

ECTA COMMENTS ON THE DESIGN LAW TREATY

I. INTRODUCTION

In advance of the upcoming Diplomatic Conference to Conclude and Adopt a Design Law Treaty, planned to be held in Riyadh, Saudi Arabia on 11-22 November 2024, ECTA would like to share its comments in relation to the text of the Basic Proposal for the Design Law Treaty which has been made publicly available.

II. COMMENTS

The international system for the protection of industrial design, commonly referred to as the Hague System, is based on the Geneva Act of the Hague Agreement concerning the International Registration of Industrial Designs of 2 July 1999. It is the basis for the European design protection and the national design protection in the Member States of the European Union.

Formal separation of the registration procedure and substantive examination

This system of protection is based on the formal separation of the registration procedure and the substantive examination of a registered design in the context of invalidity proceedings or infringement proceedings before court.

This formal separation between the registration procedure and substantive legal review is taken into account in the General Principles of Article 1bis of the BASIC PROPOSAL FOR THE DESIGN LAW TREATY (DLT). This provision stipulates that the DLT does not affect the substantive law in the Contracting States.

ECTA regards the retention of this formal separation of registration procedures and substantive examination as a basic prerequisite for achieving the goal of simplifying design protection in all the Contracting Parties concerned, i.e. in the Contracting Parties that already have a functioning design protection system and in those Contracting Parties that are in the process of setting up a design protection system.

Design Containing traditional cultural expressions (Art. 3 IX Alternative A DLT and Article 9quinquies)

From ECTA's point of view, it is important to protect traditional cultural expressions from monopolisation by private third parties and to ensure that the traditional knowledge or traditional cultural expressions can be freely and independently used by their owners, without being restricted by the design protection of individual third parties. However, from ECTA's point of view, this aspect is a substantive law aspect that is governed by the substantive law requirements of the Contracting Parties. This aspect of substantive law does not fall within the scope of the DLT and should not be made the subject of the DLT according to the general principles of Art. 1bis DLT mentioned above. Such a regulation of substantive law would complicate, rather than simplify, the requirements for obtaining design protection within the European Union and its Member States.

The same pertains to the draft regulation of Article 9quinquies which mixes aspects of formal requirements and substantive law.

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Information relevant to the eligibility for registration (Art. 3 IX Alternative B DLT)

The same applies with regard to the disclosure of information relevant to the eligibility for registration required in the registration procedure. This would also contradict the principle of separation of the registration procedure and substantive protection requirements as set out in Art. 1 bis DLT. This disclosure would indirectly mix substantive protection requirements with formal registration requirements through formal requirements to disclose information. This would make it more difficult to obtain design protection within the European Union and the EU Member States. This would also contradict the objectives of the DLT.

Electronic Industrial Design System - Article 9quater DLT

An electronic registration system is necessary to simplify registration and to provide a designer with a simple way of obtaining design protection. In most parts of the world today, electronic communication systems are significantly easier, cheaper and more effective than the possibilities for submitting written applications by post.

Firstly, registered designs serve to ensure that these rights can be enforced in court proceedings against infringers. To ensure that the courts dealing with such proceedings have complete and reliable data on the content and scope of a design registration, access to an electronic registration system is also important and particularly recommended for law enforcement.

Secondly, other designers depend on their work to ensure that no earlier rights of third parties are infringed. To provide them with reliable search options and information about possibly conflicting rights of third parties, it is essential to enable electronic searches in publicly accessible databases.

ECTA, therefore, supports the urgent demand for the introduction of electronic industrial design systems. However, it is recognised that economic requirements often hinder the introduction of systems in individual countries. Unless the signing of the DLT by a Contracting Party is linked to the requirement that an electronic system for design protection be introduced, the following wording of the DLT should at least be demanded:

Article 9quater Electronic Industrial Design System

(1) A Contracting Party shall provide a system for electronic applications.

(2) Contracting Parties shall provide a publicly available electronic information system, and an online database of registered industrial designs.

III. FINAL REMARKS

From ECTA's point of view, the following aspects are, therefore, of essential importance for the negotiations on the content of the DLT:

1) The proposed regulations in accordance with Art. 3 IX Alternative A and Alternative B for the information on traditional cultural expressions or information relevant to the eligibility for registration should be deleted without replacement. As well Article 9quinquies should not be agreed on.

2) The introduction of an electronic industrial design system within the framework of the DLT should be demanded.

ECTA, which was formed in 1980, is an organisation concerned primarily with intellectual property matters. ECTA has approximately 1,300 members, coming from all the Member States of the EU, with associate Members from more than 50 other countries throughout the world.

ECTA brings together those practicing in the field of IP, in particular, trade marks, designs, geographical indications, patents, copyright and related matters. These professionals are lawyers, trade mark and patent attorneys, in-house lawyers concerned with IP matters, and other specialists in these fields.

The extensive work carried out by the Association, following the above guidelines, combined with the high degree of professionalism and recognised technical capabilities of its members, has established ECTA at the highest level and has allowed the Association to achieve the status of a recognised expert spokesman on all questions related to the protection and use of trade marks, designs and domain names in and throughout the European Union, and for example, in the following areas:

- Harmonization of the national laws of the EU member countries;
- European Union Trade Mark Regulation and Directive;
- Community Design Regulation and Directive;
- Organisation and practice of the EUIPO.

In addition to having close links with the European Commission and the European Union Intellectual Property Office (EUIPO), ECTA is recognised by WIPO as a Non-Government Organisation (NGO).

ECTA does also take into consideration all questions arising from the new framework affecting trade marks, including the globalization of markets, the explosion of the Internet and the changes in the world economy.