

Report Q227

Design

Names and Functions of Committee Members

Chair	Mario Franzosi	(Italy)
Co-Chair	Ivan Poli	(Argentina)
Secretary	Ruth Almaraz	(Spain)
Members	Michiel Haegens Mattias Malmstedt Curtis Behmann Lucas Martins Gaiarsa Robert Wulff Kazuko Matsuo Reinhard Oertli Christopher Carani Sara Ashby	(Netherlands) (Sweden) (Canada) (Brazil) (Australia) (Japan) (Switzerland) (United States) (United Kingdom)
Responsible Reporter	Anne Marie Verschuur	(Netherlands)

Annual Report of Special Committee Q227 Designs written by Mario Franzosi, Ivan Poli, Ruth Almaraz, amended by Curtis Behmann, Christopher Carani, Michiel Haegens, Sara Asby, Reinhard Oertli with comments of Lucas Martis Gaiarsa and Robert Wulff.

Summary:

The Chairman and a majority of the members of Special Committee Q227 propose that AIPPI study the possibility of introducing a **new IP right**, located between the traditional notions of industrial design and patent/ utility patent, as means of protecting the new shape of an industrial product, the shape of which is simultaneously both affecting the appearance and dictated by the function of the product. Other members favour a proposal that AIPPI study the demarcation between and co-existence of design rights (and copyright) and patents/utility models with a view to uniform international protection for features combining appearance-related and functional aspects.

The paradigm of the successful design is a new shape which simultaneously achieves both a new appearance of the product (ideally pleasing the eye) and new function (ideally

increasing efficiency). Novelty, with regard to both appearance and functionality, is the essence of the design of new product or article.

This Committee posits that the traditional notions of design, (copyright), industrial model, utility patent, and utility model, do not address the true needs of designers: in fact, they often seem to deliberately deprive them of protection.

Traditionally *model or design rights* (regardless of the term-used) protect the appearance-related aspects of a given product of manufacture: ideally that which appeals to the eye. But the true *design* (as the term is employed by designers) blends in the same new shape both that which appeals to the eye and that which is useful.

However, there are still national legislations that offer a very limited protection for such a creation. Other jurisdictions force designers to choose between industrial designs and patents or utility patents (or utility models) or navigating any complexities involved with obtaining overlapping industrial design and utility patent protection.

Some laws or some judicial trends explicitly invalidate industrial designs whose shape is exclusively or predominantly or in any way determined by their function; others invalidate utility patents (or models) where the new shape is aesthetic. Thus, those designers who strive to achieve in a single embodiment an appearance-related as well as a functional effect (and this is the essential task of a designer), are deprived from uniform protection. The efforts to harmonize on an international level the protection of design result in harmonizing the appearance of a legal phenomenon that differs in all countries.

This Chairman and a majority of the members of the Committee therefore proposes to bridge this gap between the appearance-related and the functional effects by introducing a **new IP right** *that would provide protection to features that both pertain to the appearance of the product and are solely dictated by the technical function of the product, even if they are the only form of embodying a technical idea and form the main protection of features of appearance and of functional features.* Some members propose to achieve the same goal by allowing design protection for features of appearance that are exclusively or predominantly determined by function if, the same technical idea can be expressed in more than one form (the multiplicity of forms approach) and by allowing patent or utility patent protection for features that are also aesthetic.

We are aware that, if a new IP right is pursued, this task will entail the need to address other issues as well. First, the terminological issue, insofar as the term “design” has been used, and is currently used, as a synonym for the traditional notion of design. Secondly, insofar as this novel definition of *design* includes a functional aspect, should a substantive examination, including publication and perhaps opposition, be introduced? Thirdly, what should be its term? A shorter term, as for patents and utility models, or a longer term, as currently applied to community designs? Finally, and perhaps most importantly, how can we avoid excessive monopolisation of useful things, apart and beyond patent protection?

Nevertheless, aside from these specific details, this Committee proposes that AIPPI study the issue how to address the need of those designers (and of course of those producers) who seek to achieve, in the same embodiment, the beautiful and the useful, and for whom the current IP rights do not offer adequate protection.

As the establishment of a new IP right proposed by the Chairman and the majority of our Committee would be a long-term project, and modification and international harmonization of two existing IP rights as proposed by other members of this Committee would also take some time, this Committee proposes conducting a survey (perhaps in the context of a

working question on designs) of the ability to protect functional features as “designs” in different jurisdictions and covering, for example: the scope of application of the multiplicity of forms approach, applied by many (but not all) Courts within the EU, the justification of the test of designer’s intention (denying protection to features of a product’s appearance that are “solely dictated by its technical function”); the sole-function exclusion applied by OHIM and some Courts within the EU: the ability to amend existing legislation (if necessary) to introduce functionality as an aspect that (proposition by the Chairman) justifies protection by a new IP right or (proposition by a minority of the Committee members) does not prevent industrial design protection in those jurisdictions where this is not yet the law, and the likelihood of success. This survey would help to determine the likelihood of achieving the current objectives by way of amendment to the current framework, and may help to determine whether there is indeed need for the establishment of the new IP right being proposed by the Chairman and a majority of the Committee.

Our Committee is also involved in following WIPO SCT sessions on the International Design Law Treaty, actively participating on Convergence programmes of OHIM on Community Designs, liaison meetings, seminars and user groups meetings as Current and future issues

Deadline for any action: Whenever is requested by letter by chair, co-chair or secretary.

Action recommended: Develop a regular working question on designs. Give opinions and suggestions concerning the introduction of a new international harmonized concept of design protection that will (proposition by the Chairman) include functionality or (proposition by the minority) not exclude functionality-related features from protection.

Report of Committee’s activities

Activities of Special Committee during reporting period: Any members are encouraged to inform us about the relevant judgements, decisions or/and amendments on design Laws in their respective countries.

Project of organising small congresses on Designs within the context of AIPPI national groups. In particular, our Committee Chair, Mario Franzosi, has already prepared a congress on designs for the EXPO 2015 to be held in Milan.

Participating actively in the AIPPI annual congresses in workshops. In particular, some of our members are involved in the Mock international arbitration on designs of the Toronto Congress. We have also made several proposals for future workshops during annual Congresses.

Recommendations and priorities for the following year’s work of our Committee

Our members are particularly requested to inform AIPPI about the related changes to be implemented in their respective jurisdictions concerning the Hague Agreement, including identifying the increased harmonization that will result.

Following the OHIM liaison meetings concerning designs, WIPO SCT sessions about further developments on the International Design Law Treaty, participating actively on OHIM convergence programmes on designs and OHIM users group meetings.