

“Looking Good” – The Appeal of Designs in Getting Noticed by the Customer

WIPO-IPOPNG-SBDC

**Training of Trainers Program
Port Moresby, Nov 26 to 28, 2014**

Susanna H.S. LEONG

Associate Professor & Vice Dean

***NUS Business School, National University of
Singapore***

Introduction

- A design, in the context of intellectual property rights, concerns **features of shape, configuration, pattern or ornament** applied to or embodied in an article by any industrial process.
- It can be two dimensional (as in pattern or ornament) or three dimensional (as in shape or configuration) in expression.
- The most important aspect of a design is the **visual appeal** to the potential customer which may be a factor that substantially influences the customer's choice or preference for one product over another, particularly for items where all other factors such as function and cost are relatively equal.
- Therefore, the exclusive right conferred on a design by the law seeks to protect the competitive edge which a trader may have over his competitors in ensuring market success of his products.
- In this way, the law provides the necessary incentive for the generation of new design concepts in the production of useful articles for market consumption.



Furniture



Fabric pattern



Typeface



Mobile Phones



Bags

Benefits of a Registered Design

- By registering a design, the owner obtains a right to ownership and the right to prevent others from using the design without his permission.
- Ways of exploiting a registered design:
 - use it to better protect his market share (i.e. his profits) by barring others from copying;
 - license it to third parties for commercial returns;
 - sell the design outright for a specified value.

International Conventions and Designs

- The protection of industrial designs is well entrenched in several international conventions and treaties.
- Article 5 *quinquies* of the Paris Convention 1883
- Article 2(7) of the Berne Convention 1886
- Article 25 of TRIPS (The Agreement on Trade-related Aspects of Intellectual Property Rights)

Scope of Protection

- The scope of protection conferred on an industrial design is provided in Article 26 of TRIPS:
 - 1. The owner of a protected industrial design shall have the right to prevent third parties not having his consent from making, selling or importing articles bearing or embodying a design which is a copy, or substantially a copy, of the protected design, when such acts are undertaken for commercial purposes.
 - 2. Members may provide limited exceptions to the protection of industrial designs, provided that such exceptions do not unreasonably conflict with the normal exploitation of protected industrial designs and do not unreasonably prejudice the legitimate interests of the owner of the protected design, taking account of the legitimate interests of third parties.
 - 3. The duration of protection available shall amount to at least ten years.

Scope of Protection

- Protection for industrial designs, like all the other intellectual property rights, is territorial in nature in the sense that it is limited to the jurisdiction in which protection is conferred.
- An owner of an industrial design who wishes to exploit or protect his design in more than one jurisdiction must seek a separate registration in each of the countries where protection is desired.
- This can be both costly and time consuming.

International registration system for designs

- In response to the needs of the design owner who is desirous of multiple national registrations, an international registration system under the Hague Agreement (“Hague Agreement”) has been set up and is administered by the International Bureau of WIPO (“Hague System”).
- Under the Hague System, an applicant need file only one application with WIPO to obtain protection simultaneously for his design in several countries.
- The application is in one language and the applicant need pay only one set of fees in one currency, *eg*, Swiss francs.
- The Hague Agreement Concerning the International Deposit of Industrial Designs (“Hague Agreement on Industrial Designs”) was concluded in 1925, was revised in London in 1934 and at The Hague in 1960.
- The Hague Agreement on Industrial Designs was completed by the adoption of two Acts: the 1999 Act signed in Geneva and the 1960 Act signed in Monaco.
- Under the 1960 or the 1999 Act, an international registration of an industrial design may be sought with the International Bureau of the World Intellectual Property Organisation either directly or through the intellectual property office of the Contracting State if its national law permits.

When to File

- The design registration system in most jurisdictions operates on a first-to-file basis.
- This means, the first person to file for protection will, in general, have priority over others.
- The registered design right created under national laws such as the Registered Designs Act in Singapore is a legal monopoly, like that of a patent, which is not dependent on copying.

Priority Claim

- Singapore, like many countries, allows priority claims in the application for design registration.
- If an applicant has a corresponding design application filed earlier in a Paris Convention country or a World Trade Organization member country (other than Singapore), he may claim priority from this first-filed application, provided the Singapore registration is filed within 6 months from the date of the first filing
- An application which is first filed in Singapore may be similarly used to obtain priority in an application filed in a Paris Convention country or a World Trade Organization member country.

Registrable Designs

- A design refers to features of shape, configuration, pattern or ornament applied to an article by any industrial process.
- There are four elements that must be satisfied before a design is eligible for registration:
 - a. a "design" within the meaning of the legislation;
 - b. the design is "new";
 - c. the applicant is the "owner of the design"; and
 - d. the design is to be applied onto an "article".

Novelty

- To be registrable, the design must be new.
- A design shall not be regarded as new if it is the same as a design-
 - registered in respect of the *same or any other article* in pursuance of a *prior application*; or
 - *published anywhere in the world* in respect of the *same or any other article*; or
 - if it *differs* from such a design *only in immaterial details or in features which are variants commonly* used in the trade.

