



## **SUBMISSION TO THE STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS ON POSSIBLE AREAS OF CONVERGENCE IN INDUSTRIAL DESIGN LAW AND PRACTICE**

### **I. Introduction**

**MARQUES** was founded in 1987 and is incorporated in the United Kingdom as a not for profit company limited by guarantee. It has no shareholders, issues no dividends and its directors are expressly prohibited from being paid for their services. **MARQUES** represents the interests of European intellectual property rights (“IPR”) owners worldwide in the protection and utilization of IPRs as essential elements of commerce. Its current membership of IPR owners and legal practitioners representing IPR owners is in excess of 600 members in 84 countries. Membership crosses all industry lines.

An important objective of **MARQUES** is to safeguard the interests of the public by ensuring the proper protection of IPRs and to safeguard the interests of IPR proprietors with regard to the regime of IPR protection. **MARQUES** attempts to achieve this objective by advancing the cause of intellectual property laws which protect the public from deception and confusion. **MARQUES** is an official non-governmental observer to the World Intellectual Property Organization (“WIPO”).

Since 2005 there have been discussions within WIPO and the wider intellectual property community regarding the desirability of international harmonisation of industrial design law and practice. This can be seen in the context of:

- i. existing international co-operation in the area of industrial designs, exemplified by the Hague System for the International Registration of Industrial Designs; and
- ii. wider trends towards the international harmonisation of intellectual property law and practice, exemplified in the Patent Law Treaty (2000) and the Singapore Treaty on the Law of Trademarks (2006).

In February 2010 the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (“SCT”) published a paper (SCT/23/5) that sets out clearly the potential benefits of harmonisation and simplification of design registration procedures. The paper notes that such benefits would accrue to both design owners and users of the various national and supranational systems, and to the authorities who administer those systems.

Paper SCT/23/5 builds on previous comparative studies of international industrial design law and practice. It categorises the various areas of law and practice into three groups: (i) areas of possible convergence, where there appears to be a developing consensus; (ii) areas exhibiting common trends, where there is no single consensus but where patterns can be identified and (iii) areas where there is divergence between national legislations. This work is helpful in identifying those areas of law and practice which might be most easily harmonised.

**MARQUES** supports the significant efforts made by member states to date to assist in discussions leading towards harmonisation of industrial design law and practice, and urges member states, in the interests of both users and industrial property offices, to progress towards enacting those areas of harmonisation where there already appears to be a large level of agreement, whilst continuing to discuss and, if possible, agree additional areas of harmonisation.

## II. Potential Benefits of Harmonisation

The world has changed significantly in the past 50 years, and in ways that the early developers of the world's IPR protection systems could not have envisaged. The advent and development of accurate copying machines (including in colour), instant communication and the ability to transmit images electronically without loss of clarity are all aspects of modern life that can now be taken for granted.

At the same time as technology has developed, markets too have changed. Many enterprises now operate across national boundaries, and wish to sell and protect their innovations in several or many jurisdictions. Many businesses now operate truly internationally and hence seek protection of their IPRs in over 160 countries. At the same time, the Internet now means that innovations rarely stay local for long, with communication tools such as Twitter and email meaning product launches are instantly communicated worldwide. The confluence of developed international markets and instant communication mean that, if ever there was a time for harmonised international protection of industrial and ornamental designs, it is now.

Users of the design protection system, whether individual designers, SMEs or multinational enterprises, all require a system that is efficient, rapid and cost-effective, to match the marketplaces in which they offer their goods and services. However, as SCT/23/5 points out, the current formalities and procedures relating to the protection of industrial and ornamental designs are often complex and frequently differ from jurisdiction to jurisdiction. **MARQUES** specifically supports paragraphs 8-14 of SCT/23/5 as reflecting the experience of **MARQUES** members.

An internationally harmonised and more efficient system for protecting industrial designs would increase interest amongst users, facilitate a greater number of multi-jurisdictional filings and raise the profile of industrial design law relative to more established areas of intellectual property law. **MARQUES** submits that harmonisation would increase the effectiveness of industrial design law to the mutual benefit of users and administrators.

