



Common Practices on design examination

Sophio MUJIRI | Gros Islet, SAINT LUCIA | 25-28 October 2022



CARIFORUM

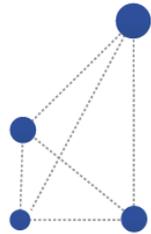


EU-CARIFORUM Regional project, funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

www.caripi-hub.com

CONVERGENCE OF PRACTICES IN DESIGNS

- **Common Practice on Graphic Representation of Designs**
- **Common Practice on Criteria for Assessing Disclosure of Designs on the Internet**



EUIPN

EUROPEAN UNION

INTELLECTUAL PROPERTY NETWORK

Colaborative Network

connecting

IP Offices, user associations and other IP
organisations

The Convergence Projects- Principles



- ❖ Focus on Practices → **No legislative amendments required**
- ❖ Commitment of implementation by the **Participating National IP Offices**

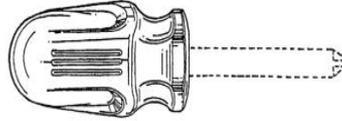
CP6: Graphic representation of designs

“Define a common practice for the graphic representation of a design which safeguards both the principle of legal certainty and the objective of having a flexible system of design registration available for users.”

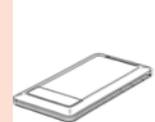
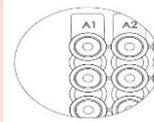
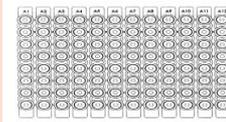


