



Sub-Regional Meeting on Industrial Designs

How to Protect Designs

**Beirut
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Introduction

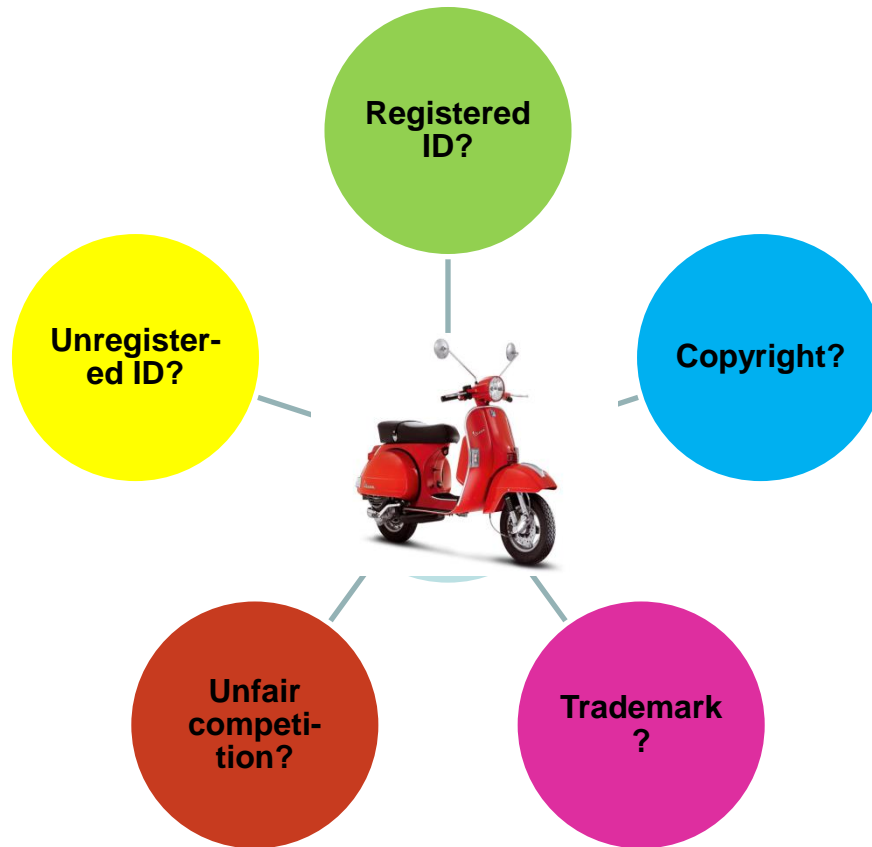
- **ONE** industrial design



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Introduction

■ DIFFERENT means of protection

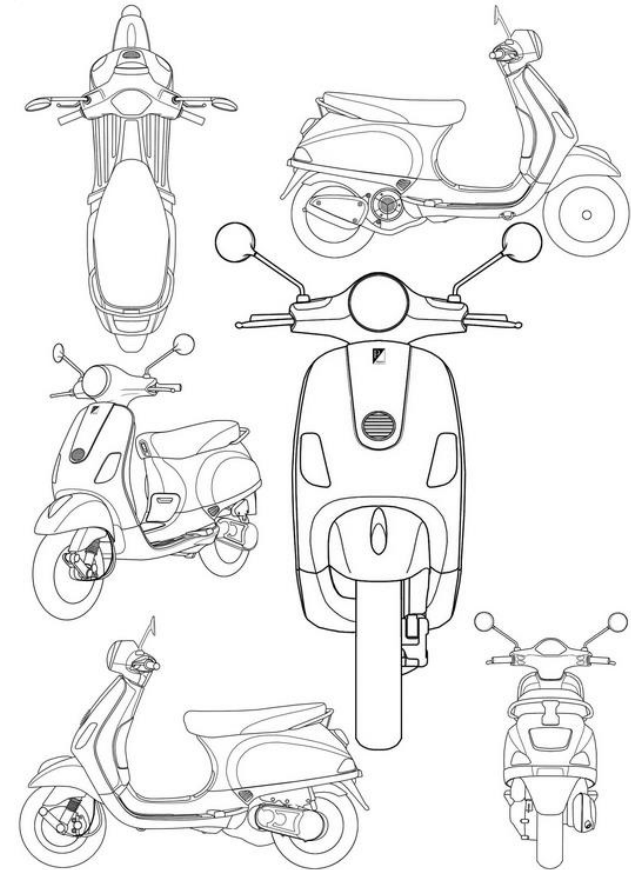


Example (in Italy)

Trademark



Copyright



EUTM 011686573

Date: 25.03.2013

IR 1178676

Date: 29.08.2013

“Opera di design industriale”

Decision April 6, 2017, Tribunal of Torino

Obligation to protect industrial designs

■ Paris Convention: Article 5 *quinquies*

“Industrial designs shall be protected in all the countries of the Union”

Obligation to protect industrial designs

■ TRIPS Agreement: Article 25.1

“Members shall provide for the protection of independently created industrial designs that are **new or original**.

