

**GUIDELINES FOR EXAMINATION OF INDUSTRIAL DESIGNS**

**A REPORT ON CONSENSUS POINTS FOR  
EXAMINATION OF INDUSTRIAL DESIGN APPLICATIONS**

May 2021

# GUIDELINES FOR EXAMINATION OF INDUSTRIAL DESIGNS

Design Law and Practice Subcommittee

Designs Committee

May 2021

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# **INTA GUIDELINES FOR DESIGN RIGHTS EXAMINATION**

## **1. INTRODUCTION/PURPOSE**

The purpose of this document is to provide general guidelines on a full range of issues related to examination of applications for industrial designs. These Guidelines are not intended to be limited to the design law of any specific jurisdiction; rather, they follow generalized conceptual lines. The Guidelines are meant to reflect various international systems in an effort to harmonize design law practice. The intention is that these Guidelines be available as a reference document, particularly for Industrial Property Offices.

## **2. MEANS OF FILING**

### **2.1 Pre-Application**

**2.1.1 Third Party Searching.** Industrial Property Offices should provide access to design rights for which publication is not deferred so applicants may search the records, on a free-of-charge basis.

**2.1.2 Classification Systems.** INTA strongly recommends that, in the interests of international harmonization, Industrial Property Offices use the Locarno Classification for the classification of goods.

### **2.2 Filing**

Industrial Property Offices should provide an official form in the designated language in which the form should be filed to be used by applicants to file the design application. INTA considers that substantial cost and administrative savings can be made to users through the filing of multiple designs in a single application (“multiple design application”) and therefore strongly recommends that Industrial Property Offices allow the filing of such multiple design applications. INTA further strongly recommends that Industrial Property Offices not require that all designs within a multiple application be in the same (Locarno) class.

Industrial Property Offices should allow for submission of applications and prosecution documents by hand, post, facsimile, and/or electronic transmission (e-filing). INTA recommends, however, due to the loss in quality in transmission by facsimile (fax) and more traditional means, that Industrial Property Offices adopt and encourage the use of filing through secure electronic transmission/e-filing interfaces. Nevertheless, users should not be penalized for failing to file electronically where electronic filing is not possible (for example due to technical problems). We therefore recommend maintaining back-up options

for when e-filing is not possible. Further, we do not support higher fees for paper-based applications or for applications filed other than by e-filing.

Industrial Property Offices should promptly provide confirmation of receipt of the application, ideally electronically, providing a receipt date, and an application number. They should also allow for payment of fees by cash, check, credit cards, EFT, and deposit accounts.

### **2.3 Response time, extensions and remedies for missed deadlines**

Industrial Property Offices should examine the application and issue a notification of objections to registration within a reasonable period after the filing date, i.e., within three to six months after the filing. The applicant should be provided a reasonable time period, of at least four weeks, within which to respond to any objections or rejections issued by the Industrial Property Office. Such deadline should be extendible at least once. In view of the fact that the consequences of missed deadlines in relation to designs can be drastic, we recommend the provision of a (limited time) remedy for missed deadlines, such as “continuation of proceedings”, upon payment of a fee.

### **2.4 Fast track examination**

Industrial Property Offices should provide a process for expedited examination, and may set criteria for qualifying for expedited examination, for example, existing or imminent litigation, or the need to immediately protect the design(s) in the market, and may charge reasonable additional fees for expedited examination.

### **2.5 Representation**

Industrial Property Offices should determine when an applicant may represent itself and when an applicant must have a representative in proceedings before that Office and the qualifications of the professional representative.

### **3. MULTI-NATIONAL APPLICATIONS**

Existing mechanisms that allow for the submission of a single application resulting in registrations that provide protection in multiple territories are encouraged. INTA strongly encourages countries, intergovernmental organizations, and non-member countries whose citizens are covered by the adherence of an intergovernmental organization to accede to the Hague Agreement Concerning the International Registration of Industrial Designs, enacting implementing legislation on the registration and enforcement of design rights. INTA can provide assistance to countries in their consideration of adherence to the system.

