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საქართველოს ინტელექტუალური
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SAKPATENTI
NATIONAL INTELLECTUAL PROPERTY
CENTER OF GEORGIA
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EU Georgia Intellectual Property Project

NATIONAL INTELLECTUAL PROPERTY CENTER OF GEORGIA “SAKPATENTI”

GUIDELINES FOR EXAMINATION OF NATIONAL AND INTERNATIONAL DESIGN APPLICATIONS



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1. Introduction

1.1 Purpose of the Guidelines

The Guidelines explain how, in practice, the provisions of Design Law (**Law**), General Administrative Code (**Code**), Instruction on Design Registration (**Instruction**) being approved by order of Chairman of Sakpatenti No.03 of 14.12.2011, Resolution of Government of Georgia No.182 of 03.07.2010 on Approval of Fees Connected with Patenting, Registration and Deposition of Objects of IP (**Fees Resolution**), Statute of Chamber of Appeals (**Statute**) being approved by order of Chairman of Sakpatenti No.02 of 18.03.2011 are applied by the Sakpatenti's examination and Chamber of Appeals from receipt of both national and international application for a design up to its publication and registration, including consideration of appeal/opposition in case of their filing.

The purpose of the Guidelines is to ensure consistency among the decisions taken by the examination and Chamber of Appeals and thus implement coherent practice in file handling.

The Guidelines are structured to follow the sequence of the examination process, with each section and subsection constituting a step in the registration proceedings from receipt of the application up to the publication and registration. The general principles (see paragraph 1.2 below) should be kept in mind throughout the whole file handling process.

1.2 General principles

1.2.1 Duty to state reasons (Article 53 of the **Code**)

The decisions of Sakpatenti must be in writing and state the reasons on which they are based. The reasoning must be logical and it must not lead to internal inconsistencies.

The reason for this is twofold: to explain to interested parties why the measure was taken so that they can protect their rights and to enable the courts to exercise their power to review the legality of the decision. Decisions should contain reference to the legal provisions that serve as a ground for decision and reasoning how those provisions apply to the subject case.

However, if Sakpatenti does not respond to all the arguments raised by the parties, this does not necessarily infringe the duty to state reasons. It is sufficient that Sakpatenti sets out the facts and legal considerations of fundamental importance in the context of the decision.

Sakpatenti can use facts that are a matter of common knowledge as a basis for its reasoning. Well-known facts are those that are very likely to be known by anyone or may be learned from generally accessible sources or those that are very likely to be known by anyone with general practical experience of marketing consumer goods and in particular by the consumers of those goods.

Sakpatenti is not required to prove the accuracy of these well-known facts and, therefore, it is not obliged to give examples of such practical experience. It is up to the party concerned to submit evidence to refute it.

1.2.2 Right to be heard

The decisions of the Sakpatenti shall be based only on reasons or evidence on which the applicant has had an opportunity to present its comments.

The applicant's right to be heard is one of the fundamental principles of the **Code** (Articles 13 and 98 of the **Code**), according to which the applicant and other interested party must be given the opportunity to make his point of view known. In accordance with that principle, Sakpatenti may base its decision only on matters of fact or of law on which the applicant or other interested party has been able to set out his views. Consequently, where Sakpatenti gathers facts and documents to serve as a basis for its decision, it is obliged to grant access to parties of administrative prosecution to these materials.

The right to be heard covers all the matters of fact or law and evidence that form the basis for the decision of formal examination (including determination of priority). As for realisation of the "right to be heard" in regards decision of examination, applicant and third parties may exercise this right either at Chamber of Appeals or before the court by appealing decision of examination.

Sakpatenti will take legal issues into account, irrespective of whether or not they have been pleaded by the parties. As for examination and appeal proceedings, Sakpatenti and Chamber of Appeals will examine the facts on its own motion.

While Sakpatenti must rule on each head of claim, it is not required to give express reasons for its assessment in respect of each and every piece of evidence submitted or arguments put forward, where it considers that evidence or arguments to be unimportant or irrelevant to the outcome of the case.

Changing circumstances arising in the course of the proceedings (e.g. if during opposition proceedings the earlier right on which the opposition was based lapses because it is not renewed or is declared invalid) will also be taken into account and the parties will be informed accordingly.

1.2.3 Compliance with time limits

Applicants must act and respond to Sakpatenti's communications within the time limits set by the **Law** and **Instruction**.

1.2.4 Scope of the examination carried out by Sakpatenti

When examining an application for a design, Sakpatenti will examine the facts of its own motion (Articles 14-17 of the **Law**, Chapters II and III of the **Instruction**).

The examination procedure is divided into formal and substantive examination stages. Accordingly, Sakpatenti *ex officio* examines whether application meets formal requirements (Article 16 of the **Law**) as well as grounds for registration (Articles 10 and 17 of the **Law**).

Design that has been granted favourable decision to register may be opposed at Chamber of Appeals (Article 20 of the **Law**) if decision has been issued in breach of requirements referred to in Articles 10 and 17 of the **Law** or other grounds stated in Article 20 of the **Law**.

If design has been registered in breach of the requirements referred to in Article 29 of the **Law**, it is liable to be challenged and invalidated if an interested party files an action before the court.

1.2.5 User-friendliness

One of the fundamental objectives of the **Law** and **Instruction** is that the registration of design should present the minimum cost and difficulty to applicants, so as to make it readily

available to any applicant, including small and medium-sized enterprises and individual designers.

To that end, examiners are encouraged to contact the applicant or its representative by any means of communication including telephone to clarify issues arising from the examination of an application for a design, either before or after an official deficiency letter is sent.

2. Filing an Application with Sakpatenti

2.1 Introduction

There are two ways of applying for registration of a design, that is, (1) either via direct filing, with Sakpatenti (Chapter II of the **Law**) or (2) via an international registration filed with the International Bureau of the World Intellectual Property Organization and designating Georgia (Article 25 of the **Law**).

This section will deal with direct filings. The examination of the formalities relating to international registrations designating Georgia will be explained in paragraph 18 below.

2.2 Form of the application

2.2.1 Different means of filing

An application for a design may be filed directly with Sakpatenti by e-filing, post or personal delivery.

E-filing is the strongly recommended mean of filing since it can guarantee accurate quality of the design representation, and the system gives guidance to the applicant, thus reducing the number of potential deficiencies.

2.2.2 E-filing

Design can be filed electronically via Sakpatenti's website (<https://online.sakpatenti.gov.ge/ka/app/login/>).

In case of electronic filing all documents related to the case are sent to the applicant through electronic system and are deemed to be received by the applicant as soon as they are uploaded in the electronic system. Time limits for the subsequent action(s) prescribed by the law are calculated from this moment.

2.2.3 Applications sent by post or personal delivery

Applications can be sent by ordinary post / courier or delivered personally to Sakpatenti at the following address:

National Intellectual Property Center Sakpatenti

31, Nino Ramishvili Street, 0179 Tbilisi, GEORGIA (front office)

5, Antioch Street, 3300 Mtskheta, GEORGIA (head office)

The application must be signed by the applicant(s) or his / her representative. The date of the signature, name of the signatory must be indicated, and the authority of the signatory must be specified.

In case of paper filing of the application, all documents related to the case are sent to the applicant also in paper form.

2.3 Content of the application

The application must satisfy all the mandatory requirements set out in Articles 3-7 of the **Instruction**.

Additional requirements apply where the applicant selects one of the following options: specimens are filed (Article 8 of **Instruction**), a multiple application is filed (Article 9 of the **Instruction**), convention priority or exhibition priority is claimed (Article 13 of the **Instruction**).

2.3.1 Minimal elements of the application

Pursuant to Article 5(1) of the **Instruction** application must be submitted being filled in the form approved by Sakpatenti and contain:

- (a) indication of the applicant. In case of natural person: name, address and personal number (in case of citizen of Georgia) of the applicant. Names of natural persons shall take the form of the given name(s) and the family name(s). In case of legal entity: name of legal entity, address and state registration number (in case applicant is a Georgian legal entity) shall be indicated. Only one address shall, in principle, be indicated for each applicant; where several addresses are indicated, only the address mentioned first shall be taken into account, except where the applicant designates one of the addresses as an address for service;
- (b) a request for registration of a design;
- (c) a claim concerning priority;
- (d) a representation of the design suitable for reproduction or, where applicable, a specimen;
- (e) indication of the product in which the design is intended to be incorporated or to be applied;
- (f) indication of a number of designs being contained in the application;
- (g) address for the correspondence in the territory of Georgia, full name of the addressee, telephone number, email address;
- (h) name, address and country code of the designer(s);
- (i) list of documents attached to application, with indication of number of copies of each document and total number of pages;
- (j) date, name and signature of the applicant or his representative. The application must be signed by the applicant(s). Where there is more than one applicant, application has to be signed by each of them. If an application is filed electronically, it is sufficient to indicate name and authority of the signatory.

2.3.2 Additional elements of the application

An application may contain a number of the following additional elements:

- (a) a description of design explaining the representation of the design or the specimen; the description must relate only to those features which appear in the reproductions of the design or the specimen. The description may, however, clarify the nature or purpose of some features of the design in order to avoid a possible objection. For instance, where different views of the same design display different colours, thus raising doubts as to consistency between them (see paragraph 4.2.10 below), the description may explain that the colours of the design change when the product in which this design is incorporated is in use. Description as such will not be published. However, the description will remain part of the administrative file of the application. As far as it represents public information as defined by the **Code** it may be disclosed to third parties upon their request;

- (b) an indication of the Locarno Classification of the products contained in the application;
- (c) a convention priority claim based on previous application stating the filing number, date on which the previous application was filed and the country code in which it was filed;
- (d) an exhibition priority claim stating the name of the exhibition and the date of the first disclosure of the products in which the design is incorporated or to which it is applied;
- (e) if the application is filed by representative, full name of that representative, telephone number(s) and email address. If the representative has more than one business address or if there are two or more representatives with different business addresses, the application shall indicate which address must be used as an address for service; where no such indication is made, only the first-mentioned address shall be taken into account as an address for service. If there is more than one applicant, the application may indicate the appointment of one applicant or representative as common representative. Power of attorney authorizing the representative shall be submitted within no more than 2 months after filing date;
- (f) if the application is filed by assignee, full name of that assignee, telephone number(s) and email address. If the assignee has more than one business address or if there are two or more assignees with different business addresses, the application shall indicate which address shall be used as an address for service; where no such indication is made, only the first-mentioned address shall be taken into account as an address for service. Document confirming authority of the assignee shall be submitted within no more than 2 months after filing date;
- (g) indication that design is a work made for hire;
- (h) indication that applicant is, at the same time, the employer;
- (i) if applicant is one of the designers, consent of other designer(s) unless otherwise is provided by the contract between designers. In such case duly attested copy of the contract has to be attached to the application;
- (j) a request for deferment;
- (k) a request for accelerated registration.

2.4 Language of the application

National application shall be filed in Georgian language (Article 5(2) of the **Instruction**). Language of the international application is regulated by the Hague Agreement Concerning the International Registration of Industrial Designs.

2.5 Representatives

The applicant may appoint a local representative and to file application through the representative having domicile in Georgia. In such case address, telephone number and email address of the representative, which may be physical or legal person, must be indicated in the application. Power of attorney must be submitted within 2 months after filing date.

The applicant has the right to appoint representative at any time later if it has not been exercised at the time of filing.

2.6 Date of receipt, file number and issue of receipt

The date of receipt is the date on which the application reaches Sakpatenti. This date may not coincide with the “date of filing” where the requirements for such a date to be allocated are not met.

For design application filed through Sakpatenti's e-filing, the system immediately issues an automatic electronic filing receipt, which contains the date of receipt and the file number.

If application is delivered personally to Sakpatenti by the applicant or its representative, filing receipt, containing assigned identification number and date of the receipt of the application, shall be issued immediately and given to the applicant or its representative.

Where the application is sent by post, the applicant will receive the confirmation of receipt from Sakpatenti also by post.

2.7 Indication of the product and classification

2.7.1 Indication of product

2.7.1.1 General principles

Pursuant to Article 6(1) of the **Instruction**, indication of product must be worded in such a way as to clearly indicate the nature of the product and to enable product to be classified in only one class of the Locarno Classification.

Neither the product indication nor the classification affects the scope of protection of a design as such (Article 6(4) of the **Instruction**). A registered design confers on its holder the exclusive right to use the relevant design in all types of products, and not only in the product indicated in the application for registration (21/09/2017, C-361/15 P & C-405/15 P, Shower Drains, EU:C:2017:720, § 93).

Classification serves exclusively administrative purposes, in particular allowing third parties to search the registered design databases.

Applicants do not themselves have to classify the products in which their design is intended to be incorporated or to which it is intended to be applied.

The considerations that follow only refer to single design applications. As far as multiple design applications are concerned, the "unity of class" requirement applies.

2.7.1.2 The Locarno Classification

The Locarno Classification is an international classification for industrial designs. It exists in two official languages, namely French and English. Its structure and contents are adopted and amended by the Committee of Experts from the countries party to the Locarno Agreement. The Classification is administered by the World Intellectual Property Organization (WIPO). The current, 13th, edition contains 32 classes and 238 subclasses.

In spite of the fact that Georgia is not a party to the Locarno Agreement Sakpatenti uses the classification (Article 2 of the **Law** and Article 6(1) of the **Instruction**) which is accessible on Sakpatenti's website - <https://www.sakpatenti.gov.ge/en/page/109/>

In order to simplify the registration procedure, it is highly recommended that products be indicated using the terms listed in the Locarno Classification.

2.7.1.3 How to indicate products

More than one product can be indicated in the application. However, each of them must belong to only one class of the Locarno Classification.

Each class and subclass of the Locarno Classification has a “heading”. The class and subclass headings give a general indication of the fields to which the products belong.

In any event, the product(s) must be indicated in such a way as to allow classification in both the relevant class and subclass of the Locarno Classification (Article 6(1) of the **Instruction**).

The use of terms listed in the heading of a given class of the Locarno Classification is not per se excluded, but it is not recommended. Applicants should **not** choose generic terms referred to in the heading of the relevant class (e.g. *articles of clothing and haberdashery* in Class 2), but instead select terms listed in the heading of the subclass (e.g. *gloves* in subclass 02-06) or more specific terms from among those listed in the subclasses of the class in question (e.g. *surgical gloves* in subclass 02-06).

Where the product indication does not allow classification in a subclass, the examiner will determine the relevant subclass by reference to the product disclosed in the graphical representation. For example, where an application contains as a product indication the term *furnishing* in Class 6 of the Locarno Classification, the examiner will assign a subclass by taking account of the design itself insofar as it makes clear the nature of the product, its intended purpose or its function. If the design discloses the appearance of a bed, the examiner will assign the subclass 06-02 to the generic indication *furnishing*.

2.7.1.4 Change of indication

Product terms not listed in the Locarno Classification

Where an applicant uses terms that are not in the Locarno Classification, the examiner may request from the applicant to substitute the wording used by the applicant with an equivalent or more general term listed in the Locarno Classification (Article 21(1) of the **Instruction**).

For instance, where an applicant chooses the term *running trainers* (assuming it is not listed in the Locarno Classification) to indicate the products in which the design will be incorporated, the examiner will request to change this indication to *running shoes* (assuming it is listed therein).

Even though the product indication does not affect the scope of protection of a design as such, the examiner will refrain from requesting the applicant to replace the terms chosen by him with more specific terms.

At the same time according to Article 20(3) of the **Instruction**, applicant is authorized to replace terms describing the product if such replacement does not affect scope of protection of the design.

Products and their parts; sets

Where a design represents the appearance of one part of a product, and that product as a whole is indicated in the application (e.g. an application for the design of a knife handle specifies that the products in which the design will be incorporated are *knives* in subclass 08-03), the examiner will replace that product indication by the *knife handle*, provided both the part in question and the product as a whole belong to the same class of the Locarno Classification.

Where a design represents the appearance of a product as a whole, but only a part of that product is indicated in the application (e.g. an application for the design of a knife specifies that the products in which the design will be incorporated are *knife handles*), the examiner will raise an objection and will suggest either disclaiming the part for which protection is not sought (in which case a new filing date must be accorded) or replacing that product indication by the product term for the whole product (in which case the original filing date may be kept but the design's subject matter of protection will remain to be determined on the basis of the representation as filed). If the applicant does not reply within the time limit, the examiner will cease the prosecution of the application.

Where a design represents a set of products, and these products are indicated in the application (e.g. an application for the design of a set of dishes specifies that the products in which the design will be incorporated are *dishes* in subclass 07-01), the examiner will replace that indication by *set of dishes*.

Ornamentation

Where the design represents ornamentation for a given product, and only that product as a whole is indicated in the application, the examiner will replace that product indication by the indication *ornamentation of product(s) X*. The product will thus be classified under Class 32-00 of the Locarno Classification.

Where the product indication is *ornamentation* and the design does not limit itself to representing ornamentation but also discloses the product to which the ornamentation is applied, or part of that product, without its contours being disclaimed, the examiner will raise an objection and will suggest either disclaiming its contours (in which case a new filing date must be accorded) or replacing the indication *ornamentation* with the product indication for the product disclosed (in which case the original filing date may be kept but the subject matter for which the design is protected will have to be determined on the basis of the representation as filed). If the applicant does not reply within the time limit set, the examiner will cease the prosecution of the application.

This may lead to an objection where a multiple application combines a number of such designs applied to products that belong to different classes of the Locarno Classification.

The same reasoning applies to the following product indications in Class 32 of the Locarno Classification: *graphic symbols and logos, surface patterns*.

2.7.2 Objections to product indications

Where the examiner raises an objection, the applicant will be given 1 month to remedy the deficiencies noted (Article 21(1) of the **Instruction**).

If the deficiency is not remedied within the 1 month period, prosecution of the application will be ceased (Article 21(6) of the **Instruction**).

2.7.2.1 No product indication

An objection will be raised where the application gives no indication of the product concerned (Article 5(3)(g) of the **Instruction**). However, if an indication can be found in the description or in the priority document, the examiner will record this as the product indication (21/03/2011, R 2432/2010-3, KYLKROPP FÖR ELEKTRONIKBÄRARE, §14).

2.7.2.2 Deficient product indication

As noted above, the indication of product must be worded in such a way as to indicate clearly the nature of the product and enable to classify it in only one class of the Locarno Classification (Article 6(1) of the **Instruction**). Therefore, the examiner will also object to the product indication if it does not enable product to be classified in only one class of the Locarno Classification (Article 21(1) of the **Instruction**).

This will be the case where the indication is too vague or ambiguous to allow the nature and purpose of the products in question to be determined, for example, *merchandise, novelty items, gifts, souvenirs, home accessories, electric devices*, etc.

This will also be the case where the indication concerns a service rather than a product, for example, *sending or processing of information*.

2.7.2.3 Obvious mismatch

Since one of the main objectives of the product indication and classification is to make Sakpatenti's Designs Register searchable by third parties, the examiner will raise an objection where the product indication clearly does not match the product as disclosed in the representation of the design.

2.7.3 Indication of the Locarno Classification

2.7.3.1 General principles

The applicant may himself identify the classification, in accordance with the Locarno Classification, of the products indicated in the application.

Since classification is optional, no objection will be raised if the applicant does not submit a classification or does not group or sort the products according to subclasses, provided that no objection is raised with regard to the indication of products. If no such objection is raised, the examiner will classify the products in subclasses *ex officio* according to the Locarno Classification.

Where the applicant has indicated only the main class and no subclass, the examiner will assign the subclass that appears suitable in view of the design shown in the representation. For instance, where a design application indicates *packaging* in Class 9 of the Locarno Classification, and the design represents a bottle, the examiner will assign subclass 09-01 (the heading of which is *bottles, flasks, pots, carboys, demijohns, and containers with dynamic dispensing means*).

Where the applicant has given the wrong classification, the examiner will assign the correct one *ex officio*.

2.7.3.2 Multiple applications and the requirement of "unity of class"

Where several designs other than ornamentation are combined in a multiple application, the application will be divided if the products in which the designs are intended to be incorporated or to which they are intended to be applied belong to more than one class of the Locarno Classification (Article 9(1) of the **Instruction**).

Multiple application may consist of no more than 100 designs.

3. Representation of the design suitable for reproduction

3.1 General requirements

The representation of the design must consist of a graphic or photographic reproduction of the design, either in black and white or in colour (Article 7(1) of the **Instruction**).

Irrespective of the form used for filing the application (e-filing or paper), the design must be reproduced on a neutral background and must not be retouched with ink or correcting fluid.

It must be of a quality permitting all the details of the matter for which protection is sought to be clearly distinguished and permitting it to be reduced or enlarged to a size no greater than 8 cm by 16 cm per view for entry in the Sakpatenti's Designs Register and for publication in the Official Bulletin of Industrial Property.

The purpose of that requirement is to allow third parties to determine with accuracy all the details of the design for which protection is sought.

In addition, for applications filed electronically, it must meet the technical requirements prescribed by the **Instruction**.

Drawings (except technical drawings), photographs, computer-made representations or any other graphical representation are accepted, provided they are suitable for reproduction, including on a registration certificate in paper format. Based on the current legislation 3D computer-animated design generating motion simulation can only be considered as an additional technical means of viewing the design and does not replace conventional static views.

3.2 Neutral background

The background in a view is considered neutral as long as the design shown in this view is clearly distinguishable from its environment without interference from any other object, accessory or decoration, whose inclusion in the representation could cast doubt on the protection sought (16/04/2012, R 2230/2011-3, Webcams, § 11-12).



In other words, the requirement of a neutral background demands neither a "neutral" colour nor an "empty" background. Instead, what is decisive is that the design stands out sufficiently clearly from the background to remain identifiable (13/09/2017, R 1211/2016-3, Tavoli, § 61).

Sakpatenti agreed to adopt a Common Practice under the European Trade Mark and Designs Network (CP6) which resulted in the **Practice Paper** ["Graphic Representation of Designs"](#) published by the EUIPN and Sakpatenti.



In accordance with the **Practice Paper**, being prepared in line with CP6, the following aspects should be taken into consideration when assessing if a background is neutral: colour, contrast and shadow. The examples given below in relation to these aspects are taken from the **Practice Paper**, which also contains additional examples.

A single or predominant colour in a background is always acceptable if it stands out against the colours of the design.

Examples of an acceptable single or predominant background colour



Austrian lapsed design No 1747/1999	RCD No 2 333 484-0001
	

Examples of an unacceptable single or predominant background colour

CP6 example	CP6 example
	

Graduating colour or more than one colour in a background is acceptable provided the design is clearly distinguishable.

Examples of an acceptable graduating colour and more than one colour in a background




RCD No 1 387 476-0001	French design No 955805-0005
	

As for contrast, all features of the design should be clearly visible. The contrast is considered insufficient when the background colour and the design are similar and melt partly into each other, with the result that not all parts of the design contrast sufficiently with the background (i.e. it is not clear where the product finishes and the background starts). Sometimes, a darker background can help when the design is clear or pale and vice versa.

Example of sufficient contrast with background





Examples of insufficient contrast with background

Portuguese lapsed design No 420-0006	CP6 example	Portuguese lapsed design No 00023465-0001
		



Shadows or reflections are acceptable as long as all of the design features remain visible.

Shadows or reflections are unacceptable when the subject of protection of the design, in any of the submitted views, cannot be determined in an unambiguous way. This can occur when there is limited colour contrast with the design or when the shadows do not allow all the features of the design to be appreciated, for example because they interfere with, or hide parts of, the design or distort the contour of the design.

Examples of acceptable shadows or reflections

Danish design No 2013 00069	CP6 example
	

Examples of unacceptable shadows or reflections

CP6 example	CP6 example
	

If views do not have a neutral background, the examiner will issue a deficiency letter and give the applicant 1 month to remedy the deficiencies by:

- withdrawing the views concerned (which will not form part of the design); or
- submitting new views on a neutral background; or
- amending the views objected to so that the design is isolated from its background. This latter option will make use of visual disclaimers.

If the applicant withdraws the deficient view(s) within the time limit set by Sakpatenti, the date of receipt of the original application will be recorded as the date of filing for the views that are not deficient.

If the applicant amends views within the time limit set by Sakpatenti, the date of receipt of amended views will be recorded as the date of filing. If the applicant fails to comply with request of Sakpatenti, the latter will cease prosecution regarding deficient views.

3.3. Designs retouched with ink or correcting fluid

To meet requirements set by Article 7(1)(b) of the **Instruction**, the design must not be retouched with ink or correcting fluid.

Therefore, when the representation is visibly retouched with ink or correcting fluid the examiner will raise an objection. The applicant may remedy any deficiency in this respect in the same way as described under paragraph 3.2 above.

3.4 Quality

The requirement that the design must be of a quality permitting all the details of the matter for which protection is sought to be clearly distinguished, for publication purposes, applies equally to all applications, irrespective of the means of filing.

3.5 E-filing

For e-filing, the terms and conditions determined by the **Instruction** must be adhered to.

Low-resolution images are likely to be objected due to their insufficient quality for reproduction and publication purposes. Accordingly, images filed electronically must be in JPEG (.jpg, .jpeg) format and with resolution from 100 to 300 DPI. At the same time, size of the image may not exceed 5 MB.

Where it is clear that the electronic filing was deficient due to technical problems attributable to the Sakpatenti, with the result that one or more views do not correspond to those originally submitted by the applicant, Sakpatenti will allow the resubmission of the affected views. The original filing date via e-filing will be retained, provided that there is no other deficiency affecting the filing date.

3.6 Specimens

The graphic or photographic reproduction of the design can be substituted by a specimen of the design provided the following cumulative conditions are met:

- the application relates to a two-dimensional design; and
- the application contains a request for deferment (Article 8(1) of the **Instruction**).

In the event of a multiple application, the substitution of the representation by a specimen may apply to some or all of the designs, provided these designs are two-dimensional and are subject to a request for deferment.

A specimen is usually a sample of a piece of material such as textile, wallpaper, lace, leather, etc.

Specimens must not exceed 26.2 cm x 17 cm in size (Article 8(2) of the **Instruction**). They must be capable of being stored. They must not be perishable and dangerous to store (Article 8(4) of the **Instruction**).

Two samples of every specimen must be filed. In the case of a multiple application, two samples of the specimen must be filed for each design (Article 8(2) of the **Instruction**).

