



Date: 23rd September 2018

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);

The Designs Committee met during the AIPPI Sydney Congress on October 2017 and during INTA Seattle on May 2018. Additionally, the Designs Committee also conducted meetings via teleconference on February 20, 2018 and May 10, 2018.

b)
were proposals for panel sessions and study questions submitted and/or did your Standing Committee further contribute in this respect (e.g. by providing input to the draft Study Guidelines)?

The Designs Committee (particularly chair Christopher Carani and vice chair Sara Ashby) supported the preparation of the Resolution on the Designs Study Question before and during the Sydney AIPPI annual congress that took place in October 2017 and before Cancun AIPPI Congress. The Designs Committee also assisted the Bureau with preparation of the Questionnaire and Report on Partial Designs.

c)
any external representation and participation in working groups on behalf of AIPPI by any member of your Standing Committee (e.g. at WIPO, EUIPO);

- Christopher Carani represented AIPPI at the ID5 Conference, which took place in December 2018 in Alicante, Spain at the EUIPO.

- Ruth Almarez together with Marieke Westgeest (AIPPI trademarks committee) to the EUIPO User group meeting that was held in Alicante on March 22nd, 2018.
- Ruth Almarez will represent AIPPI in a Conference on Trade Marks and Geographical Indications: Future Perspectives, organized by the EUIPO and the Directorate General Agriculture.
- Irmak Yalciner represented AIPPI at the WIPO 38th Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) Meeting in Geneva on October 30 to November 2, 2017 and presented "AIPPI Resolution on Protection of Graphical User Interfaces". Irmak Yalciner also attended WIPO 39th Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) Meeting on April 23 to April 26, 2018 in Geneva for representing AIPPI.

d)

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

- Accession of new countries (U.S., Japan) to the The Hague System for the International Registration of Industrial Designs, which provides applicant the ability to register up to 100 designs in over 64 territories through the filing one single international application.
- Monitor and contribute input to the the Design Law Treaty, which is a treaty currently being negotiated at the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications ("SCT")
- Monitor and contribute input to the the amendments of the Polish Industrial Law and IP Box regulation through AIPPI Polish group
- Discussion and debates of several members of the committee about the concept of designs all over the world and how to develop tools to harmonize design rights
- Comparative analyses of the treatment of the issue of functionality has on issues of validity and scope of protection
- Giving general comments and opinion about design cases in different countries amongst committee members (whenever the decisions and judgments are given)
- Attending WIPO sessions about designs (October 30 to November 2, 2017; April 23 to April 26, 2018)
- Organizing internal committee meetings within the annual congresses of AIPPI (every year)
- Proposal of having regular (perhaps monthly) calls, and varying the times of their telecons so that everyone gets a chance to participate in at least some of the calls
- The Design Committee prepared and submitted comments to the Supreme Court to the People's Republic of China draft interpretations of patent rules, including design patent rules.
- Christopher Carani was an invited speaker at the AIPPI and EUIPO Confernce, which took

place in April 2016 in Alicante Spain at EUIPO. Christopher Carani also participated in high level meeting with EUIPO personel and AIPPI Bureau members.

e)

any studies or analyses undertaken or position papers prepared by your Standing Committee, with a brief summary of the outcome(s).

- The Designs Committee will be involved in the partial Designs Study Question for the next Congress.
- Participation at national group level in the replies to the Partial Design Study Question for Cancun (by Christopher Carani, Sara Ashby, Ruth Almarez, Hanna Held, Jens Kunzel)
- The Designs Committee participated in "Trademarks, Designs and more - AIPPI at the EUIPO" seminar held on April 26, 2018 in EUIPO, Alicante, Spain. Christopher Carani (as moderator) and Klaudia Blach-Morysinska (as speaker) took part in Panel session on Functionality in trademarks and designs - comparison of the tests and case law updates. Sara Ashby was a moderator of panel session on Design protection in practice. Moreover Chris Carani and Ruth Almarez gave brief report on Designs Committees works.
- On April 5-6, 2018 The 5th of AIPPI Turkey's Traditional Intellectual Property Law Seminar. Klaudia Blach-Morysinska took part in in Trademark - Design - Artistic Works Mock Trial.
- On April 30 - May 1, 2018 Klaudia Blach-Morysinska took part as a speaker on "The 3rd International Convention on The Economy of Innovation." organized by AIPPI Israel group.
- Mexican group of AIPPI is organizing an event on September 28, 2018 at Mexico City. The event will explore experiences of joining the Hague Agreement. One of the panels will refer to analysis from the Mexican perspective with a couple of Mexican Design Agents and a Representative of the Mexican Institute of Industrial Property.
- On 15 June 2018, AIPPI German national group held its annual Seminar in Düsseldorf where Jens Kunzel presented the report on behalf of the study group.

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.