Objectives

Disclaimers



Types of Views



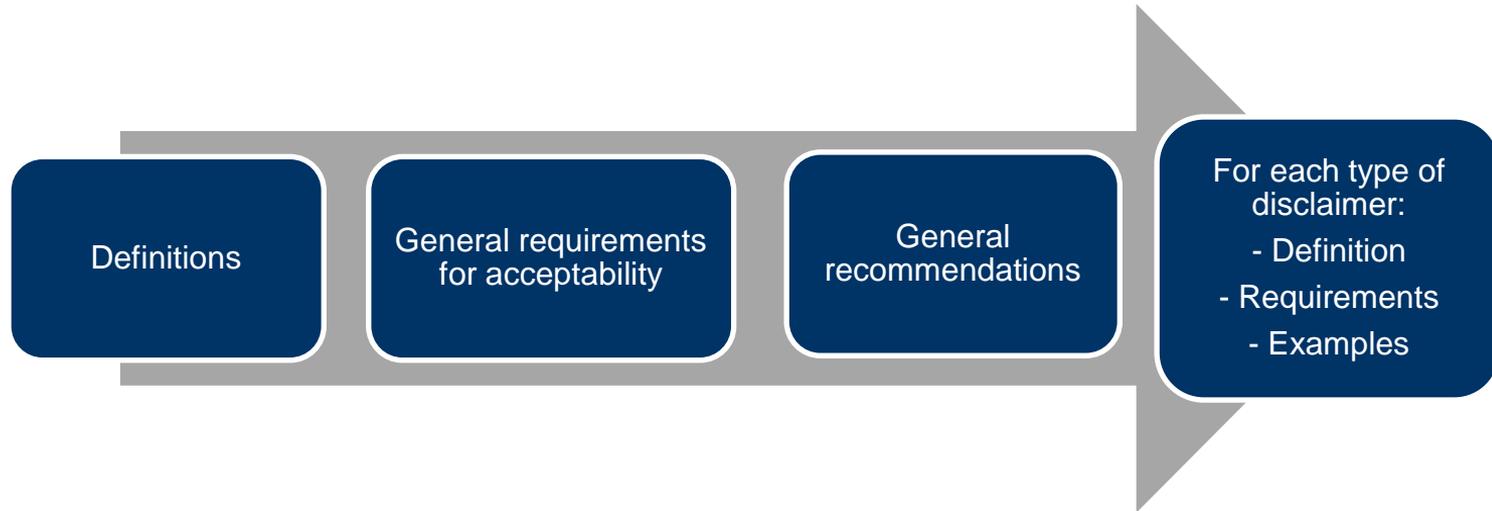
Neutral Background



Format of Views

- Limited to Benchmarking
- General recommendations

Objective 1: Use of visual disclaimers



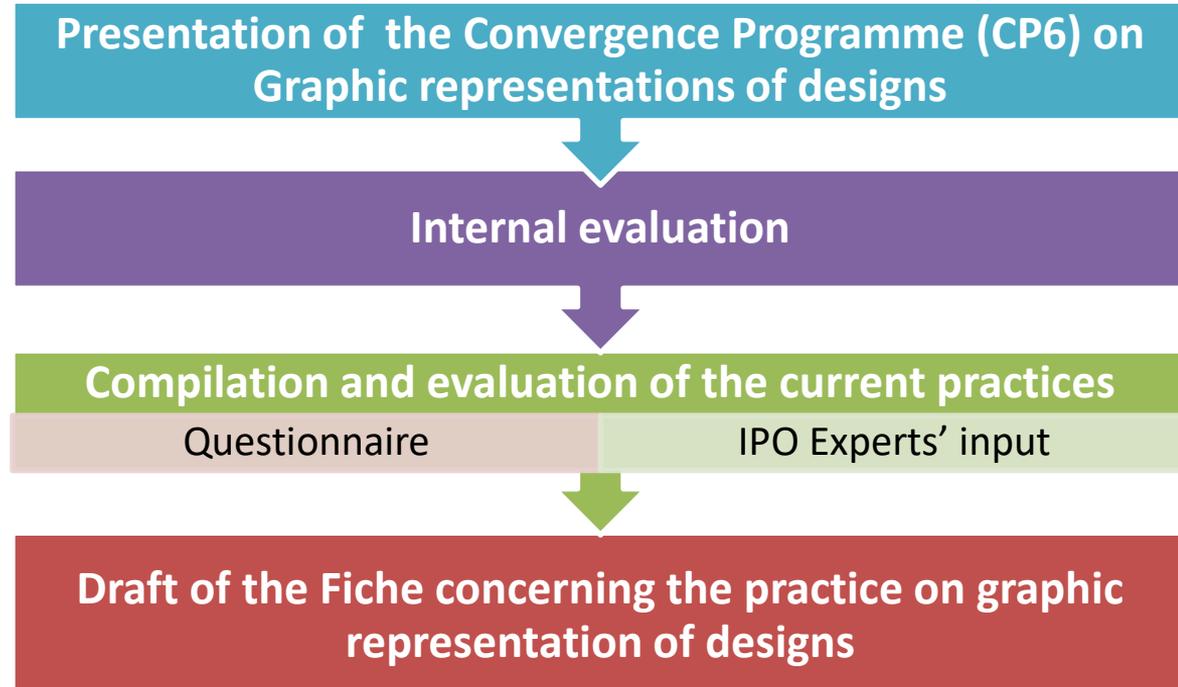
 **Disclaimer**

Background

Overall objective: to improve the overall quality and timeliness of the industrial design services in the region and facilitate stakeholders' access to information.

- **4-5 March 2021 - Specialised trainings for IPO examiners: designs**
Webinar - Design examination– practical aspects 2, 5th March, 2021
- **March 2021** - A questionnaire on Design practices was sent to IPOs
- **March - June 2021** - Submission of answers and inputs by 8 IPOs
- **June - September 2021** — Elaboration of the draft fiche (Vicos with IPOs when required)
- **10 June 2021** – Publication of the Fiche

- **Process**



The Practice Fiche

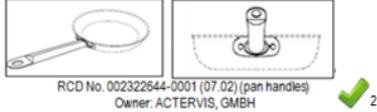


	Antigua and Barbuda Intellectual Property and Commerce Office
	Belize Intellectual Property Office
	Cuban Industrial Property Office (Oficina Cubana de la Propiedad Industrial)
	Dominica Companies and Intellectual Property Office (CIPO)
	Dominican Republic National Office of Industrial Property (Oficina Nacional de la Propiedad Industrial)
	Jamaica Intellectual Property Office
	Saint Lucia Registry of Companies and Intellectual Property
	Intellectual Property Office of Suriname (Bureau <u>Intellectuele Eigendom</u>)

Publication on 10 th November 2021

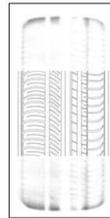
[Graphic-Representation of Designs Fiche CarIPI](#) [EN] [ES]

The Practice Fiche – Visual Disclaimers

Definition	Visual disclaimers indicate that protection is not being sought for, and registration has not been granted for, certain features of the design shown in the representation. Thus, they indicate what is not intended to be protected.
Requirements	<p>Visual disclaimers will only be accepted when:</p> <ul style="list-style-type: none">They clearly indicate that protection is not being sought for certain features of the design shown in the representation.They are shown consistently in all the views where the disclaimer appears. <div data-bbox="813 456 1190 568" data-label="Image"></div>
Recommendations/ Guidelines	<p>Graphic or photographic representations showing only the claimed design are preferred.</p> <p>However, disclaimers can be used when the graphic or photographic representation of the design contains parts of the product for which no protection is sought. In these cases, the disclaimer must be clear and obvious: the claimed and disclaimed features must be clearly differentiated.</p> <p>Where a disclaimer is used, broken lines are recommended. Only when broken lines cannot be used due to technical reasons (for example, when they are used to indicate stitching on clothing or patterns; or photographs are used), other disclaimers can be used: <u>colour shading</u>, <u>boundaries</u> and <u>blurring</u>.</p> <p>NOTE: This recommendation does not apply to Antigua and Barbuda and Saint Lucia</p>

The Practice Fiche – Visual Disclaimers - Blurring

Although broken lines are the preferred disclaimer, if they cannot be used, the use of blurring could be an option. This type of visual disclaimer consists of obscuring the features for which protection is not being sought and may only be accepted when the features for which protection is sought are clearly distinguishable from the disclaimed (blurred) features.



NOTE: This statement does not apply to Cuba, Antigua Barbuda and Saint Lucia

CP10: Scope of the Common Practice

Provide criteria and recommendations on:

1. Different sources of disclosure on the internet
2. Establishing the relevant date of disclosure
3. Means for presenting the evidence obtained from the internet
4. Exceptions to the availability of designs on the internet



OUT of scope

Assessment of 'circles specialised in the sector concerned'

CP10: Introduction – Key concepts

Two-step test: design made available to the public:

1 if ...

