

QUESTION 34

International protection of works of applied art, designs and models

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Q34

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International protection of works of applied art, designs and models

Resolution

The Congress,

invites the Executive Committee to pursue the examination of the question of the international protection of designs and models on the basis of the Orientation of the synthesis report presented to the London Congress.

Arrangement of The Hague

concerning the International Deposit of Industrial Designs or Models

Introduction

I.

The International Association for the Protection of Industrial Property (IAPIP) has examined the draft prepared by the Committee of Experts, to revise the Arrangement of The Hague.

At the Congress of London (4th June 1960), the IAPIP unanimously adopted the following observations, which it has the honour to submit to the Government of the Netherlands and to the International Bureau for the Protection of Industrial Property.

II.

The provisions of the draft prepared by the Experts fall into four categories:

- I. Constitution of a Special Union
- II. Formalities of the international registration
- III. Measures relating to the protection granted
- IV. Organs of the Separate Union.

I. Constitution of a Separate Union

Membership of the Separate Union

The draft

Art. 1 of the draft provides for the constitution of a Separate Union, open only to those countries which are members of the Paris Union.

Remarks

The IAPIP approves the provision stipulating that only members of the General Union may accede to the Separate Union:

- for fundamental reasons, because the Arrangement refers to general rules expressed in the Union Convention,
- for reasons of expediency.

Object of the Union

The draft

As indicated in the title of the Arrangement, its object is „the international deposit of designs or models“.

Remarks

The IAPIP approves the wording of the title, because it considers the Arrangement to be an instrument of formalities.

Adhesion to the Union Coming into force of the Arrangement

The draft

1. The adhesion to the Arrangement or its denunciation are provided for by articles 15, 18, 19 and 21 of the draft.
2. The application of the Arrangement is provided for by article 17: it shall come into force upon the ratification by ten countries, three of which shall not be adherents to the Arrangement of The Hague now in force.

Remarks

The IAPIP stresses that the object in view is the adhesion of the greatest number possible of new countries.

Protocol

The draft

1. A draft of the Protocol, thereto annexed, contains a number of complementary provisions.

2. Art. 22 of the draft provides:

- that the countries which had adhered to the Arrangement of The Hague of 1925, be considered as adhering to the Protocol, unless otherwise stated by them,
- that the new members may ratify the Protocol.

Remarks

The IAPIP approves the draft on this item.

II. Formalities of the International Registration

The draft of the Experts implies the institution of a deposit and of a registration of the designs or models effected at the International Bureau for the Protection of Industrial Property (art. 1 and 2).

The Depositors

The draft

A deposit may be effected by (art. 2):

- persons within the jurisdiction of a contracting country,
- persons without the jurisdiction of a contracting country, but having either their residence or a real and effective commercial establishment in such country.

Remarks

The IAPIP does not offer any remarks on this item.

Application for registration

The draft

The application for registration is submitted to the International Bureau (art. 3).

1. It may be presented:

- either directly
- or through the medium of a national Administration (the countries may require their nationals to present their application through the medium of a national Administration).

2. The application shall contain:

- a) compulsorily, a photographic or a graphic reproduction of the design or model;
- b) optionally, and in addition:
 - a specimen or a mock-up of the object
 - a description of the characteristics of the deposited design or model.

3. The deposit may be a multiple one.
4. Where necessary, the application shall include a priority claim.

Remarks

As far as the multiple deposit is concerned, the IAPIP makes a three-fold observation:

1. The institution of the multiple deposit must be approved because of the reduction of the expenses thus possible.
2. The draft of the Regulations imposes a two-fold condition for the multiple deposit to be regularly effected:

- a) that the different models which are deposited together must be intended to be incorporated in objects of the same kind.

This condition must be approved.

- b) that the number of the models which form the subject of a multiple deposit does not exceed 20. The IAPIP considers, in its majority, that this maximum number of 20 is too small.

3. A difficulty must be pointed out:

It is to be feared that certain countries, the national legislation of which does not allow the multiple deposit, do not recognize on their territory the validity of international multiple deposits effected by nationals of other adhering countries.

The IAPIP expresses the wish that the countries find a solution to this difficulty.

Territorial Limitation

The draft

The draft of the Experts does not provide for the possibility of a territorial limitation of the scope of a deposit.

Remarks

The IAPIP raised the question whether the possibility of operating a territorial limitation of the effects of the deposit should be introduced into the Arrangement under a provision similar to that introduced into the Arrangement of Madrid by the Conference of Nice.

Of course, the motives in favour of the territorial limitation in the field of trade-marks are not entirely valid in the field of models.

Nevertheless, the IAPIP voted, with a bare majority, in favour of the introduction of a territorial limitation.

Renunciation of the Deposit

The draft

The draft of the Experts did not adopt the provisions of art. 13 of the present Arrangement: this article 13 allows a depositor to renounce his deposit at any time, either wholly or in part.