The application and the specimen(s) must be sent in a single delivery either by post or personal delivery. A date of filing will not be accorded until both the application and the specimens have reached Sakpatenti.

Where the applicant submits a specimen relating to an application that does not relate to a two-dimensional design or that does not contain a request for deferment, the specimen is not admissible. In that case, the date of filing will be determined by the date on which Sakpatenti receives a suitable graphic or photographic reproduction of the design, provided the deficiency is remedied within 1 month of receipt of Sakpatenti's notification (Article 15(5) of the **Instruction**).

4. Other Requirements Regarding representation of the design

The purpose of the graphic representation is to disclose the features of the design for which protection is sought. The graphic representation must be self-contained in order to determine with clarity and precision the subject matter of the protection afforded by the registered design to its holder. This rule is dictated by the requirement of legal certainty.

In accordance with the **Practice Paper**, use of aspect views of the design is recommended.

Aspect views are defined under the **Practice Paper** as showing the design from certain directions (angles) and encompass the following: perspective view(s), front view, top view, right side view, left side view, back view and bottom view. See the following examples (for all but a bottom view).



For the purpose of filing a design, it is sufficient to file only one aspect view. However, other (non-traditional) types of view, in particular exploded views (see paragraph 4.2.3 below) and sectional views (see paragraph 4.2.6 below), cannot be filed on their own.

Applicants are reminded that the requirements concerning the format of the representation of the design may vary according to how the application is filed (e.g. e-filing, paper, use of a specimen).

The following instructions supplement the requirements regarding the quality of the reproduction and the neutral background (see paragraph 3 above). For general quality recommendations for representations filed in the form of drawings or photographs, please consult the **Practice Paper** as well.

The following instructions apply to all designs, irrespective of how the application was filed.

4.1 Recommendations concerning number of views

The number of views which can be filed is not determined by the **Law** or **Instruction**. However, the **Practice Paper**, based on CP6, considers sufficient and recommends to file no more than following seven different views in order to represent the design - front view, top view, bottom view, right side view, left side view, back view and perspective view. The views may be plan, in elevation, cross-sectional, in perspective or exploded. Only one copy of each view should be filed. Each of the views must be numbered by the applicant in Arabic numerals separated by a dot, the first numeral being the number of the design, the second being the number of the view. For instance, the sixth view of the second design of a multiple application must be numbered "2.6".

The examiner will not change the order of the views as appearing in the application.

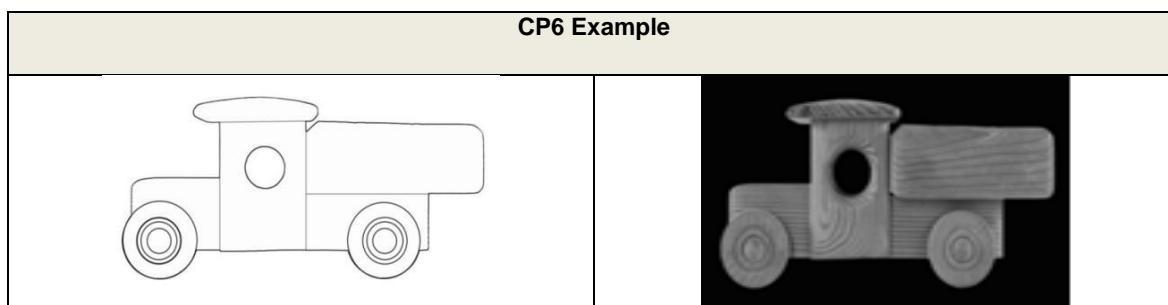
4.2 Consistency of the views

The examiner will check whether the views relate to the same design, that is, to the appearance of one and the same product or of its parts.

4.2.1 Combination of several means of visual representation

Regarding the combination of several means of visual representation, it is recommended, in accordance with the **Practice Paper**, that a design be represented using only one visual format (e.g. a drawing or a photograph). Therefore, the following combination of a

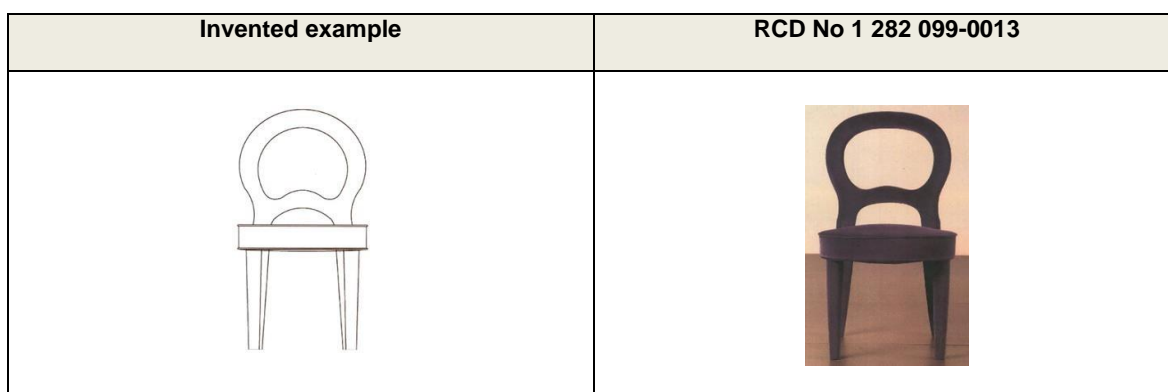
drawing and a photograph depicting a vehicle toy, as shown in the **Practice Paper**, is considered unacceptable and thus should not be filed.



Where different visual formats are used, each must clearly relate to the same design and be consistent when comparing the features disclosed.

When the different visual formats show aspects that are inconsistent with one another, they are not considered to represent the same design. A combination of a drawing and a photograph will usually reveal inconsistencies between different visual formats.

In the following example of a chair design, the seat is flat in the drawing but arched in the photograph. The backrests are also of a different shape.



The same may apply when the graphic representation indicates features other than contour lines, such as surface features that are not consistent with the corresponding features in the photographic representation.

Sakpatenti therefore strongly recommends that applicants wishing to use different visual formats file each one as a separate design (e.g. one design consisting of drawings only, the other of photographs), these can also be combined in a multiple application.

Where the views are inconsistent and relate to more than one design, the applicant will be invited either to withdraw some views or to convert the application into a multiple application for different designs and pay the corresponding fees.

The consistency of the views may be particularly difficult to assess when examining applications for designs with alternative positions, exploded views, views magnifying part of the design, partial views, sectional views, sequence of snapshots and sets of articles.

4.2.2 Alternative positions

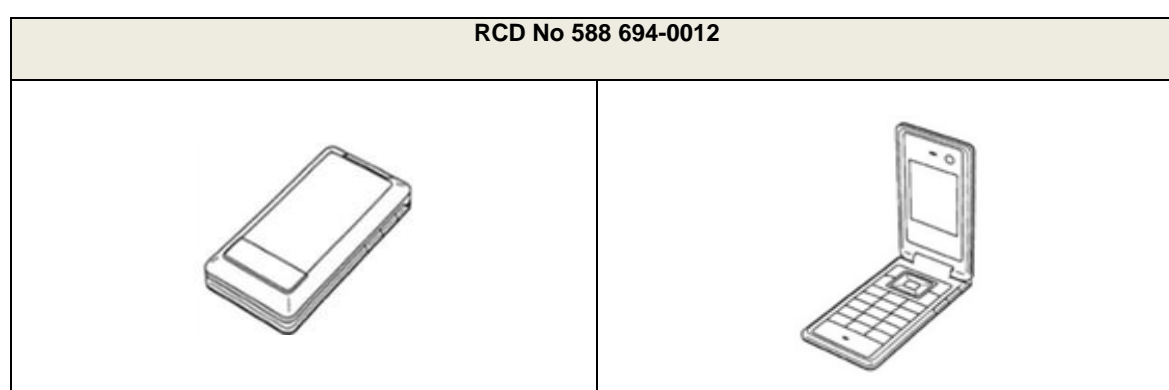
Designs with alternative positions are of an appearance that can be modified into various configurations without adding or removing any parts.

These designs have predefined stages of use that each correspond to an alternative position.

In accordance with the **Practice Paper**, views showing different configurations of the design are acceptable provided no parts have been added or deleted.

The alternative positions of the movable or removable parts of a design must be shown in separate views.

The example below of an acceptable representation of a design with alternative positions is taken from the **Practice Paper**, which also contains additional examples.



In some cases, different configurations may result in different products, such as the bag that can be converted into a towel.

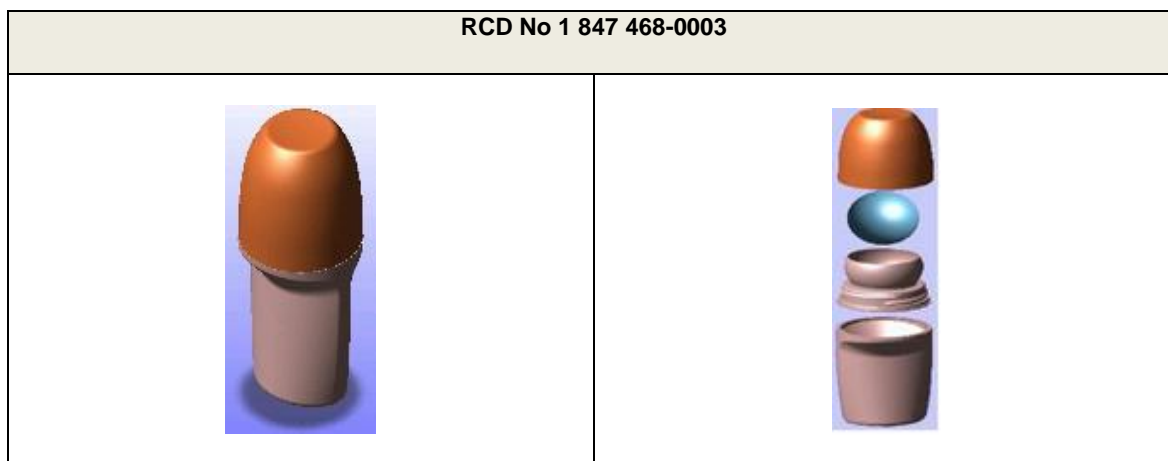


4.2.3 Exploded views

Exploded views are views where parts of a product are shown disassembled, to clarify how the parts fit together.

Exploded views must be combined with at least one view representing the assembled product. In these views, all the product's parts must be shown disassembled in a separate single view. The disassembled parts must be shown in close proximity and in order of assembly.

The example below of an acceptable representation of a design with an assembled and an exploded view is taken from the **Practice Paper**, which also contains additional examples.



Where there is no view showing the assembled product, the examiner will issue a deficiency letter inviting the applicant to submit such a view showing the assembled product for which protection is sought. The new view should not contain features that were not included in the original representation of the design. The original filing date will be retained.

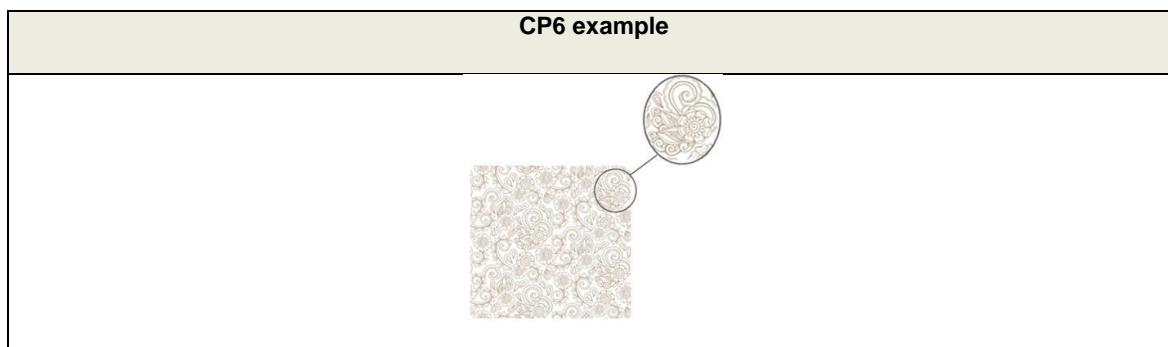
4.2.4 Views magnifying part of the design

Magnified views show one part of an overall design on an enlarged scale.

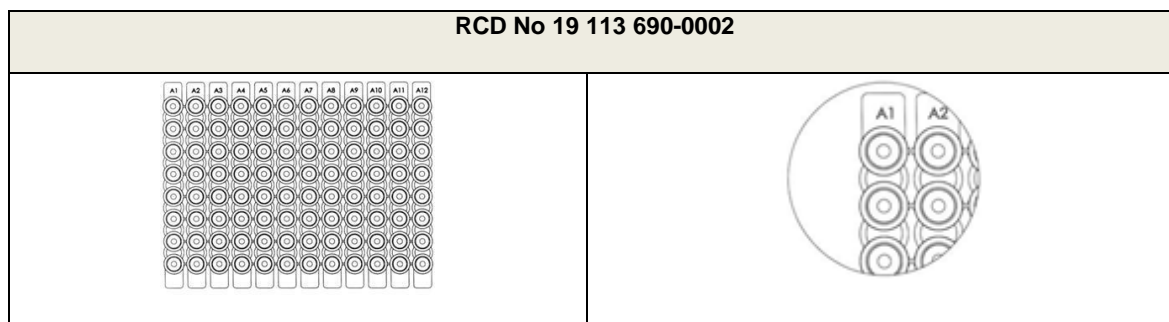
A single magnified view is acceptable provided that the magnified part is already visible in one of the other views submitted.

The view that shows the magnified part of the design must be presented in a separate single view.

Example of an unacceptable magnified view filed as one view



Example of an acceptable magnified view filed as a separate view



4.2.5 Partial views

A partial view is a view showing part of a product in isolation. A partial view can be magnified.

Partial views must be combined with at least one view of the assembled product (the different parts need to be connected to each other).

Example of an acceptable assembled view, filed together with partial views



Where all the views disclose different detailed parts, without showing these parts connected to each other, the examiner will issue a deficiency letter giving the applicant three options:

- provided “unity of class” can be maintained, the applicant can convert its application into a multiple application in which each individual part is a separate design and pay the corresponding fees;
- if “unity of class” cannot be maintained, the applicant can convert its application into separate applications, and pay the corresponding fees;
- the applicant can limit its application to just one design by withdrawing the views representing other designs.

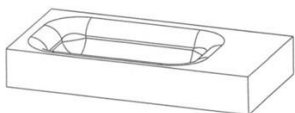
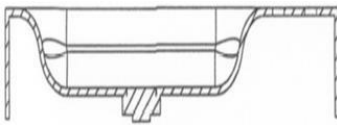
4.2.6 Sectional views

Sectional views are cutaway portions that complement aspect views by illustrating a feature or features of the product’s appearance, such as contour, surface, shape or configuration.

In accordance with the **Practice Paper**, representations with technical indications, such as axial lines or sizes (dimensions), numbers, etc. are not allowed. The sectional view should be an unambiguous view of the same design. Sectional views should not be submitted without other traditional views, such as aspect views.

The following are examples agreed in the context of the **Practice Paper** of sectional views, which must be filed together with other traditional views, such as aspect views.

Spanish design No I0152702-D	
Aspect view	Sectional view
	



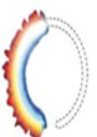




Benelux design No 38478-0002	
Aspect view	Sectional view
	

4.2.7 Sequence of snapshots (animated designs)

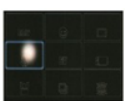
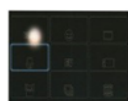





Snapshots are a short sequence of views used to show a single animated design at different specific moments in time, in a clearly understandable progression.

This applies to, for example:

- an animated icon (design consisting of a sequence)

RCD No 2 085 894-0014						
						

- an animated graphical user interface (design of an interface)

RCD No 1 282 388-0031						
						

In principle, according to the **Practice Paper**, all views of an animated icon or graphical user interface need to be visually related, which means that they must have features in

common. It is the applicant's responsibility to order the views in such a way as to give a clear perception of the movement/progression.

4.2.8 Sets of articles

A set of articles is a group of products of the same kind that are generally regarded as belonging together and are so used. See the example below.



The difference between a complex product and a set of articles is that, in contrast to a complex product, the articles of a “set of articles” are not mechanically connected.

A set of articles can be a “product” in itself within. It can be represented in a single design application if the articles making up this set are linked by common stylistic and compositional solution.

It must, however, be clear from the representation that protection is sought for a design resulting from the combination of the articles making up the set and not for each article separately.

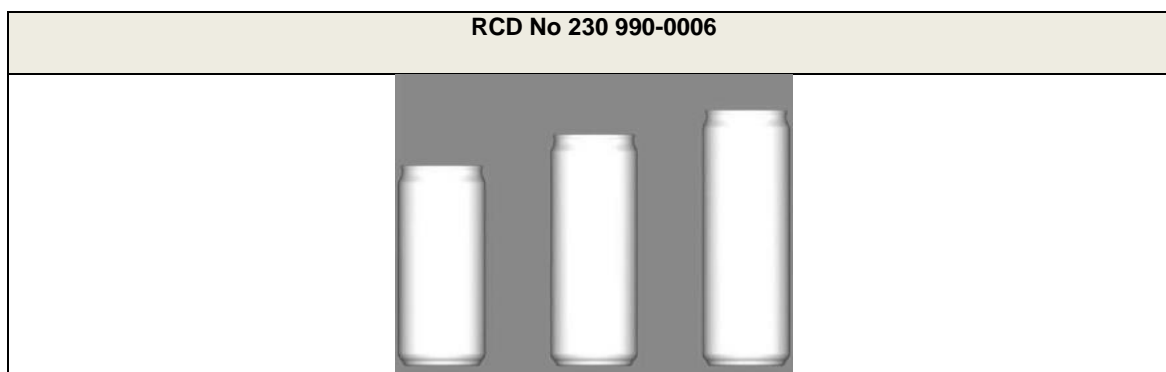
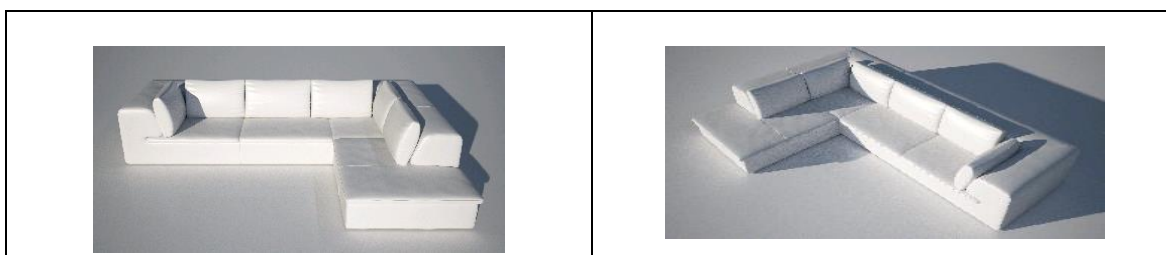
Among other views applicants must submit at least one view showing the set of articles in its entirety.

Otherwise, the examiner will issue a deficiency letter giving the applicant three options:

- provided “unity of class” can be maintained, the applicant can convert its application into a multiple application in which each individual design is a separate design and pay the corresponding fees;
- if “unity of class” cannot be maintained, the applicant can convert its application into separate applications and pay the corresponding fees;
- the applicant can limit its application to just one design by withdrawing the views representing other designs.

4.2.9 Variations of a design

Sets of products should not be confused with variations of a design. Different embodiments of the same concept cannot be grouped in a single application because each embodiment is a design on its own, as in the example below.



Where, in an application for a single design, the views relate to more than one design, the examiner will issue a deficiency letter giving the applicant three options:

- provided “unity of class” can be maintained, the applicant can convert its application into a multiple application in which each individual design is a separate design and pay the corresponding fees;
- if “unity of class” cannot be maintained, the applicant can convert its application into separate applications and pay the corresponding fees;
- the applicant can limit its application to just one design by withdrawing the views representing other designs.

4.2.10 Colours

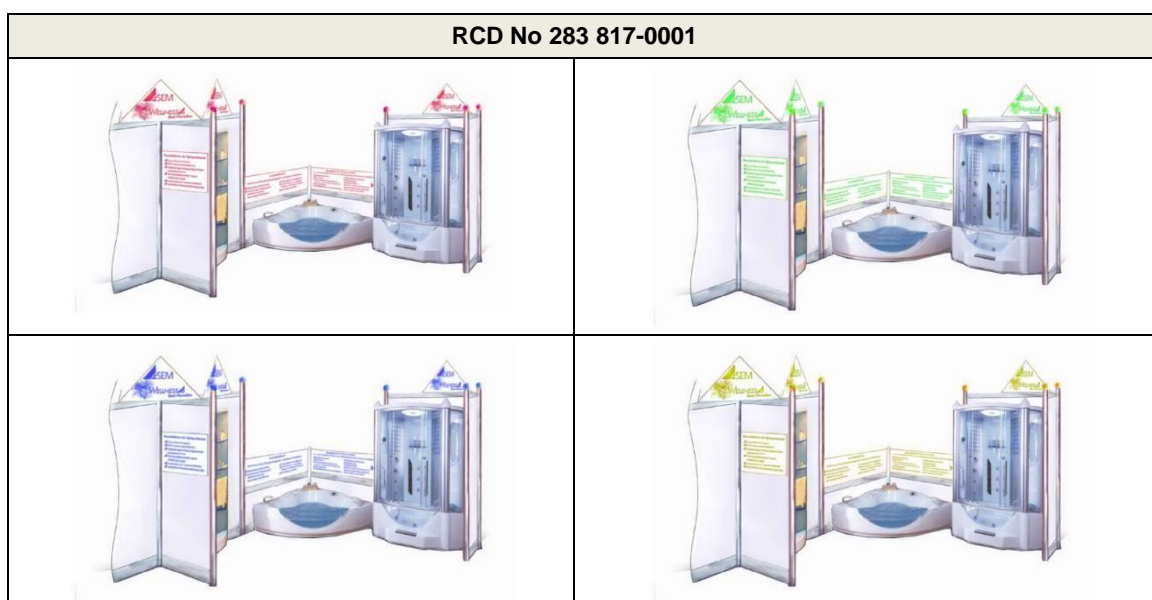
The representation of the design may be submitted either in black and white (monochrome) or in colour (Article 7(1)(c) of the **Instruction**).

Representations combining black and white views with colour views will be objected to due to their inconsistency and the resulting legal uncertainty as to the protection sought.

The same reasoning applies where the same features of a design are represented in different colours in the various views. Such an inconsistency suggests that the application relates to more than one design (31/03/2005, R 965/2004-3, Bandmaß, § 18-20; 12/11/2009, R 1583/2007-3, Bekleidung, § 9-10).

The applicant will, therefore, be invited either to withdraw some of the colour views in order to maintain consistency with the remaining ones or to convert the application into a multiple application and pay the corresponding fees.

However, as an exception to the above principle, the same features of a design can be represented in different colours in the various views if the applicant submits evidence that the change of colours at different points in time, while the product is in use, is one of the relevant features of the design, as in the example below (RCD No 283 817-0001, courtesy of ASEM Industrieberatung und Vermittlung).



Where the representation is in colour, the publication and registration will also be in colour.



4.2.11 Elements external to the design

Views should not include external and foreign matter in the design provided except when their inclusion does not cast any doubt on the protection sought and serves only an illustrative purpose (see paragraph 3.2 above).

See, for instance, the following two Registered Community Designs, in which the inclusion of a hand in one of the views of the first design serves the purpose of illustrating how the product in which the design is incorporated will be used (even though the way of use does not form part of the design's subject-matter of protection) and the background in the second design shows the context in which it will be used.



However, the following examples are not acceptable as they contain elements that are external to the design, such as a mannequin, making the subject matter of protection unclear.

RCD No 5 631 504	RCD No 4 154 086
	

4.3 Use of visual disclaimers to exclude features from protection

Neither the **Law** nor the **Instruction** provides complete rules on the rules of including in the application a statement about disclaiming one or more features disclosed in the views.

Use of a “description” provided by the Article 11(5) of the **Law** and Article 4(2)(a) of the **Instruction** is not appropriate in this regard since, according to cited provisions, a “description” has only explanatory function and shall not affect the scope of protection of the design. Moreover, “description” as such shall not be published (Article 18(1) of the **Instruction**).

Disclaimers must therefore be apparent from the representation of the design itself.

In accordance with the **Practice Paper**, visual disclaimers indicate that protection is not being sought, and protection has not been granted, for certain features of the design shown in the representation. Thus, they indicate what is not intended to be protected. This can be achieved:

- by excluding with broken lines, blurring or colour shading the features of the design for which protection is not sought; or
- by including the features of the design for which protection is sought within a boundary, thus making it clear that no protection is sought for what falls outside the boundary.

According to the **Practice Paper**, Sakpatenti agreed on the general recommendation that graphic or photographic representations showing only the claimed design are preferred. However, visual disclaimers can be used when the graphic or photographic representation of the design contains parts of the product for which no protection is sought. In these cases, the disclaimer must be clear and obvious. The claimed and disclaimed features must be clearly differentiated.

To be accepted, when the design is represented by more than one view, the visual disclaimer must be shown consistently in all the views where it appears.

Where a disclaimer is used, broken lines are recommended. Only when broken lines cannot be used due to technical reasons (e.g. when they are used to indicate stitching on clothing or patterns, or when photographs are used), can other disclaimers be used, such as colour shading, boundaries or blurring.

In accordance with the **Practice Paper**, in an application for registration of a design, the following visual disclaimers will be allowed (see paragraphs 4.3.1 to 4.3.4 below).


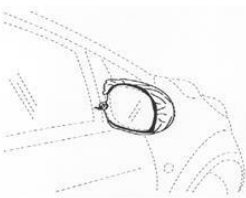
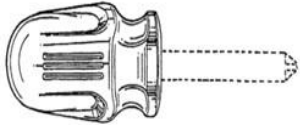
4.3.1 Broken lines

Broken lines consist of a trace made up of dots or dashes (or a combination of both), and are used to indicate that no protection is sought for features shown using the interrupted trace.

A visual disclaimer consisting of broken lines will usually be combined with continuous lines.