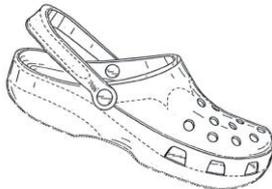
published following registration or otherwise, or exhibited, used in trade or otherwise disclosed,

2 except ...

where these events could not reasonably have become known

CP10: Introduction – Key concepts. Relevant case-law

Disclosure outside the EU



CP10

[T-651/16](#) of 14/03/2018 (**‘Footwear’**), § 48
General Court

*General presumption: design made available if event of disclosure is established, **unless established exceptions apply***

CP10: Introduction – Key concepts

Exceptions



Confidentiality

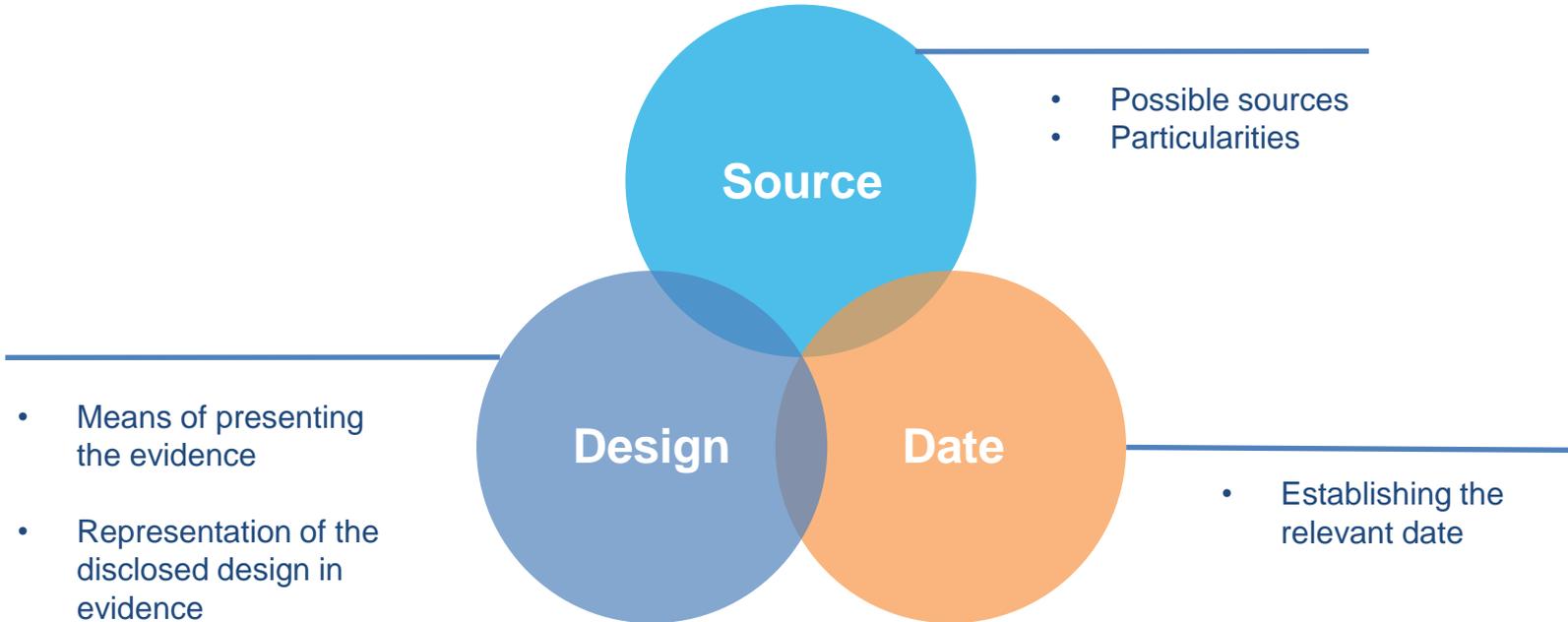


Designer/successor in title/third person during grace period



Abuse

CP10: Introduction – Key concepts



CP10: Introduction – Key concepts. Relevant case-law

Disclosure outside the EU

CP10

[C-479/12](#) of 13/02/2014
(‘**Gartenmöbel**’), § 33
Court of Justice of the European Union



A design can be disclosed anywhere in the world, including the internet.

