



Submission date: 25th April 2016

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	Vietnam
Contributors name(s)	Ageless IP AGENT
e-Mail contact	patent@ageless.com.vn
Date	14-04-2016

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 Article 4.13 of Law No. 50/2005/QH11 of November 29, 2005 on Intellectual Property and Law No. 36 of June 19, 2009 amending and supplementing a number of Articles of the Law on Intellectual Property defines:

Industrial design is appearance of a product expressed in shapes, lines, dimensions, colors or any combination thereof.

- 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 Design Patent

- 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 shall be considered as new if it significantly differs from other industrial designs that are already disclosed by way of use or description in writing or in any other forms inside or outside the country prior to the filing date or the priority date, as applicable, of the industrial design registration application.

b) non-obviousness

c) inventive step

Inventive step is also refer as creative step in the Vietnam Intellectual Property Law

An industrial design shall be considered as creative (inventive) if, on the basis of an industrial design already publicly disclosed by use or by means of a written description or any other form inside or outside the country before the filing date or the priority date, as applicable, of the industrial design registration application, it cannot be easily created by a person with ordinary skill in the art.

d) individual character

e) originality

The design rights shall be granted for the author or investor of the design or for someone acquiring the transfer of right to file design application from the author or investor of the design.

f) aesthetic

g) ornamental

h) other, namely ...

Susceptible of industrial application

An industrial design shall be considered as susceptible of industrial application if it can serve as a model for mass manufacture of products with appearance embodying such industrial design by industrial or handicraft methods.

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 Article 64.1 of the Law on Intellectual Property regulates that appearance of a product that is dictated solely by its technical features of the product shall not be protected as industrial design.

- 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

If the technical function of the product can be still achieved by various appearances, the product shall be protected as industrial design.

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:

There are no specific regulations.

- 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 ...

There are no specific regulations

- 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

When assessing infringement, only substantial or fundamental features of the patented design and the design in question are compared. Any feature dictated solely by its technical function (for example: the

flat shape of data-recording disks is dictated by the relative motion between disks and reading heads) shall not be regarded as a substantial feature of the design. Thus, functional portions will not be taken into account for consideration of infringement.

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

When assessing novelty and creativity of an industrial design, only substantial or fundamental features of such design and the prior art are compared. Any feature dictated solely by its technical function (for example: the flat shape of data-recording disks is dictated by the relative motion between disks and reading heads) shall not be regarded as a substantial feature of the design. Thus, functional portions will not be taken into account for 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 practice, the current law provides protection for the whole designs but not for partial designs. The whole designs are designs of products or parts of product which are separable. The designs of parts of product which are not separable (partial designs) are not protected under the current legislation. However, the definition of a design in the current law does not clearly state this fact. The law should clearly provide that a design means the whole design or partial 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

We propose the 3 following types of design for convenient evaluation:

+ Type 1: For designs with dominant aesthetic functionality, such as label: it is not necessary to

evaluate the functional element while conducting examination.

+ Type 2: For designs with purely technical functionality: this should not be considered as design for protection.

+ Type 3: For designs combined both aesthetic and technical functionality (designs deemed to be functional): the functional parts should not be taken into account while conducting examination.

However, there is no detailed provision on how to evaluate whether a design or part of a design is solely functional. Therefore, there are cases of confusion or controversial between technical and aesthetic functionality. In fact, it is hard to determine whether designs or part(s) of design are solely functional or not because in practice, they are often combined both technical and aesthetic functionality. Thus, general criteria in evaluation should be provided by the law.

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 current law should adjust the required number of drawing/photos for filing design application by the case. In fact, some parts of design are hardly seen during using process or not easy to take photos for a specific views (for example the perspective view of train coaches or bottom views of vehicles) or some views disclose only parts that are solely functional. Thus, the drawings should be considered as sufficiency if they can be used to identify almost substantial design features which the applicant seeks for protection.

- It should be regulated in detail whether the technical drawing lines which make the product more outstanding (for example, the technical drawing lines show the transparent or curves of a bottle) are acceptable as formality or not. In our point of views, the technical drawing lines should be accepted.

