



International Protection of Designs

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Introduction

Industrial designs are protected in the International Law. The most important acts which regulate protection of design on the international level are two conventions and two agreements.

The oldest is the Paris Convention for the Protection of Industrial Property from March 20, 1883 (Paris Convention)¹. The second one is the Berne Convention for the Protection of Literary and Artistic Works from September 9, 1886 (Berne Convention)². The third one is the Agreement on Trade-Related Aspects of Intellectual Property Rights from April 15, 1994 (TRIPS)³. The last one but not least is the Hague Agreement Concerning the International Registration of Industrial Designs constituted by three acts, but the most important is the Geneva Act from July 2, 1999 (1999 Act)⁴.

All of these legal acts provide protection for industrial design (or work of applied art) on the international level.

However, none of them define what the design is. In my opinion the best definition of design can be found in the European Union Regulation 6/2002 on Community Design from December 12, 2001⁵. Although the Regulation is limited to the European Union the definition of design takes under consideration the provision of all above mentioned acts and thus it can be treated as a basis for further deliberations.

¹ Text of Paris Convention is available on the WIPO webpage : http://www.wipo.int/export/sites/www/treaties/en/ip/paris/pdf/trtdocs_wo020.pdf. The Paris Convention was revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, and at Stockholm on July 14, 1967, and as amended on September 28, 1979.

² Paris Act of July 24, 1971, as amended on September 28, 1979. Text of Bern Convention is available on the WIPO webpage : http://www.wipo.int/export/sites/www/treaties/en/ip/berne/pdf/trtdocs_wo001.pdf.

³ TRIPS Agreement is Annex 1C of the Marrakesh Agreement Establishing the World Trade Organization, signed in Marrakesh, Morocco on 15 April 1994. The text is available on WTO webpage : http://www.wto.org/english/docs_e/legal_e/27-trips.pdf.

⁴ Text of 1999 Act is available on WIPO webpage : http://www.wipo.int/hague/en/legal_texts/wo_haa_t.htm

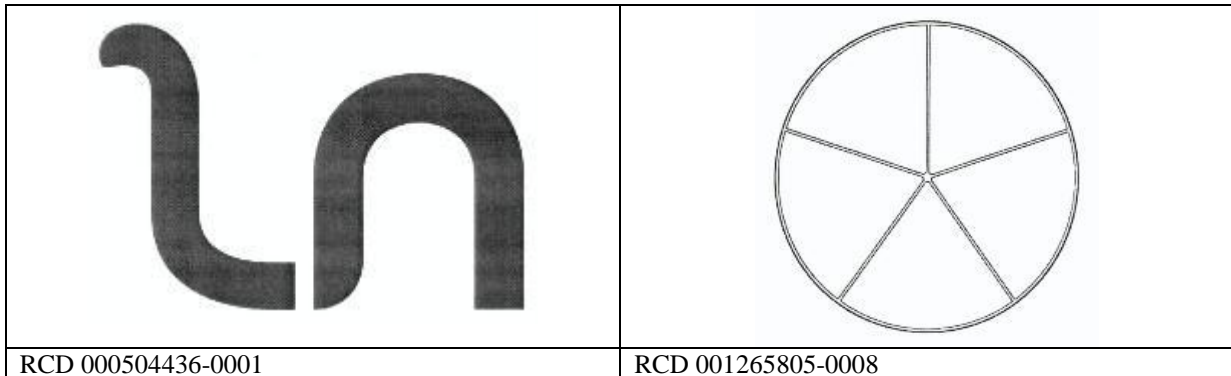
⁵ OJ L 3, 5.1.2002, 1–24, text also available on : http://oami.europa.eu/en/design/pdf/reg2002_6.pdf.

1. Design

1.1 Definition of design

According to the Art. 3a of the Regulation “design” means the appearance of the whole or a part of a product resulting from the features thereof. In particular ⁶:

- the lines,





- contours (it refers to three dimensional designs),

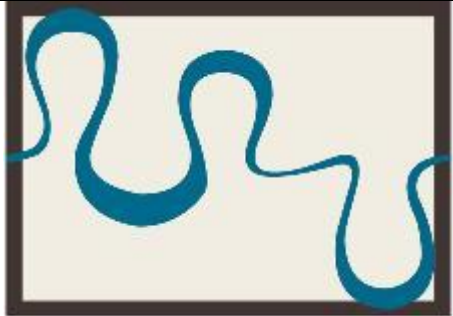



- colors, (color per se cannot be a design, but different colors constitute different designs)



⁶ All of presented designs are registered (Registered Community Design – RCD) and published. They can be found in the OHIM’s database, <http://oami.europa.eu/RCDOOnline/RequestManager> [accessed March 27, 2011].