Members may provide that designs are not new or original if they do not significantly differ from known designs or combinations of known design features”

Obligation to protect industrial designs

■ TRIPS Agreement

- **Scope of protection** – To prevent others from making, selling or importing articles bearing or embodying a design which is a copy, or substantially a copy, of the protected design, when such acts are undertaken for commercial purposes

Obligation to protect industrial designs

■ TRIPS Agreement

- **Duration:** protection shall amount to **at least 10 years**

Means of protection of industrial designs

- No particular means specified in international treaties
- Consequence: it is a question of **national policy and legislation**
- Means of protection **vary from country to country**

Reasons to protect

- Research / Development → protect investment
- Exclusive rights → enforcement : legal procedures in case of infringement
- Economic development : enhance creativity and innovation

Means of protection of industrial designs – Main categories

- Registered design / Design patent
- Unregistered design
- Copyright
- Unfair competition
- Trademark

Means of protection of industrial designs

- Possibility for States to chose **MORE THAN ONE** form of protection

**REGISTERED INDUSTRIAL
DESIGN /
DESIGN PATENT**

Basic features

- Formalities (application, fees)
 - Request
 - Identity of the applicant (+ representative)
 - Reproduction of the design(s)
 - Indication of the good(s) to which the design applies
 - Etc.

Basic features

- Procedure (formal examination and/or substantive examination)
 - Definition of a «design»
 - Public order/morality
 - Technical/functional considerations
 - Novelty/originality

Basic features

- Registration / grant of a patent
- Publication
- Opposition/ Invalidation by third parties

UNREGISTERED INDUSTRIAL DESIGN

Basic features

- No formalities
- No procedure
- No official publication
- Time- and scope-limited protection

Unregistered design – Overview of various systems

a) European Union (EU)

b) United Kingdom (UK)

Unregistered design

c) Turkey

d) Other countries

COPYRIGHT

Berne Convention

■ Berne Convention: Article 2.7

“(...) it shall be a matter for legislation in the countries of the Union to determine the extent of the application of their laws to works of applied art and industrial designs and models, as well as the conditions under which such works, designs and models shall be protected. (...)”

Basic features

■ Original work

- Originality: an industrial design is original if it may be attributed to someone
- It reflects the author's personality/creativity

■ Form

■ “Automatic” protection

Basic features

■ Exclusive rights:

- Exploitation
- Moral rights

■ Duration: 50 years after the author's death

Copyright

■ Industrial design protected under copyright law:

- without any specific requirements (“unity of art”)



Tribunal de Grande Instance de Paris, 14 December 2007, RG 06/05280,
Hermès International and Hermès Sellier SA v. Société Anna Lowe

http://legimobile.fr/fr/jp/lj/1d/tgi/75056/2007/12/7/06_05280/

Tribunal de Grande Instance de Paris, 5 March 2008, RG 06/18279,
Hermès International and Hermès Sellier SAS v. SARL Buxiki

<http://www.legifrance.gouv.fr/affichJuriJudi.do?oldAction=rechJuriJudi&idTexte=JURITEXT000019097997&fastReqId=1271973067&fastPos=1>

Copyright

- if identified *separately* from, and exist *independently* of, the functional aspect of the product (separability requirement)



Copyright

- if it presents a level of artistic creativity / value
(*high artistic character*)



Copyright

- if it is the result of a *high degree of originality*



UNFAIR COMPETITION

Unfair competition

- Article 10*bis* of the Paris Convention

(...)

(2) Any **act of competition contrary to honest practices** in industrial or commercial matters constitutes an act of unfair competition.

Unfair competition

(3) The following in particular shall be prohibited:

1. all acts of such a nature as to **create confusion** by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor;
2. false allegations in the course of trade of such a nature as to **discredit** the establishment, the goods, or the industrial or commercial activities, of a competitor;

Unfair competition

3. indications or allegations the use of which in the course of trade is liable to **mislead the public** as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods

Unfair competition

- Protection of competitors
- Protection of consumers

Unfair competition – Different approaches

- Product/Packaging: protection against slavish copy/servile imitation
- Protection for facts distinct from the copy of the product/packaging itself (e.g., way of presenting the product, or copy of a product line)

TRADEMARK

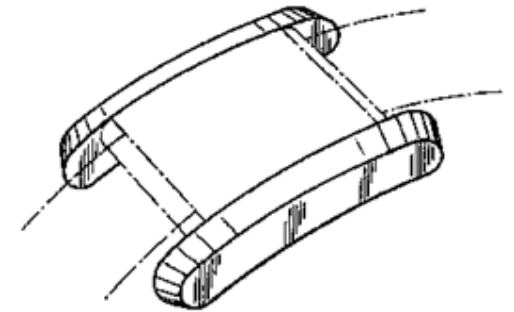
Basic features

- Application (formalities, fees)
- Examination
- Registration
- Publication
- Opposition / Invalidation

Basic features

- A sign **distinctive**
- Where 3D mark can be protected
- Duration of protection: indefinite (renewal + use)

Shape of products/packaging



Conclusion

- Obligation to protect
- Different possible means of protection