

REGULATION ON REGISTRATION OF DESIGNS

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Regulation Nº. 706/2001

CHAPTER I. Application for design registration ➡

Article 1

An application for the registration of a design shall be made on the prescribed form and submitted to the Icelandic Patent Office (IPO). An application must be signed by the applicant or his agent and include a request for registration.

The application shall also specify:

1. the name and address of the applicant, as well as his identification number, if an applicant does not have an agent;
2. the name, address and identification number of the agent, where applicable;
3. the name and address of the designer;
4. a name which describes the design;
5. whether the design concerns the appearance and type of a product or its ornamentation;
6. whether protection is to cover the colours of the design;
7. which of the applicants, in the case of more than one person applying jointly to register a design, is authorised to receive notifications from the IPO;
8. a claim of right of priority, if such is made, on the basis of the provisions of Article 16 of the Design Protection Act, together with information as provided for in Articles 5 and 7 of this Regulation; and

9. information concerning a request for postponement of registration as provided for in the second paragraph of Article 18 of the Design Protection Act, where applicable.

An application must be accompanied by:

1. two copies of each illustration, i.e. drawing or photograph, clearly showing the design; if application is made for protection of ornamentation the illustration must show the ornamentation of the product;

2. attestation of power of attorney, if an applicant has an agent; and

3. proof of an applicant's right to the design, where the applicant is other than the designer, cf. the fourth paragraph of Article 13 of the Design Protection Act. The time limit for submitting attestation of power of attorney and proof of an applicant's right to a design shall be three weeks from the date of receipt of an application. The application must be accompanied by the prescribed application fee.

Article 2

An application may be accompanied by:

1. a description of the design;

2. a model of a design, cf. the third paragraph of Article 13 of the Design Protection Act;

3. specification of the product, for which the design is to be registered; and

4. specification of the classifications to which the applicant considers the design to belong.

An applicant may only submit the above-mentioned documentation and information upon filing of the application.

The IPO may, however, request that such documentation be submitted at a later date if deemed necessary for clarification.

A description must include a short explanation (max. 150 words) of what design protection is sought for. The principal aspects which give the design individual character shall be explained. A description may neither discuss the advantages of a design nor make claims as to its value.

The name of a design should primarily serve as an explanation for an illustration. The name of a design shall not limit the extent of protection.

In the case of multiple registration, each individual design must have its own name.

Article 3

The application and description shall be in Icelandic. Other application documents may be in Icelandic, Danish, Norwegian, Swedish or English.

The IPO may require that a certified translator or other party approved by the IPO attest the translation of the accompanying documentation.

Article 4

Two copies of each illustration of a design shall be submitted, no larger than A4 size (21 x 29.7 cm). Each illustration may only show one design from one point of view. If more than one illustration is submitted of the same design, the illustrations shall be distinguished from each other and marked in alphabetical or numerical order. For explanatory purposes illustrations may be given descriptive labels (e.g. "up", "down", "cross-section"). Illustrations and symbols must be suitable for offset printing in black and white and be reproducible in various sizes.

If colour registration is sought, one copy of an illustration shall be in colour.

If an applicant submits a model of a design such shall be made of durable material. A model may not weigh more than 4 kg and shall fit inside a cube, each edge of which measures 40 cm. Models made of delicate or hazardous substances may not be submitted.

If an application covers more than one design, illustrations must be included of each individual design. Illustrations of the same design must have the same number. It must be clearly indicated which illustrations pertain to each design.

Article 5

The IPO shall enter the filing date on applications received and assign them an application number.

An application shall be deemed to have been received if it includes:

1. the name and address of the applicant;
2. the name and address of the designer;
3. a request for registration of the design;
4. illustrations, i.e. drawings or photographs, which clearly show the design, or a model of it;
and
5. the application fee.

An application which is sent by facsimile shall be deemed to have been received if the documentation, in particular the illustrations, is sufficiently clear and it is demonstrated that payment of the fee has been made. An applicant must, however, submit the original documentation within 14 days of the receipt of the facsimile.

An application, submitted without the payment of the prescribed fee, shall not be deemed to have been received.

The IPO shall, however, preserve such application for one week but after that time it shall be dismissed if payment has not been received.

The object of an application may not be altered after the application has been received.