	
RCD 001836917-0001	RCD 001836917-0002

- shape (it is very similar to contours but it can be probably also possible for two dimensional designs),


	
RCD 001826298-0002	RCD 001828724-0003

- texture/or materials of the product itself and/or its ornamentation.

	
RCD 001832114-0001	RCD 001836933-0001

Although this definition sounds rather mysterious, it is easy to explain what design is. One only has to understand that the main idea is to protect the appearance of a product. According to the Regulation, a product is 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, excluding computer programs (art. 3 b).

	<p> A B C D E F G H I J K L M N O P Q R S T U V W X Y Z a b c d e f g h i j k l m n o p q r s t u v w x y z 1 2 3 4 5 6 7 8 9 0 . : ! ? , . ; () < > @ # \$ ^ & % * ' " + - = [] { } \ / </p>
<p>RCD 001012157-0002 (graphic symbols)</p>	<p>RCD 000119961-0005 (typographic typefaces)</p>

Moreover, the complex product is a product composed of multiple components which can be replaced, permitting disassembly and re-assembly of the product. A good example of a complex product may be a car or a fitted kitchen⁷.

	
<p>CRD 000347117-0001</p>	<p>CRD 000511712-0001</p>

1.2 Requirements of protection

There are some requirements provided by Regulation which have to be fulfilled when a design can be protected. All these provisions are in accordance with international conventions and agreements.

Firstly, a design has to fulfill the requirement of novelty. It means that it has to be new. According to the Regulation, a design fulfills the requirements of novelty if no identical design has been made available to the public before the date of filing the application for

⁷ Musker, David, *Community Design Law. Principles and Practice*. London: Sweet & Maxwell, 2002, 21.

registration (art. 5). “Made available to the public” means that the design has been published following registration or otherwise, or exhibited, used in trade, or otherwise disclosed. Excepted are cases where these events could not reasonably have become known in the normal course of business to the circles specialized in the sector concerned, operating within the Community (art. 7. 1).

Secondly, a design must have an individual character. It means that the overall impression design produces on the informed user differs from the overall impression produced on such a user by any design which has been made the public. This requirement is an addition⁸ to the requirement of novelty and focuses more on overall impression rather than on details. A new design has to differ from the previous design not only in details but the differences have to be visible to the naked eye of the informed user. But it has to be kept in mind that the informed user is not an ordinary person but a person who has to be “reasonably well informed as to the range of products and design available on the relevant market”⁹. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration. This test of “design freedom” means that “where there is a little scope for difference, then relatively little difference from the prior design will be needed to establish individual character, and conversely where design freedom is great, larger differences are required.”¹⁰

Finally, a design has to fulfill the requirement of visibility (art. 4 para. 2 a). The invisible components of a product (“under the bonnet”) are excluded. Paragraph 12 of the Regulation’s preamble clearly explains that the protection should not be extended to those component parts which are not visible during normal use of product, or to those features of such part which are not visible when the part is mounted.

1.3 Exclusions from protection

There are some designs which are dictated by their technical function and designs of interconnections (*must – fit exception*). According to the Regulation a design does not subsist in features of appearance of a product which are solely dictated by its technical function and

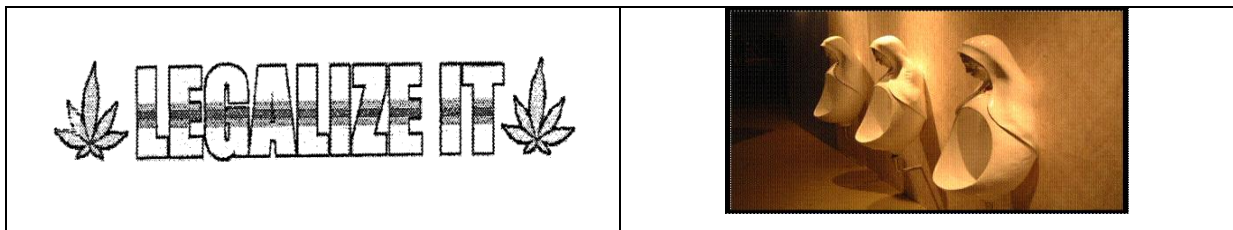
⁸ Howe, Martin and Russell-Clarke, Alan Daubeney, *Russell-Clarke and Howe on Industrial Design*, London: Sweet & Maxwell, 2005, 38.

