



INDUSTRIAL DESIGN LAW AND PRACTICE IN THE CARIFORUM REGION



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TABLE OF CONTENTS

1.	INTRODUCTION.....	4
2.	SUBJECT MATTER.....	5
2.1	Terminology.....	5
2.2	Definition	5
2.3	Requirements for protection	8
2.4	Designs excluded from protection	12
3.	RIGHTS AND SCOPE OF PROTECTION	16
3.1	Right to an industrial design	16
3.2	Right of the creator to be named as such	18
3.3	Scope of Protection.....	18
4.	REGISTERED AND UNREGISTERED DESIGNS – TEXTILE DESIGNS – RELATIONSHIP TO COPYRIGHT	23
4.1	Registered designs	23
4.2	Unregistered designs	23
4.3	Textile designs	23
4.4	Relationship to copyright.....	24
5.	APPLICATION FOR REGISTRATION	24
5.1	Filing systems – Forms	24
5.2	Language.....	25
5.3	Applicant.....	26
5.4	Content of the application	27
5.5	Representation of the design	29
5.6	Classification	38
5.7	Description	39
5.8	Information regarding foreign applications or registrations.....	40
5.9	Multiple designs in the same application	41
5.10	Division of the application	42
5.11	Amendments to the application.....	43
5.12	Withdrawal of the application	45
6.	REPRESENTATIVE	45
7.	RIGHT OF PRIORITY.....	46
7.1	Priority based on a duly filed earlier application.....	46
7.2	Priority based on an exhibition	52

8.	FILING DATE AND EXAMINATION	54
8.1	Filing date	54
8.2	Examination of the industrial design application.....	55
9.	PUBLICATION OF THE INDUSTRIAL DESIGN	60
9.1	Timing of publication	60
9.2	Deferment of publication.....	62
10.	OPPOSITION.....	64
11.	RELIEF IN RESPECT OF TIME LIMITS	65
11.1	Extension of time limits – Continued processing	65
11.2	Reinstatement of Rights	66
12.	OPPORTUNITY TO BE HEARD – REVIEW – APPEALS	67
12.1	Opportunity to be heard	67
12.2	Review.....	67
12.3	Appeals.....	67
13.	REGISTRATION	68
13.1	Registration of the industrial design and certificate thereof.....	68
14.	DURATION OF PROTECTION.....	69
14.1	Initial term	69
14.2	Renewal.....	70
14.3	Maximum duration of protection	71
15.	ENTRIES IN THE DESIGNS REGISTER	71
15.1	Change in ownership	71
15.2	License contracts	73
15.3	Change in name or address of the holder, applicant or representative.....	75
15.4	Surrender (renunciation of limitation) of the registration.....	76
16.	INVALIDATION	77
17.	APPLICATION OF INTERNATIONAL TREATIES IN RESPECT OF INDUSTRIAL DESIGNS.....	80
17.1	Membership in international treaties dealing with industrial designs	80
17.2	Application of international treaties	81
18.	CONCLUSIONS	82
18.1	Possible areas of cooperation and convergence.....	83

Annex A Industrial Designs Laws and Regulations analyzed in this document

Annex B Practice Fiche on Graphic Representation of Designs in (selected) CARIFORUM IP Offices

1. INTRODUCTION

This document has been elaborated in the context of the Innovation and Intellectual Property Rights in CARIFORUM (CarIPI) Project with a view to assisting the CARIFORUM States (CS) in visualizing the current status of industrial design law and practice in the region as a first step towards the CS deciding on whether to possibly undertake some convergence or harmonization efforts in this area.

The document is based on the analysis of the *sui generis* industrial design laws and regulations of 11 CARIFORUM States, namely 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). It focuses on industrial design registration and protection to the exclusion of matters related to the enforcement of industrial design rights. It does not cover the situation in the remaining five CARIFORUM States where no *sui generis* legislation dealing with industrial designs has been identified (Grenada, Haiti, Saint Kitts and Nevis and Suriname), or where no update of the relevant legislation has been enacted in the past 40 years (Guyana).

The laws and regulations analysed for the purposes of this document are indicated in Annex A. Throughout the document, references to specific provisions are indicated as in the following examples:

- AG-A-3.1 Section 3, subsection 1, of the Law (A) of Antigua and Barbuda (AG)
- AG-R-9.1 Regulation 9, sub-regulation 1, of the Regulations (R) of Antigua and Barbuda (AG)

Where appropriate, the document makes reference to related provisions in the following legal instruments:

- *Paris Convention for the Protection of Industrial Property (Paris Convention)*
- *Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement)*
- *Economic Partnership Agreement between the CARIFORUM States and the European Community and its Member States, done at Bridgetown, Barbados, on 15 October 2008 (EPA)*
- *Geneva Act (1999 Act) of the Hague Agreement on the International Registration of Industrial Designs, of July 2, 1999 (Hague Agreement) and Common Regulations Under*

the 1999 Act and the 1960 Act of the Hague Agreement, as in force on January 1, 2022 (Hague Regulations)

Where relevant, reference is also made to documents prepared by the WIPO Secretariat for the attention of the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), including, inter alia, the following:

- *Industrial Design Law and Practice – Draft Articles (SCT/35/2) (IDLPA) (2016)*
- *Industrial Design Law and Practice – Draft Regulations (SCT/35/3) (IDLPR) (2016)*
- *Industrial Design Law and Practice – Analysis of the Returns to WIPO Questionnaires (SCT/19/6)*

2. SUBJECT MATTER

2.1 Terminology

When referring to the relevant subject matter, the CARIFORUM States (CS) use the following terms:

- *industrial design* – AG, BB, BZ, DM, LC, VC, TT
- *design* – JM
- *design copyright* – BS
- *diseño industrial* – DO
- *dibujo o modelo industrial* – CU

In this document, the relevant subject matter is referred to as *industrial design* or *design*, indistinctly.

2.2 Definition

Neither the Paris Convention, nor the TRIPS Agreement, nor the Hague Agreement, contain a definition of “industrial design”. The question as to what matter can be protected as an industrial design remains an issue to be determined by the law of each Contracting Party.

Most industrial design laws around the world, including all those of the CARIFORUM States, define the concept of industrial design by highlighting, in particular, the following three elements: (a) the configuration of the design (either bidimensional or three-dimensional); (b) the arbitrary (non-technical or functional) appearance of the design, and (c) the industrial applicability of the design.

(AG-A-3) (BS-A-30.1) (BB-A-4) (BZ-A-2) (CU-A-91.2) (DM-A-2) (DO-A-54) (JM-A-81) (LC-A-3.1) (VC-A-3.1) (TT-A-3.1)

Configuration

Regarding the *configuration* of the design, the CS' laws use the following expressions to define:

- *bidimensional designs*:
 - any composition of lines or colours – AG, BB, BZ, DM, JM, LC, VC, TT
 - features of configuration, pattern or ornament – BS
 - any flat element or combination of elements ... of shape, colour, design, texture – CU
 - any group of lines or combination of colours ... or bidimensional form – DO
- *three-dimensional designs*:
 - any three-dimensional form, whether or not associated with lines or colours – AG, BB, JM
 - any three-dimensional form, or material, whether or not associated with lines or colours – BZ, DM, LC, VC, TT
 - features of shape – BS
 - volumetric product, or parts thereof consisting of a particular shape, configuration, texture, material, or combinations thereof – CU
- any external three-dimensional form – DO

Appearance

Regarding the *appearance* of the design, the CS' laws prescribe that the design configuration shall:

- give a special appearance to a product of industry or handicraft – AG, BB, BZ, DM, JM, LC, VC, TT
- appeal to, and be judged, (solely) by the eye – BS, BZ, DM, LC, VC, TT

- be of an aesthetic or ornamental nature or give a special ornamental or aesthetic appearance to an industrial or handicraft product, which distinguishes it from its fellows – CU
- give a special appearance to a product, without changing its function or purpose – DO

These laws further prescribe that protection is conferred to the *arbitrary features* of appearance to the *exclusion of any technical or functional feature* of the design:

- the industrial design shall not consist of anything that serves to obtain a technical result and leaves no freedom as regards arbitrary features of appearance (BZ-A-2) (DM-A-2)
- the protection conferred to an industrial design does not extend to anything in the design that serves solely to obtain a technical (or functional) result, to the extent that it leaves no freedom as regards arbitrary features of appearance (AG-A-3.2) (BB-A-8.b) (DO-A-60.1) (JM-A-82) (LC-A-3.2) (VC-A-3.2) (TT-A-3.2)
- the industrial design gives no rights in any features of an article in so far as these are dictated solely by the function which the article is intended to perform or in any method or principle of construction (BS- A-35.2)
- a design shall not be registered if it includes elements or features which are designed solely to achieve a technical effect or to perform a technical function (CU-A-92.c)
- an industrial design whose appearance is determined solely by a technical function and does not incorporate any arbitrary input from the designer shall not be protected (DO-A-55); the protection of an industrial design shall not extend to those elements or features of the design which are determined solely by the performance of a technical function, and do not incorporate any arbitrary input from the designer (DO-A-60.1).

In this respect, the EPA also prescribes that design protection shall not extend to designs dictated essentially by technical or functional considerations. (EPA, Art. 146.C.2)

Industrial applicability

Regarding the *industrial applicability* of the design, the CS' laws prescribe that the design configuration shall:

- serve as a pattern for a product of industry or handicraft – AG, BB, BZ, DM, JM, LC, VC, TT

- be applicable to articles – BS
- serve as a prototype for its industrial or handicraft production – CU
- be incorporated in an industrial or craft product – DO

2.3 Requirements for protection

The TRIPS Agreement prescribes that Members shall provide for the protection of independently created industrial designs that are new or original. Members may provide that designs are not new or original if they do not significantly differ from known designs or combinations of known design features. Members may provide that such protection shall not extend to designs dictated essentially by technical or functional considerations. (TRIPS, Art. 25.1)

The Economic Partnership Agreement (EPA) prescribes that the EC Party and the Signatory CARIFORUM States shall provide for the protection of independently created industrial designs that are new or original, and that have individual character. (EPA, Art. 146.B.1)

The CARIFORUM States require industrial designs to be *new* or *original* in order to be registrable or deserve protection. Certain laws (CU, DO, JM) further specify that only industrial designs having *individual character* shall be protected.

- In AG, BB, BZ, CU, DM, DO, JM, LC, VC and TT, an industrial design must be *new* to be registrable or protected as such (AG-A-4.1) (BB-A-9) (BZ-A-3.1) (CU-A-93) (DM-A-3.1) (DO-A-58) (JM-A-83.1 to 83.3) (LC-A-4.1) (VC-A-4.1) (TT-A-4.1)
- In BS, an industrial design must be *original* to be registrable as *design copyright* by the person claiming to be its owner (BS-A-30.2)
- In CU, DO and JM the law further specifies that the design shall have *individual character* (CU-A-94.1) (DO-A-58) (JM-A-83.5 and 83.6)

Meaning of the term novelty

The EPA prescribes that a design shall be considered to be new if no identical design has been made available to the public (EPA, Art. 146.B.2).

The laws in certain CS elaborate on the meaning of the term *novelty* by specifying that an industrial design is not new

- by reason only that it differs from earlier embodiments of an industrial design in minor respects or that it concerns a type of product different from those earlier embodiments of an industrial design (BB-A-11.3)
- merely because it is secondarily different from a prior design or because it relates to a different kind of product (CU-A-94.3); if it does not differ to a significant degree from known designs or combinations of known features of designs (CU-A-92.f)
- solely because it presents minor differences from other previous ones (DO-A-58)

Worldwide novelty

The ten CS that require designs to be *new*, require *worldwide novelty*, meaning that an industrial design is considered to be new if it has not been disclosed [made available] to the public, anywhere in the world, by publication [description] in tangible form or by use, by marketing, or in any other way, prior to the filing date or, where applicable, the priority date of the application for registration. (AG-A-4.2) (BB-A-11.1) (BZ-A-3.2) (CU-A-94.4) (DM-A-3.2) (DO-A-58) (JM-A-83.2) (LC-A-4.2) (VC-A-4.2) (TT-A-4.2)

Individual character

The EPA prescribes that a design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public. (EPA, Art. 146.B.3)

In the CARIFORUM region, the laws of CU, DO and JM elaborate on the *individual character* requirement, as follows:

- The law of JM requires specifically that the industrial design should have *individual character*, meaning that the *overall impression* it produces on the *informed user* differs from the overall impression produced on that user by any design which has been made available to the public before the date on which the application for the registration of the design was filed or is treated as filed. (JM-A 83.5). In determining the extent to which a design has individual character, the degree of freedom of the designer in creating the design shall be taken into consideration. (JM- A 83.6)
- The law of DO requires specifically that the industrial design should have *individual character (carácter singular)*, and prescribes that an industrial design shall be considered

to have individual character when the *overall impression* it produces on an *informed user* differs from the overall impression produced on that user by any other industrial design which has been made available to the public prior to the filing date or the priority date if priority is claimed (DO-A-58). In determining whether or not an industrial design has individual character, the degree of freedom of the designer in developing the design shall be taken into account. (DO-A-58)

- While not using the expression individual character as such, the law of CU clarifies that a design is deemed to be new if no other identical design has been made available to the public and the *overall impression* it produces on an informed person differs from the overall impression produced on that person by any other design which has been made available to the public before the date of priority. (CU-A-94.1)

Originality

The law of BS requires the design to be *original*. A design shall be deemed to be original insofar only as it is the original work of the author (BS-A-31.1). A design shall not be deemed to be original if it is the same as a design of or for the same or any other article by the same author which has been previously published in the country *or elsewhere* or has been deposited by or on behalf of or with the consent of the author or any proprietor thereof or differs from such design in modifications or variations not sufficient to alter the character or substantially affect the identity thereof. (BS-A-31.2)

Disclosures not affecting novelty or originality – Grace period

For the purposes of determining whether a design complies with the novelty or originality requirement, most industrial design laws around the world prescribe that certain types of disclosure to the public are not to be taken into consideration. Such laws provide for a grace period to file, further to a disclosure made by the creator, his/her successor in title or another person. In the course of preparatory work towards a possible Design Law Treaty (DLT), the SCT delegations agreed on a proposal to provide for a grace period for filing in case of disclosure of six or 12 months. Thus, Article 6 of the IDLP Draft Articles (SCT/35/2) prescribes that a disclosure of the industrial design during a period of six or 12 months preceding the date of filing of the application or, if priority is claimed, the date of priority, shall be without prejudice to the novelty and/or originality, as the case may be, of the industrial design, where it was made: (i) by the creator or his/her successor in title; or (ii) by a person who obtained information about the industrial design directly or indirectly,

including as a result of an abuse, from the creator or his/her successor in title. The question as to whether disclosure made in a bulletin of an IP Office would give rise to a grace period remains a matter for the applicable law of each country.

In the CARIFORUM region, the laws provide for grace periods regarding disclosures, as follows:

- In AG, BZ, DM, DO, JM, LC, VC and TT, a disclosure having occurred within the 12 months preceding the filing date or, where applicable, the priority date of the application shall not affect novelty, provided that the disclosure:
 - has taken place by reason or in consequence of acts committed by the applicant or his predecessor in title (AG-A-4.3) (DO-A-58) (LC-A-4.3) (VC-A-4.3) (TT-A-4.3)
 - has taken place by reason or in consequence of an abuse committed by a third party with regard to the applicant or his predecessor in title (AG-A-4.3) (BZ-A-3.4) (DM-A-3.4) (DO-A-58) (LC-A-4.3) (VC-A-4.3) (TT-A-4.3)
 - was due to or made in consequence of (JM-A-83.3):
 - (a) the matter having been obtained unlawfully or by any person from the designer or from any other person to whom the matter was made available in confidence by the designer;
 - (b) a breach of confidence by any person who obtained the matter in confidence from the designer or from any other person to whom it was made available, or who obtained it, from the designer; or
 - (c) the designer having displayed the design at a local, regional or international exhibition, and the applicant (i) states, on filing the application that the design has been so displayed; and (ii) files, within the prescribed period, written evidence in support of the statement complying with any prescribed conditions.
- The law of BS provides for a grace period of 6 months (disclosure not affecting novelty) where (a) a representation of the design, or any article to which the design has been applied, has been displayed, with the consent of the proprietor of the design, at an exhibition certified by the Office; or (b) after any such display, and during the period of the exhibition, a representation of the design or any such article has been displayed by any person without the consent of the proprietor; or (c) a representation of the design has been published in consequence of any such display, if the claim for design copyright is deposited not later than six months after the opening of the exhibition. (BS-A-34)
- The law of BB provides for a grace period of 6 months (disclosure of the design not affecting novelty) where the disclosure has been made by the applicant in an exhibition recognised

by the competent Minister as being an official national or international exhibition. (BB-A-11.2, 11.5)

- In CU, a design shall not be deemed to have been made available to the public if it has been disclosed (a) to a third party under implied or express conditions of confidentiality; or (b) as a result of an unlawful act against the applicant or his successor in title. (CU-A-95)

2.4 Designs excluded from protection

The TRIPS Agreement prescribes that Members may provide limited exceptions to the protection of industrial designs, provided that such exceptions do not unreasonably conflict with the normal exploitation of protected industrial designs and do not unreasonably prejudice the legitimate interests of the owner of the protected design, taking account of the legitimate interests of third parties (TRIPS, Art. 26.2).

The EPA prescribes that the EC Party and the Signatory CARIFORUM States may provide limited exceptions to the protection of industrial designs, provided that such exceptions do not unreasonably conflict with the normal exploitation of protected industrial designs and do not unreasonably prejudice the legitimate interests of the owner of the protected design, taking account of the legitimate interests of third parties. (EPA, Art. 146.C.1)

In one or more CARIFORUM States, certain types of designs are expressly excluded from registration (some of them only under certain circumstances), including designs that are contrary to public order or morality, designs that involve the use of State emblems or names, acronyms or emblems of intergovernmental organizations (IGOs), country names, trademarks and other distinctive signs, copyright works protected in favour of another person, images of an individual, traditional knowledge, traditional cultural expressions, non-visible components of a complex product, and/or spare parts.

