

GUIDELINES FOR EXAMINATION OF INDUSTRIAL DESIGNS

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

November 2018

GUIDELINES FOR EXAMINATION OF INDUSTRIAL DESIGNS

Design Law and Practice Subcommittee

Designs Committee

November 2018

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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 territory; 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 so applicants may search the records, on a free-of-charge basis.

2.1.2 Classification Systems. Generally accepted classification systems, such as the Locarno Classification, should be adopted for harmonization.

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 applications”) and therefore strongly recommends that Industrial Property Offices allow the filing of such multiple applications. INTA further recommends that Industrial Property Offices not require that the designs within a multiple application need to be in the same class.

Industrial Property Offices should allow for receipt of applications and prosecution documents by hand, post, facsimile, and/or electronic transmission. INTA recommends, however, due to the loss in quality in transmission by facsimile (fax), that Industrial Property Offices phase out the use of this method for design applications, in favor of more reliable methods of secure electronic transmission. Industrial Property Offices should provide confirmation of receipt of the application in a similar means as that of the application filing, provide a filing 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

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.

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. They should notify the applicant in a similar means as that of the application filing.

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 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;
- Indication of the product; and
- An express or implicit request for registration.

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, address and nationality. 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 readily 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, or even in a video file. The Industrial Property Office may specify requirements for the resolution and size of the representation.

4.2.2 Number of Views

There should be no minimum number of views to depict the object in question. Industrial design applications should be concise so as to avoid creating excessive work at the Industrial Property Office, resulting in backlog issues. Unless needed to fully disclose the design, not more than 10 to 14 views should be provided. 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.

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. 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.

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, unless otherwise explained, to prevent potential confusion.

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 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 application for the different designs as shown in the different representations. The multiple or separate applications should retain the original filing date.

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 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 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 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 elements of the design 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. 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.

4.2.4.2 Blurring

Blurring is 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 disclaimed features should be clearly distinguishable from the rest of the design for which protection is claimed.

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 sought.

4.2.4.4 Boundaries

Boundaries are 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 Indication of Product

The applicant should indicate the object to which the design is applied in such a way to indicate clearly the nature of the product. In order to facilitate the searching of designs, INTA recommends that the Industrial Property Office either classify, or require the applicant to classify, the indication of the product in accordance with the Locarno classification. INTA recognizes the commercial importance of graphical user interfaces (GUIs), icons, fonts and animations and accordingly recommends that these be capable of registration in and of themselves without requiring them to be placed on a physical article.

4.4 Request for Registration

An application for a design should include an express or implicit request for registration of the design(s). Industrial Property Offices should include such a request in their official forms.

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. As an example the 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 filing. 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.

5.3 Exhibition Priority

The effect of exhibition priority is that the date on which the design was first displayed at an officially recognized exhibition is deemed to be the date of filing of the application for a registered design. The applicant can claim exhibition priority 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 can be claimed at the time of filing or after filing a design application. Where the applicant wishes to claim exhibition priority after having filed an application, the declaration of priority, indicating the name of the exhibition and the date of first display of the product, should be submitted within a period of one month of the filing date.

Any certificate required by the responsible authority of the exhibition should be permitted to be filed after the filing of the application or the declaration of priority, e.g. within three months. It is recommended that such certificate state that the design was disclosed at the exhibition, specify the opening date of the exhibition, that the first public use did not coincide with the opening date of the exhibition, and the date of first public use. The certificate should be duly certified by the authority and accompanied by identification of the actual disclosure of the

product in which the design is incorporated. Priority can only be granted where the application for a design is filed within six months of first display at an exhibition recognized for this purpose, namely a world exhibition.

5.4 Request for Deferment of Publication

Industrial Property Offices should permit the deferment of publication of the design, if the applicant elects to do so. The maximum permitted deferment period should be at least 12 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, at a time of the applicant's choosing before the end of the deferment period and payment of the publication fee made in order for the design to be published. Claiming priority from an earlier design application should not change the available term of deferment of the publication of the design filed.

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

5.5 Identification of Designer

The application may include a citation 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.

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 territory's design law may vary, there are three main elements of examination: formalities, absolute grounds, and relative grounds.

A formalities examination should be conducted prior to registration. However, the extent of absolute and relative examination may vary widely. In some territories 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 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, use of visual disclaimers, 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 deferment.

6.1.3 Relative Grounds Examination

If an Industrial Property Office conducts a relative examination for similar designs, 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 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

Amendment 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, 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. The Industrial Property Office shall not be obliged to update a registration certificate where such a change is made after the design has been deemed registered.

7.3 Withdrawal/Surrender

Withdrawal of a single or multiple design application 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. Requests should be submitted in writing in the manner in which the application was originally filed.

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.