### **4. MANDATORY REQUIREMENTS OF A DESIGN APPLICATION**

INTA recommends that design applications be required to provide the following mandatory elements:

- Identification of the applicant, in such a way that allows them to be identified and contacted;
- A sufficiently clear representation of the design; and
- Indication of the product.

#### **4.1 Identification of the Applicant**

The applicant should be required to provide sufficient information so as to enable it to be identifiable to third parties and for it (or its representative, where appropriate) to be contacted in relation to the design. It is recommended that the applicant be required to provide its name (including, where appropriate, its legal status) and physical address (not PO Box) for correspondence purposes. In principle, no more than one address should be given for each applicant. Applications should be capable of being filed in the name of more than one applicant. Where the Industrial Property Office uses identification numbers for owners for administrative purposes, it should be sufficient in the application to mention that number.

#### **4.2 Representation of Design**

##### **4.2.1 Quality of the Representation**

The representation of the design should be of sufficient quality to clearly identify the design for which registration is sought and enable it to be compared to other designs. The representation should be permitted in black and white or color, and should consist of a graphic or photographic reproduction of the design. INTA is in favor of not combining different types such as graphic and photographic in one set of single design representation, as well as not combining the design's representations in black and white and in color.








The Industrial Property Office may specify requirements for the resolution and size of the representation.

INTA welcomes the possibility of filing dynamic views (e.g. 3D digital representations and video files) as an optional representation tool. Search tools and databases should be updated accordingly to reflect these kinds of representations and make them searchable. INTA does not encourage the use of specimens.

The design should be represented on a neutral background, and there should not be non-design elements showing in the representation. Industrial Property Offices should permit applicants to show, by way of contour shading, details of the contour of the design. Contour shading may be in the form of line shading, stipple shading (dots), or both.

Examples of static representation types in graphic and photographic reproductions, in both black and white, and color are given below.



Graphic reproduction examples			Photographic reproduction examples	
Black and white line drawing	Black and white 3D drawing	Colored 3D drawing	Black and white photograph	Colored photograph
<p>1.1</p>  <p><u>DM/205 602</u></p>	<p>1.1</p>  <p><u>DM/206 505</u></p>	<p>1.1</p>  <p><u>DM/093 868</u></p>	<p>1.1</p>  <p><u>DM/204 148</u></p> <p>Alternatively;</p> <p>1.1</p>  <p><u>DM/207 055</u></p>	<p>1.1</p>  <p><u>DM/201 388</u></p> <p>Alternatively;</p> <p>1.1</p>  <p><u>DM/203 251</u></p>

In many jurisdictions, typeface/type font designs are registered as a set. Regarding typographic typeface/type font design representations, INTA suggests that all characters including letters in both upper and lower cases, numerals, punctuation marks and any other special characters designed by that particular typeface/type font should be shown in the representations. It is advisable to show the characters at the minimum size of 16 Point in order to show details. Four lines of text comprising all typographic characters can also be added to show the typeface in text format.

An example is given below.

DM/206  
155

1.1

**ABCDEFGH  
IJKLMNOP  
OPQRSTU  
VWXYZ  
abcdefghij  
klmnopqr  
stuvwxyz**

1.2

**The quick  
brown fox  
jumps  
over the  
lazy dog**

The quick brown fox jumps over  
the lazy dog

1.3

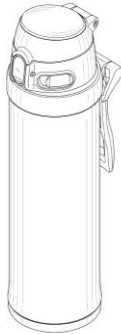
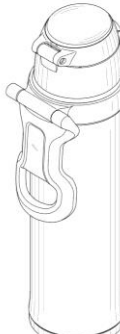
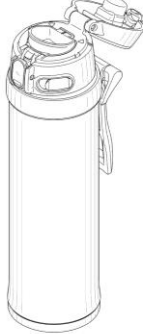
**H a  
R e  
S g**