Public order or morality

The EPA prescribes that a design right shall not subsist in a design which is contrary to public policy or to accepted principles of morality. (EPA, Art. 146.C.3)

- In AG, BZ, DM, DO, JM, LC, VC and TT, an industrial design that is (or the commercial exploitation of which would be) contrary to public order or morality is expressly excluded

from registration (AG-A-4) (BZ-A-3.3) (DM-A-3.3) (DO-A-55) (JM-A-83.1) (LC-A-4.4) (VC-A-4.4) (TT-A-4.4)

- In BB, an industrial design may not be registered if it is likely to provoke a breach of the peace (BB-A-10)
- In CU, a design shall not be registered if it is contrary to the interests of society, public policy or morality (CU-A-92.g)

State emblems

- In BS, where a portrait of any member of the Royal Family or a reproduction of the armorial bearings, insignia, orders of chivalry, decorations or flags of any country, city, borough, town, place, society, body corporate, institution or person appears on a design, the Office shall, if it so requires, be furnished with a consent to the use of such portrait or reproduction from such official or other person and, in default of such consent, may refuse to enter the claim for design copyright (BS-R-65)
- In DO, an industrial design that involves an improper use of any of the elements listed in Article 6~~ter~~ of the Paris Convention, or other distinctive emblems or coats of arms which are of public interest, shall not be protected, unless duly approved by the competent authority or institution (DO-A-55)
- In JM, a design shall not be registrable if it involves the use of
 - a representation of any national symbol or emblem of JM (Coat of Arms, national flag, armorial bearings, official signs or hallmarks, or any of other), or anything, the heraldic elements of which, in the opinion of the Office, imitates any such flag, armorial bearings or other emblem, sign or hallmark, unless consent is obtained from the Government (JM-A-83.7.a)
 - the flag, armorial bearings or any other state emblems, official signs or hallmarks of a Convention Country, or anything, the heraldic elements of which, in the opinion of the Office, imitates any such flag, armorial bearings or other emblem, sign or hallmark, unless the authorization of the competent authority of that country is obtained (JM-A 83.7.d)

Names, acronyms and emblems of IGOs

- In JM, a design is not registrable if it involves the use of the emblems, abbreviations and names of an international organization, unless consent is obtained from that organization (JM-A-83.7.e)

Country names and other identifiers

- In JM, a design is not registrable if it involves the use of:
 - the country name of Jamaica or abbreviations or homonyms thereof, the map of Jamaica or national colours of Jamaica, unless the Office is satisfied that such use is not likely to mislead the public as to the existence of a connection between the origin, nature or quality of the articles to which the design is to be applied and the country Jamaica (JM-A-83.7.b)
 - the name of another country, or abbreviations or homonyms thereof, unless the Office is satisfied that such use is not likely to mislead the public as to the existence of a connection between the origin, nature or quality of the articles to which the design is to be applied and the relevant country (JM-A-83.7.c)

Trademarks and other distinctive signs

- In CU, a design shall not be registered if it incorporates a *distinctive sign* which is the subject of a pending application for a related registration or of a registration in favour of another person, the filing date of which is prior to the filing date of the application for registration of the industrial design (CU-A-92.d)
- In DO, an industrial design incorporating a trade mark or other distinctive sign previously protected in the country whose owner has the right, by virtue of such protection, to prohibit the use of the sign in the registered design, shall not be protected (DO-A-55)
- In JM, a design is not registrable if it involves the use of:
 - a trade mark registered in JM, unless consent is obtained from the trade mark owner (JM-A-83.7.g)
 - an unregistered trade mark or other sign used in the course of trade in JM, unless consent is obtained from the trade mark owner (JM-A-83.7.f);

Works protected by copyright in favour of another person

- In CU, a design shall not be registered if it constitutes a work protected by copyright in favour of another person (CU-A-92.e)
- In DO, an industrial design that involves an unauthorised use of a work protected in the country by copyright shall not be protected (DO-A-55)
- In JM, a design is not registrable if it involves the use of a copyright work, unless consent is obtained from the copyright owner (JM-A-83.7.h)

Name or portrait of an individual

- In BS, where the name or portrait of a living person appears on a design, the Office shall be furnished, if it so requires, with consent from such person before entering a claim for design copyright in respect thereof in the Deposit List. In the case of a person recently dead the Office may call for consent from his personal representative before entering in the Deposit List a claim for design copyright in a design on which the name or portrait of the deceased person appears. (BS-R-66)
- In JM, a design is not registrable if it involves the use of the image or likeness of an individual, unless consent is obtained from the individual (JM-A-83.7.i)

Traditional Knowledge and Traditional Cultural Expressions

- In JM, a design is not registrable if it involves the use of the traditional knowledge or traditional cultural expressions of indigenous or local communities, unless authorization is obtained from the relevant community or where it is not practicable to obtain such authorization the Office is satisfied that such use is not likely to mislead the public as to the existence of a connection between the origin, nature or quality of the articles to which the design is to be applied and the relevant community (JM-A-83.7.j)

Non-visible components

- In CU, a design shall not be registered if it relates to a component part of a complex product which, being incorporated in that product, is not visible, unless the component part itself constitutes a separate product (CU-A-92.a)

Spare parts

- In CU, a design shall not be registered if it relates to the exact shape or dimension of a product, enabling it to be mechanically connected to another product placed inside, around or attached to it, so that each of them can perform its function (CU-A-92.b)
- In DO, an industrial design shall not be protected which consists of a form the exact reproduction of which is necessary to allow for the product incorporating to be mechanically mounted or connected to another product of which it constitutes an integral part (DO-A-55)

3. RIGHTS AND SCOPE OF PROTECTION

3.1 Right to an industrial design

Right to an industrial design created independently

All the laws of CS that were analysed provide that the right to an industrial design created independently belongs to the *creator, author* or *designer* (AG-A-5.1) (BS-A-32.1) (BB-A-6.1) (BZ-A-4.1) (CU-A-6.1) (DM-A-4.1) (DO-A-56.1) (JM-A-95.1) (LC-A-5.1) (VC-A-5.1) (TT-A-5.1)

Right to an industrial design created in pursuance of a commission

In BS, BB and JM, where a design is created in pursuance of a commission, the *person who commissioned the design* is the first owner of any design right in it (BS-A-32.1) (BB-A-7.1) (JM-A-95.2)

Right to an industrial design created in the course of employment or under a contract of service

- All the laws of CS that were analysed provide that, where an industrial design is created in execution of a contract of employment, the right to the industrial design shall belong to the *employer*, in the absence of contractual provisions to the contrary (AG-A-5.5) (BS-A-32.1) (BB-A-7.1, 7.2) (BZ-A-4.5) (CU-A-11.1) (DM-A-4.5) (DO-A-56.2) (JM-A-95.3) (LC-A-5.5) (VC-A-5.5) (TT-A-5.5)
- The law of JM specifies however that, whenever an employee is not required to engage in the creation of designs, he shall be the first owner of a design provided that he has created that design without making use of any information or means put at his disposal by his employer (JM-A-95.4)

- In BB, CU and JM, where an employee who is not required to engage in any creative activity, creates an industrial design by the use of information or means that his employer puts at his disposal, the right to the design belongs to the employer (BB-A-7.2) (CU-A-11.1) (JM-A-95.5); however, the employee is entitled to
 - remuneration calculated after due regard is given to the amount of his salary and the economic importance of the industrial design he created (BB-A-7.3)
 - compensation calculated with due regard given to the economic importance of the design the employee created (JM-A-95.6, 95.7)
 - participation in the economic benefits that the employer may have actually obtained from the exploitation of the created design (CU-A-11.3, R-99, 100)

Joint designers

- Most laws provide that, if two or more persons have jointly created an industrial design, the right to registration of that design shall belong to them jointly (AG-A-5.2) (BB-A-6.2) (BZ-A-4.2) (CU-A-7.1) (DM-A-4.2) (DO-A-56.1) (LC-A-5.2) (VC-A-5.2) (TT-A-5.2). The law of BB clarifies that no right is acquired by a person who only assisted in the creation of an industrial design if his assistance did not amount to a contribution of a creative nature (BB-A-6.2).
- In VC, when a design is created by several persons and one or more of them refuses to make an application in respect of the design, or the whereabouts of one or more of the creators cannot be ascertained after a diligent inquiry, the other creators may make an application in respect of that design. If the Office is satisfied, by an affidavit setting out the relevant facts, that the creators missing from the application refuse to make application or cannot be located, the creators making the application are entitled to register the design if all other requirements of the Act and Regulations are complied with (VC-R-33).

Same industrial design created independently

- The laws of AG, CU, DM, LC, VC and TT provide that, if and to the extent to which two or more persons have created the same industrial design independently of each other, the person whose application has the earliest filing date or, if priority is claimed, the earliest validly claimed priority date, shall have the right to register the industrial design, as long as the application is not withdrawn, abandoned or rejected (AG-A-5.3) (CU-A-7.2) (DM-A-4.3) (LC-A-5.3) (VC-A-5.3) (TT-A-5.3)

Assignment or transfer of the right to registration

- The right to the registration of an industrial design may be assigned, or may be transferred by succession (AG-A-5.4) (BB-A-6.1) (BZ-A-4.4) (CU-A-8.1) (DM-A-4.4) (DO-A-56.1) (LC-A-5.4) (VC-A-5.4) (TT-A-5.4). The law of BS specifies that the right to registration may also be vested by operation of law on a person other than the original proprietor (BS-A-32.2).

3.2 Right of the creator to be named as such

- The laws of AG, BZ, DM, DO, LC, VC and TT provide that the creator shall be named as such in the registration of the industrial design, unless in a special written declaration signed by him and addressed to the Registrar where he indicates that he wishes not to be named (AG-A-5.6) (BZ-A-4.6) (DM-A-4.6) (DO-A-56.3) (LC-A-5.6) (VC-A-5.6) (TT-A-5.6). Any promise or undertaking by the creator made to any person to the effect that he will make such a declaration indicating that he wishes not to be named as such in the registration of the industrial design, shall be without legal effect (AG-A-5.7) (BZ-A-4.7) (DM-A-4.7) (DO-A-56.3) (LC-A-5.7) (VC-A-5.7) (TT-A-5.7)
- In BB, when an industrial design is being registered, the creator of the design is entitled to have his name and address entered on the register as being that of the creator of the industrial design. Any agreement that would have the effect of waiving or avoiding that obligation is void (BB-A-13.1 and 13.2)
- In CU, in all cases, the author of a design has the right to be recognized as such and to be named in the registration and relevant publications and documents (CU-A-14).

3.3 Scope of Protection

3.3.1 Rights conferred by registration

The TRIPS Agreement prescribes that the owner of a protected industrial design shall have the right to prevent third parties not having the owner's consent from making, selling or importing articles bearing or embodying a design which is a copy, or substantially a copy, of the protected design, when such acts are undertaken for commercial purposes. (TRIPS, Art. 26.1)

The EPA prescribes that the owner of a protected industrial design shall have the right to prevent third parties not having the owner's consent from making, offering, selling, importing, stocking or using articles bearing, or embodying the protected design when such acts are undertaken for commercial purposes, or unduly prejudice the normal exploitation of the design or are not compatible with fair trade practice. (EPA, Art. 146. D.1)

In the CARIFORUM region,

- The laws of AG, BZ, DM, LC, VC and TT prescribe that:
 - the owner of a registered design shall have the *exclusive right to make, sell, import or otherwise distribute* in the country, for commercial purposes, any article bearing or embodying the design (DM-A-10.2) (BZ-A-10.2)
 - the exploitation of a registered industrial design in the country by persons other than the registered owner shall require the agreement of the latter (AG-A-10.1) (BZ-A-10.1) (DM-A-10.1) (LC-A-9.1) (VC-A-9.1) (TT-A-9.1)
 - the term “exploitation” means the *making, selling, importing (or otherwise distributing) for commercial purposes*, of articles bearing or embodying a design which is a copy, or substantially a copy of the industrial design (AG-A-10.2) (BZ-A-10.3) (DM-A-10.3) (LC-A-9.2) (VC-A-9.2) (TT-A-9.2)
 - the owner of a registered industrial design shall, in addition to any other rights, remedies or actions available to him, have the right to institute court proceedings against any person who infringes the industrial design by performing, without his agreement, any of the acts referred to above or who performs acts which make it likely that infringement will occur (AG-A-10.4) (LC-A-9.4) (VC-A-9.4) (TT-A-9.4)
- The law of BS prescribes that design copyright in a design is infringed by any person who, without the consent of the proprietor (a) *makes*, according to the design, or a design not substantially different therefrom, an article for which the design is deposited, or *applies* the design, or a design not substantially different therefrom, to an article for which the design is deposited, by copying the design directly or indirectly; (b) *imports for sale or for use* for the purposes of any *trade or business, sells, hires, offers or exposes for sale* an article in the country, if to his knowledge the article was produced or had a design applied to it, in infringement of the design copyright or would have been so produced or had a design so applied, if the production or application had taken place in the country (BS-A-35.1)

- The laws of BB and JM prescribe that the registration of an industrial design gives the owner the *exclusive right* [JM: to exploit the design and] to prevent other persons from performing any of the following acts: a) reproducing the design in the *manufacturing* of a product; (b) *importing, offering for sale, or exposing for sale, or selling*, a product in or by which the industrial design is reproduced; or (c) *stocking* any product described in paragraphs (a) or (b) for the purpose of sale (BB-A-5.1) (JM-A-96.1). The exclusive right can be exercised against the reproduction of an industrial design by another person even where such reproduction differs from the protected industrial design in minor respects, or where it concerns a type of product that is different from the protected industrial design (BB-A-5.2) (JM-A-96.2). The law further provides that the registered owner of a design may bring proceedings in respect of any act done without his consent which constitutes the exploitation of the design or which makes it likely that such exploitation will occur. The term section "exploitation" means making, selling, importing or otherwise distributing for commercial purposes, articles incorporating the design (JM-A-96.3, 96.5)
- The law of CU prescribes that the registration of an industrial design confers on its holder the right to prevent third parties not having his consent from *making, selling or importing* articles bearing or incorporating a design which is a copy, or substantially a copy, of the protected design, where such acts are carried out for commercial purposes. The right of the holder of the registered design extends to any other design which does not produce on an informed person a different overall impression (CU-A-108).
- The law of DO prescribes that the protection of an industrial design confers on its owner the right to *exclude third parties from exploiting* the industrial design. By virtue, thereof, the owner has the right to take action against any person who, without his or her authorisation, manufactures, sells, offers for sale or uses, or imports or stores for any of these purposes, a product that reproduces or incorporates the protected industrial design, or the appearance of which gives a general impression identical to that of the protected industrial design. The performance of any of those acts is not considered lawful merely because the reproduced or incorporated design is applied to a type or kind of product different from those indicated in the registration of the protected design. (DO-A-59).

3.3.2 Limitations to the rights conferred

Exhaustion of design rights

The principle of exhaustion of intellectual property rights is applied differently in different jurisdictions. Whereas some laws provide for the national or regional exhaustion of rights, others provide for international exhaustion. The TRIPS Agreement prescribes specifically that, for the purposes of dispute settlement under the Agreement, nothing in the Agreement shall be used to address the issue of the exhaustion of intellectual property rights (TRIPS, Article 6), which means that WTO Members are free to provide for the system of exhaustion of IP rights that they consider more suitable to their interests.

In the CARIFORUM region, seven countries (AG, BB, BZ, DM, LC, VC and TT) provide for the *national* exhaustion of design rights, whereas another three (CU, DO and JM) provide for their *international* exhaustion.

National exhaustion of design rights

- The laws of AG, BZ, DM, LC, VC and TT, specify that the rights conferred by registration of an industrial design shall not extend to acts in respect of articles which have been put on the market *in the country* by the registered owner of the industrial design or with his consent (AG-A-10.3) (BZ-A-10.4) (DM-A-10.4) (LC-A-9.3) (VC-A-9.3) (TT-A-9.3)
- The law of BB, specifies that the industrial design rights do not extend to acts done in respect of a product embodying the protected industrial design after the product has been lawfully sold in BB. The expression “lawfully sold” means that the product has, with the consent of the registered owner of the industrial design, been imported into BB for sale in BB or has been purchased, with the consent of the registered owner of the industrial design, for sale or use in BB (BB-A-5.3, 5.4)

International exhaustion of design rights

- In CU, the rights of the right holder do not extend to acts done by a third person in relation to the registered design after it has been put on the market *in any territory* by the right holder or by another person with his consent or with economic connections with him (CU-A-110).
- In DO, the industrial design does not give the right to prevent the sale, lease, use, usufruct, importation or any form of commercialisation of a product protected by the industrial design, once the said product has been placed on the market *of any country*, with the consent of the owner or of a licensee or in any other lawful manner. Products that infringe industrial property rights are not considered to have been lawfully put on the market (DO-A-30, 69)

- In JM, the rights conferred by the registration of a design, shall not extend to an act in respect of an article which has been put on the market *in any country* by the owner of the registered design or with the consent of the owner (JM-A-96.4).

Other limitations of rights

- The law of BB specifies that the rights vested in the owner of an industrial design by registration of an industrial design protect only against acts done for industrial or commercial purposes (BB-A-5.3)
- In CU, the rights conferred by registration do not extend to acts done (a) exclusively for teaching purposes; or (b) privately and for non-commercial purposes (CU-A-109.). The exploitation of the design may not be carried out in a manner contrary to the law, social interests, morality or public order and is subject to any prohibitions or limitations, temporary or permanent, laid down or to be laid down in other legal provisions (CU-A-111)
- In DO, the industrial design does not give the right to prevent (a) acts done privately and for non-commercial purposes; (b) acts done exclusively for the purposes of teaching or scientific or academic research (DO-A-30, 69). The protection of an industrial design shall not extend to those elements or features of the design (a) which are determined solely for the purpose of performing a technical function, and do not incorporate any arbitrary contribution by the designer, or (b) the reproduction of which is necessary to enable the product incorporating it to be mechanically assembled or connected with another product of which it forms an integral part (DO-A-60)
- In JM, the right in a registered design is not infringed by: (a) an act which is done privately and for purposes which are not commercial; (b) an act which is done for experimental purposes; (c) an act of reproduction for teaching purposes or for the purpose of making citations, provided that the act of reproduction is compatible with fair trade practice, does not unduly prejudice the normal exploitation of the design, and is accompanied by mention of the source; (d) the use of equipment on ships or aircraft which are registered in another country but which are temporarily in JM; (e) the importation into JM of spare parts or accessories for the purpose of repairing such ships or aircraft; or (f) the carrying out of repairs on such ships or aircraft (JM-A-97.2).

4. REGISTERED AND UNREGISTERED DESIGNS – TEXTILE DESIGNS – RELATIONSHIP TO COPYRIGHT

4.1 Registered designs

The EPA prescribes that protection for industrial designs shall be provided by registration and shall confer exclusive rights upon their holders in accordance with the EPA provisions (EPA, Art. 146.B.4)

- The laws of the 11 CARIFORUM States analysed in this document provide for industrial design protection through registration (or deposit, in the case of BS).

4.2 Unregistered designs

The EPA prescribes that unregistered designs may be protected by a design right or copyright (EPA, Art. 146.B.4). Unregistered designs shall confer the same exclusive rights as registered designs but only if the contested use results from copying the protected design. (EPA, Art. 146.B.4). For unregistered designs, the contested use shall not be deemed to result from copying the protected design if it results from an independent work of creation from a designer who may be reasonably thought not to be familiar with the design made available to the public by the holder (EPA, Art. 146.D.2). The duration of protection available in the EC Party and the Signatory CARIFORUM States for unregistered designs shall amount to at least three years as from the date on which the design was made available to the public in the respective territory (EPA, Art. 146.E.2).

- The industrial design laws of the 11 CARIFORUM States analysed in this document do not provide for the protection of unregistered designs by a design right. However, in these CS unregistered designs enjoy protection under copyright law.

4.3 Textile designs

The TRIPS Agreement prescribes that each Member shall ensure that requirements for securing protection for textile designs, in particular in regard to any cost, examination or publication, do not unreasonably impair the opportunity to seek and obtain such protection. Members shall be free to meet this obligation through industrial design law or through copyright law (TRIPS, Art. 25.2).

The EPA prescribes that textile designs may be protected by a design right or copyright (EPA, Art. 146.B.4)

- In the CARIFORUM region, the industrial design laws analysed in this document do not contain any specific provision regarding the protection of textile designs. This is without prejudice to the protection conferred to textile designs under *copyright law*.

4.4 Relationship to copyright

The EPA prescribes that a design protected by a design right registered in one of the Parties or a Signatory CARIFORUM State in accordance with EPA Article 146 shall also be eligible for protection under the law of copyright of that Party or Signatory CARIFORUM State as from the date on which the design was created or fixed in any form (EPA, Art. 146.F).

- Regarding the relationship between registered designs and copyright, the industrial design laws of the CARIFORUM States do not contain any provision excluding registered industrial designs from copyright protection. Moreover, the laws of BB and DO specifically provide as follows:
 - BB: the exclusive rights vested in the registered owner of an industrial design do not affect any right acquired in the industrial design under the Copyright Act, 1981, or under any other enactment or at common law (BB-A-8.a)
 - DO: the protection conferred on an industrial design under this law does not exclude or affect the protection that may be granted to the same design under other legal provisions, in particular those relating to copyright (DO-A-54)

5. APPLICATION FOR REGISTRATION

5.1 Filing systems – Forms

Most IP Offices around the world accept industrial design applications on paper, delivered to the Office by hand or by mail. A growing number of Offices around the world provide for the electronic filing of industrial design applications through a dedicated interface on their websites. Several still accept filings by telefacsimile (very few by e-mail), provided that the original is received by the Office within a given period.

Under the Hague System, WIPO favours the direct filing of international applications at the International Bureau through the eHague e-filing interface (<https://hague.wipo.int/#/landing/home>). However, it continues to accept the filing of international applications on paper (DM/1 form), either through the IP Office of the applicant, or delivered at the WIPO address by hand or by mail, through a postal or other delivery service. Telefacsimile filings are no longer accepted since January 1, 2019. E-mail filings were never accepted.

As provided for in Rule 7.1 of the Hague Regulations, international applications on paper form shall be presented on the official form (DM/1), which may be downloaded from the following address: https://www.wipo.int/export/sites/www/hague/es/forms/docs/form_dm_1.pdf.

In the CARIFORUM countries, all the IP Offices accept industrial design applications filed on paper and delivered to the Office by hand. Most of them accept applications on paper delivered by post mail. In AG, an application may also be filed by telefacsimile or by electronic mail, provided that the original is filed within one month. In BZ, an applicant may use an electronic application form when submitting an industrial design application to the Office and may use an electronic signature to sign the electronic application form (BZ Administrative Instructions N°8 of 2006). In CU, the application may be filed electronically, in which case the applicant will benefit of a fee reduction.

(AG-R-9.1) (BS-R-58.1) (BB-R-10, 11) (BZ-A-5.1, R-10, 11) (CU-A-100, R-2.1) (DM-A-5.1, R-10) (JM-A-85.1, R-13) (LC-R-4, 11) (VC-R-9, 10) (TT-R-4, 9)

The application for registration shall be filed in a prescribed form or in a replica of the form that contains the information required by the form and is acceptable to the Office.

