



Standing Committee on **Designs**

2017



Date: 14th October 2017

REPORT Standing Committee on

Designs

Chair: Christopher CARANI

Responsible Reporter: Anne Marie Verschuur

1) Report on the activities of your Standing Committee during the reporting period

Please provide a general overview of the activities of your Standing Committee over the last 12 months, including at least:

a) Internal meetings of the Standing Committee during the reporting period (whether by telephone, video conference or in person);

1) The Designs Committee met during the AIPPI Milan Congress last September 2016.

2) The Designs Committee also conducted meetings via teleconference on 23 February 2017 and on 28 June 2017.

b) any external representation on behalf of AIPPI by any member of your Standing Committee;

1) The Designs Committee member Irmak Yalciner represented AIPPI during the 36th Geneva Sessions on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) held from 17 to 19 October 2016.

2) The Designs Committee co chair Ruth Almaraz represented AIPPI during the EUIPO User Group meeting of 6 April 2017, together with Elena Molina (Trademarks Committee secretary). She also represented AIPPI during the EUIPO Seminar of 12 June 2017, called "IP Case Law laboratory" regarding functional trademarks and designs and disclosure of designs. She represented AIPPI as well during the last meeting of the CP07 Project at the EUIPO on 8 February 2017, concerning the new Locarno Classes/SubClasses of Designs.

c) any contribution by your Standing Committee to any external consultations; and

1) The Designs Committee prepared a reply to the WIPO GUI Survey, which was submitted by AIPPI on 15 January 2017.

2) The Designs Committee (particularly chair Christopher Carani and secretary Sara Ashby) supported the preparation of the Resolution on the Designs Study Question before and during the Milan AIPPI annual congress that took place in September 2016.

- d) any studies or analyses undertaken or position papers prepared by your Standing Committee, with a brief summary of the outcome(s).
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1) The book "Design Rights: Functionality & Scope of Protection", product of a collaboration between AIPPI and Kluwer, was finished. Christopher Carani edited the book and many Designs Committee members contributed to the book.

2) The Designs Committee will be involved in the partial Designs Study Question for the next Congress.

3) Participation at national group level in the replies to the GUI Protection Study Question for Sydney (by Curtis Behmann, Christopher Carani, Sara Ashby, Irmak Yalciner, Markus Mattila, Reinhard Oertli, Irmeli Nokkanen).

4) On 16-17 March 2017, the Polish, the German and the French Groups of AIPPI, with the participation of the AIPPI Bureau, organized a joint seminar on intellectual property related issues. The seminar covered inter alia the design (and trademark) topic "*The notion of functionality in trademark and design matters*". Jens Künzel (DE) from our committee, Aurélia Marie (FR) and Ewa Skrzdźko-Tefelska (PL) gave very interesting lectures and the design committee member Klaudia Blach Morysinska was the moderator of the design topic.

- 2) Key issues/developments during the reporting period

Please include any significant case law, legislative or regulatory developments, or policy initiatives, including their relevance and/or any implications for the work of your Standing Committee or for AIPPI more generally.

1) The Israeli branch of AIPPI is organizing a conference with regard to the new Israeli Designs Law. The conference will be held on September 19, 2017, and includes sessions by the chairman of the economic Affairs Committee of the Israeli Parliament, the former Patents, Designs and Trademarks Registrar, Patent Office Officials, private practitioners, and others. The Designs Committee member Saar Alon is the co-organizer. He has also reported about a Jerusalem District Court decision from June 25, 2017 in *Apple Inc. v The Registrar of Patents, Designs and Trademarks*, which overturned a decision by the Registrar of Patents, Designs and Trademarks rejecting an Apple design application with respect to the design of a tablet device on the grounds of prior publication. The court based its ruling on among others prior registrar decisions, according to which examination of prior publication must, first and foremost, determine in close proximity the date of publication.

2) The Designs Committee member Irmak Yalciner is a Board Member of AIPPI Turkey and within this perspective she has worked actively during the drafting and discussion stages of *the Regulation on Industrial Property Law*, publication date April 24, 2017 and *Disciplinary and Code of Practice Regulations of Patent and Trademark Attorneys*, publication date May 18, 2017, with the Turkish Patent and Trademark Office (Turk Patent). AIPPI Turkey submitted suggestions/positions on each regulation and also had meetings with Turk Patent's Management Board and other national Associations.

3) The Designs Committee member Reinhart Oertli reported that a Swiss decision was rendered in the past year that dealt with design rights and passingly with functionality as not being relevant for assessing design right violation. In the Swiss Supreme Court case 4A_565/2016 of 2 May 2017, Frédéric Jouvenot attacked Christophe Claret's wrist watch Marguerite (face side), based on his Swiss registered design 137873 for the timepiece sold under the trademark Surya, but failed both before the Cantonal Court of Neuchâtel and the Federal (Supreme) Court for lack of similarity. Contrary to the opinion of the cantonal court (referring to "technical details" or to the existence of "technical features"), the characteristics which are technically necessary were deemed not essential. On the other hand, functional and aesthetic elements are not excluded from protection.