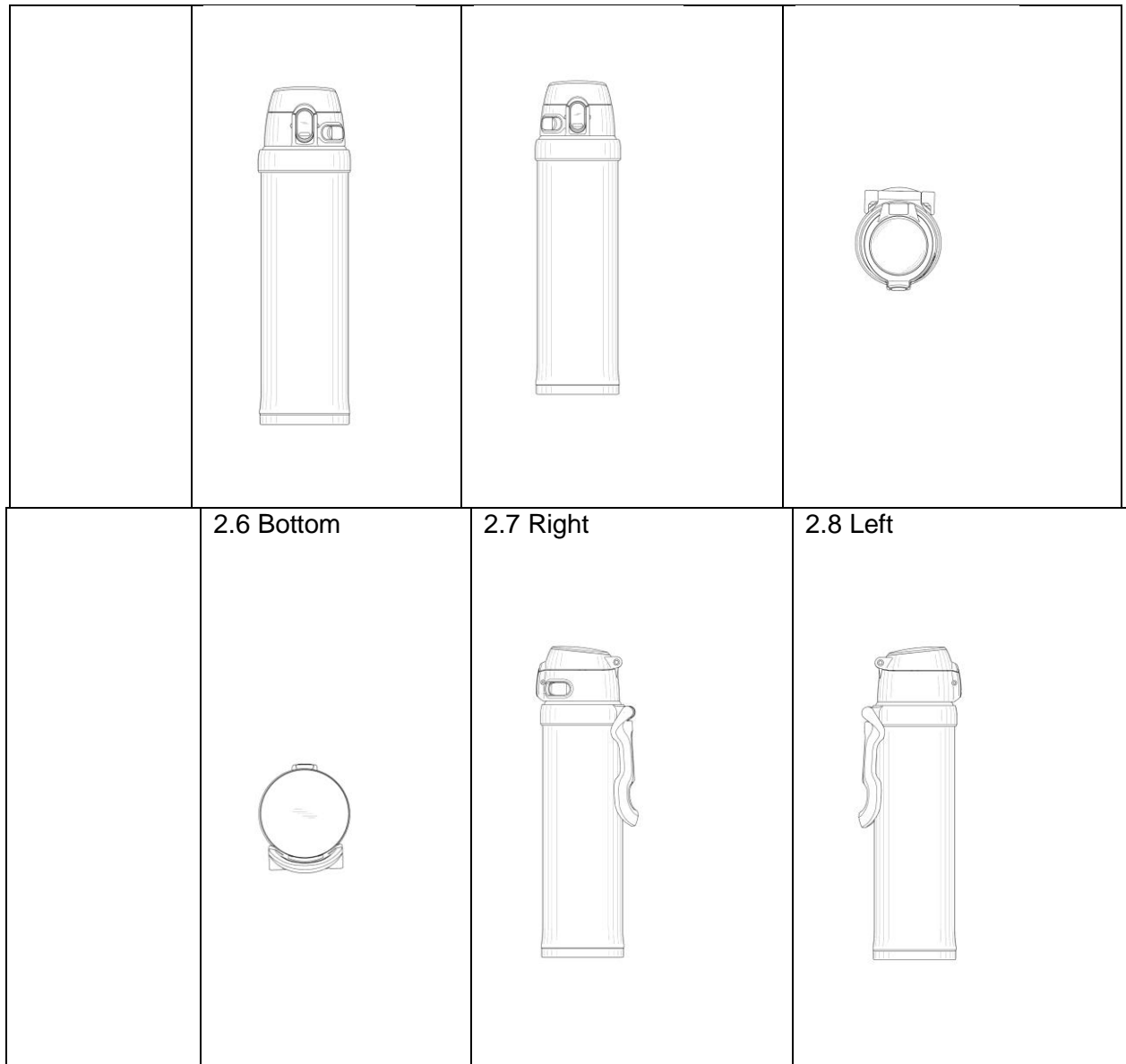
#### 4.2.2 Number of Views

There should be no minimum number of views to depict the design in question, and it should be possible to file as many representations as may reasonably be required to fully disclose the design. A sufficient number of views showing the design from different angles and alternative positions such as open/closed positions, if any, should be included in order to provide a better understanding of the design.