5.2 Language

The IDLP Draft Articles (SCT/35/2) prescribe that an IP Office may require that any communication be in a language admitted by it. If a communication is not in a language admitted by the Office, the Office may require that a translation of that communication by an official translator or a representative, into a language admitted by the Office, be supplied within a reasonable time limit. It may further require that any translation of a communication be accompanied by a statement that the translation is true and accurate. (Article 10.2)

Under the Hague System, the international application filed directly with WIPO shall be in English, French or Spanish, at the choice of the applicant. (Hague Regulations, Rule 6)

Regarding languages, the laws and regulations in the CARIFORUM region provide as follows:

- In AG, BS, BB, BZ, DM, LC, VC and TT, industrial design applications shall be in English. Any document in a language other than English shall be accompanied by an English translation, verified by affidavit (AG, BS, BB, BZ, VC), or verified by the translator that the translation is to the best of his knowledge complete and faithful (DM, LC, TT) – (AG-R-5) (BS-R-28.2) (BB-R-14) (BZ-R-14) (DM-R-11) (LC-R-5) (VC-R-13) (TT-R-5)
- In CU, the application shall be in Spanish. Any document in a language other than Spanish shall be accompanied by a translation into Spanish. Any translation shall be accompanied by a statement that the translation is true and accurate (CU-A-48.2, 121).

5.3 Applicant

The IDLP Draft Articles (SCT/35/2) indicate that the law may require that the application be filed in the name of the creator of the industrial design; if so, such requirement shall be satisfied if the name of the creator is indicated, as such, in the application, and: (i) that name corresponds to the name of the applicant, or (ii) the application is accompanied by, or contains, a statement of assignment from the creator to the applicant, signed by the creator of the industrial design (Article 7)

Regarding the applicant, the laws in the CARIFORUM region provide as follows:

- In AG, BZ, CU, DM, LC, VC and TT, where the applicant is not the creator, the request shall be accompanied by a statement justifying the applicant's right to the registration of the industrial design (AG-A-6.3, R-9.3) (BZ-A-5.4) (CU-R-39.b) (DM-A-5.4) (LC-A-6.3) (VC-A-6.3) (TT-A-6.3, R-9.3)
- In DO, any natural person or legal person may be the applicant for registration of an industrial design. If the applicant is not the designer, the application shall indicate how the right to obtain the registration was acquired. (DO-A-61)

5.4 Content of the application

Industrial design laws and regulations around the world provide for quite different requirements regarding the content of industrial design applications. In an effort to promote a certain degree of harmonization in this area, the WIPO Standing Committee SCT has been working towards agreeing on a list of maximum requirements regarding the content of such applications. In the context of preparatory work towards a Design Law Treaty (DLT), the SCT drew up a list of 26 indications or elements that an application may be required to contain, as reflected in the WIPO documents containing Draft Articles (SCT/35/2) and Draft Regulations (SCT/35/3) on Industrial Design Law and Practice (IDL).¹

The laws and regulations in the CARIFORUM States require that the industrial design application contain some, or all, of the following 22 indications or elements (all of which are included in the above-mentioned list of 26 indications or elements drawn up by the SCT):

- (i) a request for registration (AG-A-6.1) (BB-A-12.1) (BZ-A-5.1.a) (CU-A-96.1.a, R-38.a) (DM-A-5.1.a) (DO-A-63)-(JM-A-85.2.a)(LC-A-6.1) (VC-A-6.1) (TT-A-6.1)
- (ii) the name and address of the applicant (AG-R-9.2) (BS-A-33.1) (BB-A-12.1) (CU-R-38.d) (DO-A-63) (LC-R-11.2) (TT-R-9.2)
- (iii) the nationality and residence of the applicant (AG-R-9.2) (CU-R-38.d) (LC-R-11.2) (TT-R-9.2)
- (iv) the name and address of the creator of the industrial design (AG-R-9.3) (CU-R-38.g) (DO-A-63) (TT-R-9.3)
- (v) a statement that the creator believes himself/ herself to be the creator of the industrial design (AG-R-9.3) (BB-A-13.3) (CU-R-38.f) (TT-R-9.3)
- (vi) where the applicant is not the creator, a written statement justifying the applicant's right to registration (AG-A-6.3, R-9.3) (BZ-A-5.4) (CU-R-39.b) (DM-A-5.4) (LC-A-6.3) (VC-A-6.3) (TT-A-6.3, R-9.3)

¹ In 2016, the SCT reached consensus to include eight such indications or elements in IDLP Draft Article 3.1, 16 additional indications or elements in IDLP Draft Rule 2.1, and two additional indications in IDLP Draft Rule 2.2 (regarding divisional applications). No consensus was reached at that time to include a requirement of "disclosure of the origin or source of traditional cultural expressions, traditional knowledge or biological/genetic resources utilized or incorporated into the industrial design", a proposal which was supported by several SCT delegations but not all, and which therefore remained as part of IDLP Draft Article 3.1 but within brackets.

- (vii) where the applicant has a representative, the name and address of that representative (AG-R-9.4) (CU-R-39.a)
- (viii) an address for service (AG-R-19) (LC-R-21) (TT-R-19) where the applicant resides outside the country (BB-A-12.2.b) (JM-A-120, R-10)
- (ix) a representation of the industrial design (AG-A-6.1) (BZ-A-5.1.b) (CU-A-96.1.c) (DM-A-5.1.b) (DO-A-63) (JM-A-85.2.b) (LC-A-6.1) (VC-A-6.1) (TT-A-6.1) (see more details regarding representation, below)
- (x) an indication of the product or products which incorporate the industrial design, or in relation to which the industrial design is to be used (AG-A-6.1) (BS) (BB-A-12.2.d) (BZ-A-5.1.c) (CU-A-96.1.a, R-38.b) (CU-R-38.b) (DM-A-5.1.c) (DO-A-63) (JM-A-85.2.c) (LC-A-6.1) (VC-A-6.1) (TT-A-6.1)
- (xi) an indication of the class (and subclasses) of the Locarno Classification to which belongs the product which incorporates the industrial design, or in relation to which the industrial design is to be used (DO-A-63) (JM-A-85.2.c)
- (xii) a description of the industrial design, which indicates in a clear and precise form the subject matter for which protection is claimed (CU-A-96.1.b)
- (xiii) a statement of originality of the design (BS-A-33.1.c)
- (xiv) a claim, indicating whether copyright is claimed in the whole or part of the design shown in the representation, and if in part, indicating which part or parts, and also whether copyright is claimed in shape, configuration, pattern or ornament (BS-A-33.1.c)
- (xv) where the application includes more than one industrial design, an indication of the number of industrial designs included (BB-A-15) (CU-R-38.c)
- (xvi) where the applicant wishes to maintain the industrial design unpublished for a period of time (deferment of publication), a request to that effect (AG-A-6.5) (BZ-A-5.6) (CU-A-101.2) (DM-A-5.6) (JM-A-85.3) (LC-A-6.8) (VC-A-6.8) (TT-A-6.8)
- (xvii) at the request of the Office, an indication of any prior application or registration, or other information, of which the applicant is aware, that could have an effect on the eligibility for registration of the industrial design (JM-A-13, 89)
- (xviii) where the applicant wishes to take advantage of the priority of an earlier application, a declaration claiming the right of priority of that earlier application (AG-A-7.1) (BB-A-16.1) (BZ-A-6.1) (CU-A-96.1.d, R-39.d) (LC-A-6.4) (VC-A-6.4) (TT-A-6.4)
- (xix) where the applicant wishes to take advantage of Article 11 of the Paris Convention, evidence that the product or products which incorporate the industrial design or in relation to which the industrial design is to be used have been shown at an official, or

- officially recognized, international exhibition – the date of the exhibition and the name of the country where it took place (CU-R-39.e)
- (xx) where an application is to be treated as a divisional application, an indication to that effect (CU-R-39.f)
 - (xxi) where an application is to be treated as a divisional application, the number and filing date of the initial application (CU-R-39.f)
 - (xxii) evidence that the payment of the prescribed application fee has been made (AG-A-6.7) (BZ-A-5.2) (CU-A-96.2, R-38.j) (DM-A-5.2) (DO-A-63) (JM-A-85.1) (LC-A-6.10) (VC-A-6.10) (TT-A-6.10)

In addition to those requirements, Cuba also requires that, where the applicant is the author (creator) and he or she has created the industrial design within the framework of an employment relationship, the applicant should indicate that the entity is not interested in making the corresponding application for registration. (CU-R-39.c)

The industrial design application shall be signed by the applicant or an authorised agent. (AG-R-9.1) (BB-R-Schedule II- Form 1) (BZ-Form 1) (CU-A-3, R-38.i) (LC-R-11.1)

When the application is made by an agent, it must be accompanied by a power of attorney authorising the agent to make the application (BB-A-12.3) (BZ Form 3) (CU-A-96.1.f). The authorisation of agent may be filed together with the application or within two months from its filing date. (AG-R-8.2)

5.5 Representation of the design

The representation of the industrial design determines, alone or along with other elements of the application, the scope of the protection conferred by the industrial design. It is generally agreed that the industrial design should be represented in such a way as to completely disclose its appearance. In most jurisdictions, the laws and regulations prescribe in quite detail the requirements for the representation of the industrial design, which may include representation in the form of photographs, graphic reproductions, any other visual representation (e.g., specimens, computer-animated representations, etc.), or a combination of any of the above.

The Hague System prescribes very clear requirements regarding the representation of industrial designs in international registrations. The relevant requirements are provided for in the Hague

System Common Regulations (Rules 9 and 10) and Administrative Instructions (AI Sections 401 to 406. A special chapter in the Hague System User's Guide, (<https://www.wipo.int/hague/en/guide/reproduction.html>) provides detailed information on how to prepare reproductions to accompany the international application.

In recent years, several IP Offices have made public documents describing their practice in assessing whether the graphical representation of an industrial design allows full disclosure. This is the case, for example, of the Offices taking part in the European Union Intellectual Property Network (EUIPN), including the European Union Intellectual Property Office (EUIPO), the Benelux Office (BOIP), and the national offices of EU Member States, which have adopted and apply a Common Practice on the Graphical Representation of a Design (CP6), which has also been adopted and is applied by the national IP Offices of Iceland, Norway, United Kingdom and Turkey (see <https://www.tmdn.org/network/graphical-representations>). Similar practices have been adopted and published by other industrial property offices, such as the IP Offices of Georgia and Uruguay.²

In the CARIFORUM region, a similar Practice Fiche on the Graphic Representation of Designs in (selected) CARIFORUM offices was prepared and published as a result of joint efforts of the IP Offices of Antigua and Barbuda, Belize, Cuba, Dominica, Dominican Republic, Jamaica, Suriname, and the EUIPO, under the CarIPI project. This fiche provides guidance for design applicants and examiners on the use of visual disclaimers, types of views and how to represent designs on a neutral background. This practice is generally subscribed by the participating CARIFORUM Offices. The full text of this Practice Fiche can be consulted at (<https://internationalipcooperation.eu/en/caripi/news/practice-fiche-graphic-representations-designs-selected-cariforum-ip-offices>) and is attached as **Annex B** to this document.

The paragraphs below provide information regarding industrial design representation requirements in the CARIFORUM region, based on the provisions of the relevant design laws and regulations, as well as on the practice and recommendations by CARIFORUM IP Offices as reflected in the

² *Within the context of the Hague System, WIPO has also published a document on “Guidelines for the preparation and supply of reproductions to prevent possible refusals by Examining Offices on grounds of insufficient disclosure of an industrial design” (https://www.wipo.int/export/sites/www/hague/es/how_to/pdf/guidance.pdf). This document, updated in June 2020, was prepared in consultation with the Offices of Canada, Hungary, Israel, Japan, Republic of Korea, Republic of Moldova, Mexico, Romania, Russian Federation, Syrian Arab Republic and United States of America, and contains recommendations concerning the preparation and furnishing of reproductions when any of these countries is designated in an international application.*

above-mentioned Practice Fiche. It also provides information on related design representation requirements as provided for in the IDLP Draft Regulations (SCT/35/3) and in the Hague System Rules and Administrative Instructions (AI).

Form of the representation

The IDLP Draft Regulations (SCT/35/3) prescribe that the representation of the industrial design shall, at the option of the applicant, be in the form of: (i) photographs; (ii) graphic reproductions; (iii) any other visual representation admitted by the Office; (iv) a combination of any of the above.

Under the Hague System, reproductions of the industrial design shall, at the option of the applicant, be in the form of photographs or other graphic representation of the industrial design itself or of the product or products which constitute the industrial design (Rule 9.1.a). One and the same international application may comprise both photographs and other graphic representations, in black and white or in colour (AI Section 401.a).

- In AG, BZ, CU, DM, DO and JM, it is recommended that a design should be represented using only one visual format (drawing, photograph) so as to avoid disclosing aspects that may contribute to a different overall impression (see Practice Fiche, section 2.2.h), in Annex B)
- In BZ, the Office prefers the supplying of photographs by applicants, rather than drawings or a specimen of the article containing the industrial design (BELIPO website)

Number of copies

The IDLP Draft Regulations (SCT/35/3) prescribe that no more than one copy of the industrial design shall be required where the application is filed electronically, and no more than three copies where the application is filed on paper. (Rule 3.4)

The Hague System Administrative Instructions provide that each reproduction accompanying an international application shall be submitted in a single copy. (AI Section 401.b)

- AG, LC, and TT require four graphic representations, drawings or tracings for each two-dimensional design; and four graphic representations, drawings or tracings of each of the

different sides of the design, for each three-dimensional design. (AG-R-10.1) (LC-R-12.1) (TT-R-10.1)

- BS requires, in connection with each claim for design copyright, three identical representations of the design in a form satisfactory to the Office or, at the Office's option, three specimens. (BS-R-60)

Views

The IDLP Draft Regulations (SCT/35/3) prescribe that: (a) the industrial design may, at the option of the applicant, be represented by one view that fully discloses the industrial design, or by several different views that fully disclose the industrial design; (b) additional, specific views may be required by the Office where such views are necessary to fully show the product or products that incorporate the industrial design or in relation to which the industrial design is to be used. However, additional views disclosing new matter affecting the industrial design, which are not derivable from the original view or views, do not have to be admitted. (Rule 3.3)

Under the Hague System, the same product may be shown from different angles; views from different angles shall be included in different photographs or other graphic representations (Rule 9.1.a). No Contracting Party may require more than one view where the industrial design or product is two-dimensional, or more than six views where the product is three-dimensional (Rule 9.3.b). Subject to that rule, any Contracting Party to the Geneva (1999) Act which requires certain specified views of the product or products which constitute the industrial design or in relation to which the industrial design is to be used shall, in a declaration, so notify the Director General, specifying the views that are required and the circumstances in which they are required (Rule 9.3.a).³

- The Practice Fiche subscribed by the IP Offices of AG, BZ, CU, DM, DO and JM, offers general recommendations and specific guidelines regarding the filing of various types of views, including aspect views (2.2.a), views magnifying part of the design (2.2.b), alternate positions (2.2.c), exploded views (2.2.d), partial views (2.2.e), sectional views (2.2.f), and sequence of snapshots for animated designs. (2.2.g) (see Annex B)
- Regarding three-dimensional designs
 - AG, LC and TT require graphic representations, drawings or tracings of each of the different sides of the industrial design (AG-R-10.1) (LC-R-12.1) (TT-R-10.1)

³ For example, Viet Nam has declared that it requires a perspective view of each three-dimensional design.
Industrial Design Law and Practice in the CARIFORUM
Region

- CU requires at least one perspective view (CU-R-42.2)

Quality – Neutral background - Shading

The IDLP Draft Regulations (SCT/35/3) prescribe that the industrial design shall be represented alone, to the exclusion of any other matter (Rule 3.1.c) and that it may, at the option of the applicant, be in colour or in black and white. (Rule 3.1.b). The representation may include: [...]; (ii) shading, to show the contours or volume of a three-dimensional design (Rule 3.2.ii).

The Hague System requires the reproductions to be of a quality permitting all the details of the industrial design to be clearly distinguished and permitting publication (Rule 9.2). Graphic representations must be of professional standard produced with drawing instruments or by electronic means (AI Section 404.b). The photographs supplied must be of professional standard and have all the edges cut at right angles. Photographs retouched with ink or correcting fluid shall not be allowed (AI Section 404.a). The industrial design must be shown against a neutral plain background (AI Section 404.a). Graphic representations produced by electronic means may be presented on a background, provided that it is neutral and plain and all its angles are right angles (AI Section 404.b). The industrial design represented may comprise shading and hatching to provide relief. (AI Section 404.b)

- The Practice Fiche subscribed by the IP Offices of AG, BZ, CU, DM, DO and JM, contains detailed recommendations regarding the quality of the designs filed in the form of drawings and in the form of photographs (see section 2.4.1 in Annex B)
- The Practice Fiche also describes the criteria used to assess if the representation of the design complies with the requirement of being reproduced with a neutral background. In this respect, it describes the various aspects taken into consideration to assess if a background is neutral, including requirements related to colours, to contrast, and to shadows/reflections (see section 2.3 in Annex B)
- In AG, LC and TT, the Regulations require that drawings and tracings be in black ink (AG-R-10.2) (LC-R-12.2) (TT-R-10)
- In BB, BZ, DM and VC, graphic representations shall be in durable dark lines suitable for reproduction (BB-R-15) (BZ-R-15.a, 15.c) (DM-R-18.1.c) (VC-R-14). Photographs of an article taken against a neutral background may be used in an application instead of graphic representations if the photographs clearly illustrate the design and can be readily reproduced (BB-R-17) (BZ-R-17) (DM-R-18.3) (VC-R-16)

- In BS, each representation of a design which consists of a repeating surface pattern shall show the complete pattern and a sufficient portion of the repeat in length and width (BS-R-64)
- In CU, if photographs are submitted, they must be sufficiently sharp to make it possible to see all the details of the object to be protected and to represent the industrial design on a single neutral background without shadows. (CU-R-45.1). If drawings are submitted, they may be originals or quality copies, made with precise and regular strokes, and the presence of shadows to highlight the reliefs is acceptable (CU-R-46). Representations may not include inscriptions, clarifications, numerals or other objects other than the industrial design in question. Only the colours claimed are to be indicated (CU-R-43).

Elements not accepted in the representation

Under the Hague System, the following elements shall not be accepted in the representation: (i) technical drawings, particularly with axes and dimensions; (ii) explanatory text or legends in the representation (AI Section 402.c).

Disclaimers

The IDLP Draft Regulations (SCT/35/3) prescribe that, notwithstanding the requirement that the industrial design be represented alone, to the exclusion of any other matter, the representation of the industrial design may include: (i) matter that does not form part of the claimed design if it is identified as such in the description and/or it is shown by means of dotted or broken lines. (Rule 3.2.i)

Under the Hague System, in principle, the photographs and other graphic representations shall represent the industrial design alone, or the product in relation to which the industrial design is to be used, to the exclusion of any other object, accessory, person or animal (AI Section 402.a). However, the Hague Regulations accept that certain matter which is shown in a reproduction but for which protection is not sought may be indicated (Rule 9.2.b). Such matter may be indicated (i) in a brief description of the reproduction presented separately, and/or (ii) by means of dotted or broken lines or colouring. (AI Section 403.1)

- The Practice Fiche subscribed by the IP Offices of AG, BZ, CU, DM, DO and JM indicates that graphic or photographic representations showing only the claimed design are preferred.

However, disclaimers can be used when the graphic or photographic representation contains parts of the product for which no protection is sought. Where a disclaimer is used, broken lines are recommended. Only when broken lines cannot be used due to technical reasons, other disclaimers can be used, including colour shading, boundaries and blurring. (see section 2.1 of the Fiche in Annex B)

- In BS, where words, letters or numerals appear in the design, the Office may require the insertion in the claim for design copyright of a disclaimer of any right to their exclusive use. (BS-R-63)

Dimensions

Under the Hague System, the dimensions of the representation of each industrial design appearing in a photograph or other graphic representation must not exceed 16 x 16 centimetres, and in respect of at least one representation of each design, one of those dimensions must be at least 3 centimetres (AI Section 402.b). For the filing of international applications by electronic means, the International Bureau has established a data format to ensure that these maximum and minimum dimensions are respected (see below).

