



## ExCo MEETING Turin, Italy 31 March to 4 April 2019

WORKING DOCUMENT			
<i>[EXECUTIVE SUMMARY TO BE PROVIDED IF THE EXCO PAPER ITSELF IS MORE THAN 2 PAGES LONG]</i>			
TITLE:	Briefing Paper for Resolution no. 1203 (Priority Claims)		
DRAWN UP BY:	CET 2 – the topic was led and drafted by Chair Gabriel Di Blasi and Reporter Jürgen Büchhold		
PURPOSE:	For approval		
CONFIDENTIALITY:	<b>confidential</b> (accessible only to FICPI ExCo attendees):	<input type="checkbox"/>	{select one box only}
	restricted (accessible to all ExCo attendees):	<input checked="" type="checkbox"/>	
POST-ExCo	access to remain restricted post-ExCo:	<input type="checkbox"/>	{select one box only}
AVAILABILITY:	document to be made openly-available post-ExCo:	<input checked="" type="checkbox"/>	

This document aims to discuss how jurisdictions take into consideration the Priority Right, as set out by the Paris Convention Treaty, applying it to Industrial Design Applications.

This topic was proposed by Chair Gabriel Di Blasi, as Brazil understands that this right should only be granted to Priority Applications which presents the representations as an exact match of the first original application – as explained in more detailed fashion below. The topic was then accepted by FICPI Executive Committee during the meeting in Athens, 2018 – and discussed within the group during Toronto 2018 meeting.

CET 2 conducted a questionnaire so that a perspective could be drawn as to how different PTOs conduct this analysis in daily practice.

### 1- Overview of the Paris Convention Treaty and Multiple Design Application Guidelines

The Paris Convention Treaty, as adopted in September 1979 and entered into force in June 1984, establishes a set of ground rules on Intellectual Property rights. The core of the question studied by the group lies in articles 4 A (1) and 4 C (1) of the Treaty, which state:

A - (1) Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, 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 the periods hereinafter fixed

C - (1) The periods of priority referred to above shall be twelve months for patents and utility models, and six months for industrial designs and trademarks

In order to evaluate how priority rights are accessed in multiple jurisdictions, please refer to the list below of multiple updated Industrial Design Guidelines from different countries– apart from the example of Spain, in which the country goes a step further by enacting, in Law, that designs can only be considered the same if they only differ in irrelevant ways.

#### a. Australia

[http://manuals.ipaustralia.gov.au/designs/examination/6\\_priority\\_dates/6.2\\_priority\\_date\\_-\\_convention\\_applications.htm](http://manuals.ipaustralia.gov.au/designs/examination/6_priority_dates/6.2_priority_date_-_convention_applications.htm)

D06.2.4 The Basic Application



Assuming the priority document was on file at the formality check stage, there will be no detailed consideration of whether the priority application is for the same design. The issue will only be raised if it is noticed that the design of the foreign application is completely different from the design of the application – which may lead to the question of whether the correct convention application has been specified. (See D015.2.6)

b. Canada

<https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr00260.html>

3.4.3 Priority right in respect of only certain figures in the drawings

In the case of an industrial design application with a priority claim where the applicant specifies that priority is claimed with respect to only certain figures in the application (not all figures):

- If all of the figures in the application are considered to disclose the same design (either one design or variants), the priority right is considered to apply to the entire application, i.e., the entire Canadian application is deemed to have the same force and effect as if filed on the filing date of the priority application.
- On the other hand, if the figures in respect of which priority has been claimed disclose a design that is substantially different from the design disclosed by the other figures, the latter figures must be removed from the application and could be made the subject of a divisional application. The priority right is considered to apply to the "parent" application but would not apply to the divisional, i.e., the divisional is not deemed to have the same force and effect as if filed on the filing date of the priority application. The filing date of the divisional application would be the same as the filing date in Canada of the parent.

c. South Korea

[http://www.kipo.go.kr/kpo/user.tdf?a=user.english.html.HtmlApp&c=93003&catmenu=ek04\\_02\\_02\\_01](http://www.kipo.go.kr/kpo/user.tdf?a=user.english.html.HtmlApp&c=93003&catmenu=ek04_02_02_01)

2) Claim of Priority

The right of priority may be claimed for a design application under the Paris Convention or international treaties such as on a bilateral or multilateral agreement. A person claiming a right of priority under paragraph (1) of this Article shall file an application for design registration within six months of the filing date of the earlier application that serves as the basis for claiming the right of priority.