Article 6

The registration authorities shall classify a design in accordance with the provisions of the Locarno Agreement of 8 October 1968 on international classification of designs, cf. the Appendix to this Regulation.

An applicant or his agent shall be notified as to how the design has been classified and given at least one week within which to express comments on such classification. The IPO shall make the final decision on classification.

CHAPTER II. Registry of applications ➡

Article 7

The IPO shall maintain a computerised registry of applications received.

The following information shall be entered in the registry for each application:

1. application number and date of filing;
2. name and address of the applicant;
3. name, address and identification number of the agent, where applicable;
4. the name and address of the designer;
5. name of the design;
6. whether protection is requested for the appearance and type of a product or its ornamentation;
7. whether the design is to be colour-protected;
8. which of the applicants, in the case of more than one person applying jointly to register a design, is authorised to receive notifications from the IPO;
9. the name of the host country of prior application, if priority rights are claimed on its basis, as well as the filing date and number of such application;
10. information concerning a request by an applicant for postponement of registration;
11. information on fees which have been paid for the application; and
12. information on the handling and status of the application.

It must be possible to obtain information from the registry concerning those applications which have already been made accessible to the public. Prior to such time, the IPO may, however, provide some of the information listed in the second paragraph.

Article 8

When protection for more than one design is applied for in the same application, cf. Article

15 of the Design Protection Act, each design shall have the same date of filing and same application number.

Article 9

If a notification is received concerning change in ownership of a design for which registration has been sought, the name of a new applicant will only be entered in the registry of applications if proof of a transfer is provided.

CHAPTER III. Right of Priority ➡

Article 10

To enjoy right of priority as provided for in the first to third paragraphs of Article 16 of the Design Protection Act, an applicant must claim such right in his application upon filing.

The applicant must, furthermore, specify, no later than one month after the date of filing, where the application upon which the claim for right of priority is based was submitted, its date of filing and application number. Should the above information not be received by the prescribed date the right of priority shall lapse.

The IPO may demand that right of priority be confirmed within a prescribed time limit, by means of a certificate from the registration authorities receiving the application upon which the applicant bases his right of priority. The certificate must specify the date of filing and name of the applicant. The IPO may, in addition, demand a copy of the application together with illustrations of the design. Should the above documents not be received by the prescribed date the right to claim right of priority shall lapse. The time limit shall expire no sooner than three months from the date of filing.

Withdrawal of a claim to right of priority must be notified in writing.

Article 11

An application can only serve as the basis for right of priority if it is the first concerning the design in question.

If the applicant making the first application, or a transferee, has subsequently submitted an application at the same location concerning the same design, the latter application may, however, serve as basis for a claim of right of priority if the former application has been revoked upon the delivery of the latter, or if it has been dismissed or refused before being made available to the public, and provided that no rights or claim for right of priority are based upon it. If a right of priority has been established on the basis of such an application filed subsequently, right of priority cannot be based on the former application.

Article 12

For an application to enjoy right of priority as provided for in the fourth paragraph of Article 16 of the Design Protection Act, an applicant must claim such right in his application upon filing.

A claim for right of priority must be accompanied by information on what exhibition the design has been exhibited at and what date it was first exhibited. Such information must be

received by the IPO no later than one month after the date of filing. Should the above information not be received by the prescribed date the right to claim right of priority shall lapse.

The IPO may demand that right of priority be confirmed within a prescribed time limit, by means of a certificate from the responsible organisers of the exhibition on which an applicant bases his right of priority. The certificate must specify the date of filing and name of the applicant. Should the above documentation not be received by the prescribed date the right to claim right of priority shall lapse. The time limit shall expire no sooner than three months from the date of filing.

Article 13

When protection for more than one design is applied for in the same application, cf. Article 15 of the Design Protection Act, right of priority may be claimed as provided for in Article 16 of the Act for each individual design. A claim for right of priority may be based on applications from more than one country.

CHAPTER IV. Examination ➔

Article 14

If examination by the IPO reveals that an application does not fulfil the requirements of Point 1 of Article 2 and Points 1 and 2 of Article 7 of the Design Protection Act registration shall be refused. Before an application is eradicated the applicant shall be given an opportunity to explain his case and/or acquire the prescribed authorisations for badges or emblems included in the design. If the arguments or documentation provided by an applicant do not alter the previous conclusion of the IPO, the application shall be eradicated from the Registry of Designs. A design shall not, however, be eradicated until the time limit for referring a case to the Appeals Committee has expired.