- In AG, LC and TT, graphic representations, drawings or tracings shall not exceed 10x20 centimetres (AG-R-10.2) (LC-R-12.2) (TT-R-10)
- In BS, each representation of a design which consists of a repeating surface pattern shall not be of less size than 7 inches by 5 inches (BS-R-64)
- In BB, BZ, DM and VC, representations shall be on a scale sufficiently large to show the features of the design clearly (BB-R-15.e) (BZ-R-15.e) (DM-R-18.1.e) (VC-R-14.e)

Labels and Numbering

Under the Hague System, when the same industrial design is represented from different angles, the numbering shall consist of two separate figures separated by a dot (e.g., 1.1, 1.2, 1.3, etc. for the first design, 2.1, 2.2, 2.3, etc. for the second design, and so on). The reproductions shall be submitted in ascending numerical order. Legends to indicate a specific view of the product (e.g. "front view", "top view", etc.) may be indicated in association with the numbering of the reproduction. The numbering stipulated for multiple international applications shall appear in the margin of each photograph or other graphic representation. (AI Section 405)

- In BS, each figure shall be designated perspective view, front view, side view, plan or otherwise as the case may be. (BS-R-61)
- In BB, BZ, DM and VC, figures in a representation are to be numbered consecutively without regard to the number of sheets in the representation and so far as possible the figures are to be arranged in numerical order; figures can be continued on subsequent sheets if necessary or several figures can appear on the same page. (BB-R-15.f, 15.g) (BZ-R-15.f, 15.g) (DM-R-18.1.f, 18.1.g) (VC-R-14.f, 15.g)
- In CU, each industrial design shall be identified by an Arabic number; the different views of the same industrial design shall be identified by the same number followed by a decimal figure, as appropriate (CU-R-44). If the design is represented by a photograph, the number, the type of view and the signature of the applicant or his representative shall be inscribed on the back of the photograph. (CU-R-45.2)

Representations filed on paper (support and display)

Under the Hague System, where the application is filed on paper, graphic representations must be produced on good quality white, opaque paper, all of whose edges are cut at right angles (AI Section 404.b). The photographs or other graphic representations shall be either pasted or printed directly onto a separate sheet of A4 paper which is white and opaque. The separate sheet of paper shall be used upright and shall not contain more than 25 reproductions (AI Section 401.c). The reproductions must be arranged in the orientation in which the applicant wishes them to be published. A margin of at least 5 millimetres should be left around the representation of each industrial design (AI Section 401.d). Each reproduction must fall within a right-angled quadrilateral containing no other reproduction or part of another reproduction and no numbering. The photographs or other graphic representations shall not be folded, stapled or marked in any way. (AI Section 401.e)

- The IP Offices of AG, CU, DM, DO and JM, have provided detailed information regarding the quality standards required for applications received on paper (see section 2.4 of their Practice Fiche, in Annex B)
- In AG, LC and TT, the Regulations prescribe that graphic representations, drawings or tracings shall be affixed on four sheets of durable white paper or cardboard of a A4 size (AG-R-10.2) (LC-R-12.2) (TT-R-10)
- In BS, each representation of the design shall be upon paper of the size 13 inches by 8 inches and not on cardboard, and shall appear on one side only of the paper. The figure or

figures shall be placed in an upright position on the sheet. When more figures than one are shown, these shall where possible be on one and the same sheet (BS-R-61). When the representations furnished are drawings or tracings, they shall be in ink, and if on tracing cloth or tracing paper shall be mounted on paper of the size 13 inches by 8 inches (BS-R-62).

- In BB, BZ, DM and VC, graphic representations shall be affixed on strong, durable, white paper or other material suitable for reproduction; on one side of the paper only (BB-R-15) (BZ-R-15.a, 15.c) (DM-R-18.1) (VC-R-14); and shall be free of such folds, breaks or creases as render them unsuitable for reproduction (BB-R-16) (BZ-R-16) (DM-R-18.2) (VC-R-15).

Representations filed electronically

Under the Hague System, any reproduction accompanying an international application filed electronically through the eHague interface shall be in the image formats JPEG or TIFF. Any reproduction shall have a resolution of 300 x 300 dpi ("dots per inch"). A reproduction uploaded with a different resolution is automatically adjusted to have a resolution of 300 x 300 dpi. The interface asks for validation of the adjusted resolution by the applicant. The size of the representation of each industrial design must comply with the parameters indicated above under the paragraph entitled "Dimensions". The file size of each reproduction filed through the eHague interface shall not exceed 2 megabytes. For more details, see https://www.wipo.int/hague/en/how_to/efiling_tutorial/.

Specimens

The IDLP Draft Regulations (SCT/35/3) provide that it would be up to each Office to decide whether to admit, or not to admit, specimens as a form of visual representation of the industrial design (Note R3.02 to Rule 3).

Under the Hague System, the filing of specimens instead of reproductions is only accepted where the application contains a request for deferment of publication and concerns a two-dimensional industrial design (Rule 10). In any case, specimens are accepted only for a limited period of time after which the applicant must submit the corresponding reproduction of the design. Reproductions shall be submitted not later than three months before the expiry of the period for paying the publication fee (period that expires three weeks before the period of deferment expires or is

considered to have expired) (Rule 16.4). The applicant who wishes to submit specimens shall submit one for the International Bureau and one for each designated Office that has notified its wish to receive a confidential copy of the international registration. All the specimens shall be contained in a single package. They may be folded. (Rule 10). A specimen shall not exceed 26.2 centimetres x 17 centimetres in size (unfolded), 50 grams in weight or 3 millimetres in thickness. Specimens shall be pasted on sheets of A4 paper and numbered in ascending numerical order. The same number shall be assigned to each reproduction corresponding to these specimens when submitted to the International Bureau. None of the dimensions of a package containing specimens shall exceed 30 centimetres and the weight of such package and its packing shall not exceed 4 kilograms. Perishable products or products which may be dangerous to store shall not be accepted (AI Section 406).

- In AG, BZ, DM, LC, VC and TT, the application may be accompanied by a specimen of the article embodying the industrial design, where the industrial design is two-dimensional (AG-A-6.2) (BZ-A-5.3) (DM-A-5.3) (LC-A-6.2) (VC-A-6.2) (TT-A-6.2)
- In AG, LC and TT, a specimen shall be of a size not exceeding 20x20x20 centimetres (AG-R-10.2) (LC-R-12.2) (TT-R-10)
- In BS, the application shall be accompanied by a representation or, at the Registrar General's option, a specimen of the design (BS-A-33.1)
- In BB, BZ, DM and VC, the Office may require that a graphic representation or a photograph be provided instead of a specimen when the size and weight of the specimen makes it difficult to process and store it; and, in any event, a specimen must not exceed 1 kilogram in weight or 30 centimetres in any dimension. Specimens that are perishable or made of dangerous material shall not be submitted to the Office. (BB-R-18) (BZ-R-18) (DM-R-18.4, 18.5) (VC-R-17)
- In JM, the application may be accompanied by a specimen embodying the design (JM-A-85.2)

5.6 Classification

The IDLP Draft Regulations (SCT/35/3) prescribe that any IP Office may require that an industrial design application contain an indication of the class of the Locarno Classification⁴ to which belongs

⁴ Classification established by the Locarno Agreement Establishing an International Classification for Industrial Designs, signed at Locarno on October 8, 1968, as revised and amended.

the product which incorporates the industrial design, or in relation to which the industrial design is to be used. (Rule 2.1.i)

Under the Hague System, the products which constitute the industrial designs, or in relation to which the industrial designs are to be used, are classified by the International Bureau in accordance with the Locarno Classification (Rule 1.vii). When filing an international application, the applicant may indicate the Locarno class (optional content) preferably identifying the product or products by using terms appearing in the list of goods of the Locarno Classification (Rule 7.3.iv). In any case, all the products in the international application shall belong to the same class (Rule 7.7) and the relevant class shall be determined by the International Bureau (Rule 15.2.v).

For the purposes of the classification of industrial designs, AG, BZ, CU, DM, DO, JM, LC, VC, and TT apply the International Classification established by the Locarno Agreement of 8 October 1968 (AG-A-2) (BZ-A-2) (CU-A-107) (DM-A-2) (JM-A-81, 85.2.c) (LC-A-2) (VC-A-2) (TT-A-2). The law in DO specifies that the International Classification is applied as revised and updated (DO-A-163).

5.7 Description

The IDLP Draft Regulations (SCT/35/3) prescribe that any IP Office may require that an industrial design application contain a description (Rule 2.1.iv).

Under the Hague System, the applicant is not required to provide a brief description of the reproduction or of the characteristic features of the industrial design that is the subject of the international application unless any of the three countries that have declared that they require such description is designated for protection (1999 Act, Article 5.2.b.ii).⁵ However, the applicant is always free to provide such a description in the international application (DM/1 Form, item 9). If so, only the characteristic features of the industrial design(s) that appear in (a) reproduction(s) should be described. In addition, matter which is shown in a reproduction but for which protection is not sought may be indicated in the description. The description can further disclose the operation or possible use of the industrial design as long as it is not technical. Furthermore, the omission of a

⁵ If the Syrian Arab Republic is designated, a brief description of the reproduction or of the characteristic features of the industrial design is mandatory. If Romania or Viet Nam is designated, a brief description of the characteristic features of the design is mandatory. If the Russian Federation is designated, ROSPATENT recommends that a brief description of the characteristic features of the industrial design be provided.

specific view may be indicated. If the description exceeds 100 words, an additional fee of 2 Swiss francs per word exceeding 100, shall be payable. (Rule 11.2)

In the CARIFORUM region, BZ and CU appear to require a description of the design, as follows:

- In BZ, the application form (Form 1, Regulation 10) requires the applicant to give a short description of the visual features of the designs, indicating what parts of it are original.
- In CU, the description of the industrial design must contain the following information: (a) the title, as entered in the application; b) a reference to the final object to which it is applied; c) the description of the visible parts of the object, in a clear and concise manner, referring to the views characterising the novel features of the object; and (d) if the applicant wishes to claim colour as a distinctive feature of the industrial design, a statement to that effect, as well as the name of each colour claimed and an indication in the parts of the design where each colour appears. The description should not refer to technical aspects, dimensions or size, manufacturing process or materials used, if they do not contribute distinctive elements to the appearance of the object. (CU-R-40)

5.8 Information regarding foreign applications or registrations

The IDLP Draft Regulations (SCT/35/3) prescribe that any IP Office may require that an industrial design application contains an indication of any prior application or registration, or other information, of which the applicant is aware, that could have an effect on the eligibility for registration of the industrial design (Rule 2.1.x).

In the CARIFORUM region,

- In CU, the Office may require the applicant to provide details on prior applications for the same designs filed in other countries and their legal status. The applicant shall indicate the number, date and countries concerned, as well as any objections raised (CU-R-53).
- The law of JM prescribes that an applicant shall upon that applicant's own initiative or, at the request of the Registrar, (1) furnish the Office with the date and number of any foreign application or registration relating to the same or essentially the same design as that claimed in the application filed in JM; and (2) furnish the Office with copies of the following documents relating to the foreign application: (a) any original or notarized communication received by the applicant concerning the result of any search or examination carried out in

respect of the foreign application or registration; (b) the industrial design registered pursuant to the foreign application; (c) any final decision accepting or rejecting the foreign application or refusing the registration of the design requested in the foreign application; (d) any final decision invalidating the industrial design registered pursuant to the foreign application. The applicant may submit comments on any of such documents. If not in English, those documents shall be translated into English and accompanied by the relevant form and prescribed fee, and by a declaration of the translator that to the best of the translator's knowledge, the translation is complete and accurate. (JM-A-13, 89)

5.9 Multiple designs in the same application

The IDLP Draft Articles (SCT/35/2) prescribe that, subject to such conditions as may be prescribed under the applicable law, an application may include more than one industrial design (Article 3.3). For example, the applicable law may prescribe that it accepts multiple applications only where all the designs in the application apply to, or are constituted by, products which belong to the same class of the Locarno Classification, or only where all the designs in the application conform to the requirement of unity of design or unity of invention or when the products to which the design is applied belong to a set or are intended for the same purpose.

Under the Hague Agreement (1999 Act), an international application may include two or more industrial designs (Article 5.4) up to a maximum of 100 (Rule 7.3.v), provided that all the products which constitute the industrial designs to which the international application relates, or in relation to which the industrial designs are to be used, belong to the same class of the Locarno Classification. (Rule 7.7)

In the CARIFORUM region, AG, BB, BZ, CU, DM, DO, JM, LC, VC and TT accept multiple applications subject to the following conditions:

- In AG, BZ, DM, LC, VC and TT, two or more designs may be the subject of the same application, provided that they relate to the same class of the Locarno Classification or to the same set or composition of articles (AG-A-6.4) (BZ-A-5.5) (DM-A-5.5) (LC-A-6.7) (VC-A-6.7) (TT-A-6.7)
- In BB, an application for registration may comprise as many as 50 industrial designs if (a) the products indicated in the application as products to which the industrial designs relate

are of the same kind; or (b) the products to which the industrial designs relate are within the same class (BB-A-15)

- In CU, the application for registration of an industrial design may refer to a single design or to a group of designs included in the same class, up to the number of one hundred (CU-A-99.1)
- In DO, two or more designs may be the subject of the same application provided that the products to which they are applied belong to the same class (DO-A-62)
- In JM, an international application may be made for several designs (not exceeding one hundred in total) provided that the designs referred to therein, belong to the same class of the Locarno Agreement (JM-A-85.7). Each design referred to in the same international application shall be in relation to one single product and belong to one single class and sub-class of the Locarno Agreement (JM-A-85.8).

In BS, where it is desired to claim design copyright for features of shape or configuration in respect of more than one article, a separate claim shall be made in respect of each article (BS-R-59).

5.10 Division of the application

The IDLP Draft Articles (SCT/35/2) provide that, if a multiple application (“initial application”) does not comply with the conditions prescribed by law, the Office may require the applicant, at the option of the applicant, to either: (i) amend the initial application to comply with those conditions; or (ii) divide the initial application into two or more applications (“divisional applications”) that comply with those conditions by distributing among the latter the industrial designs for which protection was claimed in the initial application. Divisional applications shall preserve the filing date of the initial application and the benefit of the claim of priority, if applicable. The division of an application may be subject to the payment of fees. (Article 8)

Under the Hague System, where following a notification of refusal by a designated Office, an international registration is divided before the Office concerned in order to overcome a ground of refusal stated in the notification, that Office shall be entitled to charge a fee in respect of each additional international application that would have been necessary in order to avoid that ground of refusal (1999 Act, Article 13.3). That Office shall notify the International Bureau of the data concerning the division (Rule 18.3), including the numbers of the industrial designs which have

been the subject of the division, and the resulting national or regional application numbers or registration numbers (AI, Section 502).

In the CARIFORUM region, regarding the division of an application, CU and DO provide as follows:

- In CU, the applicant may, at any time, divide his application into two or more separate applications, without, in any case, extending the content of the initial application. The separate applications have the priority date of the initial application and are subject to the payment of the prescribed filing fee. In the case of division of an application, the applicant must file the graphic representations corresponding to each application. Separate applications are processed separately, as if they had been filed in this way from the filing date. However, the publication of the application prior to the division takes effect for each separate application. (CU-A-99.2 to 4). Where an application is divided, either at the request of a party or at the request of the Office, the date of the original application and, where applicable, the priority right claimed, shall be retained as the date of the divisional application. The division may under no circumstances extend the contents of the original application. In the case of the division of industrial design applications, each industrial design shall be independent of the others and shall accrue the annuity corresponding to the initial registration, starting from the last annuity paid at the time of filing the corresponding divisional applications. (CU-A-20.2 to 4)
- In DO, the applicant may divide its application into two or more sub-applications, but no sub-application may expand the disclosure contained in the initial application. Each divisional application shall be attributed the filing date of the initial application. Each divisional application shall bear the fee prescribed for the filing of an industrial design application, and the fee paid for the initial application shall be counted as a credit. (DO-A-18, 69)

5.11 Amendments to the application

- In AG, the Office may correct any clerical error or mistake, or error of translation or transcription, in any application or document filed with the Office, upon receipt of a request in writing and subject to such terms as the Office may consider appropriate (AG-A-18, R-22)
- In BS, the Office may, on request in writing and accompanied by the prescribed fee, correct any clerical error in a claim for design copyright or in the representation of a design, in the

name or address of the proprietor of any design or in any other matter which is entered upon the deposit list of designs (BS-A-49)

- In BB, a document relating to an application may be corrected if the Office is satisfied that the document contains an error of a clerical nature and that its correction would involve no change of substance to the application (BB-R-35)
- In BZ and DM the Office may, upon written request of any interested person, correct any clerical error or error in translation or transcription in the application, or in any document filed in pursuance of the application (BZ-A-19.1) (DM-A-19.1) if it is satisfied that the document contains an error of a clerical nature and that its correction would involve no change of substance to the application (BZ-R-35) (DM-R-37)
- In CU, the amendment or correction of errors of content in the application may only be requested by the applicant prior to its publication; the applicant may amend the content of the description provided that the amendment does not consist of the addition of new matter to that contained in the application as originally filed (CU-A-131). The amendment or correction may concern the inclusion or deletion of authors, if there has been an improper omission or inclusion of authors; a deletion may be made by the Office if the person whose name should be deleted is in agreement (CU-R-92.1); otherwise, the deletion of an author may be made only if it has been ordered by a final decision of a court (CU-A-132). The amendment or correction which is not due to an error attributable to the Office is subject to the payment of a fee (CU-A-133).
- In DO, the applicant may amend or correct his application while it is pending. The amendment or correction of the application shall be subject to the prescribed fee, except in the case of simple formal errors which may be corrected free of charge (DO-A-149.1)
- In JM, the applicant may at any time before the design is registered, make an application to amend the particulars of the application (JM-A-90.3)
- In LC and TT, the Office may correct any error of translation or transcription, clerical error or mistake in any application or document filed with the Office (LC-A-17) (TT-A-17) upon receipt of a request in writing and subject to such terms as it may consider appropriate (LC-R-25) (TT-R-23).
- In VC, the Office may correct any error of translation or transcription, clerical error or mistake in any application or document filed with the Office (VC-A-16) if the Office is satisfied that the document contains an error of a clerical nature and that its correction would involve no change of substance to the application (VC-R-34). When, after an application has been filed, it appears that the names of one or more creators of the design were improperly included in or omitted from the application, then, if the Office is satisfied, by an affidavit

setting out all the relevant facts, that a correction should be made, the Registrar may delete or add, as the case requires, the names of those other creators (VC-R-32).

5.12 Withdrawal of the application

- In AG, BZ, DM, LC, VC and TT the applicant may withdraw his application at any time before the registration of the design (AG-A-6.6) (BZ-A-5.7) (DM-A-5.7) (LC-A-6.9) (VC-A-6.9) (TT-A-6.9). The application may be withdrawn by written declaration submitted to the Office and signed by each applicant (AG-R-12.1) (LC-R-14.1) (TT-R-12.1). The application fee is not refunded if the application is withdrawn (AG-R-12.2) (LC-R-14.2) (TT-R-12.2)
- In BB, BZ, DM and VC, when an application that is filed by joint applicants is being proceeded with by one of the joint applicants, it may not be withdrawn without the written permission of all the other joint applicants (BB-R-31) (BZ-R-31) (DM-R-33) (VC-R-30)
- In CU, an application for registration may be withdrawn by the applicant, in whole or in part, either before or after registration, in writing addressed to the Office. If there is more than one applicant, the withdrawal has to be signed by all (CU-A-58, 114)
- In DO, the applicant may withdraw its application while it is still pending. Withdrawal of an application shall not entitle the applicant to a refund of any fees paid (DO-A-151). In the case of co-applicants, the amendment or withdrawal of the application must be done by all of them (DO-A-136.1.a)
- In JM, an application to register a design, may be withdrawn by the applicant in writing before the application is determined (JM-A-87)

6. REPRESENTATIVE

The IDLP Draft Articles (SCT/35/2) provide that any IP Office may require an applicant, holder, or other interested person who has neither a domicile nor a real and effective industrial or commercial establishment in its territory appoint a duly qualified representative for the purposes of any procedure before the Office. However, it also prescribes that any applicant or holder may act himself/herself before the Office for the filing of an application, for the purposes of the filing date, and for the mere payment of a fee (Article 4.2).