- Argentine

On January 10, 2018 the Argentine government issued Emergency Decree No. 27/2018 which included a number of provisions on trademarks, patents and designs. The main changes involve non-prejudicial disclosure, multiple and divisional applications, simpler formal

requirements, easier rules for renewal, reinstatement of expired designs, and deferred publication. A provision set forth in the 2015 draft bill which regrettably was not picked up by the decree was an extension of the term from 15 years (three 5-year terms) to 25 years (five 5-year terms).

- European Union

It is worth to mention following EU case law:

concerning Functionality [Art. 8(1) CDR] Judgment of General Court case C-395/16 DOCERAM of 8/03/20, where Court ruled that:

"1. Article 8(1) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs must be interpreted as meaning that in order to determine whether the features of appearance of a product are exclusively dictated by its technical function, it must be established that the technical function is the only factor which determined those features, the existence of alternative designs not being decisive in that regard.

2. Article 8(1) of Regulation No 6/2002 must be interpreted as meaning that, in order to determine whether the relevant features of appearance of a product are solely dictated by its technical function, within the meaning of that provision, the national court must take account of all the objective circumstances relevant to each individual case. In that regard, there is no need to base those findings on the perception of an 'objective observer'."

concerning Disclosure [Art. 7 CDR] General Court, 13/12/2017, T-114/16, Delfin Wellness GmbH (saunas) [Art. 7(2) CDR]: a disclosure of designs 12 months before the grace period prior to the date of priority claimed;

concerning Individual character [Art. 6 CDR] General Court, 18/07/2017, T-9/15, Chanel SAS v EUIPO;

concerning Representation [Art. 4(1)(c) CDIR, Art. 36(1)(c) CDR: representation of the design suitable for reproduction General Court (GC), 09/02/2017, T-16/16, Mast-Jägermeister SE.

- Germany

The Federal Supreme Court's judgment in the case Perfume Trademarks, rendered on November 9, 2017 (BGH GRUR 2018, 84 – Parfummarken [Perfume trademarks]), has considerably affected the way in which Union Trademarks and Community Designs may be asserted before German courts. Although technically a trademark decision, the enforcement of Community Designs will – at least for the time being – considerably be affected by it. At issue is the appropriate court venue for cases where the defendant has committed several potentially infringing actions in different countries – quite a regular scenario in Europe's interdependent business world, regardless of whether a Union Trademark or a Community Design is asserted.

On 23 November 2017, the Federal Patent Court, has decided on case where a design

consisted of seven slightly different depictions of a sports helmet (BPatG GRUR 2018, 725-Sporthelme [Sports helmets]). The issue was whether the design concerned a “unitary subject-matter”. In this kind of situation, the current case law in Germany says that the subject-matter of a design has to be interpreted, having regard to an (optional) verbal description, the obligatory identification of the product concerned or the (optional) specification of the class of goods concerned. The leading authority on this issue is a 2012 decision of the Federal Supreme Court (“Decanter”). In “Sports Helmet”, the Federal Patent Court now says that the design in question did in fact concern a unitary subject-matter as all depictions showed the same basic form and only differed in ornamental features of its surface. The court expressly made use of a rule in Decanter which said a potential result of the interpretation may be that a design consisting of several different depictions may concern a subject-matter whose features are the intersection of those features present in all depictions. The basic form consisted of features present in all depictions. The court admitted a further remedy to the Federal Supreme Court, arguing that there are still unresolved questions with regard to this result as the Supreme Court, in the Decanter case, had also said that a protection only of elements of a unitary design was not in line with German and European design laws. To resolve this apparent ambiguity, the Federal Patent Court admitted a further remedy to the Supreme Court.

The Federal Supreme Court has decided a design case in June 2017 (BGH GRUR 2018, 72 – Bettgestell [Bed frame]) concerning a bed frame sold in Germany by IKEA. That bed frame had been challenged by a plaintiff who asserted that this bed frame infringed his national design right. IKEA had claimed a right of prior use and asserted that it had made “serious and effective preparations” to the commencement of use that gave rise to such a right. Such right of prior use, if it can be established, is a valid defence against a claim for design infringement. It can be established if the defendant has “in good faith commenced use within Germany, or has made serious and effective preparations to that end” of a design which corresponds with the attacked product. IKEA sought to establish a right of prior use based on the second aspect “serious and effective preparations”. District Court and Court of Appeal had dismissed the complaint. The Federal Supreme Court now says that IKEA may not be allowed to put forward a defence based on a right of prior use because the “serious and effective preparations” must have been made in the territory of Germany and not, as IKEA had claimed, in Sweden.