⁹ *Ibid.*, 40.

¹⁰ Musker, 33.

which must be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either may perform its function (art. 8 para. 1 and 2). The main aim of introduction of these provisions has been to avoid hampering technological innovation. But, what is interesting is that the mechanical fittings of modular products can be protected (art. 8 para 3). As stated in the preamble, they can “constitute an important element of innovative characteristic of modular products and present a major marketing asset”. Commentators suppose that the introduction of this regulation was at behest of the Danish government because para 3 removes mainly Lego and Duplo from the ambit of para 2 (must-fit).

In addition, a Community design does not subsist in a design which is contrary to public policy or morality. The designs presented below should not be registered.



Source : Pictures from the Polish Patent Office (not published).

2 Paris and Berne Convention

2.1 Paris Convention for the protection of Industrial Property

The Paris Convention was approved and signed in 1883 by 11 States. It came into effect in 1884 in 14 countries. Since 1884 the number of members increased significantly and nowadays there are 173 Contracting Parties¹¹.

2.1.1 National Treatment

Paris Convention introduces some main principles which are applicable to all IP rights. The main important is a principle of "national treatment"¹².

Article 2 (1) provides that "Nationals of any country of the Union shall, as regards the protection of industrial property, enjoy in all the other countries of the Union the advantages that their respective laws now grant, or may hereafter grant, to nationals; all without prejudice to the rights specially provided for by this Convention. Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided that the conditions and formalities imposed upon nationals are complied with". It means that each Contracting Party to Paris Convention must grant the same protection to nationals of the other Contracting Party as it grants to its own nationals.

What is more the same treatment must be granted also to nationals from countries which are not Members to Paris Convention "if they are domiciled in a member country or if they have a "real and effective" industrial or commercial establishment in such a country" (Article 3).

Article 2 (2) provides that : "no requirement as to domicile or establishment in the country where protection is claimed may be imposed upon nationals of countries of the Union for the enjoyment of any industrial property rights".

¹¹ See : http://www.wipo.int/treaties/en/ShowResults.jsp?country_id=ALL&start_year=ANY&end_year=ANY&search_what=C&treaty_id=2 [accessed March 26,2011].

¹²*Intellectual Property Handbook: Policy, Law and Use*, WIPO Publication No.489, Chapter 5, p. 6-7, Available on: <http://www.wipo.int/about-ip/en/iprm/> [accessed March 26,2011].

2.1.2 Right of priority

Another important principle which is now incorporated in most national legislations is “a right of priority”. It is expressly stated in Article 4 A (1) that “Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed”. It means that the designer who has obtained protection for a design on the basis of national application in the country which is a Member to Paris Convention for his design, he or she may also apply for protection of his or her design in all Members countries within a specified period of time. Members cannot impose any special requirements for an application even if their legal system provided them. Pursuant to Article 4 A (2) “any filing that is equivalent to a regular national filing under the domestic legislation of any country of the Union or under bilateral or multilateral treaties concluded between countries of the Union shall be recognized as giving rise to the right of priority”.

The right of priority in reference to an industrial design can be claimed only within six months. This period starts from the date of filing of the first application but the day of filing shall not be included in the period. To claim the Right of priority any person shall “be required to make a declaration indicating the date of such filing and the country in which it was made” (Article 4 D (1)) . Pursuant to Article 4 D some further requirements can be introduced by Members.

There is also a special provision applicable to industrial design. Article 4 E (1) provides that “Where an industrial design is filed in a country by virtue of a right of priority based on the filing of a utility model, the period of priority shall be the same as that fixed for industrial designs.”

2.1.3 Design in the Paris Convention

First of all the Paris Convention expressly includes industrial design within the scope of industrial property and thus protect them. Article 1(2) clearly states that the protection of industrial property has as its object industrial designs. Nevertheless there is also an Article *5quinquies* which provides that “Industrial designs shall be protected in all the countries of the Union”. A. Kingsbury stresses that it was first adopted in 1958 “as part of a

move to promote sui generis design laws after the efforts to include designs in copyright law had achieved only some success”¹³.