- In AG, where an applicant's ordinary residence or principal place of business is outside the country, he shall be represented by a registered agent resident and practising in the country before the IP Office (AG-A-16).
- In BZ and DM, every applicant whose ordinary residence or principal place of business is outside the country shall be represented (in BZ, by an Attorney-at-Law) (in DM, by a legal practitioner) who has been enrolled to practice in the courts of the country in accordance with the relevant law (BZ-A-22) (DM-A-22)
- In LC, VC and TT, where an applicant's ordinary residence or principal place of business is outside the country, he or she shall be represented by an attorney-at-law resident and practising in the country (LC-A-20) (VC-A-19) (TT-A-20)
- In CU, foreign applicants who do not have a domicile or a real and effective industrial or commercial establishment in CU must be represented by an Official Industrial Property Agent accredited in CU in order to carry out any procedure before the Office (CU-A-15.4)
- In DO, where the applicant or the holder of an industrial property right is domiciled or has his headquarters outside DO, he must be represented by a representative domiciled in the country who shall be notified of all decisions, correspondence, letters and any other documentation issued by the IP Office (DO-A-148.2)

7. RIGHT OF PRIORITY

7.1 Priority based on a duly filed earlier application

*The Paris Convention prescribes that any person who has duly filed an application for the registration of an industrial design in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a **right of priority** during a period of **six months**. Any filing that is equivalent to a regular national filing under the domestic legislation of any country of the Union or under bilateral or multilateral treaties concluded between countries of the Union shall be recognized as giving rise to the right of priority. By a regular national filing is meant any filing that is adequate to establish the date on which the application was filed in the country concerned, whatever may be the subsequent fate of the application (Article 4.A)*

*The Paris Convention further prescribes that any person desiring to take advantage of the priority of a previous filing shall be required to make a **declaration** indicating the date of such filing and*

the country in which it was made. Each country shall determine the latest date on which such declaration must be made (Article 4.D).

7.1.1 Claim of priority declaration

Right of priority

All the CARIFORUM States prescribe that, as provided for in the Paris Convention, the industrial design application may contain (or be accompanied by) a declaration claiming the priority of one or more earlier national, regional or international applications regularly filed by the applicant or his predecessor in title, within the preceding six months, in or for any State party to that Convention (AG-A-7, R-11) (BS-A-63) (BB-A-16) (BZ-A-6) (CU-A-17) (DM-A-6, R-19) (DO-A-135) (JM-A-12, 89) (LC-A-6.4 to 6) (VC-A-6.4 to 6) (TT-A-6.4 to 6)

The laws of AG and JM specify that the right of priority also applies regarding earlier applications filed in respect of any Member of the World Trade Organization (WTO). The law of DO prescribes that a right of priority also applies regarding earlier applications filed in respect of any country that accords reciprocity for these purposes to persons of Dominican nationality or domiciled in the DO, or that are bound by treaties that so provide, also binding DO.

Timing of the declaration

The IDLP Draft Articles (SCT/35/2) and Draft Regulations (SCT/35/3) prescribe that an applicant shall be entitled to correct or add a priority claim to an application which could have claimed the priority of an earlier application, but did not do so (Article 14) provided that the request for correction or addition is filed not less than six months from the priority date and two months from the filing date of the subsequent application (Rule 12). This would apply both where the application filed contained no priority claim (addition of priority claim) and where the application already claimed priority of one or more earlier applications (correction of priority claim). The provision would also provide for the restoration of the priority right where a subsequent application is filed after the expiration of the priority period, but within not less than one month from the date on which the priority period expired. This would apply only where the failure to file the application within the priority period occurred in spite of all due care required by the circumstances having been taken, or, at the option of the Contracting Party, was unintentional (Article 14 and Rule 12). An Office may require that a fee be paid in respect of any such request.

- In AG, CU, DM, LC and TT, the priority claim declaration shall be made at the time of filing (AG-R-11.1) (CU-R-39.d) (DM-R-19.1) (LC-R-13.1) (TT-R-11.1)
- In DM, LC and TT, the priority claim declaration may be amended at any time before the registration of the design (DM-R-19.4) (LC-R-13.4) (TT-R-11.4)
- DO allows the declaration claiming priority to be filed within a period of two months from the date of the application (DO-A-135.4)
- In JM, the priority claim declaration may be made in the design application form or in a separate form (JM-A-12.2) and is subject to the payment of the prescribed fees.

Content of the declaration

- The priority claim in the application (or accompanying statement/declaration) shall indicate (AG-R-11) (BS-R-67.1) (BB-A-16) (CU-R-39.d) (DM-R-19) (DO-A-135) (JM-A-12) (LC-R-13) (TT-R-11):
 - the filing date of the earlier application – AG, BS, BB, CU, DM, DO, JM, LC, TT
 - the number of the earlier application – AG, BS, BB, CU, LC, TT (AG, DM, LC, TT: if not known at the time of filing, it may be submitted within three months) (DO: if known)
 - the symbol or class number allocated to the earlier application (if available) – AG, DM, LC, TT
 - the Office or State where the earlier application was filed – AG, BS, BB, CU, DM, DO, LC, TT
 - where the earlier application is a regional or an international application, the State(s) for which it was filed – AG, DM, LC, TT
 - the name of the applicant who made the earlier application – BS
- In CU and JM, priority claims are subject to the payment of the prescribed fees (OCPI Resolution 112/2021) (JM-A-12.2)

7.1.2 Priority document

Certified copy and certificate

*The Paris Convention prescribes that the countries of the Union **may require** any person making a declaration of priority to produce a copy of the application previously filed. The copy, certified as*

correct by the authority which received such application, shall not require any authentication, and may in any case be filed, without fee, at any time within three months of the filing of the subsequent application. They may require it to be accompanied by a certificate from the same authority showing the date of filing, and by a translation. No other formalities may be required for the declaration of priority at the time of filing the application. Each country of the Union shall determine the consequences of failure to comply with the formalities prescribed by this Article, but such consequences shall in no case go beyond the loss of the right of priority. (Article 4.D)

Where an applicant claims priority of an earlier application, most IP Offices around the world require the applicant to furnish a certified copy and certification of the date of filing of the earlier application (priority document) at the time of filing the new application or within a period thereafter. Some IP Offices only require the applicants to furnish a priority document upon request.

In the CARIFORUM region, the IP Offices of AG, BZ, DM, LC, VC and TT, *may require* the applicant to furnish, within the prescribed time limit (AG, DM, LC, TT *3 months*), a copy of the earlier application certified as correct by the Office with which it was filed (AG-A-7) (BZ-A-6) (DM-A-6) (LC-A-6.4 to 6) (VC-A-6.4 to 6) (TT-A-6.4 to 6, R-11.5)

In BS, BB, CU, DO and JM, the applicant claiming priority of an earlier filing *shall* furnish a priority document as follows:

- In BS, *within three months* from the claim made in the application, the applicant *shall submit* a copy of the representation of the design filed or deposited in respect of the first application for protection in a convention country, duly certified by the official chief or head of the appropriate office of the convention country or otherwise verified to the satisfaction of the Registrar General (BS-R-67.2)
- In BB, the applicant *shall furnish*, within a period of *90 days* from the date of the application, a copy of the earlier application certified as correct by an authority in the other country who is competent to so certify (BB-A-16)
- In CU, within *three months* from the filing of the application, the applicant shall submit a certified copy of the earlier application issued by the office of origin along, including an indication of the filing date and the application number. Failure to do so shall result in the priority claim not being taken into account (CU-A-98, R-5)
- In DO, within *three months* from the filing of the application, a copy of the application giving rise to the priority, certified as correct by the industrial property office which received the

said application and accompanied by a certificate of the filing date of the priority application issued by the said office, *shall be filed*, these documents being exempt from any legalisation (DO-A-135)

- In JM, where a claim for a right of priority is made *the applicant shall* within six months of the claim, furnish the Registrar with (a) a copy of the earlier application, certified as correct by the appropriate authorities in the country in which that application was filed (JM-A-12.4)

Translation

- In AG, DM, LC and TT, where the earlier application is in a language other than English, the applicant *shall*, within six months from the date of the request by the Office, furnish an English translation of the earlier application (AG-R-12.6) (DM-R-19.6) (LC-R-13.6) (TT-R-11.6)
- In CU and DO, where the earlier application is in a language other than Spanish the certified copy of the application *shall* be accompanied by a translation into Spanish (CU-A-26.1.g) (DO-A-135) and, in the case of CU, a declaration regarding the verification of that translation
- In JM, the applicant *shall* within six months of the claim, furnish the Office with a translation into English of the earlier application accompanied by the relevant form and the prescribed fee and a declaration by the translator that the translation is to the best of the translator's knowledge, complete and faithful (JM-A-12.4.b)
- In BZ and DM, the Office *may* also request the applicant to furnish a translation thereof verified by the translator that the translation is, to the best of his knowledge, complete and faithful (BZ-A-6.3) (DM-A-6.3)

WIPO Digital Access Service (DAS)

In 2012, WIPO launched the WIPO Digital Access Service (DAS), an electronic system allowing priority documents to be securely exchanged between participating IP offices. The system enables applicants and offices to meet the requirements of the Paris Convention for certification in an electronic environment. IP Offices may participate both as a Depositing Office (usually the office of first filing, allowing applications to be made available to other offices through DAS) and as an Accessing Office (where the office – acting as office of second filing – allows the applicant to request that a priority document be retrieved through DAS rather than filing a certified copy). At present, 17 IP Offices from around the world participate in WIPO DAS both as depositing offices and accessing offices for industrial design priority documents, including four offices of developing

countries (Chile, Colombia, India, Mexico). Another four IP Offices (including Brazil) participate in WIPO DAS only as depositing offices for industrial design priority documents.

So far, none of the IP Offices of CARIFORUM States participates in the WIPO DAS, either as a depositing office or as an accessing office for industrial design priority documents.

Failure to comply with the requirements for the recognition of the right of priority

- In AG, BZ, DM, LC, VC and TT, where the Office finds that the requirements pertaining to a declaration of priority have not been fulfilled, the declaration shall be considered not to have been made (AG-A-7.3) (BZ-A-6.4) (DM-A-6.4) (LC-A-6.6) (VC-A-6.6) (TT-A-6.6)
- In BB, if a declaration claiming priority does not comply with all the necessary requirements, the Office shall request the applicant to complete the missing information within 90 days (BB-A-17.2). Failure to comply shall result in the application being accepted but with no mention of the priority claimed (BB-17-3.b)
- In CU, if the priority document is not filed within three months, the priority claim shall not be considered as such (CU-A-28.1); likewise, if there are irregularities with the data to be provided by the applicant concerning the declaration of priority, the Office shall issue an official action as part of the formal examination of the application (CU-A-32 and 100) (CU-R-48.2.c)
- In JM, where the Office finds that the requirements with respect to the claim of priority have not been met, the claim for a right of priority shall be deemed as having not been made (JM-A-12.5)

7.1.3 Effects of the claim of priority

The Paris Convention prescribes that any subsequent filing of an industrial design application in any of the other countries of the Union before the expiration of six-month priority period shall not be invalidated by reason of any acts accomplished in the interval, in particular, another filing, the publication, or the putting on sale of copies of the design, and such acts cannot give rise to any third-party right or any right of personal possession. Rights acquired by third parties before the date of the first application that serves as the basis for the right of priority are reserved in accordance with the domestic legislation of each country of the Union. (Article 4.B).

- In AG, BZ, DM, LC, VC and TT, the effect of the declaration shall be as provided in the Paris Convention (AG-A-7) (BZ-A-6) (DM-A-6) (LC-A-6.4) (VC-A-6.4) (TT-A-6.4)
- In BS, the claim to design copyright in a design shall be made in the same manner as an ordinary application and shall be accompanied by a request for convention priority together with such declaration as may be prescribed; the design copyright in a design shall not be invalidated by reason of the publication of the design during the period that runs from the date of the convention priority (BS-A-63).
- In CU, an application enjoying the right of priority cannot be invalidated by events occurring in the interval, in particular by another filing, by the publication of the industrial design or by its exploitation or by the offering for sale of copies of the design, and such events shall not give rise to any right of third parties in the said subject-matter, nor to any personal possession. (CU-A-17)
- In DO, an application filed under a right of priority shall not be refused or invalidated on account of events occurring during the priority period, carried out by the applicant himself or by a third party, and such events shall not give rise to the acquisition of any right of third parties in respect of the industrial design (DO-A-135)
- In JM, where an applicant for a design claims a right of priority, the priority to which the applicant is entitled shall take effect from the filing date of the earlier application, and shall not be invalidated by reason of any acts of any other person occurring after the priority date and in particular another filing, or the disclosure, publication or exploitation of the design, and such acts shall not give rise to any third-party rights with respect to the design. Where the date taken to be the priority date, or the filing date in JM, or both, were effected by a person who was not entitled to the registration of the design, the true owner of the right may claim the priority. The acceptance by the Office of a claim to a right of priority in respect of a design application does not relieve the applicant or holder of the obligation to prove the existence of such right. In relation to a design application, no opposition may be raised with reference to any act occurring between the priority date and the date on which the application is first filed in JM (JM-A-12.6 to 12.9, 89).

7.2 Priority based on an exhibition

The Paris Convention (Article 11) provides that the countries of the Union shall, in conformity with their domestic legislation, grant temporary protection to industrial designs in respect of goods exhibited at official or officially recognized international exhibitions held in the territory of any of

them. Such temporary protection shall not extend the right of priority based on an earlier filing. If, later, the right of priority is invoked, the authorities of any country may provide that the period shall start from the date of introduction of the goods into the exhibition. Each country may require, as proof of the identity of the article exhibited and of the date of its introduction, such documentary evidence as it considers necessary.

The IDLP Draft Articles (SCT/35/2) prescribe that, when an applicant wishes to take advantage of Article 11 of the Paris Convention, an Office may require that the product or products which incorporate the industrial design or in relation to which the industrial design is to be used have been shown at an official, or officially recognized, international exhibition (Article 3.1.viii).

Under the Hague System, where the applicant wishes to take advantage of Article 11 of the Paris Convention, the international application shall contain a declaration that the product or products which constitute the industrial design or in which the industrial design is incorporated have been shown at an official or officially recognized international exhibition, together with the place where the exhibition was held and the date on which the product or products were first exhibited there and, where less than all the industrial designs contained in the international application are concerned, the indication of those industrial designs to which the declaration relates or does not relate. (Rule 7.5.d)

- In CU, applicants may, at the time of filing the industrial design application, request the Office to recognise their right of priority from the date on which they have exhibited the subject matter of the application at an official or officially recognised *international exhibition*, provided that the exhibition was held within the six months preceding the date of filing of the application. This right of priority shall not extend the time limits provided for in the event of claiming priority based on an earlier filing. The exhibitions to be taken into account with regard to the right of priority shall be limited to exhibitions recognised in accordance with the Convention relating to International Exhibitions of 22 November 1928. The official recognition of official international or officially recognised exhibitions has legal effect provided that it is prior to the exhibition of the prior to the exhibition of the subject matter of the industrial design application. (CU-A-19). The date of priority claimed by the applicant by virtue of the display of the creation at an officially recognised exhibition is attested by a certificate issued and duly signed and stamped by the highest authority of the exhibition concerned. The certification attesting to the official recognition of the exhibition must state the name of the exhibition, the country, the opening and closing date, the description of the

creation, the manner, date and time of the exhibition and must be accompanied by a translation if it is written in a language other than Spanish. The applicant may submit photos, illustrations or other audio-visual means that demonstrate the correspondence of what is exhibited with the content of the claims or graphic representations of the object applied for. (CU-R-6)

8. FILING DATE AND EXAMINATION

8.1 Filing date

In the course of preparatory work towards a possible Design Law Treaty (DLT), the SCT attempted to set out a list of requirements that might be established for the purpose of according a filing date to an industrial design application. Several proposals were made, but no consensus was reached on them. Consequently, IDLP draft Article 5 on Filing Date (SCT/35/2) continues to show alternative options or proposals supported by different SCT delegations.

In the CARIFORUM region, the laws provide for the following requirements to accord a filing date to an industrial design application:

- In AG, BZ, DM, LC, VC and TT, the Office accords as the filing date the date of receipt of the application, provided that, at the time of receipt, the application contains indications allowing the identity of the applicant to be established and the required graphic representation of the article embodying the industrial design. Where the Office finds that the application does not, at the time of receipt, fulfil those requirements, it invites the applicant to file the required correction and accords as the filing date the date of receipt of the required correction. If the applicant does not file the required correction, the application is treated as if it had not been filed. (AG-A-8) (BZ-A-7) (DM-A-7) (LC-A-7) (VC-A-7) (TT-A-7)
- In CU, the Office accords as the date of filing of the application, the date on which there is, at least: (a) an express or implicit indication that the grant of an industrial design registration is sought; (b) any information enabling the applicant or the person filing the application to be identified, or enabling the Office to communicate with that person; c) an indication of the kind of product in which the design is incorporated; and (d) the graphic or photographic representation of each design (CU-A-97)

- In DO, the filing date of the application shall be deemed to be the date of its receipt by the IP Office, provided that it contains at least the following elements: (a) an express or implicit indication that registration of an industrial design is sought; (b) sufficient information to identify the applicant; (c) a graphic or photographic reproduction of the industrial design; in the case of two-dimensional designs made of textile, paper or other flat material, the reproduction may be replaced by a sample of the product incorporating the design (DO-A-64)
- In JM, the filing date of an application for the registration of a design, shall be the earliest date on which an application, accompanied by the application fee is submitted to the Office (JM-A-88)

8.2 Examination of the industrial design application

Industrial design laws in different jurisdictions provide for different requirements regarding the examination of industrial design applications. Whereas many Offices are required to undertake an examination both regarding formalities and substance, some are only required to undertake a formal examination of applications. In 2008, WIPO undertook an analysis of the industrial design law and practice in 68 members of the SCT on the basis of replies received to a questionnaire, and reported that 56% of the IP Offices had indicated that they examined industrial design applications for compliance with both formal and substantive requirements, whereas 42% had replied that they only examined applications for compliance with formal requirements (SCT/19/6, page 6).

8.2.1 Formal examination

Nearly all IP Offices having replied to the above-mentioned questionnaire, indicated that they examined whether the application contained or was accompanied by the contact details of the applicant or his representative (99%), the identity of the applicant (97%), a reproduction of the industrial design (97%), the required fee (97%) and a request for the registration of the industrial design (96%) (SCT/19/6, page 6). The majority of Offices also examined as to whether the application contained, or complied with an address for service (88%), a correct indication of the product or products to which the industrial design was to be applied (86%), the requirements that apply to a multiple design application (79%), the requirement concerning the design creator (73%), the required number of reproductions (69%), and the number of views for the industrial design to be fully disclosed (61%) (SCT/19/6, page 7).

In the CARIFORUM region, the industrial design laws and regulations (AG-A-7, 8.3) (BB-A-17) (BZ-A-8.a, 8.c) (CU-A-31, 32, 100, R-48, 49) (DM-A-8.a, 8.c) (LC-A-7.3) (VC-A-7.3) (TT-A-7.3) provide for the IP Offices to undertake a formal examination of industrial design applications to determine whether:

- the application complies with all the formal requirements regarding prescribed content and accompanying documents – AG, BB, BZ, CU, DM, LC, VC, TT
- if priority is claimed, the relevant declaration provides all the required information – AG, BB, BZ, CU, DM, LC, VC, TT
- the prescribed fee has been paid – AG, BB, BZ, CU, DM, LC, VC, TT
- the application refers to not more than 100 designs – CU

In BB and CU, if the application does not comply with all the formal requirements regarding its content and accompanying documents, or the application fees have not been paid, the Office shall request the applicant to comply within a given period (BB 90 days; CU 60 days + 30 days extension upon request). Failure to comply within that period, shall result in the refusal of the application (BB-A-17.3 a) or in the application being considered abandoned (CU-A-32.2, 100).

8.2.2 Substantive examination

The abovementioned WIPO report (SCT/19/6) indicated that the vast majority of the IP Offices having indicated that they undertook a substantive examination of industrial design applications had responded that they examined the applications as to whether the industrial design for which registration was sought, was contrary to morality or public order (83%), or fulfilled the notion of “design” established by the relevant legal framework (81%). Over half of those IP Offices had responded that they also examined as to whether the industrial design conflicted with official signs or emblems protected under Article 6ter of the Paris Convention (68%), was new (54%), or differed significantly from known designs (52%).

A majority of those Offices (74%) appeared to conduct a substantive examination ex officio. Over one third of the Offices indicated that they carried out substantive examination following opposition by a third party. Another third of the Offices indicated that they did so following an invalidation action. In some jurisdictions (16%), substantive examination was carried out both ex officio and also following opposition. A majority of Offices (68%) replied that they carried out substantive

examination before registration of the industrial design, as opposed to 22% which indicated that they conducted such examination after registration.

In the CARIFORUM region, at least ten IP Offices undertake a substantive examination as to whether the subject matter of the industrial design application complies with the definition of industrial design and is not contrary to public order or morality. Four Offices are also required by law to undertake a substantive examination as to whether the industrial design complies with other registration requirements, including novelty.