Remarks

The IAPIP considers that the provisions of the former art. 13 should be repeated in the new text.

Registration

The draft

Art. 4 of the draft provides that.

- par. 1: the International Bureau shall enter the application presented in the international register.
- par. 2: the date of the international registration is the day on which the last of the following formalities has been complied with: receipt of the application - receipt of the fee - receipt of the photographic or of the graphic reproduction of the design or model.

Remarks

1. The IAPIP is of the opinion that the draft of the Experts concerns two operations and that these two operations are confused.

a) The two operations referred to in the draft are as follows:

- first, the receipt of the application for registration;
- second, the entering of that application in the register.

b) These two operations must be distinguished, because a certain period of time may elapse between the carrying out of the one and the other.

However, this distinction is not clearly established and the result is a most regrettable confusion.

In fact:

- Art. 4 (2) provides that the date of the international registration is the day of the receipt of the application;
- but art. 5 (1) states that the protection shall come into effect from the entering „the registration in the international register“; and art. 7 and 10, for the calculation of the duration of protection seem also to consider the registration itself.

2. In order to overcome this confusion, the IAPIP makes the two following suggestions.

a) In fact, the only date to be considered is the day of the receipt of the application i.e. the date of the deposit.

It is, indeed, the deposit (or the receipt of the application) which starts the term of priority and confers the right of protection.

Thus, it seems advisable not to take into account the second operation which consists in the registration proper, i.e. the entering of the application in the register. Only the date of the deposit should be considered, i.e. the date on which the application is received.

It must be observed that the deposit is sufficient, if it meets the provisions of art. 4 A (3) of the General Convention, as revised in Lisbon.

- b) However, if the carrying out of the two operations is maintained, it will be necessary to revise the wording, in order clearly to specify:
- the distinction between the two operations;
 - the regulation according to which the first operation (receipt of the application or deposit) starts the term of priority and confers the right of protection.

Publication

The draft

1. The International Bureau proceeds to the publication of the registered designs of models (art. 4 [3]).
2. The depositor may apply for a delay in publication of six months (art. 4 [4]).
3. The deposits are placed at the disposal of the public, excepted during the period of secrecy (art. 4 [5]).

Remarks

1. The publication of the designs or models has been thoroughly discussed in the preparatory stages:
 - according to some, publication is necessary to inform third parties of creations for which protection is claimed;
 - according to others, publication is prejudicial because thus the creation is divulged and imitation encouraged.

The IAPIP, having taken this preliminary discussion into account, approves the compromise set out in the draft, by which publicity shall be provided for, with the option of reserving a period of secrecy of six months.

2. Art. 4 (4) provides that during the period of secrecy the depositor may withdraw his deposit.

The IAPIP considers that it would be of benefit to specify that in this case the entry in the register be cancelled.

Change in proprietorship

The draft

Art. 8 specifies that the International Bureau registers and publishes all changes that affect the proprietorship of the designs or models.

Remarks

The IAPIP has no remarks to make on this item.

Fees

The draft

1. Art. 12 (b) provides that the registration shall be subject to the payment of a fee the amount of which is fixed by the Regulations.
2. Art. 6 of the draft Regulation provides for several fees (for example 50 frs. for the registration of one model, with publication in black and white in one standard space).

Remarks

The Vice-Director of the International Bureau observed that the future fees should not be compared to the present ones which are quite insufficient and should in any case be raised to S. Fr. 25.-- or 30.--.

The IAPIP recognizes the necessity to fix the fees at a sufficiently high level.

III. Measures relating to the Protection Granted

Definition of Designs or Models

The draft

The draft does not contain any definition of the designs or models to which protection shall be granted.

Remarks

1. The IAPIP unanimously considers it both impossible and undesirable to establish a definition of designs or models.
2. The IAPIP considered whether it would not be suitable to add the qualifying word „industrial“ to the expression „designs and models“ used in the draft.

This addition could be justified:

- by the desire to avoid a confusion of the designs or models, which are the subject of the international registration, and the „utility models, which are not referred to in the Arrangement;
- by the fact that both in the general Convention (art. 1 [2]) and in the present Arrangement of The Hague of 1925 the designs and models are qualified as „industrial“.

The IAPIP thinks it preferable not to add the qualifying word „industrial“, in order to avoid any possible confusion with utility models.

But the IAPIP considers it desirable to specify that utility models are excluded from the provisions of the Arrangement, by means of a provision inserted in the text or, possibly, by a statement by way of an „Exposé des Motifs“.