d. Spain

<https://wipo.lex.wipo.int/en/text/126758>

Spanish Law set forth that both design application and its priority are considered as identical if their features differ only in non-relevant details. (article 6.2. of Law 20/2003, of 7th July, on the Legal Protection of Industrial Designs)

6.2: Shall be considered identical the designs which the characteristics are only different in irrelevant ways.

e. Europe

[https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/contentPdfs/law\\_and\\_practice/designs\\_practice\\_manual/WP\\_Designs\\_2018/examination\\_of\\_applications\\_for\\_registered\\_community\\_designs\\_en.pdf](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/designs_practice_manual/WP_Designs_2018/examination_of_applications_for_registered_community_designs_en.pdf)

The Community design relates to the 'same design or utility model'.

The subject matter of the previous application must be identical to that of the corresponding Community design, without the addition or deletion of any features.

According to Article 5(2) CDR, the subject matter is considered to be identical if the Community design and the previous application for a design right or a utility model differ only in details that can be qualified as 'immaterial'.

The identity of the subject matter may not be affected when, on account of diverging formal requirements, the representation of the design as shown in the previous application has to be altered in order to be filed as a Community design (15/05/2013, ICD 8 683).



## 2- Current Status in Brazil

As mentioned in the introduction, the topic arose as Brazil is currently implementing its first Industrial Design Guidelines. In 2018, a draft version of the guidelines was submitted for public consultation, and despite a number of NGOs having pointed out the incorrect treatment of priority rights, the BPTO has not changed its opinion, publishing a directive that will be effective as of March 2019.

The following is the BPTO's position on Priority Claims for Industrial Designs:

### 5.1 Analysis of the Priority Right document

While undertaking technical analysis, in alignment with the legal opinion of the Attorney General Office no. 0044-2016-AGU.PGF.PFE.INPI.COOPI-DJT-1.0, it will be verified if the industrial design applied for is integrally correspondent to the one represented in the drawings or photographs of the priority document. The correspondence will be verified in terms of the matter to which protection is applied for in the pictures.

During the technical examination, if there is a divergence between the application document and the priority document, an Office Action will be issued requiring that the priority document that corresponds to the design application filed in Brazil is presented. The lack of compliance will lead to the publication of loss of priority right.

The legal opinion mentioned in the Guidelines expresses the following:

"22. In essence, what is examined is whether, in light of the current legal framework, there is a need that, considering industrial designs, the subject that is the object of application subjected to the BPTO must correspond *ipsis litteris* to the matter in the priority document, or, in other words, if there must be strict and absolute identity between the object subject to design application in Brazil and the priority application it refers to.

[...]

29. In fact, the Paris Convention, in its article 4, "F" and "H", refers to patents only. At least that is what it says literally, as it can be seen below:

[...]

30. It must be observed that both items specify the scope of application of the norm, whether referring to patents expressly (section F), or making a correlation with inventions (section H), a figure which protection is typically via patents.

[...]

32. It appears that there is no space for interpretation of the Paris Convention Treaty that allows certain flexibility to the industrial design application based on Priority rights, so as to protect priority claims in which the figure of the filed object is not in conformance with the priority document.

[...]

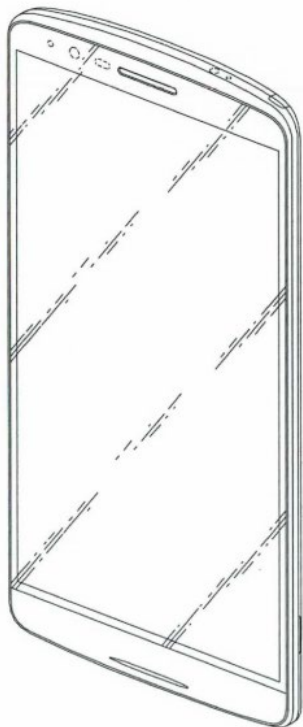
34. It is safe to deduct that the Paris Convention Treaty does not contain provisions that legitimize priority rights for industrial design applications which contain a figure diverse from the one depicted in the priority document.

[...]

