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2016 – Study Question (Designs)

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Requirements for protection of designs

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I. Current law and practice

- 1) Does your Group's current law provide for an intellectual property right (registered or patented) that specifically protects the outward appearance or ornamentation of an object or article of manufacture?

As set out in the Study Guidelines, copyrights and trademarks are not such rights in the context of this Study Question.

yes

Please explain:

Yes: decree-law No. 6673/63 enacted August 9, 1963.

- 2) If yes, what is this right called? (e.g. registered design, design patent, industrial design, industrial design patent)

References to design below are to be read as references to this right, irrespective of what it is called in your jurisdiction.

Industrial models or designs. The Argentine statute provides two distinct rights, namely "industrial models" and "industrial designs". The only difference is that "industrial models" are intended for 3-D shapes, while "industrial designs" are for planar designs, i.e. 2-D forms.

- 3) What are the statutory requirements for such right? Please tick any relevant boxes and explain the basis and application of these requirements.

a) novelty

Different shape/appearance vis-à-vis prior-art designs

b) non-obviousness

c) inventive step

d) individual character

See comment *infra* at 23)

e) originality

f) aesthetic

See comment *infra* at 23).

g) ornamental

Shape/appearance must confer ornamentality

h) other, namely ...

Industrial applicability; specific shape or appearance, not a mere change in colouring; lawfulness

4) Does your Group's current law deny design protection to a design with an appearance that is dictated solely by its function?

yes

Please explain:

The statute provides that "[t]he following shall not enjoy the protection conferred by this decree: [...] industrial models and designs whose elements are imposed by the function to be carried out by the product" (section 6[c] of decree-law No. 6673/63). The wording of the statute does not include the adverb "solely" to qualify the condition of functionality as a bar to protection. Legal scholars in Argentina have nevertheless held that protection is barred only if the change in shape or aspect is exclusively due to functional considerations.

5) If yes, what are the relevant factors to determine whether or not a design is deemed unprotectable as being functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

b) whether each portion of the overall appearance is dictated solely by its technical function

c) the availability of alternative appearances that can obtain the same functional result

d) the need to achieve the product's technical function was the only relevant factor when the design in question was selected

e) other, namely ...

The statute does not go beyond the provision cited *supra* at 4). While the circumstances described here at a) and b) may be construed to be non-protectable functionality and c) a defence against invalidity, it should be noted that they must be predicated on the new shape or aspect which is the object of the industrial model or design, and not to the product to which it is applied.

6) Does your Group's current law deny design protection to any portions (e.g. a "feature", "element") of the overall design that are deemed functional?

yes

Please explain:

Yes, as explained *supra* at 4) and 5).

7) If yes, what are the relevant factors to determine whether or not a portion is deemed functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

b) the availability of alternative appearances for the portion to obtain the same functional result

c) the need to achieve the product's technical function was the only relevant factor when the portion in question was selected

d) other, namely ...

Any of the above factors may be deemed to be functional, but there is no specific statutory provision other than the one set forth *supra* at 4).

8) What is the effect on the scope of protection of a design with one or more functional portions? Please tick any relevant boxes and explain as applicable:

a) any portions deemed functional will not be taken into account when assessing infringement

b) any portions deemed functional will not be taken into account when assessing validity

c) any portions deemed functional will not be taken into account separately when assessing infringement, but can play a role in the overall comparison

d) any portions deemed functional will not be taken into account separately when assessing validity, but may play a role in the overall comparison

e) no effect (e.g. so long as the overall appearance is not dictated solely by its technical function, all portions of the design are included in the scope of protection, irrespective as to whether any portions may be functional)

f) the Group's current law is unsettled

g) other, namely ...

II. Policy considerations and possible improvements to your current law

9) How can the following aspects of your Group's current law be improved, if at all?

a) the definition or meaning of a "design"

b) the requirements for protection of a design

c) the treatment of functionality in the sense described in paragraph 14) of the Study Guidelines or aspects of such functionality

Ad b) and c), that the design features not be dictated solely by function.

10) Are there any other policy considerations and/or proposals for improvement to your current law falling within the scope of this Study Question?

yes

Please explain:

The statute should be amended to specifically add the adverb "solely" in section 6(c), so that it would read: "The following shall not enjoy the protection conferred by this decree: [...] Industrial models and designs whose elements are solely imposed by the function to be carried out by the product".

III. Proposals for harmonisation

11) Does your Group consider that harmonisation in the three areas in question 9) above is desirable?

If yes to some but not all of those three areas, please state in relation to which of the areas your Group considers harmonisation is desirable.

If yes in relation to any of those areas, please respond to the following questions without regard to your Group's current law.

Even if no in relation to any of those areas, please address the following questions to the extent your Group considers your Group's current law could be improved.

no

Please explain:

No opinion.

12) Should there be harmonisation of the definition of an intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture?

yes

Please explain:

13) If so, what should that right be called?

Industrial design.

14) What should the requirements for such right be? Please tick any relevant boxes and explain the basis and application of these requirements:

a) novelty

b) non-obviousness

c) inventive step

d) individual character

See *infra* at 23)

e) originality

f) aesthetic

See comment *infra* at 23).

g) ornamental

h) other, namely ...

Specific shape, pattern or appearance; lawfulness.

15) Should design protection be denied to a design with an appearance that is dictated solely by its function?

yes

Please explain:

16) If yes, what should the relevant factors be to determine whether or not a design is deemed unprotectable as being functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

b) whether each portion of the overall appearance is dictated solely by its technical function

c) the availability of alternative appearances that can obtain the same functional result

d) the need to achieve the product's technical function was the only relevant factor when the design in question was selected

e) other, namely ...

17) Should design protection be denied to any portions (e.g. a "feature", "element") of the overall design that are deemed functional?

yes

Please explain:

18) If yes, what should the relevant factors be to determine whether a portion of a design is functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

b) the availability of alternative appearances for the portion to obtain the same functional result

c) the need to achieve the product's technical function was the only relevant factor when the portion in question was selected

d) other, namely ...

19) What should the effect be on the scope of protection of a design with one or more functional portions? Please tick any relevant boxes and explain as applicable:

a) any portions deemed functional will not be taken into account when assessing infringement

b) any portions deemed functional will not be taken into account when assessing validity

c) any portions deemed functional will not be taken into account separately when assessing infringement, but can play a role in the overall comparison

d) any portions deemed functional will not be taken into account separately when assessing validity, but may play a role in the overall comparison

e) no effect (e.g. so long as the overall appearance is not dictated solely by its technical function, all portions of the design are included in the scope of protection, irrespective as to whether any portions may be functional)

f) the Group's current law is unsettled

g) other, namely ...

20) If your answer to question 11) is no, is it your Group's view that a (registered or patented) intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture should not be available at all?

no

21) If yes, why?

22) If your answer to question 11) is no in relation to some but not all of the three areas set out in question 9) above, please state why your Group does not consider that harmonisation in that area(s) is desirable.

Design law is reasonably harmonized as it is.

23) Please comment on any additional issues concerning any aspect of the definition and requirements for protection of designs, or the role of functionality, you consider relevant to this Study Question.

The Argentine Group is not unanimous as to whether there is any difference between "aesthetic" and "ornamental" (see *supra* at 3.f] and 3.g], as well as 14.5] and 14.g]).

The Argentine Group is not unanimous as to the existence of the requirement of "individual character" (see *supra* at 3.d] and 14.d]).

Please indicate which industry sector views are included in part "**III. Proposals for harmonization**" of this form:

Summary