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## STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS

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INDUSTRIAL DESIGNS AND THEIR RELATION WITH WORKS OF  
APPLIED ART AND THREE-DIMENSIONAL MARKS

*Document prepared by the Secretariat*

### INTRODUCTION

1. At the eighth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), held in Geneva from May 27 to 31, 2002, some Members of the SCT expressed interest in having more information on the protection of industrial designs. In particular, the relationship between industrial designs and certain expressions of traditional knowledge, such as works of handicraft, and the difference between industrial designs and three-dimensional marks were mentioned as points of interest. It was suggested that the International Bureau could prepare an information paper on this subject for the ninth session of the SCT.

2. With a view to identifying possible areas of interest for future work of the SCT in respect of industrial designs, and on the basis of the above-mentioned suggestion, the International Bureau has prepared the information paper contained in the Annex to this document. The Annex discusses briefly selected matters relating to the recognition and protection of industrial designs as objects of intellectual property, the relation between industrial designs and other objects of intellectual property, and the main features of the Hague Agreement concerning the International Deposit of Industrial Designs.

3. This document is intended to help the SCT identify and clarify some of the issues connected with the protection of industrial designs and their relation to other objects of intellectual property. It may also facilitate selecting and particular aspects for further analysis by the SCT, should the Committee find it desirable to do so.

4. It is understood that the discussion contained in this document is within the mandate of the SCT. It is not intended to prejudge the work done or planned to be undertaken by other bodies of WIPO within their own purview of competence.

*5. The SCT is invited to comment on the information contained in the Annex to this document and proposes specific areas of interest, if any, for possible future work by the Committee.*

[Annex follows]

## ANNEX

INDUSTRIALDESIGNSANDTHEIRRELATION WITHWORKS  
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## INDUSTRIAL DESIGN AS AN OBJECT OF INTELLECTUAL PROPERTY

### Introduction

1. Intellectual property deals with a broad range of creations of the human mind which often have a high economic relevance when applied in industry and commerce. Although the intellectual creations that constitute the objects of protection under intellectual property are quite varied and generally well-defined, they are confined to those that have achieved legal recognition. Intellectual property is a set of special rights that apply to a defined list of objects of protection (principle of *numerus clausus*).

2. Intellectual property covers objects that range from works of art and other artistic intellectual creations, to technical solutions, to signs and business identifiers used in trade to distinguish persons, goods and services. Industrial designs are a particular object of protection in the intellectual property gamut, and enjoy special recognition and treatment.

### Recognition of Industrial Designs and Works of Applied Art

#### *Special Nature of Industrial Designs*

3. Industrial designs developed into a distinct object of intellectual property because of their peculiar nature aimed at satisfying both aesthetic and functional purposes when incorporated in a tangible product. Industrial designs are at the crossroads of art and technology, since the designers of industrial products strive to create products whose shape or appearance will satisfy the aesthetic preferences of consumers as well as their expectations with regard to the functional performance of those products.

4. Although the design that gives a product its particular shape and aspect will be conceived to meet both functional and non-functional criteria simultaneously, many laws provide that only the non-functional features will be covered by industrial design protection. This reflects different policy options regarding the desirability to give legal protection to, on the one hand, technical achievements and, on the other, aesthetic creations.

5. The functional features of the shape or appearance of a product normally affect the technical performance of that product. To the extent that technical performance depends on such functional features, these features may be regarded as *necessary* from an economic point of view. Such necessity stems from the fact that the product will not perform its function, or will not perform in the same way, if such technical features are not incorporated in the product. For example, an ergonomic curve-shaped computer keyboard is different from a standard rectangular keyboard not only in appearance, but also in the way in which it can be handled and used for its intended purpose (e.g., as regards comfort, speed of typing, etc.).

6. If the shape of a product affects its performance in any material way (as in the foregoing example) that shape may be regarded as being "functional." The functional or technical features embodied in a particular product will normally have an economic impact, either because of savings in the cost of manufacturing or distributing the product, or because of the increased efficiency or performance of that product, which implies added commercial value. For this reason, any restriction on the freedom to copy the functional features of a product will generally affect competition among the producers of that product. To the extent that, from an

economic point of view, competition is desirable and should be encouraged, it would seem to make sense to facilitate the free use of economically -relevant functional features of products, or at least subject any restriction to such freedom to stringent conditions. This rationale underlies the strict requirements found in the law that allow for the establishment of exclusive rights in technical creations, in particular the patent system for the protection of inventions, including utility models. Such restrictions on free copying by competitors may only be obtained on compliance of special conditions, and only for a relatively short period of time.

7. On the other hand, features of the shape or appearance of a product that respond to an aesthetic preoccupation are not regarded as economically critical to the same extent as the functional features of the product. The reason for this is that a variation in the aesthetically-determined features of a particular product will normally not prevent it from functioning and performing as intended. Aesthetic features are not strictly necessary for the product to function; they are *arbitrary* in the sense that they respond to the personal, subjective preferences of the designer or of the public to whom the product is to be presented. For example, most of the features that make various sets of tableware look different are non-functional, since dishes and cups of different sets will normally function in the same way, regardless of their multiple configurations and styles.

8. Unlike the technical features of a product, there does not seem to be any absolute economic necessity for a competitor to copy the non-functional features of a product's appearance, i.e. the product's design. On this basis, it would seem warranted to permit exclusive rights for industrial design to be acquired more easily and for a longer period than exclusive rights in functional features and technical creations.

9. Because industrial designs normally express the personal taste and style of their designers, such creations are in fact akin to works of fine art. Moreover, works of art applied to useful products can in certain cases be assimilated to industrial designs. However, because such artistic expressions are applied to industrial products that perform specific utilitarian functions, industrial designs are also closely linked to technical creations. This dual (aesthetic/functional) nature of industrial design is the basis for their special recognition and autonomous legal treatment as objects of intellectual property.

#### *Definition of Industrial Design in National and Regional Laws*

[National]

10. The specificity of industrial design is well reflected in most definitions of that object in national and regional laws. The following example taken from a sample of national and regional laws help to illustrate this:

*Australia.* A design is defined as features of shape, configuration, pattern or ornamentation applicable to an article, being features that, in the finished article, can be judged by the eye, but does not include a method or principle of construction.<sup>1</sup>

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<sup>1</sup> Design Act (1906), section 4(1).

*Brazil.* An industrial design is defined as the ornamental shape of an object or the ornamental combination of lines and colors that can be applied to a product, to give a new and original visual result in its external configuration and can serve as a model for industrial production. <sup>2</sup>

*Canada.* Industrial design means features of shape, configuration, pattern or ornament and any combination of those features that, in a finished article, appeal to and are judged solely by the eye. <sup>3</sup>

*Costa Rica.* An industrial drawing (“ *dibujo industrial* ”) is defined as any combination of lines and colors, and an industrial model (“ *modelo industrial* ”) as any shape whether or not associated with lines or colors, provided that such combination or shape provides a special appearance to a product of industry or handicraft and can serve as a pattern for their manufacture. <sup>4</sup>

*Japan.* Design means a shape, pattern or color or any combination thereof in an article (including part of an article) which produces an aesthetic impression on the sense of sight. <sup>5</sup>

*Switzerland.* Industrial design is any arrangement of lines or any three-dimensional shape, whether or not combined with colors, that serves as a model for the industrial production of an article. <sup>6</sup>

*United Kingdom.* “Design” means features of shape, configuration, pattern or ornament applied to an article by any industrial process, being features which in the finished article appeal to and are judged by the eye, but does not include:

- a method or principle of construction; or

- features of shape or configuration of an article that are dictated solely by the function that the article has to perform; or are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part. <sup>7</sup>

*United States of America.* The design for an article consists of the visual characteristics embodied in or applied to an article. A design is manifested in appearance, and may relate to

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<sup>2</sup> Industrial Property Law No. 9279 of May 14, 1996, Article 95.

<sup>3</sup> Industrial Design Act (CHAPTER 1-9) 1985, Consolidation of 30/04/1996.

<sup>4</sup> Law on Patents, Industrial Designs and Utility Models, No. 6867 of 1983 (amended by Law No. 7979 of 1999), Article 25.

<sup>5</sup> Design Law, No. 125 of April 13, 1959 (as amended by Law No. 220 of December 22, 1999, entry into force: January 6, 2001), section 2.

<sup>6</sup> Federal Law on Industrial Designs of March 30, 1900, as amended on March 24, 1995, Article 2.

<sup>7</sup> Registered Designs Act 1949 (as amended by the Copyright, Designs and Patents Act 1988), section 1(1).

the configuration or shape of an article, to the surface ornamentation applied to an article, or to the combination of configuration and surface ornamentation.