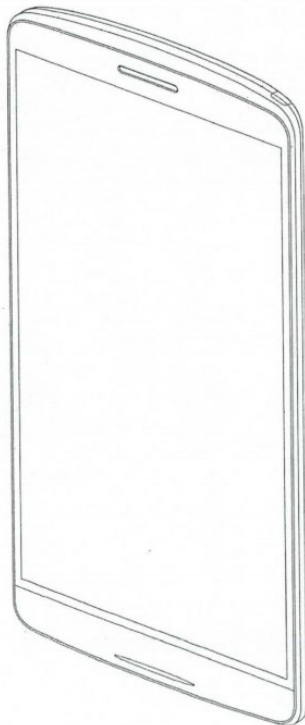
47. In view of that, there is no law in force, national or international, that grants the applicant of industrial design applications the priority right in case the object in analysis of the application filed in the country differs from the design in the priority document, and the BPTO should, therefore, have a strict position regarding the verification of correspondence between the



representations before granting priority rights, according to the principle of legality contained in article 37 of the Constitution of Brazil.”



Priority application



Brazilian application as filed

configuration applied to mobile phone. The priority was lost in Brazil.

3- The survey conducted

In order to evaluate whether the BPTO’s understanding of the application of Priority Rights is echoed in the other PTOs, CET 2 conducted a survey amongst its members.

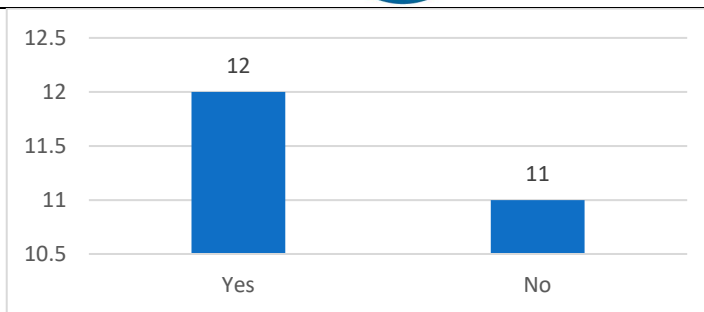
The survey collected the replies of representatives of 23 countries: AR, AU, AT, BR, CA, CN, CH, DE, FI, GB, IR, IT, JP, KR, MX, NZ, NO, PH, PT, RO, TR, US, ZA

The full questionnaire and individual responses per jurisdiction can be accessed in the annex (EXCO/IT19/CET/1203-annex).

Below is a summary of the responses and evaluation of the results:

**Priority Right Subject to Substantive Examination**

**Question 1:** Is the Priority right in your jurisdiction subject matter of a substantive examination procedure?

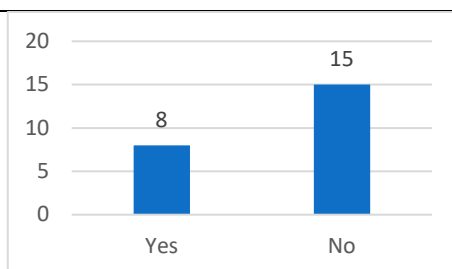


**Analysis:** This result shows that the world of design applications is divided into two parts.

- Countries conducting a substantive examination whether a design applied for fulfills the protection requirements of novelty and individual character usually also examine the effectiveness of a priority claim. - The priority claim, however, will normally only be regarded if it is relevant for patentability (e.g., whether there is an intervening prior art reference).
- Countries carrying out only a formal examination of a design application assume the validity of a formal correct priority claim in favor of the applicant. They shift the question of the effectiveness of a priority claim into subsequent procedures and authorities – namely cancellation or nullity proceedings and infringement proceedings.

### Priority Claim Examination

**Question 2a:** Do formal or non-substantial differences between the representation of a Design priority application filed in your jurisdiction and its original application counterpart lead to a rejection of the priority right?



**Analysis:** In principle, the first design application and the subsequent application must relate to the same design, with a majority of countries considering only the real subject matter of the design, consequently the disclosed and pictured features of the design.

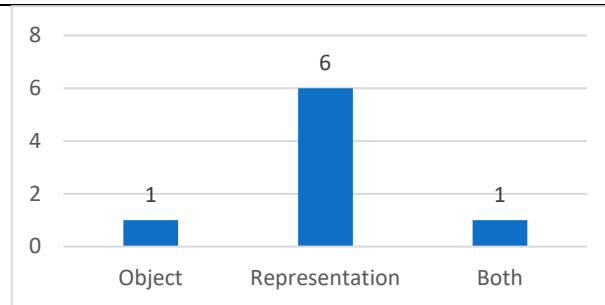
Purely formal differences or deviations in immaterial details of the design do not annihilate the effectiveness of a priority claim.

However, some countries also attach importance to the formal requirements and to differences in non-substantial details.

For those countries, there was a following question:



**Question 2b:** If yes, is the Priority right analyzed by the Examiner taking into consideration the object itself or its representations?