It is suggested to use perspective and orthogonal views (front, back, top, bottom, right side and left) of a three-dimensional design. Design applications should, however, be concise so as to avoid creating excessive work at the Industrial Property Office, resulting in backlog issues. In this regard, repeated views should not be included, and it is noted that mirrored images, flat bottoms, and unornamented surfaces can be clearly indicated in the description (where provided).

Below are examples of representations showing the design from different angles.

	DM/206 296		
Perspective views	2.1 Perspective 	2.2 Perspective 	2.6 Perspective 
Orthogonal views	2.3 Front	2.4 Back	2.5 Top



### 4.2.3 Consistency of Views

#### 4.2.3.1 Different Formats of Representations for the Same Design

The scope of protection will often vary depending on whether the representation of a design is in the form of a simple line drawing, a greyscale image, or a color photograph. To avoid doubts as to the scope of protection, representations of a single design should all be in the same format.

#### 4.2.3.2 Consistency of Visual Content Contained in Representations

All representations of a single design should relate to the same design. Levels of detail and colors should be consistent between representations.

If two or more representations are inconsistent with each other regarding the level of detail shown in them, colors used, etc., the applicant should be given a reasonable period of time to withdraw representations (without affecting the filing date of the other representations) or submit amended representations that are consistent.

If inconsistent representations are filed which support different designs, the applicant should be given an opportunity to convert the application into a multiple or separate design application for the different designs as shown in the different representations. The multiple or separate design application(s) should retain the original filing date or priority date (where applicable).

#### 4.2.3.3 Consistency Between Representation and Classification for Whole Design

The Industrial Property Office should be entitled to object if the classification/indication of product clearly does not match the design as shown in the representation(s). The applicant should be given a reasonable period of time to file amended representations or an amended classification to correct the inconsistencies.

#### 4.2.3.4 Consistency Between Representation and Classification for Parts of Designs.

The Industrial Property Office should be entitled to object where it is uncertain whether the representation(s) of the design is/are consistent with the classification if the product identified is not the whole article shown in the representation, or when the classification/indication of the product describes the whole object when the representation only shows part of the object. The applicant should then be given a reasonable period of time to file amended representations or an amended classification to correct the inconsistency.

### **4.2.4 Visual Disclaimers**

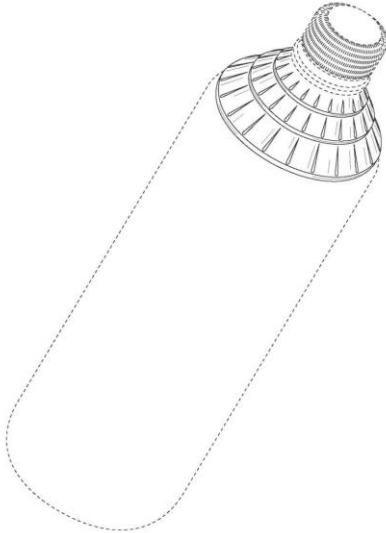

All Industrial Property Offices should permit applicants to show, by way of a visual disclaimer, parts of the design for which protection is not sought. The visual disclaimer must be clear and obvious, meaning the claimed and disclaimed design elements should be clearly differentiated. The Industrial Property Offices should issue clear guidelines for such disclaimers.

INTA prefers that visual disclaimers be achieved by indicating with broken lines the features of the design for which protection is not sought, especially when the design is shown in line drawing format. The disclaimer may be achieved by other means such as blurring the features of the design for which protection is not sought, and/or including within a boundary the features of the design for which protection is sought.

#### 4.2.4.1 Broken Lines

Broken lines consist of a trace made up of dots and/or dashes, and are used to indicate that no protection is sought for the features shown using an uninterrupted trace. A visual disclaimer consisting of broken lines will usually be combined with continuous lines reflecting what is claimed. To be accepted, the features for which protection is not sought should be clearly indicated with broken lines, and the parts for which protection is sought should be indicated with continuous lines.

