



INDUSTRIAL DESIGN LAW & PRACTICE IN CARIFORUM

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CARIFORUM



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A working document based on the analysis of the industrial design laws and regulations of 11 CARIFORUM States

- Antigua and Barbuda (AG), Bahamas (BS), Barbados (BB), Belize (BZ), Cuba (CU), Dominica (DM), Dominican Republic (DO), Jamaica (JM), Saint Lucia (LC), Saint Vincent and the Grenadines (VC), and Trinidad and Tobago (TT)
- ... does not cover the situation in States where no *sui generis* legislation on ID has been enacted or updated in the past 40 years
- ... focuses only on the registration and protection of ID, to the exclusion of matters related to the enforcement of ID rights

The study analyses and compares the ID provisions within CARIFORUM

- ... in the light of the main international legal instruments relevant to the region
 - Paris Convention for the Protection of Industrial Property - 1967
 - TRIPS Agreement - 1995
 - Economic Partnership Agreement with the EC and its Member States - 2008
 - 1999 Act of the Hague Agreement on the international registration of ID
- ... also takes into account the draft articles and draft regulations on ID law and practice, elaborated within the WIPO Standing Committee (SCT) in preparation of a possible Design Law Treaty

The study analyses, *inter alia* ...

- subject matter
- rights of the design creator and design owner & scope of protection
- protection of registered and unregistered designs
- requirements regarding the application
filing methods, language, content, representation of the design, classification, etc.
- legal representation of non residents
- right of priority – claim and priority documents
- filing date and examination practice

The study analyses, *inter alia* ...

- publication of the design – timing, deferment
- possible opposition to registration
- opportunity to be heard – review – appeals
- duration of protection – initial term, renewal, maximum duration
- entries in the designs register – ownership, names, address, licenses, limitations
- invalidation procedures
- application of international treaties

Laws and regulations – a variety of adoption dates and structure

- ID specific – AG, BB, BZ, DM, LC, VC , TT – similar structure & content
- Patents and ID – CU, JM
- Industrial Property – BS, DO
- Laws by date – JM 2020, CU 2011
LC 2015, VC 2005, AG 2003, BZ 2000, DM 1998, TT 1996
DO 2000
BB 1981 (rev. 1988)
BS 1965 (rev. 1994)
- Aligned with main international treaties – Paris Convention, TRIPS Agreement

Comparison of CS laws and regulations – Many similarities, *e.g.*...

- definitions – configuration, non-functional appearance, industrial applicability
- world-wide novelty (or originality) requirement
- exclusion of designs contrary to public order or morality
- rights of the creator
 - right to the design created independently
 - right to be named as such in the application/registration
- scope of exclusive rights of the design owner
 - make/sell/import/distribute for commercial purposes
- protection of unregistered designs – under copyright law

Comparison of CS laws and regulations – Many similarities, *e.g.*...

- means for the filing of applications – on paper, handed personally or by post
- recognition of the right of priority – Paris Convention, TRIPS
- multiple applications – largely accepted, subject to certain conditions
- classification – Locarno largely accepted, but not clear whether latest version
- requirement for non residents to be legally represented
- requirement for Offices to examine
 - compliance with definition
 - public order or morality
- provisions regarding opportunity to appeal against Office decisions
- provisions regarding annotation of entries in the designs register

Comparison of CS laws and regulations – Some differences ...

- “individual character” (overall impression on the informed user) as a protection requirement – only CU, JM (see EPA)
- novelty examination prior to registration – only BB, CU, DO, JM
- publication of the application – only CU, JM, for opposition purposes
- opposition procedures – only CU and JM
- exhaustion of design rights - national – AG, BB, BZ, DM, LC, VC, TT
- international – CU, DO, JM
- maximum duration of protection - 15 years – AG, BS, BB, BZ, DM, DO, JM, LC, TT
- 10 years – CU, VC

In the light of the findings of this study, your Offices may wish to consider working jointly on certain initiatives such as ...

- developing common forms and similar e-filing facilities for ID registration
- promoting common practices regarding ID representation and classification
- developing a common understanding of certain concepts (e.g. in a manual)
- disseminating information on ID registered and applied for in the region
- facilitating the recognition of ID priority documents
- exchanging experience regarding joining and using the Hague System
- elaborating a model law and model rules reflecting modern trends
- studying the feasibility of setting up a regional design system

Common forms for ID procedures

- common application form
 - allowing the indication of any of the 22 elements currently required by one or more Offices
 - containing notes explaining what is required by each Office
 - would give visibility to the CARIFORUM Offices as a group
 - would facilitate the filing of applications by nationals and foreigners
 - may help in harmonizing application requirements
- other common forms
 - e.g., for the recording of changes in ownership, licenses, changes of names and addresses, etc.