Should an application fail to fulfil the requirements of Articles 13, 14 and 15 of the Act, the applicant shall be notified of the formal deficiencies as promptly as possible. The notification shall indicate that the application may be dismissed if the deficiencies are not rectified within one month's time.

Article 15

An investigation as provided for in the second paragraph of Article 17 of the Design Protection Act shall only be based on designs registered in Iceland and designs for which registration has been sought and which have been made available to the public. The examination shall also include designs which have been eradicated during the past five years prior to the date of filing/submission?? of an application. The basis of the examination shall also include trademarks registered in Iceland and trademarks for which registration has been sought, together with information from the Registry of Companies.

Should an application include a request for protection of more than one design, cf. Article 15 of the Design Protection Act, the examination shall only concern the design specified in the request for an examination.

Article 16

If an examination is demanded, as provided for in the second paragraph of Article 17 of the

Design Protection Act, unconnected to an application, the result of such examination shall in no way affect the handling of a subsequent application for that design.

Should the IPO refuse the registration of a design on the basis of an examination which is carried out at the request of an applicant, the applicant shall be notified of such as promptly as possible. The notification shall explain the grounds for refusal of registration. An applicant shall be given a time limit of two months to express comments concerning the refusal before the application is dismissed.

CHAPTER V. Registration and publication ➡

Article 17

Where an application for design [registration] fulfils the requirements prescribed in the Design Protection Act as well as the demands made of applications in this Regulation, the design shall be registered and the proprietor sent notification of registration.

Article 18

When a design has been registered it shall, as promptly as possible, be published in a special publication issued by the IPO, the IPO Gazette. Such publishing shall include, in addition to clear illustrations, the following information:

1. application number and registration number;
2. date of filing;
3. name and address of the applicant;
4. name, address and identification number of the applicant's agent, where applicable;
5. the name and address of the designer;
6. name of the design;
7. whether the registered design concerns the appearance and type of a product or its ornamentation;
8. the classification or classifications to which the design is deemed to belong, as provided for in the Locarno Agreement on International

Classification of Designs;

9. whether the design is to be colour-protected;
10. information on right of priority together with information as to where an application upon which right of priority is based was submitted and the date of filing and number of such application;
11. illustrations showing the design; and

12. when the application was made accessible to the public, if this was not done concurrent to the date of registration.

CHAPTER VI. Registry of Designs ➔

Article 19

The IPO shall keep a registry of registered designs.

The Registry of Designs shall include the following information:

1. application number and registration number;
2. name and address of the registered proprietor;
3. name, address and identification number of the proprietor's agent, where applicable;
4. the name and address of the designer;
5. name of the design;
6. whether the design concerns the appearance and type of a product or its ornamentation;
7. whether the design is to be colour-protected;
8. the classification or classifications to which the design is deemed to belong in accordance with the Locarno Agreement on International Classification of Designs;
9. information on the products which the design is to characterise, if available;
10. the date the application was:
 - a. received or deemed to be received,
 - b. registered,
 - c. made available to the public, if this was not done concurrent to the date of registration, and
 - d. published;
11. which of the applicants, in the case of more than one person applying jointly to register a design, is authorised to receive notifications from the IPO;
12. information as to where an application, upon which a claim to right of priority is based, was submitted and its date of filing and number, if right of priority is claimed on the basis of the first to third paragraphs of Article 16 of the Design Protection Act;
13. information as to at what international exhibition, upon which a claim to right of priority is based, the design was first exhibited and on what date, if right of priority is claimed on the

basis of the fourth paragraph of Article 16 of the Design Protection Act; and

14. illustrations of the design.

When a registration covers more than one design, cf. Article 17 of the Act, there shall be only one common registration number.

Article 20

Initiation of legal proceedings based on the first paragraph of Article 25 of the Design Protection Act shall be noted in the Registry of Designs.

If the IPO cancels a design on the basis of the first paragraph of Article 27 of the Act, the design shall be eradicated from the Registry of Designs. A design shall not, however, be eradicated until the time limit for referring a case to the Appeals Committee has expired.