- Regarding the design description, the regulation according to Article 33.5.e of Circular 01/2007/TT-BKHCN which requires an industrial design application to include a description of the design is unnecessary and should be eliminated to reduce the administration procedure. In fact, the industrial design patent does not include this description. Furthermore, the drawings fully disclose the industrial design, so they are totally sufficient for examination as well as for further actions such as infringement assessment.

- The law should provide protection for partial designs. Therefore, the applicant can voluntarily exclude the solely functional features from protection and seeks protection only for new, creative and easthetic features.

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:

We consider that there should be a harmonisation in the requirement of protection of a design and the treatment of functionality. In other words, item 9b and 9c should be harmonized.

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?

no

Please explain:

The definition may depend on the administrative procedures of each country and it does not affect the rights of the design owner.

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

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

The design rights should only be granted to new designs because only truly novel designs justify the reward of exclusive rights and this will encourage the development of industrial designs.

b) non-obviousness

c) inventive step

The design rights should only be granted to creative designs which justify the reward of exclusive rights and this will encourage the development of industrial designs.

d) individual character

e) originality

The design rights should only be granted for the author or investor of the design to prevent someone from acquiring rights without the permission of the author or investor of the design.

f) aesthetic

g) ornamental

h) other, namely ...

Industrial applicability

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

function?

yes

Please explain:

If the appearance of design is dictated solely by its function is protected, no one has the right to use such design except the patentee. This does harm to the benefit of general community.

Functional aspects should be protected only by utility patent rights. Purely functional designs should not be protected by design rights to prevent someone from "going around", acquiring another form of protection for inventions which do not meet requirements of patentability.

- 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 is taken into account when determining whether or not a design is deemed unprotectable as being functional. There are no designs which are totally easthetic because every product play a specific function. Therefore, it is possible that some portions of the overall appearance are solely functional but other portions are not. If only some portions of the overall appearance are solely functional, the design is not solely functional because other portions still contribute to the easthetic value of the overall design.

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

If the same functional result of a product can be obtained by adopting alternative appearances, such appearance is not the only one can be selected. Therefore, it can be argued that such appearance is selected due to its contribution to the easthetic value of the product. Thus, such design is not solely functional.

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:

Design is protected as a whole, not for any specific portions/parts.

- 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

When assessing infringement, only substantial or fundamental features of the patented design and the design in question should be compared. Any feature dictated solely by its technical function (for example: the flat shape of data-recording disks is dictated by the relative motion between disks and reading heads) should not be regarded as a substantial feature of the design. Thus, functional portions should not be taken into account for consideration of infringement.

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

When assessing novelty and creativity of an industrial design, only substantial or fundamental features of such design and the prior art should be compared. Any feature dictated solely by its technical function (for example: the flat shape of data-recording disks is dictated by the relative motion between disks and reading heads) should not be regarded as a substantial feature of the design. Thus, functional portions should not be taken into account for 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?

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.

The subject matters which can be protected as industrial designs vary from country to country. This depends on the level of development and the socio-economic strategy of each country. Therefore, the definition of a design can be different among countries.

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

- National IP Office;
- IP agencies

Summary

The report proposes for improvement regarding the definition of design, the requirement for protection and the factors to determine whether a part/the whole design is deemed to be functional or not. Firstly, the meaning of design should clearly provide that the design means the whole design or partial design based on the separable criteria. Secondly, designs should be divided into 3 types are designs with dominant aesthetic functionality, designs with purely technical functionality and designs combined both aesthetic and technical functionality for convenient treatments. For each types, criteria should be set to specific and reduce the confusion between technical and aesthetic functionality. These divisions also relate to the assessing infringement and validity in which any portions deemed functional will not be taken into account. Furthermore, in the requirements for industrial design patent should supplement the "originality" item. It means that the design rights should only be granted for the author or investor of the design to prevent someone from acquiring rights without the permission of owners. In short, the harmonization between some but not all of three mentioned improvements depends on the level of development and the socio-economic strategy of each country.