To be accepted, the features for which protection is not sought should be clearly indicated with broken lines, whereas the parts for which protection is sought should be indicated with continuous lines.

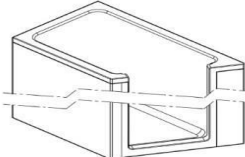
The following are examples agreed in the context of the **Practice Paper** for correctly applied broken lines.

RCD No 30 606-0005	Benelux design No 38212-0001	Hungarian design No D9900409-0001
		

In cases where broken lines are a feature of the design (such as stitching on clothing), this must be clear from the representation. In such cases, it may be helpful to file, for example, a magnified view.

In cases where broken lines are a feature of the design and a part of the design needs to be disclaimed, any of the other visual disclaimers can be used, such as colour shading, blurring or boundaries.

For ease of illustration, broken lines may also illustrate separations, indicating that the precise length of the design is not claimed (indeterminate length).

RCD No 2 509 430-0001


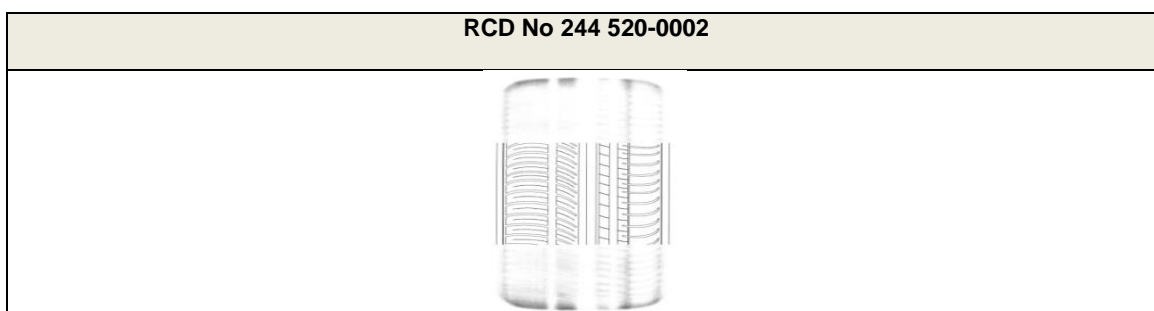
According to the **Practice Paper**, Sakpatenti does not recommend using broken lines to indicate portions of the design that are not visible in that particular view, that is to say, non-visible lines.

4.3.2 Blurring

Blurring is a type of visual disclaimer that consists in obscuring the features for which protection is not sought in the drawings or photographs of a design application.

Blurring may only be accepted when the features for which protection is sought are clearly distinguishable from the disclaimed (blurred) features.

The following is an example agreed in the context of the **Practice Paper** of correctly applied blurring.

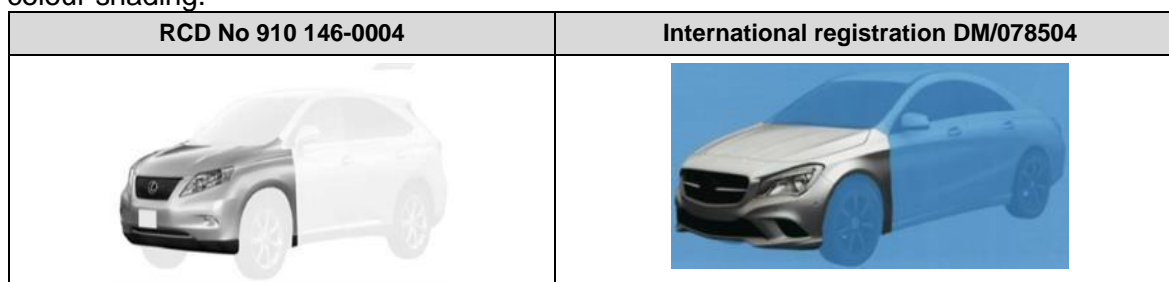


4.3.3 Colour shading



Colour shading is a type of visual disclaimer that consists in using contrasting tones to sufficiently obscure the features for which protection is not sought in the drawings or photographs of a design application.

With colour shading, the features for which protection is sought must be clearly perceptible, whereas the disclaimed features must be represented in a different tone and so as to appear blurred or imperceptible.

The following are examples agreed in the context of the **Practice Paper** for correctly applied colour shading.





These are additional examples of EUIPO's practice:

RCD No 5 819 851-002	RCD No 5 295 680-0009
	

4.3.4 Boundaries



Boundaries are a type of visual disclaimer used in drawings or photographs of a design application to indicate that no protection is sought for the features not contained within the boundary.

The following are examples agreed in the context of the **Practice Paper** for correctly applied boundaries.

RCD No 2 182 238-0002	RCD No 1 873 688-0003
	

In order to be accepted, the features for which protection is sought should be clearly indicated/represented within the boundary, whereas all the features outside the boundary are considered to be disclaimed and therefore not protected.

Due to the risk of including more than just the design within the boundary, boundaries must be used carefully in drawings/photographs. The following are examples of incorrectly applied boundaries.

CP6 example	CP6 example
	

4.4 Explanatory text, wording or symbols

No explanatory text, wording, symbol or element not being part of the design may be displayed in the views (Article 7(1)(f) of the **Instruction**).

Where words, letters, numbers and symbols (such as arrows) are clearly not part of the design, the examiner may cut them from the views using the specific IT tool available for this. If the examiner is not able to cut them out for technical reasons, the applicant will be requested to send in corrected views or to withdraw the deficient ones.

Where the words, letters, numbers, etc. are part of the design (graphical symbol), the design is acceptable.

Indications such as “side”, “front view”, etc. will be cut for publication purposes.

4.5 Amending and supplementing views

The representation may be altered after the application has been filed, but before accomplishment of formal examination, with condition that scope of protection of design shall not be affected.

4.6 Specific requirements

4.6.1 Repeating surface patterns

Where the application concerns a design consisting of a repeating surface pattern, the representation of the design must disclose the complete pattern and a sufficient portion of the repeating surface (Article 7(6) of the **Instruction**) in order to show how this pattern is infinitely multiplied.

Where the application does not contain a description making clear that the design consists of a repeating surface pattern, Sakpatenti will assume that this is not the case and will not request a sufficient portion of the repeating surface.

If additional views represent the pattern applied to one or more specific products for illustrative purposes, the applicant must make sure that the shape of such products is not claimed as part of the design by using any method referred to under paragraph 4.3 above.

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4.6.2 Typographic typefaces

Where the application concerns a design consisting of a typographic typeface, the representation of the design must consist of a string of all the letters of the alphabet and of all the Arabic numerals, as well as of a text of five lines produced using that typeface, all in 16-pitch font (Article 7(7) of the **Instruction**).

Where the application does not include a text of five lines using the typeface concerned, the applicant will be requested to submit such a text or to accept a change in the indication of products to “set of characters” in Class 18-03 of the Locarno Classification.

4.7 Specimens

The graphic or photographic reproduction of the design can be substituted by a specimen of the design according to the rules prescribed in paragraph 3.6 above.

5. Multiple Application

5.1 General principles

A multiple application is a request for the registration of more than one design within the same application. Each of the designs contained in a multiple application is examined and dealt with separately. In particular, each design is the subject of independent protection (Article 12(3) of the **Law**) and thus may, separately, be enforced, be licensed, be the subject of a levy of execution or insolvency proceedings, be surrendered, renewed or assigned, be the subject of deferred publication or be declared invalid.

Multiple application is subject to specific prosecution fees, being paid for each design in the application.

5.2 Formal requirements applying to multiple application

5.2.1 General requirements

All the designs in a multiple application must have the same owner(s) and the same representative(s) (if any).

The maximum number of designs contained in a multiple application is one hundred (Article 9(1) of the **Instruction**). The designs need not be related to one another or be otherwise similar in terms of appearance, nature or purpose. The designs must, however, meet the “unity of class” requirement (see paragraph 5.2.3 below).

The number of designs should not be confused with the “number of views” that represent the designs.

Applicant must number the designs contained in a multiple application consecutively, using Arabic numerals (Article 7(2) of the **Instruction**).

5.2.2 Separate examination

Each of the designs contained in a multiple application is examined separately (Article 12(3) of the **Law**). If a deficiency concerning some of the designs contained in a multiple application is not remedied within the time limit set by Sakpatenti, the application will be refused only insofar as those designs are concerned.

The decisions on the registration or refusal of the designs contained in a multiple application will all be taken at the same time.

Even if some of the designs in a multiple application already comply with both the formal and substantive requirements, decision about their registration will not be issued until any deficiencies affecting other designs have been remedied or the designs in question have been refused by the decision of an examiner.

5.2.3 The “unity of class” requirement

Principle

All the product(s) indicated for the designs contained in a multiple application must be classified in only one of the 32 Locarno classes.

Products other than ornamentation

The products indicated for each design in a multiple application may differ from those indicated for others.

“Unity of class” requirement is considered to be complied with even if the products belong to different subclasses of the same class of the Locarno Classification.

For instance, a multiple application is acceptable if it contains one design with the product indication *motor vehicles* (Class 12, subclass 08) and one design with the product indication *vehicle interiors* (Class 12, subclass 16), or if both designs indicate both these terms. This is an example of two designs in different subclasses but in the same class, namely Class 12 of the Locarno Classification.

An objection would, however, be raised if, in the above example, the products indicated were *motor vehicles* (Class 12, subclass 08) and *lights for vehicles*, since the second term belongs to Class 26, subclass 06 of the Locarno Classification. The examiner would then require the multiple application to be divided, as explained below.

Ornamentation

Ornamentation is a decorative element capable of being applied to the surface of a variety of products without affecting their contours. It can take the form of a pattern, including a molding, engraving or carving in which the design stands out from a flat surface.

Although ornamentation is, in itself, a product within the meaning of the Locarno Classification (Class 32), its primary purpose is to constitute one of the features of other products. Therefore, representations of ornamentation should not include the product to which it will be applied.

A multiple application can therefore combine designs for ornamentation with designs for products such as those to which the ornamentation will be applied, provided that all the products belong to the same class of the Locarno Classification.

For some designs, the indication *ornamentation* or *product(s) X (ornamentation for)* in Class 32 of the Locarno Classification is neutral and therefore ignored for the purpose of examining whether the product indication for the remaining designs meets the “unity of class” requirement.

The same reasoning applies to the following product indications in Class 32 of the Locarno Classification: *graphic symbols*, *logos* and *surface patterns*.

For example, a multiple application is acceptable if it combines designs for *ornamentation* or *china (ornamentation for)* in Class 32 with designs representing pieces of a tea set for *china* in Class 7, subclass 01. However, if, in turn, *linen (table -)* were indicated as a product for one of these designs, an objection would be raised as this product belongs in Class 6, subclass 13 of the Locarno Classification, that is, a different class.

Where the representation of the design is not limited to ornamentation itself but also discloses the product to which such ornamentation is applied, without the contours of this product being disclaimed, the examiner will raise an objection and will suggest replacing the indication *ornamentation* with the product indication for the product disclosed and the classification must be amended accordingly.

This may lead to an objection where a multiple application combines a number of such designs applied to products that belong to different classes of the Locarno Classification.

Deficiencies

Where a multiple application combines a number of designs applied to products that belong to more than one class of the Locarno Classification, a deficiency will be raised.

For example, let us assume that four designs representing cars are combined in one multiple application, and the product indication for each design is *motor cars* (subclass 12-08) and *scale models* (subclass 21-01).

The examiner will issue an objection and request the applicant to:

- delete some of the product indications so that the remaining products can be classified in only one Locarno class; or
- divide the application into two multiple applications for each of the Locarno classes concerned, and pay the corresponding additional fees; or
- divide the application into four single applications for each design concerned and pay the corresponding additional fees.

The applicant will be invited to comply with the examiner’s request within 1 month and pay the total amount of fees for two or more applications resulting from the division of the multiple application according to Locarno classification or to delete some products in order to meet the “unity of class” requirement.

Where the applicant does not remedy the deficiencies in due time, Sakpatenti:

- will continue prosecution of only those designs which are applied to products that belong to one class; or
- will identify one class, where applicant has not classified designs himself, and continue prosecution of only those designs which belong to this class.

6. Joint Application

6.1 General principles

A joint application is a request for the registration of more than one design within the same application by joining two or more earlier applications filed with Sakpatenti. Each of the designs contained in a joint application is examined and dealt with separately. In particular, each design is the subject of independent protection (Article 12(3) of the **Law**) and thus may, separately, be enforced, be licensed, be the subject of a levy of execution or insolvency proceedings, be surrendered, renewed or assigned, be the subject of deferred publication or be declared invalid.

Joint application is subject to specific registration and publication fees, being paid for each design in the application.

6.2 Formal requirements applying to joint application

6.2.1 General requirements

All the designs in a joint application must have the same owner(s) and the same representative(s) (if any).

The maximum number of designs contained in a joint application is unlimited. The designs need not be related to one another or be otherwise similar in terms of appearance, nature or purpose. The designs must, however, meet the “unity of class” requirement (see paragraph 6.2.4 below).

The number of designs should not be confused with the “number of views” that represent the designs.

Applicant must number the designs contained in a joint application consecutively, using Arabic numerals.

6.2.2 Specific requirements

The joint application may be filed with Sakpatenti before issuing decision of substantive examination on registration concerning designs contained in it.

The scope of protection of joint application may not exceed the scope of protection of designs contained in it.

Each design contained in joint application shall enjoy its individual priority.

The joint application shall be processed as new application and individual prosecution of applications contained in it shall be ceased.

6.2.3 Separate examination

Each of the designs contained in a joint application is examined separately. If a deficiency concerning some of the designs contained in a joint application is not remedied within the time limit set by Sakpatenti, the application will be refused only insofar as those designs are concerned.

The decisions on the registration or refusal of the designs contained in a joint application will all be taken at the same time.

Even if some of the designs in a joint application already comply with both formal and substantive requirements, they will not be registered until any deficiencies affecting other designs have been remedied or the designs in question have been refused by the decision of an examiner.

6.2.4 The “unity of class” requirement

Principle

All the product(s) indicated for the designs contained in a joint application must be classified in only one of the 32 Locarno classes.

Products other than ornamentation

The products indicated for each design in a joint application may differ from those indicated for others.

“Unity of class” requirement is considered to be complied with even if the products belong to different subclasses of the same class of the Locarno Classification.

For instance, a joint application is acceptable if it contains one design with the product indication *motor vehicles* (Class 12, subclass 08) and one design with the product indication *vehicle interiors* (Class 12, subclass 16), or if both designs indicate both these terms. This is an example of two designs in different subclasses but in the same class, namely Class 12 of the Locarno Classification.

An objection would, however, be raised if, in the above example, the products indicated were *motor vehicles* (Class 12, subclass 08) and *lights for vehicles*, since the second term belongs to Class 26, subclass 06 of the Locarno Classification. The examiner would then require the joint application to be divided, as explained below.

Ornamentation

Ornamentation is a decorative element capable of being applied to the surface of a variety of products without affecting their contours. It can take the form of a pattern, including a molding, engraving or carving in which the design stands out from a flat surface.

Although ornamentation is, in itself, a product within the meaning of the Locarno Classification (Class 32), its primary purpose is to constitute one of the features of other products. Therefore, representations of ornamentation should not include the product to which it will be applied.

A multiple application can therefore combine designs for ornamentation with designs for products such as those to which the ornamentation will be applied, provided that all the products belong to the same class of the Locarno Classification.

For some designs, the indication *ornamentation* or *product(s) X (ornamentation for)* in Class 32 of the Locarno Classification is neutral and therefore ignored for the purpose of examining whether the product indication for the remaining designs meets the ‘unity of class’ requirement.

The same reasoning applies to the following product indications in Class 32 of the Locarno Classification: *graphic symbols*, *logos* and *surface patterns*.

For example, a multiple application is acceptable if it combines designs for *ornamentation* or *china (ornamentation for)* in Class 32 with designs representing pieces of a tea set for *china* in Class 7, subclass 01. However, if, in turn, *linen (table -)* were indicated as a product for one of these designs, an objection would be raised as this product belongs in Class 6, subclass 13 of the Locarno Classification, that is, a different class.

Where the representation of the design is not limited to ornamentation itself but also discloses the product to which such ornamentation is applied, without the contours of this product being disclaimed, the examiner will raise an objection and will suggest replacing the indication *ornamentation* with the product indication for the product disclosed and the classification must be amended accordingly.

This may lead to an objection where a multiple application combines a number of such designs applied to products that belong to different classes of the Locarno Classification.

Deficiencies

Where a joint application combines a number of designs applied to products that belong to more than one class of the Locarno Classification, a deficiency will be raised.

For example, let us assume that four designs representing cars are combined in one joint application, and the product indication for each design is *motor cars* (subclass 12-08) and *scale models* (subclass 21-01).

The examiner will issue an objection and request the applicant to:

- delete some of the product indications so that the remaining products can be classified in only one Locarno class; or
- divide the application into two multiple applications for each of the Locarno classes concerned, and pay the corresponding additional fees; or
- divide the application into four single applications for each design concerned and pay the corresponding additional fees.

The applicant will be invited to comply with the examiner's request within 1 month and pay the total amount of fees for two or more applications resulting from the division of the joint application according to Locarno classification or to delete some products in order to meet the "unity of class" requirement.

Where the applicant does not remedy the deficiencies in due time, Sakpatenti:

- will continue prosecution of only those designs which are applied to products that belong to one class; or
- will identify one class, where applicant has not classified designs himself, and continue prosecution of only those designs which belong to this class.

7. Separated Application

7.1 General principles

A separated application may result from division of multiple or joint application and represents a request for the registration of one or more designs within the same application earlier being filed with Sakpatenti (Article 11 of the **Instruction**).

7.2 Requirements applying to separated application

The separated application may be filed with Sakpatenti before issuing decision of substantive examination on registration concerning designs contained in it.

The scope of protection of separated application may not exceed the scope of protection of main application it was derived from.

Design(s) contained in separated application shall enjoy priority granted to main application it was derived from.

The main application shall be processed in regular manner.

7.3 Prosecution of separated application

Where separated application contains single design, it shall meet requirements set by the **Law** and the **Instruction** for single design application and be processed as such.

Where separated application contains multiple designs, it shall meet requirements set by the **Law** and the **Instruction** for multiple design application and be processed as such.

8. Filing of the national application

For design applications filed through Sakpatenti's e-filing system, it immediately issues an automatic electronic filing receipt, which contains the date of receipt and the file number.

If application is delivered personally to Sakpatenti by the applicant or his representative, filing receipt, containing assigned file number and filing date, shall be issued immediately and given to the applicant or his representative.

Where the application is sent by post, the applicant will receive the confirmation of receipt from Sakpatenti also by post.

Filing receipt does not represent confirmatory document of "filing date".

9. Priority claim

9.1 Priority claim and supporting documents

Applicant may claim convention or exhibition priority when filing application or within one month of filing date, but before accomplishment of formal examination (Article 13(1) of the **Instruction**) which may be accomplished by Sakpatenti only after expiration of one-month period.

Where the applicant claims the priority of one or more previous applications by providing relevant details but without submitting a copy thereof, or claims priority from an exhibition without submitting a certificate thereof, the applicant may still submit a copy / certificate within 3 months of the claiming priority (Articles 13(2) and 13(3) of the **Instruction**).

9.2 Priority claims made subsequent to filing

The priority of one or more previous applications or of an exhibition may still be claimed within 1 month of the filing date (Article 13(1) of the **Instruction**), by submitting the

declaration of priority, stating the file number, date and country of the previous application or the name of the exhibition and the date of first disclosure of the product.

9.3 Convention priority and exhibition priority

9.3.1 Convention Priority

General principles

An application for a design may claim the priority of one or more previous applications for the same design in or for any state party to the Paris Convention or to the Agreement establishing the World Trade Organization (Article 13(1) of the **Law**). This “Convention priority” is of 6 months from the date of filing of the first application.

Any filing that is equivalent to a standard national filing under the domestic law applicable to it will be recognised as giving rise to the right of priority. A standard national filing means any filing that is suitable for establishing the date on which the application was filed in the country concerned, whatever the subsequent outcome of that application.

Priority may be claimed either when filing design application or within 1 month of the filing date, but before accomplishment of formal examination stage (Article 13(1) of the **Instruction**) which may be accomplished by Sakpatenti only after expiration of one-month period. During this month, the applicant must submit the declaration of priority and indicate the application number as well as the date on which and the country in which the previous application was made (Article 5(3)(e) of the **Instruction**).

Where there is no indication of the claim in the application, the submission of priority documents within 1 month of the filing date will be construed as a declaration of priority.

Formal requirements

At the filing stage, Sakpatenti will only examine whether all formal requirements are met.

The formal requirements are:

- priority claim must be filed together with the design application or within 1 month of the filing date;
- application number, filing date and country of previous application must be indicated when claiming priority;
- attested copy of all priority documents must be submitted in due time, i.e. within 3 months of either the filing date of the application (when priority is claimed in the application) or the date of declaration of priority (when priority is claim during one month subsequent to filing) along with attested translations into Georgian thereof.

The priority document must consist of a copy of the entire previous application or registration, emanating from the authority that received it, stating the filing date of that application. The priority document may be filed in the form of an original or as an attested (by the authority that received it) photocopy. Insofar as the original document contains a representation of the design in colour, the photocopy must also be in colour.

At the same time Sakpatenti is participating office of WIPO Digital Access Service (WIPO DAS) which is an electronic system allowing priority documents to be securely exchanged between [participating national / regional intellectual property offices](#). The system enables participating offices to meet the requirements of the [Paris Convention](#) for certification in an electronic environment.

In order to use the WIPO Digital Access Service (WIPO DAS) applicant must request the first office to make priority documents available to the System and as a result the first office registers it in the system with indication of the following mandatory data elements:

- IP type;
- Priority office code;
- Priority application number;
- Priority application filing date;
- Access code.

After making application available in WIPO Digital Access Service (WIPO DAS), applicant may request access code which can be applied in the course of claiming priority when filing a subsequent application before the participating office and thus eliminate the need for providing paper copies of the first application and related registration documents. However, in the course of claiming priority related to the application being available in WIPO Digital Access Service (WIPO DAS), applicant must provide to Sakpatenti attested translation of documents being available through the service (Article 13(2¹) of the **Instruction**).

For the purpose of examining the formal requirements, the examiner will only verify that the information allowing the examiner to check the application number, date and country of the previous application has been provided in Georgian. However, the applicant must also file complete and dully attested translation of the remaining parts concerning the substantive requirements. This is also in the interests of third parties when inspecting the validity of the priority claim.

Formal priority requirements not satisfied

At the filing stage Sakpatenti will limit itself to verifying whether the formal requirements listed above relating to a priority claim are satisfied.

Where remediable deficiencies are found, the examiner will request that the applicant remedy them within 1 month.

If the deficiencies are not remedied in due time or cannot be remedied, Sakpatenti will reject convention priority claim and grant the application priority corresponding with filling date of the application (Article 13(5) of the **Instruction**).

If the deficiencies that are not remedied concern only some of the designs contained in a multiple application, the convention priority claim will be rejected in respect only of the individual designs concerned.

Substantive requirements

The substantive requirements to be met for a priority claim to be considered valid will be examined before accomplishment of formal examination and will be based on the copy of the priority documents submitted. It is, therefore, the responsibility of the applicant to submit a copy of the priority documents and translations thereof within required time limit to allow the priority claim to be examined substantively.

The requirements that refer to the substance of the priority claims are:

- previous application must be a first filing;
- previous application must concern a design;
- filed design must relate to the same design;
- proprietor of the previous design must be the same;

- priority must be claimed within 6 months of filing the first application;
- previous application must have been filed in a country where a right of priority can arise.

If the priority claim does not satisfy all of the substantive requirements, the applicant will receive request to provide examination with additional documentation within the time limit set by Sakpatenti. If the validity of the priority claim cannot be verified, the priority cannot be taken into account for the purpose of the proceedings concerned. The decision on the priority claim can be separately appealed at the Chamber of Appeals or the court.

The previous application is a first filing

As a matter of principle, the previous application must be a first filing. The examiner will therefore check that the priority document does not refer to priority being claimed in respect of an even earlier application.

The previous application concerns a design

The priority of a previous design application may be claimed, including that of a previous national design or an international design registration.

The design relates to the same design

The subject matter of the previous application must be identical to that of the corresponding design, without the addition or deletion of any features. The subject matter is nevertheless considered to be identical if the design applied for and the previous design application differ only in details that can be qualified as immaterial.

The proprietor of the previous design is the same

Priority can be claimed by the applicant of the first application or its successor in title. In the latter case, the first application must have been transferred prior to the filing date of the design application and documentation to this effect must be submitted.

The right of priority as such may be transferred independently of the first application. Priority can therefore be accepted even if the holders of the design and the previous application are different, provided that evidence of assignment of the priority right is submitted. In this case, the execution date of the assignment must be prior to the filing date of the design application.

Subsidiary or associated companies of the applicant are not considered to be the same legal entity as the design applicant itself.

Priority is claimed within 6 months of filing the first application

Sakpatenti will examine whether the date of filing allocated to the design is within 6 months of the filing date of the first application. Applicants should note that the date of filing allocated by Sakpatenti may not always correspond to the date of receipt of the design application.

The priority right claimed must always be a previous application, which, for this very reason, cannot bear the same date as the design application.

The previous application was filed in a country where a right of priority can arise

The “convention priority” right is a right limited in time, which is triggered by the first regular filing of a design. A regular national filing is any filing that is “adequate to establish the date on which the application was filed in the country concerned, whatever the subsequent fate of the application” (Article 4A(3) Paris Convention). It may be claimed during the 6 months following the first filing, provided the country of first filing was a party to the Paris Convention or to the Agreement establishing the World Trade Organisation (WTO).

9.3.2 Exhibition priority

General principles

The effect of exhibition priority is that the date on which the design was displayed at an exhibition is deemed to be the date of filing of the application for a design.

The applicant can claim exhibition priority within 6 months of the first display.

Exhibition priority cannot extend the 6-month period of “Convention priority” and vice versa (Article 13(3) of the **Law**).

Claiming exhibition priority

Similar to “Convention priority”, exhibition priority can be claimed either when filing design application or within 1 month of the filing date, but before accomplishment of formal examination stage (Article 13(1) of the **Instruction**) which must be accomplished by Sakpatenti only after expiration of one-month period. During this month, the applicant must submit the declaration of priority and indicate the date of first display of the product (Article 5(3)(f) of the **Instruction**).