Anyone initiating legal proceedings on the basis of the first paragraph of Article 25 of the Act shall deliver a copy of the verdict to the IPO so that the Registry of Designs may be changed in accordance with the outcome of the verdict. The Registry of Designs shall not, however, be altered in accordance with the verdict of a District Court until the time limit for submitting an appeal has expired.

The outcome of a court case as provided for in the first paragraph of Article 25 of the Act shall be published in the periodical IPO Gazette, which is issued by the IPO.

Article 21

Anyone acquiring the right to a registered design, cf. Article 51 of the Design Protection Act, must notify the IPO of such in writing. Such notification shall include the name, address and identification number of the proprietor of the design, as of what date he acquired the right and when the change of right holders took place. The notification shall be entered in the Registry of Designs.

If this is so requested, mention shall be made in the Registry of Designs as to whether the right of a licensee to grant licences is limited.

A notification of change of agent, as well as a change in the name or address of a right holder, shall be entered in the Registry of Designs.

Notifications as provided for in the first to third paragraphs must be made in writing and be accompanied by the necessary documentation together with the prescribed fee.

Notifications shall be published in the IPO Gazette, which is issued by the IPO.

Article 22

The IPO may demand that the signature to a transfer, licence or declaration that a design has been eradicated be attested to by a notary public, an attorney or two witnesses. The IPO may also demand the attestation of signatures on other documents if such is deemed necessary.

CHAPTER VII. Postponement of registration ➡

Article 23

A request for postponement of registration, cf. the second paragraph of Article 18 of the Design Protection Act, must be included in an application. Such applications receive the same handling initially as other applications, up until the point of registration.

When an application as provided for in the first paragraph fulfils the requirements of the Act and of this Regulation, the applicant shall be notified of such as promptly as possible.

Article 24

If a request is made for postponement of registration as provided for in the second paragraph of Article 18 of the Design Protection Act, all documentation concerning the application shall be kept secret until it is registered. However, a notification shall be published in the IPO Gazette, which is issued by the IPO, to the effect that an application has been submitted together with information on:

1. the name of the applicant, address and identification number, if the applicant does not have an agent;
2. the date of filing;
3. for how long registration is to be postponed; and
4. the classification or classifications to which the design is deemed to belong.

Once the period during which registration was to be postponed has expired, the registration shall be published in the IPO Gazette.

CHAPTER VIII. Renewal ➡

Article 25

An application for the renewal of a registered design must be submitted in writing to the Icelandic Patent Office (IPO) on an application form for this purpose. The provisions of Article 1 of this Regulation shall apply mutatis mutandis to an application for renewal.

The prescribed fee must accompany the application for renewal.

If an application for renewal is deficient, the applicant shall be granted a short time limit within which to rectify the application. If the application is not rectified within the prescribed time limit it shall be refused, this shall be notified to the applicant and the registered design shall be eradicated from the Registry of Designs, as its registration period has expired.

Renewal of registration shall be entered in the registry of Designs and published in the periodical IPO Gazette, which is issued by the IPO. Publication shall include the registration number of the design and when the registration is deemed to expire.

CHAPTER IX. Cancellation of registration ➡

Article 26

Should the IPO receive a written comment concerning an application before the design referred to in the application is registered, this shall be notified to the applicant. The party submitting the comment shall be informed that it is possible to demand that the registration be cancelled.

Article 27

A request as provided for in Article 27 of the Design Protection Act shall be submitted in writing to the IPO in two copies.

The request must include the following information:

1. the name and address of the person making the claim;
2. the registration number and name of the design, for which cancellation is demanded, together with the name of its proprietor; and
3. the name, address and identification number of the agent making the claim that the registration be cancelled if an agent is involved.

Grounds must be given for a request for cancellation of a registration and it shall be accompanied by the necessary substantiating documentation.

A request that a registration be cancelled must be accompanied by the prescribed fee.

If a court has already issued a verdict in a case concerning the same subject and involving the same parties, the request shall be dismissed.

Article 28

If the request fails to fulfil the requirements of Article 27 of the Design Protection Act or of the first, second and fourth paragraphs of Article 27 of this Regulation, it shall be refused.

