

Protecting Designs Internationally  
**Experience from an Industry Perspective**



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# 1 – Introduction - Nestlé Legal IP Counsels

Nestlé IP in-house lawyers are responsible for the protection and defence of Nestlé's Brand IP Rights.

They are providing specific advice and insight in the context of a multinational company.

They are working in close collaboration with the Nestlé business entities to co-pilot their projects.

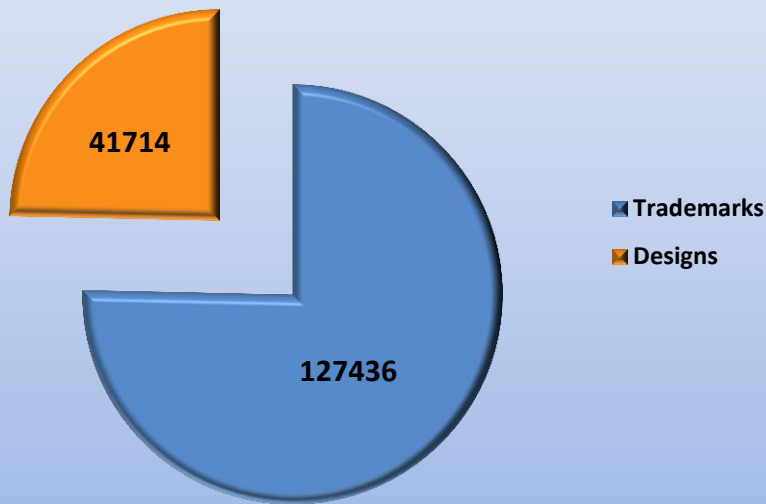
- Doing business = taking risks
- We help our clients identify the risks
- Our role :
  1. to manage the risks
  2. to avoid unnecessary risks
  3. to best manage unavoidable risks

=> Look at IP with a business focused perspective

# Setting the scene - Brands portfolio at Nestlé

Over 2000 Brands  
In total around 160.000 protections:

Active Protections Worldwide - All Brands



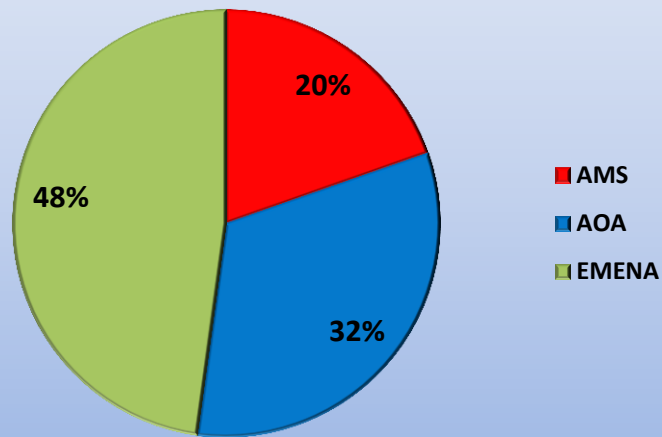
## Example NESCAFÉ

197	Trademarks
4447	Trademark protections
46	Designs
1119	Design protections
375	Domain names

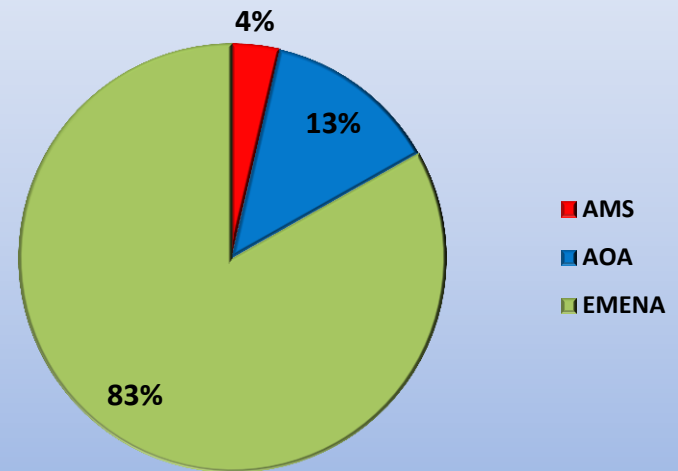
# Brands Protection – Statistics

## Active Protections per Zones

### Trademarks

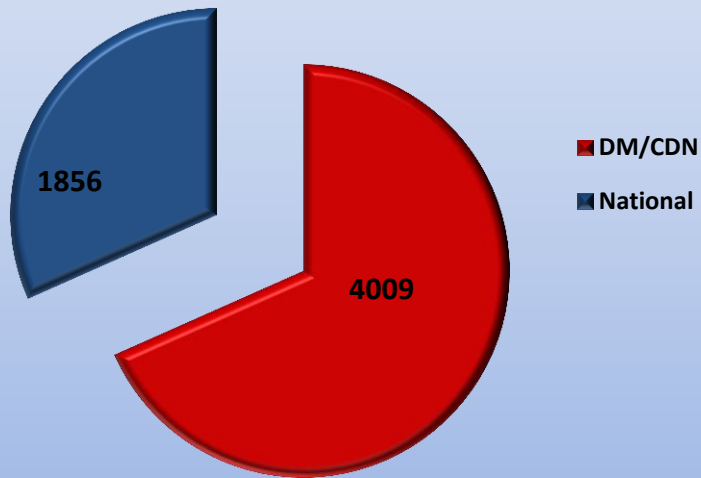


### Designs

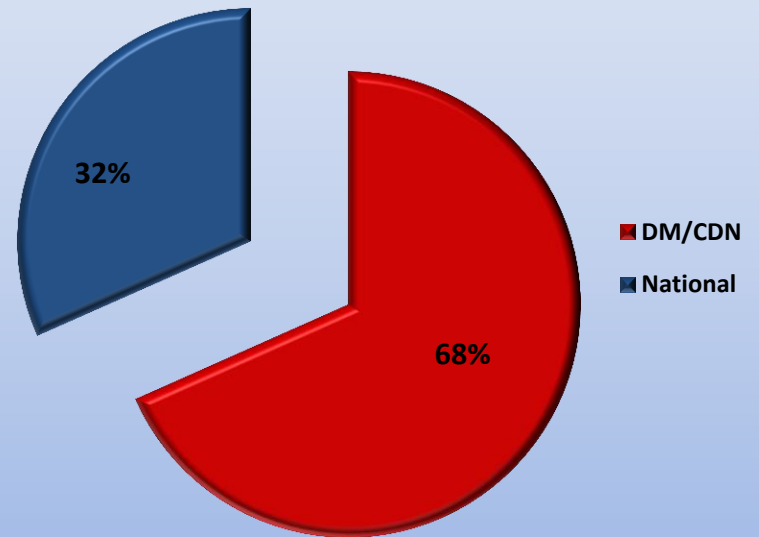


# Design Protection Strategy – Statistics

DM-CDN versus Local/National (5864 Designs representing 41714 protections)



DM-CDN versus Local/National



## 2 - Nestlé's customized filing strategy

We usually favor the International route but our strategy depends on several factors



=> Strategy definition means looking into all directions and considering all aspects of projects...!

# Global Presence – Protection Strategy

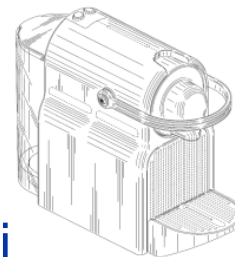
Nestlé's global presence requires a thorough protection strategy that is:

- providing the broadest protection *word mark vs. logo + design*
- covering (most of) the existing markets *enforcement of protection*
- constantly adapted to business plans and launches i.e. be relevant and in line with customer expectations
- taking into account the economic situation and ongoing challenges

→ *imitations/counterfeits*

## Questions to be considered:

- What to protect? Whole product? Parts of it?
- New, original, functional?
- Which countries to cover?
- Timing? Consider the launch date... Publications....
- Filing requirements (drawings, declaration of transfer of rights, etc.)?





# National and/or International Filings? That is the question!



- The Madrid System
- The Hague System

# Design Protection Strategy – Due Diligence

Liaise with R&D and Patent Colleagues at early stage of new projects

Make sure novelty is adequately preserved during development and consumer tests

Identify and make primary analysis of elements that could be protected

Secure Assignment of rights from the Agency and the creators of the final designs

Design protection can be a suitable complement to Patent protection or be a good alternative if Patent protection is not an option (...depends on the nature of the development).