CP10: Common Practice Principles

Sources of disclosure on the internet



CP10: Common Practice Principles

Sources of disclosure on the internet

Websites

Types:

- E-commerce platforms
- Online databases
- Social media

CP10: Common Practice Principles

Sources of disclosure on the internet. Relevant case-law

E-commerce platforms

CP10

Websites

ZR 187/16 of 11/01/2018 (**'Ballerina shoes'**) , § 26 - 27
Federal Supreme Court of Germany I

Offering a product for sale in an e-shop = disclosure



CP10: Common Practice Principles

Sources of disclosure on the internet. Relevant case-law

Online databases

Websites

CP10

[T-251/14](#) of 15/10/2015 ('Doors (part of)'),
§ 22
General Court



Publication of a design in an online database administered by public authorities constitutes disclosure

[T-513/09](#) of 16/12/2010 ('Ornamentación'), § 20
General Court



CP10: Common Practice Principles

Sources of disclosure on the internet. Relevant case-law

Social media

CP10

Websites

[ICD 10 141](#) of 17/01/2017 (**‘Christmas decorations’**),
pg. 3
EUIPO



[ICD 10 364](#) of 05/12/2016 (**‘Animal clothing’**),
pg. 3
EUIPO



[ICD 10 729](#) of 27/04/2018 (**‘Sofas’**), pg. 6



37 O 17964/17 of 31/01/2018 (**‘Mythos H.’**),
§ 27 - 28
Munich Regional Court I

- *Social media is widely used by designers to share their work and products*
- *When printout/screenshot does not include all relevant information - recommended to submit additional evidence*

- *Provide information regarding the purpose or the nature of the relevant social media services*

CP10: Common Practice Principles

Sources of disclosure on the internet

Websites

Recommendations

- 01** Present website evidence through a printout or a screenshot
- 02** Evidence should display clear image of the design, date of disclosure and URL address
- 03** Printouts: printing date assumed the date of disclosure, unless earlier relevant date established
- 04** Submit information regarding the purpose and the main characteristics of the website in question

CP10: Common Practice Principles

Sources of disclosure on the internet

E-mails

Traditionally, e-mails considered private correspondence. However, if aimed to **promote products**, it cannot be considered private correspondence

What should be taken into consideration is the **content** of the e-mail, and **not its form**

CP10: Common Practice Principles

Sources of disclosure on the internet

Recommendations

E-mails

- 01** E-mail evidence should include:
 - representation of design
 - clear indication of relevant date
- 02** Indicators of circle specialised in the sector concerned: recipients of the e-mail and its purpose
- 03** Veracity of the confidentiality claim: keep in mind the contents, recipients and purpose of an e-mail

CP10: Common Practice Principles

Sources of disclosure on the internet

File Sharing

File incorporating design uploaded to a file sharing system = **disclosure (in principle)**

2 key aspects:

- link between the contents of the file containing a design and the file's reference in the file sharing system
- relevant date

CP10: Common Practice Principles

Establishing relevant date of disclosure

Necessary
criterion for
assessing
disclosure

Establishment of the date of disclosure:

i.e. the date when the design was made available to the public

This section
provides

Non-exhaustive list of tools to help determine relevant date
when design made available on the internet

Establishing the relevant date of disclosure

Establishing relevant date of disclosure

Tools:

- 1 Search engines and web archiving services
- 2 Computer-generated timestamps
- 3 Software forensic tools

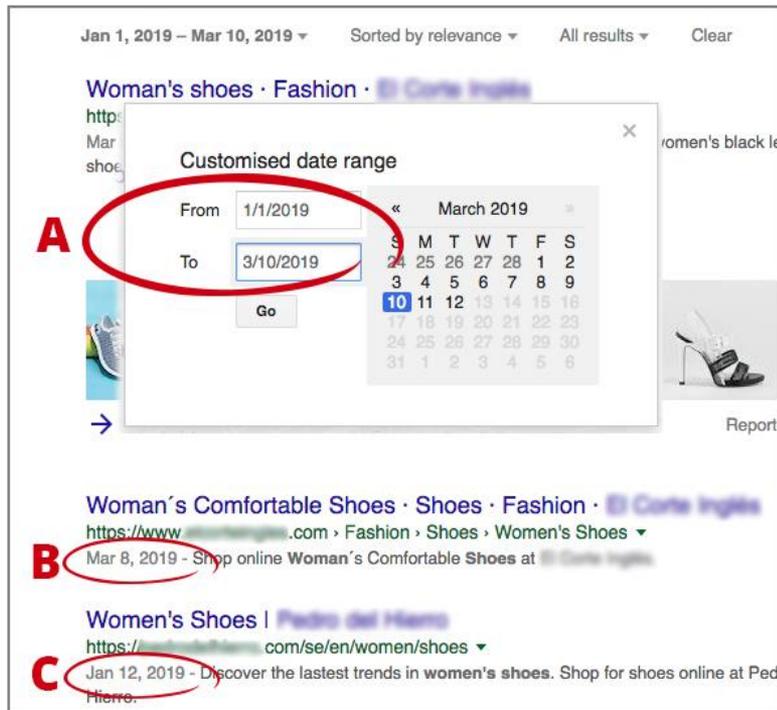


CP10: Common Practice Principles

Establishing relevant date of disclosure

Search engines and website archiving services

Search engines allow users to search for the information within a specific time frame



The screenshot shows a search engine interface with a search query "Woman's shoes" and a date range filter overlay. The filter is set to "From 1/1/2019" and "To 3/10/2019". A calendar for March 2019 is visible, with the 10th of March highlighted. The search results are sorted by relevance and show several entries related to women's shoes.

