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**STANDING COMMITTEE ON THE LAW OF TRADEMARKS,
INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS**

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DRAFT QUESTIONNAIRE ON INDUSTRIAL DESIGN LAW AND PRACTICE

Document prepared by the Secretariat

INTRODUCTION

1. At the sixteenth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), held in Geneva from November 13 to 17, 2006, the SCT requested the Secretariat to develop a questionnaire relating to the formalities of industrial design registration and to the borderlines between all types of marks and industrial designs (see document SCT/16/8, paragraphs 25 and 27). Accordingly, the Secretariat has prepared the present document which contains, in its Annex, a draft questionnaire on industrial design law and practice dealing with the issues requested by the SCT.

[Annex follows]

ANNEX

DRAFT QUESTIONNAIRE ON INDUSTRIAL DESIGN LAW AND PRACTICE

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I. INDUSTRIAL DESIGN APPLICATION

(a) Reproduction of Industrial Design

(i) *Reproduction in general*

Q1: The industrial design, or the product or products which constitute the industrial design, may be reproduced in the form of

- photographs yes no
- drawings yes no
- technical drawings yes no
- other graphic representations yes no

Q2: Dotted or broken lines may be used to represent matter that is not part of the claimed design. yes no

Q3: A specific number of copies of the reproduction is required. yes no
If yes, please indicate the number of copies required: _____

(ii) *Contents of the reproduction*

Q4: The reproduction should contain a sufficient number of views to completely disclose the appearance of the claimed design. yes no

Q5: The number of views that may be provided is limited. yes no
If yes, please specify the maximum number of views permitted: _____

Q6: A specific number of views is required. yes no
If yes, please specify the views required:

- front yes no
- rear yes no
- right side yes no
- left side yes no
- top yes no
- bottom yes no
- other views, namely: _____

Q7: Sectional views of the industrial design are permitted. yes no

Q8: Perspective views of the industrial design are

- mandatory. yes no
- optional. yes no

Q9: A specific number of perspective views is required. yes no
If yes, please indicate the number of perspective views required: _____

(b) Descriptions

Q10: A description of the reproduction is

- mandatory. yes no
- optional. yes no

Q11: A description of the characteristic features of the industrial design is

- mandatory. yes no
- optional. yes no

(c) Design Specimen

(i) *Specimens in general*

Q12: The submission of a design specimen is

- mandatory in general. yes no
- mandatory in the case of two-dimensional designs. yes no
- optional in general. yes no
- optional in the case of two-dimensional designs. yes no
- generally not permitted. yes no

(ii) *Relation with reproduction*

Q13: The specimen

- substitutes the reproduction. yes no
- complements the reproduction. yes no
- can only be submitted in the case of a deferment of publication. yes no

Q14: If the reproduction does not correspond to the specimen,

- the reproduction is decisive. yes no
- the specimen is decisive. yes no
- the applicant is asked for clarification. yes no

(d) Indication of Products

Q15: An indication of the product or products to which the industrial design is applied, is required. yes no

If no, please indicate whether this means that an industrial design could be applied for in the abstract. yes no

Q16: An indication of the class (or sub-class) of the Locarno Classification for which the design(s) is (are) registered, is required. yes no

(e) Multiple Design Application

Q17: The application may include several industrial designs. yes no

Q18: The number of industrial designs that may be included is limited. yes no
If yes, please indicate the maximum number of industrial designs: _____

Q19: The industrial designs that are included in the same application must

- belong to the same class of the Locarno Agreement. yes no
- belong to the same set or composition of items. yes no
- conform to a requirement of unity of design. yes no
- conform to a requirement of unity of production. yes no
- conform to a requirement of unity of use. yes no

(f) Claim

Q20: The application must contain one or several claims. yes no

Q21: The number of claims is limited. yes no
If yes, please indicate the permitted number of claims: _____

Q22: The claim may generally refer to

- the reproduction or the specimen of the industrial design (“the design as shown”). yes no
- additional descriptions (“the design as shown and described”). yes no

(g) Creator of Design

(i) *General requirements*

Q23: The application must contain

- indications allowing the identity of the creator to be established. yes no
- a statement that the creator believes himself or herself to be the creator of the industrial design. yes no
- the signature of the creator. yes no

Q24: Instead of the creator’s signature, the application may contain

- the signature of the creator’s representative. yes no
- other evidence of the creator’s consent. yes no

Q25: The creator of the industrial design must be a natural person. yes no

(ii) *Requirement of filing in the name of the creator*

Q26: The application must be filed in the name of the creator. yes no

Q27: In case the applicant is not the creator, the application must contain

- a statement of assignment. yes no
- other evidence of assignment. yes no

(h) Filing Date

Q28: For a filing date to be accorded, the following indications and elements are required:

- indications allowing the identity of the applicant to be established yes no
- indications allowing the applicant or its representative, if any, to be contacted yes no
- a sufficiently clear reproduction of the industrial design yes no
- a description of characteristic features yes no
- a specimen of the industrial design yes no
- a sufficiently clear indication of the product(s) to which the design is applied yes no
- a claim yes no
- indications allowing the identity of the creator to be established yes no
- indications allowing the creator or its representative, if any, to be contacted yes no
- the payment of a fee yes no

Q29: If the application does not contain all indications and elements required, the applicant may complement the application within a given time limit. yes no
If yes, please specify the time limit: _____ months.