The applicant must, within 3 months of the filing date of the application or the declaration of priority, provide Sakpatenti with a certificate issued by the responsible authority of the official exhibition (Article 13.3 of the **Instruction**) being organised on the territory of the country being member of the Paris Convention or WTO (Article 13(2) of the **Law**). This certificate must state that the design was disclosed at the exhibition by display of the product in which the design is incorporated and specify the opening date of the exhibition (Article 13(4) of the **Instruction**).

Priority can only be granted where the application for a design is filed within 6 months of first display at an exhibition.

Deficiencies

Sakpatenti will limit itself to verifying whether the following requirements of an exhibition priority claim have been satisfied:

- whether the filing date of the design falls within the 6-month period following the first display of the product;
- whether the first display of the product took place in the course of exhibition which was organised in the territory of the member of the Paris Convention or WTO
- whether priority was claimed when filing the application or within 1 month of the filing date;
- whether the application or the subsequent declaration of priority gives the date of first display of the product;
- whether the certificate issued at the exhibition by the responsible authority was submitted in due time;
- whether the certificate issued at the exhibition is translated and attested;
- whether the proprietor named in this certificate is the same as the applicant.

Where remediable deficiencies are found, the examiner will request the applicant to remedy them within 1 month.

If the deficiencies are not remedied in due time or cannot be remedied, Sakpatenti will reject exhibition priority claim and grant the application priority corresponding with filing date of the application (Article 13(5) of the **Instruction**).

If the deficiencies that are not remedied concern only some of the designs contained in a multiple application, the exhibition priority claim will be rejected in respect only of the individual designs concerned.

10. Examination

10.1 Examination of the application

Sakpatenti carries out an examination of the application according to articles 14-17 of the **Law** and Chapters II and III of the **Instruction**.

The examination of the application will be put on hold in the periods between sending communication by the examiner and providing respond by the applicant. Corresponding terms being set for the examination will be extended respectively.

10.2 Allocation of the filing date

The date on which an application is “filed” is the date of actual receipt by Sakpatenti and not, for example, date on which application was sent by post or courier.

Sakpatenti shall allocate filing date within 2 weeks of filing the application.

Allocation of a filing date requires that the application is filed in Georgian language and contains at least:

- (a) a request for registration of a design;
- (b) name and address of the applicant; and
- (c) a representation of the design suitable for reproduction (pursuant to Articles 7(1) and 15(1) of the **Instruction**) or, where applicable, a specimen (Articles 8(1) and 15(2) of the **Instruction**).

If representation of the design is not clear which makes impossible its perception, design shall not be considered as filed.

If the application meets above mentioned requirements, Sakpatenti will allocate “filing date” which will be the date of filing materials with Sakpatenti.

If the application does not meet any of these requirements, Sakpatenti will notify the applicant of the deficiency, and give the applicant 1 month from receipt of the notification to remedy that deficiency.

If deficiencies are remedied within the time limit set by Sakpatenti, the date on which all the deficiencies are remedied will determine the date of filing.

If the deficiencies are not remedied within the time limit set by Sakpatenti, the application will be rejected and the file will be closed.

10.3 Examination of formal requirements

Sakpatenti carries out an examination of formal requirements within 1 month of allocation “filing date”, but not before expiration of 1 month term from filing of application if respective fees had been dully paid by the applicant.

Formal examination fees have to be paid within 2 weeks of filing the application with Sakpatenti otherwise application will not be processed.

If several designs are contained in the application and the paid fees are not sufficient for processing all of them, deficiency will be raised by Sakpatenti inviting the applicant to remedy deficiency within 1 month by:

- Paying of the fees in full or
- Sending confirmation to Sakpatenti as to which design(s) has to be processed within paid amount of the fees

If the applicant does not respond Sakpatenti's request within 1 month of receipt the communication, Sakpatenti will process only the number of designs which corresponds the fees actually paid by the applicant taking into account consecutive numbering of designs.

In the course of formal examination Sakpatenti verifies compliance of the filing materials with requirements set by Article 16 of the **Law** and the **Instruction**.

If filing materials do not comply with above mentioned requirements, Sakpatenti will raise deficiency which shall be remedied by the applicant within 1 month of its receipt. If applicant does not comply with Sakpatenti's request, application will be rejected and respective decision sent to the applicant.

Decision of formal examination may be appealed by the applicant at the Chamber of Appeals or court.

In case of multiple application, above mentioned procedures may be applicable only to some of the designs contained in the application.

If the application meets the requirements set by the **Law** and **Instruction**, Sakpatenti will assign it a number, confirm priority and issue a decision on accomplishment of the formal examination, which will be communicated to the applicant.

10.4 Substantive examination

In the course of the substantive examination Sakpatenti verifies compliance of the filing materials with the requirements set by Articles 3, 10 and 17 of the **Law** and the **Instruction**.

Sakpatenti carries out substantive examination within three months of accomplishment of the formal examination, provided that the respective fees have been dully paid by the applicant.

The substantive examination fees have to be paid within 2 weeks of receipt formal examination decision by the applicant otherwise the application will not be processed.

If several designs are contained in the application and the paid fees are not sufficient for processing all of them deficiency will be raised by Sakpatenti inviting the applicant to remedy deficiency within 1 month by:

- Paying of the fees in full or
- Sending confirmation to Sakpatenti as to which design(s) has to be processed within paid amount of the fees

If the applicant does not respond Sakpatenti's request within 1 month of receipt the communication, Sakpatenti will process only the number of designs which corresponds the fees actually paid by the applicant taking into account consecutive numbering of designs.

Sakpatenti shall suspend prosecution of the application if it is supposed that the design in question is identical to the design with earlier priority being filed prior to this design. In such case prosecution of the application shall be suspended until the publication of favourable decision concerning the prior design in the Official Bulletin of Industrial Property or issuing refusal by Sakpatenti concerning the same design.

In case of multiple application, above mentioned procedures may be applicable only to some of the designs contained in the application.

Upon accomplishment of substantive examination, Sakpatenti communicates to the applicant the respective decision.

Decision of substantive examination (registering or refusing the design) may be appealed by the applicant at the Chamber of Appeals or court.

10.4.1 Requirements of substantive examination

Sakpatenti carries out an examination of the substantive protection requirements, which is limited to the following grounds for non-registrability:

- Non-compliance with the definition of a design;
- Lack of novelty (limited assessment);
- Non-compliance with public order;
- Use of country name, state coat of arms, flag, money sign (without consent of the competent authority);
- Use of name, coat of arms or flag of international organization (without consent of such organization);
- Use of geographical indication or appellation of origin.

An application will be refused if the design does not correspond to the above listed requirements.

10.4.1.1 Compliance with the definition of a design

A “design” means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation (Article 3(1) of the **Law**).

A “product” means any industrial or handicraft item, including, inter alia, parts intended to be assembled into a complex product, packaging, get-up, graphic symbols, graphic user interfaces and typographic typefaces, but excluding computer programs (Article 3(2) of the **Law**).

Whether the product claimed is actually made or used, or can be made or used, in an industrial or handicraft manner will not be examined.

Whether a design discloses the appearance of the whole or a part of a “product” will be examined in the light of the design itself, insofar as it makes clear the nature of the product, its intended purpose or its function, and of the indication of the products in which the design is intended to be incorporated or to which it is intended to be applied.

The following examples, albeit non-exhaustive, illustrate the EUIPO's practice.

Blueprints, plans for houses or other architectural plans or landscape designs

Blueprints, plans for houses or other architectural plans or landscape designs (e.g. gardens) will be considered “products” for the purpose of applying Article 3(2) of the **Law** and will be

accepted only with the corresponding indication of *other printed matter* in Class 19-08 of the Locarno Classification.

An objection will be raised if the product indicated in an application for a design consisting of a blueprint of a house is *houses* in Class 25-03 of the Locarno Classification. This is because a blueprint does not disclose the appearance of a finished product such as a house.

Colours per se and combinations of colours

A single colour may of course be an element of a design, but on its own it does not comply with the definition of a design because it does not constitute the “appearance of a product”.

Combinations of colours may be accepted if it can be ascertained from the contours of the representation that they relate to a product such as, for instance, a logo or a graphic symbol in Class 32 of the Locarno Classification.

Icons

Designs of screen displays and icons, graphic user interfaces and other kinds of visible elements of a computer program are eligible for registration (see class 14-04 of the Locarno Classification).

Mere verbal elements

Mere words per se and sequences of letters (written in standard characters in black and white) do not comply with the definition of a design because they do not constitute the appearance of a product.

The use of fanciful characters and/or the inclusion of a figurative element, however, render(s) the design eligible for protection either as a logo/graphic symbol in Class 32 of the Locarno Classification or as the ornamental representation of a part of any product to which the design will be applied.

Music and sounds

Music and sounds per se do not constitute the appearance of a product and, therefore, do not comply with the definition of a design.

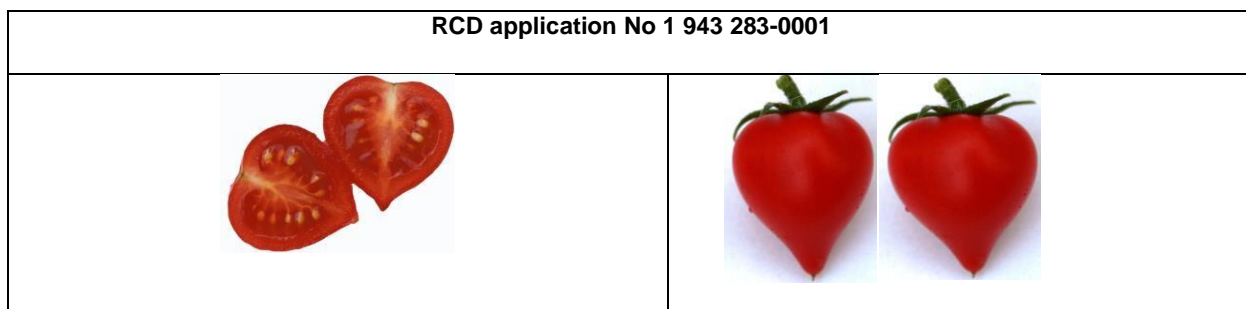
However, the graphical representation of a musical composition, in the form of musical notation, would qualify as a design, if applied for as, for example, *other printed matter* in Class 19-08 or *graphic symbols* in Class 32 of the Locarno Classification.

Photographs

A photograph per se constitutes the appearance of a product and, therefore, complies with the definition of a design, irrespective of what it discloses. The indication of the product can be *writing paper, cards for correspondence and announcements* in Class 19-01, *other printed matter* in Class 19-08 of the Locarno Classification, or any product to which the design will be applied.

Living organisms

Living organisms are not “products”, that is, industrial or handicraft items. A design that discloses the appearance of plants, flowers, fruits etc. in their natural state will, in principle, be refused. Even if the shape at issue deviates from that of the common corresponding living organism, the design should be refused if nothing suggests *prima facie* that the shape is the result of a manual or industrial process (18/02/2013, R 595/2012-3, GROENTE EN FRUIT, §11).



However, in the cited example, no objection will be raised if it is apparent from the representation that the product does not show a living organism or if the indication of the product specifies that the product is artificial (see, in particular, Class 11-04 of the Locarno Classification).

Teaching materials

Teaching materials such as graphs, charts, maps etc. can be representations of products in Class 19-07 of the Locarno Classification (*Teaching materials*).

Concepts

A design application will be refused where the representation is of a product that is simply one example amongst many of what the applicant wishes to protect. An exclusive right cannot be granted to a “non-specific” design that is capable of taking on a multitude of different appearances. This is the case where the subject matter of the application relates, inter alia, to a concept, an invention or a method for obtaining a product.

10.4.1.2 Lack of novelty

A design will pass examination step to the extent that it is new. The novelty of a design must be examined on its date of filing or, as the case may be, on its date of priority, in the light of the relevant earlier designs which are limited to (a) the designs filed with Sakpatenti and (b) designs filed with International Bureau with request of extension its protection to the territory of Georgia (Articles 3(6), 10(b), 10(c) and 17(2) of the **Law**). Broader assessment of novelty, for example with regard to designs being used on the market or published as a result of their filing in other jurisdictions, are not subject of the examination, but may become subject of consideration at the Chamber of Appeals in the course of opposition proceedings and at the court in the course of an invalidation action.

Individual character of the design is not assessed at the stage of examination and may be subject of opposition at the Chamber of Appeals or invalidation action at the court (for more details please see below paragraphs 22.1 and 22.1.2.3).

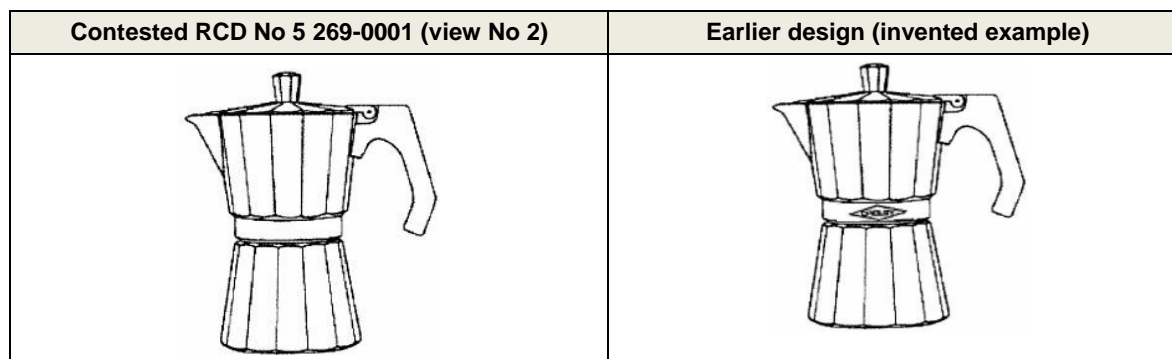
For the purposes of the examination design will be considered to be new if it is not predated by an identical design being filed with Sakpatenti or International Bureau with request of extension its protection to the territory of Georgia. Designs will be deemed to be identical if their features differ only in immaterial details (Article 3(7) of the **Law**).

There is identity between the design applied and the earlier design where the latter discloses each and every element constituting the former. A design cannot be new if it is included in a more complex earlier design (25/10/2011, R 978/2010-3, PART OF SANITARY NAPKIN, § 20-21).

However, the additional or differentiating features of the design may be relevant for deciding whether it is new, unless such elements are so insignificant that they may pass unnoticed.

An example of an immaterial detail is a slight variation in the shade of the colour pattern of the compared designs (28/07/2009, R 921/2008-3, NAIL FILES, § 25).

Another illustration is the display, in one of the two compared designs, of a label that is so small in size that it is not perceived as a relevant feature (08/11/2006, R 216/2005-3, CAFETERA, § 23-26), as in the following example.



Common principles. Global comparison.

The design must be compared individually with each and every earlier design found relevant by the examination. Novelty of a design cannot be defeated by combining features taken in isolation and drawn from a number of earlier designs, but by one or more earlier designs, taken individually (21/09/2017, C-361/15 P and C-405/15 P, Shower drains, EU:C:2017:720, § 69; 19/06/2014, C-345/13, Karen Millen Fashions, EU:C:2014:2013, § 23-35; 22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 23-24).

A combination of already disclosed features is, therefore, eligible for protection as a design, provided the combination, as a whole, is novel.

In principle, subject to a number of exceptions detailed below, all the features of conflicting designs must be taken into consideration when examining novelty.

Point of reference for the comparison

The design applied is the point of reference when assessing novelty in the comparison with the earlier design.

Novelty, therefore, have to be assessed solely on the basis of the features disclosed in the design applied (13/06/2017, T-9/15, Dosen [für Getränke], EU:T:2017:386, § 87).

Consequently, if the design applied reproduces only certain aspect views, for instance, the front view, a comparison is made only with the corresponding view of the earlier design. Any additional aspect views disclosed by the earlier design, such as the rear view, are disregarded.

The same principle applies when the design applied shows the appearance of only part of a product whereas the earlier design discloses the whole product.

However, in turn, when the design applied shows more features than the earlier design, its overall impression is determined by all of its features save for the exceptions outlined below.

Features dictated by a technical function and features of interconnection

Features that are solely dictated by a technical function and features that must necessarily be reproduced in their exact form and dimensions in order to allow interconnection with another product cannot contribute to the novelty of a design. Such features must therefore

be disregarded when comparing the design with the relevant earlier designs. However, when parts of a product serve a functional purpose without being solely dictated by the technical function, its features may constitute a differentiating factor to the extent that its features could be designed differently. For instance, a button operating the functions on an electronic wristband can be placed on the product in different ways and can have different shapes and sizes (04/07/2017, T-90/16, Measuring instruments, apparatus and devices, EU: T: 2017: 464, § 61).

The visibility requirement

Features of a design applied to, or incorporated in a “component part of a complex product”, will be disregarded if they are invisible during normal use of the complex product in question and thus will not be taken into consideration when comparing the design with the relevant earlier designs (Article 3(10) of the **Law**).

“Complex product” means a product that is composed of multiple components that can be replaced, permitting disassembly and reassembly of the product (Article 3(3) of the **Law**). For instance, the visibility requirement does not apply to a design representing the appearance of a garbage container as a whole since garbage containers may be complex products as such, but not component parts of complex products (23/06/2008, ICD No 4 919).

“Normal use” means use by the end user, excluding maintenance, servicing or repair work. “Normal use” is the use made in accordance with the purpose for which the complex product is intended.

For instance, for safety reasons, an electrical connector is a component part that is normally incorporated in a casing in order to be shielded from any contact with potential users when a complex product, such as a train or an electric vehicle, is in operation. The fact that such a component part of a complex product can theoretically be made visible when inserted in a transparent casing or cover constitutes a purely hypothetical and random criterion that must be disregarded (03/08/2009, R 1052/2008-3, Contacteurs électriques, § 42-53).

Where none of the features of a design applied to a component part (e.g. a sealing ring) is visible during normal use of the complex product (e.g. a heat pump system), the design will be refused as a whole (20/01/2015, T-616/13, Heat Exchanger Inserts, EU:T:2015:30, § 14-16).

However, the **Law** does not require a component part to be clearly visible in its entirety at every moment of use of the complex product. It is sufficient if the whole of the component can be seen some of the time in such a way that all its essential features can be apprehended (22/10/2009, R 690/2007-3, Chaff cutters, § 21).

Where the features of a design applied to a component part are only partially visible during normal use of the complex product, the comparison with the relevant earlier designs invoked must be limited to the visible parts.

Clearly discernible features

Features of a design that are not clearly discernible in its graphical representation cannot contribute to its novelty. Likewise, features of the earlier design that are not of sufficient quality to allow all the details to be discerned in the portrayal of the earlier design cannot be taken into consideration for the purpose of assessment of novelty (10/03/2008, R 586/2007-3, Barbecues, § 23-26).

Disclaimed features

Features of design applied that are disclaimed are disregarded for the purposes of comparing the designs. This applies to the features of a design applied represented with broken lines, blurring, colour shading or boundaries or in any other manner making clear that protection is not sought in respect of such features (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 59-64).

In contrast, disclaimed features of an earlier registered design can be taken into account when assessing the novelty of a design applied because the earlier design is considered as a disclosure irrespective of the subject matter of protection as a design, and thus includes even the disclaimed features.

10.4.1.3 Non-compliance with public order

General principles

Sakpatenti will apply the concepts of public policy and morality to make sure that registration of the design is in compliance with public order. Doing so Sakpatenti will be guided by below given principle and practices regarding trademarks but being applicable mutatis mutandis to the designs:

- Principle implemented with Article 6quinquies(B)(3) of the Paris Convention regarding trademarks, which provides for the refusal of trademark application and for the invalidation of registration where trademark is “contrary to morality or public order”;
- Practice being implemented by Sakpatenti;
- Best European practice.

It is not necessary that use of the design would be illegal and prohibited by other pieces of legislation (other than IP laws). However, illegality of the use of the design under legislation is a strong indication that the design should be refused.

The wording of “public order” is very broad and allows a great deal of room for interpretation. A judicious application of this provision necessarily entails balancing the right of traders to freely employ words and images they wish to register as designs against the right of the public not to encounter disturbing, abusive, insulting and even threatening designs (06/07/2006, R 495/2005-G, SCREW YOU, §14).¹

The rationale of legislation and practice should not be to identify and filter out designs whose use in commerce must at all costs be prevented, but to preclude designs from registration where granting a monopoly would contravene the state of law or would be perceived by the relevant public as going directly against the basic moral norms of society. In other words, IP office should not positively assist people who wish to further their business aims by means of designs that offend against certain basic values of civilized society (06/07/2006, R 495/2005-G, SCREW YOU, § 13).

The application of such regulation is not limited by the principle of freedom of expression (Freedom of expression - Article 10 of European Convention on Human Rights and Article 17 of Constitution of Georgia) since the refusal to register only means that the design is not granted protection under the design law and does not stop that design from being used — even in business (09/03/2012, T-417/10, ¡Que buen uye! HIJOPUTA (fig.), EU:T:2012:120, § 26).

Whether or not a design is contrary to public policy or accepted principles of morality must be determined by the intrinsic qualities of the design applied for, and not by the circumstances relating to the conduct of the person applying for the design (13/09/2005, T-140/02, Intertops, EU:T:2005:312, § 28).

¹ Court decisions cited in this paragraph refers to trademark cases but are relevant to designs as well.

Public policy

The safeguard of public policy may be relied on to refuse a design application only if there is a genuine and sufficiently serious threat to a fundamental interest of society (14/03/2000, C-54/99, *Église de scientologie*, EU:C:2000:124, §17).

Sakpatenti will apply universal rule reflected in article 10 of the Treaty on the Functioning of the European Union stating that “In defining and implementing its policies and activities, the Union shall aim to combat discrimination based on sex, racial or ethnic origin, religion or belief, disability, age or sexual orientation.” Accordingly, designs that portray or promote violence or discrimination based on sex, racial or ethnic origin, religion or belief, disability, age or sexual orientation will be refused on that account.

“Public policy” is the body of all legal rules that are necessary for the functioning of a democratic society and the state of law. In this context “public policy” refers to the body of country’s legislation, as well as to the legal order and the state of law which reflect a common understanding of certain basic principles and values, such as human rights.

Morality

The safeguard of morality may be relied on to refuse a design application if the design is perceived as sufficiently obscene or offensive from the perspective of a reasonable person of normal sensitivity and tolerance (09/03/2012, T-417/10, *¡Que bueno ye! Hijoputa* (fig.), EU:T:2012:120, §21).

Objection based on “morality” concerns subjective values, but these must be applied as objectively as possible by the examiner. For, instance, the provision excludes registration as designs containing blasphemous, racist, discriminatory or insulting signs, but only if that meaning is clearly conveyed in an unambiguous manner. The standard to be applied is that of the reasonable consumer with average sensitivity and tolerance thresholds (09/03/2012, T-417/10, *¡Que bueno ye! HIJOPUTA* (fig.), EU:T:2012:120, §21).

The concept of morality is not concerned with bad taste or the protection of individuals’ feelings. In order to be refused by Sakpatenti, a design must be perceived by the relevant public, or at least a significant part of it, as going directly against the basic moral norms of society. It is not sufficient if the design is only likely to offend a small minority of exceptionally puritanical citizens.

Conversely, a design should not be allowed to be registered simply because it would not offend the equally small minority at the other end of the spectrum who find even gross obscenity acceptable. The design must be assessed by reference to the standards and values of ordinary citizens who fall between those two extremes (06/07/2006, R 495/2005-G, *SCREW YOU*, §21).

Legislation and practice existing in the country are considered to be factual evidence that enables an assessment of the perception of the relevant public. Example of national legislation taken into account as evidence of a sign being contrary to accepted principles of morality is the law of Georgia - Charter of Freedom and of the existing practice - Sakpatenti’s refusals to register trademarks containing word designations STALIN (please see below image), СЕРП И МОЛОТ (Hammer and Sickle), SOVIET (please see below image) arguing that registration of these signs may facilitate use and may be considered as a propaganda of soviet symbols being prohibited by Georgian Law “Charter of Freedom” which reads the following:

“Article 1 - Purpose of the Law

This Law, in compliance with international standards and universally recognised principles and norms, intends to: eliminate the threat of crimes against the state, and terrorism and

violation of the principles of state security; ensure the effective exercise of the legislative norms of Georgia and strengthen national security in accordance with modern practices; provide preventive measures against the principles of communist totalitarian and national socialist (Nazi) ideologies; remove the symbols and names of cult buildings, memorials, monuments, bas-reliefs, inscriptions, streets, squares, villages and settlements of the communist totalitarian regime, as well as prohibit the propaganda instruments and other means of communist totalitarian and national socialist (Nazi) ideologies.”

National Trademark Application 86191/3	National Trademark Application 80173/3
	

Designs that can be perceived as promoting the use of illegal drugs also fall under morality standard. Taking into account, as factual evidence, that cultivation, possession and consumption of drugs (except cases provided by the law, for example, possession of small amount and consumption of cannabis) are illegal in Georgia an objection should be raised. It is an objective indication that such signs would be perceived as going directly against the basic moral norms of society.

10.4.1.4 Use of country and territorial unit names, flags and other state and intergovernmental organizations' symbols

General remarks

Sakpatenti assesses the legality of use in designs of country and territorial unit names, including in full or abbreviated form, armorial bearings and flags that belong to states and/or international or intergovernmental organisations, money signs at the stage of substantive examination and will be guided by below given principle and practices regarding trademarks but *mutatis mutandis* being applicable to the designs as well:

- Principle implemented with Article 6^{ter} of the Paris Convention regarding trademarks, which provides for the refusal of trademark applications and for the invalidation of registrations if trademark constitutes an improper use of items listed in the article;
- Practice being implemented by Sakpatenti;
- Best European practice.

Design will be refused *ex-officio* if it contains modern name of Georgia or its territorial unit, as well as, name of foreign state. At the same time, designs containing historical name of Georgia or its territorial units, like Colchis or Iberia, located in the territory of Georgia, may be challenged at the court. It should be noted that modern / historical names of foreign state's territorial unit are not subject of the protection of the **Law**.