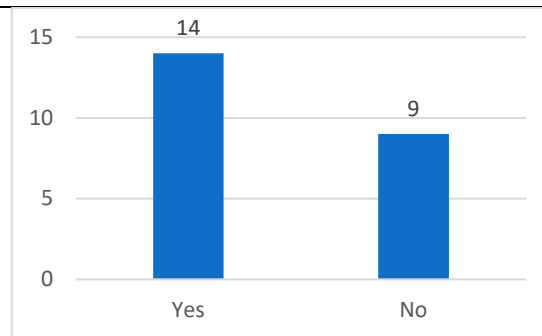


**Analysis:** If formal or non-substantial differences between the first and the subsequent design application occur, the examination of the validity of the priority claim is predominantly carried out on the basis of the representations of the design.

Only AR considers both, the object itself and its representations.

CN considers the object.

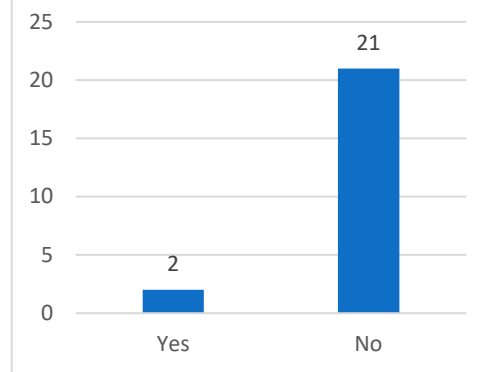
**Question 2c:** Is it possible to remedy objections to a priority claim?



**Analysis:** In the majority of countries, objections to a priority claim can be remedied by the applicant. However, in some countries this is not possible.

### Amendments in representations/drawings.

**Question 3a:** Is it necessary that all the representations presented in the original (first) design application are also present in the priority (subsequent) application filed in your jurisdiction (identical number of drawings)?

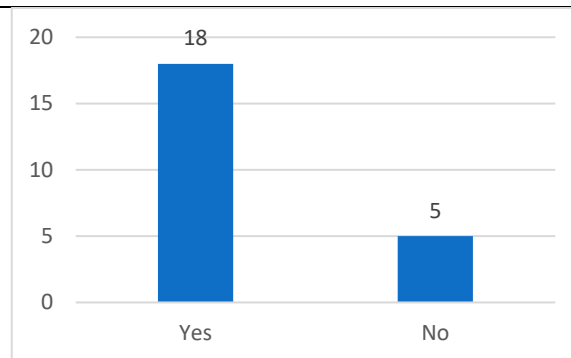


**Analysis:** The applicant is, in almost all the countries surveyed, free to select the representations of the design filed with the first (priority) application for the subsequent design application.

This is quite desirable as it may happen that the first application contains representations that are not admissible in other jurisdictions.

There are, however, a few exceptions: in AR and AT, the number of representations in both applications (first and subsequent) must be the same.

**Question 3b:** Is it allowed to add additional drawings in the priority (subsequent) application with respect to the drawings of the original (first) application – e.g. additional views of the model, additional drawings with details of the model, etc.?

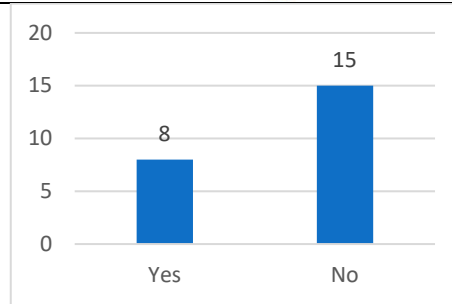


**Analysis:** It is possible in the majority of countries to include additional representations of the design in the subsequent application, without losing the right of priority.

This is always important if the original (first) design application only comprises a few representations with selected views, and the country of the subsequent design application demands additional views (for example, additional side or front views, or a perspective view of the design).

In AT, JP, PH and RO no additional drawings or representations of the design are permitted in a subsequent application claiming the priority of a first application.

**Question 3c:** Is it necessary to have identical drawings, i.e. identical representations, etc.?



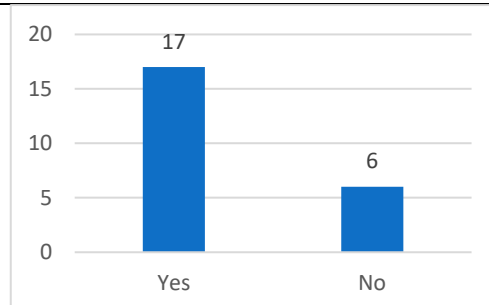
**Analysis:** This result is not as clear as in the previous questions.