A Customised date range

From 1/1/2019 To 3/10/2019

Go

March 2019

S	M	T	W	T	F	S
24	25	26	27	28	1	2
3	4	5	6	7	8	9
10	11	12	13	14	15	16
17	18	19	20	21	22	23
24	25	26	27	28	29	30
31	1	2	3	4	5	6

B Woman's Comfortable Shoes · Shoes · Fashion · El Corte Inglés
<https://www.elpartidoparis.com> > Fashion > Shoes > Women's Shoes
Mar 8, 2019 - Shop online Woman's Comfortable Shoes at El Corte Inglés

C Women's Shoes | Pedro del Hierro
<https://www.pedrodelhierro.com/se/en/women/shoes>
Jan 12, 2019 - Discover the latest trends in women's shoes. Shop for shoes online at Pedro del Hierro.

CP10: Common Practice Principles

Establishing relevant date of disclosure

Search engines and website archiving services

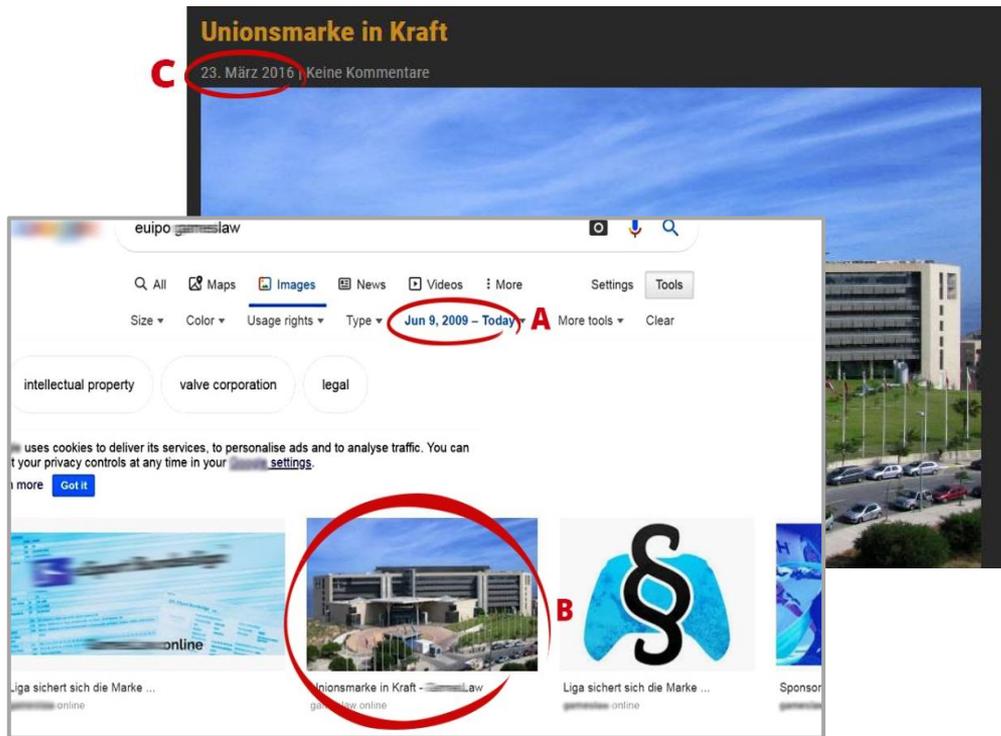


Setbacks

Established time frame search ('A') might give a result of when the site was cached ('B') and not the date when the content was published ('C')



Use with caution!



The screenshot shows a search engine interface with the following elements:

- Search Bar:** Contains the text "euipto" and "law".
- Filters:** Includes "All", "Maps", "Images", "News", "Videos", "More", "Settings", and "Tools".
- Advanced Search:** Includes "Size", "Color", "Usage rights", "Type", "Jun 9, 2009 - Today" (circled in red and labeled 'A'), "More tools", and "Clear".
- Results:** Shows a result for "Unionsmarke in Kraft" with a date of "23. März 2016" (circled in red and labeled 'C') and "Keine Kommentare".
- Image Results:** Below the main result, there are several image thumbnails. One thumbnail shows a building (circled in red and labeled 'B').
- Footer:** Includes a cookie notice and a "Got it" button.

