



European Communities Trade Mark Association

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ECTA COMMENTS ON WIPO USER SURVEY ON INDUSTRIAL DESIGN REGISTRATION PROCEDURE

ECTA welcomes the International Bureau's initiative to evaluate design users' views on the International Design Registration Procedure.

The Survey has been available online under <https://webaccess.wipo.int/opinio/s?s=5173>. Members of ECTA's Design Committee have completed the Survey individually using WIPO's website.

The present paper summarises ECTA's Design Committee members' ¹ collective opinions on the survey:

General observation:

The answers to most of the questions are common to EU national systems harmonised under the EC-Design Directive No. 98/71. For many countries of the EU the majority of the questions of the survey can be answered by "yes" due to changes already in place before the national Intellectual Property Offices. This applies especially to questions 2.1 to 2.5 and questions 2.7 of Section 2 of the survey. The registration procedure is, with respect to the topics touched by these questions, a little easier and quicker.

Standardisation:

ECTA wishes to draw attention to question 2.8 regarding the Standardisation of information required for filing a design application.

¹ This paper has been prepared under the lead of the Vice-Chair of ECTA Design Committee, Elena Sonn with the active contribution of the Committee members, Ketih Hodkinson and Lena Ericsson.



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Reference hereto is made to the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) regarding Convergence of Design Law and Practice, in which the Design Committee of ECTA is taking part and, hence, is aware of the ongoing Convergence project aiming for common formal standards for International Design Applications/Registrations as well as its present status.

ECTA wishes to emphasise that more standardisation is desired by users and thus the continuation and successful completion of the Convergence project is of great importance.

However, more specifically, regarding question 2.8, ECTA wishes to stress that great caution should to be exercised before accepting any kind of graphic or photographic representation of a design.

By providing a greater choice of representation to applicants the International System is vulnerable to the filing of “arbitrary” representations, where applicants may file representations in which e.g. views, greyscales, colours, dotted or stippled lines in line drawings for disclaiming, shadings in 3-dim designs, etc. have divergent “meanings” in national systems. Thus, the meaning and scope of the same industrial designs may be interpreted differently by national authorities and/or third parties.

The situation becomes especially dangerous where inexperienced applicants (who may be prone to file inappropriate representations) are concerned; additionally, without rules or guidelines subjective points of view come into play which can lead to inconsistent protection and additional expense for users of the system).

Filing “any kind of” representations can, hence, easily give rise to (legal) uncertainties and insecurities with regard to:

- certainty as to the definition/scope of protection of a design,
- searches of designs,
- possible inconsistent protection for the same representations of the design registration in different countries,
- enforceability of the granted designs.



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Interpretation of a design having such representations, especially ones without a description including a statement of the features for which protection is sought pose difficulties for the national authorities as well as for third parties when assessing the scope of protection of (the national part) of an International Design Registration.

Therefore, ECTA takes the view that allowing too liberal rules or a unrestricted choice of forms of representation for a design application makes designs - in the absence of common guidelines as to the interpretation of said representations - less easily understandable by third parties, less easily searchable and less easily enforceable (a design, filed as an International Application, being registrable as opposed to an enforceable design).

ECTA strongly supports the continuation of the Convergence project of the SCT, i.e. leading to at least minimum standards with regard to representations of designs and common guidelines as to the meaning of certain drawing conventions, resulting in legally certain and secure International Design Registrations.

Legally valid documents:

The issue touched by question 2.9 (legalisation and authentication of documents may be omitted for acceptance of an International Design Registration) is welcomed by ECTA. However, it is to be stressed that national requirements are of importance for legal certainty.