



Submission date: 9th June 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	Thailand
Contributors name(s)	Chavalit UTTASART, Kallayarat CHINSRIVONGKUL and Narongcachon CHOMSA
e-Mail contact	chavalitlaw@chavalitlaw.com
Date	10-05-2016

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:

Section 3 of the Patent Act B.E 2522 as amended by the Patent Act No. 3 B.E. 2542 defines:

Design means any form or composition of lines or colors which gives a special appearance to a product and can serve as a pattern for a product of industry or handicraft.

- 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.

Design patent

Section 3 of the Patent Act, patent means a document issued to grant protection for an invention or design under the provisions in Chapters 2 and 3.

- 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

Section 56 of the Patent Act, the following designs are not new:-

(1) a design which was widely known or used by others in the country before the filing of the application for a patent;

(2) a design which was disclosed or described in a document or a printed publication in this or a foreign country before the filing of the application for a patent;

(3) a design which was published under the Patent Act before the filing of the application for a patent...

b) non-obviousness

c) inventive step

d) individual character

e) originality

Section 56 of the Patent Act, the following designs are not new:-...

(4) any design so nearly resembling any of the designs prescribed in (1), (2) or (3) as to be an imitation.

f) aesthetic

g) ornamental

h) other, namely ...

- 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 appearance of the design is considered solely on novelty and originality, its function is not a criteria to be considered.

- 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:

The appearance of the design is considered solely on novelty and originality, as a whole.

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)

Any specific functional portions will not be separately considered when neither assessing infringement nor validity.

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

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:

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?

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

This is similar to the explanation in 3) a).

b) non-obviousness

c) inventive step

d) individual character

e) originality

This is similar to the explanation in 3) c).

f) aesthetic

g) ornamental

The ornamental requirement should be added to explicitly define that the design protection is only limited to appearance of the design, excluding its functional feature.

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

The overall appearance should be the main factor in determining the technical function of the design registration.

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

The overall appearance should still be a factor in determining the design for registration. A portion of the functional feature of the design should not be protected.

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

This enhances creativity and creates the opportunity for potential designers to create new designs and obtain their suitable rights and design protection for their creative designs.

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

Similarly, this also enhances creativity and creates the opportunity for potential designers to create new designs and obtain their suitable rights and design protection for their creative designs.

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?

N/A

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.

N/A

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.

N/A

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

Summary