



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

TWENTY-FOURTH SESSION
GENEVA, 1st to 4th November 2010

INDUSTRIAL DESIGN LAW AND PRACTICE

COMMENTS ON BEHALF OF FICPI

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the profession in private practice, is pleased to submit these comments in preparation for the Twenty-Fourth Session of the SCT from November 1 to 4, 2010. FICPI's Design Working Group has studied the Draft Provisions in SCT/24/3. We hope that these comments will be helpful to the SCT.

INTRODUCTION

We are grateful for the work of the International Bureau in assembling the Draft Provisions. These appear to be reflective of the discussions of the SCT to date on the convergence of Design Law and Practice. However, we believe that if Design Law is to be improved globally, for both users and the Offices, the Provisions should be aspirational by setting out desired Law and Practice. The following comments are based on this view, and are intended to adjust the provisions to attain this aim.

PROVISION 1 – CONTENTS OF APPLICATION; FEE

Whilst we generally agree with the list of possible contents in this provision, we believe items (iv), (vi), (vii) and (viii) should be listed together as the single item 'a representation of the industrial design, as prescribed' (see discussion of Provision 2 below).

PROVISION 2 – REPRESENTATION OF THE INDUSTRIAL DESIGN

We believe this section should address all items which relate to the definition of the industrial design by the applicant. Therefore, in addition to the mandatory requirement for graphic or photographic representations of the design, the applicant should be allowed to file a description, which can include limiting and/or explanatory statements. As such, this description can take the place of a claim, statement of novelty and/or disclaimer that are currently used in various jurisdictions. In addition, the provision of a description can explain the meaning of dotted and stippled lines in the graphic or photographic representations. Thus the combination of the graphic or photographic representations with the optional description provides the definition of the monopoly right sought by the applicant.

Regarding subprovision (4) on Views, we do not believe the Office should have the right to request additional, specific views. Although this provision mentions avoiding the disclosure of new matter, in practice, any additional views are highly likely to add new matter. Furthermore, we believe it should be the choice of the applicant as to how the industrial design is defined.

PROVISION 3 – REQUIREMENT TO FILE THE APPLICATION IN THE NAME OF THE CREATOR

We have no comments on this section.

PROVISION 4 – DIVISION OF APPLICATION

In subprovision (3) on Fees, we believe it should be stated that the total of the original and additional fees should not exceed the fees that would have been charged if the applications were filed separately in the first instance. This addition is intended to prevent excessive divisional fees being used as a deterrent to the filing of multiple applications.

PROVISION 5 – FILING DATE

In subprovision (3) relating to correction of applications, we believe a single time limit should apply for all applicants, being either one or two months from invitation. Given the rise in electronic communication, the need to split the time limits is not seen.

PROVISION 6 – GRACE PERIODS

We strongly believe that the Grace Period should be calculated from the Priority Date as proposed. This provides greater certainty for applicants who make use of the Grace Period in a first country then wish to file in further countries. As to the length of such a Grace Period, we believe that this should be long enough to be of practical use, and that it should preserve the balance between right owners' and third parties' interests.

PROVISION 7 – DEFERMENT OF PUBLICATION OF THE INDUSTRIAL DESIGN

In order to provide a simple and uniform system, we believe a period of deferment should be available under all systems. Only in this way can the applicant guarantee for deferment to take place, which may have critical importance. We agree with providing a minimum deferment period of six months. However, in the interest of third parties, we also believe a maximum deferment period should be set.

PROVISION 8 – COMMUNICATIONS

We have no comments on this provision.

PROVISION 9 – INITIAL TERM OF PROTECTION AND RENEWAL

Given the requirement in TRIPS for a minimum term of protection of 10 years, we believe this provision should also clearly include this requirement.

PROVISIONS 10 & 11 – RELIEF IN RESPECT OF TIME LIMITS & REINSTATEMENT OF RIGHTS

We support these provisions and their basing on the PLT.

PROVISIONS 13 & 14 – REQUEST FOR RECORDING OF A LICENCE, SECURITY INTEREST OR CHANGE IN OWNERSHIP

We have no comments on these provisions.

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