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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:

The law provides the possibility of protecting certain elements of the outer appearance of a product, separate from trademark or copyright protection.

- 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.

This right is an industrial design registration.

The Mexican Industrial Property Law protects industrial designs which comprise industrial drawings that are understood as any combination of shapes, lines or colors that are incorporated unto an industrial product for ornamentation purposes or to give it a peculiar and unique appearance.

Industrial designs also comprise industrial models, understood as the three-dimensional shape that serves as the pattern for manufacturing a product with a special appearance, **without implicating technical effects**.

In this manner, industrial design rights can protect the appearance or ornamentation of an object or article in two manners. First, industrial drawings can protect the actual colors, shapes or lines that are incorporated in the product. But also, industrial models can protect the three dimensional shape that is used as the pattern to provide the special appearance to the product.

The right of exclusive use over an industrial design is obtained through registration before the Mexican Institute of Industrial Property. Such protection will last fifteen years counted from the respective filing date.

- 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

An industrial design is considered “new” when independently created and significantly different from known designs or the combination of known design characteristics. The Federal Tax and Administrative Justice Tribunal has interpreted this requirement in the sense that an industrial design cannot be conformed of other previously known designs or the combination of their characteristics.

b) non-obviousness

c) inventive step

d) individual character

e) originality

f) aesthetic

g) ornamental

h) other, namely ...

The requisite of being susceptible of industrial application, which means that it should be susceptible of production or use in any economic activity.

- 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:

As previously mentioned, the law divides industrial designs into industrial drawings and industrial models. For both definitions, however, the law refers to non-functional aspects. For industrial drawings the law indicates that they should have an ornamentation purpose and therefore, a shape that is strictly functional would not be susceptible of being protected as an industrial drawing. Similarly, the definition of industrial models indicates that they should provide a special appearance without implicating technical effects. Thus, based on the definitions used by the law, a strictly functional shape would not, in our opinion, be considered as either an industrial model or an industrial drawing.

More importantly, the law clearly provides that the protection granted to industrial designs shall not comprise characteristics or elements that are dictated exclusively by technical reasons and do not contain an arbitrary contribution of the designer. Designs comprised exclusively of such elements will not be registered.

Therefore, an exclusively functional design that does not incorporate an arbitrary contribution from the designer cannot be protected in Mexico through an industrial design registration.

- 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

The law provides that an industrial design will not be protected if **exclusively** conformed of elements and characteristic that are functional and do not comprise an arbitrary contribution from the designer. The design has, therefore, to be evaluated in its overall appearance and should not be refused protection only on the basis that certain isolated elements or features are functional.

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 ...

- 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?

no

Please explain:

The law provides that the protection will not include elements or characteristics that are dictated exclusively by technical reasons and do not contain an arbitrary contribution of the designer. Still, the law clearly provides that it will deny protection to designs conformed **exclusively** of such elements and characteristics. Therefore, the fact that a certain portion of the design is functional is not in itself sufficient to refuse the registration of the design. Instead the overall appearance should be considered. The functional elements should not and cannot be separated from the overall appearance

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 ...

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

When determining infringement, the overall appearance of the design should be considered, but infringement cannot and should not be avoided on the basis of differences in functional elements alone due to the law's mention that such elements are not included in the protection.

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

Since the law provides that a design will not be protected if exclusively conformed of such portions, then they cannot be considered separately for determining the validity, but they may play a role in determining if the design as a whole is exclusively conformed of functional elements.

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"

The current protection encompasses industrial drawings and industrial models, but those two divisions do not necessarily encompass all possible elements from the appearance of a product. The word "incorporated" used on the definition of industrial drawings may not be entirely adequate for defining them as it refers to joining or putting together onto the product and not necessarily covers all the possibilities of the visual design of an object.

b) the requirements for protection of a design

The Group considers that a discussion is desirable on the subject whether industrial applicability of designs should be a requirement for design protection.