Definition of industrial design

- In AG, BB, BZ, CU, DM, DO, JM, LC, VC and TT, the Office examines the application to determine whether its subject matter complies with the definition of industrial design, or amounts to an industrial design (AG-A-3, 8.4) (BB-A-18.1.a) (BZ-A-8.b) (CU-A-91, 105.a, R-50.a) (DM-A-8.b) (DO-A-54, 65) (JM-A-83.1, 90.1) (LC-A-3, 7.4) (VC-A-3, 7.4) (TT-A-3, 7.4)

Public order or morality

- In AG, BZ, CU, DM, DO, JM, LC, VC and TT, the Office examines the application to determine whether the design is not contrary to public order or morality (AG-A-4.4, 8.4) (BZ-A-8.d) (CU-A-92.g, 105.b) (DM-A-8.d) (DO-A-55, 65) (JM-A-83.1, 90.1) (LC-A-4.4, 7.4) (VC-A-4.4, 7.4) (TT-A-4.4, 7.4)
- In BB, the Office examines the application to determine whether the design is not likely to provoke a breach of peace (BB-A-10, 17.1)

Entitlement to file the application

- In JM, the Office is required to examine the applicant's or representative's entitlement to file the application (JM-A-84, 90.1)

Novelty

- In BB, the Office examines the application to determine whether the industrial design is new at the time of the application; and that no earlier application for registration of the same

industrial design has been made in BB, or that no earlier application benefitting from an earlier priority relating thereto has been made in BB (BB-A-18.1)

- In CU, the Office examines whether the application satisfies the worldwide novelty requirement (CU-A-93, 94, 103.1, 105.c, R-50.c, 51, 52). Substantive examination is carried out on the basis of a search of industrial designs existing prior to the priority date, contained in the sources of disclosure published up to that time, and of applications pending at the Office (CU-R-51). For the purpose of determining novelty, account is taken of applications pending before the Office, the priority date of which is prior to the priority date of the design application under examination, provided that its contents have been or are subsequently made available to the public (CU-A-94.2). If, in the course of the substantive examination of an application, it is found that another unpublished industrial design application with an earlier priority date is pending, which could affect in whole or in part the novelty of the industrial design under examination, the Office suspends the current examination until the publication of the earlier application. (CU-R-52).
- In DO, the IP Office is required by law to examine whether the design complies with the worldwide novelty requirement (DO-A-58, 65)
- In JM, the Office is required by law to examine whether the application satisfies the worldwide novelty requirement (JM-A-83.1 to 83.3, 90.1)

Individual character

- In DO and JM, the Offices are required to examine whether the design satisfies the requirement of having individual character (DO-A-58, 65) (JM-A-83.1, 83.5, 83.6, 90.1)
- In CU, the novelty examination implies also examining whether the design satisfies the requirement of having individual character (CU-A-94.1, 105.b)

Information regarding related foreign applications

- In CU and JM, during the substantive examination stage, the Office may require the applicant to provide details on prior applications for the same designs filed in other countries and their legal status. The applicant shall indicate the application numbers, dates and countries concerned, as well as any objections raised (CU-R-53) (JM-13. 89)

Other matter excluded from protection

- In CU, the Office examines whether the design involves any other matter excluded from protection (protected distinctive signs, works protected by copyright, non-visible components, spare parts, functional or technical designs) (CU-A-92, 105.b)
- In JM, the Office is required to examine whether the application involves any other matter excluded from protection unless the necessary consent is obtained (national symbols or emblems, country names, emblems and names of intergovernmental organizations, protected trademarks, copyright works, images or likenesses of individuals, traditional knowledge, traditional cultural expressions) (JM-A-83.7, 90.1)

Multiple designs and division of the application

- In CU, the Office examines whether all the designs filed in a multiple application correspond to the same class and that those corresponding to the same class do not exceed the number of one hundred. If this is not so, the applicant is required to divide the application originally filed into as many designs as are necessary to comply with those requirements. The division may under no circumstances extend the contents of the original application. If the applicant does not divide the application, the registration is granted, where applicable, in respect of the first design filed and in respect of all the designs in the same class, up to the number of 100 (CU-A-20.3, 104, R-50.b, 57, 58, 59)

8.2.3 Procedure following examination

- In AG, BZ and DM, where the Office is not satisfied that the relevant requirements for registration have been fulfilled, it shall refuse the application and notify the applicant in writing of that fact (AG-A-9.1) (BZ-A-9.2) (DM-A-9.2)
- In BB, when the Office determines that the subject of the application is not an industrial design, that the industrial design is not new, or that there has been an earlier application for registration thereof made in BB, the Office shall refuse registration and inform the applicant by notice in writing why the design cannot be registered, and invite him either to withdraw the application or to present, within a period of 60 days from the receipt of the notice, the applicant's comments on the reasons for the refusal of registration. If the applicant either fails to withdraw his application or to present his comments within that period, or presents his comments and the Office is not of the view that the design ought to be registered, the

Office may (a) refuse registration in respect of the application; or (b) grant an extension of a further period of not more than 60 days for the presenting of comments if the applicant resides outside BB, or if the Office thinks fit for any other reason to grant such an extension. (BB-A-18.2, 18.3)

- In CU, in the course of the substantive examination, the Office may require the submission of evidence from the parties and issue directions to the applicant, so as to give the applicant the opportunity to correct any errors or omissions which may lead to the refusal of registration, its partial grant or to a reduction in scope (within 60 days, extendable for a further 30 days), provided that no new matter is added to that contained in the application. The applicant may submit comments on any information or document at any stage of the examination. (CU-A-103.2)
- In JM, if the Office is not satisfied that the requirements for registration have been fulfilled, the Office shall invite the applicant to make an application in the prescribed form, accompanied by the prescribed fee, and within the prescribed period, for the necessary corrections to be made and if the corrections are not so made, the application shall be refused (JM-A-90.2)

9. PUBLICATION OF THE INDUSTRIAL DESIGN

In most jurisdictions, industrial designs applied for protection are published by the IP Office in an official journal or gazette, either before or after registration. Such publication may take place on paper and/or electronically and usually contains bibliographic data and at least one representation of the industrial design.

Under the Hague System, international registrations are published by the International Bureau in the International Designs Bulletin on the WIPO website. Such publication, takes place only electronically on Friday of each week, and is deemed to be sufficient publication in all Contracting Parties. However, Contracting Parties may republish the international registration, at no cost to the holder, with a view to facilitating the possible filing of an opposition or invalidation action by a third party.

9.1 Timing of publication

Offices may publish industrial designs either before or after registration, or both before and after. Those offices that publish industrial design applications (before registration) may do so either

before or after examination. In most jurisdictions, deferment of publication for a certain maximum period is allowed.

Under the Hague System, the general rule (as from January 1, 2022) is that an international registration is published 12 months after the date of international registration. Nevertheless, at the time of filing, the applicant may request (a) immediate publication or (b) publication at a chosen time of maximum 30 months (specified in months counted from the filing date). After filing, the applicant or holder may request earlier publication at any time before the expiration of the publication period initially specified in the international application. The international registration will be published immediately upon receipt of any such request by the International Bureau.

In the CARIFORUM region, industrial design applications are published in CU and JM, as follows:

- In CU, after the formal examination has been carried out and any deficiencies in the application have been remedied, the Office publishes the application for registration of the design in the Official Bulletin of Industrial Property within a period of not less than six months from the date of filing (CU-A-101.1)
- In JM, where the Office is satisfied that the requirements for registration have been met, the Office shall forthwith publish the application upon payment of the prescribed fee, unless the applicant has filed a request for deferment, in which case the application will be published at the expiry of the period of deferment upon payment of the publication fee (JM-A-90.4)

In BZ, where, following the examination referred to in BZ-A-8, the IP Office is satisfied that the relevant requirements for registration have been fulfilled, the Office (a) publishes a notice or registration of the industrial design in the Journal, (b) registers the industrial design, and (c) issues, to the applicant, the certificate of registration (BZ-A-9.1).

In AG, BS, BB, DM, LC, VC and TT, industrial designs are published only after registration, as follows:

- In AG, DM, DO, LC, VC and TT, where, following the examination, the IP Office is satisfied that the application complies with the registration requirements, the Office registers the industrial design and publishes a notice of the registration (AG-A-9-1) (DM-A-9.1) (LC-A-8.1) (VC-A-8.1) (TT-A-8.1)

- In BS, the representation or specimen of a design in respect of which a claim for design copyright has been deposited under the Act shall be open to inspection at the Office on and after the twenty-eighth day after the claim for design copyright has been deposited (BS-A-42)
- In BB, from time to time as prescribed by the regulations, the Office publishes in the Gazette, in the order of the registration, such industrial designs as have been registered in the Register to that time or since the last such publication. The publication of industrial designs must include all the particulars recorded in the Industrial Designs Register. (BB-A-24)

9.2 Deferment of publication

The IDLP Draft Articles and Draft Regulations (SCT/35/2 and SCT/35/3) prescribe that an Office shall allow the industrial design to be maintained unpublished for a period of minimum six months from the filing date or, where applicable, the priority date, upon request of the applicant. Where such a request has been made, the applicant or holder, as the case may be, may, at any time during that period, request the publication of the industrial design (Article 9, Rule 6). This provision has been justified by the fact that there is an interest for users in maintaining the industrial design unpublished for some time, as this enables them to control the first release of the product embodying the industrial design. However, maintaining an industrial design unpublished in one jurisdiction serves no purpose if the design is published in another jurisdiction. It is a fact that, nowadays, any matter that is made accessible in one part of the world can easily become accessible everywhere. The article does not provide for a specific system to maintain the design unpublished. An Office might comply with this Article by implementing, for example, a system of deferment of publication, a secret design system, or a system giving the possibility to effectively postpone publication, where publication takes place after registration by delaying the payment of the registration fees.

Under the Hague System (1999 Act), the actual period of deferment of publication depends upon the domestic law of each Contracting Party designated in the international application. The applicant may request deferment of publication for a period of up to 30 months from the filing date or, where priority is claimed, from the priority date. However, if a designated Contracting Party has declared that, under its domestic law, the period of deferment allowed is less than 30 months, then publication takes place on the expiry of the period stated in that declaration. If more than one designated Contracting Party has declared that the period of deferment allowed for is less than 30 months, then publication takes place on the expiry of the shortest of the periods stated in those

*declarations. If a designated Contracting Party has declared that deferment of publication is not possible under its domestic law, the International Bureau notifies the applicant that the request for deferment of publication is incompatible with the designation of the Contracting Party concerned. If the holder does not withdraw that designation within one month of the date of the notification sent by the International Bureau, the request for deferment of publication is not taken into consideration.*⁶

In the CARIFORUM region, deferment of publication is dealt with as follows:

- In AG, BZ, DM, LC, VC and TT, an application, at the time of filing, may contain a request that the publication of the industrial design, upon registration, be deferred for a period not exceeding *twelve months* from the date of filing, or if priority is claimed, from the date of priority, of the application (AG-A-6.5) (BZ-A-5.6) (DM-A-5.6) (LC-A-6.8) (VC-A-6.8) (TT-A-6.8). Where a request for deferment of publication has been made, no representation of the design or any file relating to the application shall be open to the public for inspection and the Office shall publish a notice of deferment which shall contain information identifying the registered owner, the filing date of the application, the length of time for which deferment has been requested and any other particulars as may be prescribed. During the period of deferment of publication, legal proceedings on the basis of a registered industrial design may not be instituted unless the information contained in the Register and in the file relating to the application has been communicated to the person against whom the action is brought. At the expiry of the period of deferment, the Office shall publish the registered industrial design. (AG-A-9.2 to 9.4) (BZ-A-9.3 to 9.5) (DM-A-9.3 to 9.5) (LC-A-8.2 to 8.4) (VC-A-8.2 to 8.4) (TT-A-8.2 to 8.4)
- In CU, the publication of the application for registration of the design may be deferred for a period of not more than *twelve months* from the date of filing, at the request of the applicant and subject to payment of the prescribed fee (CU-A-101.2)
- In JM, an application may contain a request, accompanied by the prescribed fee, that upon examination and subsequent acceptance of the application for registration the full

⁶ The following Contracting Parties to the Hague Agreement (1999 Act) have declared that they allow for maximum periods of deferment of publication of less than 30 months from priority date: 6 months from priority date (Denmark, Finland, Norway), 6 months from filing date (Israel), 12 months from priority date (OAPI, Belize, Benelux, Brunei Darussalam, Cambodia, Croatia, Estonia, Samoa, Slovenia, Suriname, Syrian Arab Republic), 12 months from filing date (United Kingdom), 18 month from filing date (Singapore). The following Contracting parties have declared that they do not allow for deferment of publication: Belarus, Hungary, Iceland, Mexico, Monaco, Poland, Russian Federation, Ukraine, United States of America, Viet Nam.

publication of the design be deferred for a period not exceeding *twelve months* from the date of filing, or, where priority is claimed, from the date of priority (JM-A-85.3). Where a request for deferment of publication is made, the Office shall publish a notice of deferment, which shall contain information identifying the applicant, the filing date of the application, the length of time for which deferment has been requested, and any other particulars as may be prescribed. However, no representation of the design or any file relating to the application shall be open to the public for inspection (JM-A-85.4). At the expiry of the period of deferment, after examination and subsequent acceptance of the application for publication, the applicant shall pay the publication fee within one month and the Office shall fully publish the application, but if the applicant fails to pay the publication fee within one month of the expiry of the period of deferment, the Office may treat the application as withdrawn (JM-A-85.5).

10. OPPOSITION

The WIPO analysis of industrial design law and practice in 68 members of the SCT, in 2008, indicated that at least 58% of the IP Offices had replied that they had either a pre- or a post-registration opposition procedure, as opposed to 35% which had indicated that they did not have any. Just over one quarter indicated that there was a pre-registration procedure in their jurisdiction, while approximately one third indicated that they operated a post-registration procedure. The returns to the questionnaire revealed that in an opposition, the opponent could invoke in general that the design was not new (76%) did not differ significantly from known designs (70%); did not fulfil the notion of “design” under the applicable law (67%); or was in conflict with official signs or emblems protected under Article 6ter of the Paris Convention (65%). Opponents could also base an opposition in general on a conflict with a prior design (75%), a prior trademark (69%) or copyright in a literary or artistic work (68%)^{7, 8}

In the CARIFORUM region, two countries provide for pre-registration opposition procedures, as follows:

⁷ Industrial Design Law and Practice – Analysis of the Returns to WIPO Questionnaires, 2008 (SCT/19/6)

⁸ The European Union system does not provide for a pre-registration opposition procedure; but it does provide for a post-registration invalidation procedure at the request of any third party.

- In CU, any interested person may file an opposition with the Office as to the appropriateness of the registration of the industrial design within a period of sixty days from the date of the Official Bulletin of Industrial Property in which the design application was published. The applicant shall pay the prescribed fee, state the grounds of opposition and attach the documents on which his claim is based. Any person who files an opposition shall be considered a party to the proceedings for the registration of the design. If no opposition is filed within the prescribed time limit, the Office shall carry out the substantive examination. Oppositions and objections filed are forwarded to the applicant, who may, if he deems it appropriate, reply to the allegations made, within a period of sixty days from the date of notification. Once the applicant's arguments have been received, or, failing that, once the time limit has expired, the Office shall carry out the substantive examination. (CU-A-34, 35, 102. R-61 to 65)
- In JM, any interested person may, within two months after the date of publication of the application, file with the Office a notice of opposition to the registration of the design on the grounds that (a) one or more of the requirements for registration are not met; or (b) the applicant does not have a right to the registration of the design. A notice of opposition shall be filed in the prescribed form, and shall be accompanied by the prescribed fees. An interested person filing a notice of opposition shall provide the applicant with a copy of the notice of opposition within fourteen days thereafter (JM-A-92).

11. RELIEF IN RESPECT OF TIME LIMITS

11.1 Extension of time limits – Continued processing

The IDLP Draft Articles (SCT/35/2) contain provisions on relief measures in respect of time limits. Without any relief measures, missing a time limit generally results in a loss of rights, which, in the case of industrial designs, is irreparable. Draft Article 12 requires IP Offices to provide relief in respect of time limits in the form of an extension of a time limit and/or continued processing, and if necessary, by reinstating the rights of the applicant or holder with respect to the application or registration concerned. Such relief is restricted to time limits “fixed by the Office for an action in a procedure before the Office”. It would not apply to time limits that are not fixed by the Office, in particular, time limits established by national legislation or under a treaty. The exceptions to the applicability of relief measures and reinstatement of rights, provided for in the IDLP Draft

Regulations (SCT/35/3), are intended to prevent an applicant or holder from abusing a system of relief measures, for example by obtaining double relief in respect of a procedure.

In the CARIFORUM region, the laws envisage the possible extension of time limits, as follows:

- In AG, BZ, DM, LC, VC, TT, where the Office is satisfied that the circumstances justify it, it may, upon the written request of any interested person, extend the time for doing any act or taking any proceeding under the ID Act and the Regulations, upon notice to the parties concerned and upon such terms as it may direct. An extension of time may be granted though the time for doing the act or taking the proceeding has expired. (AG-A-19) (BZ-A-20) (DM-A-20) (LC-A-18) (VC-A-17) (TT-A-18)
- In CU, where the Office is satisfied that the circumstances so justify it, it may extend a time limit to reply to an official action (CU-A-32, 36 and 100)
- In DO, at the request of the interested party, the Office may, in duly justified cases, prudentially extend the time limits laid down in the Law or in its regulatory provisions for answering an action or replying to a notification (DO-A-153)
- In JM, the Office may extend any period imposed by the Office for the doing of anything (JM-A-110.3). Any person who requests the Office to extend any period imposed under the IP Act for the doing of anything under the Act shall do so in the prescribed form and accompanied by the prescribed fee (JM-A-110.4).

11.2 Reinstatement of Rights

The IDLP Draft Articles (SCT/35/2) would oblige an IP Office to provide, under certain circumstances, for the reinstatement of rights with respect to an application or registration following failure to comply with a time limit for an action in a procedure before the Office, where that failure has the direct consequence of causing a loss of rights with respect to an application or registration (Article 13). In contrast to the relief measures mentioned above (extension of time limits, continued processing), such reinstatement would be subject to a finding by the Office that the failure occurred in spite of all due care required by the circumstances, or was unintentional. This reinstatement would not be restricted to time limits fixed by the Office, although it would be subject to certain exceptions as prescribed in draft Rule 11.3 of the IDLP Draft Regulations (SCT/35/3).

- IN CU, the applicant for or proprietor of an industrial design registration or any other party to proceedings before the Office may, on written request, have his rights re-established if,

having taken all due care required by the circumstances, he was unable to comply with a time limit in respect of a procedure before the Office, if the impossibility would have had the direct consequence of causing the loss of a right or a means of contesting that right. The request must be filed within sixty days of the removal of the cause of non-compliance, but is admissible only within one year of the expiry of the unobserved time limit, and must state the facts and evidence in support thereof, and is subject to the payment of a fee. At the conclusion of the proceedings, the Director General of the Office shall issue, within thirty days, the appropriate decision, in which he may or may not re-establish the right. (CU-A-123). Details regarding the procedure for reinstatement of rights are given in the Regulations (CU-R-77 to 82)

12. OPPORTUNITY TO BE HEARD – REVIEW – APPEALS

12.1 Opportunity to be heard

- In AG, BZ, DM, LC, VC and TT, the Registrar/Controller shall, before exercising any discretionary power vested in him/her by the ID Act or the Regulations, give any party to a proceeding before him/her the opportunity of being heard if his/her decision might adversely affect that party. (AG-A-20) (BZ-A-21) (DM-A-21) (LC-A-19) (VC-A-18) (TT-A-19)

12.2 Review

- In CU, a decision by the competent Head of Department regarding the grant or refusal of an industrial design registration may be subject to review by the Director General of the Office by following the established procedure (CU-R-66 to 71).