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Most countries require «absolute novelty» => Avoid disclosure during development stages and consumer tests => Ask detailed information and secure confidentiality agreements.

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Review artwork and assess novelty and individual character => conduct search for “prior art” (online and in existing databases -> unfortunately not exhaustive!)

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Novelty requires to know where to protect to preserve validity => Seek assignment as wide as possible without restriction in time or geography!

# Design Protection Strategy – Criterias for protection

Query the planned use and importance of the project

- The importance of the project and the relevance of concerned Nestlé business in the market(s) have to be considered to define the territorial coverage.

Assess the competitive environment and risk of facing infringements and the degree of enforcement

- The risk of facing infringements is higher in countries like China for example, and for certain business categories (especially for the machine driven businesses, e.g. Nespresso).

Examine the nature of the designs

- A stricter approach is recommended for categories where the freedom of the designer is by default very narrow, such as for containers and accessories.

Consider the prior art and freedom of the designer

- Is the proposed design sufficiently new and original ?
- In overcrowded sectors where the freedom of the designer is more limited, small differences can make the difference (e.g. bottles shapes...but scope of protection may be very narrow!)

# Criteria for protection of Designs:

## Novelty

No identical design has been made available to the public before the date of application. (Novelty applies worldwide or regional)

→ a design shall be deemed to have been made available to the public if it has been published (e.g. in a patent) or exhibited, used in the trade or otherwise disclosed before the date of application