Similar platforms for the electronic filing of industrial designs

- based on the common forms initiative mentioned earlier
- possibly developed with the support of an experienced external partner
- would strengthen the visibility of the CARIFORUM Offices
- would be extremely attractive for creators and companies wishing to apply for protection of their designs in the region

Common practice regarding the graphic representation of designs

- Last year, the IP Offices of seven CS – AG, BZ, CU, DM, DO, JM, SR – agreed on a Practice Fiche on the Graphic Representation of Designs
- ... gives guidance on types of views required or accepted, how to use visual disclaimers, and how to represent designs on a neutral background
- ... helps applicants and examiners in ensuring the full disclosure of designs
- ... good example of convergence of practices which might be extended to other matters regarding design representation, and possibly shared by other Offices

Common practice regarding ID classification

- Locarno classification, largely accepted, but not clear whether the latest version is being applied by all CS Offices – this would be desirable
- 13th edition, in force since January 2021, contains 32 classes, 228 subclasses, and a non-exhaustive list of over 5,000 product indications
...of course, there is still a risk that product indications not contained in the Locarno list be classified differently by different examiners or Offices
- CS Offices could work on a larger list accepted by all – similar to the EU harmonized DB that contains 16,300 commonly accepted product indications
- ... may also consider participating in the **DesignClass** search tool (40 Offices), indicating the terms that they accept and thus gaining further visibility

Common manual on the substantive examination of designs

- harmonize the interpretation of certain concepts regarding registration requirements that are common to all your laws
 - industrial applicability
 - arbitrary appearance, to the exclusion of any technical or functional feature
 - public order or morality
 - worldwide novelty
- provide examples of acceptable and non-acceptable designs, preferably based on case law
- address some new concepts, such as, e.g. “individual character” = overall impression that the design produces on the informed user differs from the overall impression produced by any design previously made available to the public

Online platform on CARIFORUM designs

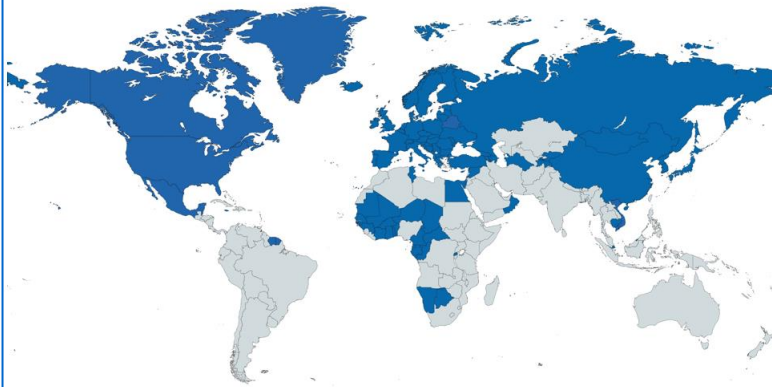
- would help disseminate free-of-charge information – regarding registered designs and design applications published in your countries
- would enhance the visibility of your Offices and offer a useful search tool for potential design applicants
- meanwhile, your Offices may consider already participating, individually, in the international databases DesignView and WIPO Global Design database
 - DesignView – 19 million designs, 70 Offices (116 countries) – including CU
 - WIPO Global Design – 14 million designs, 36 Offices (91 countries) – including CU

Participation in WIPO DAS for priority documents

- DAS = electronic system allowing priority documents to be securely exchanged between participating IP Offices
 - depositing offices (1st filing) 21 Offices
 - accessing offices (2nd filing) 17 Offices
- participation in DAS would
 - facilitate priority certification procedures for both applicants and offices
 - enhance the visibility of the participating offices

Participation in the Geneva Act (1999 Act) of the Hague Agreement

Members of the 1999 Act of the Hague Agreement
68 Contracting Parties (including European Union and OAPI)
covering 93 countries (on May 5, 2022)



- BZ, JM, SR are members
- all major trading partners of CS are also members of the Hague System
- significant benefits for Contracting Parties
 - nationals benefit from obtaining design protection with lesser formalities and costs
 - national economies benefit from increased dynamism and exports of their design sectors

Exchange experience on how to best prepare to join and use the Hague System

Design model law and model rules

- model provisions of interest for countries wishing to modernize their current legislation on industrial designs
 - taking into consideration relevant provisions of the TRIPS Agreement and the Economic Partnership Agreement with the EU (EPA)
 - incorporating provisions for the implementation of the Hague Agreement 1999 Act

Feasibility study on a possible regional design system

- different possible models
 - a single law, separate registration offices – e.g. Andean Community
 - a single law, a single registration office – Benelux, OAPI
 - a regional law & office (in parallel with national systems) – EU, ARIPO, EAPO
- study should analyse legal, organizational and financial implications and assess possible impact on design application flows
- regional system should be compatible with the international system (Hague)
- setting up such a system would require a high degree of political will



THANK YOU



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