[Regional]

11. A number of regional intergovernmental organizations have established legal instruments that deal with industrial designs. The following examples illustrate some of the definitions of industrial design found in regional texts.

*African Intellectual Property Organization (OAPI).* <sup>9</sup>The OAPI Agreement <sup>10</sup> provides that any arrangement of lines or colors shall be considered a design (“*dessin*”), and any three-dimensional shape, whether or not associated with lines or colors, shall be considered a model (“*modèle*”), provided that the said arrangement or shape gives a special appearance to an industrial or craft product and may serve as a pattern for the manufacture of such product (Article 1(1) of Annex VI).

*Andean Community.* <sup>11</sup>Decision No. 486 of the Andean Community <sup>12</sup> provides that the particular appearance of a product resulting from any arrangement of lines or combination of colors or any two-dimensional or three-dimensional outward shape, line, outline, configuration, texture or material that does not alter the intended purpose or use of the said product shall be considered an industrial design (Article 113).

*European Union.* <sup>13</sup>The European Directive on the legal protection of designs <sup>14</sup> defines “design” as the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colors, shape, texture and/or material of the product itself

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<sup>8</sup> Manual of Patent Examining Procedure (MPEP) Edition 8, August 2001, Chapter 1500 – Design Patents, section 1502.

<sup>9</sup> The OAPI Agreement binds the following countries: Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Côte d’Ivoire, Democratic Republic of the Congo, Gabon, Guinea, Guinea-Bissau, Mali, Mauritania, Niger, Senegal and Togo.

<sup>10</sup> Industrial designs are dealt with in Annex VI of the Agreement Revising the Bangui Agreement of March 2, 1977, on the Creation of an African Intellectual Property Organization (Bangui, Central African Republic), February 24, 1999.

<sup>11</sup> The Andean Community is comprised of Bolivia, Colombia, Ecuador, Peru and Venezuela.

<sup>12</sup> Decision No. 486, Common Provisions on Industrial Property, of September 14, 2000; *Gaceta Oficial*, September 19, 2000.

<sup>13</sup> The European Union comprises Austria, Belgium, Denmark, Finland, France, Germany, Greece, Ireland, Italy, Luxembourg, Netherlands, Portugal, Spain, Sweden and the United Kingdom.

<sup>14</sup> Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs; Official Journal L289, 28/10/1998, p.28 –33.



and/or its ornamentation (Article 1(a)). The European Regulation on Community designs contains an identical definition (Article 3(a)).

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*MERCOSUR*.<sup>16</sup> The Mercosur authorities adopted a Harmonization Protocol on industrial designs.<sup>17</sup> It establishes that a design may be protected if it is an original creation consisting of a shape or purporting to provide a special appearance to an industrial product, giving it an ornamental character (Article 5).

[WIPO Model Law]

12. The definition of industrial design contained in the WIPO Model Law on Industrial Design is not worthy as an additional reference.<sup>18</sup> The Model Law (Article 2(1)) defines an industrial design as any composition of lines, colors or any three-dimensional form, whether or not associated with lines or colors, provided that such composition or form gives a special appearance to a product of industry or handicraft and can serve as a pattern for such a product.

#### *Common Elements in the Definition of Industrial Design*

13. The legal definitions of industrial design in legal texts such as those quoted above denote a number of common elements that characterize industrial designs as objects of protection. The main such elements may be summarized as follows:

a) *Visibility*. Industrial designs must be perceptible by the sense of sight. Visibility is a condition for recognition of an industrial design. When incorporated in a particular product, the shape or appearance must be visible and capable of being “judged by the sense of sight.” It is also required that the design be visible during normal use of the product by the intended end user. This is relevant to products that change their appearance during normal use. For example, the inside of a suitcase should be regarded as part of the aspect of the suitcase as much as its outside, since both are visible during normal use. Likewise, the shape of a collapsible sofa-bed in both its extended and collapsed positions must be taken into account as the design of the product. Visibility is also relevant in respect of parts and components of larger products, for example spare parts of machines, automobiles or home appliances. In this respect, the European Directive<sup>19</sup> provides that a design applied to or incorporated in a product that constitutes a component part of a complex product shall only be considered to comply with the conditions for protection if the component part, once incorporated into the complex

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<sup>15</sup> Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs; Official Journal L 003, 05/01/2002, p. 1 – 24.

<sup>16</sup> The MERCOSUR Common Market is composed of Argentina, Brazil, Paraguay and Uruguay.

<sup>17</sup> Protocol on the Harmonization of Norms on Industrial Designs, Decision No. 16/98, 10 December 1998. This Protocol has not yet entered into force.

<sup>18</sup> Model Law for Developing Countries on Industrial Designs, WIPO, Geneva, 1970 (Publication No. 808(E)).

<sup>19</sup> European Directive, Article 3.3. An identical provision is found in the European Regulation on Community designs, Article 4.2.

product, remains visible during normal use. It is clarified that “normal use” means use by the end user, excluding maintenance, servicing or repair work. This condition might effectively exclude from design protection the shapes of, for example, parts and pieces of a car engine that are not visible during normal use of the car. e

*Special appearance*. A design gives the product in which it is embodied a special, particular appearance. It makes a useful article look different, more attractive to the prospective consumer or user. This special aspect is achieved by the designer's choices among many possible means and techniques, including shape and contour, volume, colors and lines, materials and texture, and surface treatment.

*Non-technical aspect*. Industrial designs concern only the visible appearance of a product, and not the technical or functional features thereof. Although the overall appearance of a product will be determined as much by function as by aesthetics, only the features of appearance that are not entirely determined by technical constraints may be protected as a design. The appearance of a product may result from effects applied to the surface of the product (two-dimensional features), from the shape of the product (three-dimensional features), or – as is most usual – from a combination of both types of features.

*Embodiment in a utilitarian article*. Industrial designs are conceived to be embodied in utilitarian articles, i.e., in products that have a useful, functional purpose. They are not primarily intended as objects for purely aesthetic contemplation, as would be works of fine arts. The requirement that a design be apt for incorporation in a useful product denotes its ultimate goal, namely, to make a useful product more attractive without impairing the product's ability to perform its intended function. Some laws expressly require that the design serve as a model or type for the manufacture of a product of industry, or that it be industrially applicable. Other laws also mention that designs may also be applied to products of handicraft.

#### *Recognition of Industrial Designs in International Law*

14. Industrial designs and works of applied art are expressly recognized in international law as objects of protection under intellectual property. The main relevant texts in this respect are the Paris Convention for the Protection of Industrial Property (hereinafter “the Paris Convention”), the Berne Convention for the Protection of Literary and Artistic Works (hereinafter “the Berne Convention”), and the Agreement on Trade-Related Aspects of Intellectual Property Rights (hereinafter “the TRIPS Agreement”).

15. Early references to industrial designs in the Paris Convention date back to the original text of 1883 (see Articles 2 and 4). The present text of the Paris Convention (Stockholm Act (1967)), Article 2 paragraph (2), provides that industrial property has industrial designs among its objects of protection. Article 5 *quinquies* of the Paris Convention mandates that industrial designs be protected in all the countries of the Paris Union. Due to the variety of approaches to industrial design protection found in the national laws of Member countries, the Convention does not specify the manner in which that obligation is to be implemented.

However, the Convention contains several provisions relating to specific aspects of industrial design protection which the countries must observe.<sup>20</sup>

16. The Berne Convention contains early references to works of applied arts since the adoption of its Berlin Act in 1908. Article 2 of that Act speaks of “works of art applied to industrial purposes,” requiring that they be protected as far as the domestic legislation of each country so allows. Since the revision in 1948 (Brussels), “works of applied art” are mentioned expressly among the examples of works protected by copyright, contained in Article 2 paragraph (1) of the Convention. Moreover, Article 2 paragraph (5) of the 1948 revision mentions industrial designs alongside works of applied art, and that they should be protected in accordance with the provisions of national law.

17. The present text of the Berne Convention, adopted in Stockholm in 1967 and in Paris in 1971, fixes in Article 7(4) the term of copyright protection of works of applied art at a minimum of 25 years computed from the making of the work. However, any longer term provided in national laws will apply. Furthermore, Article 2(1) and (7) maintain the obligation to protect works of applied art and industrial design under national law. The Convention makes it clear that the obligation to protect works of applied art by copyright is only relevant insofar as such works are regarded as artistic works. However, the determination whether a particular product’s shape or appearance is to be regarded as a “work” for copyright purposes is left to national law and courts. Article 2(7) also deals with the possibility of different protection systems, in that it limits the obligation to protect works of applied art and industrial designs under copyright to cases where they enjoy such protection in their country of origin, unless there is no *suigeneris* protection of designs in the country where protection is claimed.