II. EXAMINATION AND OPPOSITION

(a) Examination

Q30: As to formal requirements, the Office examines whether the industrial design application

- indicates the identity of the applicant. yes no
- provides the contact details of the applicant or its representative. yes no
- contains a reproduction of the industrial design in a permissible form. yes no
- contains the required number of reproductions. yes no
- contains a sufficient number of views for the industrial design to be fully disclosed. yes no
- does not exceed the maximum number of views permitted. yes no
- contains the required number of perspective views. yes no
- contains a description of the industrial design. yes no
- contains a description of characteristic features. yes no
- contains a design specimen. yes no
- contains a correct indication of the product or products to which the industrial design is applied. yes no
- contains a correct indication of the class (or sub-class) of the Locarno Classification. yes no
- complies with the requirements that apply to a multiple design application. yes no
- contains a correct claim. yes no

- does not exceed the maximum number of claims. yes no
- complies with the requirements concerning the design creator. yes no
- contains a description of the industrial design. yes no
- contains a description of characteristic features of the industrial design. yes no
- is accompanied by the required fee. yes no

Q31: As to substantive requirements, the Office examines whether the industrial design for which registration is sought,

- is an independent creation. yes no
- is new. yes no
- is original. yes no
- differs significantly from known designs. yes no
- is essentially dictated by technical or functional considerations. yes no
- is contrary to morality or public order. yes no
- conflicts with official signs or emblems protected under Article 6ter of the Paris Convention, other international conventions or according to national law. yes no

Q32: When examining the industrial design, the Office takes into account

- prior industrial designs or industrial design applications. yes no
- copyright in literary or artistic works. yes no
- prior trademarks or trademark applications. yes no
- well-known marks. yes no
- geographical indications or appellations of origin. yes no
- the real or assumed name, likeness or portrait of persons. yes no

Q33: When examining an industrial design as to novelty or originality, the Office takes into account the situation

- in the country in which registration is sought (national). yes no
- worldwide (international). yes no
- in a specific group of countries (regional). yes no

If the novelty/originality standard is regional, please indicate the countries considered: _____

Q34: On average, the examination by the Office is carried out in about _____ months.

(b) Opposition

Q35: The registration system provides for

- pre-registration opposition proceedings. yes no
- post-registration opposition proceedings. yes no

Q36: In case of pre-registration opposition, the opposition procedure takes place

- after the examination of the application. yes no
- during the examination of the application. yes no

- Q37: An opposition can be lodged by
- any person. yes no
 - any person having a legitimate interest. yes no
 - a circle of persons defined in national law. yes no
- Q38: The opposition period is _____ months.
This period can be extended. yes no
If yes, please specify the maximum period of extension: _____ months.
- Q39: As to substantive requirements, the opponent may assert that the industrial design
- is not an independent creation. yes no
 - is not new. yes no
 - is not original. yes no
 - does not differ significantly from known designs. yes no
 - is essentially dictated by technical or functional considerations. yes no
 - is contrary to morality or public order. yes no
 - conflicts with official signs or emblems protected under Article 6ter of the Paris Convention, other international conventions or according to national law. yes no
 - should not be registered for other reasons, namely: _____ yes no
- Q40: The opponent may base the opposition on a conflict with
- a prior industrial design or industrial design application. yes no
 - copyright in a literary or artistic work. yes no
 - a prior trademark or trademark application. yes no
 - a well-known mark. yes no
 - a geographical indication or appellation of origin. yes no
 - a person's real or assumed name, likeness or portrait. yes no
- Q41: Oppositions are examined by
- a single examiner. yes no
 - a collegial body of examiners. yes no
 - an opposition board including a judge. yes no
- Q42: On average, the opposition procedure is carried out in about _____ months.

III. PUBLICATION AND DEFERMENT OF PUBLICATION

(a) Publication

- Q43: The industrial design is published
- before the examination by the Office. yes no
 - after the examination by the Office. yes no
 - after registration. yes no

Q44: The industrial design is published

- in a paper gazette. yes no
- on compact disc or DVD. yes no
- on the website of the Office. yes no

Q45: The publication is issued

- weekly. yes no
- every _____ weeks. yes no
- monthly. yes no
- every _____ months.

Q46: In case the application contains a specimen of the industrial design but no reproduction, the Office requests a reproduction for the purpose of publication. yes no

(b) Deferment of Publication

Q47: The applicant can request the deferment of publication. yes no
If yes, please specify the maximum period of deferment: _____ months.

