



## QUESTIONS & ANSWERS

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### Specialised training for IPO staff: Exchange of good practices for design examiners

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Zoom



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## Exchange of Good Practices for Design Examiners Questions and Answers

1. Is Design Registration the same as Industrial Design Registration?

Yes. The term 'design' is usually used as a short way of saying Industrial Designs.

2. [To Participants] Does your Office undertake only formalities examination or does it also carry out a substantive examination of industrial designs? Can you indicate who examines only formalities, morality and that it is eligible for designs?

Participants' responses:

- Jamaica, Trinidad and Dominica examine for novelty.
- Substantive examination involves an administrative cost.
- The region should consider doing away with substantive examination if it works for the EU.

3. If you don't do substantive / absolute examination then do you have a registration system in the EU?

Indeed, we do. The Office carries out an examination of the substantive protection requirements, which is limited to two grounds for non-registrability. An application will be refused if the design does not correspond to the definition set out in Article 3(a) CDR or if it is contrary to public policy or to accepted principles of morality (Article 9 CDR).

Novelty examination is not checked at the EUIPO at the registration stage, this and other grounds will be checked upon an invalidity application.

4. With the use of State, County or National flag on your Design. Are you required to get permission from the relevant authority?

A Community design will be declared invalid if it constitutes an improper use of any of the items listed in Article 6ter of the Paris Convention, or of badges, emblems and escutcheons other than those covered by the said Article 6ter that are of particular public interest in a Member State (Article 25(1)(g) CDR).

5. Who determines if the use is proper? Maybe some countries require an authorization to be sent with it.

The object of the examination is to ascertain whether the applicant for a declaration of invalidity is the person or entity affected by the use and whether the Community design constitutes an improper use of one of the symbols covered by Article 25(1)(g) CDR as explained above. We check the 6ter database when there is a flag involved in the design.

6. For the use of a flag by an applicant unconnected to the country whose flag is the subject of an application, who can file an application for invalidity in this regard? Would it be the Government of the country for the flag being used?

Invalidity proceedings can be initiated depending on who has the right. In this case anyone can, as it can be considered an improper use. It does not have to be the country.

7. How does the EUIPO treat to employees at the EUIPO filing patents? Are such persons subject to restrictions?

We don't register patents. I understand that you refer to designs and if an examiner himself files a design.

Please note that when examining an application, the Office performs an objective examination, and the applicant is only checked during a formalities examination, should he/she not be within the EEA, and therefore require the appointment of a representative.

8. With regards to the application process in Belize, the substantive examination does not look at novelty, it is only under an appeal is novelty considered. How is the situation when the applicant is not the creator of the design dealt with to avoid fraudulent activities?

In Belize, if the applicant is not the creator of the design, the application must then include a written statement by the creator of the design, which provides a reason why the applicant has a right to make the application for registration.

At the stage of application leading up to registration there is no substantive examination as it relates to novelty. We do not determine whether the design is new at this stage. When it comes to an interested party applying to invalidate the design on the ground that it is not new, then that determination will be made in the court.

In the EU there would also be ground for lack of entitlement in an invalidity proceeding and it would then go through the route of an examination. In the EUIPO novelty is also examined in invalidity proceedings. There is a substantive examination once there is an invalidity application.

9. Can you provide/share your experience/thoughts regarding the standard practices in determining novelty? Will a comparison of the design being examined with a similar existing design works?

When checking Novelty, this is an objective test, a matter-of-fact: Does there exist, in the relevant prior art an identical design? Is the later design exactly reproduced, or does it differ only in immaterial details (insignificant details which may pass unnoticed)?

As to the individual character test, this is a subjective one, based on the perception of the informed user: the question to ask yourself is whether there exists, in the relevant prior art, a design which does not differ in the overall impression? The Factors affecting the perception of the informed user are:

- The designer's freedom & technical features due to the purpose, function and nature of some types of products
- The design corpus & saturation of the market
- The visibility of some features during the normal use
- Those banal and common features to all the designs of the type of a product

10. On Class 32 of the Locarno classification system as it relates to logos. In light of the fact that we already have a system to protect logos - TM registration. What is your rationale for having design registration for logos?

Protection is different for trade marks and designs. With a design we are protecting the appearance of the product. The protection in design is 5 years renewable up to 25 whereas with TM the protection can be renewed indefinitely. 'What you see is what you get'. What the costs are and what you will achieve from a design vs a trademark.