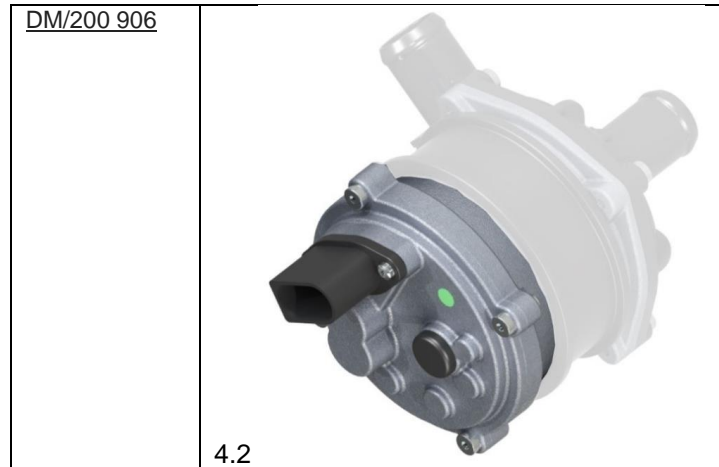
Below are examples of representations of design registrations in which a partial disclaimer is shown with broken lines.

<u>DM/201 443</u>	 <p>1.1</p>
<u>DM/210 273</u>	 <p>1.1</p>

#### 4.2.4.2 Blurring

Blurring is a type of visual disclaimer that consists of obscuring the features for which protection is not sought in the drawings or photographs of a design application. The blurred features to be disclaimed should be clearly distinguishable from the rest of the design for which protection is claimed.

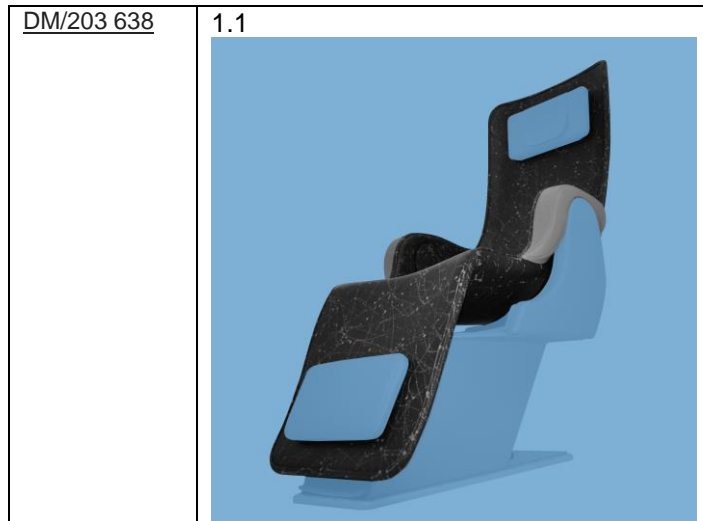
Below is an example of a representation of a design registration in which a partial disclaimer is shown with blurring technique.



#### 4.2.4.3 Color Shading

Color shading is a type of visual disclaimer that consists of using contrasting tones to sufficiently obscure the features for which protection is not sought in the drawings or photographs of a design application. The color-shaded features to be disclaimed should be clearly distinguishable from the rest of the design for which protection is claimed.

Below is an example of a representation of a design registration in which a partial disclaimer is shown with color shading technique.



#### 4.2.4.4 Boundaries

Some jurisdictions allow boundaries as a type of visual disclaimer used in drawings or photographs of a design application to indicate that no protection is sought for the features not contained within the boundary. To be accepted, the features for which protection is sought should be clearly indicated within the boundary. All features outside of the confines of the boundary are disclaimed and will not be protected.

### **4.3 Identification of Product**

The applicant should identify the object to which the design is applied or is made perceptible in such a way to specify clearly the nature of the product. In order to facilitate the searching of designs, INTA strongly recommends that the Industrial Property Office either classify, or require the applicant to classify, the product in accordance with the Locarno classification.