18. The TRIPS Agreement includes by reference most of the substantive provisions of the Paris and Berne Conventions relating to industrial designs and works of applied art. Moreover, Articles 25 and 26 of the TRIPS Agreement contain additional provisions dedicated to industrial designs, which establish certain standards for their protection.

## INDUSTRIAL DESIGNS AND OTHER FORMS OF INTELLECTUAL PROPERTY

### Works of Art, Applied Art and Handicraft

19. As noted above, several industrial property laws refer to the possibility of recognizing industrial designs not only where they may serve as a type or pattern for the industrial manufacture of a particular product, but also where they may serve as a model for works of handicraft.<sup>21</sup> On the other hand, works of handicraft or artistic craftsmanship may be deemed covered by the broader notion of works of applied art – still broader – simply works of art.

<sup>20</sup> Provisions relating particularly to industrial designs can be found in the Paris Convention, for example, in Article 4 (right of priority), Article 5B (no forfeiture for failure to work), Article 5D (no need to mention deposit details) and Article 11 (temporary protection at international exhibitions).

<sup>21</sup> See, for example, the definitions of industrial design in the law of Costa Rica and in the WIPO Model Law for Developing Countries on Industrial Designs, mentioned earlier.

To the extent that works of handicraft or artistic craftsmanship are works of applied art or works of art, they become objects of copyright protection.

20. However, can industrial designs intended for industrial and consumer products of mass production also be regarded as works of art? The question has for many years been controversial and is still today a disputed matter. However, in a number of cases the question has been responded in the affirmative. An industrial design could be regarded as an artistic expression to the extent that it responds (at least in part) to an aesthetic preoccupation of the designer. A designer's work, like that of any other artist, could be seen as an original expression of the designer's personality.

21. Yet, the fact that an industrial design, even if regarded as an artistic expression, is embodied in the shape of a useful, functional object, raises the need to decide whether only the functional or the artistic aspect of that shape is to be retained for protection under intellectual property, or if both can be retained cumulatively or alternatively.

#### *Overlap with Copyright*

22. The dual nature of industrial designs as functional and aesthetic creations allows at least two modes of protection, namely protection by copyright and protection by a special *sui generis* regime. Depending on whether one or both systems of protection are applicable, alternatively or simultaneously, at least three combinations of protection regimes may be conceived, namely, cumulative or dual protection, separation of protection regimes, and partial overlap of protection regimes.

#### Cumulative Protection

23. Under this approach the copyright regime and the *sui generis* industrial design regime are made to operate simultaneously and independently from each other, automatically overlapping one another. An industrial design will therefore receive protection under both systems, in accordance with the particular rules and conditions that may apply under each of them. The design will receive copyright protection as a work of art (or applied art), and special protection under the *sui generis* designs regime.

24. Cumulative protection is based in a number of countries, in particular France where it was first consolidated, on the theory of *unity of art* (*l'unité de l'art*). This theory recognizes that art may be expressed in many ways, and fixed in any material support. Art is regarded as a unitary concept, and artistic creations should not be distinguished or discriminated on the basis of aesthetic merit or mode of expression. To the extent that a particular work expresses the personality of its creator, it deserves recognition as a work of art. An artistic expression should not be disqualified merely because it is fixed or embodied in a utilitarian article.

25. With cumulative protection, an industrial design (like a work of art) would be protected by copyright as of its creation or fixation in tangible form, as the law may require. Additionally, the same design could benefit from protection under the special law on designs as of the date of registration or deposit of the design, or from the first commercial distribution of the relevant product, where the law provides.

26. Cumulative protection is often implemented by inserting non-preemption clauses in intellectual property laws. Such clauses expressly provide that protection of an industrial

design or of a work of applied art under the applicable law does not preempt or affect protection of the same design or work by other laws that might be applicable. <sup>22</sup> That approach is also suggested by the WIPO Model Law on Industrial Design <sup>s.</sup> <sup>23</sup>

### Separate Protection

27. Contrary to the system of cumulative protection, a separation of protection regimes for industrial designs and for works of art has been proposed. Under this approach, an industrial design (i.e., the design of a useful object) may only be protected as such under the special regime for industrial designs. Industrial designs may not, as a matter of principle, be assimilated to works of art protected by copyright.

28. In countries adopting this approach, for example, the United States of America and (formerly) Italy, <sup>24</sup> copyright protection is reserved exclusively for works of art. Therefore, the overall shape or configuration of utilitarian, industrial or consumer products may not receive copyright protection, regardless of how aesthetically pleasing or valuable that shape or configuration might be. The rationale for this strict separation is to prevent functional (technical) creations from circumventing the stricter conditions required by (in particular) patent and utility model legislation to obtain protection against copying.

29. This exclusion of industrial designs from copyright protection operates on the basis of the notion of “separability” and “independence” of a particular shape or configuration from the product in which it is embodied. In order that the shape or configuration of a product may enjoy copyright protection, that shape or configuration must be capable of being identified separately and exist independently from the functional aspects of the product in which it is embodied. <sup>25</sup> The design must be such that the viewer can conceptually “dissociate” the design from the product in which it is embodied

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<sup>22</sup> Such clauses can be found in industrial design laws and in copyright laws. In respect of industrial designs see, for example: European Directive (Articles 16 and 17), European Regulation (Article 96), OA PIA agreement (Annex IV, Article 1.3), and the design laws of Costa Rica (Article 23.3), Dominican Republic (Article 54.2), El Salvador (Article 124), Guatemala (Article 148), Panama (article 67), Sri Lanka (Article 25), and Uruguay (Article 87). In respect of copyright see, for example, the law of Paraguay (Article 3.3), Spain (Article 3), and United States of America (section 301(d)), although in the latter country dual protection will only apply in respect of works of art whose artistic features are “separable” from their embodiment in a useful article.

<sup>23</sup> See Model Law for Developing Countries on Industrial Designs, WIPO, Geneva, 1970 (Publication No. 808(E)), Section 1(2).

<sup>24</sup> In Italy, the law on industrial designs (Royal Decree 1411 of August 25, 1940), Article 5.2, provided that the provisions of the copyright law were not applicable to industrial designs. This provision banning copyright protection for industrial designs was repealed by Government Decree No. 95/2001 (April 2001), with a view to bringing the country’s law into conformity with the European Directive on industrial designs.

<sup>25</sup> For example, the Copyright Law of the United States of America – USC 17 (section 101 – definition of “Pictorial, graphic, and sculptural works”) provides that “the design of a useful article [...] shall be considered a [copyrightable] work only if, and only to the extent that, such

30. “Separation” or “dissociation” of the design from the object that embodies it would be clearly possible in cases where the object itself was primarily a work of art and was subsequently used as, or applied to, a utilitarian article. For example, a pair of statuettes reproducing two dolphins could be used as a set of salt and pepper shakers. These could be protected by copyright as sculptural works, notwithstanding their utilitarian application as tableware accessories. However, the theory of dissociation will effectively exclude from copyright protection the shape or configuration of most industrial and consumer products, since their shape cannot normally be “separated” or considered independently from the objects themselves.<sup>26</sup> The overall shape of objects such as furniture, household appliances and wearing apparel would consequently not qualify for copyright protection. Those shapes could only be protected as industrial designs under the special laws implemented for that purpose.

#### Partial Overlap

31. A halfway house system between, on the one hand, simultaneous, automatic cumulative protection of industrial designs by copyright law and by a special law on designs and, on the other hand, strict separation of protection regimes, would provide industrial design protection for the shape or appearance of any utilitarian, industrial or consumer products, but allow overlapping copyright protection in case the design can also be considered as a work of art (or of applied art). This system is or was applied, for example, under the Benelux Designs law and in Germany, the Nordic countries (Denmark, Finland, Norway and Sweden) and Switzerland.

32. In practice, however, many of the countries that recognized the possibility of granting copyright protection to the designs of utilitarian products have traditionally been strict about the standard of aesthetic achievement required before a particular shape or configuration can be recognized as a work of art for copyright purposes. For example, the Benelux design law expressly provides that a design that has “a marked artistic character” may be protected both by that law and by the copyright laws of the Benelux countries, if the conditions for the

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[Footnote continued from previous page]

design incorporates [...] features that can be identified *separately* from, and are capable of existing *independently* of, the utilitarian aspects of the article.” Similarly, the Copyright Law of Italy (Law No. 633 of April 22, 1941, as amended by Decree Law No. 154 of May 26, 1997) (Article 2(4)) provides that protection is available for “works of sculpture, painting, drawing, engraving and similar figurative arts [...], even where such works are applied to industrial products, if their artistic value is *distinct* from the industrial character of the product with which they are associated” [emphasis added]. This is referred to as the principle of “*scindibilita*”.

