

Model Design Law Guidelines

May 16, 2023

Sponsoring Committee: Designs Committee

PROPOSED RESOLUTION:

WHEREAS, the International Trademark Association from time to time needs to analyze and comment on national and regional design laws and regulations;

WHEREAS, the Designs Committee has recommended Model Design Law Guidelines to serve as a baseline standard by which INTA could analyze or comment on national and regional design laws and regulations;

WHEREAS, the first version of the Model Design Law Guidelines was adopted by INTA's Board of Directors on November 7, 2017;

WHEREAS, the first set of updates of the Model Design Law Guidelines was adopted by INTA's Board of Directors in 2019;

WHEREAS, the Designs Committee has recommended a second set of updates and additions to the Guidelines, which are based, amongst others, on positions taken and several submissions made by INTA, in the field of designs, since the second version of the Guidelines was adopted in 2019 as well as on the proposed amendments to the Design Directive and Community Design Regulation;

BE IT RESOLVED, that the International Trademark Association adopts the attached (revised) Model Design Law Guidelines to serve as a baseline standard by which INTA could analyze or comment on national and regional design laws and regulations.

BACKGROUND:

In November 2017, INTA's Board of Directors adopted the first version of the Model Design Law Guidelines. These were based primarily on the Model Trademark Law Guidelines, which the Association has had for many years. They attempted to suggest a minimum set of standards for design laws for, for example, a jurisdiction looking at implementing design law for the first time, or a jurisdiction amending its design law.

In addition to the Model Trademark Law Guidelines, the Designs Law and Practice Subcommittee ("the Subcommittee") has been assisted by a good number of submissions published by INTA during the years 2020 to 2023 in several jurisdictions (e.g. India, Spain, UK, etc.) and with the European Commission (i.e. the ECTA and MARQUES, INTA Joint Comments on the EU's Proposed New Design Law filed in January 2023 to the EU Commission).

The Subcommittee further took into consideration the draft Design Law Treaty currently being negotiated within the World Intellectual Property Organization (WIPO).

The Model Design Law Guidelines are aimed at being non-contentious. Accordingly, there are a number of contentious aspects of design law that have purposefully not been addressed (for example, the exhaustion/limitation of rights) and others that have been addressed neutrally (such as whether an examination or deposit system is to be preferred). However, the Subcommittee felt that certain aspects of design law should be included in the Model Design Law Guidelines to further complete them – such as the aspect of unregistered designs.

In order to develop a comprehensive set of guidelines addressing the main issues, the Subcommittee recommended a more detailed Model Design Law Guidelines which allows INTA to continue to build a framework for weighing in on design law and practice.

The Subcommittee has therefore proposed further additions to the Guidelines to broaden its coverage and refine certain positions based on more recent developments and positions taken by INTA. These enhancements are focused in the areas of protection of partial designs, multiple designs, protection of icons, and graphical user interfaces, and projected, holographic, and/or virtual augmented reality (PHVAR) designs, deferral of publication, remedies, correction or addition of priority claim; restoration of priority right and unregistered designs.

In conclusion, the Designs Law and Practice Subcommittee of the Designs Committee recommends that the Board of Directors pass a resolution adopting the Model Design Law Guidelines as currently drafted.