### **4.4 GUIs, PHVARs and Interior Designs**

INTA recognizes the commercial importance of graphical user interfaces (GUIs), icons, fonts and animations, as well as projected, holographic and/or virtual/augmented reality (PHVAR) designs, and accordingly recommends that these be capable of registration in and of themselves without requiring them to be placed on a physical article. Similarly, INTA recognizes the commercial importance of interior designs, whether real or virtual, and considers that they should also be capable of registration in and of themselves.



## 5. OPTIONAL ELEMENTS OF A DESIGN APPLICATION

### 5.1 Description

A description can help clarify the features being claimed for protection or other aspects of the design, and it can also help users of the system and enforcement bodies interpret the scope of protection of a design (although any description should not define such scope of protection in and of itself).

For example, a description can be helpful to clarify the design where different views of the same design display different colors or where the nature of a product causes it to adopt different positions in use. A complementary description can also provide better understanding of the nature or purpose of some features of the design. Industrial Property Offices should provide that the applicant can include a written description to be submitted with the application. The description should only relate to features that appear in the representations of the product design. It should not contain statements concerning non-visual features, protection requirements, or value of the design (e.g. novelty, individual character, non-obviousness, or technical value). The description should not define the scope of protection of a design.

### 5.2 Convention Priority Claims

The priority declaration should contain the date, number, and country of the first application and should be submitted no later than one month from the date of filing of the design application. The details and the certified copy of the previous application, where required, should be permitted to be filed after the filing of the application or the declaration of priority, e.g. within three months.

INTA strongly encourages Industrial Property Offices to accede to WIPO Digital Access Service (DAS), an electronic system that allows priority documents and similar documents to be securely exchanged between Industrial Property Offices. WIPO DAS system enables applicants and Industrial Property Offices to meet the requirements of priority documents by only obtaining the DAS Code and eliminating the obligation of requesting and submitting the certified paper copies of documents from one Industrial Property Office and then submitting those documents to other Industrial Property Office(s).

### **5.3 Exhibition Priority**

The effect of exhibition priority is that the date on which the design was first displayed at an exhibition, or was in any other way made available to the public (collectively, “display”), is deemed to be the date of filing of the application for a registered design. The applicant may claim exhibition priority only within six months of the first display. Evidence of the display must be filed. Exhibition priority cannot extend the six-month period of ‘Convention priority.’

Exhibition priority may be claimed at filing or after filing a design application. Where the applicant wishes to claim exhibition priority after filing, the declaration of priority, indicating the name of the exhibition if applicable, the nature of the display, including disclosure of the product in which the design was incorporated or means by which the design was made perceptible, and the date of first display, should be submitted within a period of one month of the filing date.

If a certificate is required, it should be permitted to be filed after the declaration of priority, e.g. within three months. The certificate should state the nature of the display, including disclosure of the product in which the design was incorporated or made perceptible, and date of the first display. The certificate should be duly certified by the exhibition authority and accompanied by identification of the actual display of the design.

### **5.4 Request for Deferral of Publication**

Industrial Property Offices should permit the deferment of publication of the design, if the applicant elects to do so. The permitted deferment period should be up to 30 months after the date of application. A request for deferment, if desired, should be made in the application. The applicant may be required to pay a fee for deferment of publication along with the application. Payment of the publication fee should be optional at the filing stage. An application for publication should be filed and payment of the publication fee made at a time of the applicant’s choosing before the end of the deferment period in order for the design to be published. Claiming priority from an earlier design application should not change the available term of deferment of publication of the design filed.

In the case of a multiple design application, a request for deferment of publication should be permitted to concern only some of the designs of the multiple design application.

### **5.5 Identification of Designer**

The application may include an indication of the designer(s), a collective designation for a team of designers, or an indication that the designer(s) or team of designers has/have waived the right to be cited. Information as to the designer(s) may also be added by the applicant at a later date, after filing the application. Industrial Property Offices should not have a requirement under which the applicant has to prove that the designer has assigned

her/his rights to the applicant, nor should Industrial Property Offices have a requirement that naming of the designer be mandatory.

