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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	Uruguay
Contributors name(s)	Juan LAPENNE
e-Mail contact	jlapenne@fox.com.uy
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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:

Applicable law in Uruguay is Law No. 17.164 Regulating Rights and Obligations Relating to Patents, Utility Models and Industrial Designs, dated September 2, 1999 (the "Patent Law").

Relevant provisions are included under TITLE IV "PATENTS FOR INDUSTRIAL DESIGNS". Chapter I deals with the "Requirements, Conditions and Scope of Protection".

Article 86 of the Patent Law provides that

*"Original creations of an ornamental nature which, when incorporated in or applied to an industrial or craft product, give it a special appearance shall be considered patentable industrial designs.*

*The ornamental nature may be due among other things to the shape, lines, contours, configuration, color and texture, or material".*

- 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.

The name of the right is 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

b) non-obviousness

c) inventive step

d) individual character

e) originality

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:

Our law specifically states that if the design responds to functionality issues, it cannot be protected by patent designs.

Relevant provision is article 89 of the Patent Law, which reads as follows:

Article 89:

*"The following may not be the subject of an industrial design patent:*

...

*(c) designs whose shape is basically for the purposes of a technical effect or due to requirements of a technical nature or the function to be performed by the product;"*

- 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

Arguable. No statutory provision.

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 ...

Please note that our law dedicates only one sentence [paragraph c) of Article 89 of the Patent Law] to this matter and we are not aware of any jurisprudence addressing the functionality issues in patent designs. Hence, besides the statutory provision, the previous responses can all be arguable as to the extent of the interpretation of the statute.

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:

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 ...

These questions are too specific taking into account that Uruguayan law refers only to the functionality of the object, and does not refer to the functionality of parts of the object. Besides, there is no jurisprudence, so there is no statutory or case law basis to respond to these questions.

Under one interpretation of the statute, it may be possible to affirm the following: if an important part (and no minor parts) of the object is deemed functional, hence the entire object would be deemed functional and hence would not enjoy patent design protection (or could be invalidated if it were registered as an industrial design patent).

## 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"

As regards questions 9 and 10, we deem that the language of the law concerning Industrial Designs has not been sufficiently tested as yet before Courts, and therefore it is too early, for our jurisdiction, to consider amendments to the current law in regard to the issues falling within the scope of this Study Question.

b) the requirements for protection of a design

As regards questions 9 and 10, we deem that the language of the law concerning Industrial Designs has not been sufficiently tested as yet before Courts, and therefore it is too early, for our jurisdiction, to consider amendments to the current law in regard to the issues falling within the scope of this Study Question.

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

As regards questions 9 and 10, we deem that the language of the law concerning Industrial Designs has not been sufficiently tested as yet before Courts, and therefore it is too early, for our jurisdiction, to consider amendments to the current law in regard to the issues falling within the scope of this Study Question.

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:

As regards questions 9 and 10, we deem that the language of the law concerning Industrial Designs has not been sufficiently tested as yet before Courts, and therefore it is too early, for our jurisdiction, to consider amendments to the current law in regard to the issues falling within the scope of this Study Question.

### 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.

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?

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

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?

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?

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?

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.

Again, as mentioned above, we deem that the language of the law concerning Industrial Designs in Uruguay has not been sufficiently tested as yet before Courts, and therefore it is too early, for our jurisdiction, to consider amendments to the current law in regard to the issues falling within the scope of this Study Question, or to make comments or suggestions in regard to potential harmonisation efforts.

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

Summary