If premises are given for a request that registration be cancelled but further arguments or substantiating documentation are not provided, the opponent shall be given a time limit of one month to submit further arguments and/or substantiating documentation.

Article 29

The proprietor of a design must be notified as promptly as possible concerning the request submitted for cancellation and granted a time limit of two months to express comments.

The proprietor of a registered design shall be sent a copy of all letters and documents which are received from anyone requesting cancellation of a registration, and vice versa.

If letters are sent to the proprietor of a registered design concerning the substantive

handling of the case, anyone requesting cancellation of a registration must be concurrently sent a copy of such letters.

After the proprietor of a registered design has responded to a request for cancellation of registration the IPO shall reach a decision as to whether further exchange of letters between parties is necessary.

Article 30

If the IPO deems it necessary that parties be given an opportunity to express themselves orally concerning a request as provided for in Article 27 of the Design Protection Act, it shall summon both parties.

Article 31

Parties to a case as referred to in Article 27 of the Design Protection Act shall provide documentation. Decisions by the IPO in such cases shall be based only on the facts of the case, evidence and arguments presented by the parties.

If the position and arguments of the parties are not evident from the documentation of the case, the parties to the case shall be given the opportunity of expressing their comments on the subject of the case twice before the IPO makes its decision, unless such is clearly unnecessary.

The IPO may set the parties in the case a time limit to acquaint themselves with the documentation in the case and express their opinion on the case.

Once the parties have had an opportunity to express their comments as provided for above, the IPO shall notify them that a decision will be taken in the case and that no further documentation may be submitted.

Article 32

A copy of the final decision by the IPO concerning a request that registration be cancelled shall be sent to both the proprietor of a design and the party submitting the request. The IPO shall always provide grounds for its final decision.

When the time limit for an appeal as provided for in Article 36 of the Design Protection Act has expired, without a decision by the IPO concerning a request as provided for in Article 27 of the Act being referred to the Appeals Committee, the decision shall be published in the periodical IPO Gazette, which is issued by the IPO.

CHAPTER X. Division ➡

Article 33

If an application covers more than one design, as provided for in Article 15 of the Design Protection Act, the proprietor of an application may request that the application be divided into two or more applications. Such a request must include information on the application number of the original application and to what design each application shall apply following the division.

After a request for the division of an application has been handled, the application arising from the division shall be given a separate application number.

An application arising from a division shall have the same date of filing and date of priority as the original registration.

A decision on division shall be published in the periodical IPO Gazette, which is issued by the IPO.

Article 34

If a registration covers more than one design, as provided for in Article 15 of the Design Protection Act, the proprietor of the registration may request that the registration be divided into two or more registrations. Such a request must include information on the registration number of the original registration and as to what design each registration shall apply following the division.

After a request for the division of a registration has been handled, each registration arising from the division shall be given a separate registration number.

A registration arising from a division shall have the same date of filing, of priority and of registration as the original registration.

A decision on division shall be published in the periodical IPO Gazette, which is issued by the IPO.

CHAPTER XI. Miscellaneous provisions ➡

Article 35

A time limit granted shall commence as of the date of the letter from the IPO. The time limit shall be two months, unless decided otherwise or unless such derives from the provisions of the Design Protection Act or this Regulation. If the final day of a time limit falls on a public holiday, the time limit shall be extended until the next working day thereafter.

Article 36

A request that a design be eradicated from the Registry of Designs must be signed by the proprietor of the design. If a licence is registered in the Registry of Designs, a design shall only be eradicated if the proprietor demonstrates that the licensee has been notified of his intention.

A notification must be published to the effect that the design has been eradicated from the Registry of Designs or the rights to a registered design [transferred] to another name pursuant to a final court verdict.

Article 37

The IPO shall preserve a model submitted with an application, cf. the third paragraph of Article 13 of the Design Protection Act, for five years after the registration has been cancelled. If the owner of the model has laid no claim to it within that time the Office may

destroy it.

CHAPTER XII. Entry into force ➡

Article 38

This Regulation, which is set by authority of Article 53 of the Design Protection Act, No. 46/2001, shall enter into force on 1 October 2001.

Ministry of Industry, 25 September 2001

Jón Kristjánsson

Jón Ögmundur Þormóðsson