

Design Practice Notice (DPN) 01/24: Practice in respect of the examination of a product consisting of multiple components

Response of INTA's Designs Committee to DPN

The International Trademark Association (INTA) is a global association of brand owners and professionals dedicated to supporting trademarks and complementary intellectual property (IP) to foster consumer trust, economic growth, and innovation, and committed to building a better society through brands. Members include nearly 6,000 organizations, representing more than 33,500 individuals (trademark owners, professionals, and academics) from 181 countries, who benefit from the Association's global trademark resources, policy development, education and training, and international network. Founded in 1878, INTA is headquartered in New York City, with offices in Beijing, Brussels, Santiago, Singapore, and the Washington, D.C. Metro Area, and representatives in Amman, Nairobi, and New Delhi.

INTA has adopted [Model Design Law Guidelines](#) and [Guidelines for Examination of Industrial Designs](#), which contain INTA's basic positions on design law and practice and serve as a baseline standard by which INTA analyses and comments on national and regional design laws, regulations, and the practices of IP offices.

INTA welcomes the Design Practice Notice (DPN) from UKIPO as being an initiative for clarifying the examination of products consisting of multiple components. INTA's Designs Committee offers the comments that follow for consideration.

INTA's Current INTA [Model Design Law Guidelines](#) and [Guidelines for Examination of Industrial Designs](#)

INTA's Model Design Law Guidelines do not currently articulate INTA's position on protecting a unitary product if the design contains multiple components. However related matters set below would be helpful:

The current INTA Model Design Law Guidelines recognize that a part of a product should be registrable as a design provided that it otherwise meets the requirements for registration. This could include either the registration of a part of a product where (a) only such part is represented in the drawing; or (b) part of a product where the whole part is represented but the part or parts in which protection is not claimed are identified using visual disclaimers which may be broken lines, blurring, color shading, or by the use of added boundaries.

In addition, the current INTA Model Design Law Guidelines recognize that a product or part of a product should be protectable regardless of whether the design is visible at any time, provided there is some period in life of the product or part thereof when its appearance is a matter of

concern to a purchaser (section 6). INTA recognizes that in some jurisdictions, including the European Union, there is an exception that the design of a component part of a complex product, such as complex machinery, must be visible while the product is in normal use to be protected by design law. In such cases, INTA encourages that such exceptions be limited to the spare parts market for complex machinery.

On the other hand, our current Guidelines for Examination of Industrial Designs recognize that, for example, typeface/type font designs are registered as a set (section 2.1).

Additionally, INTA's Guidelines for Examination of Industrial Designs stress that the applicant should identify the object to which the design is applied or is made perceptible in such a way to specify the nature of the product (section 4.3).

General Comments on the Design Practice Notice



The DPN is largely consistent with the practices of most ID 5 countries (EUIPO, USPTO, South Korea, and Japan), and Australian and New Zealand practice. The nomenclature varies: in Australia, "[kits or sets](#)" are referred to, while in the [EUIPO](#), South Korea (Article 42 of Design Act), [Japan](#), and [New Zealand](#), "sets of articles" can be a "product". In the [USPTO](#), while the claimed design must be embodied in an article of manufacture as required by statute, it may encompass multiple articles or multiple parts within that article. There is consistency in the EUIPO, South Korea, Japan, Australia, New Zealand and (proposed) UKIPO wherein "aesthetic and functional complementarity" are required and wherein the components must be normally sold (or used) together as a single product. USPTO practice only requires that the claim be to the collective appearance of the multiple-article product as shown. So, in Australia, as with the UKIPO Revised Practice, "kits/sets" such as first aid kits which are a mere collection of objects are not registrable.

Therefore, INTA supports the UKIPO's position which is aligned with other jurisdictions.

One additional note is that the provided examples included in the DPN should help the user to assess if a number of articles make up a single unitary product.

In this regard, INTA points out that it perhaps confusing to use the same "product" (i.e. a cutlery set), to illustrate what is acceptable as a single unitary product for registration and conversely what would face an objection.

In particular, the cutlery sets included in paragraph 2.14 and in paragraph 2.15 are depicted along with their associated packaging.

	
The cutlery set of paragraph 2.14	The cutlery set of paragraph 2.15

The “packaging” of the sort in paragraph 2.14 looks like an expensive presentation case, and the “packaging” of the sort in paragraph 2.15 corresponds to a cardboard packaging.

However, from INTA’s perspective, if the user filed black and white line drawings to both of the above (and thus either packaging could be, for example, single-use cardboard or expensive mahogany that is intended for re-use) – the DPN do not provide an adequate bases for understanding how the Office will determine that the cutlery set of paragraph 2.14 is a unitary product (i.e. the case is intended to be used for the lifetime of the cutlery set), whereas the cutlery set of paragraph 2.15 is a product and packaging (i.e. that is disposed of)?

In this sense, it should be emphasized that some companies make great efforts and investment on packaging design and that is it a key aspect of branding. In those cases, the packaging design is protectable by registering the design of the packaging *per se* not showing the product (i.e. Locarno class 9: Packages and containers for the transport or handling of goods) or by disclaiming the product in accordance with INTA’s Model Design Law Guidelines noted above.

However, in cases in which the specific orientation/ placement/ interaction of the product within the packaging is an important element of the design (i.e. a packaging and a product could be designed together to have complimentary aesthetic features), perhaps there is arguably no objective reason for not allowing this to be registerable as a single design as is the position of the USPTO.

For all these reasons, INTA encourages UKIPO to consider possible scenarios in which disposable packing and the product it contains shown together are registerable together. At the very least, it would be helpful for the DPN to clarify that it is permissible to include an environmental view showing the product within the packaging to give context to the design (perhaps with a visual and/or written disclaimer that protection is sought to the packaging only).

INTA would be pleased to answer any questions that you may have and is available to discuss our comments and recommendations in more detail. Please contact Tat-Tienne Louembe Chief Representative Officer, Europe and IGOs tlouembe@inta.org