

QUESTION 73

Legal and economic significance of design protection

Yearbook 1982/III, page 109

Q73

Executive Committee and Council of Presidents of Moscow, April 19 - 24, 1982

Questions Q73

Legal and Economic Significance of Design Protection

Resolution

The IAPIP

1. affirms the economic importance of the protection of designs and models both on the national as well as the international levels because such protection stimulates creativity and competition,

and recognises that this importance is still increasing;

2. decides to continue the study of this question on the basis of the Summary Report, of the report of the Working Committee, and of the discussion in the meeting of the Executive Committee

and charges the Working Committee in association with the Reporter General to draw up a questionnaire which will be sent to the national groups whose answers will enable a Summary Report to be drawn up for the Paris Congress.

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QUESTION 73

Legal and economic significance of design protection

Yearbook 1984/I, pages 160 - 162
32nd Congress of Paris, May 22 - 27, 1983

Q73

Question Q73

Legal and Economic Significance of Industrial Design Protection

Resolution

After having considered the resolution of the meeting of the Executive Committee in Moscow, the Reports of the National Groups and the Summary Report on the Question 73 (Yearbook 1983/III):

I. The AIPPI

notes that a system of dual protection for industrial designs and models by copyright and by specific registration, prevails in most states. This system presents some difficulties, for example:

- an uncertainty of third parties in the absence of an obligation to deposit in operation of the system;
- the fact that the copyright system can confer a term of protection which seems to be excessive for industrial designs and models.

considers that States should make changes where such dual protection exists. Such changes could consist in the institution of specific provisions relating to protection of industrial designs and models, within the copyright law, which could avoid the inconvenience of such dual protection. The nature of such changes and the further question of protection of technical drawings and of three-dimensional reproductions produced there from should be the subject of further study by the AIPPI.

II. National Law

The AIPPI

expresses the opinion that protection on industrial designs by specific legislation which is independent of the rules relating to copyright or unfair competition has real advantages. The AIPPI thinks it is desirable that each State have specific legislation for protection of

industrial design, and suggests that the countries adopt the following regulations for such legislation in the interests of harmonization of the different national laws:

1. Object of protection

(a) The definition of the object of protection of a design should be as defined at the Congress in Tokyo, viz:

The appearance of an industrial object may be protected as an industrial design or model; this appearance may result among other things from an assembly of lines or colours, from the shape of the article itself or from its ornamentation.

The expression *industrial object* is to be interpreted liberally, covering handicrafts (*object artisanal*) for example.

b) A model of which the characteristics are dictated solely by its function should not be suitable for protection by the specifically legislated form of protection for designs and models.

2. Novelty

(a) Novelty is essential for valid protection. It is to be an absolute novelty, both territorially and timewise.

(b) Nevertheless, a period of grace of 6 months should be instituted for the benefit of an author whereby he may be allowed to apply for registration of his design or model after he has disclosed it.

3. Formalities

(a) A deposit system which is simple, not onerous and which is followed quickly by publication, should be established.

(b) The deposit should be effected by filing an example of the object, or a representation thereof.

(c) The deposit should be made at an official central organisation of the State.

(d) Substantive examination is not to be foreseen.

(e) Joint deposits may be made, provided that there is a certain link between the objects filed.

(f) The deposit can be kept secret for a period which should be short but at least one year.

(g) Publication must comprise a representation of the object. Third parties must have access to registrations.

(h) The administrative classification system of Locarno is to be applied without limitation of the scope of protection.

(i) Marking of objects made according to the registered design or model is to be optional.

4. Form and extent of protection

(a) The right of the registered design or model is an exclusive right which prohibits use of the design or model by all persons other than the proprietor, without the consent of the proprietor.

(b) The right of the registered design or model is a monopoly right enforceable against any commercial use by all persons even those who do not know about the design.

(c) Infringement is established if the essential elements of the registered design or model are reproduced.

(d) Infringement is to be dealt with as a civil matter and, possibly as a criminal matter.

(e) Registration gives rise to a simple presumption of validity in respect of the design or model, that is to say the burden of proof of invalidity lies with an opposer.

(f) Failure to work the design or model does not result in forfeiture of the registered design or model.