Design will be also refused if it constitutes an improper use of any of the items listed in Article 6^{ter} of the Paris Convention and representation of the money sign.

The items covered by Article 6^{ter} are the following:

- armorial bearings, flags, other emblems, official signs and hallmarks that belong to states and have been communicated to WIPO, although, in the case of flags, such communication is not mandatory;

- armorial bearings, flags, other emblems, abbreviations and names of international intergovernmental organisations that have been communicated to WIPO, with the exception of those already the subject of international agreements for ensuring their protection.

When an item that is not listed in Article 6ter is invoked and Sakpatenti issues refusal concerning registration of the design, examination has to substantiate that such item is of particular public interest in Georgia.

Article 4(1)(i) of Trademark Law incorporates Article 6ter of the Paris Convention for the Protection of Industrial Property into the Georgian trademark system. The same is true for Articles 10(e) and 10(f) of the **Law** which seem to be limited version of respective provision regulating trademarks. It therefore protects armorial bearings, flags and other state emblems of states that are party to the Paris Convention, as well as official signs and hallmarks indicating control and warranty adopted by them. This protection was extended to armorial bearings, flags, other emblems, abbreviations and names of intergovernmental organisations (IGOs) in 1958. Georgian legislation applies only if the sign applied for is identical to a protected “emblem” or is a heraldic imitation of such an “emblem”.

However, use in design of official signs and hallmarks indicating control and warranty may not be subject of the *ex-officio* refusal, but at the same time such design may be challenged at the court through invalidation proceeding (Article 29(1)(h) of the **Law**).

The objective of Article 6ter Paris Convention is to exclude the registration and use of trade marks that are identical or notably similar to state emblems, official signs and hallmarks indicating control and warranty adopted by the states or the emblems, abbreviations and names of IGOs. This prohibition is also applicable to designs, because such registration or use would adversely affect the right of the authority concerned to control the use of the symbols of its sovereignty, and might, moreover, mislead the public as to the origin and other characteristics of the product to which a design is applied or in which it is incorporated. Registration of these emblems and signs, as well as any imitation from a heraldic point of view, either as a design or as an element thereof, shall be refused if no authorisation has been granted by the competent authority. Members of the World Trade Organization (WTO) enjoy the same protection pursuant to Article 2(1) TRIPS, according to which members of the WTO must comply with Articles 1 to 12 and 19 of Paris Convention.

Protected emblems and signs

State flags

A state flag is defined by the constitution of a state and/or by a specific law of that state. Normally, a state will have only one state flag. For instance, the Georgian flag is defined in Article 2 of Organic Law on State Symbols of Georgia, the Spanish flag is defined in Article 4 of the Spanish Constitution, the French flag is defined in Article 2 of the French Constitution and the German flag is defined in Article 22 of the German Constitution.

State flags enjoy protection per se without any need for registration at WIPO pursuant to Article 6ter (3)(a) Paris Convention. There is no need to establish any link between the product to which a design is applied or in which it is incorporated and the country. State flags enjoy absolute protection.

Armorial bearings, flags, and other state emblems

Armorial bearings normally consist of a design or image depicted on a shield. An example of an armorial bearing is the coat of arms of Spain.



Protected under ES5

Apart from the state flag (protected per se), a member state of the Paris Convention may also request protection for other flags, namely those of its first political division in a federal state. For instance, Germany has requested protection for the flags of each Bundesland ("federal state").



Protected under DE34 (flag of the federal state of Berlin)

In contrast, Spain has not requested protection for the flag of the Comunidades Autónomas (Autonomous Communities), only for the state flag and the state flag with the coat of arms. France and the United Kingdom are examples of states that have not requested protection for any flag.

The expression "other state emblems" indicates any emblems constituting the symbol of the sovereignty of a state. This might be a representation of the national crown



Protected under NL48

or the official seal of a member state of the Paris Convention



Protected under US1

Like state flags, armorial bearings, flags, and other state emblems enjoy absolute protection, irrespective of the product to which a design is applied or in which it is incorporated.

Armorial bearings, names, abbreviations and other emblems of intergovernmental organisations


Intergovernmental organisations of which one or more member states of the Paris Convention is a member enjoy protection for their armorial bearings, names, abbreviations and other emblems.

For instance, the following signs enjoy protection under the Paris Convention:

		
Protected under QO60.	Protected under QO1.	Protected under QO1248.

AU
Protected under QO884 for the AFRICAN UNION.

The European Union has requested, for instance, protection for the following signs, abbreviations and names:

	EUIPO	European Union Intellectual Property Office
Published under QO1717	Published under QO1742 (QO1743 to QO1746 in other languages)	Published under QO1718 (QO1719 to QO1741 in other languages)

Pursuant to Article 6ter(1)(c) of Paris Convention, armorial bearings, flags, names, abbreviations and other emblems of IGOs enjoy protection only for products that would suggest to the public that a connection exists between the organisation concerned and the armorial bearings, flags, emblems, abbreviations, and names, or if the design misleads the public about the existence of a connection between the user and the organisation.

Even though the European Union is not a state in terms of international law, but rather an international intergovernmental organisation, its area of activity is equated with that of a state (12/05/2011, R 1590/2010-1, EUROPEAN DRIVESHAFT SERVICES EDS (fig.), §54; 15/01/2013, T-413/11, European Driveshaft Services, EU:T:2013:12, § 70).

Consequently, the emblems of the European Union enjoy protection for all kind of products and there is no need to establish any specific link.

Pursuant to the Article 6ter(1)(b) Paris Convention, Article 6ter is not applicable to any armorial bearings, flags, other emblems, abbreviations, and names that are already the subject of international agreements in force intended to ensure their protection (e.g. under the Geneva Convention which protects the emblems of the Red Cross on a white ground, the words "Red Cross" or "Geneva Cross, and analogous emblems.").

Search for emblems

Relevant information about emblems protected under the Paris Convention is found in the WIPO Article 6ter database (<http://www.wipo.int/ipdl/en/6ter/>). The database can be searched by "state" (i.e. country), by "category" (i.e. the type of 'emblem') and by "Vienna Classification".

For example, Google image search (<https://images.google.com/>) might give some basic hints for identifying an emblem before the Article 6ter database is checked.

Since state flags enjoy protection per se without any need for registration at WIPO they are normally not found in the WIPO Article 6ter database (unless the flag is, at the same time,

protected as another state emblem). Tools for finding flags such as <http://www.flagid.org> or <http://www.flag-finder.com> can be consulted.

Reproduction and “Heraldic imitation” of the abovementioned symbols

To fall under the regulation of Paris Convention and respective provisions of the **Law** design:

- must consist solely of an identical reproduction or a “heraldic imitation” of the abovementioned symbols; or
- must contain an identical reproduction or a “heraldic imitation” of the abovementioned symbols.

Furthermore, the competent authority must not have given its authorization.

In principle, prohibition of the imitation of an emblem applies only to imitations of it from a heraldic perspective, that is to say, those that contain heraldic connotations that distinguish the emblem from other signs. Therefore, protection against any imitation from a heraldic point of view refers not to the image itself, but to its heraldic expression. Therefore, it is necessary to consider the heraldic description of the emblem at issue to determine whether the design contains an imitation from a heraldic point of view (16/07/2009, C-202/08 P & C-208/08 P, RW feuille d’érable, EU:C:2009:477, § 48; 05/05/2011, T-41/10, esf école du ski français (fig.), EU:T:2011:200, § 25).

It follows from the above that, in the course of examination by the Sakpatenti / court, as a first step, both the protected “emblem” and the sign being applied / registered as design must be considered from a heraldic perspective.

Nonetheless, according to principles reflected in findings of the European Court of Justice as far as “imitation from a heraldic point of view” is concerned, a difference detected by a specialist in heraldic art between the design applied for and the state emblem will not necessarily be perceived by the informed user and, therefore, in spite of differences at the level of certain heraldic details, the design may be an imitation of the emblem in question within the meaning of Article 6ter of Paris Convention (16/07/2009, C-202/08 P & C-208/08 P, RW feuille d’érable, EU:C:2009:477, § 50 et seq.; 25/05/2011, T-397/09, Suscipere et finire, EU:T:2011:246, § 24-25).


To apply respective restrictions, it can therefore be sufficient that the informed user, despite some differences in heraldic details, can see in the design an imitation of the “emblem”. There may, for example, be imitation when the design contains the main element of, or part of, the “emblem” protected under Article 6ter of Paris Convention. That element need not necessarily be identical to the emblem in question. The fact that the emblem in question is stylised or that only part of the emblem is used does not necessarily mean that there is no imitation from a heraldic point of view (21/04/2004, T-127/02, ECA, EU:T:2004:110, § 41).



As a first step, it is important that the Sakpatenti / court identifies the various elements of the design applied / registered and establishes the part that is considered to be the reproduction or heraldic imitation of an “emblem” protected under Article 6ter of Paris Convention. The size of the protected emblem contained in the design is irrelevant, as long as it is legible and perceivable.



The fact that the design applied for also contains word elements does not in itself preclude application of Article 6ter of Paris Convention (21/04/2004, T-127/02, ECA, EU:T:2004:110, § 41). On the contrary, such a word element may even strengthen the link between the design application and an emblem (13/03/2014, T-430/12, European Network Rapid Manufacturing, EU:T:2014:120, § 66 et seq.; 28/10/2014, R 1577/2014-4, SWISS CONCEPT, § 33).



Examples:


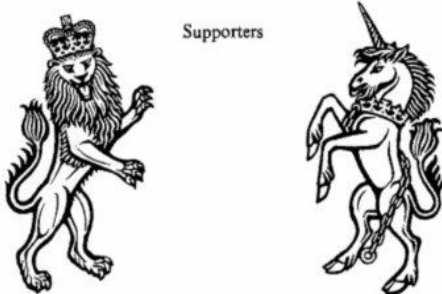

• Heraldic imitation found



Flag	Sign applied for
The flags of Norway, France, Austria, Germany, Sweden, France, Czech Republic, Belgium, Denmark, Ireland, Italy and Finland (from the top in a clockwise circle).	
	EUTM application No 10 502 714; 17/06/2013, R 1291/2012-2, WHO WANTS TO BE A FOOTBALL MILLIONAIRE (fig.)
The colours are recognisable and follow the structure of the flags.	

Flag	Sign applied for
	
Flag of the United Kingdom	EUTM application No 13 169 313
The trade mark contains a faithful representation of the UK flag in terms of colour/configuration. The slight degree of stylisation does not take it outside the scope of heraldic imitation.	



Flag	Sign applied for
	
French flag	18/03/2015, R 1731/2013-1, LAPIN NA LA NOUVELLE AGRICULTURE (fig.)
The French flag is incorporated into the trade mark. Although it is small, it is immediately recognisable.	



Flag	Sign applied for
	
Emblem (Bavaria) protected under DE26	EUTM No 12 031 531; 26/02/2015, R 1166/2014-1, ALPENBAUER BAYERISCHE ONBONLUTSCHKULTUR (fig.)
The escutcheon with the white and blue diamonds contained in the sign applied for reproduces the heraldic symbol of the lesser Bavarian state coat of arms.	



Emblem	Sign applied for
 	
Protected under GB3 Protected under GB4	EUTM No. 5 627 245; 23/07/2009, R 1361/2008-1, SUSCIPERE ET FINIRE (fig.)
<p>The Board of Appeal of the EUIPO took into account the heraldic description of the protected emblems in order to consider whether there was a heraldic imitation.</p> <p>As regards the emblem protected under GB3, it concluded that since central elements such as the quartered shield and the supporters were largely identical, this was in this respect an imitation in the heraldic sense. The differences were not sufficient to give the EUTM application new meaning from a heraldic point of view. As regards the emblem protected under GB4, it concluded that the only difference between the supporters was the representation of the crowns, which would go unnoticed by the general public.</p>	

Flag	Sign applied for
	
Swiss flag	EUTM No. 9 273 137
In spite of a slight stylisation, the Swiss flag is immediately recognisable in the sign with the same structure and colours as the protected flag.	

- Heraldic imitation not found



Flag	Sign applied for
	
French flag	EUTM No. 4 624 987, 05/05/2011, T-41/10, esf école du ski français (fig.)
Although the colours are recognisable, the sign does not have the structure of the French flag.	



Flag	Sign applied for
	
Peruvian flag	EUTM No. 14 913 438
The dimensions of the stripes and also the overall shape of the figurative element are different from that of the Peruvian flag.	



Flag	Sign applied for
	
Flag of the United Kingdom	EUTM No. 15 008 253
The trademark is not a faithful representation of the UK flag in terms of colour/configuration. The high degree of stylisation takes it outside the scope of heraldic imitation.	



The fact that the design applied for contains only part of the protected “emblem” does not mean that there may not be an imitation from a heraldic point of view (21/04/2004, T-127/02, ECA, EU:T:2004:110, § 41). As regards the flag of the European Union, its essential element is the circle of twelve golden mullets (stars) (14/07/2011, R 1903/2010-1, A (fig.), § 17). However, to qualify as a heraldic imitation, it turned out not to be necessary for all the stars to be present in the EUTM applied for (13/03/2014, T-430/12, European Network Rapid Manufacturing, EU:T:2014:120). The exact orientation of the stars is irrelevant (15/01/2013, T-413/11, European Driveshaft Services, EU:T:2013:12). The same is true with respect to their colour (15/01/2013, T-413/11, European Driveshaft Services, EU:T:2013:12, § 43 for silver; 13/03/2014, T-430/12, European Network Rapid Manufacturing, EU:T:2014:120, § 48 for red; 14/07/2011, R 1903/2010-1 A (fig.), § 17 for blue).

- Main characteristics/part of the emblem incorporated in the sign applied for



Protected “emblem”	Sign applied for
	
Protected under QO188	EUTM application No 6 697 916; 01/03/2012, R 1211/2011-1, DIRO.net Lawyers for Europe (fig.); 13/03/2014, T-430/12, European Network Rapid Manufacturing
The EUTM applied for consists of a circle of 12 stars, of which three are covered. It contains the most important element of the European flag. The adjective ‘European’ reinforces the link already established by the circle of stars.	



Protected "emblem"	Sign applied for
	
Protected under QO188	EUTM No 6 373 849; 14/07/2011, R 1903/2010-1, A (fig.)
Since the EUTM contains an element that amounts to a heraldic imitation of the European emblem and the EUTM owner could not justify any authorisation, the registration must be declared invalid (para. 27).	



Protected "emblem"	Sign applied for
	
Protected under QO188	EUTM No 4 819 686; 21/03/2012, R 2285/2010-2, EUROPEAN MOO DUK KWAN TANG SOO DO FEDERATION
One element of the contested EUTM contains an imitation of all the heraldic elements of the European emblem (para. 48).	



Protected "emblem"	Sign applied for
	
Emblem (Bavaria) protected under DE24	EUTM No 12 031 531; 26/02/2015, R 1166/2014-1, ALPENBAUER BAYERISCHE ONBONLUTSCHKULTUR (fig.)
The escutcheon with the white and blue diamonds contained in the sign applied for reproduces the heart shield in the greater Bavarian state coat of arms.	

- Main characteristics/part of the protected emblem not incorporated in the sign applied for

Protected "emblem"	Sign applied for
	
Protected under IE11	EUTM application No 11 945 797; 01/04/2014, R139/2014-5, REPRESENTATION OF A CLOVERLEAF (fig.)
It must also be taken into consideration that the graphic element of the sign applied for has a colour configuration that is clearly different from the Irish national symbol. These elements are so strong that the mere fact that the sign applied for also contains a cloverleaf does not mean that the sign is similar to one of the national emblems of Ireland (paras 18-19).	

Protected "emblem"	Sign applied for
	
Protected under SE20	EUTM application No 13 580 981
The mark is not a heraldic imitation of the Swedish armorial bearing; it contains only one of the three crowns that are the main characteristic of the Swedish armorial bearing.	


Protected "emblem"	Sign applied for
	
Protected under CA2	EUTM application No 15 951 262
The mark is not a heraldic imitation of the Canadian state emblem.	









Protected "emblem"	Sign applied for
	
Protected under QO188	EUTM application No 15 889 157
The mark is not a heraldic imitation of the European emblem.	

- Black and white representations of the protected emblem



Flags are often reproduced in black and white; therefore, a black and white depiction of a protected emblem (or vice versa) may still be considered a heraldic imitation (21/04/2004, T-127/02, ECA, EU:T:2004:110, §45; 28/02/2008, T-215/06, RW feuille d'érable, EU:T:2008:55, §68).

Examples:

Flag	Sign applied for
	
Protected under QO188	21/04/2004, T-127/02, ECA



	
Protected under CA1	EUTM application No 2 793 495
	
Protected under CA2	C-202/08 P & C-208/08 P
	
Flag of the United Kingdom	Invented example
	
Protected under CH27	28/10/2014, R 1577/2014-4

However, if the black and white depiction does not allow recognition of a specific flag, there is no heraldic imitation.

Flag	Sign applied for
	
Various state flags	Invented example
It is not possible to recognise a specific flag, as the sign could be a black and white reproduction of any of the four flags reproduced above.	

Changes in colour

The use of silver v gold is important in heraldry. However, informed user will not necessarily recognise this difference in colour; indeed, they will not even give it any importance (15/01/2013, T-413/11, European Driveshaft Services, EU:T:2013:12, § 43). Slight differences in the actual colour are irrelevant (light blue v dark blue). Heraldry does not normally distinguish between different tones of the same colour (15/01/2013, T-413/11, European Driveshaft Services, EU:T:2013:12, § 42). Furthermore, gold is often reproduced as yellow (20/05/2009, R 1041/2008-1, kultur IN DEUTSCHLAND + EUROPA (fig.), § 33); consequently, this difference has no impact on the assessment.

Protected Emblem	Sign applied for
	
Protected under QO188	EUTM No 2 180 800; 15/01/2013, T-413/11, European Driveshaft Services
General Court of the European Union maintained that even as regards professionals the possibility of making a connection between the sign represented above and the organisation concerned is not excluded.	

Other protected symbols

The following signs (not covered by Article 6ter of Paris Convention) enjoy special protection under Article 10(e) of the **Law**.

- Money signs like euro sign, dollar sign or lari sign





- The symbols protected under the Geneva Conventions and their additional protocols, that is to say, the red cross, the red crescent and the red crystal emblems and their names (<https://www.icrc.org/en/war-and-law/emblem>);




However, a number of well-known red crosses have traditionally been used and are still in use, the incorporation of which in a design would not be considered a reproduction/ heraldic imitation of the “Red Cross”.

Examples of these crosses include the following:

'Templar cross'	
'Maltese cross'	



- The Olympic Symbol protected under the Nairobi Treaty (Georgia is not party to this treaty) on the Protection of the Olympic Symbol (http://www.wipo.int/treaties/en/text.jsp?file_id=287432)



The five interlaced rings in blue, yellow, black, green and red, arranged in that order from left to right. The symbol consists of the Olympic rings alone, whether in a single colour or in different colours, as set out in the Nairobi Treaty on the Protection of the Olympic Symbol.	
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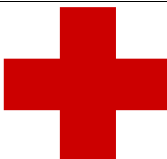

The same rules as set out above concerning the heraldic imitation and authorisations also apply with respect to money signs imitation.

Examples

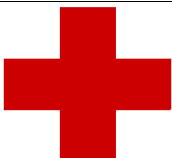

- Reproduction/heraldic imitation found

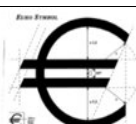

Symbol	Sign applied for
	
	EUTM application No 6 110 423, 10/07/2013, T-3/12.
The EUTM contains an imitation of the euro symbol in a central position. A link will be established with the European Union. The other elements reinforce the link between the EUTM and the euro sign (para. 109 et seq).	

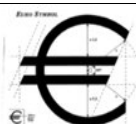

Symbol	Sign applied for
	
	EUTM application No 2 966 265, applied for in respect of goods and services in Classes 9, 38, 42 and 44.
Trade mark cancelled by decision of 13/05/2008, 2 192 C. The EUTM clearly contains the emblem of the Red Cross on a white background, as defined by and protected by the Geneva Convention, as a discernible, individual portion of the mark (para. 23).	

Symbol	Sign applied for
	
	EUTM application No 5 988 985, applied for in respect of goods in Classes 28 and 30.
The trade mark contains the representation of the Red Cross, protected by the Geneva Convention.	

- Reproduction/heraldic imitation not found

Symbol	Sign applied for
	
	28/06/2007, R 315/2006-1, D&W REPAIR (fig.), applied for in respect of goods in Classes 8, 11 and 12.
<p>In the present case, the Red Cross cannot be said to be included in the contested EUTM because of the difference in colour. The Red Cross, as its denomination indicates, is red and the colour constitutes a very essential element of its protection. The cancellation applicant's argument that the colour orange may be very similar to some shades of red cannot be accepted (para. 20).</p> <p>Additionally, the cross of the contested EUTM contains the wording 'REPAIR' which, coupled with the goods concerned (tools, car spare parts and accessories in Classes 8, 11 and 12), is likely to be associated with car and motorcycle repairs. This association makes the orange cross of the contested EUTM even more distinct from the Red Cross emblem protected by the Geneva Convention (para. 21).</p>	

Symbol	Sign applied for
	
	EUTM application No 10 868 985, applied for in respect of goods and services in Classes 12, 35, 38, 39 and 42 (car rental related).
No link will be made with the European Union; the symbol rather refers to the 'good price' of the goods and services concerned.	

Symbol	Sign applied for
	
	EUTM application No 11 076 866, applied for in respect of goods and services in Classes 9, 35, 36, 37 and 42 (e.g. electricity measuring devices, services related to building and construction).
No link will be made with the European Union; the symbol will be perceived as a stylised letter E.	

Exceptions

The design applied for can be registered despite restriction provided by Articles 10(e) and 10(f) of the **Law**, if the applicant provides Sakpatenti with the authorisation to include the protected emblem or parts of it in its design. The authorisation must cover registration as a design or as a part thereof. Authorisation to use the protected emblem is not sufficient.

10.4.1.5 Use of geographical indication or appellation of origin

Design will be refused if a protected geographical indication or appellation of origin (hereafter together referred as GI) is used in a subsequent design. Terms "protected geographical indication" and "protected appellation of origin" covers both local and foreign GIs being protected in Georgia either through registration or by international agreement.

The notion of "use in a subsequent design" does not necessarily presuppose a full and detailed reproduction of the earlier GI in a subsequent design. Even though the design may lack certain features of the earlier GI or may have different additional features, this may constitute "use" of that sign, particularly where the features omitted or added are of

secondary importance and are unlikely to be noticed by the relevant public. It is enough that the design and the earlier GI be similar.

Where a design includes a GI without any disclaimer making clear that protection is not sought in respect of such feature, it will be considered that the design makes use of the earlier GI even if the latter is represented in only one of the views.

Where the design is intended to be incorporated in two-dimensional “logos”, examination will consider that such logos may be applied to an infinite range of products and services, including the products in respect of which the earlier GI is protected.

11. Publication

Once substantive examination is completed and decision on registration is issued, within one month from this date Sakpatenti shall publish bibliographic data of the application and representation(s) of the design(s) in the Official Bulletin of Industrial Property which is published twice a month in paper and electronic format. Electronic copy of the bulletin is published on Sakpatenti's website.

Sakpatenti will publish bibliographic data of the application and representation(s) of the design(s) in case where respective fees had been fully paid by the applicant within one month from receipt of substantive examination's decision.

If several designs contained in the application and paid fees is not sufficient for publication of all of them, deficiency will be raised by Sakpatenti inviting the applicant to remedy deficiency within 1 month from its receipt by:

- Paying of the fees in full or
- Sending confirmation to Sakpatenti as to which design(s) has to be published within paid amount of fees.

If the applicant does not respond to Sakpatenti's request within 1 month of receipt the communication, Sakpatenti will publish only the number of designs which corresponds the fees actually paid by the applicant taking into account consecutive numbering of designs.

The design being refused by Sakpatenti is not subject to publication. If as a result of the appeal, Sakpatenti's refusal of the design is reversed by the final decision of the court being entered into legal force, Sakpatenti shall make publication according to rules described above.

Sakpatenti shall not publish designer's name if the latter requests so (Article 19(3) of the **Law**).

12. Deferment of publication

The applicant for a design may, when filing the application, request that its publication be deferred for no more than 30 months from the date of filing or, if a priority is claimed, from the date of priority (Article 18(1)(a) of the **Law** and Article 19 of the **Instruction**).

Where Sakpatenti issues favourable decision on registration of the design, the information published in the Official Bulletin of Industrial Property consists of name of the applicant, date of filing, the application number and expiration of deferment period with indication of deferment of publication.

No other particulars, such as the representation of the design or the indication of products, are published.

12.1 Request for deferment

Deferment of publication may be requested in the application or at any time subsequently, but before Sakpatenti issues decision of substantive examination on registration of the design.

The time period of deferment will be calculated either from the filing date of the design or from the date of priority, if it has been claimed. Moreover, the time limits applicable to deferment may differ for each of the designs of a multiple application if different priority dates are claimed for each individual design. A request for deferment of publication may concern only some of the designs of a multiple application. In this case, the designs to be deferred must be clearly identified in the application.

Where the applicant requires deferment of publication for only some of the designs of a multiple application, only the designs for which deferment has not been requested are published in full.

Applicant must pay corresponding fee within 1 month of filing deferment request or such request will not be considered.

12.2 Request for publication

After the deferment period has expired and provided that the decision to register the design is favorable, Sakpatenti shall publish it according to general rules. Publication fee must be paid no later than 1 month after receipt of favourable decision by the applicant.

In cases where a representation of the design has been replaced by a specimen in accordance with Article 8(1) of the **Instruction**, at the latest 3 months before deferment period expires the applicant must file a representation of the design in accordance with Article 19(8) of the **Instruction**. If applicant does not comply with these rules, Sakpatenti will cease the prosecution of the application.

No later than 3 months before expiration of deferment period, the applicant may notify Sakpatenti about cancellation of deferment and request publication (Article 19(7) of the **Instruction**).

If the applicant, despite a previous request for publication, decides that the design should not be published after all, he may submit a written request for surrender before the design is published.