Although the Paris Convention states the obligation to protect industrial design it does not provide the way of protection. The majority of the countries introduced the special sui generis system for protection of design but it is also possible to grant the protection of design under the law on copyright or the law against unfair competition¹⁴. As some author suggest “this article (...) did not go as far as many countries were suggesting it should at the time, since it neither defines “industrial design” nor gives any precision on the type of protection (Although civil judicial protection must be available to right holders (art. 42))”¹⁵.

In Article 5 B it can be found that “The protection of industrial designs shall not, under any circumstance, be subject to any forfeiture, either by reason of failure to work or by reason of the importation of articles corresponding to those which are protected.” But the countries are free to impose some different measures like compulsory licenses to make the design working.

The industrial design is also mentioned in Article 11 which states that countries of the Union shall grant temporary protection to industrial designs, in respect of goods exhibited at official or officially recognized international exhibitions held in the territory of any of them. There are some different ways to provide this protection but the aim is to protect the product which were exhibited from copying. The solution can be very similar to the right of priority. The designer for example would have the right of priority to file an application for protection of design within 6 months from the date of the opening of exhibition. This solution is very common and widely accepted in countries where sui generis system of protection of designs is introduced.

As we can see the Paris Convention protects industrial design. However, the provisions are very basic and nowadays most of the countries provide much more sophisticated protection of designs.

¹³ Kingsbury, Anna, *International Harmonisation of Designs Law : the case for Diversity*, E.I.P.R, no 8, 2010, 386.

¹⁴ Intellectual Property Handbook, 21.

¹⁵ Gervais, Daniel, *The TRIPS Agreement, Drafting History and Analysis*, London: Sweet & Maxwell, 2003, p. 212.

In my opinion the Paris Convention does not play any more important role in design protection in Europe. The scope of the provision is too broad and they do not specify any special requirements. I think that all the European countries have a system of design protection much more precise and coherent than proposed in Paris Convention. The Paris Convention may play a role as a general International Act showing that protection of designs shall be recognized internationally. This is still important in the developing and in the least developed countries.

2.2 Berne Convention for the protection of literary and artistic works

The Berne Convention is the oldest international treaty in the field of copyright. It governs protection on the basis of copyright and it does not introduce any special system for protection of industrial designs. Nowadays there are 164 Contracting parties to the Berne Convention¹⁶.

2.2.1 National treatment

By joining the Berne Convention Contracting Parties agree that “Authors shall enjoy, in respect of works for which they are protected under this Convention, in countries of the Union other than the country of origin, the rights which their respective laws do now or may hereafter grant to their nationals, as well as the rights specially granted by this Convention” (Article 5(1)). It means that designer from the Union must be treated in all countries of the Union in the same way as nationals if he or she wants to protect his or her work of applied art. Article 5 (2) introduces that :

- the enjoyment and the exercise of these rights shall not be subject to any formality;
- such enjoyment and such exercise shall be independent of the existence of protection in the country of origin of the work.

It leads to the conclusion that the law of the country where protection is claimed regulates all the issues like extent of protection or seeking a redress by the designer. There is an important remark that principle of national treatment “does not lead to creation of a uniform body of copyright regulations applicable in all the countries of the Union. (...) since there are

¹⁶ http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=15 [accessed March 26,2011].

considerable differences between legislation of the States of the Union (...), the protection granted to authors will vary according to whether it is claimed in one country to another”¹⁷.

2.2.2 Subject of protection

The scope of Convention is very broad. Pursuant to Article 2 (1) literary and artistic works include : “every production in the literary, scientific and artistic domain, whatever may be the mode or form of its expression, such as books, pamphlets and other writings; lectures, addresses, sermons and other works of the same nature; dramatic or dramatico-musical works; choreographic works and entertainments in dumb show; musical compositions with or without words; cinematographic works to which are assimilated works expressed by a process analogous to cinematography; works of drawing, painting, architecture, sculpture, engraving and lithography; photographic works to which are assimilated works expressed by a process analogous to photography; **works of applied art**;¹⁸ illustrations, maps, plans, sketches and three-dimensional works relative to geography, topography, architecture or science”.

However, there is any definition of “works of art”. Thus, important is an Article 2 (7) which provides that “it shall be a matter for legislation in the countries of the Union to determine the extent of the application of their laws to works of applied art and industrial designs and models, as well as the conditions under which such works, designs and models shall be protected. Works protected in the country of origin solely as designs and models shall be entitled in another country of the Union only to such special protection as is granted in that country to designs and models; however, if no such special protection is granted in that country, such works shall be protected as artistic works”.