<sup>26</sup> For example, the Manual of Patent Examining Procedures of the United States of America (Edition 8 – August 2001, Chapter 1500, section 1502) provides that a “design is inseparable from the article to which it is applied and cannot exist alone merely as a scheme of surface ornamentation.”

application of both are met. On the other hand, designs that do not have a marked artistic character are expressly left outside the scope of protection by copyright law.<sup>27</sup>

33. In countries adopting this approach, courts often require a high “artistic character” as a condition to protect industrial designs under copyright law. Designs that, in the eyes of the courts, do not have sufficient aesthetic originality or artistic value, may not be regarded as works of art, and cannot enjoy copyright protection. Since the large majority of consumer product designs fail to meet such high standards, overlap and double protection by copyright and industrial design laws might rarely occur in practice. This situation is likely to change to some extent in respect of the European Union countries, since the European Directive on industrial designs requires that industrial designs registered in a country in accordance with the Directive also be eligible for protection under the copyright law of that country. However, the conditions under which this protection is conferred, “including the level of originality required,” would still be determined by each State.<sup>28</sup>

34. Along similar lines, partial overlap of protection regimes may also be made to depend on whether the shape of a useful article is regarded as a work of “handicraft” or “artistic craftsmanship,” or as a work of pure industrial design. For example, under copyright law in the United States of America, works of artistic craftsmanship embodied in useful articles such as tableware, glassware, cutlery and jewelry will receive copyright protection, even if they are or could be protected as designs under the patent law. In respect of such product configurations, overlap of protection would be possible in practice.

## Inventions

### *Functional Shapes of Products*

35. The possibility that an aesthetic concept can be expressed, materialized or fixed in a utilitarian product capable of performing a technical function, means that such product may be regarded simultaneously as a functional device and as a work of art. In turn, this brings up the question of deciding what form of intellectual property is to be applied to such creations. If the shape of a product is devised to perform both a technical function and an aesthetic function, what form of intellectual property is appropriate to protect that shape from unauthorized copying?

36. Inventions - understood as products and processes that contribute technical solutions to defined practical problems - have for centuries been dealt with under special rules. Modern patent laws have consolidated and standardized those rules aimed at protecting inventions in a way that balances the interests of inventors and those of competitors and the public. Because access to state-of-the-art technology is critical to the development of economies and necessary to sustain a continued improvement of living standards, public policy is especially

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<sup>27</sup> Uniform Benelux Designs Law (Annex to the Benelux Designs Convention, Brussels, October 25, 1966), Article 21.

<sup>28</sup> Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs, Article 17. A substantially identical provision is found in the European Regulation on community designs, Article 96.2.

strict when it comes to granting exclusive rights to inventions and technical solutions. Patent rights that protect inventions from unauthorized commercial exploitation are only granted for a relatively short period of time, and only if strict formal and substantive conditions are complied with.

37. The rationale for the protection of works of art and other aesthetic and artistic contributions, including the aesthetically pleasing aspect of industrial products, is different from that of the patent system. Generally, the critical public necessity to access technology at the earliest possible time compatible with a reasonable economic incentive to innovate, does not seem to exist in respect of works of art, nor with the aesthetic aspect of product designs. Consequently, the conditions for the protection of such aesthetic non-functional contributions may be made less stringent, and the duration of protection may be made longer.

38. The different policy rationale behind the protection of inventions, on the one hand, and of aesthetic contributions, on the other, explain the clear separation that subsists between the protection regimes for one and the other. Unlike the relationship between the industrial design and the copyright regimes, no overlap or cumulative protection under those regimes is possible for purely technical creations. This radical separation of the patent system from other intellectual property regimes shows in two important ways, namely, the preemption of those other regimes by patent law when it comes to protecting technical creations, and the confinement of industrial design protection to the non-technical, non-functional aspects of a product's configuration.

39. *Preemption.* It appears to be a generally accepted principle that, in respect of inventions, patent protection preempts any other form of protection under intellectual property.<sup>29</sup> This means that an invention (i.e. the technical contribution claimed by the inventor) can only be protected against unauthorized copying by taking out a patent of invention with the effect in the jurisdiction where copying is to be prevented. Failure to take out a patent cannot be offset through other means of protection since, in principle, other forms of intellectual property will not apply to inventions of a strictly technical nature.<sup>30</sup>

40. For example, a cutting tool that offers improved efficiency, performance and durability on account of its particular shape or configuration, could be patented as an invention. That special shape or configuration produces a technical effect, and can therefore be said to provide a technical solution to overcome the shortcomings of earlier cutting tools. However, if the inventor of that tool does not apply for and obtain a patent for his or her invention, he or she will not be able to rely on other means of intellectual property to prevent third parties from manufacturing and distributing the same tool.

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<sup>29</sup> For the purposes of this document, unless otherwise specified, “invention” includes utility models, since these are also technical solutions where in the solution is provided by the shape or configuration of the product. Likewise, unless otherwise specified, “patent” covers other equivalent titles of protection for inventions and utility models, such as utility certificates, petty patents, short-term patents and the like.

<sup>30</sup> New varieties of plants and the layout designs (topographies) of integrated circuits may also be regarded as “inventions” to the extent that they are “technical solutions.” However, for those special objects of protection *suigeneris* systems have been established.



41. Copyright protection does not cover product inventions because an invention will normally not be regarded as an artistic expression, a reflection of the “author’s personality.” Rather, such product would be regarded as a solution created (invented) to respond to a specific technical or functional challenge, and not to express an aesthetic preoccupation.

42. Likewise, industrial design laws might not allow an inventor to claim a purely technical solution under the guise of a simple product configuration. The protection afforded to the design of a product will often only cover its outward appearance, to the extent that such appearance is not functionally necessary. If the shape of a product invention turns out to be *entirely* or *solely* determined or dictated by technical function, such that no freedom of design is expressed in the configuration of the product, industrial design protection for that configuration may be foreclosed. This rule, based on the principle of preemption by the patent system, is expressed in a number of industrial design laws.<sup>31</sup> Of course, a different rule applies if the design law is expressly intended to cover also purely functional designs.<sup>32</sup>

43. The principles of marks and other distinctive signs exclude functional and technical shapes from recognition or protection as marks. This also responds to the patent preemption policy in respect of technical creations, and is intended to prevent circumvention of the patent system as the only means to attain exclusive rights for such creations. Failing such preemption, a particular technical feature or a functional product configuration could be claimed and registered as a mark and retained indefinitely under private control. The functional character of a product’s shape and the need to access functional configurations for competition purposes, are mentioned in several trademark laws as absolute grounds for refusal (or invalidation) of a mark’s registration.<sup>33</sup> Moreover, in certain jurisdictions, for example the United Kingdom and the United States of America, a functionality doctrine has been affirmed

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<sup>31</sup> Provisions in this respect may be found, for example, in the Andean Community Decision No. 486 (Article 116.b), and in the industrial design laws of Argentina (Article 6.c), Dominican Republic (Article 54.2), France (Article L.511-3(2)), Honduras (Article 29.3), Mexico (Article 31.4), and Turkey (Article 10.1).

<sup>32</sup> For example, the Designs Act of Australia (section 18.1) provides that an application for registration of a design shall not be refused, and a registered design is not invalid, by reason only that the design consists of, or includes, features of shape or configuration that serve, or serve only, a functional purpose. Such was also the declared purpose of the Nordic design laws of 1970/1971.

<sup>33</sup> See, for example: European Directive on marks (First Council Directive of 21 December 1988 –89/104/EEC), Article 3.1(e); European Regulation on the Community trademark (Council Regulation No. 40/94 of 20 December 1993), Article 7.1(e)(ii); Andean Community Decision No. 486, Article 135.c and d); and the trademark laws of Brazil (Article 124(XXI)), Bulgaria (Article 11(1)5(b)), Canada (section 13), Costa Rica (Article 7.a and b)), Czech Republic (Article 2(1)(e)), Dominican Republic (Article 73.1.a and b)), El Salvador (Article 8.a and b)), Guatemala (Article 20.b and c)), Honduras (Article 83.1 and 2)), Hungary (Article 2.2.b)), Latvia (Article 6.1(5)), Mexico (Article 90(iii)), Nicaragua (Article 7.c and d)), Panama (Article 91(14)), Paraguay (Article 2(c)), Romania (Article 5(e)), South Africa (section 10(5) and (11)), Sri Lanka (section 99(1)(a)), Switzerland (Article 2.b), and Turkey (Article 7(e)).

by jurisprudence, to the effect that functional shapes of products may normally not be protected as marks.

