

ECTA

European Communities Trade Mark Association

32nd ANNUAL CONFERENCE

THE JURY IS STILL OUT

BUCHAREST, 19-22 June 2013



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OHIM CONVERGENCE PROGRAMMES REGARDING DESIGNS

20 June 2013

António Andrade

Chair of ECTA Design Committee

 **VIEIRA DE ALMEIDA**
& Associados Sociedade de Advogados, R.L.



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Dear Friends of OHIM



Please consider the following issues

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Strike while the iron is hot

STRIKE WHILE THE IRON IS NOT SO HOT...

- Efforts to achieve convergence in the way offices around the world operate have led to only modest results
- Within the EU, there is still a long way to go in order to iron out the discrepancies among the 27 offices
- There are still unnecessary differences of practices that need to be addressed in order to strengthen the trade mark and design protection in Europe

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Always the sun....

ALWAYS THE TRADEMARKS ®

- **WHAT ABOUT DESIGNS?** a long way to convergence notably when considering the CDR and IR – Hague System (WIPO)
- Convergence of formalities requirements in national and international design registration laws in order to:
 - i. simplify and harmonise these formalities, saving cost and duplication of effort for applicants and
 - ii. reduce the current uncertainty as to the legal effect of design registrations arising from different national rules and practices on the interpretation of representations in design registrations

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Global Harmonization

- RCD (direct registered Community design filings at OHIM) and International (Hague Agreement - IR) filings where only the OHIM is designated in the IR
- There are no differences in the legal effect of a RCD obtained directly as opposed to an international registration designating OHIM. The comparison really concerns speed, ease of use and costs, with a few issues concerning the application as a basis for protection outside the UE
- Harmonization of national practices (IPOs)

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Comparison RCD v. IR

- Fees
- Eligible Applicants
- Priority claims
- Timescales
- Representations and multiple designs
- Languages
- Prosecution bureaucracy
- Post grant administration
- Searching RCDs and IRs designating OHIM
- Representations and multiple designs

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2012

A Year of Achievement

- What a year it's been for the Cooperation Fund, and for the Convergence Programme
- 2012 saw great success for both, and concrete results – a tribute to the dedication of the teams at national and Benelux offices, EPO, WIPO, user associations and OHIM

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Main Issues – 2013 (...)

- The Design View – continuing the improvement...
- Postponing of a filing date if the representations need to be amended to exclude background material, etc
- Need of Convergence of practice on **design representations** – a convergence project on this and other design law issues can be expected at the beginning of 2014

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Main Issues – 2013 (...)

- Practice surveys disclosed a complete diversity of practice in the IPOs on many substantive issues
- Priority claims
- Disclosure
- Procedural practice aligned with CTM

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Main Issues – 2013 (...)

- Moving images and methods of publication of designs, including new three dimensional CAD style representations
- What is required for the future?
- Everywhere except Denmark you can file black and white representations based on a coloured representations priority filing but not the other way around

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Main Issues – 2013 (...)

- Drawings and their interpretation
- The maximum 7 representations rule from RCD – removal?
- The WIPO review in November last year on the Hague Agreement disclosed wide variations in practice even in Europe
http://www.wipo.int/meetings/en/details.jsp?meeting_id=25018
- The Apple v. Samsung cases showed the need for a coherent regulation of the matter

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Good achievements

- DesignView (project has gone live November 2012)
- GR OBI, ES, BG, BX, SK, EE and PT have all integrated their databases successfully!
- Implementation of convergence – regular meetings (ABBC)

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What we should expect?

- Convergence of practice on design representations – beginning of 2014
- Integration of IPOs databases
- Alignment of practices with IPOs
- Alignment with WIPO/ Hague System

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With kind regards

Mulțumesc – Thank you!



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