



## Report Q227

### Design

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#### **I. INTRODUCTION**

It seems to our Group that the most relevant question is that there is not at all any uniformity in relation to the concept of Design itself. What is regarded a protectable design in country A is not protectable in country B. And even in the same country the opinions differ substantially. Therefore the first task of an international convention, in our opinion, should be to define what amounts to protectable design. From the very definition several different options derive.

The definition of protectable design does not serve a purpose of classification. The law should promote the progress of good design, and avoid the creation of monopolies that, being useless, become dangerous. Our Group underlines these concepts to the maximum strength.

## II. DIFFERENCES AMONG VARIOUS JURISDICTIONS

The term “industrial design” is interchangeably used with “industrial model”, “design” (as in community design) and “design patent” to mean the esthetic shape or configuration of an industrial product.

In order to show the differences in definitions, we are providing some examples of several countries:

Definitions of design in *Japanese* and *Chinese* laws are very similar. However, a big difference is that in Japan the design includes a picture provided by an image display for operation of the article and shown on the article concerned or the article used as an integral part thereof whereas Chinese law protect only designs integrated with the article. On the contrary and according to the US Patent Design Law, in a design patent application, the subject matter which is claimed is the design embodied in or applied to an article of manufacture (or portion thereof) and not the article itself.

It refers not to the design of an article, but to the design for an article, and is inclusive of ornamental designs of all kinds including surface ornamentation as well as configuration of goods. The design for an article consists of the visual characteristics embodied in or applied to an article. Design is inseparable from the article to which it is applied and cannot exist alone merely as a scheme of surface ornamentation. It must be a definite, preconceived thing, capable of reproduction and not merely the chance result of a method.

On the other hand, in Brazil an industrial design is considered to be an ornamental plastic form of an object or an ornamental arrangement of lines and colors which may be applied to a product, providing a new and original visual result in its external configuration and that may serve as a model for industrial manufacture.

In India "Design" means only the features of shape, configuration, pattern, ornament or composition of lines of colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark as defined in Clause (v) of Sub-section (1) of Section 2 of the Trade and Merchandise Marks Act, 1958 (43 of 1958) or property mark as defined in Section 479 of the Indian Penal Code (45 of 1860) or any artistic work as defined in clause (c) of Section 2 of the Copyright Act, 1957 (14 of 1957);

In Peru, the particular appearance of a product resulting from any arrangement of lines or combination of colors or any two-dimensional or three-dimensional outward shape, line, outline, configuration, texture or material that does not alter the intended purpose or use of the said product, on the contrary, in Australia those designs consisting of three-dimensional shapes are only protected by copyright and they are not protected as designs.

In Argentina the official terminology is “industrial models and designs”, as the statute refers to both (see, for instance, arts. 1-6, 8, 14, 17, 22, 28). Art. 3 sets forth the statute’s definition: “Under this decree, the shape or appearance incorporated in or applied to an industrial product and giving it an ornamental quality shall be considered as industrial models or designs”. The term “model” applies to three-dimensional products, while “design” applies to two-dimensional products. The statute applies equally to both, as it makes no distinction, other than terminological, between them.

Under the Canadian statute, “design” or “industrial design” means features of shape, configuration, pattern or ornament and any combination of those features that, in a finished article, appeal to and are judged solely by the eye. This definition is also used in the *Copyright Act* to help determine which copyrights may be unenforceable because of overlapping protection under the *Industrial Design Act*. Under the Canadian statute, the word “article” within the definition is elsewhere defined to mean anything that is made by hand, tool or machine.

According to the EU Community Design Regulation "design" means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation; "product" means any industrial any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs; "complex product" means a product which is composed of multiple components which can be replaced permitting disassembly and re-assembly of the product. There are no other national definitions within the EU since the national Laws are quite harmonized.

### **III. OTHER DIFFERENCES**

Turning to less fundamental points, examination of formalities and substance is required before registration only in some legislations. Furthermore, the most important conceptual differences in the Laws come from the confusion between patent designs, utility models and designs as well as overlapping laws of copyright: these defects occur in several countries.

On the contrary, as regards the procedural Laws concerning applications for designs and subsequent registration, national laws are quite harmonized due to the Hague agreement and WIPO International Designs. There are also many different opinions about the freedom of designer to be limited by technical or statutory requirements and/or by trends and fashion too.

Concerning prior art examination and innovative step, these will not be examined within the EU but will be very much taken into account under US Law. Moreover, the US Patent Design is becoming a strong right where examination takes place even more thoroughly with the new Patent Design Act. There are also different evaluations given in the several legislations as regards the concept of novelty or individual character. For instance in order to evaluate individual character, while within the EU functional features cannot be taken into consideration, some national legislations, to the contrary, consider that Design shape with functional solutions can give more individual character. So functionality is a bar for protection in some countries and an element for validity in others.

In some legislation, prior art is to be taken into account because informed users know the existing corpus but technical requirements seem to have less weight. Perhaps those legislations confuse between utility models or small inventions and design shapes. Function is accepted as providing individual character in some Laws, but designs cannot be dictated solely by function.

It is also generalized that National Courts in some countries consider “overall impression given by designs under comparison” as equivalent to likelihood of confusion. The last is a concept imported from trademark law, scarcely applicable to design. In general has to be said that the informed user has knowledge about designs and it is not the average consumer.

As regards the evaluation of validity and infringement, the European court of Justice and the General Court apply the same criteria in both cases. In other countries (Australia is a good example) where there is examination of prior art, if the design is distinctive over the prior art due to one or more features, then there is a high likelihood of a positive finding of infringement. The dominant test seems to be the following: the person making the decision (e.g. judge or informed user) is to give more weight to similarities between the designs than to differences between them.

#### **IV. CONCLUSION**

In conclusion, it is our considered opinion that it would be recommendable or necessary to clearly indicate what kind of design should be protected. Otherwise, the approach of different national laws, international conventions, projects of national laws or international conventions, instead of establishing a clear concept of design, develop only procedural rules (without knowing exactly what can be protected as a design or not). The concept of design is left to the various national laws. It is the considered opinion of this Committee that establishing a common workable regulation is a sound objective, but to ignore what we regulate is not sound.

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