44. *Scope of industrial design protection*. Industrial designs are protected in respect of the overall configuration of utilitarian products. Because such products have a functional purpose, their configuration and appearance will necessarily evidence an inextricable combination of functional (technical) and non-functional (aesthetic) features. As mentioned earlier, those different features cannot be separated from the object in which they are embodied.

45. However, although a design is protected as a whole, for the totality of its visible features, actual protection in terms of what the design right holder may prevent third parties from copying, is limited to the features and elements of a non-functional nature. This limited scope of protection is consistent with the above-mentioned preemption principle and the limited object of design protection. Since the features of a design that are determined only by function, or respond only to technical constraints, may not be claimed and exempted from the public domain other than through the patents system, design rights may not extend to those features. In case of dispute, where a defendant's product configuration is alleged to be a copy of the plaintiff's design, the competent authority may have to identify the features or elements of appearance that cause the identity or similarity. If such identical or similar features or elements are functional and technically necessary, they would not be covered by the design right. Furthermore, if those functional or technical features are not covered by a valid patent of invention, third parties may not be joined from copying those features.

46. Provisions that expressly exclude from the scope of industrial design protection any technical or non-functional features of the product's configuration can be found in several industrial design laws.<sup>34</sup>

## Marks

### *Three-dimensional Marks*

47. Overtime, the concept of "mark" as an object of intellectual property, and the types of signs that may be used and recognized as marks, have expanded considerably. It is now a broadly accepted standard that any sign capable of distinguishing goods or services in the marketplace may, in principle, constitute a valid mark.<sup>35</sup> Some laws require that the sign be

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<sup>34</sup> See, for example: European Directive on designs (Article 7.1), European Regulation on designs (Article 8.1), Andean Community Decision No. 486 (Article 130.1), OAPI Agreement (Annex IV, Article 1.3), and the industrial design laws of Canada (section 5.1(a)), Dominican Republic (Article 60.2), El Salvador (Article 123.2), Guatemala (Article 149.a)), Honduras (Article 31.3), Mexico (Article 31.3), Panama (Article 66.2).

<sup>35</sup> The TRIPS Agreement (Article 15.1) provides that "a sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark."

capable of being represented graphically. Stricter laws may require that the sign be visually perceptible.<sup>36</sup>

48. The aforementioned broad definition of mark effectively allows three-dimensional signs to be recognized as marks, if they otherwise comply with the applicable conditions for protection. Moreover, three-dimensional signs, in particular the shapes of products (or parts thereof), or their packaging or containers, are expressly mentioned in many trademark laws among the signs that may be registered as marks.<sup>37</sup>

49. Recognition and protection of any sign as a mark is conditional on the fundamental requirement that the sign be distinctive, i.e. capable of distinguishing the goods or services to which it applies. For a mark to be “distinctive,” it must convey (at least to the targeted consumers) the notion that the products (or services) bearing that mark have been put on the market by, or under the authority of, a particular commercial entity. A mark must be capable of indicating to the public that all the products distinguished by the mark have a common commercial origin or sponsorship. This condition must be complied also by three-dimensional devices, if they are to benefit from protection as marks.

50. The possibility of registering the shape of products, packaging and containers as marks, raises the question of how to differentiate the three-dimensional marks from regular industrial designs, which may also be embodied in products, packaging and containers. But, can the same shape or configuration be protected simultaneously or successively as an industrial design and as a mark? Is this type of cumulative protection possible?

#### *Purpose of Designs and Marks*

51. Industrial designs and marks have different roles to play in the economy, and are consequently protected as intellectual property for different reasons.

52. The function of industrial designs is to make utilitarian, industrial and consumer products more pleasing to the eye, i.e., more aesthetically attractive to prospective buyers. Beauty of appearance adds not only aesthetic value but also commercial value to any product. That value becomes real when an article, for example a wristwatch, embodying a particular design can command a higher market price than a functionally identical watch having a different shape or aspect.

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<sup>36</sup> This seems to be the most restrictive standard permitted by the TRIPS Agreement (Article 15.1).

<sup>37</sup> See, for example: European Directive on marks (Article 2), European Regulation on Community trademarks (Article 4), Andean Community Decision No. 486 (Article 134.f), OAPI Agreement (Annex III, Article 2.1), and the trademark laws of Belarus (Article 1.2), Bulgaria (Article 9.1), Costa Rica (Article 3.1), Czech Republic (Article 1), Dominican Republic (Article 72.1), El Salvador (Article 4.1), Estonia (Article 6.1), Guatemala (Article 16.1), Honduras (Article 82.1), Hungary (Article 1.2.d), Latvia (Article 3.3), Mexico (Article 89(ii)), Nicaragua (Article 3.1), Norway (section 1.2), Panama (Article 90.4), Paraguay (Article 1), Poland (Article 4.2), Romania (Article 3(a)), South Africa (section 2(x)), Switzerland (Article 1.2), Trinidad and Tobago (section 2(1) - “mark”), Turkey (Article 5), and Ukraine (Article 5.2).

53. The protection of industrial designs against unauthorized copying is predicated on the same basis that justifies the protection of literary and artistic works, and of new technical utilitarian products and processes: to encourage human effort and the flow of financial resources toward the creation of new works of art, product designs and inventions. From an economic stance, the incentive operates by giving the author, designer or inventor legal recourse to prevent third parties (mainly competitors) from copying, using or otherwise exploiting the object of protection. Because copyrights, design protection and patents block competitors from freely making, using or selling the products that embody the protected work, configuration or invention, these intellectual property rights have been likened to “monopoly” rights. They are typically characterized by having a limited duration in time, and when their term expires the protected object falls permanently into the public domain.

54. Protecting marks and other distinctive signs by intellectual property has a different purpose because the functions of marks differ from those of industrial designs. Distinctive signs are business identifiers. They serve to identify and distinguish businesses, activities, goods and services operating or circulating in commerce. Through advertising and publicity, distinctive signs convey information about the identity and quality of the undertakings, products and services for which they are used. Distinctive signs are the means by which companies attach customer demand for their goods and services.

55. Distinctive signs in general, and marks in particular, are necessary to maintain transparent and loyal relations between commercial undertakings in highly competitive markets. Marks allow consumers to select and buy the products and services they want, on the basis of their preferences. In turn, this will help the public’s preferred suppliers, products and services to prevail in the marketplace. Marks and other distinctive signs are therefore necessary for the proper functioning of market economies. To the extent that it is a declared public policy goal to maintain and encourage transparency and competition in the marketplace, there is a corresponding public interest to protect distinctive signs so they may accomplish their function and help attain that goal.

#### *Cumulative Protection*

56. The rule of preemption that bars technical and functional creations from obtaining exclusive intellectual property rights other than through the patent (or equivalent) system, does not apply in respect of non-technical creations. Cumulative protection by copyright and industrial design rights is therefore possible for the non-functional features of product configuration. Likewise, the shape of a product may theoretically enjoy overlapping protection as an industrial design and as a (three-dimensional) mark. However, for this to happen, the shape in question must be capable of functioning as a mark, i.e., it must allow consumers to distinguish goods on the market.

57. For a product shape or configuration to function as a mark it must, in and of itself, be recognized by consumers as indicating a particular commercial origin or sponsorship. The shape of the product must not only provoke aesthetic empathy in a prospective buyer (e.g., the reasoning “I like the style of this couch better than the others and it matches the wall paper at home, so I’ll buy it”). It must also convey the information that all the products having that particular shape have been manufactured by, or under license from, a particular (albeit anonymous) entity. For example, a chocolate or confectionery product shaped as a triangular-section bar may be recognized by consumers as a particular chocolate, that they

distinguish from other chocolates that do not have that shape. Because the product's shape allows it to be distinguished from competing products on the market, that shape operates as a mark and could be protected as such. sasa

Table 1. Main differences between Industrial Designs and Three-dimensional Marks	
Industrial Designs	Three-dimensional Marks
1. Purpose: Encourage creativity in new product designs and investment to produce innovative consumer goods that incorporate those designs	1. Purpose: Promote transparency and facilitate competition in the marketplace and allow consumers to focus their demand more efficiently
2. Function: Make goods aesthetically pleasant and functional for consumers, in order to increase their commercial value	2. Function: Allow consumers to distinguish goods bearing the mark from other equivalent, competing products
3. Overlap: Cumulative protection possible (under certain laws) as works of art and (if sufficiently distinctive) as marks, only in respect of non-functional features	3. Overlap: Cumulative protection possible (under certain laws) as works of art and (in certain cases) as industrial designs, only in respect of non-functional features
4. Scope: The holder of design rights can prevent manufacture and distribution of any product embodying the design ("monopoly" effect)	4. Scope: The holder of rights in a mark can only prevent unauthorized use of the mark in connection with the specified goods, but cannot prevent manufacture and distribution of such goods if that mark is not used
5. Duration: Exclusive rights in a design are limited in time, usually between 10 and 25 years from registration or deposit	5. Duration: Exclusive rights in a mark may be unlimited in time if the mark's registration is renewed periodically and/or the mark is properly used in trade as required

58. Recognition of product shapes and packaging as marks is a matter of perception, and often requires consumer education. The shape of a product may have intrinsic or acquired distinctiveness as a mark, although with most shapes it is likely to be the latter. Advertising and publicity will inform the public that a particular shape is not accidental but rather a mark used by a particular undertaking to distinguish its goods. In principle, as soon as a product's shape unequivocally conveys to the consumer the notion that the product has a distinct commercial origin, and the shape is not perceived merely as product style, that shape should be entitled to protection as a mark.