Contracting Parties are also free to determine the term of protection but Article 7 (4) imposes obligation that “term of protection. shall last at least until the end of a period of twenty-five years from the making of such a work”.

It means that Contracting Parties can determine the “nature of the protection they apply to applied art, but where copyright protection is provided for, the term should be 25 years”¹⁹.

¹⁷ Cohen, Daniel, *The International Protection of Designs*, The Hague, London, Boston : Kluwer Law International, 2000, 91.

¹⁸ Only since the Brussel Revision of 26 June 1948 work of applied are covered by the Berne Convention and contained in Art. 2 (1).

¹⁹ Kingsbury, 386.

2.2.3 Exclusive rights

The Berne Convention grants also to the authors of applied art some moral rights. The author “shall have the right to claim authorship of the work and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation”. In some cases claiming moral rights can be very important also with reference to designs. The designer can transfer all his economic rights but he or she shall still have the right to be shown as the author of the design. In many case the name of designer attracts attention of the consumers and plays important role in promoting products.

Convention grants also economic rights to the authors. I think that in reference to design only the right of reproduction (Article 9) and the right to make adaptations, arrangements or other alterations of a work (Article 12) are applicable. Pursuant to Article 9 (1) the author “shall have the exclusive right of authorizing the reproduction of these works, in any manner or form” and pursuant to Article 12 the author “shall enjoy the exclusive right of authorizing adaptations, arrangements and other alterations of their works”. It means that the Member State which choose the copyright to protected work of applied art then it has to grant all these rights to the author of the work of applied art. However, it can also introduces some limitations and exceptions but it is provided only in relation to the reproduction right (Article 9 (2)).

In conclusion I fully agree with the statement that the Berne Convention “provides considerable flexibility for member states as to how and what extent designs are protected. The Berne Convention does not impose a harmonized framework, or prescribed clear rules for designs to the extent that it does for many other categories of work required to be protected by copyright”²⁰.

²⁰ Ibid.

3 Trade Related Aspects of Intellectual Property Rights (TRIPS)

3.1 Introduction

Agreement on Trade Related Aspects of Intellectual Property Rights (later TRIPS) was created under the supervision of the World Trade Organization (WTO). The provision of TRIPS about intellectual property rights were negotiated from 1986 to 1994 in Uruguay Round and then introduced for the first time into the multilateral trading system. TRIPS is very important because there are 153 Members²¹ in WTO and they also accepted TRIPS²².

The main aim of the creators of TRIPS was a desire “to reduce distortions and impediments to international trade, and taking into account the need to promote effective and adequate protection of intellectual property rights, and to ensure that measures and procedures to enforce intellectual property rights do not themselves become barriers to legitimate trade”²³.

TRIPS “performs a number of functions in the WTO legal system. First, the Agreement adopts certain generally applicable principles. (...) Second (...) prescribes minimum substantive standards of IPRs protection for all WTO Members. (...) Third, (...) requires that Members make provision for adequate and effective enforcement of IP rights (...). Fourth (...) recognizes the importance of maintaining competitive markets (...). Fifth (...) gives special attention to the situation of developing and least developed countries. (...) Sixth, establishes institutional arrangements. (...) Seventh, incorporates dispute settlement under the DSU.”²⁴

The main important areas of intellectual property rights are covered by TRIPS. There are :

- Copyrights and related rights (art. 9-14)
- Trademarks (art. 15-21)
- Geographical Indications (art. 22-24)
- Industrial designs (art. 24-26)
- Patents (art. 27-34)

²¹ There were 153 Members on 23 July 2008, see :

http://www.wto.org/english/thewto_e/whatis_e/tif_e/org6_e.htm [accessed March 26,2011].

²² “All the WTO agreements (...) apply to all WTO members. The members each accepted all the agreements as a single package with a single signature — making it, in the jargon, a “single undertaking”. The TRIPS Agreement is part of that package. Therefore it applies to all WTO members”. See :

http://www.wto.org/english/tratop_e/trips_e/tripfq_e.htm#Who%27sSigned [accessed March 26,2011].

²³ The Preamble to TRIPS Agreement

²⁴ Abbott, Frederick, Cottier, Thomas and Gurry, Francis, *International Intellectual Property in an Integrated World Economy*, Austin, Boston, Chicago, New York, The Netherlands: Wolters Kluwer, 2007, 21.