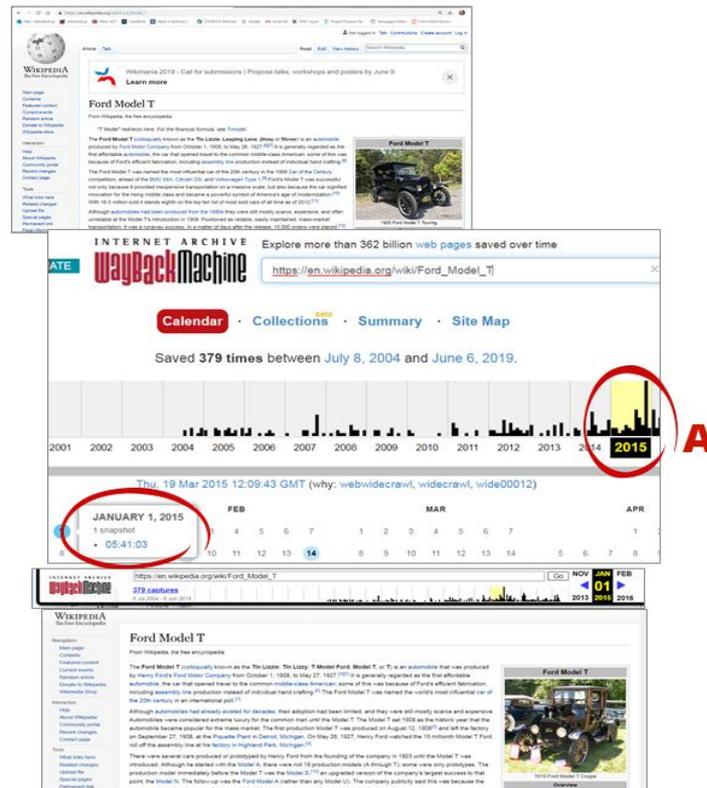
CP10: Common Practice Principles

Establishing relevant date of disclosure

Search engines and website archiving services

Website archiving services (e.g. “WayBack Machine”) can help prove date of disclosure.

- Access to archived websites or parts thereof as they appeared at a certain point in time (‘captures’) (‘A’)
- Possibility to view and navigate them



The screenshot shows a Wikipedia page for "Ford Model T" with a Wayback Machine overlay. The Wayback Machine interface includes a search bar with the URL "https://en.wikipedia.org/wiki/Ford_Model_T", a "Calendar" button, and a bar chart showing the number of captures over time. A red circle highlights the date "JANUARY 1, 2015" with a time of "05:41:03". Another red circle highlights the date "Thu, 19 Mar 2015 12:09:43 GMT". A red letter "A" is placed next to the 2015 bar on the calendar. Below the calendar, there is a "379 captures" section with a small bar chart and a "Wikipedia" logo.

CP10: Common Practice Principles

Establishing relevant date of disclosure



Setbacks

- limited access to website content
- content removal
- sporadic updates

Recommendations

- 01** Use website archiving services instead of search engine services
- 02** Separate parts of the archived website might relate to different dates

CP10: Common Practice Principles

Establishing relevant date of disclosure. Relevant case-law

CP10

- [No. O-544-17](#) of 27/10/2017 (**‘plastic bottle, aluminum bottle, chemical bottle, general use bottle, fuel tank applications bottle’**), § 38
UKIPO
- [R 25/2014-3](#) of 02/07/2015 (**‘Soft drink bottle’**), § 29
- [R 1537/2016-3](#) of 28/09/2017 (**‘Wheel rims’**), § 22
- [R 2112/2015-3](#) of 08/03/2017 (**‘Flushing systems for water closets’**), § 42
- [R 1849/2015-3](#) of 20/12/2016 (**‘Doors’**), § 24
- [R 1341/2013-3](#) of 05/03/2015 (**‘Packaging’**), § 18
EUIPO

Web archiving services is a valuable tool for proving the date of disclosure.

However, in order to prove disclosure using this tool, the relevant date should be corroborated by further information.

CP10: Common Practice Principles

Means for establishing the date of disclosure

- Any means able to prove disclosure (or rebut the availability) of a design can be submitted
- Disclosure can be established by submitting various types of evidence
- Evidence proving disclosure extracted from the internet can be submitted with other pieces of evidence
- Integrity of the documents submitted is assumed

CP10: Common Practice Principles

Means for establishing the date of disclosure

Recommendations

- 01** Clearly indicate the source of disclosure
- 02** If necessary, provide additional information (on the source)
- 03** Ensure the quality of the evidence is sufficient to define the features of the design and identify the relevant date

CP10: Common Practice Principles

Means for establishing the date of disclosure

Printouts and Screenshots

Printouts and screenshots should



contain:

- a) the source (e.g. URL address)
- b) the relevant date
- c) the disclosed design



not be manually modified

CP10: Common Practice Principles

Means for establishing the date of disclosure

Printouts and Screenshots

Recommendations

- When a printout or screenshot does not include all of the relevant information, submit additional evidence providing the missing elements
- When a printout or a screenshot is inserted in the text of the submissions and contains additions for illustrative purposes, such as highlighting or indicating the relevant elements, submit an unaltered version of the printout or screenshot as a separate document