59. It is therefore not impossible that, although the shape or configuration of a particular product was originally intended as an industrial design, it is subsequently retained and developed into a mark for that product. In this case, the shape or configuration would enjoy cumulative protection under design law and protection under the law on marks as of the time it acquires sufficient distinctiveness. <sup>38</sup>

<sup>38</sup> It is noted that original figurative devices, three-dimensional shapes and combinations of both can be regarded as works of pictorial, graphic or sculptural art, even if they are originally

60. Unlike industrial design rights, rights in a mark may be extended indefinitely in time, through continuous use to distinguish goods or services on the market, and periodic renewal of the mark's registration. Such perpetual exclusive rights in marks are not, however, detrimental to competition, since it is not necessary to copy or use someone else's mark to be able to produce and sell the same goods competitively.

61. Appendix I to this document contains selected examples of industrial design taken from the "International Designs Bulletin"/" *Bulletin des Dessins et Modèles Internationaux* ". Appendix II to this document contains selected examples of three dimensional marks taken from the "WIPO Gazette of International Marks"/" *Gazette OMPI des Marques Internationales* ". Both periodicals are regularly distributed by the International Bureau of WIPO under the Hague Agreement and under the Madrid Agreement and Madrid Protocol, respectively.

## *SUI GENERIS* PROTECTION OF INDUSTRIAL DESIGNS

### Acquisition of Exclusive Rights in Industrial Designs

62. As mentioned earlier, industrial designs have for over a century been recognized independent status among the objects of intellectual property, both under national laws and international agreements. That status is reflected in the fact that most countries in the world nowadays have enacted legislation to provide *suigeneris* protection for industrial designs. However, notwithstanding the state of modernization of many national laws on industrial design since the mid-1990's, and the significant harmonization that this process has entailed, considerable differences still subsist at the national level in the treatment of industrial designs as intellectual property. Many such discrepancies are due to different historical legal traditions and the inherent complexity resulting from the dual nature of industrial designs as functional and aesthetic creations.

63. One aspect in which those differences are relevant is the manner in which exclusive rights are acquired in an industrial design. While most *suigeneris* industrial design laws adopt systems of formal registration or deposit of designs, those systems present many variations. On the other hand, systems have been maintained or newly implemented to allow for exclusive rights in industrial design to be acquired without any formal procedure. Some of these points are discussed in the following paragraphs.

### *Acquisition of Rights by Registration or Deposit*

64. Most industrial property legislations establish procedures and formalities to register or deposit industrial designs. Depending on the particular approach adopted, formalities can be reasonably light or fairly cumbersome. In laws that have opted for a patent-type approach to the protection of industrial designs, registration procedures are lengthy, detailed and generally

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[Footnote continued from previous page]

created or subsequently used as a mark to distinguish goods or services. In this respect, a particular creation could receive cumulative protection as a work of art and as a mark. However, this type of overlap is not within the intended purview of this paper.

more expensive. Those procedures may include one or more of a formal filing of an application, an examination for compliance with formalities, a search for prior art or conflicting rights, a substantive examination of the design, a publication of the application, and the possibility for third parties to file oppositions against the registration.<sup>39</sup> The cost of acquiring protection under a fully fledged procedure of that type can be relatively high, and (failing subsidized fees) could effectively act as a disincentive to register industrial designs. That disincentive is compounded greatly if the procedure only admits one design per application, as is sometimes the case.

65. With a view to making registration of industrial design easier and cheaper, many laws have implemented lighter, more economical procedures. In some cases these are simplified versions of earlier patent-type procedures. For example, the system may omit any substantive examination of the application,<sup>40</sup> eschew prior art searches,<sup>41</sup> or obviate pre-registration opposition proceedings.<sup>42</sup> In other cases the system derives from a copyright-type approach to industrial design recognition, and operates on the basis of a simple deposit and publication of the design.<sup>43</sup>

#### *Acquisition of Rights by Other Means*

66. Exclusive rights in an industrial design may, under certain laws, also be acquired on the basis of original creation of the design, or first fixation or embodiment of the design in a product or in a document.<sup>44</sup> Such systems plainly adopt the basic principle of copyright law, whereby exclusive rights are generated upon creation of a literary or artistic work, without any formality or procedure. These systems have the clear advantages of simplicity and economy, since there is no initial cost to obtain exclusive rights. Arguably, one disadvantage of those systems would come from the need to prove authorship and entitlement at the time of litigation proceedings. Registration of a design, or even a simple deposit thereof, would help by establishing a rebuttable presumption of ownership in favor of the rightholder.

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<sup>39</sup> Design registration systems that include a substantive examination (with or without a prior art search) may be found, for example, in the Andean Community Decision No. 486, and in the laws of Australia, Austria, Canada, Mexico, the Nordic countries (Denmark, Finland, Norway, Sweden), South Africa, United Kingdom (in respect of “registered designs”), and United States of America (in respect of “design patents”).

<sup>40</sup> For example, the European Regulation on Community designs and the laws of Argentina, Brazil, Italy.

<sup>41</sup> For example, the Andean Community Decision No. 486.

<sup>42</sup> For example, the European Regulation on Community designs and the laws of Brazil and Italy.

<sup>43</sup> For example, the OAPI Agreement and the laws of the Benelux, France, Germany, Switzerland.

<sup>44</sup> For example, the European Regulation on Community designs in respect of “unregistered designs,” and the law of the United Kingdom in respect of “design rights” under the copyright law.

67. A degree of formality - free exclusivity in the exploitation of a product design may also be attained through the law on the repression of unfair competition. Notwithstanding the principle that any creation that is not covered by copyright, a design right or a patent is in the public domain and hence free for anyone to copy, in certain cases unfair competition principles may be invoked to prevent copying. In particular, slavish or systematic imitation of a competitor's products in a manner that may be regarded by a competent authority as contrary to honest commercial practices, could be enjoined. Distinguishing fair competitive copying from unfair slavish or parasitic imitation is not easy. However, certain unfair competition laws<sup>45</sup> and court decisions may effectively allow an unregistered product configuration to be protected against unauthorized copying.

## OPTIONS FOR AN INTERNATIONAL PROTECTION OF INDUSTRIAL DESIGNS

### Regional Systems

68. A number of regional systems for the registration or deposit of industrial designs have been established, aimed at facilitating the protection of designs on the basis of a simplified, centralized procedure, and in some cases also harmonized substantive procedures. The following paragraph lists some examples of such regional systems.

#### *African Regional Industrial Property Organization (ARIPO).*<sup>46</sup>

69. The Harare Protocol<sup>47</sup> concluded among the Members of ARIPO establishes a system for granting patents of inventions and registering industrial designs. The Protocol empowers the ARIPO Office at Harare (Zimbabwe) to register industrial designs. The system operates on the basis of a notification of the application by the Office of ARIPO to the Contracting States designated in the application. The designated States may, within six months of the notification, inform the Office that they will not recognize protection for the design if it were to be registered. The grounds for refusal of protection are laid down in the Protocol. After expiration of six months, the Office of ARIPO proceeds to register the design with effect in those countries that did not communicate a refusal of protection. The Protocol does not establish a definition of industrial design, and does not contain substantive provisions on the scope of rights in industrial designs. These matters, as well as proceedings for the invalidation of the registration, are left to the laws and competent authorities of the Contracting States.

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<sup>45</sup> See, for example, the law on unfair competition of Colombia (Article 14), Spain (Article 11), Peru (Article 13) and Switzerland (Article 5.c).