One additional issue arises with respect to design law: harmonisation is required to aid efficiency, but also to prevent loss of rights. In some cases divergent legislation may prevent design owners from obtaining protection abroad, for instance where the owner

has disclosed the design in his/her own territory, relying on the availability of a grace period for filing the application after the disclosure of the design. More generally, unintentional loss of substantive rights may result from failure to comply with divergent formal requirements. **MARQUES** believes that harmonisation should generally be progressed in such a manner as to minimise the situations where design owners would be unable to obtain protection for their designs.

### III. Possible Areas of Convergence

**MARQUES** supports harmonisation of the areas identified in SCT/23/5 as possible areas of convergence.

#### (a) **Form of Reproduction**

Due to differing requirements concerning the form (e.g. graphic/photographic, colour/greyscale) of reproductions of the design, design owners currently seeking protection in multiple jurisdictions must prepare multiple sets of reproductions. Divergent requirements increase time and financial costs on both design owners, by necessitating the preparation of multiple applications tailored to individual jurisdictions, and administrators, by increasing the chances that applications will be non-compliant and contain irregularities.

**MARQUES** submits that greater consistency in application requirements would lead to enhanced legal certainty and security. This would lead to increased filings, and hence ultimately generate greater revenue for authorities. Standardised applications would rationalise the work required on the part of both design owners and authorities, saving time and money for each. These arguments were successfully made in the case for trade mark law reform: indeed, recent international experience in relation to trade mark law reform could serve as a model for industrial design law reform.

**MARQUES** supports the proposed text at paragraph 19(a) of SCT/23/5. As noted above, advances in reproduction technology mean that what is proposed is an achievable minimum standard. Specifically, **MARQUES** supports designers being able to use:

- i. line drawings and/or photographs;
- ii. colour or black and white reproductions;
- iii. dotted or stippled lines to indicate matter for which protection is not sought;  
and
- iv. shading to show contours/volume of three dimensional designs.

**MARQUES** further supports the suggestion that applicants should be afforded considerable freedom to decide on the form of reproductions used. In order to harmonise practice, authorities' ability to make subsequent requests should be restricted. The aim should be that the same set of reproductions can be used in each and every member state.

(b) **Number of Copies of Reproductions**

**MARQUES** supports all national offices in their endeavours to move towards electronic filing of design applications. Given recent, rapid progress in this regard, **MARQUES** expects that the next few years will see most national offices taking significant steps in this direction.

**MARQUES** therefore sees a requirement for three copies of reproductions to reflect the past and not the future, but supports SCT/23/5 paragraph 22(b) as an interim measure until electronic filing is universal.

(c) **Views**

**MARQUES** supports harmonisation of the number of views required for an industrial design application. **MARQUES** members report that differing requirements for maximum and minimum numbers of views constitutes one of the aspects of international design filing programmes that adds significantly to costs and timing delays.

**MARQUES** would like to see no minimum number of views and any maximum number set by the SCT at seven (7). As between 1 and 7 views (inclusive), users of the system should be able to choose for themselves how many views are required to demonstrate the design.

**MARQUES** does not object to the proposed ability of national offices, suggested in paragraph 25(c) of SCT/23/5, to require further views, on the basis that such requests will only be made in exceptional circumstances.

Again, the aim of harmonisation should be to enable an applicant to file the same set of reproductions in each member state, without the need to remove or add views for different jurisdictions.

(d) **Other Contents of the Application**

**MARQUES** supports the wording of the first sentence of paragraph 30(d) of SCT/23/5, but would like to see harmonisation of as many aspects as possible of design applications. Hence, **MARQUES** would prefer to see harmonisation of the requirements listed in the second sentence, namely: a claim or a statement of novelty; a description and/or the indication of the identity of the creator of the design.

In **MARQUES'** view, harmonisation should provide that the following shall not be required:

- i. a claim;
- ii. a statement of novelty;
- iii. a description; or
- iv. an indication of the identity of the creator.

Harmonisation should provide for these indications to be optional, at the decision of the applicant, but not mandatorily required by any member state.