4) The Designs Committee member Robert Wulff reported that no significant court cases on designs were decided in Australia this year. However, a few cases were decided in the Australian Designs Office, including one dealing with the vexed issue of copyright/design overlap. The copyright/design overlap is still an uncertain area of the Australian law.

5) The Design Committee member Lili Wu reported that the Chinese patent law concerning designs is under process of amendments. One of the changes is that the patent term of a design patent can be extended from 10 years to 15 years if the patentee requests the extension of protection at the end of 10 years. It is not expected that the new patent law can be finalized in 2017. Concerning Chinese case law, the first invalidation decision regarding a GUI design patent was recently decided by the Patent Reexamination Board. The decision concerns animation GUI design. One of the points in this decision is that both hardware products carrying GUI and GUI itself are considered when comparing with prior designs, but the GUI itself is regarded as more important to the overall visual effect of the whole design because the hardware product carrying the GUI has been disclosed in a prior design and the brief description of the design states that the GUI is the key designing point. In addition, the decision touched on whether or not the layout of a GUI is protectable under a design patent and the conclusion is that layout itself, such as webpage layout, is not protectable but the layout of a GUI is protectable if it relates to the function of software. The invalidation dispute is between a subsidiary of Alibaba as the patentee and a Beijing software company as the petitioner. The case is now pending on appeal, at the Beijing IP court, for review.

3) Any recommendations for AIPPI involvement/action for the next 12 months

This need not be limited to recommendations for your Standing Committee but can be recommendations for AIPPI more broadly. For example, please include:

In each case, please explain why such involvement/action is recommended, by whom it should be undertaken and any relevant time frames.

- a) any recommendations for involvement/action in relation to any upcoming or foreshadowed case law, legislative or regulatory developments, or policy initiatives;

The issue of functionality in design rights, both with respect to whether a design right should be afforded and whether portions of such design should be denied protection, is a continuing issue of confusion. There is significant discord between EU designated national courts dealing with cases on the infringement of community designs. It is the sincere hope of the Designs Committee that the courts and interested parties will refer to the Resolution passed at the 2016 Milan Congress on this issue. For further analysis on the topic, reference is made to the recently released book "Design Rights: Functionality & Scope of Protection" (see also above).

- b) any other recommendations for AIPPI involvement/action;

1) We recommend the active participation of AIPPI in the activities, seminars and convergence programs organized by the EUIPO, WIPO, EPO, National Offices, etc.

2) It is recommended that AIPPI have a presence at the USPTO Design Day. The AIPPI Designs Committee can provide a unique perspective to the discussion.

- c) any recommendations for the work programme of your Study Committee.

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4) Outline of the work programme of your Standing Committee for the next 12 months

Please set out specific activities and priorities having regard to the matters in 1) - 3) above, including any relevant time frames.

1) The Designs Committee will represent the AIPPI at the ID5 Annual Meeting in December 2017.

2) The Designs Committee plans to be active in helping prepare the Study Question on Partial Designs for the 2018 Cancun Congress.

3) The Designs Committee will continue to monitor and track developments in design law throughout the world.

AIPPI

Names and Functions of Committee Members

Chair(s)	Christopher CARANI	United States
Co Chair(s)	Ruth ALMARAZ PALMERO	Spain
Secretary	Sara ASHBY	United Kingdom
Members	Saar ALON	Israel
	Cristiano BACCHINI	Italy
	Curtis BEHMANN	Canada
	Klaudia BLACH - MORYSINSKA	Poland
	Subroto BOSE	United States
	Pina CAMPAGNA	United States
	Crystal J. CHEN	Taiwan
	Fernand DE VISSCHER	Belgium
	Patrice DE CANDÉ	France
	Aysu DERICIOGLU EGEMEN	Turkey
	Octavio ESPEJO	Mexico
	Mario FRANZOSI	Italy
	Lucas Martins GAIARSA	Brazil
	Qing GE	China
	Arnout GROEN	Netherlands
	Michiel HAEGENS	Netherlands
	Hanna Karin HELD	Germany
	Jens KÜNZEL	Germany
	S. Yong LEE	South Korea
	Johan LOJE	Denmark
	Mattias MALMSTEDT	Sweden
	Kazuko MATSUO	Japan
	Markus MATTILA	Finland
	Saulo MURARI CALAZANS	Brazil
	Koichi NAKA	Japan
	Irmeli NOKKANEN	Finland
Reinhard OERTLI	Switzerland	
Iván POLI	Argentina	
Wayne SLATER	Australia	
Simon STRÄSSLE	Switzerland	
Lili WU	China	
Robert WULFF	Australia	
Irmak YALCINER	Turkey	