<sup>46</sup> The African Regional Industrial Property Organization (ARIPO) binds the following countries: Botswana, The Gambia, Ghana, Kenya, Lesotho, Malawi, Mozambique, Sierra Leone, Somalia, Sudan, Swaziland, Tanzania, Uganda, Zambia, Zimbabwe.

<sup>47</sup> Protocol on Patents and Industrial Designs within the Framework of the African Regional Industrial Property Organization (ARIPO), adopted on December 10, 1982, at Harare (Zimbabwe), and last amended on November 26, 1999. ARIPO has also issued Regulations for Implementing the Protocol on Patents and Industrial Designs. They entered into force on April 25, 1984, and were amended last on November 27, 1998.



*African Intellectual Property Organization (OAPI)* <sup>48</sup>

70. The OAPI Agreement <sup>49</sup> establishes an Organization mandated to, *inter alia*, register industrial designs submitted directly or through the competent national authority of a Member State. The Agreement and its regulations contain both substantive and procedural provisions for the protection of industrial designs. The Organization, based in Yaounde (Cameroon), examines each application as to form, and registers and publishes the deposited designs. The registration of an industrial design by OAPI has unitary effect in all the Contracting States sas from the date of deposit. Registration may be extended up to 15 years from the date of deposit. An OAPI design registration may be declared invalid, with effect in all the OAPI Member States, by decision of a competent judicial authority in any of those States.

*Benelux* <sup>50</sup>

71. The Benelux countries have concluded a Convention on designs, <sup>51</sup> which establishes a single Benelux Designs Office for the three Benelux countries, and adopts a common Uniform Benelux Designs Law for those countries. The system is based on the deposit, registration and publication of industrial designs by the Benelux Office, subject only to an examination as to formalities. A registered design has unitary character and is effective throughout the territory of the Benelux. The rights may be extended up to 15 years counted from the date of deposit, and may be invalidated by the competent judicial authorities of any of the three countries, with effect in all of them.

*European Union*

72. The European Union has adopted a Regulation on Community designs <sup>52</sup> that implements a system for the protection of unregistered designs and for the registration of industrial designs, for the entire territory of the European Union. The industrial design rights conferred under the Regulation have unitary character and may only be invalidated and assigned as a whole for the entire Union. The Regulation contains detailed substantive and procedural provisions, and calls for Member States to designate Community design courts of first and second instance in each State, to have jurisdiction over cases dealing with the infringement and the validity of Community designs. Applications for the registration of

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<sup>48</sup> The OAPI Agreement binds the following countries: Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Côte d'Ivoire, Democratic Republic of the Congo, Gabon, Guinea, Guinea-Bissau, Mali, Mauritania, Niger, Senegal and Togo.

<sup>49</sup> Bangui Agreement of March 2, 1977, on the Creation of an African Intellectual Property Organization (Bangui, Central African Republic), as revised in Bangui, February 24, 1999.

<sup>50</sup> The Benelux comprises Belgium, Luxembourg and the Netherlands.

<sup>51</sup> Benelux Designs Convention, Brussels, October 25, 1966

<sup>52</sup> Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs; Official Journal L 003, 05/01/2002, p. 1 to 24.

designs are filed with the Office for the Harmonization of the Internal Market (OHIM), located in Alicante (Spain).

International Protection: the Hague Agreement <sup>53</sup>

73. With a view to facilitating the protection of industrial designs internationally, a system providing for an international registration of industrial designs with effect in many countries was established by the Hague Agreement Concerning the International Deposit of Industrial Designs. This treaty was concluded in 1925. It entered into force in 1928, and has been revised at various times, in particular at London (1934 Act), at The Hague (1960 Act) and at Geneva (1999 Act). The system is administered by the International Bureau of WIPO, which maintains the International Register and publishes the *Bulletin des dessins et modèles internationaux/International Designs Bulletin*.

74. The international registration or deposit of an industrial design may be governed by the provisions of the 1934 Act, those of the 1960 Act, or both. At present, the vast majority of international deposits are governed exclusively or partly by the 1960 Act. For example, out of the 4334 international deposits made in 2000, only 210 were governed exclusively by the 1934 Act. Unless otherwise specified, this document reflects the provisions of the 1960 Act.

75. The States party to the Agreement constitute a special union, called the Hague Union. Accession to the Hague Agreement and participation in the Hague Union do not entail any financial obligation for the acceding States since the Union is financed by the fees paid by depositors and owners of international deposits.

*Objectives and Use of the International System*

76. The system for the international deposit of industrial designs has two main objectives. Firstly, it offers the possibility of obtaining protection for industrial designs in a number of States through a single deposit made with the International Bureau of WIPO. Secondly, by having a single deposit with effect in several countries, the subsequent management of the protection obtained is also made much easier. For instance, there is only one renewal procedure to follow, and changes regarding the registered design can be recorded in the International Register through a single simple procedural step.

77. International deposits may be made only by a natural person or legal entity having a real and effective industrial or commercial establishment or domicile in, or being a national of, one of the States party to the Hague Agreement.

78. Protection can be obtained only in those States which are party to the same Act as the State with which the applicant has a necessary connection to make an international deposit. For example, if the applicant has a connection with a State bound only by the 1934 Act, he will obtain protection only in those States which are bound by the 1934 Act, whether they are also bound by the 1960 Act or not. If the applicant has a connection with a State bound only

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<sup>53</sup> Further details on the Hague Agreement may be found in WIPO publication "The Hague Agreement Concerning The International Deposit Of Industrial Designs: Objectives, Main Features, Advantages" (No. 453 (E)).

by the 1960 Act, he will be able to obtain protection, by designating them, in those States which are bound by the 1960 Act, whether they are also bound by the 1934 Act or not. If the applicant has a connection with a State bound by both Acts, he will be able to obtain protection in all member States of the Hague Union.

79. Protection for a design may also be obtained in the State of origin of the applicant<sup>54</sup> by means of an international deposit, unless the domestic legislation of that State does not permit it.<sup>55</sup>

### *The International Deposit*

80. An international deposit of an industrial design does not require any prior national deposit. An industrial design can therefore be deposited and protected for the first time at the international level through the Hague Agreement.

81. The international deposit is normally made directly with the International Bureau of WIPO, by the depositor or his representative, on a form provided by the International Bureau. The deposit may also be made through the national Office of a Contracting State if such State so permits.<sup>56</sup> However, a State may require that, where it is considered to be the State of origin, the deposit be made through its national Office.

82. An application for international deposit must contain the designation of the article or articles in which it is intended to incorporate the designs, and a reproduction (photograph or graphic representation) of each design or each article deposited. An international deposit may include up to 100 designs. All the designs in a deposit must be intended to be incorporated in articles included in the same class of the International Classification of Industrial Designs (Locarno Classification).

83. The working languages of the Hague Agreement (1960 Act) are English and French. An international deposit may thus be made in either of the two languages.

84. An international deposit is subject to the payment of fees, in Swiss francs. The fees for a deposit governed exclusively or partially by the 1960 Act consist of the following:

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<sup>54</sup> “State of origin” means the Contracting State in which the applicant has a real and effective industrial or commercial establishment or, if the applicant has such establishments in several States, the Contracting State which he has indicated in his application; if the applicant has no such establishment in any Contracting State, the Contracting State in which he has his domicile; if he has no domicile in a Contracting State, the Contracting State of which he is a national.

<sup>55</sup> According to the information available to the International Bureau, Hungary is the only country that does not allow itself to be designated in an international deposit for which it is the State of origin.

<sup>56</sup> According to the information available to the International Bureau, Benin, Bulgaria, Greece, Hungary, Italy, Liechtenstein, Mongolia and Switzerland allow an international deposit to be made through their national Offices.

- an international deposit fee (comprising a basic fee for one industrial design and a further fee for each additional design included in the same deposit) which covers the costs of the International Bureau in administering the Designs Registry;
- a publication fee (which is greater where there are reproductions of the design in color);
- fees for each Contracting State designated (State fees).

85. The Agreement provides for two State fees — the ordinary State fee and an additional State fee which is payable for a designated Contracting State that has a novelty examination<sup>57</sup>. The State fees are distributed each year among the Contracting States. For the year 2000, 2.3 million Swiss francs were collected and distributed by the International Bureau.

86. The International Bureau checks that the application for international deposit complies with the requirements of the Agreement and the Regulations, including requirements relating to the photographs or graphic representations, and that the required fees have been paid. The depositor is informed of any defects; these must be corrected within three months, otherwise the international deposit will be declined. This is solely a formal examination; the International Bureau of WIPO does not appraise in any way the novelty of the designs and it is their *ex officio* right to reject a deposit on this or any other substantive ground.