## **5.6 Signature**

INTA recommends that, where a signature is required in the application, it should not be required to be a “wet ink” signature, and that Industrial Property Offices should allow electronic forms of signature.

## **6. PROCEDURAL MATTERS**

### **6.1 Examination Procedure**

#### **6.1.1 Scope of Examination**

The scope of examination, as well as the criteria by reference to which examination is conducted, will be determined by the substantive law under which an Industrial Property Office operates. Each Office should publish its requirements and make them available to users. Although the wording of a given jurisdiction’s design law may vary, there are three main elements of examination: formalities, absolute grounds, and relative grounds.

A formalities examination should be conducted by each Office prior to registration. However, the extent of absolute and relative examination may vary widely. In some jurisdictions there are no examinations on relative grounds, although a search may be carried out to make the applicant aware of possible relative objections.

#### **6.1.2 Formalities Examination**

Industrial Property Offices should examine applications to confirm that they contain the essential minimum data specified by design law. This should include: applicant details, representation of the design suitable for reproduction, compliance with the definition of design, compliance with the number of views permitted under the law, consistency of the views, and indication of products. Optional data that may be specified under design law should, as above, include classification, claims of priority, description of the design(s), and request for deferral of publication.

#### **6.1.2 Absolute Grounds Examination**

If an Industrial Property Office conducts an absolute grounds examination, a design applicant should be afforded the opportunity to respond, within a reasonable period of time, to any objection made. Specifically in relation to any possible ground for refusal based on

technical function, no objection should be raised unless the appearance of the design as a whole is solely dictated by its technical function, even if individual features of the design or the design as a whole serves a technical function. Such technical function ground for refusal should apply in rare cases only.

### **6.1.3 Relative Grounds Examination**

If an Industrial Property Office conducts a relative grounds examination, the examination of the designs should include an analysis of actual conditions in which the public will encounter the designs rather than based solely on classification.

### **6.1.4 Registration, Publication, and Certificates**

Unless a request for a deferment of publication is made and granted, once examination of grounds for non-registrability, formalities, required information is confirmed, all fees are paid, and no deficiency is found, those Industrial Property Offices that issue registrations prior to publication should issue the registration followed by publication.

Unless a request for deferment of publication is made and granted, those Offices that publish designs prior to registration should proceed to publication of the design and issue the registration certificate if no objection is raised during the opposition/publication period.

In either case, publication should be made in a timely fashion not exceeding three months. Likewise, issuance of the registration should be in a timely manner.

## **7. AMENDMENTS OF AN APPLICATION/REGISTRATION**

### **7.1 Corrections/Other Changes**

Amendments to the application should be permitted for the purpose of correcting errors and overcoming objections. Industrial Property Offices may determine that certain elements cannot be amended or corrected, without affecting the filing date. Where amendments concern features of the design, it should be possible to proceed with the amended design with a new filing date rather than the design being rejected. Depending on the circumstances, an amendment may be requested in writing, by telephone followed by confirmation sent in writing to the applicant, or electronically. Generally, if an amendment is required to correct an administrative error of the Industrial Property Office, it should be allowed at any time.

## **7.2 Changes with Respect to Design Owner**

The applicant should be entitled, at any time, to request a change of name or address, or record a transfer, in respect of designs. It is recommended that Industrial Property Offices allow design owners to seek updated registration certificates reflecting any changes, if appropriate upon payment of a fee.

## **7.3 Withdrawal/Surrender**

Withdrawal of a single or multiple design application, or of any view, should be permitted at any time prior to registration. In the case of multiple design applications, applicants should be permitted to withdraw some of the designs any time prior to registration.

Surrender of a single or multiple design application should be permitted at any time after registration. In the case of multiple design applications, holders should be permitted to surrender some of the designs any time after registration.

## **7.4 Licenses/Security Interests**

The applicant should be entitled, at any time, to request the recordal of a license or security interest in respect of the design or particular design(s) in a multiple design application. The Industrial Property Office shall publish the fact of such license or security interest, and shall include a link or other cross-reference to such recordal(s) in the official files of the affected application or registration.