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2016 – Study Question (Designs)

Sarah MATHESON, Reporter General
John OSHA and Anne Marie VERSCHUUR, Deputy Reporters General
Yusuke INUI, Ari LAAKKONEN and Ralph NACK, Assistants to the Reporter General
Requirements for protection of designs

Responsible Reporter: Anne Marie VERSCHUUR

National/Regional Group	Republic of Korea
Contributors name(s)	Nam Yeon KWON
e-Mail contact	nykwon@KimChang.com
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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:

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

- 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.

Registered design

- 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

b) non-obviousness

c) inventive step

d) individual character

e) originality

f) aesthetic

g) ornamental

h) other, namely ...

other, namely creative difficulty, instead of non-obviousness or inventive step. The creativity of a design signifies that a person with ordinary skill in the art cannot easily create a given design from internationally or domestically known designs, or from domestically well-known shapes, patterns, colors, or a combination thereof.

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:

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 ...

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:

We assume that you are referring to "partial designs" when using the phrase "any portions (e.g. a "feature", "element") of the overall design," and thus we answered this question with this

understanding.

- 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
- 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"

In the July 2014 amendments to the Design Protection Act ("Act"), there was a discussion to abolish the requirement that the design should relate to an article. This would have permitted the enforcement of a design registration against other designs with identical or similar concepts regardless of the article in question. However, this amendment was ultimately rejected because of the potential conflicts that

may arise with the current Act, which is entirely based on the fact that a registered design should always be for a particular article. That said, we believe Korea's current law could be improved in this aspect given the development of today's commercial environment where visual designs are favored over product designs.

b) the requirements for protection of a design

We do not believe further improvement regarding this issue is necessary at this time.

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

We do not believe further improvement regarding this issue is necessary at this time.

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

no

Please explain:

Our comments regarding policy considerations and/or proposals for improvement have been addressed above.

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:

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?

Design

Note: We believe the term "design" is the most appropriate term from a harmonization perspective as the term encompasses "the outward appearance or ornamentation of an object," etc.

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

e) originality

f) aesthetic

g) ornamental

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:

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?

21) If yes, why?

We find that harmonization of design rights is fairly accepted worldwide given the globalization of businesses. At least, from a procedural aspect, the acceptance of harmonization is evident from the willingness of various countries to become part of the Hague System for the International Registration of Industrial Designs. However, despite the conveniences of the Hague System, applicants must still invest more time and costs to conform to the examination and registration standards of each country. Therefore, in order to address the foregoing, we believe it would be prudent to at least have harmonization in the three areas mentioned in question 9 above.

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.

Please see our comments above.

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

Summary

We believe the Korean design practice, including the application of the Design Protection Act, is fairly comprehensive with regards to the requirements for protecting a design and the treatment of functionality. However, certain improvements can be made to the design practice within Korea and on a worldwide basis given the globalization of businesses and development of technology, specifically in connection to visual designs.

More specifically, we propose that the Korean Design Protection Act can be improved to permit the enforcement of a design registration against other designs with identical or similar concepts regardless of the article in question. This improvement may be vital for in light of the development of today’s commercial environment where visual designs are favored over product designs.

From a harmonization perspective, we believe further steps can be taken to harmonize the definition of a design, requirements for design protection, and treatment of functionality, because differences in the foregoing lead to varying examination and registration standards. As a result, applicants end up investing more time and costs for their design applications despite the conveniences of the Hague System for the International Registration of Industrial Designs.