The Effects of the International Registration or the Protection Granted

The draft

The protection granted through the international registration is referred to in art. 5 (1), 10 and 16:

- Art. 5 (1) specifies that the international registration shall produce the same effects as a deposit or the delivery of a certificate in each one of the contracting countries;
- Art. 10 specifies that the contracting countries shall grant to internationally registered designs or models a protection, the duration of which shall be the same as that granted to the designs or models in the countries concerned;
- Finally, art. 16 requires each country to adopt, before ratification of the Arrangement, the measures necessary for assuring its application.

Remarks

1. The IAPIP recalls that there are two possible systems for determining the providing protection granted through the international registration:

- a) The first system consists in providing that the protection arises from the international registration.

In this case, a provision of supranational right must be inserted in the Arrangement, specifying that „registered models be protected in all the contracting countries“.

- b) The second system consists in providing that the protection arises from the national law.

In that case, the Arrangement is merely a technical instrument which sets up the formality of the international registration and leaves it to the national legislation to determine the protection granted.

2. The IAPIP notes that the draft Arrangement deliberately adopts the second system.

The IAPIP approves it for the following reasons:

- most countries would not accept a system by which the protection is granted to all registered models without distinction;
- because of their constitution most of the countries cannot apply directly an international treaty as a national law.

3. However, the IAPIP considers it desirable to retain in the Arrangement the provision of art. 5 (5) of the general Convention adopted at Lisbon, that is:

„Designs and models shall be protected in all countries of the Union.“

In fact:

- a) this rule is not contrary to a system of protection that derives from national law, because it only makes it binding upon the countries to organize the protection on their territory;
- b) it would be useful to insert this rule in the Arrangement as there may be countries which would adhere to it before having ratified the Lisbon text.

Priority

The draft

Art. 6 specifies that if the international registration is effected within six months of a first application, it shall benefit from the priority.

Remarks

The IAPIP points out that art. 6 involves only the possibility of claiming the priority of a first application deposited in one of the contracting countries.

It would be advisable to specify that the depositors may claim the priority of a first application deposited in a unionist country, even if this country is not an adherent to the Arrangement.

Duration of protection

The draft

1. The international registration is valid for five years.

It is renewable for periods of five years upon application made within the last year of the current period (art. 7).

2. The minimum duration of protection granted by the countries is (art. 10 [3]):

- of ten years, reckoned from the date of the international registration;
- of five years, in case the international registration is not renewed.

This minimum duration is fixed at fifteen years for the countries, signatories of the Protocol annexed.

3. In principle, the duration of protection in the countries is that of the national legislation, provided that the minimum duration referred to above is complied with (art. 10 [1]). However, the countries may provide for a shorter period, provided they do not go below the minimum duration (art. 10 [2]).

Remarks

The IAPIP is in favour of the compromise as proposed in the draft.

It points out, however, the two following remarks of minor importance:

1. It would be desirable to retain the provisions of art. 10 of the present Arrangement, according to which the International Bureau shall give an unofficial notice of lapse of the deposit.

2. It would be desirable to specify in art. 7 that the renewal of the deposit shall be effected directly with the International Bureau.

Cumulative Protection

The draft

Art. 14 specifies:

- that wider provisions of the national laws may be claimed;
- that the regime of the Arrangement does not affect the protection of artistic works and works of applied art granted by International Conventions on Copyright.

Remarks

The IAPIP approves the provisions of art. 14, which it considers to be very wise.

The reservations of the national legislations

The draft

Art. 5 and 9 provide for the items upon which the national legislations may impose restrictions.

1. The countries may provide that the international registration shall have no effect on their territory (art- 5 [2]), with respect to its own nationals.
2. Countries which practice the preliminary examination are allowed, within a term of six months, to refuse protection to internationally registered designs or models which are not in conformity with their domestic laws (art. 5 [3]).
3. Countries, the domestic laws of which require the offering to the public of the design or model as a condition for protection, are allowed to refuse protection of the international registration if this offering did not occur within a term of six months. Offering to the public takes place when the object in which the design or model is incorporated, is exhibited, sold or gratuitously offered to the public in any country whatsoever (art. 5 [4]).
4. Marking cannot be required for the recognition of a right.

If the domestic laws require marking for the exercise of certain remedies, this requirement shall be fulfilled by the affixing on the objects or on their label of the symbol (D), followed by certain particulars (art. 9).

The Protocol annexed provides for the renunciation of this requirement for the countries signing it.

Remarks

1. The reservations contained in the draft have been the subject of two kinds of observation:
 - a) For some, they are unnecessary because protection flows from the national legislation. However, attention must be drawn to the fact:
 - that these reservations are claimed by certain countries and that this claim must be satisfied;

- that these reservations limit the restrictions imposed by the domestic laws, and thus are favourable to the protection.

b) For others, the restrictions are most regrettable because they excessively limit protection.

However, it must be noted that these regrets are vain because protection proceeds from domestic law which is sovereign in this respect.

2. In conclusion, the compromise set forth in the draft is approved by the IAPIP.

IV. Administrative provisions

The Draft

The International Committee

The draft provides for the institution of an International Committee, composed of representatives of the contracting Countries.