IV. MANAGEMENT OF REGISTRATIONS

(a) Renewal

Q48: According to the applicable law, the registration of an industrial design is effected for

- a single term of _____ years.
- an initial term of _____ years and _____ additional terms of _____ years.

Q49: Prior to the expiry of the current term of registration, the Office sends a notice of expiry indicating the date of expiry of the registration. yes no
If yes, please specify: the notice of expiry will be sent _____ months before the expiry of the term of registration.

Q50: The renewal of an industrial design registration may be effected by

- sending a written request and paying a fee. yes no
- submitting an official form and paying a fee. yes no
- paying a fee without sending any request. yes no

Q51: In case the registration concerns multiple industrial designs, the renewal may be limited to certain industrial designs specified in the request. yes no

Q52: In case the payment of the prescribed renewal fee is not made until the date on which the renewal is due, it may still be made within a period of grace. yes no
If yes, please specify the length of the period of grace: _____ months.

(b) Licenses

Q53: With regard to registered industrial designs, the applicable law provides for the recordal of licenses. yes no

Q54: With regard to the recordal of a license, the following evidence is accepted by the Office:

- an extract of the license contract indicating the parties and the rights being licensed. yes no
- a certified extract of the license contract indicating the parties and the rights being licensed. yes no
- an uncertified statement of license signed by both the holder and the licensee. yes no

Q55: In the request for recordal of a license, the legal cause of the license must be indicated. yes no

Q56: The recordal of a license is necessary

- to maintain the protection of the industrial design concerned. yes no
- to maintain the registration of the industrial design concerned. yes no
- for the licensee to initiate infringement proceedings with regard to the industrial design concerned. yes no
- for the licensee to join infringement proceedings initiated by the holder of the industrial design concerned. yes no
- for the licensee to receive damages resulting from the infringement of the industrial design concerned. yes no

(c) Fee Structure

(i) *Filing, examination and registration*

Q57: The following stages of the registration procedure require the payment of a fee:

- the filing of an industrial design application; yes no
- the examination of the application by the Office; yes no
- the publication of the industrial design; yes no
- the deferment of publication; yes no
- the extension of time limits; yes no
- the issuance of a registration certificate. yes no

If fees are due, please indicate whether these fees depend on

- the number of industrial designs. yes no
- the number of reproductions. yes no

(ii) *Opposition*

Q58: The following stages of the opposition procedure require the payment of a fee:

- the lodging of an opposition; yes no
- the extension of time limits; yes no
- oral hearings. yes no

If fees are due, please indicate whether these fees depend on the number of industrial designs opposed. yes no

(iii) *Renewal*

Q59: If the applicable law provides for the renewal of industrial design registrations, please indicate whether the renewal fee depends on

- the number of industrial designs to be renewed. yes no
- the number of reproductions. yes no

Q60: If the applicable law provides for a period of grace with regard to the payment of the renewal fee, please indicate whether the payment of the renewal fee during the grace period is subject to the payment of a surcharge. yes no

If yes, please specify whether the surcharge depends on

- the number of industrial designs to be renewed. yes no
- the number of reproductions. yes no

(iv) *Recordal of licenses*

Q61: If the applicable law provides for the recordal of a license, please indicate whether the recordal requires the payment of a fee. yes no

If yes, please specify whether the fee depends on the number of industrial designs covered by the license.

yes no

V. COMMUNICATION WITH THE OFFICE

(a) Means of Communication

Q62: The Office accepts communications

- on paper. yes no
- filed by electronic means of transmittal, such as fax. yes no
- filed in electronic form, for instance, via the Internet. yes no

Q63: Applications can be filed

- on paper. yes no
- on paper accompanied by reproductions on an electronic support. yes no
- by electronic means of transmittal. yes no
- in electronic form (e-filing). yes no

(b) Signature and Authentication

(i) *Communications on paper*

Q64: A communication on paper must

- be signed by the applicant, holder or other interested person. yes no
- be supplemented with evidence where the Office doubts the authenticity of the signature. yes no
- generally be certified. yes no
- only be certified in special cases, such as the surrender of a registration. yes no

(c) Coexisting Protection in Practice

Q74: In case of subject matter enjoying coexisting protection, trademark and industrial design protection can be invoked in parallel before the courts

- without having to satisfy any specific requirements. yes no
- only if the interested party shows a distinct legitimate interest
with regard to each of the two protection regimes. yes no

Q75: The assertion of trademark protection may be deemed legitimate if the distinctiveness of subject matter enjoying coexisting protection, i.e. its use to indicate commercial origin or to distinguish goods or services, is affected. yes no

Q76: The assertion of industrial design protection may be deemed legitimate if the esthetic aspect of subject matter enjoying coexisting protection, i.e. its esthetic value, substance or contents, is affected. yes no

[End of Annex and of document]