

Guidelines for Examination of Industrial Designs

Sponsoring Committee: Design Law and Practice Subcommittee of the Designs Committee

Resolution:

WHEREAS, the International Trademark Association from time to time is required to analyze and comment on national and regional design examination guidelines and the practices of Industrial Property Offices;

WHEREAS, the Designs Committee has recommended Guidelines for Examination of Industrial Designs to serve as a baseline standard by which Industrial Property Offices should examine design applications and by which the Association can analyze or comment on proposed or adopted examination guidelines or practices;

WHEREAS, on 6 November 2018 the Board of Directors of the Association adopted the first version of the Guidelines for Examination of Industrial Designs to serve as a standard for the Association's analysis of and comment on design examination guidelines and practices;

WHEREAS, the Designs Committee has now recommended a first set of updates and additions to the Guidelines, which are based on positions taken and several submissions made by the Association, in the field of designs, since the first version of the Guidelines was adopted in 2018, as well as to reflect changes in technology and to make the Guidelines more comprehensive;

BE IT RESOLVED, that the International Trademark Association adopts the attached revised **Guidelines for Examination of Industrial Designs** to serve as the baseline standard for Industrial Property Offices' practice in the examination of design applications, and by which INTA can analyze or comment on national and regional guidelines for the examination of design applications.

Background:

INTA has since at least as early as 1998 had formal Guidelines for Trademark Examination, which have been presented to trademark offices worldwide over the years and which have, moreover, served as an effective reference document for the Association to provide guidance to those offices.

With the inclusion of design rights as a new area of intellectual property within INTA's mission and the establishment of the Designs Committee of the Association in 2016, the Association had the need to create policy in respect of design rights independently of their impact on trademark law and practice.

In November 2018, the Board of Directors of the Association adopted the first version of the Guidelines for Examination of Industrial Designs, which suggested a minimum set of standards for design examination. Those Guidelines have already been used by the Designs Committee and the Association generally in responding to a number of consultations relating to national or regional design laws, across the world, thus affording INTA the opportunity to demonstrate its expertise in this area and to improve design examination for brand owners and consumers worldwide and to effectively advocate for harmonization of design right practice.

The Design Law and Practice Subcommittee of the Designs Committee has, since the adoption of the first version of the Guidelines, been required to analyze and provide comment on various issues that, while not controversial, were not directly covered by the Guidelines.

Moreover, developments in examination practice, such as the use of e-filing, the increasing use of the WIPO Digital Access Service (DAS) system, as well as the need to take into account technological advances and the need to protect designs in the field of Graphical User Interfaces (GUIs), projected, holographic, and/or virtual/augmented-reality designs (collectively “PHVARs”) and Interior Designs, prompted a revision of the Guidelines.

The Subcommittee carefully examined and analyzed trends in worldwide design examination practice and drew on both existing and proposed design right examination best practice, as well as INTA members’ expertise worldwide. In drafting the Guidelines, committee members considered and had due regard to the Association’s Model Design Law Guidelines, though it is noted that some of the recommendations in these Guidelines deliberately go further than the minimal consensus points in the Model Design Law Guidelines, insofar as they concern design examination and practice, an area which is generally less controversial than the underlying design laws. The Subcommittee also decided to introduce detailed design representation examples, taken from public registered design records, to provide recommendations and examples of best practice in the field of design representations for the benefit of members and Industrial Property Offices alike. Finally, having regard to INTA’s greater voice in the design right area and greater experience in harmonizing this area, the Subcommittee decided to strengthen various of the recommendations set out in the first version of the Guidelines.

The Guidelines are, as with the first version, written in a jurisdictionally neutral way and enable INTA to continue to take positions purely on design examination practice, without a connection to trademarks.

Input was provided by the Designs Committee as a whole and the revised Guidelines for Examination of Industrial Designs were also presented to and approved by the Association’s Advocacy Group Council.

Accordingly, the Subcommittee unanimously recommended that the Board approve this resolution adopting the Guidelines for Examination of Industrial Designs as currently drafted.