12.3 Appeals

- In AG, LC, VC and TT, any decision taken by the Registrar/Controller under the ID Act, in particular the decision to register an industrial design or to refuse an application for such a registration, may be the subject of an appeal by any interested party before the Court and such appeal shall be filed within [AG 2 months] [LC 3 months] [VC 2 months] [TT 2 months] of the date of the decision. (AG-A-21) (LC-A-21) (VC-A-20) (TT-A-21)

- In BB, a person aggrieved by any determination of the Director regarding the registration or refusal to register an industrial design may appeal to the High Court by notice of motion from that determination. After hearing the appeal, the court may rescind or confirm the determination of the Director. The Registrar of the Supreme Court shall transmit a certified copy of the court's decision on an appeal under this section to the Director who must thereupon record it in the register and publish a notice of it in the Gazette. The Director may be heard in person or by his attorney on an appeal under this section. (BB-A-43)
- In BZ, any person who has been aggrieved by a decision of the Registrar under the ID Act may, within two months of that decision, appeal to the Court. (BZ-A-23-2)
- In CU, a person aggrieved by a decision by the Office may appeal to the Court against that decision within 30 days from the date of notification of the decision (CU-A-119)
- In DM, any person who has been aggrieved by a decision of the Registrar under the ID Act may, within two months of that decision, appeal to the Court. (DM-A-23.2)
- In DO, the decision of the DG of the IP Office shall be final and enforceable. This decision may be appealed before the court of appeal of the judicial department corresponding to the place where the Office is located, in its civil and commercial functions, within thirty (30) days of its notification. The judgment of the Court of Appeal may revoke or confirm the decision of the DG (DO-A-157.2). The judgments of the Court of Appeal shall be subject to appeal in cassation in accordance with the provisions established for civil and commercial matters by Law No. 3726 on Cassation Procedure of 1953, or the one that replaces or modifies it. (DO-A-158)
- In JM, where any person is aggrieved by any decision or act of the Registrar, that person may (a) within the time provided by or under the IP Act; or (b) within three months from the day the person became aware of the decision or act; or (c) within such further time as the Court may allow in accordance with the rules of Court, appeal the decision of the Registrar. Rules of Court may make provisions for the appointment of advisors to assist the Court in proceedings under this Act for any matter in relation thereto. (JM-A-114)

13. REGISTRATION

13.1 Registration of the industrial design and certificate thereof

- In AG, BZ, DM, DO, LC, VC and TT, where, following the examination, the IP Office is satisfied that the application complies with the registration requirements, the Office registers

the industrial design, publishes a notice of the registration, and issues to the applicant a certificate of registration (AG-A-9-1) (BZ-A-9.1) (DM-A-9.1) (DO-A-23) (LC-A-8.1) (VC-A-8.1) (TT-A-8.1)

- In BS, the Office shall grant a certificate of deposit to the proprietor of a design when the claim to design copyright is deposited (entered) in the Deposit List (BS-A-41)
- In BB, if the Director is satisfied that the application complies with the registration requirements, the applicant is entitled on payment of the prescribed fee to have the industrial design registered. (BB-A-19). The law specifies that registration of the industrial design does not give any statutory assurance of the validity of the design (BB-A-20)
- In CU, once the registration of an industrial design has been granted and the fee has been paid within 30 days from the relevant communication, the Office issues the corresponding certificate (CU-R-56).
- In JM, after examination and publication, where the registration of the design (a) has not been opposed within two months after the date of publication of the application; or (b) has been opposed and the opposition has been decided in the applicant's favour, the Office shall issue a certificate of registration of the design to the applicant (JM-A-93).

14. DURATION OF PROTECTION

14.1 Initial term

The Economic Partnership Agreement (EPA) provides that the initial duration of protection available in the EC Party and the Signatory CARIFORUM States following registration shall amount to at least five years (EPA, Article 146.E.1)

Under the Hague System, international registrations are valid for an initial period of five years.

- In AG, BB, BZ, DM, DO, JM, LC, VC and TT, the initial term of protection of the registered industrial design is of *five years* from the filing date of the application for registration (AG-A-11.1) (BB-A-26.1) (BZ-A-11.1) (DM-A-11.1) (DO-A-67.1) (JM-A-94.1) (LC-A-10.1) (VC-A-10.1) (TT-A-10.1)
- IN BS, the initiation term of protection of the deposit of a claim to design copyright is of *five years* from the date of deposit (BS-A-36.1)

- In CU, the term of protection of the registered industrial design is of *ten years* from the filing date of the application for registration (CU-A-112). From the third year onwards, maintenance of the registration is subject to payment of annual fees (CU-A-113). In the absence of such payment, the registration lapses (CU-A-116.b).

14.2 Renewal

The Economic Partnership Agreement (EPA) provides that, at the request of the right holder, registration shall be renewed for one or more periods of five years each, but not exceeding 25 years from the date of filing, provided that the renewal fee has been paid (EPA. Article 146.E.1)

Under the Hague System, international registrations can be renewed for one or more additional periods of five years, in respect of each designated Contracting Party, up to the expiry of the total term of protection allowed by those Contracting Parties' respective laws.

- In AG, BZ, DM, DO, JM, LC and TT, the registration may be renewed for two further consecutive periods of five years upon payment of the prescribed renewal fee (AG-A-11.2) (BZ-A-11.1) (DM-A-11.1) (DO-A-67.2) (JM-A-94.3) (LC-A-10.2) (TT-A-10.2). A grace period of six months is allowed for the late payment of the renewal fee upon payment of a prescribed surcharge (AG-A-11.3) (BZ-A-11.2) (DM-A-11.2) (DO-A-67.3) (JM-A-94.5) (LC-A-10.3) (TT-A-10.3)
- In BS, the period of design copyright may be extended for two additional periods of five years each upon payment of the prescribed fee. A grace period of six months is allowed for the late payment of such fee upon payment of a surcharge (BS-A-36.2)
- In BB, the registration may be renewed for two further consecutive periods of 5 years each, upon payment of the prescribed fee for each renewal. The renewal fee must be paid within the 12 months immediately preceding the expiration of an earlier period of registration. However, the registered owner, upon payment of the prescribed fee therefor, is entitled to renew a previous registration within 6 months from the expiration of the earlier registration. A renewal of a registration of an industrial design is recorded in the register and a notice thereof published in the Gazette (BB-A-26)
- In CU, the industrial design registration has a validity of ten years from the filing date and cannot be renewed (CU-A-112). From the third year onwards, maintenance of the registration is subject to payment of annual fees (CU-A-113). In the absence of such payment, the registration lapses (CU-A-116.b)

- In VC, the registration may be renewed for one further consecutive period of five years through the payment of the prescribed fee (VC-A-10.2). A grace period of six months shall be allowed for the late payment of the renewal fee on payment of the prescribed surcharge (VC-A-10.2, 10.3).

14.3 Maximum duration of protection

*Under the Hague System, the maximum duration of protection in each designated Contracting Party corresponds to the maximum duration provided for by the law of that Contracting Party. A majority of Contracting Parties (37) provide for a maximum duration of protection of 25 years. A large number (27) provide for maximum duration of protection of 15 years. Only one country provides for a duration of 20 years and another one for a duration of 50 years.*⁹

In the CARIFORUM region, the maximum duration of protection for industrial designs is of

- 10 years in CU and VC
- 15 years in AG, BS, BB, BZ, DM, DO, JM, LC and TT

15. ENTRIES IN THE DESIGNS REGISTER

15.1 Change in ownership

The IDLP Draft Articles (SCT/35/2) prescribe that, where there is a change in the person of the holder, an Office shall accept that a request for the recording of the change be made either by the holder or by the new owner (Article 19.1). The IDLP Draft Articles and Draft Regulations (SCT/35/3)

⁹ The maximum duration of protection for industrial designs in the Contracting Parties of the Hague Agreement (1999 Act) is of **25 years** in Armenia, Belgium, Bosnia and Herzegovina, Bulgaria, Croatia, Denmark (15 years for spare parts), Estonia, European Union, Finland (15 years for spare parts), France, Georgia, Germany, Hungary, Iceland, Israel, Japan, Latvia, Liechtenstein, Lithuania, Luxembourg, Mexico, Montenegro, Netherlands, North Macedonia, Norway, Poland, Republic of Moldova, Romania, Russian Federation, San Marino, Serbia, Slovenia, Spain, Switzerland, Turkey, Ukraine, United Kingdom (37 Contracting Parties); **15 years** in Albania, Azerbaijan, Belarus, Belize, Botswana, Brunei Darussalam, Cambodia, Canada, Democratic People's Republic of Korea, Egypt, Ghana, Kyrgyzstan, Mongolia, Namibia, Oman, Rwanda, Samoa, Sao Tome and Principe, Singapore, Suriname, Syrian Arab Republic, Tajikistan, Tunisia, Turkmenistan, United States of America, Viet Nam (27 Contracting Parties); **20 years** in Republic of Korea; and **50 years** in Monaco.

provide a list of maximum requirements concerning the content of the request for recording and the supporting documents that should accompany that request (Article 19, Rule 14).

The Hague System provides for the central recording by the International Bureau of a change in ownership regarding an international registration, in respect of one or more designated Contracting Parties, at the request of the holder or, under certain conditions, of the new owner (Article 16, Rule 21). The recording of such change in the International Register has the same effect in each Contracting Party concerned by that change, as if it had been made directly at its own Register. However, a Contracting Party may, in a declaration, notify the Director General of WIPO that such a recording shall not have effect in its territory until its Office has received certain statements or documents (Article 16.2). Moreover, an Office may declare that the recording of a given change in ownership in the International Register shall have no effect in its territory because it does not comply with the conditions prescribed in its domestic law (Rule 21bis), in which case the Office shall follow the procedures prescribed in that rule.

- In AG, BZ, DM, LC, VC and TT, any change in the ownership of a registered design, or in the ownership of an application therefor, shall be in writing and shall be recorded in the Register upon the request of any interested party and, except in the case of an application, shall be published by the Office. A change in ownership shall be of no effect against third parties until it has been recorded. (AG-A-14) (BZ-A-15) (DM-A-15) (LC-A-13) (VC-A-13) (TT-A-13)
- In BS, notices of assignments and of transmissions of the design copyright shall be entered by the Office in the Deposit List of claims to design copyright (BS-A-40.1). Where a person becomes entitled by assignment, transmission or other operation of law to the design copyright in a design, he shall make application to the Office in the prescribed manner to register his title and the Office shall, on receipt of such application and on proof of title to his satisfaction, register him as the proprietor of such design and shall cause an entry to be made in the Deposit List of designs of the assignment, transmission or other instrument affecting the title (BS-A-50.1)
- In BB, an industrial design application may be transferred by the applicant or anyone claiming under him. A transfer of an application or of a registered industrial design must be recorded in the register upon payment of the prescribed fee. A transfer of an application or of a registered industrial design has no effect against any person other than the parties to the transfer until it is recorded in the register (BB-A-27). In order to be recorded in the register, a transfer that is made, otherwise than by operation of law, of an application for

registration of an industrial design or of an industrial design must be in writing and signed by the parties to the transfer. (BB-A-28). In the absence of an agreement to the contrary, joint owners of an industrial design may separately assign or transfer their shares of the industrial design and separately use the industrial design as well as separately exercise the exclusive rights vested in them under the law as registered owners (BB-A-30).

- In CU, applicants for and holders of industrial design registrations have the right to assign them, to transfer them by succession and by any other legally admissible means (CU-A-8.1). The request for recording a change in ownership shall be made in a special form and accompanied by a certified copy of the document justifying the change in ownership (CU-R-84).
- In DO, the registration of an industrial design, or an application therefor, may be assigned or transferred by succession or any other admissible means. Any transfer of a registered design or design application must be in writing and registered with the IP Office. The transfer shall have legal effect vis-à-vis third parties only after it has been registered. The registration shall be subject to the prescribed fee (DO-A-32).
- In JM, the owner of a registered design, shall have power to assign the registered design (JM-A-103.4). The Office shall enter in the Register of Designs particulars as to assignments and transmissions of registered designs (JM-A-100.1.a). Where a person becomes entitled (a) by assignment, transmission or operation of law, to a registered design or an application therefor or to a share in a registered design, such person shall apply to the Office, in the prescribed form and accompanied by the prescribed fee, for the registration at that person's title as owner or as joint owner, as the case may be or notice that person's interest, in the Register (JM-A-103.1). The application may also be made by the assignor (JM-A-103.2). Where the Office is satisfied, it shall enter the particulars of the applicant in the Register as owner or joint owner of the registered design (as the case may be), indicating the instrument or event by which the person derives title (JM-A-103.3). The Office may require the person who requests the recording of a change in ownership to furnish such supporting documents and information as the Office considers necessary in connection with the request (JM-A-103.5).

15.2 License contracts

The IDLP Draft Articles (SCT/35/2) and Draft Regulations (SCT/35/3) contain several provisions on maximum requirements regarding the recording of a license, the request for amendment or

cancellation of such recording, the effects of the non-recording of a licence (subject to alternative options or proposals) and the indication of the license (Articles 15 to 18, Rule 13).

The Hague System does not provide for the recording of licenses. Therefore, formalities which may be necessary to secure the effectiveness of a licensing agreement in a designated Contracting Party must be carried out directly before the Office of the Contracting Party concerned, provided that the domestic legislation in question so permits.

- In AG, BZ, DM, LC, VC and TT, the owner of a registered industrial design or an application therefor may grant licenses in respect of the design. A copy of each licence contract concerning a registered design, or an application therefor, shall be submitted to the Office, which shall keep its contents confidential but shall record it and publish a notice thereof. The licence contract shall have no effect against third parties until it has been recorded in the Register. (AG-A-15) (BZ-A-16) (DM-A-16) (LC-A-14) (VC-A-14) (TT-A-14)
- In BB, a registered owner of an industrial design may, by a licence-contract, grant another person or an enterprise a licence to use the industrial design for industrial or commercial purposes. A licence-contract must be in writing and signed by the parties, and it has no effect, as against persons other than the parties thereto, until it is recorded in the register. A licence-contract may be recorded in the register upon payment of the prescribed fee to the Director. The recording in the register of a licence-contract relating to an industrial design shall be cancelled by the Director (a) at the request of the registered owner of the industrial design or at the request of the licensee under the licence-contract; and (b) on production to the Director of satisfactory evidence by the person making the request that the licence-contract has terminated (BB-A-29). In the absence of an agreement to the contrary, joint owners of an industrial design may by joint action only grant a licence-contract to another person to use the industrial design for industrial or commercial purposes (BB-A-30). A provision in a licence-contract or a provision in an agreement relating to a licence-contract is void if it purports (a) to impose on the industrial or commercial use of an industrial design a restriction on the licensee that does not derive from the rights vested by registration of an industrial design under this Act; or (b) to impose a restriction that is unnecessary for the purpose of safeguarding the rights vested by registration of an industrial design under the ID Act. (BB-A-31)
- In CU, the applicant or holder of an industrial design registration may authorise the exploitation of the subject matter of the registration to third parties by means of licences. Licences shall be exclusive, unless otherwise agreed. Contracts for the licensing of a

registered industrial design must be recorded at the Office and are only effective against third parties as from the date of their recording. The Office publishes such annotation in the Official Bulletin of Industrial Property (CU-A-9). The request for recording a license shall be made in a special form and accompanied by a certified copy of the document justifying that the license has been granted (CU-R-85).

- In DO, the owner or co-owner of an industrial design may grant to third parties a non-exclusive licence to exploit or use the industrial design that is the subject matter of the application or of the registration; the co-owner must compensate equitably those co-owners who do not exploit the said subject matter and have not granted a licence to exploit or use it. In the absence of agreement, the compensation shall be fixed by the competent court. An exclusive licence for exploitation or use may only be granted with the common agreement of all the owners (DO-A-136.1.d and e)
- In JM, the owner of a registered design, shall have power to grant licences under the registered design (JM-A-103.4). In JM, the Office shall enter in the Register of Designs particulars as to licenses of registered designs (JM-A-100.1.a). The Office shall enter in the Register of Designs particulars as to licenses assignments and transmissions of registered designs (JM-A-100.1.a). Where a person becomes entitled (a) as licensee in respect of a registered design or an application therefor, such person shall apply to the Office, in the prescribed form and accompanied by the prescribed fee, for the registration at that person's title as licensee, in the Register (JM-A-103.1). The application may also be made by the licensor (JM-A-103.2). Where the Office is satisfied, it shall enter the particulars of the applicant in the Register as licensee of the registered design, indicating the instrument or event by which the person derives its title (JM-A-103.3). The Office may require the person who requests the recording of a license to furnish such supporting documents and information as the Office considers necessary in connection with the request (JM-A-103.5)

15.3 Change in name or address of the holder, applicant or representative

The IDLP Draft Articles (SCT/35/2) and Draft Regulations (SCT/35/3) prescribe maximum requirements for the recording by an Office of a change in the name and/or address of the holder, applicant or representative (Article 20, Rule 2) whenever there is no change in the person of the holder, applicant or representative. A single request shall be sufficient even where the change relates to more than one registration.

Under the Hague System, a change in name or address recorded by the International Bureau in the International Register, shall effect in all the designated Contracting Parties concerned by such change (Article 16.1, Rule 21).

- In CU, a request for the recording of a change in name or address of the applicant or holder is submitted on the prescribed form, specifying the details of the change in question, subject to payment of the corresponding fee (CU-R-83)
- In DO, the owner of a registration may at any time request the registration of a change in the name, address or other particulars relating to the owner. The change shall have legal effect vis-à-vis third parties as soon as it has been registered with the IP Office. (DO-A-150.1)
- In JM, the Office shall enter in the Register of Designs changes of name, changes of address and particulars as to mergers and other changes in legal nature of registered proprietors of registered designs (JM-A-100.1)

15.4 Surrender (renunciation of limitation) of the registration

Under the Hague System, the holder of an international registration may renounce its registration in respect of all the industrial designs that are the subject of the registration and of some or all of the designated Contracting Parties (Article 16.1.iv). The holder may also request the recording of a limitation of the international registration, which implies renouncing its registration in respect of only some of the industrial designs contained therein, but never all, and in relation to any, or all, of the Contracting Parties (Article 16.1.v). A request to record a renunciation or a limitation is subject to the payment of a fee. The International Bureau promptly records the renunciation or the limitation in the International Register and publishes a notice thereof (Article 16.4, Rule 21).

- In AG, BZ, DM, LC, VC and TT, the owner of a registered industrial design may surrender it by written declaration submitted to the Office, which shall record the surrender in the Register and publish it appropriately. The surrender shall have effect from the date on which it is recorded. (AG-A-12) (BZ-A-12) (DM-A-12) (LC-A-11) (VC-A-11) (TT-A-11). In DM, a design registration that is owned by several persons shall not be surrendered without permission of all the owners of the design (DM-R-34).
- In BS, the deposit of a claim to design copyright may be cancelled by the Office upon a request made by the proprietor (BS-A-38)

- In BB, a registered owner of an industrial design may renounce registration by a written renunciation addressed to the Director. A renunciation may be limited to one kind of product or to one class of product, or, if the registration relates to several industrial designs, to some only of those designs. Upon receiving a renunciation, the Director shall record it in the register and publish a notice of the renunciation in the Gazette as soon as possible. A renunciation of an industrial design has no effect until it is recorded in the register. (BB-A-36)
- In CU, the holder of a registered industrial design may renounce the registration, in whole or in part, in writing addressed to the Office. No fee is due. If there is more than one holder, the surrender has to be signed by all (CU-A-58, 114, 125.2). If a right of a third party deriving from the registration is registered at the Office, the surrender can only be accepted with the express consent of the third party (CU-A-59, 114)
- In DO, the renunciation, reduction, limitation or voluntary cancellation, in whole or in part, of an industrial design registration shall be made with the common agreement of all the co-owners (DO-A-136.1.f)

16. INVALIDATION

Under the Hague System, the competent authority (whether administrative or judicial) of a designated Contracting Party may revoke, cancel or invalidate the effects, in the territory of that Contracting Party, of an international registration with regard to all or some of the industrial designs covered by the designation of that Contracting Party (Rule 20). Proceedings concerning such invalidation take place directly between the holder of the international registration, the party who has brought the action for invalidation and the competent authority concerned (Office or tribunal). Where the effects of an international registration are invalidated (in whole or in part) in a Contracting Party, and the invalidation is no longer subject to any appeal, the Office of that Contracting Party, where it is aware of the invalidation, must notify the International Bureau of the relevant facts. The International Bureau records the invalidation in the International Register, together with the data contained in the notification, and it publishes the invalidation in the International Designs Bulletin (Rule 20).