This Committee would meet upon convocation by the Director of the International Bureau, in agreement with the Swiss Government, or upon request of one-third of the Member Countries.

Its functions are:

- to amend the Regulations by a majority of four-fifths;
- to study the problems of the application of the Arrangement (art. 11).

Regulations for carrying out the Arrangement

1. The details of the application of the present Arrangement are governed in Regulations (art. 12).

2. These Regulations may be amended:

- either by the Committee (art. 11), or
- by means of written procedure: the amendments proposed by the Director of the International Bureau are considered as adopted by the Countries if none of them has offered opposition within one year from the date of the proposal (art. 13 [2]).

Revision Conference

The Arrangement may be revised by conferences, convened upon request of the International Committee or of one half of the contracting Countries (art. 20).

Remarks

The IAPIP has no observations on these various items.

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QUESTION 34

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Yearbook 1963, New Series No. 13, 1st Part, 66th Year, page 84
25th Congress of Berlin, June 3 - 8, 1963

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QUESTION 34

International protection of works of applied art, designs and models

Resolution

Studies on the unification of the law on industrial designs and models

The Congress considering that this question requires further study refers it to the Executive Committee for consideration!

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QUESTION 34

International protection of works of applied art, designs and models

Yearbook 1964/II, 67th Year, pages 109 - 110
Executive Committee of Salzburg, September 14 - 18, 1964

Q34

Studies on the unification of the law on industrial designs and models

Resolution

The Executive Committee,

considering it indispensable to provide without delay a solution, even if limited, to a problem which has been for years deferred because of the differences in the concepts in the national groups and the differences in the national legislation, considering that it would - to say the least - be premature to suggest the drafting of a detailed statute which could be approved by all the national groups,

decides to submit to the next Congress basic elements for the protection of industrial designs and models which it would like to see appear in the different national laws.

It must be well understood that these elements constitute a minimum basis of protection which each country has the option of exceeding by granting to the originator of the design or model more favourable provisions especially in the scope and term of protection.

In the proposal which follows, the Executive Committee, without going into detail, has taken into account the fact that the determination of infringement and sanctions against it must depend upon the national jurisprudence.

I. Subject matter of protection

The appearance of an industrial object may be protected as a design; this appearance may result among other things from an assembly of lines, from the shape of the article itself or from its ornamentation.

II. Nature of protection

Industrial designs must be protected by a system of their own which can co-exist with the copyright protection system in accordance with domestic laws.

III. 1. Basic conditions of protection

The protection of the above-mentioned system may be refused to a design

- a) which corresponds to an earlier design or which involves no creative effort relatively thereto;
- b) or which is exclusively dictated by a technical necessity.

III. 2. Formal conditions for protection

- a) The design must be the subject of a deposit.
- b) The deposited design must be officially made public, either immediately after a period of secrecy limited to a maximum duration of one year, including any priority period provided for in the Arrangement of The Hague.
- c) Marking of the deposit or the registration on the object must not be a condition precedent to the institution of infringement proceedings.

IV. Effects of protection

- 1. The term of the protection available shall be at least ten years, which may be divided into periods.
- 2. The deposit or, in examining countries, the registration shall give protection not only against exact reproduction but also against any substantial copying and wrongful reproduction by any means.

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QUESTION 34

International protection of works of applied art, designs and models

Yearbook 1966/II a, 69th Year, pages 44 - 45Q34
26th Congress of Tokyo, April 11 - 16, 1966

Question Q34

Study on the unification of the law on industrial designs and models

Resolution

The Congress,

with a view to establishing the essential features of legislation for the protection of industrial designs and models adopts the following principles:

I. Subject matter of protection

The appearance of an industrial object may be protected as a design or model; this appearance may result among other things from an assembly of lines, or colours, from the shape of the article itself from its ornamentation.

II. Nature of protection

Industrial designs and models must be protected by a system of their own which can co-exist with the copyright protection system in accordance with domestic laws.

III. 1. Basic conditions protection

The protection of the above-mentioned system may be refused to a design or model:

a) which corresponds to an earlier design or model or which involves no creative effort relatively thereto;

b) or which is exclusively dictated by a technical necessity.

2. Formalities for protection

a) The design or model must be the subject of a deposit.

b) The deposit must be officially made public, either immediately or after a period of secrecy limited to a maximum duration of one year, including any priority period accorded under article 4 of the Paris Convention or the Agreement of The Hague.

c) Marking of the deposit or the registration on the object must not be a condition precedent to the institution of infringement proceedings.

IV. Effects of protection

1. The term of the protection available shall be at least ten years, which may be divided into periods.

2. The deposit or, in examining countries, the registration, shall give protection not only against exact reproduction, but also against any substantial copying and wrongful reproduction by any means.

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