

MARQUES



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

TWENTY-FOURTH SESSION GENEVA, 1 – 4 NOVEMBER 2010

I. **MARQUES**

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 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.

II. **Twenty-Third Session**

Prior to the Twenty-Third Session, **MARQUES** submitted a non-paper on Possible Areas of Convergence in Industrial Design Law and Practice dated 1 June 2010 in support of the International Bureau's paper SCT/23/5. **MARQUES's** non-paper sought to elucidate the perspective of users of the international industrial design registration system, many of whom are members of **MARQUES**, including IPR owners, designers and the lawyers and trade mark and patent attorneys who represent them.

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 ask the General Assembly to approve the convening, during 2012/2013, of a diplomatic conference for the adoption of a treaty for the simplification and harmonization of industrial design filing law and practice.

III. **Comments on SCT/24/3**

MARQUES is very grateful for the work of the International Bureau in preparing the Draft Provisions and is supportive of the aims as well as many of the specifics of SCT/24/3. **MARQUES** considers SCT/24/3 to be a constructive and helpful step forward.

We make the following minor comments to assist member states in their deliberations. For a more detailed discussion of the various areas of convergence, please refer to the **MARQUES** non-paper dated 1 June 2010.

We have also had the opportunity to read in draft the submission prepared by FICPI, and are grateful for their considered contribution.

(a) **Contents of Application; Fee**

As previously noted, divergent requirements increase time and financial costs on both design owners, by necessitating the preparation of multiple applications tailored to individual jurisdictions, and on administrators, by increasing the chances that applications will be non-compliant and contain irregularities.

MARQUES supports the list of maximum requirements set out in SCT/24/3.

In time, **MARQUES** would like to see the removal of the ability of an office to require (vi) a claim; (vii) a statement of novelty; and (viii) a description - **MARQUES** sees these requirements as unnecessary when seeking to protect the appearance of a product or part of a product.

Users of the system are keen for more offices to offer the opportunity for designers to file multiple designs in the one application. Users also would appreciate greater consistency and clarity around what collection of designs can be filed in the same application. **MARQUES** would therefore like to see a limit on the "conditions as may be prescribed" for multiple applications.

(b) **Representation of the Industrial Design**

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/or
- iv. shading to show contours/volume of three dimensional designs.

MARQUES therefore would ask that paragraph (1) of this provision be amended to read "graphic *and/or* photographic reproductions" to enable a designer to choose how best to represent her or his design. If a design is best represented by four line drawings and two photographs, it should be able to be thus represented.

We consider that the representation of the design should be a matter for the designer, and that any ability for the office to require additional views should be removed, or highly proscribed.

A primary aim of harmonisation from the users' perspective is that the same set of reproductions be able to be used in each and every member state.

(c) **Requirement to File the Application in the Name of the Creator**

We have no comments on this section and support the proposed wording.

(d) **Division of Application**

MARQUES agrees with FICPI's comments on this section that offices should not use their fee regimes to deter the filing of multiple applications.

(e) **Filing Date**

MARQUES supports the wording of this section 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 agrees with FICPI's comments in relation to the time allowed to correct an application.

(f) **Grace Period for Filing in Case of Disclosure**

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 suggested wording.

(g) **Deferment of Publication of the Industrial Design**

MARQUES supports harmonisation of deferment regimes, and agrees with FICPI that deferment should be available under all systems, not only those that do not examine for novelty/originality. Whilst, in practice, deferment may not be often claimed before offices that examine for novelty/originality because of the natural time taken for examination, the option should be available for all users of the system.

MARQUES therefore supports the SCT's efforts to harmonise a minimum deferral period across all member states.

MARQUES supports a 6 month minimum period, but would like to see this extended over time.

(h) **Communications**

MARQUES members report that current requirements for attestation, notarisation, authentication and legalisation add significantly to the cost of international filing programmes, which fall especially heavily on SMEs and individual designers.

MARQUES supports the proposed wording, but sees no need for maintaining the ability for offices to require attestation, notarization, authentication, legalization or other certification of any translation or of any communication "in specific cases". This leaves open to offices 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.

(i) **Initial Term of Protection and Renewal**

We have no comments on this section and support the proposed wording.

(j) **Relief in Respect of Time Limits and Reinstatement of Rights after a Finding by the Office of Due Care or Unintentionality**

We have no comments on these sections and support the proposed wording.

(k) **Request for Recording of a License or a Security Interest and Request for Recording of a Change in Ownership**

We have no comments on these sections and support the proposed wording.

Respectfully submitted

21 October 2010



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Chair of **MARQUES** Council



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