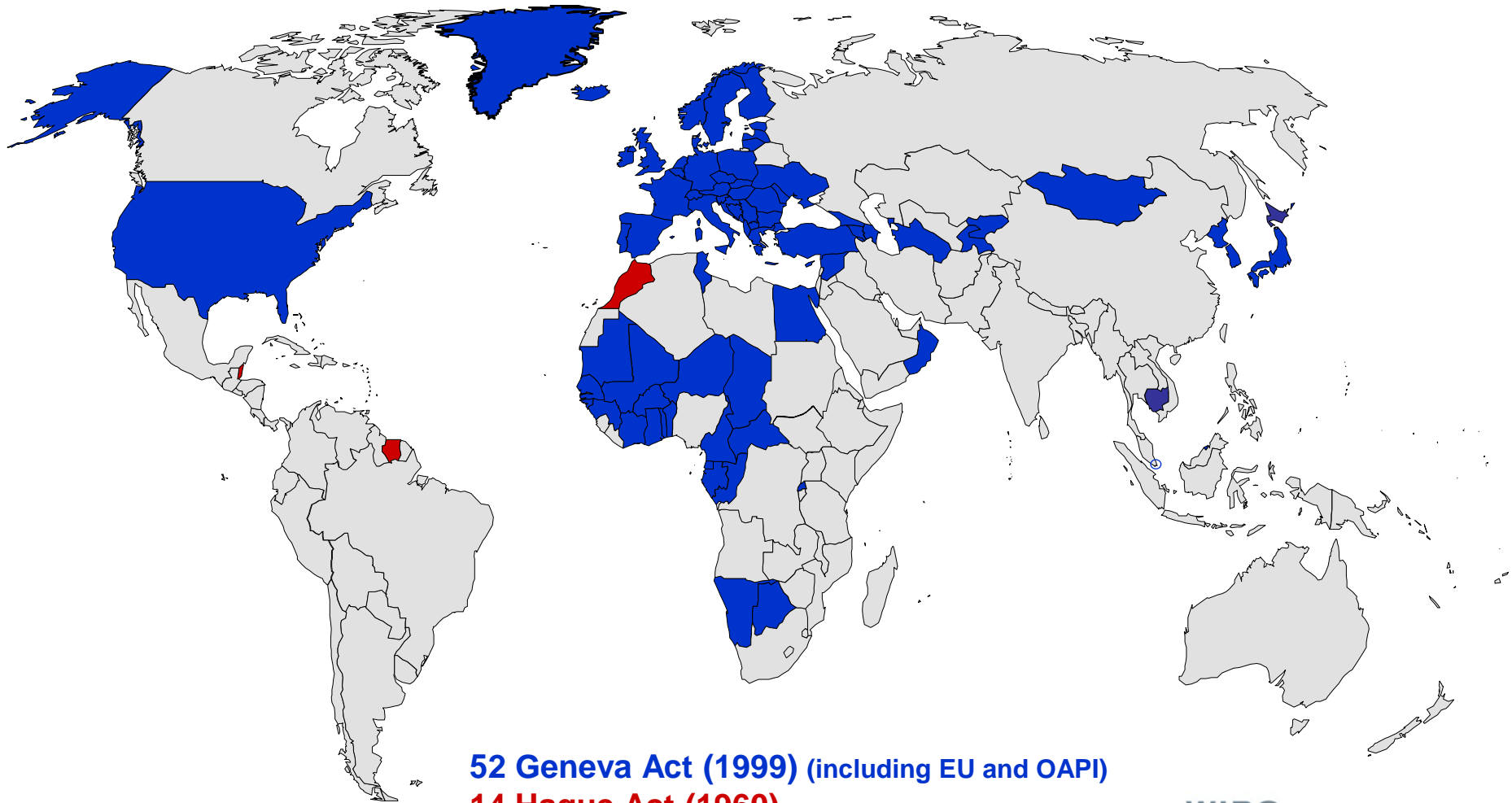
## Individual character

The overall impression differs from the overall impression produced by any design made available to the public.

In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.

=> Clients struggle a lot with this!!!

# Hague Union



**52 Geneva Act (1999) (including EU and OAPI)**

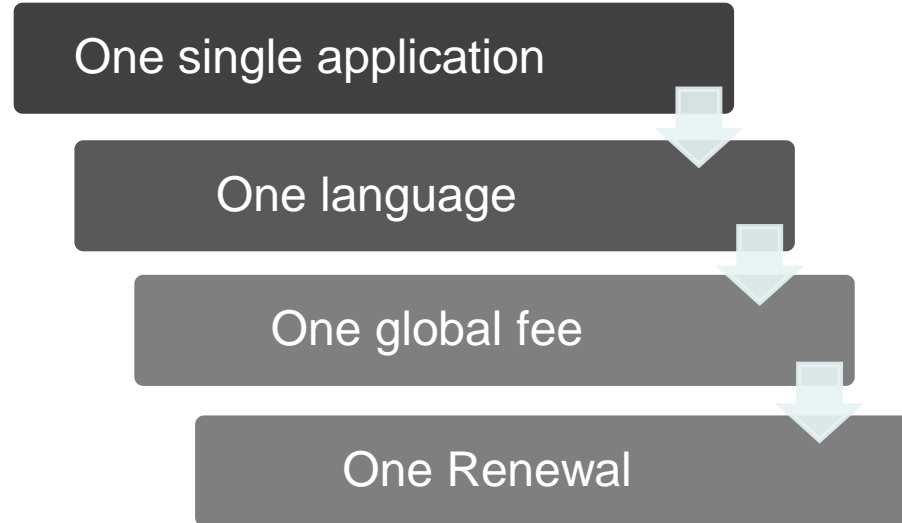
**14 Hague Act (1960)**

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**66 Contracting Parties**

# The Hague System

- No Prior National Application or Registration
- Easy and simple way to obtain wide geographical coverage (currently up to 66 countries representing 84 jurisdictions )
- But no extension possible (because of novelty requirement)



# 3 - International Registrations: Obvious options at Nestlé

- Nestlé is a big user of the Madrid Protocol for the protection of International Trademark registrations and of the Hague Agreement for the protection of International Designs
- Today Nestlé has more than 1.800 active International Trademark Registrations and ranks in the top 10 companies for filing IRs applications (although it has slowed down the pace of its filings in 2016 due to internal reorganization).
- It has more than 800 active International Design Registrations and it constantly assesses and reviews the list of countries to designate
- => that is for example the case with the recent accession of Cambodia which can now be designated in International design application since February 25, 2017