There are quite a number of countries that consistently require identical representations of the design when the priority of a first design application is claimed.

This, of course, has the advantage that there is no room for discussions as to whether the priority is effective or not with reference to deviations in the representations.

Consequently, in all the other countries, the applicant must ensure, when supplementing representations of the design, that no additional features are shown or disclosed within the additional representations that are modifying or altering the design. This normally leads in all countries to a loss of the priority right.

**Question 3d:** Is it allowed to make amendments in the drawings of the priority (subsequent) application with respect to the drawings of the original (first) application – e.g. applying shadings in the drawings of the subsequent application, adding additional views of the model, etc.?



**Analysis:** The majority of countries surveyed allow such changes, namely changes that relate to the presentation and the reproduction of the respective design only are principally allowed.

Here too, however, the Applicant must ensure that the amendments or additions in the illustrations of the design relative to the initial filing do not alter or modify the design/the product as such with regards to content.

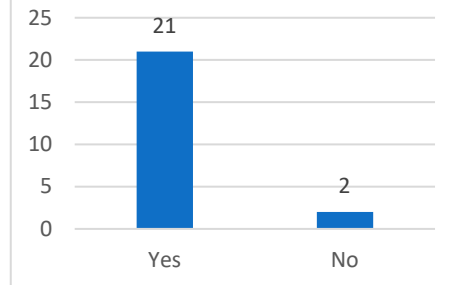
The design protection may therefore be changed formally, but not in terms of content. In AR, CH, BR, FI, PH and RO such amendments are not admissible.

### Use of Continuous and Broken Lines





**Question 4:** If the applicant wants to disclaim a portion of the design in your jurisdiction, are the drawings presented in a manner which shows the difference between claimed and unclaimed portions (e.g., by solid and broken lines)?



**Analysis:** In almost all countries surveyed, it is permissible to exclude parts of the design protection by graphically distinguishing the unwanted parts from the parts to be protected.

For example, dashed or dotted lines are used for the parts or sections of the design, which shall remain unclaimed. An alternative is a weaker representation of these areas. The design part, which is to be protected is shown in solid lines or in a full representation.

This is not possible in BR and CN.

Thus, it becomes necessary to appropriately amend the representations for a subsequent design application in BR or CN if the priority of a first application, which protects only parts of the design by using graphical elements like solid and dotted lines, is to be claimed.

#### 4. Conclusions

Despite the fact that half of the surveyed jurisdictions do conduct substantive examination of the Priority Design Applications filed, in most of the cases the applicants are free to modify the representations of the object that is subject to design protection in order to better suit and adapt the representations to the rules of the jurisdiction where the protection is sought.

The alterations on the designs represented should not be so significant as to modify the scope of protection of the design, making a portion of it that was not protected in the first applications – if anything, the amount of protection must be either equal to the first application or seek to protect a smaller portion, but never bigger.

In order to preserve design rights and to foster innovation and design protection globally, design right owners must be able to have their design protected in different countries, having their Priority Rights duly respected. It is in the spirit of the Paris Convention Treaty to welcome multiple applications and grant the applicant their right to preserve the first filing date (for which was created the Priority right).

In order to avoid bad-faith use of the priority rights, jurisdictions should focus their substantive examinations of the priority applications on whether or not the scope of protection is unlawfully augmented in the second (priority) application – in which case jurisdictions should invite users to present the original design application that matches the priority design application presented. Minimal differences between those applications should be tolerated. Otherwise, jurisdictions risk undermining the Global Design Industry on the basis of procedural technicalities.



<b>BACKGROUND/HISTORY</b> <i>[TO BE PROVIDED FOR FUTURE REFERENCE AND TRACKING]</i>	
a. (i) When was this topic first studied and	August 2018
(ii) by which group?	CET 2
b. (i) Who introduced this topic and	Gabriel Di Blasi
(ii) what was the initial motivation?	The BPTO released guidelines stating that if the representations in a priority design application do not identically match the first application's, the priority right will not be granted.
c. At what occasion the resolution was discussed the first time?	Within CET 2, it was first discussed during the Toronto 2018 meeting.
<b>d. For what organization or country/region is the resolution mainly of interest?</b>	Brazil - BPTO
e. Is the resolution an outcome of a workshop, a survey of the delegates, a survey of the group members, a group discussion, a general discussion during a CET meeting?	The resolution was made possible after conducting and analysing a survey.
f. Relevant <b>key words</b> for the purpose of later recovery of resolutions.	Priority Rights; Identity of Design Applications

*[End of working document]*