13. Corrections to the application

13.1 Corrections by the applicant

13.1.1 Elements subject to correction

The following elements of the design application may be corrected at the applicant's written request and subject to conditions set by the Article 20 of the **Instruction**:

- Representation of the design;

- Indication of the product and their classification;
- Description of the design;
- Name and address of the applicant;
- Name and address of the designer;
- Name and address of the representative;
- Mechanical error.

Representation and description of the design, as well as indication of the product, may be corrected free of charge, but only before accomplishment of formal examination and with condition that correction of representation of the design or indication of the product will not result in change of the design's scope of protection.

Corrections concerning name and address of the applicant, designer and representative may be conducted during prosecution as well as after registration. Corrections requested before accomplishment of formal examination will be performed by Sakpatenti free of charge, after formal examination stage – only after the payment of the respective fee.

Mechanical error may be corrected any time and free of charge before or after registration of the design.

13.1.2 Elements that cannot be corrected

The **Instruction** does not provide possibility to correct the following elements of the design application:

- Country, date and number of the prior application where Convention priority is claimed;
- Name, place and date of the first exhibition of the design, where exhibition priority is claimed.

Where a request for correction amends above listed elements or representation, indication and description of the design after accomplishment of formal examination, the applicant will be informed that his request is not acceptable. Then applicant must decide whether he wishes to continue the registration process or to file a new application for which he will have to pay the applicable fees.

13.2 Request of corrections by Sakpatenti

Sakpatenti, at any stage of the examination, is authorized to request from the applicant additional materials, entering amendments and/or corrections to the application only in case where it is impossible to further process the application without such action (Article 21(1) of the **Instruction**).

Where applicant complies with Sakpatenti's request to provide additional materials and/or enter amendments / corrections to the application within one month from the date of receipt of the respective notification, he will not be charged any fee. If the applicant needs to extend one-month period mentioned above, he has right to request extension twice, for no more than for two months in total and with payment of the respective fee. If applicant fails to comply with Sakpatenti's request, the latter will cease prosecution of the application.

Additional materials and/or amendments / corrections to the application provided by the applicant, must not affect scope of protection of the design.

14. Suspension

Before accomplishment of substantive examination and issuing refusal or favourable decision on registration of the design (in latter case no later than the publication of the design) by the Sakpatenti, applicant has right to request suspension of prosecution of the application for one-month period, in total for no more than six months, in case where he has paid respective fee.

The applicant may not use the right of suspension to prolong:

- Term for submission of materials requested by the Sakpatenti and being necessary for allocation of filing date;
- Term for payment of fees to Sakpatenti.

15. Reinstatement

Within six-month from Sakpatenti's decision to cease prosecution of the application because of the violation of the time-limits set by the **Law** and **Instruction**, the applicant has right to request reinstatement of the application. Along with filing of application on reinstatement the applicant shall comply with Sakpatenti's request and cure violation which caused ceasing of prosecution and pay respective fee (Article 23 of the **Instruction**).

If decision to cease prosecution of the application was taken due to non-payment of fees, applicant shall pay such fees along with reinstatement fee (Article 29 of the **Instruction**).

Sakpatenti shall make decision on reinstatement within one month from the receipt of the respective application.

16. Withdrawal

Prior to publication of the design applicant may at any time withdraw an application (Article 24 of the **Instruction**) or, in the case of a multiple application, withdraw some of the designs contained in the multiple application. In case of withdrawal applicant will not have right to request its reinstatement.

Request to withdraw the application (design(s) in case of multiple application) shall result in ceasing of the prosecution by Sakpatenti.

The "date of withdrawal" is the date on which Sakpatenti issues order on ceasing of the prosecution.

Request for withdrawal must be submitted in writing and include:

- application number or, where the request for withdrawal is submitted before an application number has been allocated, identification number of the application or any information enabling the application to be identified;
- in the case of a multiple application, an indication which design(s) the applicant wants to withdraw if not all are to be withdrawn; and
- the name and address of the applicant and, if applicable, the name and address of the representative.

17. Attested copy of the application

After allocation of the filing date by Sakpatenti, the applicant has the right to request attested copy of the application subject to payment of corresponding fee within 1 month of such request. Sakpatenti shall provide attested copy of the application within 10 working days from the payment of corresponding fee by the applicant. Per request of the applicant attested copy of the application may be provided by Sakpatenti through WIPO Digital Access Service (WIPO DAS) (Article 25 of the **Instruction**).

18. International Registration

18.1 General overview of the Hague System

18.1.1 The Hague Agreement and the Geneva Act

The Hague Agreement is an international registration system that makes it possible to obtain protection for designs in a number of states and/or intergovernmental organisations, such as the European Union or the African Intellectual Property Organization, by means of a single international application filed with the International Bureau. Under the Hague Agreement, a single international application replaces a whole series of applications that, otherwise, would have had to be individually filed with different national intellectual property offices or intergovernmental organisations.

The Hague Agreement consists of two separate international treaties: the Hague Act (1960) and the Geneva Act (1999). Each Act has a different set of legal provisions, which are independent of one another. Georgia is a party to both Acts.

18.1.2 Procedure for filing international applications

18.1.2.1 Particularities

A difference from the Madrid System of international registration of trademarks is that the Geneva Act of the Hague Agreement neither allows nor requires an international registration to be based on a previously filed national design.

Sakpatenti can be both: a “designated office” and “office of origin”. International applications may therefore be filed directly with the International Bureau or through Sakpatenti. Procedural issues related to the filing of international application through Sakpatenti is regulated in detail by the article 26¹ of the **Instruction**.

Unlike the Madrid “Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks”, neither the Geneva Act nor the **Law** provides for procedures for converting or transforming an international registration into national designs or into designations of Member States party to the Hague System, or for replacing national designs by an international registration designating the contracting party in question.

18.1.3 Examination carried out by the International Bureau

When it receives an international application, the International Bureau checks that it complies with the prescribed formal requirements, such as those relating to the quality of the reproductions of the design(s) and the payment of the required fees. The applicant is informed of any deficiency, which must be corrected within the prescribed time limit of 3 months, failing which the international application is considered to be abandoned.

Where an international application complies with the prescribed formal requirements, the International Bureau records it in the International Register and (unless deferment of publication has been requested) publishes the corresponding registration in the International Designs Bulletin. Publication takes place electronically on the website of the World Intellectual Property Organization (WIPO) and contains all relevant data concerning the international registration, including a reproduction of the design(s).

The International Bureau notifies the international registration to all designated offices, which then have the option of refusing protection on substantive grounds.

18.2 The role of Sakpatenti as designated office

This section is based on Article 25 of the **Law** and Article 26 of the **Instruction** and explains how international registrations are dealt with by Sakpatenti from notification by the International Bureau through to the final decision to grant or refuse the protection to the design being filed through Hague System.

The main steps before Sakpatenti as designated office are:

- Receipt of the international registration designating Georgia;
- Conducting substantive examination.

It is important to note that priority may be claimed at the time of the international application only. The examination of the priority claim for international designs is carried out by the International Bureau. Sakpatenti does not examine priority or request supporting documents for international designs. Any document received by Sakpatenti will be archived with no effect on the grant of protection, but may be relied upon in *inter partes* proceedings.

18.2.1 Receipt of the international registration designating Georgia

Communications between Sakpatenti and the International Bureau are by electronic means.

18.2.2 Substantive examination

Once the international registration designating Georgia has been notified to Sakpatenti by the International Bureau, the rules laid down by the Articles 10, 12, 17, 19, 20 and 25 of the **Law** and article 26 of the **Instruction** apply. Coming out from the mentioned, international application:

- Is subject to the substantive examination on regular basis (see paragraph 10.4 above);
- May be presented as single, multiple or joint application;
- Is subject to local publication by the Sakpatenti in the Official Bulletin of Industrial Property;
- May be subject of appeal or opposition at Chamber of Appeals of Sakpatenti;
- May be subject of legal action before the court.

18.2.2.1 Time limits

Sakpatenti shall conduct substantive examination within 3 months of publication of the international registration in the International Designs Bulletin (Article 26(1) of the **Instruction**).

Where Sakpatenti takes favourable decision on granting protection to the international design, it must publish particulars of the application and representation of the design within one month and inform International Bureau within three months of such decision (Articles 26(3) and 26(4) of the **Instruction**).

Sakpatenti must inform the International Bureau of refusal of protection within 6 months of publication of the international registration in the International Designs Bulletin (Article 26(2) of the **Instruction**).

A preliminary refusal shall be issued in accordance with requirements of the **Law** and the holder of the international registration will be given an equal opportunity to appeal it (Article 20 of the **Law**) within 3 months from the date of publication of refusal in the International Designs Bulletin.

Thus, within 3 months of the date of publication of refusal in the International Designs Bulletin, applicant will be given the opportunity to renounce the international registration for Georgia (for all the designs in the registration), to limit the international registration to one or some of the designs for Georgia or to submit appeal against decision of the examination.

The International Bureau, along with publication, will forward the notification of provisional refusal to the holder (or to its representative before WIPO if applicable). The holder or his representative must reply directly to Sakpatenti.

18.2.2.2 Renunciation and limitation

Where the holder renounces the entire international registration in Georgia or limits it to one or some of the designs for Georgia, he must inform the International Bureau by way of recording procedure in accordance with Article 16(1)(iv) and (v) of the Geneva Act. The holder can inform Sakpatenti by submitting a corresponding statement.

18.2.2.3 Grant of protection

Where Sakpatenti finds no grounds for refusing international design or where a preliminary refusal is withdrawn, Sakpatenti must publish information on granting protection in the Official Bulletin of Industrial Property and inform the International Bureau accordingly within one month period.

18.2.2.4 Refusal

Where after receipt of refusal, the applicant does not renounce the international registration for Georgia, does not limit it to one or some of the designs, does not submit appeal (that would be satisfied by Chamber of Appeals of Sakpatenti) within the specified time limit and does not appeal at the court decision of the Chamber of Appeals to keep in force refusal of examination, or does not withdraw the application, Sakpatenti will confirm its decision refusing protection for the international registration. If the refusal concerns only some of the designs contained in a multiple international registration, Sakpatenti will refuse the latter only insofar as those designs are concerned.

The applicant of the international registration has the same remedies available to it as it would have had if it had filed the design(s) in question directly with Sakpatenti. The ensuing procedure takes place solely at Sakpatenti level. An appeal against a decision to refuse protection must be submitted by the holder to the Chamber Appeals within the time limit and in accordance with the conditions set out in Article 20 of the **Law**. The International Bureau is not involved in this procedure at all.

Once the decision to refuse or accept the international registration is final, a final notification will be sent to the International Bureau, indicating whether the design(s) has been finally refused or accepted.

Where the final refusal relates to only some of the designs contained in a multiple application, the notification to the International Bureau will indicate which designs have been refused and which have been accepted.

18.3 Effects of international registration

If no refusal is notified by Sakpatenti within 6 months of the publication of the international registration on the WIPO website or if a notice of preliminary refusal is withdrawn, the international registration will, from the date of registration granted by the International Bureau, as referred to in Article 10(2) Geneva Act, have the same effect as if it had been applied for with, and registered by, Sakpatenti.

International registration can be subject to opposition / invalidity proceedings under the same conditions and procedural rules as national filings granted favourable decision / resulted in registration.

Where the court declares the effects of an international registration invalid in the territory of Georgia and respective decision will be received by Sakpatenti, it must publish this information in the Official Bulletin of Industrial Property and inform the International Bureau of court's decision.

The particularities of the procedures governing the renewal of international registrations and records of changes of name / address, transfers, renunciation or limitation of certain designs, registration for any or all of the designated contracting parties, or limitation of the registration to certain designs are dealt with by the International Bureau of WIPO.

19. Registration and issue of certificate

Sakpatenti shall start registration formalities of the design where:

- Favorable decision on registration of the design was made by examination, design was published, three-month opposition period expired and no objection was filed at the Chamber of Appeals or court;
- Within three-month period opposition was filed but Chamber of Appeals dismissed it, this decision of Chamber of Appeals was not appealed in the court and thus entered into force;
- Within three-month period objection was filed at the court which dismissed it.

Sakpatenti shall initiate registration formalities also in situation:

- (a) when initially examination refused to register design, decision was appealed to the Chamber of Appeals or court by the applicant and subsequently reversed or
- (b) when refusal of examination was confirmed by the Chamber of Appeals, but court with its final ruling reversed both decisions of examination and Chamber of Appeals and granted protection to the design.

Sakpatenti starts registration formalities by sending invitation to the applicant to pay registration fee. Such invitation should be sent out within one month from:

- Expiration of the opposition period;
- Entering into force decision of Chamber of Appeals;

- Receipt of the final decision of the court by Sakpatenti.

Along with registration fee applicant is required to pay fee for the maintenance in the force of the design for the first five-year period. These fees should be paid within one month of receipt the invitation by the applicant. Non-compliance with this time limit shall result in taking by Sakpatenti decision on ceasing prosecution of the application.

If application contains multiple designs and fees paid by the applicant is not sufficient to be applied for all of them, the applicant will be requested to pay fees in full to cover all designs or indicate those designs that should be registered within paid amount of fees. Applicant must respond to Sakpatenti's request within 1 month from the date of its receipt (Article 27(4) of the **Instruction**).

Where the applicant does not comply with such request in due time, Sakpatenti will register only the number of designs which corresponds the fees actually paid by the applicant taking into account consecutive numbering of designs (Article 27(5) of the **Instruction**).

Sakpatenti also publishes data concerning the design(s) which has been published but have not been registered.

Within one month of registration date Sakpatenti issues registration certificate which shall be reflected in the electronic system. In case of paper filing of the application, registration certificate shall be issued in the paper format, but in case of electronic filing registration certificate in paper format shall be issued within 5 business days only in case of the applicant's request.

However, Sakpatenti does not issue registration certificate for international registration designating Georgia.

The certificate contains all the particulars entered in the designs register at the date of registration. No new certificate is issued following changes made in the register after the date of registration. However, an extract from the register, which reflects the current administrative status of the design, may be requested.

20. Accelerated Procedure of Registration

According to Article 22 of the **Law** and the **Instruction**, the design may be registered through accelerated procedure.

The applicant may request Sakpatenti to process application through accelerated procedure by making indication in the application (by ticking respective box) or within one month after filing date by submitting written request.

Subject to payment of required fees, Sakpatenti shall allocate filing date and conduct formal examination within 3 working days.

For smooth accomplishment of formal examination through accelerated procedure, the applicant shall submit application and supplementary documents according to paragraphs 10.2 and 10.3 above and where applicant claims priority, respective documents confirming validity of such claim (see paragraph 9 above). If application and supplementary documents do not comply with these requirements, Sakpatenti will raise deficiency which shall be remedied by the applicant within 15 working days of its receipt. If the applicant does not comply with Sakpatenti's request, application will be processed through regular procedure and 50% of fees for accelerated procedure be refunded to the applicant.

Substantive examination shall be carried out within 7 business days. Where substantive examination results in favourable decision on registration of the design within 1 month of such decision, subject to payment of respective fees, Sakpatenti shall:

- Register design;
- Publish particulars of the design;
- Issue registration certificate.

Registration of the design through accelerated procedure shall be annulled by Sakpatenti if after accomplishment of registration process another application for identical design but with earlier priority is filed (Article 22(8) of the **Law**). This rule shall be applicable in both cases: where design contained in application with earlier priority was made available before or after filing of accelerated application. In such case fees paid by the owner of annulled design shall not be refunded.

In case where applicant applies for registration through accelerated procedure, deferment of publication may not be requested.

2 1 . Procedures of Appeal and Opposition at the Chamber of Appeals of Sakpatenti

21.1 General Principles applying to the proceedings before the Chamber of Appeals

Chamber of Appeals of Sakpatenti is authorised to consider appeals of the applicant and oppositions of third parties concerning decision of the examination.

Refusal of Sakpatenti's substantive examination may be appealed before the Chamber of Appeals within three months after the date of receipt of the refusal by the applicant or his representative. In case of International registration, refusal may be appealed within three months from its publication in Official Gazette of WIPO.

Favourable decision of Sakpatenti's substantive examination may be appealed before the Chamber of Appeals within three months of its publication date in Official Bulletin of Industrial Property.

The Chamber of Appeals shall consider appeal/opposition within three months of its filing date.

The decisions of the Chamber of Appeals must state the reasons on which they are based. The reasoning must be logical, and it must not disclose internal inconsistencies.

If an appeal/opposition is based on the grounds that are examined during substantive examination, such grounds are subject of revision by the Chamber of Appeals according to the principles and practice set out in paragraph 10.4 above.

The decision of the Chamber of Appeals will be based only on reasons or evidence(s) on which the parties concerned have had an opportunity to present their comments (for more details please consult paragraphs 1.2.1 and 1.2.2).

The decision made by the Chamber of Appeals is based on the facts, evidences and arguments provided by the parties. This does not preclude the Chamber of Appeals from

taking into consideration well-known facts (16/02/2017, T-828/14 & T-829/14, Radiatori per riscaldamento, EU:T:2017:87, § 90; the Guidelines, Part A, General Rules, Section 2, General Principles to be Respected in the Proceedings, paragraph 1, Adequate Reasoning). Moreover, the Chamber of Appeals shall investigate all important circumstances of the case during the proceedings and deliver the decision on the basis of their evaluating. The decision of the Chamber of Appeals shall not be based on the circumstances or facts not investigated by the chamber in the manner set out in the **Law**, **Code**, **Statute** and present guidelines.

The Chamber of Appeals must weigh the facts, evidence and arguments, adjudicate on their conclusiveness, and thereafter draw legal inferences from them without being bound by the points of agreement between the parties. Alleged facts that are not supported by evidence are not taken into account (16/02/2018, R 459/2016-G, Dishes, § 26).

Fact, **evidence** and **argument** are three different items not to be confused with each other. For instance, the date of disclosure of an earlier design is a **fact**. **Evidence** of that **fact** could be the date of publication of a catalogue showing the earlier design together with evidence proving that the catalogue had been made available to the public before the date of filing or the priority date of the contested design. The applicant's **argument** could be that the earlier design forms an obstacle to the individual character of the contested design given the similar overall impression it produces on the informed user. Whether a contested design lacks individual character or not is not a fact but a legal question to be decided by the Chamber of Appeals on the basis of the **facts**, **evidence** and **arguments** submitted by the parties.

Expert reports or expert opinions and other statements in writing fall within the means of evidence. However, the fact that they are procedurally admissible does not automatically mean that the statement is credible and will serve as proof of the facts to be proven. Rather, such statements must be critically examined as to the accuracy and correctness of the information, as well as whether they come from an independent source and/or are fettered or supported by written information (09/03/2012, T-450/08, Phials, EU:T:2012:117, § 26).

If applicant appeals refusal of examination of Sakpatenti (Article 20(1) of the **Law**) principles stated in present guidelines regarding opposition filed by third party shall apply mutatis mutandis.

21.2 Filing and scope of appeal / opposition

Sakpatenti recommends filing an appeal/opposition by e-filing system accessible through its website. However, it is possible to submit appeal/opposition directly on paper.

Appeal/opposition shall be filed only based on the grounds as indicated in Article 20 of the **Law** and shall comply with requirement set out in the **Statute**.

According to Article 20(1) of the **Law**, applicant may file an appeal at the Chamber of Appeals against a decision of Sakpatenti on formal requirements, or termination of the application proceedings, as well as a decision of the substantive examination on refusal of the design registration.

According to Articles 20(2) and 20(3) of the **Law** third party may file an opposition before the Chamber of Appeals against decision of the substantive examination if:

- The decision on registration of design violates requirements of Article 17 of the **Law**;
- The design lacks novelty and/or individual character;

- The design wholly or by any constituent element coincides with a trademark with earlier priority registered in Georgia, except for the case when the design registration is requested by the holder of the exclusive right in this trademark (Articles 20(3)(b) of the **Law**);
- The design wholly or by any constituent element coincides with a mark recognised as a well-known mark according to Article 3(4) of the Trademark Law of Georgia (Articles 20(3)(b) of the **Law**);
- The design wholly or by any constituent element coincides with the emblem of an international or intergovernmental organisation, its full or abbreviated name, official controlling, guarantee, sampling seal, stamp, order, medal, historic name, armorial bearings, flag, emblem, money sign of Georgia or its territorial unit, or represents an imitation of a symbol indicated in this sub-paragraph (Articles 20(3)(b) of the **Law**);
- The design or its constituent element displays an appellation of origin or geographical indication which has been granted protection on the territory of Georgia based on the local registration, a bilateral or international treaty (Articles 10(g) and 17(1) of the **Law**).

The appeal/opposition must include an indication of the grounds on which it is based.

The appeal/opposition must indicate the facts, evidences and arguments in support of the ground(s) on which the appeal/opposition is based. Each ground must be supported by its own set of facts, evidences and arguments.

22. Grounds for opposition / invalidation

Present paragraph covers the grounds for opposition and invalidation of registered design that are not examined during substantive examination of the design application.

As mentioned above, if an opposition against decision of substantive examination is based on the grounds that are examined during substantive examination, the Chamber of Appeals will take into account principles and practice set out in paragraph 10.4 of the present guidelines.

22.1 Lack of novelty and individual character

22.1.1 Disclosure of earlier design

22.1.1.1 General principles

Challenging the validity of a design on account of its lack of novelty or of individual character requires proof that an earlier design that is identical or that produces a similar overall impression has been made available to the public before the date of filing of the application for registration or, if a priority is claimed, the date of priority (Articles 3(5) and 3(8) of the **Law**).

The required disclosure of the earlier design is preliminary to deciding whether the two designs are identical or produce the same overall impression on the informed user. If the earlier design has not been disclosed, then the opposition is rejected to the extent that it is based on Articles 20(2) and 20(3) of the **Law**.

Where the quality of the representation of the earlier design does not enable a comparison with the contested design, this does not amount to a disclosure for the purpose of Article 6(1) of the **Law** (10/03/2008, R 586/2007-3, Barbecues, § 22 et seq.).

For the purpose of Article 6(1) of the **Law**, it is immaterial whether or not an earlier “design” within the meaning of Article 3(1) of the **Law** enjoys or enjoyed legal protection (as a design, trade mark, copyright work, patent, utility model or otherwise) (21/05/2015, T-22/13 & T-23/13, UMBRELLAS, EU:T:2015:310, § 24).

Under Article 6(1) of the **Law**, the appellant relying on an earlier design has to prove the event of disclosure, for instance in publications, at exhibitions, in trade or on the internet (see paragraphs 22.1.1.3-22.1.1.5 below). Such proof will allow Chamber of Appeals to prima facie deem the design to have been made available. The applicant of the contested design can refute this presumption by way of establishing, to the requisite legal standard, that the circumstances of the case could reasonably prevent those events from becoming known in the normal course of business to the circles specialised in the sector concerned (15/10/2015, T-251/14, Doors (parts of), EU:T:2015:780, § 26; 21/05/2015, T-22/13 & T-23/13, UMBRELLAS, EU:T:2015:310, § 26; 14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 47).

The presumption set out in Article 6(1) of the **Law** applies irrespective of where the events of disclosure took place. It is therefore not necessary that they take place in Georgia. At the same time, according to Article 6(2)(a) of the **Law**, design does not deem to be made available if it could not reasonably have become known to circles specialised in the sector concerned in Georgia. The question whether events of disclosure outside Georgia could reasonably have become known to persons forming part of those circles in Georgia is a question of fact and may be disputed by the person challenging fact of disclosure. The answer to that question has to be assessed by the Chamber of Appeals on the basis of the particular circumstances of each individual case (13/02/2014, C-479/12, Gartenmöbel, EU:C:2014:75, § 34; 14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 55).

In the context of Article 6(1) of the **Law**, what matters is whether the “circles specialised in the sector concerned” have had an opportunity to have access to the design irrespective of the number that actually seized this opportunity and might have encountered the disclosed design. There is thus no quantitative threshold with regard to actual knowledge of the disclosure events (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 73).

It must be examined whether, on the basis of the facts to be adduced by the party challenging the disclosure, it is appropriate to consider that it was not actually possible for those circles to be aware of the events constituting disclosure, whilst bearing in mind what can reasonably be required of those circles in terms of being aware of prior art. Those facts may concern, for example, the composition of the specialised circles, their qualifications, customs and behavior, the scope of their activities, their presence at events where designs are presented, the characteristics of the design at issue, such as its interdependency with other products or sectors, and the characteristics of the products into which the design at issue has been integrated, including the degree of technicality of the products concerned. In any event, a design cannot be deemed to be known in the normal course of business if the circles specialised in the sector concerned can become aware of it only by chance (14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 56).

The term “circles specialised in the sector concerned” within the meaning of Article 6(1) of the **Law** is not limited to persons involved in creating designs and developing or manufacturing products based on those designs within the sector concerned. Article 6(1) of the **Law** lays down no restrictions relating to the nature of the activity of natural or legal persons who may be considered to form part of the “circles specialised in the sector

concerned”. Consequently, traders may also form part of the “specialised circles” within the meaning of this article (see, by analogy, 13/02/2014, C-479/12, Gartenmöbel, EU:C:2014:75, § 27).

22.1.1.2 Establishing the event of disclosure

Neither the **Law** nor the **Instruction** provides for any specific form of evidence required for establishing the event of disclosure. Nor are there any provisions as to any compulsory form of evidence that must be submitted to competent authority. Accordingly, the evidence in support of the event of disclosure is a matter for the discretion of the appellant and, in principle, any evidence capable of proving the event can be accepted.

The Chamber of Appeals will carry out an overall assessment of such evidence by taking into account of all the relevant factors in the particular case. An event of disclosure cannot be proven by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient disclosure of the earlier design (09/03/2012, T-450/08, Phials, EU:T:2012:117, § 21-24). However, Chamber of Appeals shall not request appellant to submit evidence proving actual access or encounter of the design by the “circles specialised in the sector concerned”. Evidence proving reasonable opportunity to access the design by “circles specialised in the sector concerned” shall be sufficient for determining disclosure of the design for the purposes of article 6(1) of the **Law**.