# Example of complete IP protection: NESCAFÉ

Word mark  
**NESCAFÉ**

Special  
Lettering

**NESCAFÉ**

Figurative  
Trademark

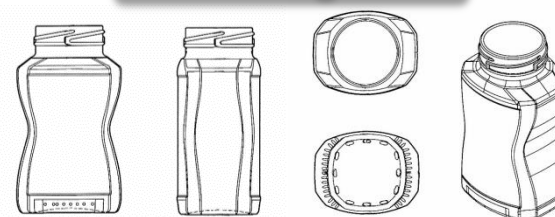


Word mark  
**GOLD BLEND**

Copyright



Design



Figurative  
Trademark



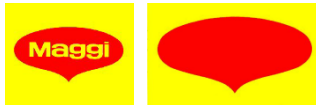
Domain Name  
**nescafe.com**

Patents



# Example of complete IP protection: MAGGI

Word mark  
Figurative  
Trademarks



Word mark  
**MAGGI DOBLE GUSTO**

Special  
Lettering

**DOBLE  
GUSTO**

Copyright



Design



Device Marks



Domain Name  
**maggi.com**

Patents

# Example of complete IP protection: NESPRESSO

Word mark  
**NESPRESSO**

Figurative  
Trademarks

**NESPRESSO**

Word marks  
**INISSIA**  
**AEROCCINO**  
**ARPEGGIO**

Domain Names  
nespresso.com



Design



Copyright



Patents

# 4 - Designs - Best Practices

- ✓ The protection strategy must be defined before any disclosure N.B.: In most countries, novelty is **worldwide** → disclosure in e.g. Nigeria destroys novelty in e.g. Malaysia
  - 1<sup>st</sup> filing must be done prior to any public disclosure
  - 1<sup>st</sup> filing determines 6 months priority to complete protection abroad with same filing date as first filing
- ✓ Be careful about divulgation when presenting a project to partners or clients. Idem for consumers tests → secure confidentiality agreements!
- ✓ Ensure that the creator of the design, if not a Nestlé employee, has transferred to Nestlé the copyrights related to the design, worldwide
- ✓ Claim of priority can however be very burdensome => plan properly filings!

# Designs - Best Practices – Continued...

- ✓ How to deal with variations of shapes? The shape has evolved compared with the one covered by the 1<sup>st</sup> filing
  - a) If essential characteristics are the same, no impact
  - b) If essential characteristics are affected → new filing
  
- N.B:
  - Possibility to defer the publication up to 30 months
  - Unpublished application is reputed non-existing
  - Also allows to hide our filings to our competitors
  
- ✓ Be selective in terms of countries where to protect
  - a) If enforcement not possible => no usefulness of protection
  - b) If no active business in country => no business impact → no filing
  
- ✓ Look at print requirements and quality of specimens to avoid formal objections

# Designs - Best Practices – Continued...

- ✓ Design protection can be a good alternative:
  - a) If feature cannot function as a Trademark
  - b) Given increased difficulty to secure 3-D Trademark registration
  
- ✓ Scope of the protection obtained through design protections is narrower than Trademark protection -> Explain and Manage clients expectations!
  
- ✓ Possibility to file multiple designs gives flexibility -> We have to also remain costs focused!
  
- ✓ Not experienced a lot of conflicts based on Designs until now -> will no doubt come!

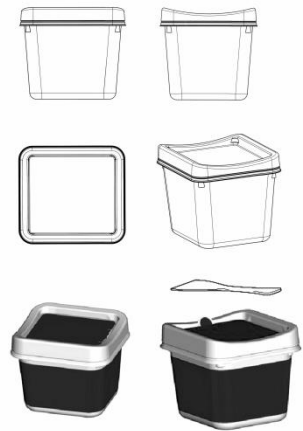
# Nestlé protects internationally various types of designs...