- Layout-Designs (Topographie) of Integrated Circuits (art. 35-38)
- Protection of Undisclosed Information (art. 39)
- Anti-Competitive Practices in Contractual Licenses (art. 40).

The author of these thesis is going to focus only on main principles and on the industrial designs.

Before going to the requirements for protection of industrial designs the basic principles of TRIPS which influences the whole Agreement have to be mentioned.

3.2 Minimum standards

First of all art. 1.1 TRIPS provides that “Members shall give effect to the provisions of this Agreement. Members may, but shall not be obliged to, implement in their law more extensive protection than is required by this Agreement, provided that such protection does not contravene the provisions of this Agreement. Members shall be free to determine the appropriate method of implementing the provisions of this Agreement within their own legal system and practice”. It secures that Members of the WTO will at least have the protection on the same level as it is provided in TRIPS. They have right to introduce the higher level of protection of IP rights but are not allowed to introduce the lower threshold. This provision is very important for the Members of WTO because they know what are the minimum standards in every Member state.

Nevertheless TRIPS does not impose any method of implementing the provisions. Members are free to choose the most appropriate method within their own legal system.

3.3 National treatment

C. M. Correa stresses that there are three major principles established by TRIPS : national treatment, most favoured national treatment, and international exhaustion of rights ²⁵.

The principle of national treatment is placed in Article 3 TRIPS. It provides that each Member of WTO is obliged to “accord to the nationals of other Members treatment no less favourable than that it accords to its own nationals with regard to the protection of intellectual property”.

The term protection is also defined in TRIPS and it “shall include matters affecting the availability, acquisition, scope, maintenance and enforcement of intellectual property rights as

²⁵ Correa, Carlos M., *Trade Related Aspects of Intellectual Property Rights, A Commentary on the TRIPS Agreement*, New York: Oxford University Press, 2007, 52.

well as those matters affecting the use of intellectual property rights specifically addressed in this Agreement”.

This principle is considered to be the cornerstone of intellectual property conventions²⁶. It protects a foreigner from being discriminated vis-à-vis nationals. If the nationals are given some rights the same rights should be given also to the foreigners. For example if the term of protection of design for nationals will be extended then the duration of protection for foreigners shall be the same.

The principle of national treatment exists also in Paris Convention.

3.4 Most-favoured nation treatment

Second principle provides that “with regard to the protection of intellectual property, any advantage, favour, privilege or immunity granted by a Member to the nationals of any other country shall be accorded immediately and unconditionally to the nationals of all other Members” (Article 4 TRIPS). It is an innovation in intellectual property convention²⁷ and traditionally this principle was reserved to trade in goods. Nevertheless Article 5 excludes from this principle “based on the existing international agreements or in connection with certain subject matters”²⁸ :

- a) international agreements on judicial assistance or law enforcement of a general nature and not confined to protection of the IP
- b) rights granted under the Bern Convention (1971) or the Rome Convention based on the treatment accorded in another country
- c) rights of performers, producers of phonograms and broadcasting organizations not provided under this Agreement
- d) deriving from international agreements related to the protection of intellectual property which entered into force prior to the entry into force of the WTO Agreement.

The principle guarantees that all the nationals will be treated equally. This principle protects the nationals from one Member state against discrimination vis-à-vis nationals from another Member state. If the Member grants more favourable rights to nationals from one state they should be also granted to the nationals of the other states.

²⁶ Ibid.

²⁷ Blakeney, Michael, *Trade Related Aspects of Intellectual Property Rights: A Concise Guide to the TRIPs Agreement*, London: Sweet & Maxwell, 1996, 41.

²⁸ Correa, 67.

3.5 Exhaustion of Intellectual Property Rights

The third important principle is in Article 6, which states that “For the purposes of dispute settlement under this Agreement, subject to the provisions of Articles 3 and 4 nothing in this Agreement shall be used to address the issue of the exhaustion of intellectual property rights”. The principle gives the right to legally import into a country a product which is protected by the intellectual property rights. However there is a requirement that the product has been legitimately put on the market in the foreign country. “These imports – made by party without the authorization of the title-holder but equally legal – are generally known as ‘parallel imports’”²⁹.

3.6 Requirements for protection (art. 25 (1))

In TRIPS there are only two Articles concerning protection of industrial design in Section 4 “Industrial design” – Article 25 and Article 26.