A decision rendered by Germany’s Federal Supreme Court on 11 January 2018 (“Ballet dancer shoe”) (BGH GRUR GRUR 2018, 832 – Ballerinaschuhe [Ballet dancer shoe]) sheds light on the question which party has the burden of proof for facts concerning the scope of protection of the design, or, respectively, for facts pertaining to prior art that would potentially limit the scope of protection. The court has now decided that “circumstances which reduce the scope of protection of a design are in principle not among the facts that the plaintiff must disclose on his own initiative. It is the responsibility of the defendant who has been sued on the basis of the design to present facts as to this issue.” In other words: The plaintiff is not under a procedural duty to present facts (i.e. prior art) that would potentially limit the scope of protection of his own design; it is rather the defendant who has to present these facts. However, the plaintiff is under a procedural duty to present facts that would

support the assumption that the challenged product is an infringement, i.e. that it does not have a different overall impression than the claimed design right. He is also under a duty to present prior art that would support his contention that the design in suit has a broad or normal scope of protection, i.e. that there is a relevant distance between the prior art and the claimed design.

- Israel

New Israeli Design Law comes into force on August 7, 2018. The new law introduces cumulative requirements for novelty and individual character. The term of protection for registered designs filed on or after the new law comes into force, will be 25 years, effective from the Israeli filing date. The new law replaces the requirement for local novelty with a requirement for absolute novelty. A design that is novel and has individual character may be protected as an unregistered design. A grace period of 12 months was introduced by this law. Multiple design applications may be filed.

- Mexico

The Industrial Design chapter of the Mexican Industrial Property Law (IPL) was amended. The concepts of "independent creation" and "significant degree" were defined and included in the law to evaluate the novelty of an industrial design. The registration of industrial designs is now valid for five years, from the filing date of the application, and it may be renewable for successive periods of the same duration (5 years) up to a maximum of twenty five years. Previously the validity was for 15 years. Publication of the pending industrial design application will take place as soon as possible after the formal examination has been approved, without possibility of requesting an anticipated publication. Before the reform, industrial design registrations were published only after granted.

- Switzerland

In a decision of the Swiss Federal Supreme Court, 12 July 2017 - case no. 4A_115/2017 the Swiss Federal Supreme Court made interesting remarks regarding the relationship between copyright protection and protection as registered design. The areas of copyright protection on the one hand and of protection as registered design on the other hand differ in that copyright law protects the "individual", design law protects the "original" creation. The protection of both laws applies to works of creative design. In view of the varying degrees of protection, it follows from the basically identical protective purpose that the standard of individuality in copyright law must be higher than the one for originality in design law. A work of applied art protected by copyright can therefore only exist if the artistic design of a product indisputably, clearly and distinctly meets (at least) the requirements for protection as registered design. For the originality required for design protection it is necessary that persons with a direct interest in purchasing products with such a design consider the overall impression of the claimed design distinctly different from the body of designs already known. Since works of applied art are determined by their intended use, it is decisive whether the artistic design in the context of this purpose differs distinctly from the designs already known so clearly that it appears to be "individual" for copyright protection, or

"original" for design law protection.

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;

not responded

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 continued 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 Standing Committee.

We would like to recommend for future discussion in the Committee, or as a potential future design topic for a study question, the issue of different and contradictory design depictions/pictures, possible solutions regarding the interpretation of such designs, their scope of protection and the ways different jurisdictions have so far treated this problem.

The issue of double patenting as it applies to designs is also ripe for discussion.

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.

In-person meeting in Cancun

Quarterly telephonic meetings

Continued monitoring of design law, both case law and legislation

AIPPI Standing Committee on Designs

Commenting on any external inquiries

Participating in SCT and WIPO and ID5 conferences

AIPPI

Names and Functions of Committee Members

Chair	Christopher CARANI	United States of America
Vice Chair(s)	Sara ASHBY	United Kingdom
	Klaudia BLACH - MORYSINSKA	Poland
Members	Ruth ALMARAZ PALMERO	Spain
	Saar ALON	Israel
	Prof. AVV. MARIO FRANZOSI	Italy
	Cristiano BACCHINI	Italy
	Curtis BEHMANN	Canada
	Subroto BOSE	United States of America
	Pina CAMPAGNA	United States of America
	Crystal J. CHEN	Independent members
	Patrice DE CANDE	France
	Fernand DE VISSCHER	Belgium
	Aysu DERICIOGLU EGEMEN	Turkey
	Octavio ESPEJO HINOJOSA	Mexico
	Lucas Martins GAIARSA	Brazil
	Qing GE	China
	Michiel HAEGENS	Netherlands
	Hanna Karin HELD	Germany
	Jens KÜNZEL	Germany
	S. Yong LEE	Republic of Korea
	Johan LOJE	Denmark
	Mattias MALMSTEDT	Sweden
	Kazuko MATSUO	Japan
	Markus MATTILA	Finland
	Saulo MURARI CALAZANS	Brazil
	Koichi NAKA	Japan
	Irmeli NOKKANEN	Finland
	Reihnard OERTLI	Switzerland
	Erum RASHEED	Pakistan
	Iván A. POLI	Argentina
	Syed Auqil Ali SHAH	Pakistan

Wayne SLATER
Simon STRÄSSLE
Lili WU
Robert WULFF
Andres WYLD
Irmak YALCINER

Australia
Switzerland
China
Australia
CA-Caribbean Regional-
Group
Turkey

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