5. Duration of protection

The term of protection is to be 15 years, possibly dividable into several periods. A term at least equivalent to the one prevailing in practice for patents for inventions, would be desirable.

III. International Law

Revision of the Convention of the Paris Union

The AIPPI *desires* that the priority period effective for designs should be modified from six months to one year.

IV. The AIPPI

decides to continue the study on the following points:

1. How to correct the inconveniences of the application of the rules of copyright to industrial designs and models in countries where dual protection is available:

In particular, how to resolve the question of technical drawings and three dimensional articles produced from such drawings.

2. How to improve international arrangements for protection of industrial designs and models, in particular by modification of the Hague Convention or by initiation of a new international Convention or by regional protection systems.

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QUESTION 73

Legal and economic significance of design protection

Yearbook 1985/III, pages 307 - 308
Executive Committee of Rio de Janeiro, May 13 - 18, 1985

Q73

Question Q73

Legal and Economic Significance of Protection by Designs and Models

Resolution

After having taken into consideration the resolution of the Paris Congress, the national reports and the Summary Report on Question 73 (Annuaire 1985/I),

I. AIPPI, being aware of the advantages but also the inconveniences that the double protection of designs and models by copyright law and by the specific law can cause, considers it desirable that the countries which recognize double protection without imposing on the copyright protection a requirement of a certain individual quality, should arrange this protection in the following way:

1. The legislation for copyright protection should provide a special system for industrial designs and models, defined as industrial articles considered in a broad sense, that is to say including in particular objects of artistic craftsmanship.

2. The protection of copyright law should be given to these works for a reduced period, which could be fixed at 25 years.

3. The protection based on the specific design law should be arranged in such a way that the duration does not exceed the protection given by copyright law.

4. The transfer of copyright should automatically include the transfer of rights arising under the specific law and vice versa. Similarly, the grant of a licence of the copyright should automatically include a grant of a licence of the rights arising under the specific law, and vice versa. These two statements do not affect the "droit moral".

II. AIPPI, having studied the question raised by certain countries concerning the relation between the protection of technical drawings and that of three-dimensional articles made according to those drawings.

1. states that the difficulties which have arisen in certain countries, flow from circumstances in which jurisprudence applies copyright to the protection of purely

functional articles made according to technical drawings and that this question should be resolved at the national level;

2. recalls that in accordance with the resolution passed at the Paris Congress (1983), designs, whose characteristics are dictated exclusively by technical needs should not be protected by the specific law of designs and models; protection by other juridical systems is possible (e.g. laws against unfair competition);

3. makes the following recommendation:

A technical drawing may be protected in itself by national copyright law as regards reproduction in two dimensions if it complies with the general requirements of such law. But the protection of a technical drawing should not of itself permit the prevention of the manufacture of the article corresponding to such drawing, because such an extension of the protection could create conflicts with the general conditions for protection under the laws relating to patents, utility models and registered designs.

III. AIPPI confirms the need to improve the protection of industrial designs and models at international level and puts forward the following *conclusions*:

1. It has been said before that the extension and improvement of the international protection of designs and models would be greatly enhanced by a harmonization of the systems of national protection. AIPPI refers on this point to the resolution passed by the Congress, which proposed a statute for protection of designs and models.

2. There would be room for the adaptation of the Hague Arrangement in its most recent version (Act of 1960, coming into effect in 1984) with a view to increasing the number of members. This improvement, which could be effected by modification of the Arrangement itself or of its rules of procedure, should be studied in the following directions:

a) augmentation (to 18 months for example) of the time within which the countries having provisions for examination can communicate their refusal of protection for applications published in the bulletin of OMPI;

b) the possibility of formally rectifying certain errors before publication;

c) the lowering of the fees, the amount of which is a deterrent to use of the Arrangement.

3. Independently of the Hague Arrangement, interested countries are invited to examine the possibilities of working out a regional Convention established on lines analogous to those of the European Patent.

IV. The study which has been made of the Question has made it possible to identify a great number of the problems which result from the existence of different means and juridical systems for the protection of industrial designs and models and has also led to the conclusion that it is necessary to pursue in a much more fundamental way the study of all aspects of the matter and in particular the study of all the possible systems of protection with a view to determining the most appropriate means of protecting industrial designs and models.

Therefore, AIPPI resolves to continue the study of the question.

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