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

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:

Yes, definitions and parameters of the aspects or features to be evaluated, such as novelty, degree of difference against other designs, functionality, individual character, etc

### 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.

yes

Please explain:

The Group considers that harmonisation is generally desirable in the current context of globalized market so there is more certainty about the role of the design system around the world for both right holders and potential competitors. In that context, harmonising the definitions of what may be protected as a design and the requirements for such protection, including the treatment of functionality, for the purposes of both assessing validity and infringement is necessary.

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:

The outward appearance of a product should be protected and harmonizing the definition and extent of that right is necessary to provide legal certainty in the international market to both right holders and their competitors.

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

Industrial Model

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

Novelty would be a necessary requirement to justify the existence of such right. If the design were already used or known, then the respective right should not be granted. Novelty for this purpose should not be understood as the distinctiveness demanded for trademarks or the non-obviousness demanded for inventions but only as the fact that the design should not have previously existed and that it should not be a simple juxtaposition of already existing elements. Changes in respect to designs that already existed should be noticeable to justify. In this manner, the protection of designs is justified in that such protection will promote innovation in respect to the outward appearance of a product.

b) non-obviousness

c) inventive step

d) individual character

e) originality

Originality understood as the design having an arbitrary contribution from the designer to the appearance of the product would be necessary to ensure that the protected outward shape of the product is not merely functional. If the designer does not provide an arbitrary contribution then the design is entirely functional and should not be protected through design rights.

f) aesthetic

g) ornamental

The main purpose of the shape should be ornamentation of the product rather than functionality. There already are other intellectual property rights for protecting novel technical solutions and the design protection system should not be a tool for maintaining exclusivity over such solutions but only over the arbitrary outward appearance given to a specific product.

h) other, namely ...

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

yes

Please explain:

An appearance dictated exclusively by functionality does not imply an arbitrary contribution to the design. If the purpose of design protection is to promote innovation in respect to the outward appearance of products, then it is evident that a design that is absolutely functional and lacks an appearance that is arbitrary and not dictated by function should not be protected.

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

The overall appearance would be the primordial factor as the fact that certain portions of the design are functional do not imply that the design is not new or that it lacks originality or that its appearance is not ornamental. If the overall appearance has originality, is new and has an ornamental purpose then the design should be protected in spite of having certain functional portions.

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?

no

Please explain:

No. Protection should not be evaluated with respect to features/elements taken independently from the overall appearance, irrespective whether such features/elements are functional or not. However, mere functional portions are desirable to be identified when assessing infringement or validity.

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

Yes, in order for a design to be infringed, all portions should be substantially replicated. However, infringement should not be avoided alleging differences in functional portions only.

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

Yes, in order to evaluate if a design is valid, all portions should be taken into account, but validity cannot rely on functional portions only. e.g. alleged lack of novelty should not be overcome by considering differences in functional portions only.

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?

21) If yes, why?

The Group considers that harmonisation is generally desirable in the current context of globalized market so there is more certainty about the role of the design system around the world for both right holders and potential competitors.

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.



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 Group considers that a discussion is desirable on the subject whether industrial applicability of designs should be a requirement for design protection.

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

The views included are those of the Mexican Industry and their chambers.

#### Summary

Mexico’s protects the outer appearance of products through the registration of industrial designs, providing that new industrial designs susceptible of an industrial application can be protected in such manner. However, such protection will not be granted to characteristics or elements dictated exclusively by technical reasons and that do not convey an arbitrary contribution from the designer. A design composed **exclusively** of such characteristics or elements will not be granted registration.

The group does consider that a design with an appearance dictated exclusively by its technical function should not be protected in this manner and that any proposed harmonization should foresee such refusal of protection. However, the group also considers that designs should be studied in their entirety for both deciding their possible protection and deciding on their enforcement and therefore that functional elements should not be separated from the overall design. The mere existence of a functional element does not imply that the design as a whole is not new nor should possible infringements be decided exclusively on the basis of the reproduction of a functional element.

The Group considers that harmonisation is generally desirable in the current context of a globalized market so that there may be more certainty about the role of the design system around the world for both right holders and potential competitors. The design systems of each country should be harmonized as to provide effective and legally certain means to protect the appearance of their products in a worldwide scale.