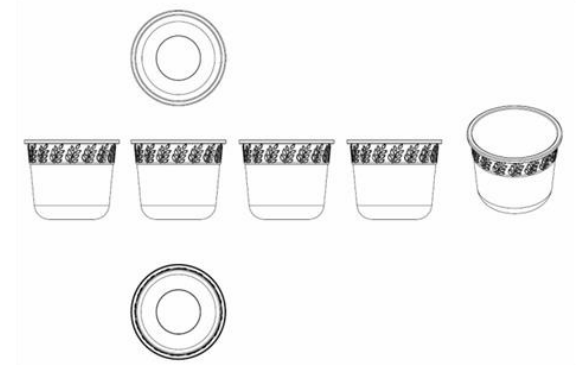
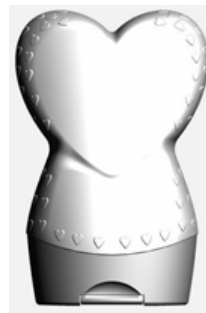
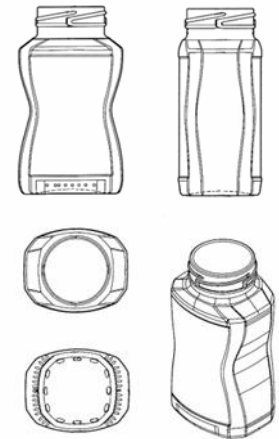
## Machines



...depending of the nature of the businesses



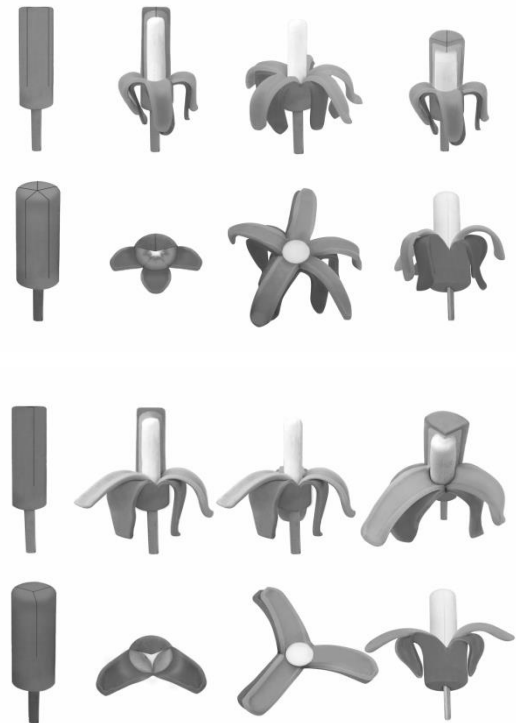
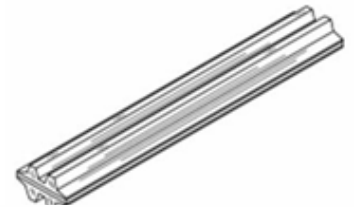
## Containers



# Other type of designs Nestlé protects internationally...



Product shapes





...including also multiple designs



### Labels and key visuals / 2D designs



## 5 - Practical difficulties with new members states may influence the filing strategy...

- For example for the USA, Korea and Japan – often facing objections related to the drawings submitted => forces to seek preliminary advice from local agents to secure easier acceptance
- Logos per se not registrable in Japan (must appear on an article)
- Design must be usable for an industrial purpose in Korea
- Criteria for acceptance of multiple designs and drawings are different and lead to frequent objections – For example Multiple design not admitted in the USA if considered distinct (although non distinct designs can be kept as “embodiments” of the one design, multiple designs accepted in Korea and Japan but with indication of the main design and other designs considered “related”
- It is hoped filings in Cambodia will go moothly...

# Companies welcome simplification!

- Nestlé welcomes very much new developments aimed at simplifying the protection of IP rights and especially Designs (such as e.g. providing the priority documents electronically)
- Nestlé views very favourably an enlargement of the list of Hague members
- However, to avoid refusals in the new countries Nestlé may (regrettably) tend to favor the national route rather than the Hague System
- Nestlé thus hopes to see more flexibility and uniformity in the examination and acceptance of designs/views and also looks with interest at the future development and protection of GUIs and logos as per the new initiative discussed during the last SCT Meetings in Geneva

## 6 – Conclusion: “Imitation is the sincerest form of flattery...”

Yes, BUT what about...

...Investments in creation of products and their design?

...Time spent (research, development, etc.)?

...Marketing investments?

...Responsibilities towards our business partners (developers, machine partners)?

And most importantly ... responsibilities towards our customers?

**➤ It is therefore important to have a good protection strategy in place...and the Hague Agreement surely helps... but as time is of essence, flexibility and simplicity is a key success factor to using it even more!**

**THANK YOU!**