Sub-Regional Meeting on Industrial Designs
How to Protect Designs

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Introduction

ONE industrial design
Introduction

DIFFERENT means of protection

- Registered ID?
- Copyright?
- Unregistered ID?
- Unfair competition?
- Trademark?
Example (in Italy)

“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 choose **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)
- c) Turkey
- d) Other countries
“(...) 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")
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
  \textit{(high artistic character)}
Copyright

- if it is the result of a high degree of originality
UNFAIR COMPETITION
Unfair competition

Article 10bis 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