With regard to a trademark, this can encounter some 'problems' that you will not face with a design, as the trademark needs to be distinctive and not descriptive of the goods/services applied for. (as a matter of example). A registered Community design confers on its holder the exclusive right to use the relevant design in all types of products, and not only in the product indicated in the application for registration (21/09/2017, C-361/15 P & C-405/15 P, Shower drains, EU:C:2017:720, § 93), and a trademark needs to be used in respect of the goods and services applied for.

It will therefore depend on what protection is the applicant seeking.

11. Who can be a representative for non-EEA applicants? Does the representative need to have legal background?

In all Member States of the EEA, representation in legal proceedings is a regulated profession and may only be exercised under particular conditions. In proceedings before the Office, the following categories of representative are distinguished:

- **Legal practitioners** (Article 120(1)(a) EUTMR and Article 78(1)(a) CDR) are professionals who, depending on the national law, are fully entitled to represent third parties before national offices
- **Other professionals** (Article 120(1)(b) EUTMR and Article 78(1)(b) CDR) need to comply with further conditions and need to be included on a specific list maintained by the Office for this purpose (the Office's list of professional representatives). Amongst these, two further groups need to be distinguished: those who may represent only in RCD proceedings ('designs list') and those who may represent in both EUTM and RCD proceedings (see paragraph 2.3 below). The Office refers to these other professionals collectively as 'professional representatives'.

Several legal practitioners and professional representatives may be organised in entities called ‘associations of representatives’ (Article 74(8) EUTMDR; Article 62(9) CDR) (see paragraph 3.4.3 below).

- The final category of representatives is made up of **employees** acting as representatives for the party to proceedings before the Office (Article 119(3) EUTMR, first alternative; Article 77(3) CDR, first alternative) or employees of **economically linked** legal persons (Article 119(3) EUTMR, second alternative; Article 77(3) CDR, second alternative).

In Belize, any person can do it. If it is a foreigner, there must be a representative with a legal background.

12. [comment] The Carnival/mas subsector of the Creative Industry in T&T is vibrant. We promote the use of Industrial Design Rights. The Design system gives us the opportunity not only for protection but having a database of Designs which is necessary to resolve conflicts in the commercialization of mas.
13. With your present way of examination how does it compare with examination under the Hague Agreement?

Via the Hague system, Designs are filed directly at WIPO where formalities are checked. Where the EU is designated, the EUIPO examines exactly the same grounds as for Registered Community Designs (RCD) – definition of a design and public policy/morality. All designated offices will perform their check according to their law.

14. Does the Belize Act outline that the design is registrable if it is new? If so, it is my understanding that this is not considered. Please clarify.

The Belize Act does have a section on registrable industrial design. There is also a section on examination of application outlining what the examiner must do when examining an application. That section does not include checking whether or not that application is new. There is another section of registration of the design which states that once the formalities are present then the design must be registered. Keep in mind the formalities do not include the examination of novelty.

15. [To Participants] Is it possible to use visual disclaimers for design application in your country?

Yes, [in Jamaica] visual disclaimers are accepted, such as dotted lines/broken lines.

16. [Comment] I am seeing that there is need for further training regarding Industrial Property in the area of Administration of an Industrial Design subsystem: Policy, Practice, tools, techniques and know, data and information resources and success stories.

This has been noted.

17. What are your views on the registration of Functional Designs?

Article 8 of the Design regulation aims to avoid registrations of designs based only on technical functions; it aims to prevent technological innovation from being hampered by the granting of design protection to features which are solely dictated by a technical function. Article 8 protects those features of the appearance of the product which need that technical function, with considerations other than the need of that product to fulfil its technical function. In particular, those related to the appearance/visual aspect which does not play a decisive role in the choice of features.

This is not to say that functional designs can't have an aesthetic quality. The fact that a design or particular feature of a design is denied protection doesn't mean that the whole must be denied design protection, see Article 25 of the Design Regulation.

18. Does Belize get a lot of designs that would be considered functional?

No. Functional designs are the subject of a patent application

19. [comment] [in T&T] Functional designs are protected by a patent. Example of a functional feature of a design is corrugation of a solar heat collector to improve its heat collection efficiency.