- In AG, LC, VC and TT any interested person may apply to the Court to invalidate the registration of an industrial design. The Court shall invalidate the registration if the person requesting the invalidation proves that any of the registration requirements (compliance with

the definition of industrial design, novelty, and not being contrary to public order or morality) is not fulfilled or if the registered owner of the industrial design is not the creator or his successor in title. An invalidated registration of an industrial design, or part thereof, shall be regarded as null and void from the date of the registration. The final decision of the Court shall be notified to the Registrar/Controller who shall record it and publish a reference to it as soon as practicable. (AG-A-13) (LC-A-12) (VC-A-12) (TT-A-12)

- In BS, at any time after a claim to design copyright has been deposited, any person interested may apply to the Court for cancellation of the deposit on any one or more of the following grounds, that is to say: (a) that the deposit was obtained by or in the name of a person not entitled thereto; (b) that the design or a representation thereof was published before the priority date of the claim by, on behalf of, or with the consent of, any proprietor thereof; (c) that the design was not an original work in respect of the feature stated in the deposit to be original; (d) that the design is the same as a design of, or for, the same or any other article by the same author which has been previously published or deposited by, on behalf of or with the consent of the author or any proprietor thereof, or differs from such design in modifications or variations not sufficient to alter the character or substantially affect the identity thereof (BS-A-39.1).
- In BB, proceedings requesting that the registration of an industrial design be declared invalid may be instituted in the High Court by any interested person. After hearing the parties to the proceedings, the High Court may declare the registration invalid if (a) the industrial design ought not to have been registered because of its being likely to provoke a breach of the peace; (b) the industrial design is not an industrial design within the meaning of the definition given in the law; (c) the industrial design is not new; (d) the same industrial design had been previously registered following an earlier application or following an application benefitting from an earlier priority; or (e) the industrial design was usurped. When the application for registration included several designs and the proceedings for a declaration of invalidity of the registration relates only to some of the industrial designs, the decision of the court applies only to the industrial designs to which the proceedings relate. (BB-A-40) When the registration of an industrial design is declared invalid in whole or in part by the High Court, the registration is, to the extent decided by the court, invalid from the date of the impugned registration. (BB-A-41.1)
- In BZ, DM, the Court may, on the application of any interested party, invalidate the registration of an industrial design either wholly or in part or in respect of any particular article in connection with which the design is registered on any of the following grounds: (a) that the design is not new; (b) that the applicant for registration is not the owner or his

successor in title; (c) that the application was made with the intention of defrauding the owner; or (d) any other ground on which the Registrar could have refused to register the design. An application for the invalidation of a design shall be served on the person in whose name the design is registered and lodged with the Court in the manner and within the time prescribed. An invalidated registration of an industrial design, or part thereof, shall be regarded as null and void from the date of the registration. The Registrar of the Court shall notify the Registrar of the decision of the Court to invalidate a design and the Registrar shall publish a reference thereto in the Journal as soon as possible. (BZ-A-14) (DM-A-14)

- In CU, an industrial design registration shall be declared null and void, in whole or in part, in the following cases: (a) where it has been granted without observance of the conditions laid down for refusal; (b) where it infringes the provisions in force at the time when the registration was granted, or, (c) where it was granted on the basis of false, inaccurate or omitted information. If the grounds for invalidity concern only part of the contents of the registration, partial invalidity shall be declared by striking out the designs affected by those grounds. (CU-A-115). The procedure that may lead to a decision of the DG of the Office declaring an industrial design registration invalidated or cancelled is detailed in the Regulations (CU-R- 72 to 76).
- In DO, at the request of any interested person, and after hearing the owner of the registered industrial design, the IP Office shall declare the registration null and void if it was made in contravention of any of the provisions of law. The request for a declaration of invalidity may be filed as a counterclaim in any action for infringement relating to the registered industrial design. (DO-A-68). The Office shall invalidate an industrial design registration where it has been granted to a person who is not entitled to it. In this case, annulment may only be requested by the person who claims to be entitled to the industrial design, and the action shall be barred after five years from the registration of the design. (DO-A-34). The effects of a declaration of invalidity shall be retroactive to the date of the registration, without prejudice to the conditions or exceptions laid down in the decision declaring the invalidity. (DO-A-156.1)
- In JM, the registration of a design may, on the application of any interested person filed in the prescribed form and upon payment of the fee prescribed, be revoked by the Office on the ground that the requirements for registration were not met (JM-A-98).

17. APPLICATION OF INTERNATIONAL TREATIES IN RESPECT OF INDUSTRIAL DESIGNS

17.1 Membership in international treaties dealing with industrial designs

17.1.1 Paris Convention

As of 15 December 2021, 178 States are parties to the Paris Convention (1883). As regards the substantive provisions of the Convention are concerned, 168 States are bound by the Stockholm Act (1967), seven are bound by the Lisbon Act (1958), two are bound by the London Act (1934) and one is bound by the Hague Act (1925).

In the CARIFORM region,

- AG, BB, BZ, CU, DM, JM, LC, VC and TT are bound by the Paris Convention as last revised in Stockholm (1967)
- BS is bound by the substantive provisions of the Lisbon Act (1934) and the administrative provisions of the Stockholm Act (1967)
- DO is bound by the Hague Act (1925)

17.1.2 TRIPS Agreement

As of 15 December 2021, the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) applies to all the 164 Members of the World Trade Organization (WTO).

In the CARIFORUM region,

- AG, BB, BZ, CU, DM, DO, JM, LC, VC and TT are Members of the WTO and apply the TRIPS Agreement, including Article 2 which prescribes that Members shall comply with Articles 1 through 12 and Article 19 of the Paris Convention Stockholm Act (1967).

17.1.3 Geneva Act (1999 Act) of the Hague Agreement

As of 15 December 2021, the Geneva Act (1999) of the Hague Agreement has 66 Contracting Parties, including 64 States and two intergovernmental organizations, covering overall the territories of 91 countries.

The Economic Partnership Agreement (EPA) provides that the EC Party and the Signatory CARIFORUM States shall endeavour to accede to the Hague Agreement for the International Registration of Industrial Designs (1999) (EPA. Article 146.A) ¹⁰

In the CARIFORUM region

- Belize acceded to the Hague Agreement (1999 Act) on February 9, 2019
- Suriname acceded to the Hague Agreement (1999 Act) on September 10, 2020
- Jamaica deposited its instrument of accession to the Hague Agreement (1999 Act) in November 2021 and will become a party to this treaty on February 10, 2022.

17.2 Application of international treaties

- In AG, BZ, DM, LC and TT, the provisions of any international treaty in respect of industrial property to which the country is party shall apply to matters dealt with in the Industrial Designs Act. In case of conflict, the provisions of the treaty shall prevail (AG-A-23) (BZ-A-26) (DM-A-26) (TT-A-23) or the provisions of the Act shall be construed to give effect to the provision of the relevant treaty (LC-A-23).
- In CU, in matters regarding industrial design registration, the corresponding international conventions and treaties to which the Republic of Cuba is a party shall apply (CU-A-51.1).
- In JM, where there is a conflict between a provision in the 1999 Act of the Hague Agreement and a provision in the Patents and Designs Act, 2020, or where the Act is silent on any aspect concerning international applications or international registrations for designs, the 1999 Act shall prevail (M-A-106.2)

¹⁰ The European Union acceded to the Hague Agreement (1999) on January 1, 2008.

18. CONCLUSIONS

The laws and regulations of the eleven CARIFORUM States analysed in this document provide for the registration (deposit) and protection of registered (deposited) industrial designs in line with the relevant provisions of the Paris Convention and the TRIPS Agreement.

AG, BB, BZ, DM, LC, VC and TT have enacted separate laws and regulations dealing exclusively with the registration of industrial designs, whereas BS and DO have integrated their industrial design provisions within their industrial property laws and regulations, and CU and JM have done so within their laws and regulations dealing with both patents for invention and industrial designs.

The laws of AG, BZ, DM, LC, VC, and TT, adopted between 1996 and 2005, have quite similar structures and content. On the other hand, the laws of BS (1965), BB (1981), DO (2000), CU (2011) and JM (2020) are structured quite differently, particularly those which also deal with other IP rights (BS, DO, CU and JM).

From the viewpoint of substance, these laws have adopted relatively similar provisions regarding the definition of industrial design, registrable industrial designs and scope of protection of design rights. However, they show some significant differences regarding certain matters, including, *inter alia*, the following:

- *requirements for protection* – whereas the vast majority of laws require designs to be *new* to deserve protection, only BS requires *originality* instead of *novelty*; only CU, DO and JM specify in their laws that the design shall also have *individual character* as a requirement for registration.
- *designs excluded from protection* – whereas designs that are contrary to public order or morality are excluded from registration in all these countries, the laws of CU, DO and JM (more recently enacted) provide for several other reasons why certain designs may be excluded from protection.
- *maximum duration of protection* – whereas nine countries (AG, BS, BB, BZ, DM, DO, JM, LC, TT) provide for a maximum duration of protection for designs of 15 years, another two (CU, VC) provide for a maximum duration of design rights of only 10 years.

- *exhaustion of design rights* – whereas seven countries (AG, BB, BZ, DM, LC, VC, TT) provide for the national exhaustion of design rights, another three (CU, DO, JM) provide for their international exhaustion.

There are also some significant differences regarding procedural matters dealt with in the relevant laws. For example, regarding the following:

- *substantive examination of design applications* – whereas ten IP Offices (AG, BB, BZ, CU, DM, DO, JM, LC, VC, TT) shall examine whether the design complies with the legal definition of design and is not contrary to public order or morality, four of those Offices (BB, CU, DO, JM) are required by law to also examine other matters, including as to whether the design is new (worldwide novelty requirement) and contains no other matter otherwise excluded from protection.
- *opposition* – whereas the laws of CU and JM provide for the possible opposition to registration by interested third parties, the laws of the other nine countries do not provide for such possibility.
- *publication of the design* – whereas the laws of CU and JM provide for the publication of design applications, the laws of AG, BS, BB, DM, LC, VC and TT provide for the publication of designs only after registration.

A regional effort to harmonize the design protection regimes of the CARIFORUM States in the abovementioned areas may prove to be difficult as it would imply reaching agreement on quite a number of matters requiring significant substantive amendments to the relevant laws.

Nevertheless, the IP Offices of the CARIFORUM States may wish to consider working together on some cooperation and convergence initiatives that may help raise the visibility of their design systems and convey the message that the CARIFORUM region as a whole offers a modern and attractive framework for the protection of design rights in the benefit of both national and foreign creators and companies.

18.1 Possible areas of cooperation and convergence

The following paragraphs briefly describe some ideas regarding possible areas in which the IP Offices of the CARIFORUM States may wish to work jointly on common initiatives concerning industrial designs.

Industrial design common forms

In spite of current differences regarding some requirements concerning the content of industrial design applications in the laws and regulations of the various CARIFORUM States, their IP Offices could work together in trying to elaborate a common application form that would give visibility to the CARIFORUM IP Offices as a group and would facilitate the filing of applications both by nationals and foreigners. Such common application form should, initially, allow for the indication of any of the 22 elements currently required by one or more such Offices and contain notes explaining what is required by each Office. In the course of this exercise, the CARIFORUM IP Offices may be able to assess to what extent it would be possible to aim towards achieving a further degree of harmonization of such requirements, either through the adoption of Office instructions or proposals for amendment of the relevant regulations. A similar exercise could be undertaken regarding also other forms, for example, those used to request the recording of various types of entries in the national Design Registers, such as a change in ownership, licenses, or changes in names or addresses.

Industrial design electronic filing platform

An initiative that would give enormous visibility to the CARIFORUM IP Offices in the industrial design field would be to offer a common platform for the electronic filing of industrial design applications and related requests. Based on the initiative mentioned above (regarding the elaboration of common industrial design forms), the CARIFORUM IP Offices could work together in developing such an electronic filing platform, possibly with the external support of another IP Office currently offering similar facilities. This would be a very attractive tool for creators and companies wishing to apply for the protection of their industrial designs in the CARIFORUM region.

Common practice regarding industrial design classification

The laws or regulations of all the CARIFORUM States analysed in this document, with the only exception of those of BS and BB, expressly provide for the application of the Locarno Classification for the purposes of the classification of products for which a design may be registered. The law of DO, moreover, clarifies that the International Classification is applied as revised and updated. In

the context of the implementation of the Hague System, the WIPO International Bureau also applies the latest version of the Locarno Classification (13th edition that came into force in January 2021), which currently consists of a list of 32 classes and 228 subclasses that contain over 5 000 acceptable terms to describe the product indications for which a design may be registered. It would be desirable that all the IP Offices in the CARIFORUM region apply the latest edition of the Locarno Classification in the course of their design procedures in order to favour consistency in classification practice.

Additionally, it should be recalled that the list of indications in the Locarno Classification is not exhaustive and does not provide a product indication for every possible type of product for which a design may be registered. As a result, there is a risk that product indications that are not contained in the Locarno Classification are treated differently by the different IP Offices in the CARIFORUM region. This creates uncertainty for users as they may not be able to count on a unique list of product indications being accepted at all those offices. Therefore, it might be interesting for the CARIFORUM IP Offices to work together towards establishing a larger list of indications that are accepted by all their Offices and that should, obviously, cover all those contained in the Locarno Classification list. A similar effort has been undertaken by the IP Offices of the European Union, which have adopted a common practice (CP7) in this area and have created a harmonised database of approximately 16,300 product indication for the purposes of design classification. The harmonised database of product indications provides the input for an intuitive and easy-to-use design classification tool – DesignClass – in which applicants can search for and select the most suitable product indication for their design and examiners can verify the acceptability of terms. DesignClass incorporates additional divisions of Locarno subclasses into groups and subgroups to further improve the intuitiveness of searches. As a result, both those IP offices and users now enjoy a more consistent mapping of products, simplified priority checks, novelty searches, and, most importantly, greater legal certainty.

Meanwhile, the CARIFORUM IP Offices may consider already participating individually in the abovementioned DesignClass tool, indicating the terms that each of them accepts. This would contribute to their international visibility and facilitate the work of their examiners and of the user community as a whole.

Dissemination of information regarding industrial designs in the CARIFORUM region

Another area in which the CARIFORUM IP Offices may wish to join efforts concerns the dissemination of industrial design information already published in their respective countries (both concerning registered designs and, where applicable, designs applied for registration). Here again, offering a common CARIFORUM platform over the Internet, where the public could get free and easy access to such information, would highly contribute to the visibility of the CARIFORUM IP Offices and offer a useful tool for potential design applicants. Meanwhile, the CARIFORUM IP Offices may consider participating already, individually, in the international design databases DesignView and WIPO Global Design Database.

Participation in the WIPO DAS for priority documents

As mentioned earlier in the body of this document, in 2012, WIPO launched the WIPO Digital Access Service (DAS), an electronic system allowing priority documents to be securely exchanged between participating IP offices. This system enables applicants and offices to meet the requirements of the Paris Convention for certification in an electronic environment. IP Offices may participate both as a Depositing Office (usually the office of first filing allowing applications to be made available to other offices through DAS) and as an Accessing Office (where the office – acting as office of second filing – allows the applicant to request that a priority document be retrieved through DAS rather than filing a certified copy). At present, 17 IP Offices from around the world participate in WIPO DAS both as depositing offices and accessing offices for industrial design priority documents, including four offices of developing countries (Chile, Colombia, India, and Mexico). Another four IP Offices (including Brazil) participate in WIPO DAS only as depositing offices for industrial design priority documents. So far, none of the IP Offices of the CARIFORUM States participate in the WIPO DAS. Their participation in this service, both as depositing and accessing offices for industrial design priority documents, would contribute to give visibility to these Offices and would be extremely helpful for creators and companies wishing to obtain protection for their designs.

Substantive examination manual

The CARIFORUM IP Offices may also wish to cooperate in the elaboration of a common manual on the substantive examination of industrial design applications that would help harmonize the interpretation of certain concepts regarding registration requirements that are to be examined by law in all or in some of their Offices, and provide examples of acceptable and non-acceptable designs, preferably based on case law.

Regarding requirements that are common to all the CARIFORUM States, such manual could focus, for example, on developing a common understanding of what constitutes an industrial design in accordance with the definitions given in their respective laws, and could elaborate on the concepts of configuration, industrial applicability, and arbitrary appearance of the design to the exclusion of any technical or functional feature. The manual could also elaborate on the exclusion from registration of designs that are contrary to public order or morality, a requirement that is common to all the CARIFORUM States.

In respect of those CARIFORUM IP Offices that are required by law to examine whether a design is new, has individual character and is not otherwise excluded from protection, the manual could elaborate at least on the concepts of worldwide novelty, disclosures that do not affect novelty, and individual character.

Participation in the Hague System

As mentioned earlier, as of 15 December 2021, the Hague Agreement 1999 Act has 66 Contracting Parties, including 64 States and two intergovernmental organizations, covering overall the territories of 91 countries. In the CARIFORUM region, Belize and Suriname are already parties to this treaty and Jamaica will become a party on February 10, 2022.

Accession to the Hague Agreement 1999 Act by those CARIFORUM States that are not yet party to this Act, would offer important advantages to them, as it would directly benefit their countries' innovative sectors in the field of design, and indirectly their countries' economies as a whole. Design creators and companies producing and marketing design products in the CARIFORUM States would be able to obtain and maintain protection for their industrial designs with a minimum of formalities and expenses, in a much simpler and cheaper way than at present. They would thus be in a better position to sell their products in export markets with the added value of doing so with their own designs. This would help them increase their competitiveness and may open up new opportunities for them for licensing, franchising or other forms of business collaboration. Accession to the 1999 Act of the Hague Agreement would likely have a very positive impact on the economy

of the CARIFORUM States, since the major trading partners of these States, in particular those that are the destination of most of their exports, are already parties to the Hague System.¹¹

A joint policy decision by the CARIFORUM States to join the Hague Agreement (1999 Act) would certainly be beneficial for all of them.

Design model law and regulation

Another initiative on which the CARIFORUM IP Offices may wish to join efforts could consist of the elaboration of a design model law and regulation that would take into consideration the relevant provisions of the TRIPS Agreement and the Economic Partnership Agreement (EPA) with the European Union, and would also incorporate provisions for the implementation of the Hague Agreement (1999 Act) as well as other international good practices in the industrial design field. Such an exercise would be particularly useful for those countries that may wish to review their current legislation in favour of a more modern and Hague-friendly law.

Feasibility study regarding a possible regional design system

Finally, the CARIFORUM States may wish to explore the feasibility of setting up a regional system for the registration of industrial designs with a regional office registering design rights that would be valid in all their countries. A regional system of this type would represent a more ambitious form of integration but not necessarily mean the elimination of the national systems that already exist in the region. In the European Union, for example, the Community design system coexists with the national design systems of the various member States. Of course, undertaking a feasibility study on this matter would imply taking into account not only legal considerations but also the very significant economic implications of setting up such a regional system.

[Annex A follows]

¹¹ It should be recalled that some 70% of the products exported by Caribbean companies go to Hague Union Members, about half of them to the United States (33%) and the European Union (17.9%), large volumes also being exported to other Hague Union Members such as Switzerland, Canada, United Kingdom, Mexico, Republic of Korea, Japan, Singapore, Russian Federation, etc.

ANNEX A

INDUSTRIAL DESIGN LAWS AND REGULATIONS ANALYSED IN THIS DOCUMENT

For the purposes of the analysis undertaken in this document, the following texts have been consulted:

Antigua and Barbuda – AG

- AG-A Industrial Designs Act 2003, N° 19 of 2003
- AG-R Industrial Designs Regulations, 2006

Bahamas – BS

- BS-A Industrial Property Act 1965, amended 1974, 1975, 1987, 1994 (2001)
- BS-R Industrial Property Rules, 1967, S.I. 1975, 1983, 2003, 2004 (2006)

Barbados - BB

- BB-A Industrial Designs Act (Chapter 309A), 1981-57, as amended by Act 1988-6
- BB-R Industrial Designs Regulations, 1984

Belize - BZ

- BZ-A Industrial Designs Act, revised edition 2000
- BZ-R Industrial Designs Regulations, 16 of 2001, revised edition 2003
- BZ-106 Industrial Designs (Electronic Filing) Administrative Instructions, 2006

Cuba – CU

- CU-A Decreto-Ley 290 de las Invenciones y Dibujos y Modelos Industriales, 2011
- CU-R Reglamento del Decreto-Ley 290, Decreto 342, 2018

Dominica – DM

- DM-A Industrial Designs Act 1998
- DM-R Industrial Designs Regulations 2008

Dominican Republic – DO

- DO-A Ley de Propiedad Industrial, 20 de 2000, modificada por las Leyes 424 y 493 de 2006
- DO-R Reglamento de Aplicación de la Ley sobre Propiedad Industrial, Decreto 599 de 2001

Jamaica – JM

- JM-A Patents and Designs Act, 2020

Saint Lucia -LC

- LC-A Industrial Designs Act 2001, revised edition 2015
- LC-R Industrial Designs Regulations, 2003

Saint Vincent and the Grenadines – VC

- VC-A Industrial Designs Act, 2005
- VC-R Industrial Designs Regulations, 2009

Trinidad and Tobago – TT

- TT-A Industrial Designs Act, 1996
- TT-R Industrial Designs Rules, 1996

[Annex B follows]

ANNEX B

PRACTICE FICHE ON GRAPHIC REPRESENTATION OF DESIGNS IN (SELECTED) CARIFORUM IP OFFICES

<https://internationalipcooperation.eu/en/caripi/news/practice-fiche-concerning-graphic-representation-designs-participating-ip-offices>

[End of document]