A global examination of the items of evidence relating to the same earlier design implies that these items must be assessed in the light of each other. Even if some items of evidence are not conclusive of an event of disclosure in themselves, they may contribute to establishing the event of disclosure when examined in combination with other items (09/03/2012, T-450/08, Phials, EU:T:2012:117, § 25, 30-45; 27/02/2018, T-166/15, Sacs pour ordinateurs portables, EU:T:2018:100, § 24; 14/03/2018, T-651/16, Footwear, EU:T:2018:137, § 52; 17/05/2018, T-760/16, Fahrradkörbe, EU:T:2018:277, § 42, 45 and 50).

The Chamber of Appeals is not required to determine through assumptions and deductions which earlier designs among those represented in the appellant’s documentary evidence may be relevant where the applicant does not provide further specifications in this respect.

As regards “statements in writing, sworn or affirmed”, affidavits in themselves, as a matter of principle, are not sufficient to prove a fact such as the event of disclosure of an earlier design. They may, however, corroborate and/or clarify the accuracy of additional documents (18/11/2015, T-813/14, Cases for portable computers, EU:T:2015:868, § 29).

In order to assess the evidential value of an affidavit, regard should be had first and foremost to the credibility of the account it contains. It is then necessary to take account, in particular, of the person from whom the document originates, the circumstances in which it came into being, the person to whom it was addressed and whether, on the face of it, the document appears sound and reliable (09/03/2012, T-450/08, Phials, EU:T:2012:11739-40).

22.1.1.3 Official publications

Publication of an earlier design in the bulletin of any intellectual property office worldwide constitutes an event of disclosure (27/10/2009, R 1267/2008-3, MONTRES, § 35 et seq; 07/07/2008, R 1516/2007-3, BIDONS, § 9). The same applies where the publication concerns the appearance of a product in relation with any other kind of intellectual property right.

However, a document kept by any IP Office (Patent Office), which is either available to the public as public information or is available to the party through court proceedings, may not be considered to have become known in the normal course of business to the specialised circles in the sector concerned and therefore does not give rise to a disclosure of an earlier design within the meaning of Article 6 of the **Law** (22/03/2012, R 1482/2009-3, INSULATION BLOCKS, § 39-43; 15/04/2013, R 442/2011-3, Skirting boards, § 26).

In order to prove the event of disclosure, the evidence must specify the date of publication independently of the date of filing or the date of registration (15/04/2013, R 442/2011-3, Skirting boards, § 24).

22.1.1.4 Exhibitions and use in trade

Exhibiting a design at a trade fair exhibition anywhere in the world is an event of disclosure (26/03/2010, R 9/2008-3, FOOTWEAR, § 73-82; 01/06/2012, R 1622/2010-3, Lámparas, § 24).

Use in trade is another example given in Article 6(1) of the **Law** as a means of disclosing a design, irrespective of whether this use is made within or outside Georgia (26/03/2010, R 9/2008-3, FOOTWEAR, § 63-71).

Disclosure of a design can be the result of use in trade even where there is no proof that the products in which the earlier design is incorporated have actually been produced or put on the market (21/05/2015, T-22/13 & T-23/13, UMBRELLAS, EU:T:2015:310, § 36). It can be sufficient that the products have been offered for sale in catalogues distributed (22/10/2007, R 1401/2006-3, ORNAMENTACIÓN, § 25) or imported from other countries (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 31-32) or have been the object of an act of purchase between two Georgian operators (09/03/2012, T-450/08, Phials, EU:T:2012:117, § 30-45).

As regards the submission of catalogues, their evidential value does not necessarily depend on their being distributed to the public at large. Catalogues that are made available to specialised circles only can also be valid means of evidence, bearing in mind that the relevant public for assessing disclosure is the “circles specialised in the sector concerned”.

It is enough that the disclosure took place at a point in time that can be identified with reasonable certainty prior to the filing date or priority date of the contested design even if the exact date of disclosure is unknown (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 31-32).

22.1.1.5 Disclosures derived from the internet²

Information disclosed online is considered to be publicly available as of the date information was published. The most common sources of design disclosure on the internet are the following:

- websites;
- apps;
- electronic mails;
- file-sharing.

² This paragraph contains general principles regarding disclosure of design on the internet. More details with corresponding examples may be found in [Practice Paper of Sakpatenti on CRITERIA FOR ASSESSING DISCLOSURE OF DESIGNS ON THE INTERNET](#).

The source of disclosure of a design on the internet must be properly identified in the evidence submitted.

Websites

There is a large variety of websites available on the internet, such as private, corporate, institutional or organisational websites.

E-commerce platforms

The constant growth of e-commerce is reshaping trading habits, in particular in the retail sector. Many of the existing websites are dedicated to various forms of e-commerce, such as online retailing, online auctions, online marketplaces, and online marketing.

Offering a product for sale in an e-shop or displaying it in an online catalogue generally constitutes an event of disclosure of a design incorporated in that product. In practice, a growing number of designs are made available to the public by displaying them on websites dedicated to e-commerce.

Online databases

For the purpose of the present guidelines, online databases will be understood as those containing information on the intellectual property rights relevant for assessing disclosure of designs. These databases can be administered by public authorities or private entities.

Publication of a design in a database administered by public authorities constitutes disclosure which, in principle, cannot be refuted by relying on the exceptions to availability. This includes, for example, online publications of design, trademark or patent registrations by IPOs.

On the other hand, the assessment of disclosure that took place in a database administered by a private entity is no different from that applicable to websites in general.

Social media

Online media has significantly changed the way the information is created and shared. A number of online media services are available on the internet. For the purpose of design disclosure, the most relevant online media services are those related to social media, in particular social networking, blogs and vlogs.

Social media is widely used by designers to share their work and also by businesses to present new products, etc.

Some of the key features of social media are that its content is created by users and that the dissemination of information might be very fast and extensive. When assessing disclosure of designs on various social media services, aspects such as its purpose or nature might be relevant. Moreover, some social media services provide the possibility to retrieve historical information or even search for content. In other cases, the content might only be available for a short period of time.

As for the form of how the evidence should be submitted, following should be taken into account:

- The evidence taken from a website should be presented by creating a printout or a screenshot of the relevant information presented therein.
- The evidence submitted should display a clear image of the relevant design revealing its features, the date of disclosure and the URL address.

- If the information is obtained through a printout, its printing date will be assumed to be the date of disclosure, unless another earlier relevant date can be established from the contents of the document or from any other evidence.
- When assessing evidence of disclosure of a design from certain websites (e.g. online shops, social media sites), the information regarding the purpose and the main characteristics of the website in question could be relevant for assessing the availability of the design.

Apps

A considerable part of online activity entails the use of apps (e.g. online retail sales, online auctions, social networking, instant messaging, etc.). Therefore, this medium has to be taken into account for the purposes of assessing the disclosure of designs.

In terms of disclosure of designs, apps and websites can provide the same relevant content (i.e. date, design) in a relatively similar manner. Therefore, the main difference between apps and websites lies not in the content itself, but in the means of presenting the relevant information.

Proving disclosure of designs in apps that do not have a website version can be burdensome, in particular because of:

- the difficulty in obtaining proof that a design has been disclosed through an app when the information displayed is temporary and might not be retrievable after a certain period of time;
- the limited capability of web archiving services to capture historical data from apps;
- the limited possibility to create a printout version of the information displayed in apps.

Hence, while submitting evidence from apps it is recommended to do the following:

- When apps also have a website version, it is advisable to extract the relevant information from the website.
- If a website version is not available, a screenshot from a mobile device can be used as evidence.

Electronic mails

Electronic mails (hereinafter “e-mails”) can be another source of disclosure of designs on the internet. Traditionally, an e-mail is perceived as private correspondence. However, e-mails are also widely used in e-commerce.

An e-mail which aims to promote a product, including to a limited circle of persons, should not be considered as private correspondence. For instance, an e-mail sent by a producer of a certain product to selected retailers with the offer of putting it on the market would normally be considered as an event of disclosure of a design incorporated in that product.

In addition, the standard data contained in e-mails could provide valuable indications for the assessment of disclosure of designs. For example, the ‘sent’ or ‘received’ date could establish when the event of disclosure took place and the recipient addresses could help to identify whether the communication was targeted to the members of the specialised circles concerned.

File sharing

Making a file that incorporates a design available through a file sharing system, in principle, constitutes an event of disclosure.

For the purposes of this document, two of the most common services for file sharing have been considered, namely peer to peer (P2P) and file hosting.

These services are similar to the extent that in both cases the files available for downloading would be listed on a sharing platform and by following their hyperlinks, users would be able to download them.

The key difference between them is principally technical in nature. In the case of the P2P file sharing, the files are downloaded directly from the computer of one user to another, whereas in the case of file hosting those files will have to be first uploaded on the sharing platform.

It should be noted that the contents of the files shared through either of the aforementioned systems would normally not be visible to users until the files have been downloaded and opened. Therefore, when assessing disclosure of designs through file sharing systems, two key aspects should be taken into consideration:

- establishing the link between the contents of the file containing a design and the file's reference in the file sharing system;
- establishing the relevant date.

When proving disclosure of a design through file sharing, merely submitting a printout from the platform displaying the indexed file would not be sufficient. The link between the index of the file and its content will need to be established.

The evidence should also indicate the date of disclosure. In general, the date when the file has been made available for sharing would be considered as the date of disclosure, unless it is proven that no file has actually been downloaded using that hyperlink. In the case that the date when the file has been made available is not indicated, the date when it has actually been downloaded would serve as the relevant date.

Establishing the relevant date of disclosure. The nature of the internet can make it difficult to establish the actual date on which information was in fact published. For instance, not all web pages mention the date when they were launched. In addition, websites are easily updated, yet most do not provide any archive of previously displayed material, nor do they display records that enable members of the public to establish precisely what was published and when. For the purposes of proving disclosure of designs, in particular as regards the relevant date, website archiving services are preferred rather than search engine services. Timestamping could be used as a precautionary measure in order to secure the evidence of disclosure of designs. When several steps are required in order to obtain the evidence of design disclosure, the entire browsing session could be timestamped. Besides, submitting evidence extracted using forensic software tools, information explaining the tool, how the information was obtained, which kind of information was extracted and from which content it was taken should also be submitted.

In this context, the date of disclosure on the internet will be considered reliable in particular where:

- the website provides time stamp information relating to the history of modifications applied to a file or web page (for example, as available for Wikipedia or as automatically appended to content, e.g. forum messages and blogs); or
- indexing dates are given to the web page by search engines; or
- a screenshot of a web page bears a given date; or

- information relating to the updates of a web page is available from an internet archiving service such as the “Wayback Machine” (02/07/2015, R 25/2014-3, SOFT DRINK BOTTLE, § 29).

Means for presenting the evidence obtained from the internet. Design Law of Georgia does not provide any specific form in which the evidence on disclosure of designs must be submitted. In general, any means able to prove an event of disclosure of a design can be submitted.

Regarding the means for presenting evidence obtained from the internet, submitting evidence in following forms are recommended:

1. Printouts and screenshots

- Printouts and screenshots should ideally contain information on the source where the content was taken (e.g. URL address), the relevant date and disclosed design, and should not be manually modified.
- When several dates and/or designs are displayed in a printout or a screenshot, it should be clearly indicated which is the relevant date/design.
- Images of a design should be precise and of sufficient quality to allow the definition of its features.

2. Images and videos

- The information on the source where images or videos displaying a design originate from should be provided.
- The date when an image or a video displaying a design was made public should be established.
- The image showing the design could be presented in a printout or a screenshot.
- The video itself (e.g. as a file) or only captures of the relevant parts where the design is perceived could be presented. Submitting only URL of the video would not be sufficient.

3. Metadata

When metadata is submitted as evidence, information explaining how it was obtained, what kind of information was extracted and from which source it was taken should preferably be provided.

4. URL addresses and hyperlinks

When the URL address or a hyperlink is submitted, a printout or a screenshot of the relevant information contained therein should also be provided.

5. Statements in writing

The information contained in statements in writing, sworn or affirmed, should be supported by additional evidence, such as printouts or screenshots, showing the information relevant for disclosure (e.g. design, date of disclosure, etc.).

Exceptions to the availability of the design on the internet. Once the event of disclosure of a design is proven, there is a presumption that such a design has been made available to the public. Taking into account the global nature of the internet, in general, online content is available worldwide.

Only under certain circumstances events of disclosure would not be considered to reasonably become known to the circles specialised in the sector concerned, operating within Georgia. This can be due to some restrictions, in particular, as to the accessibility or searchability of the information on the internet.

In order to refute the presumption of disclosure, these exceptions to the availability of the design have to be proven by submitting the respective evidence. In general, neither restricting access to a limited circle of people (e.g. by password protection) nor requiring payment for access (analogous to purchasing a book or subscribing to a journal) prevents a design on a web page from being found to have been disclosed. When assessing whether such a disclosure could not reasonably have become known in the normal course of business to the circles specialized in the sector concerned and operating in Georgia, aspects such as accessibility and searchability of the web page can be taken into account. Depending on the sector concerned, languages might affect the possibility of the specialized circles operating within Georgia to become aware of the event of design disclosure on the internet. Geo-blocking can be another factor that might affect the accessibility to information contained in the internet by the specialised circles operating in Georgia.

22.1.1.6 Disclosure to a third person under explicit or implicit conditions of confidentiality

Disclosure of the design to a third person under explicit or implicit conditions of confidentiality will not be deemed to have been made available to the public (Article 6(2)(b) of the **Law**).

Therefore, disclosure of a design to a third party in the context of commercial negotiations is ineffective if the parties concerned agreed that the information exchanged should remain secret (20/06/05, ICD No 172, § 22).

The burden of proving facts establishing confidentiality lies with the holder of the contested design.

22.1.1.7 Grace period

Article 6(3) of the **Law** provides for a “grace period” of 12 months preceding the date of filing or the priority date of the design applied. Disclosure of the design within such period will not be taken into consideration if it was made by the designer or its successor in title.

As a matter of principle, the holder must establish that it is either the creator of the design upon which the application is based or the successor in title to that creator, failing which Article 6(3) of the **Law** cannot apply (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 26-29).

However, acts of disclosure made by a third person as a result of information provided or action taken by the designer or its successor in title are also covered by Article 6(3) of the **Law**. This can occur where a third party has made public a design copied from a design that was previously disclosed within the grace period by the holder itself (02/05/2011, R 658/2010-3, LEUCHTVORRICHTUNGEN, § 37-39).

Article 6(3) of the **Law** also provides for immunity against the loss of individual character.

The “grace period” also applies where the disclosure of a design is the result of an abuse in relation to the designer or its successor in title (Article 6(3) of the **Law**). Whether the disclosure is the result of fraudulent or dishonest behavior will be assessed on a case-by-case basis in the light of the facts, arguments and evidence submitted by the parties (25/07/2009, R 552/2008-3, LECTEUR ENREGISTREUR MP3, § 24-27).

22.1.2 Assessment of novelty and individual character

A design will be protected to the extent that it is new and has individual character (Articles 3(4), 3(5) and 3(8) of the **Law**). The novelty and individual character of a contested design must be examined on its date of filing or, as the case may be, on its date of priority, in the light of the relevant earlier designs. The relevant earlier designs are made up of the earlier designs whose disclosure, according to Article 6 of the **Law**, was substantiated by the appellant. Unlike limited assessment of novelty at the stage of substantive examination (paragraph 10.4.1.2), appellant may rely on designs being disclosed not only in the course of filing with Sakpatenti and International Bureau (with request of extension its protection to the territory of Georgia), but on any design disclosed in the form described in paragraph 22.1.1.

22.1.2.1 Common principles

Global comparison

The contested design must be compared individually with each and every earlier design relied on by the appellant. Novelty and individual character of a design cannot be defeated by combining features taken in isolation and drawn from a number of earlier designs, but by one or more earlier designs, taken individually (21/09/2017, C-361/15 P and C-405/15 P, Shower drains, EU:C:2017:720, § 69; 19/06/2014, C-345/13, Karen Millen Fashions, EU:C:2014:2013, § 23-35; 22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 23-24). Hence, when several designs are cited in opposition by the appellant, each of them shall be compared separately to the contested design.

A combination of already disclosed features is, therefore, eligible for protection as a design, provided the combination, as a whole, is novel and has individual character.

In principle, subject to a number of exceptions detailed below, all the features of conflicting designs must be taken into consideration when examining novelty and individual character.

Point of reference for the comparison

The contested design is the point of reference when assessing novelty and individual character in the comparison with the earlier design.

Novelty and individual character, therefore, have to be assessed solely on the basis of the features disclosed in the contested design (13/06/2017, T-9/15, Dosen [für Getränke], EU:T:2017:386, § 87).

Consequently, if the contested design reproduces only certain aspect views, for instance the front view, a comparison is made only with the corresponding view of the earlier design. Any additional aspect views disclosed by the earlier design, such as the rear view, are disregarded.

The same principle applies when the contested design shows the appearance of only part of a product whereas the earlier design discloses the whole product.

However, in turn, when the contested design shows more features than the earlier design, its overall impression is determined by all of its features save for the exceptions outlined below.

Features dictated by a technical function and features of interconnection

Features that are solely dictated by a technical function and features that must necessarily be reproduced in their exact form and dimensions in order to allow interconnection with another product cannot contribute to the novelty and individual character of a design. Such features must therefore be disregarded when comparing the contested design with the relevant earlier designs (Article 7 of the **Law**).

However, when parts of a product serve a functional purpose without being solely dictated by the technical function within the meaning of Article 7 of the **Law**, its features may constitute a differentiating factor to the extent that its features could be designed differently. For instance, a button operating the functions on an electronic wristband can be placed on the product in different ways and can have different shapes and sizes (04/07/2017, T-90/16, Measuring instruments, apparatus and devices, EU:T:2017:464, § 61).

The visibility requirement

Features of a design applied to or incorporated in a “component part of a complex product”, will be disregarded if they are invisible during normal use of the complex product in question (Article 3(10) of the **Law**).

“Complex product” means a product that is composed of multiple components that can be replaced, permitting disassembly and reassembly of the product (Article 3(3) of the **Law**). For instance, the visibility requirement does not apply to a design representing the appearance of a garbage container as a whole since garbage containers may be complex products as such, but not component parts of complex products (23/06/2008, ICD No 4 919).

“Normal use” means use by the end user, excluding maintenance, servicing or repair work (Article 3(11) of the **Law**). “Normal use” is the use made in accordance with the purpose for which the complex product is intended.

For instance, for safety reasons, an electrical connector is a component part that is normally incorporated in a casing in order to be shielded from any contact with potential users when a complex product, such as a train or an electric vehicle, is in operation. The fact that such a component part of a complex product can theoretically be made visible when inserted in a transparent casing or cover constitutes a purely hypothetical and random criterion that must be disregarded (03/08/2009, R 1052/2008-3, Contacteurs électriques, § 42-53).

Where none of the features of a design applied to a component part (e.g. a sealing ring) is visible during normal use of the complex product (e.g. a heat pump system), the design will be refused as a whole (20/01/2015, T-616/13, Heat Exchanger Inserts, EU:T:2015:30, § 14-16).

However, Article 3(10) of the **Law** does not require a component part to be clearly visible in its entirety at every moment of use of the complex product. It is sufficient if the whole of the component can be seen some of the time in such a way that all its essential features can be apprehended (22/10/2009, R 690/2007-3, Chaff cutters, § 21).

Where the features of a design applied to a component part are only partially visible during normal use of the complex product, the comparison with the relevant earlier designs invoked must be limited to the visible parts.

Clearly discernible features

Features of a design that are not clearly discernible in its graphical representation cannot contribute to its novelty or its individual character. Likewise, features of the earlier

design that are not of sufficient quality to allow all the details to be discerned in the portrayal of the earlier design cannot be taken in consideration.

Features of an earlier design can be supplemented by additional features that were made available to the public in different ways, for instance, first, by the publication of a registration and, second, by the presentation to the public of a product incorporating the registered design in catalogues. These representations must however relate to one and the same earlier design (22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 25-30).

Disclaimed features

Features of a contested design that are disclaimed are disregarded for the purposes of comparing the designs. This applies to the features of a contested design represented with broken lines, blurring, colour shading or boundaries or in any other manner making clear that protection is not sought in respect of such features (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 59-64).

In contrast, disclaimed features of an earlier registered design can be taken into account when assessing the novelty and individual character of a contested design, because the earlier design is considered as a disclosure irrespective of the subject matter of protection as a design, and thus includes even the disclaimed features.

22.1.2.2 Novelty

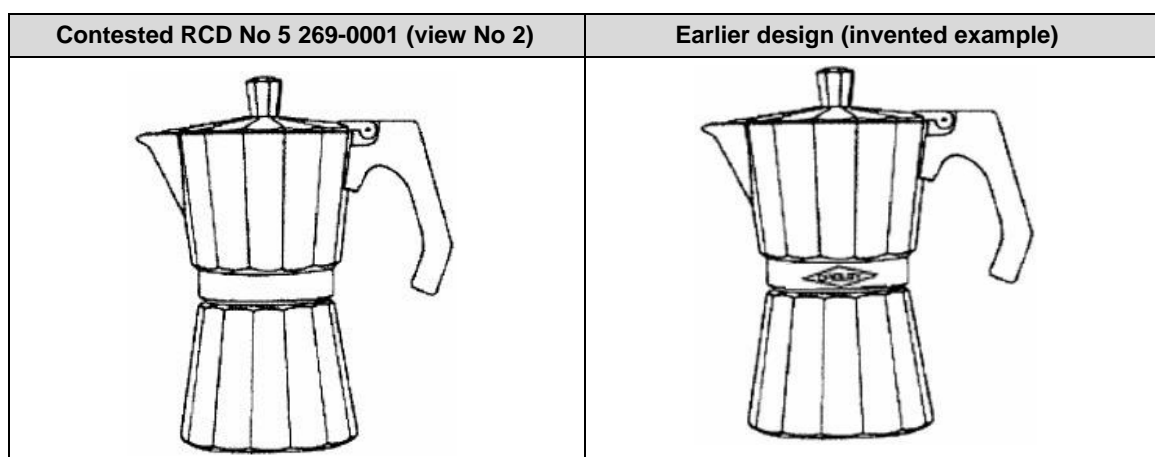
A design will be considered to be new if it is not predated by an identical design disclosed pursuant to Article 6 of the **Law**. Designs will be deemed to be identical if their features differ only in immaterial details (Article 3(7) of the **Law**).

There is identity between the contested design and an earlier design where the latter discloses each and every element constituting the former. A design cannot be new if it is included in a more complex earlier design (25/10/2011, R 978/2010-3, PART OF SANITARY NAPKIN, § 20-21).

However, the additional or differentiating features of the contested design may be relevant for deciding whether it is new, unless such elements are so insignificant that they may pass unnoticed.

An example of an immaterial detail is a slight variation in the shade of the colour pattern of the compared designs (28/07/2009, R 921/2008-3, NAIL FILES, § 25).

Another illustration is the display, in one of the two compared designs, of a label that is so small in size that it is not perceived as a relevant feature (08/11/2006, R 216/2005-3, CAFETERA, § 23-26) as in the following example.



22.1.2.3 Individual character

A design will 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 that has been made available to the public before the date of filing of the application for registration or, if a priority is claimed, the date of priority (Article 3(8) of the **Law**).

In assessing individual character, the degree of freedom of the designer in developing the design will be taken into consideration (Article 3(9) of the **Law**).

The informed user

The status of “user” implies that the person concerned uses the product in which the design is incorporated, in accordance with the purpose for which that product is intended (22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 46; 09/09/2011, T-10/08, Internal combustion engine, EU:T:2011:446, § 24; 06/06/2013, T-68/11, Watch-dials, EU:T:2013:298, § 58).

The concept of “informed user”, which refers to a fictitious person, lies somewhere between that of the average consumer applicable in trade mark matters, who need not have any specific knowledge, and the sectorial expert, who has detailed technical expertise. Without being a designer or a technical expert (and therefore without necessarily knowing which aspects of the product concerned are dictated by technical function, as found in 22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 48), the informed user is aware of the various designs that exist in the sector concerned, possesses a certain degree of knowledge with regard to the features that those designs normally include, and, as a result of his or her interest in the products concerned, shows a relatively high degree of attention when using them (20/10/2011, C-281/10 P, Metal rappers, EU:C:2011:679, § 53, 59; 22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 47; 06/06/2013, T-68/11, Watch-dials, EU:T:2013:298, § 59).

In other words, the informed user is neither a designer nor a technical expert. Therefore, an informed user is a person that has some awareness of the existing designs in the sector concerned, without necessarily knowing which aspects of a product are dictated by a technical function.

The informed user is neither a manufacturer nor a seller of the products in which the designs at issue are intended to be incorporated (09/09/2011, T-10/08, Internal combustion engine, EU:T:2011:446, § 25-27).

However, depending on the nature of the product in which the design is incorporated (e.g. promotional items), the concept of informed user may include, firstly, a professional who acquires such products in order to distribute them to the final users and, secondly, the final users themselves (20/10/2011, C-281/10 P, Metal rappers, EU:C:2011:679, § 54). The fact that one of the two groups of informed users perceives the designs at issue as producing the same overall impression is sufficient for a finding that the contested design lacks individual character (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 56).

When the nature of the product in which the compared designs are incorporated makes it possible, the overall impression made by these designs will be assessed on the assumption that the informed user can make a direct comparison between them (18/10/2012, C-101/11 P & C-102/11 P, Ornamentación, EU:C:2012:641, § 54-55).

The degree of freedom of the designer

The designer's degree of freedom depends on the nature and intended purpose of the product in which the design will be incorporated, as well as on the industrial sector to which the product belongs. The Chamber of Appeals will take into account the indication of the product(s) in which the design is intended to be incorporated or to which it is intended to be applied, as well as the design itself, insofar as it makes clear the nature of the product, its intended purpose or its function (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 56).

The designer's degree of freedom in developing its design is established, inter alia, by the constraints of the features imposed by the technical function of the product or an element thereof, or by statutory requirements applicable to the product. Those constraints result in a standardisation of certain features, which will thus be common to the designs applied to the product concerned (13/11/2012, T-83/11 & T-84/11, Radiatori per riscaldamento, EU:T:2012:592, § 44).

The greater the designer's freedom in developing the challenged/refused design, the less likely it is that minor differences between the designs at issue will be sufficient to make a different overall impression on an informed user. Conversely, the more the designer's freedom in developing the design is restricted, the more likely it is that minor differences between the designs at issue will be sufficient to make a different overall impression on the informed user (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 67, 72). Therefore, if the designer enjoys a high degree of freedom in developing a design, this reinforces the conclusion that the designs that do not have significant differences make the same overall impression on an informed user (09/09/2011, T-10/08, Internal combustion engine, EU:T:2011:446, § 33).