Designs which cannot be registered

- Designs that are contrary to public order or morality
- Computer programs or layout-designs of integrated circuits
- Any method or principle of construction
- Features of shape or configuration of an article which-
 - i. are dictated solely by the function which the article has to perform;
 - ii. are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part; or
 - iii. enable the article to be connected to, or placed in, around or against, another article so that either may perform its function.

Any method or principle of construction

- This exclusion applies to both three-dimensional designs of features of shape or configuration and two-dimensional designs in the form of a pattern or ornament applied to an article.
- In *Swain v Barker*, the court held that the design of a wire filing-tray without corner supports was a design feature that arose from the construction adopted and so not a feature that would be protected by law.

Designs dictated solely by the function

- This exclusion of designs “dictated solely by function” is applicable only to design features of shape or configuration of an article.
- The design feature in a shape or configuration is considered “dictated solely by function” if it is brought about *only by*, or is attributable *only* to the function which the article in that shape or configuration is to perform and there is nothing extra that could be considered as any kind of embellishment.
- The presence of other shapes or configurations that could fulfil the same function is irrelevant.
- If at the end of the assessment, every feature of the shape or configuration is attributable solely to the function which the article is to perform, then the design is not registrable even though the design may have eye-appeal.
- This is also the test accepted in the case of *Interlego A G v Tyco Industries Inc.*
- There is some uncertainty whether the assessment is subjective or objective. It is suggested that the better view should be an objective assessment, the subjective intention of the designer being irrelevant.

“Must Fit” and “Must Match” Features

- The first point to note about the “must match” exclusion is that it is concerned with the *appearance* of the article.
- This is to be contrasted with the “must fit” exclusion which is concerned with the interconnection or the interface of the parts of the articles so that either part can perform its function.
- An example of a “must match” design feature that is commonly cited is the door panel of a car.
- The design feature of the shape of the door panel of a car is dependent on the appearance of the rest of the car and the door panel is intended by the designer to form an integral part of the car.
- However, it should be noted that parts of the design of the car door panel also consist of “must fit” features so as to allow the door to be fitted onto the chassis.

Summary

- Registrable designs are not limited to designs that have aesthetics qualities in them, technical designs are also registrable.
- Purely functional or utilitarian designs will be excluded.
- Designs of articles with "must fit" and "must match" features will not be registrable.

Article of Manufacture

- The design must be one that is to be applied to “an article”.
- This means that the designer must have a specific article in mind to which the design is to be applied.
- When applying for registration of designs, the design owner is required to classify the article or articles to which the design is applied.
- The Locarno Classification for Industrial Designs – 32 classes and subclasses

Owners of Designs

- As a general rule, the designer of a design shall be treated as the owner of the design for purposes of registration.
- To this general rule, there are a number of exceptions:
 - a. Commissioned works
 - b. Employees' works
 - c. Agreements to the contrary

Duration of Protection

- The initial period of protection granted to a design registered under the RDA 2000 is 5 years.
- After which, the period of protection may be extended for a second and a third period of 5 years by an application to the Registrar.
- Therefore, the maximum period of protection granted to a registered design under the RDA 2000 is 15 years.

Exclusive Rights of a Registered Design

- The exclusive rights given to the owner of a registered design include the following:
 - a. to make any article in respect of which the design is registered and to which that design or a design not substantially different from it has been applied, for purposes of sale or hire or for use for trade or business
 - b. to import any article, in respect of which the design is registered and to which that design or a design not substantially different from it has been applied, for purposes of sale or hire or for use for trade or business;
 - c. to sell, hire or offer or expose for sale or hire any article in respect of which the design is registered and to which that design or a design not substantially different from it has been applied.

Infringement of a registered design right



**£9 Marks & Spencer
bag**

VS.



**£495 Jimmy Choo Cosmo
Silk Satin Evening bag**

Infringement of a registered design right

- A registered design may be infringed in two ways:
- (a) the infringing article bears a design which is *exactly the same* to that which has been registered; or
- (b) the infringing article bears a design which is *not substantially different* to that which has been registered.

Infringement of a registered design right

- The first point to note is that the comparison is to be made between the alleged infringing article and the registered design as described in the Certificate of Registration of Design and not between the alleged infringing article and any article claimed to be manufactured in accordance with the registered design.
- As registration is for the whole of the design, it is the whole of the shape and configuration of the registered design which is to be taken into account when the comparison is made.
- There will be no infringement if the alleged infringement is substantially different from the look of the registered design as a whole.
- Although the similarities and differences between the registered design and the alleged infringing article are noted by a side by side comparison, at the end of the day “it is the general impression of an object as a whole that may be more important”.
- In considering whether there is or is not a substantial difference, it is also important to bear in mind the concept commonly referred to as “imperfect recollection”.

Defences

- Acts done for particular purposes such as private non-commercial use, teaching, research, analysis or evaluation.
- Reproduction of a feature in the design that has been left out of account in the process of determining whether the design is registrable and in this case, the reproduction does not constitute an infringement.
- Parallel imports.

Concurrent protection of industrial designs by other intellectual property rights

- Protection of industrial designs under the law of copyright as original artistic works
- Protection of industrial designs under the law of trade marks as shape marks

Protecting PNG art and crafts by design rights?

- Tribal culture
 - Basketry
 - Masks
 - Tattoos tribal art
 - Ornaments
 - Jewellery and fashion accessories



Thank You!

Questions?