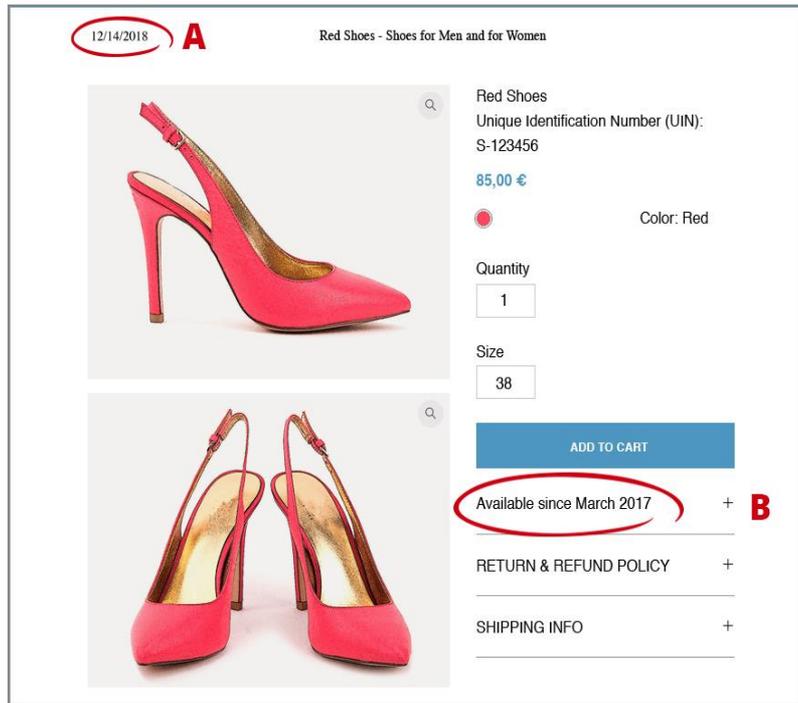
CP10: Common Practice Principles

Means for establishing the date of disclosure

Printouts and Screenshots

B) Relevant date

- Distinguish between printing date (printout) and date of disclosure
- Printing date ('A') assumed date of disclosure, unless an earlier relevant date can be established from:
 - URL address
 - contents of the document itself or
 - any other evidence ('B')



12/14/2018 **A** Red Shoes - Shoes for Men and for Women

Red Shoes
Unique Identification Number (UIN):
S-123456
85,00 €
Color: Red

Quantity
1

Size
38

ADD TO CART

Available since March 2017 + **B**

RETURN & REFUND POLICY +

SHIPPING INFO +

CP10: Common Practice Principles

Means for establishing the date of disclosure

Printouts and Screenshots

B) Relevant date

Recommendations

When several dates are indicated in a printout/screenshot, clearly indicate which is the relevant date

CP10: Common Practice Principles

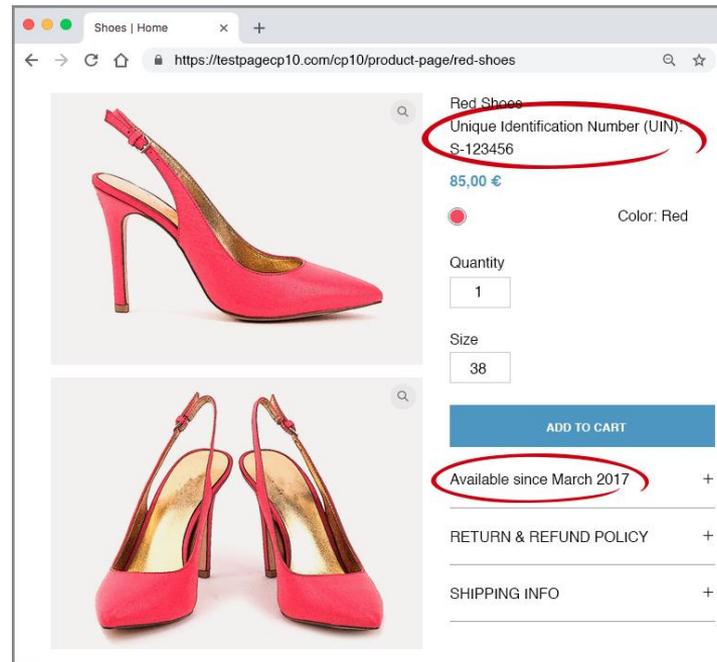
Means for establishing the date of disclosure

Printouts and Screenshots

Printouts and screenshots from e-commerce platforms

E-commerce platforms can indicate the date when the product was first available for sale ('A')

The specific product reference (e.g. name or a code) can link information on the product contained in other evidence ('B')



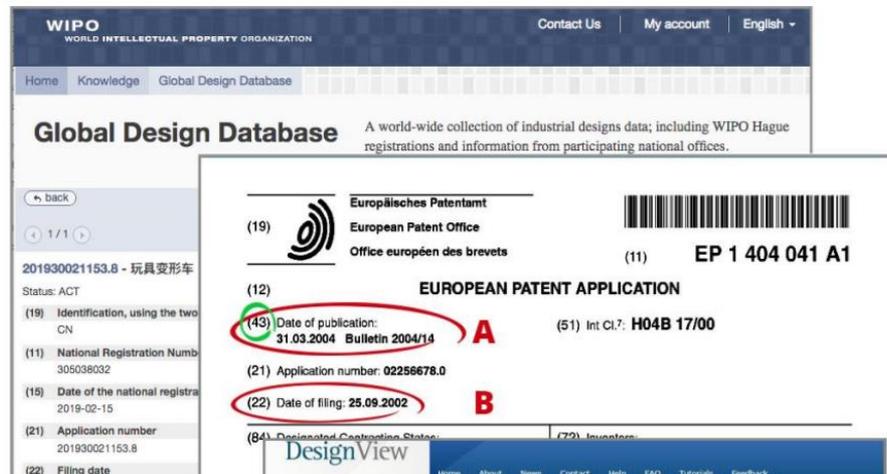
CP10: Common Practice Principles

Means for establishing the date of disclosure

Printouts and Screenshots

Printouts and screenshots from online databases

- Publication date from online databases = relevant date ('A')
- Designs published in online databases administered by public authorities = disclosed as from the indicated publication date



The screenshot displays the WIPO Global Design Database interface. The main record shown is for a European Patent Application (EP 1 404 041 A1) filed on 25.09.2002 and published on 31.03.2004. The publication date is circled in red and labeled (43), and the filing date is also circled in red and labeled (22). The application number is 02256678.0. The record is titled 'EUROPEAN PATENT APPLICATION' and includes the designation 'H04B 17/00'. The interface also shows the WIPO logo, navigation links, and a 'DesignView' watermark.