The fact that the intended purpose of a given product requires the presence of certain features may not imply a restricted degree of freedom of the designer where the parties submit evidence that there are possible variations in the positioning of such features and in the general appearance of the product itself (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 69; 06/10/2011, T-246/10, Reductores, EU:T:2011:578, § 21-22; 09/09/2011, T-10/08, Internal combustion engine, EU:T:2011:446, § 37; 29/11/2018, T-651/17, Spray guns for paint, EU:T:2018:855, § 33-34).

The degree of freedom of the designer is not affected by the fact that similar designs coexist on the market and form a "general trend" or coexist on the registers of industrial property offices (22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 58; 01/06/2012, R 89/2011-3, Sacacorchos, § 27).

The overall impression

Unless the designs compared include functional (see paragraphs 23.1 and 23.2 below) or invisible or disclaimed features, the two designs must be compared globally. That does

not mean, however, that the same weight should be given to all the features of the designs compared.

First, the informed user uses the product in which design is incorporated, in accordance with the purpose for which that product is intended. The relative weight to give to the features of the designs compared may therefore depend on how that product is used. In particular, the role played by some features may be less important depending on their reduced visibility when the product is in use (22/06/2010, T-153/08, Communications equipment, EU:T:2010:248, § 64-66, 72; 21/11/2013, T-337/12, Sacacorchos, EU:T:2013:601, § 45-46; 21/05/2015, T-22/13 & T-23/13, UMBRELLAS, EU:T:2015:310, § 97).

Second, when appraising the overall impression conveyed by two designs, the informed user will only give minor importance to features that are totally banal and common to the type of product in question and will concentrate on features that are arbitrary or different from the norm (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 77; 28/11/2006, R 1310/2005-3, galletas, § 13; 30/07/2009, R 1734/2008-3, FORCHETTE, § 26 et seq.).

Third, similarities affecting features in respect of which the designer enjoyed a limited degree of freedom will have only minor importance in the overall impression produced by those designs on the informed user (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 72).

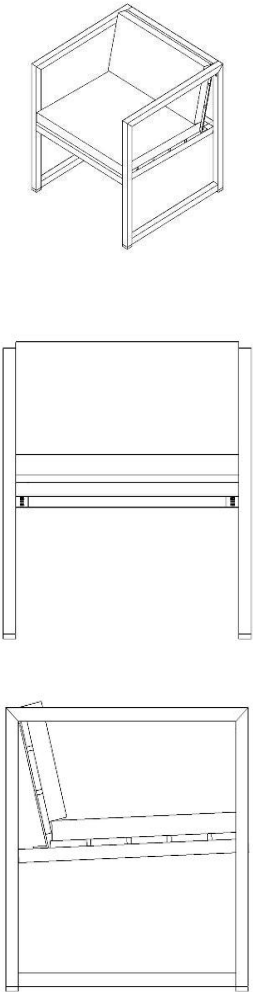
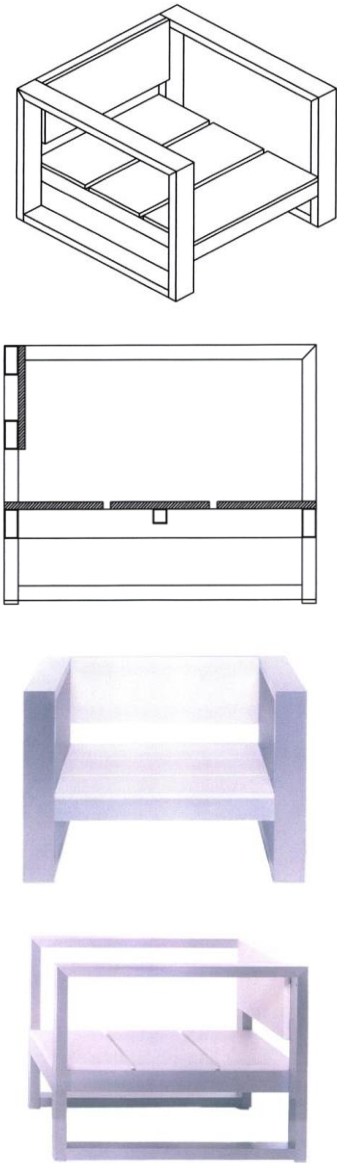
Fourth, when familiar with a saturation of the prior art due to the density of the existing design corpus³, the informed user may be more sensitive to even minor differences between the designs that may thus produce a different overall impression (13/11/2012, T-83/11 & T-84/11, Radiatori per riscaldamento, EU:T:2012:592, § 81; 12/03/2014, T-315/12, Radiatori per riscaldamento, EU:T:2014:115, § 87). In order to prove the actual impact of such saturation on the informed user's perception, the holder of the contested design must present sufficient evidence of the existing design corpus and its density at the date of filing of the contested design or its priority date (10/10/2014, R 1272/2013-3, RADIATORI PER RISCALDAMENTO, § 36, 47; 09/12/2014, R 1643/2014-3, Radiatori per riscaldamento, § 51).

To illustrate, it was held that RCD No. 1 512 633-0001 created an overall impression different from that produced by the earlier design (RCD No 52 113-0001). In an area in which the designer's degree of freedom in developing his or her design is not limited by any technical or legal restraints, the General Court (GC) upheld the decision of the Board of Appeal of the EUIPO, which had found that the differentiating features of the two designs below prevailed over their common points. In particular, the fact that the armchair of the earlier design has a rectangular rather than a square shape, that its seat is placed lower and that the arms are broader, was considered decisive in support of the conclusion that the contested community design had individual character (04/02/2014, T-339/12, Armchairs, EU:T:2014:54, § 23-37).

Accordingly, account must be taken of the difference between the designs at issue as regards the angle of the backrest and the seat of the armchair represented in the contested design, bearing in mind that the overall impression produced on the informed user must necessarily be determined in the light of the manner in which the product in question is used. Since an inclined backrest and seat will give rise to a different level of comfort from that of a straight back and seat, the use that will be made of that armchair by the

³ According to UK High Court, case *L'Oreal v RN Ventures* [2018] EWHC 173 (Pat) - the design corpus is, in essence, the other designs for products of that type which existed at the date of creation of the RCD in question.

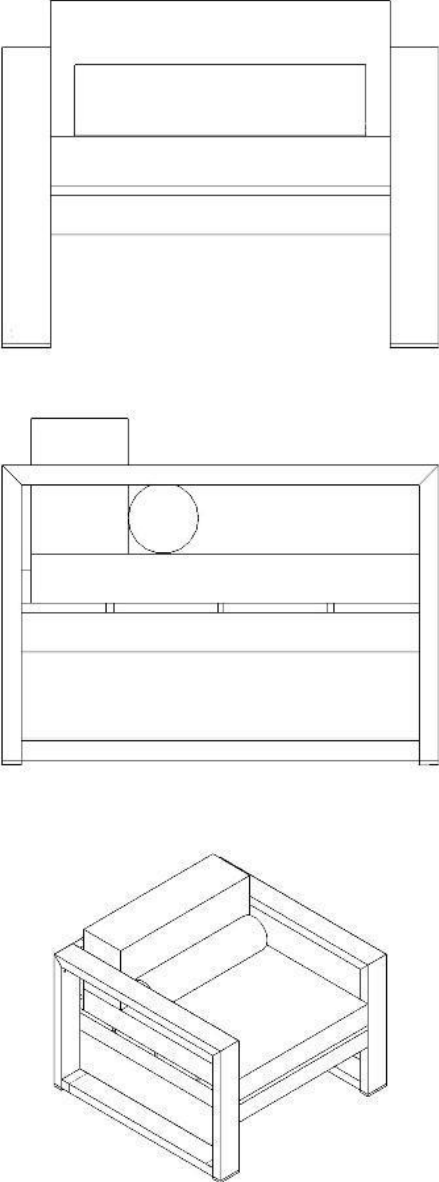
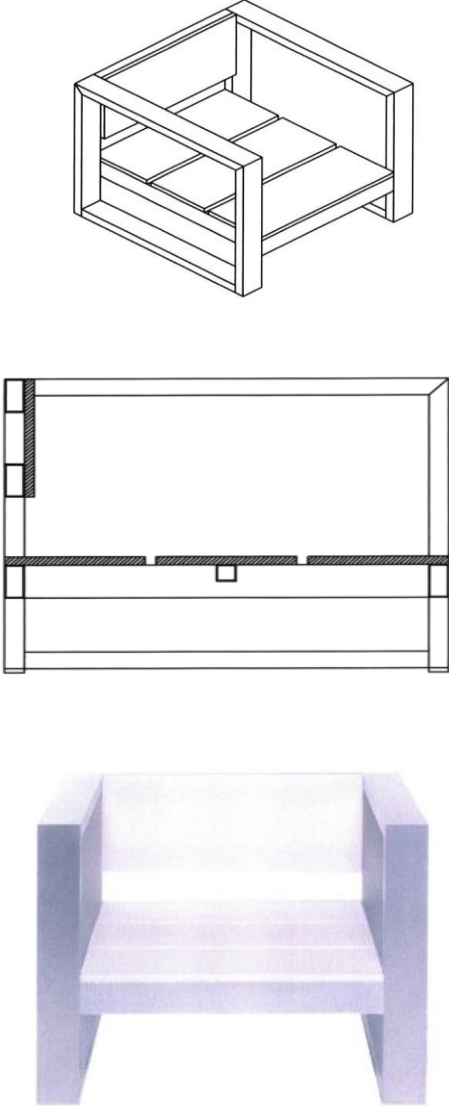
circumspect user is liable to be affected thereby (04/02/2014, T-339/12, Armchairs, EU:T:2014:54, § 30).

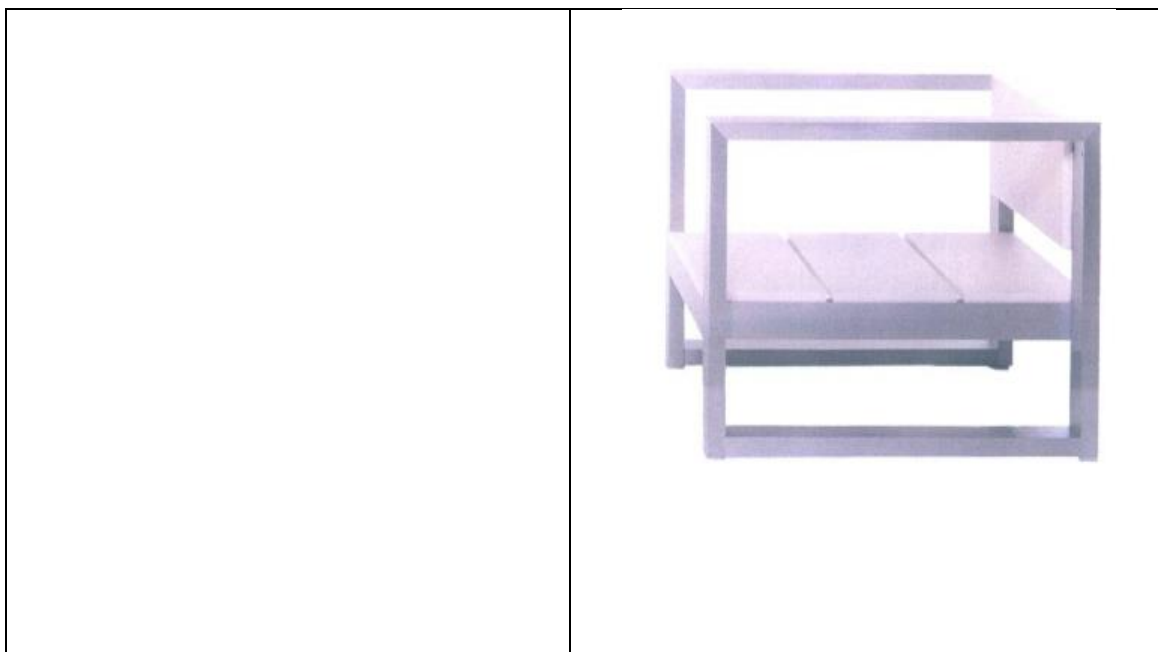
Contested RCD No 1 512 633-0001	Earlier RCD No 52 113-0001
	

By contrast, it was found that RCD No. 1 512 633-0003 lacked individual character in respect of the same earlier design. It was held that the differentiating features between the designs, including the presence in the contested community designs of three cushions, were outweighed by their common characteristics (the rectangular shape, the flat back and seat, the seats positioned below the mid-section of the armchairs' structure, etc.) (04/02/2014, T-357/12, Armchairs, EU:T:2014:55, § 44-60).

The court confirmed the view taken by the Board of Appeal of the EUIPO (27/04/2012, R 969/2011-3, ARMCHAIRS) that the cushions are less important than the structure of the armchairs when assessing the overall impression caused by the designs because the cushions are not a fixed element but can be easily separated from the main product and

because they are often sold and purchased separately, at a relatively low cost compared to that of the structure of an armchair. The informed user perceives the cushions as a mere optional accessory. They can hardly be considered to be “a significant part of the design”. Consequently the overall impression produced by the designs at issue is dominated by the structure of the armchairs itself and not by the cushions, which could be regarded as secondary elements (04/02/2014, T-357/12, Armchairs, EU:T:2014:54, § 37, 38).

Contested RCD No 1 512 633-0003	Earlier RCD No 52 113-0001
	



22.2 Use of an earlier distinctive sign

A design will be declared invalid if it wholly or by any constituent element coincides with:

- Trademark having earlier priority registered in Georgia;
- Well-known trademark as defined by article 3(4) of the Law on Trademarks of Georgia (Article 20(3)(b) of the **Law**); or
- With an appellation of origin or geographical indication which has been granted protection on the territory of Georgia based on the local registration, a bilateral or international treaty

22.2.1 Distinctive sign and right to prohibit use


The notion of a “distinctive sign” encompasses registered trademarks as well as all well-known trademarks as defined by article 3(4) of the Law on Trademarks of Georgia and appellations of origin and geographical indications protected in Georgia according to the corresponding legislation.

It is important to highlight a difference between the rationale put in article 20(3)(b) of the **Law** and lack of novelty and individual character of the design. If earlier distinctive sign defeats novelty or individual character of the contested design, opposition should be based on Articles 20(2) and 20(3) of the **Law**. In this regard, prior distinctive sign should be considered as disclosed design of the product according to paragraph 22.1.1 of the present guidelines. Article 20(3)(b) of the **Law** applies to the situations where contested design has novelty and individual character compared to earlier distinctive sign, but it falls under the scope of protection of mentioned earlier distinctive sign. In particular, the Chamber of Appeals shall not allow contested design to be registered if a right holder of earlier distinctive sign has right to prohibit its use. Thus, while deciding the conflict between earlier distinctive sign and design at the Chamber of Appeals, novelty and individual character criteria are not applied and case will be handled based on the criteria defining scope of protection of earlier distinctive sign.

The appellant must establish only that he has a right to prohibit use of the contested design. It cannot be required to establish that such right has been exercised. In other words, that

the appellant has actually been able to prohibit such use (see, by analogy, 29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 191).

In the example given below Chamber of Appeals of Sakpatenti held that contested design fell under the scope of protection of earlier registered trademark. Namely, from the perspective of Law on Trademarks of Georgia, earlier trademark and contested design were confusingly similar and trademark holder had right to prevent use of contested design. Hence, ground for invalidation favourable decision on registration of design determined by articles 20(3)(b and) 29(1)(f) of the **Law** existed and the Chamber of Appeals accordingly invalidated favourable decision of examination on registration of contested design. It should be noted that earlier trademark was registered for goods in classes 32 and 33 whilst contested design was applied as an appearance of a label. The Chamber of Appeals held that as far as contested design could be used as a label for the goods in classes 32 and 33 and that there was relevance between the goods of earlier trademark registration and the product for which contested design was applied.

Earlier trademark (reg. No 26472)	Contested design (ID No 869/4)
KARTVELLI KARTВЕЛЛИ	

22.2.2 Coincidence with earlier distinctive sign wholly or by any constituent element

The notion of “coincidence with earlier distinctive sign wholly or by any constituent element” does not necessarily presuppose a full and detailed reproduction of the earlier distinctive sign in a subsequent design. Even though the design may lack certain features of the earlier distinctive sign or may have different additional features, this may constitute use of that sign, particularly where the features omitted or added are of secondary importance and are unlikely to be noticed by the relevant public. It is enough that the contested design and the earlier distinctive sign be similar (12/05/2010, T-148/08, Instruments for writing, EU:T:2010:190, § 50-52; 25/04/2013, T-55/12, Cleaning devices, EU:T:2013:219, § 23; 09/08/11, R 1838/2010-3, INSTRUMENTS FOR WRITING, § 43).

Where a contested design contains earlier distinctive sign without any disclaimer making clear that protection is not sought in respect of such feature, it will be considered that the design makes use of the earlier distinctive sign even if the latter is represented in only one of the views (18/09/2007, R 137/2007-3, Containers, § 20).

22.2.3 Substantiation of the opposition under Article 20(3)(b) of the **Law** (earlier distinctive signs)

Where an opposition is based on a right held to an earlier well-known trademark, applicant shall submit relevant decision of the court or decision of the Chamber of Appeals of Sakpatenti by which cited well-known trademark is recognized as such.

22.2.4 Examination by the Chamber of Appeals

The examination of the ground of invalidation is carried out in accordance with the law governing the earlier distinctive sign.

Chamber of Appeals will apply the principles established by relevant law and practice in relevant field.

For the purpose of applying these principles, the Chamber of Appeals will assume that the contested design or an element used in the contested design will be perceived by the relevant public as a sign capable of being used “for” or “in relation to” goods or services for which earlier distinctive sign is protected (12/05/2010, T-148/08, Instruments for writing, EU:T:2010:190, § 107; 25/04/2013, T-55/12, Cleaning devices, EU:T:2013:219, § 39 and 42).

The Chamber of Appeals will examine for which goods the contested design is intended to be used (12/05/2010, T-148/08, Instruments for writing, EU:T:2010:190, § 108). For the purpose of determining whether these goods and services are identical or similar, the Chamber of Appeals will take into account the indication of the product(s) in which the design is intended to be incorporated or to which it is intended to be applied and also the design itself, insofar as it makes clear the nature of the product, its intended purpose or its function (18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 56; 07/11/11, R 1148/2010-3, PACKAGING, § 34-37).

Where the contested design is intended to be incorporated in two-dimensional “logos”, the Chamber of Appeals will consider that such logos may be applied to an infinite range of products and services, including the products and services in respect of which the earlier distinctive sign is protected (03/05/2007, R 609/2006-3, logo MIDAS, § 27).

23. Other Grounds of Invalidity of the Design

The purpose of this paragraph is to explain how, in practice, the provisions of Article 29 of the **Law** are applied. In particular, present section explains practical aspects of those grounds of invalidation provided by article 29 of the **Law** which are not examined neither during examination nor before the Chamber of Appeals of Sakpatenti.

23.1 Technical function

Article 7(1)(a) of the **Law** provides that – “a design shall not subsist in features of appearance of a product which are solely dictated by its technical function”.

23.1.1 Rationale of article 7(1)(a)

The objective of Article 7(1)(a) of the **Law** is to prevent technological innovation from being hampered by the granting of design protection to features dictated solely by a technical function of a product.

It excludes protection for features of appearance of a product where considerations other than the need for that product to fulfil its technical function, in particular those related to the visual aspect, have not played any role in the choice of those features, even if other designs fulfilling the same function exist (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 31).

The fact that a particular feature of a product’s appearance is denied protection by Article 7(1)(a) of the **Law** does not mean that the whole design must be declared invalid pursuant to Article 29(1)(a) of the **Law**. The design as a whole will be invalid only if all the essential features of the appearance of the product in question were solely dictated by its technical function (29/04/2010, R 211/2008-3, FLUID DISTRIBUTION EQUIPMENT, § 36).

23.1.2 Examination by the court

It is the claimant's responsibility to prove any technical function invoked as a ground for invalidity.

The technical facts required for assessing criteria provided by Article 7(1)(a) of the **Law** may not be well-known. It is thus the obligation of the party relying on these facts to submit them, as the examination carried out by the court is, in principle, restricted to the facts, evidence and arguments provided by the parties.

The technical functionality of the features of a design may be assessed by taking into account of patent documents describing the technical elements of the shape concerned. However, the drawing illustrating a patent cannot in itself, without further facts, evidence and arguments, establish the technical function of a contested design.

In order to determine whether the essential features of the appearance of the product into which the contested design will be incorporated are solely dictated by the technical function of the product, it is necessary to determine what the technical function of that product is. The relevant indication in the application for registration of the design should be taken into account, but also the design itself, insofar as it makes clear the nature of the product, its intended purpose or its function (see, by analogy, 18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 56).

Whether Article 7(1)(a) of the **Law** applies must be assessed on the basis of all the objective circumstances relevant to each individual case and not from the perspective of the informed user, who may have limited knowledge of technical matters.

Such an assessment must be made, in particular, having regard to the design at issue, the objective circumstances dictating the choice of features of appearance of the product concerned, and/or information on its use or the existence of alternative designs that fulfil the same technical function, provided that the circumstances, data, or information as to the existence of alternative designs are supported by reliable evidence (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 36-37).

The information on its use may include the use made of the actual product that the design is applied to or incorporated into, as well as any information on its marketing.

23.2 Designs of interconnections

Features of a design are excluded from protection if they must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to, or placed in, around or against another product so that either product may perform its function. If Article 7(1)(b) of the **Law** applies to all the essential features of the contested design, the latter must be declared invalid (20/11/2007, ICD No 2 970).

It is up to the claimant to prove that a contested design may be objected to on the basis of Article 7(1)(b) of the **Law**. The claimant must substantiate the existence of the product whose form and dimensions dictate those of the contested design and submit facts, evidence and arguments demonstrating the functions performed by the product and by the contested design individually and/or in combination.

As an exception, Article 7(1)(b) of the **Law** does not apply to a design that serves the purpose of allowing the multiple assembly or connection of mutually interchangeable

products within a modular system (Article 7(2) of the **Law**). It is up to the holder to prove that the contested design serves such a purpose.

23.3 Lack of entitlement

According to Article 29(1)(d) of the Law, a design may be declared invalid if, by virtue of a court decision, the right holder is not entitled to the contested design under Articles 8 and 9 of the **Law**.

This ground may be invoked solely by the person who is entitled to the contested design under articles 8 and 9 of the **Law**.

23.4 Unauthorised use of a work protected under the copyright law

A design will be declared invalid if it constitutes unauthorised use of a work protected under the Law of Georgia on Copyright and Neighbouring Rights (article 29(1)(e) of the **Law**).

23.4.1 Substantiation of the claim under Article 29(1)(e) of the **Law** (earlier copyright)

Invalidation claim should contain:

- particulars establishing the content of law of which the claimant is seeking application including, where necessary, court decisions and/or academic writings (see, by analogy, 05/07/2011, C-263/09 P, Elio Fiorucci, EU:C:2011:452; 23/10/2013, T-566/11 & T-567/11, Vajilla, EU:T:2013:549, § 52);
- particulars showing that the claimant acquired the rights to the work protected under the copyright law relied on before the filing date or the priority date of the contested design (23/10/2013, T-566/11 & T-567/11, Vajilla, EU:T:2013:549, § 47) and
- particulars showing that the claimant satisfies the necessary conditions, in accordance with that law, to have the contested design invalidated or its use prohibited by virtue of his earlier right.

23.4.2 Examination by the Court

The object of the examination is to ascertain whether the claimant for a declaration of invalidity is the holder of the copyright invoked and whether unauthorized use of a work protected by the copyright legislation has occurred (23/10/2013, T-566/11 & T-567/11, Vajilla, EU:T:2013:549, § 52; 17/10/2013, R 781/2012-3, CHILDREN'S CHAIRS, § 27, 43).

It should be noted that Article 29(1)(e) of the **Law** does not apply to cases in which ownership of the design is contested, in particular when the claimant's essential argument is that the rights over the contested design is not owned by the registered holder but by the claimant. Such claim should be grounded on article 29(1)(d) of the **Law** as described in paragraph 23.3 above.

24. Payment of Fees

24.1 General principles

Design applications are subject to various fees, which are established by Resolution of Government of Georgia No. 182 of 03.07.2010 on Approval of Fees Connected with Patenting, Registration and Deposition of Objects of IP (**Fees Resolution**).

The applicant must pay fees for examination, publication and registration or, where the application includes a request for deferment of the publication, the deferment fee etc.

Fees are also paid for post-registration services like renewal, registration of assignment, change(s), license etc.

In the case of multiple applications, additional examination, publication, registration or deferment fees must be paid for each additional design.

In the case of deferment, applicants can, when filing, choose to pay not only the registration and deferment fee, but also the publication fee.

24.2 Currency, amounts and means of payment

Fees for prosecution of national design applications and post registration services are defined in USD but must be paid in Georgian Lari according to official exchange rate established by the National Bank of Georgia for the day of payment. Payments in other currencies are not accepted. Amount of fees are established by **Fees Resolution**.

Sakpatenti accepts fees only through wire transfers (Article 28(7) of the **Instruction**). Fees may not be paid by check or in cash.

Amount of fees and payment procedure for international applications are prescribed by the Hague Agreement.

24.3 Timing for payment

Fees are subject of payment within one month from the date of receipt by the applicant respective invitation (except where **Instruction** explicitly prescribes otherwise).

Fees for actions requested by the applicant or third parties are paid within 1 month of filing day of such request with Sakpatenti as in other case request will not be considered.

The applicants may pay full amount of fees in advance. In such case fees will be deposited and applied by Sakpatenti stage by stage, according to prosecution phase of the application, but if one or more action(s) are not performed, fees are subject to full re-fund.

24.4 Discounted Fees

Fees are subject to discount where applicant meets requirements set by **Fees Resolution**.

Where application has more than one applicant and at least one of them does not qualify to enjoy discount, fees are payable in full.

Where application has more than one applicant being eligible to different discount, fees are payable according to less discounted rate.