87. Where the international deposit complies with the applicable requirements, it will be recorded in the International Register and published in the *International Designs Bulletin*. This publication, which is made on CD-ROM only, comprises a reproduction of the deposited photographs or graphic representations. Copies of the Bulletin are sent to the national Office of each Contracting State.

88. The applicant may request that the publication be deferred for a period which may not exceed 12 months as from the date of the international deposit (where priority is claimed) from the priority date.

#### *Possibility of Refusal*

89. Under the 1960 Act, the Office of a Contracting State whose domestic legislation provides for an administrative examination *ex officio* or for opposition by third parties may notify the International Bureau that it refuses to grant protection to an industrial design on the ground that it does not meet the requirements of that domestic law. However, protection may not be refused on the grounds of non-compliance of the international deposit with formal requirements, since all such requirements must be considered by each Contracting State as having been complied with in the international procedure.

90. Any refusal of protection must be notified to the International Bureau within six months of the date on which the national Office receives the Bulletin in which the international deposit is published. The depositor has the same remedies against the decision of refusal as he would have had if he had deposited the design concerned directly with the national Office that issued the refusal. An appeal against a refusal must be submitted to the competent

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<sup>57</sup> At present, the State novelty examination fee is payable in respect of a designation of Bulgaria, Hungary, the Republic of Moldova or Romania.

authority of the country concerned within the time limit and in accordance with the conditions set out by the corresponding national legislation. The ensuing procedure takes place solely at the national level and before the competent national authorities. In practice, refusals are extremely infrequent. Only approximately fifteen are received each year by the International Bureau.

#### *Effects of the International Deposit*

91. If no refusal is notified within the prescribed time limit, the international deposit will have effect in that Contracting State as from the date of that deposit. However, in the States in which the national legislation provides for a novelty examination, the starting point of the protection may, according to the national legislation, be later than the date of deposit.

92. An industrial design that is the subject of an international deposit enjoys, in each of the States concerned which has not refused protection, the same protection as is conferred on industrial designs by the law of that State.

#### *Term of Protection*

93. International deposits governed by the 1960 Act are made for an initial period of five years. They can be renewed for an additional period of five years, for all or some of the designs included in the deposit and for all or only some of the States in which it has effect (the minimum period of protection is therefore 10 years). Furthermore, if the domestic legislation of a Contracting State provides for a term of protection of more than 10 years for industrial designs that have been the subject of an international deposit, the international deposit may be renewed in respect of that State for an additional period of five years and up to the expiry of the total term of protection allowed for international deposits.

#### *Advantages of the System*

94. The international deposit of industrial designs arose from a need for simplicity and economy. Nationals and residents of, or companies established in a State party to the Hague Agreement are able to obtain protection for their designs in a number of States with a minimum of formalities and expense. In particular, they are relieved of the need to make a separate national deposit in each of the States in which they require protection, thus avoiding the complications arising from procedures which differ from State to State. They do not have to submit the required documents in various languages nor keep a watch on the deadline for renewal of a whole series of national deposits, varying from one State to the other. They also avoid the need to pay a series of fees in various currencies. Under the Hague Agreement, the same result can be obtained by means of a single international deposit, made in one language, on payment of a single set of fees, in one currency and with one Office (i.e., the International Bureau).

#### *Development of the Hague Agreement: the Geneva Act of 1999*

95. The facilities offered by the Hague Agreement (1934 and 1960 Acts) have served well for design owners for over 70 years. However, the number of countries party to that Agreement has remained low and their geographical spread limited, mainly because certain States that examine industrial designs as to novelty considered that the Agreement as it is

does not provide the flexibility they need for their requirements.

96. With a view to making the international deposits system more flexible, a new Act of the Hague Agreement was negotiated and adopted at a Diplomatic Conference held in Geneva on July 6, 1999 (the Geneva Act).

97. The Geneva Act of the Hague Agreement has two main purposes. One is to make the Hague system more attractive to new members, particularly those whose office carries out a novelty examination of industrial designs. For that purpose, the Geneva Act introduced a number of new elements such as the possibility for Contracting Parties to extend the refusal period to 12 months or to fix a higher designation fee. The other purpose is to maintain the fundamental simplicity of the Hague system and to render it more attractive to users by introducing new features, for example extending the minimum term of protection to 15 years.

98. The new Act also permits the establishment of a link between the international deposit system and regional systems such as the European Community design system or the African Intellectual Property Organization (OAPI) systems since it provides for certain intergovernmental organizations to become party to the Act.

99. The Geneva Act of the Hague Agreement will enter into force three months after six States have deposited their instruments of ratification or accession, provided that at least three of those States have a certain level of activity in the field of industrial designs, as defined in their treaty.

## SUMMARY OF MAIN POINTS

1. Industrial designs have been recognized as a special object of intellectual property protection for over a century. This recognition is currently expressed in special legislation at the national, regional and international levels.
2. Industrial designs refer to the visually perceptible appearance of utilitarian products.
3. Industrial designs are intended to make utilitarian products more aesthetically pleasing and attractive to the prospective buyer, without impairing the product's functionality and performance. Industrial designs are unique because they inextricably combine functional and non-functional features in the same expression.
4. Industrial designs are closely related to works of art, and might be assimilated to works of applied art. Industrial designs can be regarded as a form of artistic expression.
5. While industrial designs are usually embodied in industrial and consumer products, they may also be embodied in works of handicraft. Handicrafts and other forms of traditional arts expressed in tangible products are automatically protected by copyright as works of art or applied art, and may also be protected as industrial designs.
6. Industrial designs have been regulated in most countries through *sui generis* legislation, on the basis of their specialty with respect to other objects of intellectual property. However, the dual nature of industrial designs as an expression that contains both functional and aesthetic

features, and their occasional assimilation to works of art brings up the issue of the extent to which copyright may overlap with top protect industrial designs.

7. Three approaches may be considered in relating copyright and *suigeneris* design rights: cumulative protection, separation of regimes, and partial overlap. (i) Cumulative protection (based on the theory of “unity of art”) proposes a total and automatic application of both the copyright and the special industrial design regimes to industrial designs. (ii) Separation of regimes (based on the theory of “separability” or “dissociation”) proposes a clear separation of protection regimes, such that industrial designs may only be protected by special design legislation because the artistic expression, if any, cannot be separated from the article in which it is embodied. (iii) Partial overlap would allow copyright protection for industrial designs that meet the standards of works of art, although the required level of artistic merit might not be easily met in practice.

8. Overlap of protection for industrial designs is not possible in relation to the patent system. The patent system preempts all other forms of intellectual property when it comes to protecting technical solutions and functional devices (inventions). Any functional or technical features of the configuration of a product will normally not be covered by industrial design protection, and may only be protected from free copying if covered by a valid patent of invention.

9. Under the modern standard definition of mark, any sign capable of distinguishing goods or services in the market place may constitute a valid mark. This broad definition allows for the shape or configuration of a product, or its packaging or container, to be recognized as a three-dimensional mark.

10. The shape or configuration of a product, or its packaging or container, may be protected as a three-dimensional mark if it is sufficiently distinctive and complies with the other conditions for protection. Although unusual, it is not impossible for the shape or configuration of a product protected as an industrial design to acquire sufficient distinctiveness to deserve protection as a mark.

11. Under most *suigeneris* design laws, exclusive rights in industrial designs are acquired by registration or deposit. Some such laws respond to a patent-system approach, and provide for a more lengthy and detailed registration procedure. Other laws follow a copyright approach and provide a relatively simple procedure for deposit or registration.

12. A number of design laws have retained or recently adopted full formality-free systems for the protection of industrial designs. These systems plainly adopt the copyright principle of protection on the basis of creation or fixation.

13. The Hague Agreement offers designers and other design owners a simplified and economic system for the protection of designs in a large number of countries. The 1999 revision of the Hague Agreement gives Member States additional flexibility to maintain certain conditions applicable under their national design laws.

[Appendices follow]

APPENDIX I

EXAMPLES OF INDUSTRIAL DESIGNS FROM THE  
“INTERNATIONAL DESIGN BULLETIN”/  
“BULLETIN DES DESSINS ET MODELES INTERNATIONAUX”

[Appendix II follows]



APPENDIX II

EXAMPLES OF THREE -DIMENSIONAL MARKS FROM THE  
“WIPO GAZETTE OF INTERNATIONAL MARKS”/  
“GAZETTE OMPIDESMAREQUES INTERNATIONALES”

[End of Appendix II, and of document]