(19) Identification, using the two CN	(11) National Registration Number: 305038032	(15) Date of the national registration: 2019-02-15	(21) Application number: 201930021153.8	(22) Filing date
(12) EUROPEAN PATENT APPLICATION	(13) Date of publication: 31.03.2004 Bulletin 2004/14	(21) Application number: 02256678.0	(22) Date of filing: 25.09.2002	(51) Int. Cl.: H04B 17/00

CP10: Common Practice Principles

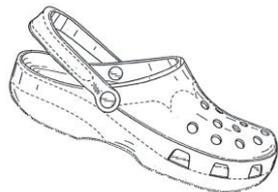
Exceptions to the availability of designs on the internet

Exceptions

- Not reasonably known in the normal course of business
- Under explicit/implicit confidentiality conditions
- Made available by designer/successor in title/third person during 12-month grace period
- Consequence of an abuse in relation

CP10: Common Practice Principles

Exceptions to the availability of designs on the internet



CP10

Searchability

[R 853/2014-3](#) of 06/06/2016 (**'Footwear'**), § 83 – 84
EUIPO

[T-651/16](#) of 14/03/2018 (**'Footwear'**), § 54, 56, 61
General Court

- *Taking into account the global nature of the internet, in general, online content is available worldwide.*
- *To refute the presumption of disclosure, the exception has to be proven by submitting respective evidence.*
- *“When analysing whether events of disclosure of a design could not have reasonably become known to the circles specialised in the sector concerned, examine whether it was not actually possible for those circles to be aware of the events constituting disclosure of a design.”*

Exceptions to the availability of the design

Exceptions to the availability of designs on the internet



**Passwords
&
payments**



**Languages
&
top-level
domain names**



Searchability



Geo-blocking



Confidentiality

CP10: Common Practice Principles

Exceptions to the availability of designs on the internet

Passwords and Payments

In general, neither restricting access to a limited circle of people by password protection, nor requiring payment for access would prevent a design that has been made available on a webpage, app or file sharing platform from forming the prior art.

- Exception: internal databases used by employees of a company



CP10: Common Practice Principles

Exceptions to the availability of designs on the internet. Relevant case-law

CP10

[ICD No 9862](#) of 03/03/2016 ('Fireplaces (indoor -)'), pg. 4
EUIPO



[ICD 10 388](#) of 23/11/2017 ('Jars'), pg. 7
EUIPO



Password protection/payment for access does not prevent a design from forming part of the prior art

CP10: Common Practice Principles

Exceptions to the availability of designs on the internet

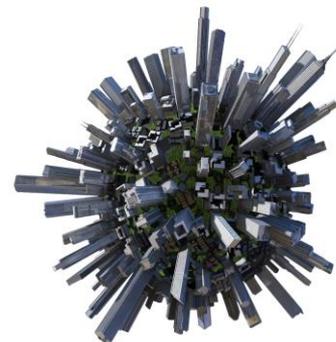
Language and Top-level Domains

Languages:

- Do not (in principle) affect perception of a design – but can impair the possibility to find them on the internet
- Image search technology allows designs published in different languages to be found

Top-level domain:

- In principle, not an obstacle to find designs on the Internet
- But can serve as an indicator of the likelihood of the specialized circle accessing the site

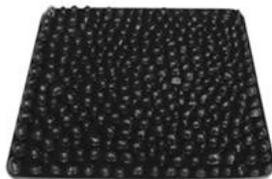


CP10: Common Practice Principles

Exceptions to the availability of designs on the internet. Relevant case-law

CP10

[T-227/16](#) of 21/06/2018 ('**Floor covering**'), § 28
General Court



[R 1750/2016-3](#) of 04/01/2018 ('**Locks**'), § 13 - 15
EUIPO



- *Establish whether the specialized circle is expected to search for information in the respective language*
- *Depending on the sector concerned, it can be usual or not for the specialised circles to consult information in non-EU languages*

CP10: Common Practice Principles

Exceptions to the availability of designs on the internet

Searchability

Assess the possibility for the specialized circle to find the prior art on the internet

- Consider whether the site was technically accessible
- Customs/behaviours in the normal course of business



CP10: Common Practice Principles

Exceptions to the availability of designs on the internet

Confidentiality

Designs disclosed under explicit/implicit confidentiality conditions will not constitute disclosure

Circumstances that might affect the effectiveness of the confidentiality claim in an e-mail:

- contents
- purpose
- recipients





THANK YOU
GRACIAS
MERCÍ
BEDANKT



CARIFORUM



EU-CARIFORUM Regional project, funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

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