(e) **Formalities etc**

**MARQUES** members report that different national requirements relating to the designer can add considerably to the costs of international filing programmes. **MARQUES** therefore supports the proposed language in paragraph 32(e) of SCT/23/5, with the addition that the signature of the applicant's representative should be sufficient to conclude the pre-printed statement of assignment on behalf of the applicant.

(f) **Division of Applications**

**MARQUES** supports the wording of paragraph 35(f) of SCT/23/5.

**MARQUES** also supports harmonisation of the ability to have multiple designs in a single application. Currently allowed in some jurisdictions, these save significant administrative costs and resources. Again, the aim should be to enable the same application to be used in multiple jurisdictions.

(g) **Communications**

**MARQUES** members report that current requirements for attestation, notarisation, authentication and legalisation add significantly to the cost of international filing programmes. These should all be abolished as serving no legitimate purpose in an electronic age.

**MARQUES** sees no need for maintaining the additional wording in paragraph 38(g) of SCT/23/5 "except in individual specified cases". This leaves open to member states to specify various circumstances, undermining the purpose of harmonisation. Even in cases of surrender of a registration, **MARQUES** sees no reason for requiring attestation, notarisation, authentication or legalisation. A signed (or electronically signed) request from the owner or his/her representative ought to suffice.

#### IV. **Common Trends**

As a general comment, **MARQUES** would like to see as many as possible of the common trends identified in SCT/23/5 developed further with the aim of including them in SCT's harmonisation efforts. Whilst some divergence remains, harmonisation in these areas would be of significant value to users of the system.

In **MARQUES'** view, the SCT has a role in promoting harmonisation. **MARQUES** therefore sees the following areas as appropriate for further harmonisation efforts.

(a) **Filing-Date Requirements**

**MARQUES** supports the wording of paragraph 44(a) of SCT/23/5 which reflects an appropriate maximum list of requirements to assign a filing date. Unlike trade marks, a failure to file by a certain date may lead to the loss, forever, of the right to file (or invalidate any registration granted). Any list of requirements to obtain a filing date should therefore be as short as possible.

**MARQUES** does not support the inclusion in any list of requirements to obtain a filing date of:

- i. a description of the design;
- ii. a claim;
- iii. payment of a fee; or
- iv. attestation, notarisation, authentication and/or legalisation requirements.

(b) **Deferment of Publication and Secret Design**

**MARQUES** supports harmonisation of deferment regimes. **MARQUES** therefore supports the SCT's efforts to harmonise a minimum deferral period across member states. **MARQUES** supports a 6 month minimum period, but would like to see this extended over time.

(c) **Grace Period**

**MARQUES** supports efforts to harmonise a grace period, at least for disclosures by or on behalf of the creator or his/her successor in title, and supports the wording of paragraph 54(c) of SCT/23/5.

**MARQUES** would like to see further discussions towards harmonisation of the period of the grace period, preferably at 12 months. **MARQUES** recognises that this may not presently be achievable.

Further, **MARQUES** would like to see harmonisation efforts include an express statement that a disclosure in circumstances of confidence should not constitute a disqualifying disclosure.

(d) **Structure of Period of Protection**

**MARQUES** supports harmonisation of the structure of protection periods, and would like to see the maximum period of protection harmonised at 25 years, subject to renewal every 5 years. Renewal decisions are most cost-effectively made if made together. If renewals arise at the same time, it saves designers/IPR owners having to revisit the same issue more frequently than every 5 years.

(e) **Relief Measures**

**MARQUES** supports the harmonisation of relief measures, and believes that such measures should be available to users (in line with the approach in the Patent Law Treaty).

V. **No Common Trend at Present**

**MARQUES** recognises that harmonisation in the additional area identified may be more difficult, and urges member states not to delay harmonisation efforts in other, achievable areas.

(a) **Specimens**

**MARQUES** members report that specimens are now used in a tiny fraction of the design applications they file. Given excellent reproduction technology, there appears to be no ongoing need to include the ability to file specimens.

Respectfully submitted

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