Article 25 (1) determines that “Members shall provide for the protection of independently created industrial designs that are new or original.” Although the requirements of protection are clear there is any definition of design. It was not coincidence that the definition was omitted. The TRIPS commentators think that “the broad room for manoeuvre was (...) retained in recognition of the wide diversity of regimes of industrial design protection that Members had at the time the TRIPS Agreement was negotiated. Thus, after the adoption of the TRIPS Agreement many countries (such as United States) with diverging regimes did not change the pre-existing mode of design protection”³⁰.

Although there is any definition, there are requirements for protection. The design must be :

- a) independently created
- b) new or
- c) original.

In every country there are different way of understanding them.

In my opinion the design will be independently created in case when the designer has created the design of his own and not copied it. However it does not exclude designs which were created by the designer who was inspired by the previous design.

There is also a requirement of novelty and it varies across countries. It can be understood as a universal (absolute) or national (local) novelty. Universal novelty means that any design of

²⁹ Correa, 78.

³⁰ Correa, 261

the same kind have been disclosed anywhere else in the world and national novelty is merely limited to the state. Nevertheless the “touchstone of novelty (...) is whether the design has been published or disclosed prior to the date of application”³¹. In the majority of cases when design was published or disclosed prior to the date of application the novelty is destroyed for the purpose of registering the design.

Originality differs from novelty. It is a link between a design and a designer. As S.M. Stuart says “It means no more than that the creator can truthfully say – ‘This is all my own work’”³². Thus, It is possible that two designers create independently the same design. It would not destroy the possibility of registration of design because the requirement of originality is obeyed.

Article 25 (1) also permits Members to “provide that designs are not new or original if they do not significantly differ from known designs or combinations of known design features”. The provision is not very clear and the Members has to determine the degree of differentiation which is necessary for design to be eligible for protection.

Interesting is that TRIPS gives Members the possibility to exclude some designs from protection. There are designs dictated essentially by technical or functional considerations. We have to remember that it is only the facultative clause and Members can introduces the protection of technical and functional designs, exclude technical or functional designs or exclude technical and functional designs. For example in all EU States designs dictated solely by technical function are excluded from protection. M. Blakeney stresses that “this exclusion reflects the evolution of registered designs protection which conferred protection upon those ornamental and aesthetic aspects of a product which were distinctive of a particular manufacture and which would not be imitated by a rival producer acting in a good faith. For this reason the functional aspects of a design, (...), if dictated by the necessity for articles to perform a particular task were denied protection”³³.

3.7 Textile designs (art. 25 (2))

Art. 25 (2) introduces special regulation for textile designs. Members are oblige to “ensure that requirements for securing protection for textile designs, in particular in regard to any cost, examination or publication, do not unreasonably impair the opportunity to seek and obtain such protection”. The reason to introduce this provision is the fact that most of the textile

³¹ Blakeney, 77.

³² Stewart, Stephen M., *International Copyright and Neighbouring Rights*, London : Butterworths, 1989, 50.

³³ Blakeney, 78.

designs have short-lived economic value and enterprises should have possibility to protect their designs quick and cheap. It is very important for the developing countries where SME's produce mostly textile designs. Art. 25 (2) gives the opportunity for a Member to meet this obligation through copyright law instead of sui generis system of protection for industrial designs. Under Copyright is much easier to obtain protection for designs because in most countries the copyright law provide protection for work of applied art (design) without any kind of registration and fees. Thus this provision does not exclude the cumulative protection of design but in my opinion TRIPS admits it very clearly.

3.8 Protection

Art. 26 (1) provides that the owner of a protected industrial design shall have the right to prevent third parties not having the owner's consent from :

- making,
- selling
- or importing

articles bearing or embodying a design which is a copy, or substantially a copy, of the protected design, when such acts are undertaken for commercial purposes.

This article provides the minimum protection which the Members have to grant to the owners of protected industrial designs.

There are three very interesting remarks made by TRIPS commentator C.M. Correa. First of all he points out that "while the provisions on trademarks and patents refer to the granting of 'exclusive right', this word is absent in case of industrial design"³⁴. It is very important because it means that TRIPS extends the possibility of protection of design not only to copyright or design law but also to unfair competition rules, which do not grant exclusive rights.

Second "Article 26.1 confers a right against the copying of protected designs (... 'a design which is a copy, or substantially a copy, of the protected design...')"³⁵. I agree with the opinion that it is a visible sign that rights conferred by registration of design are closer to copyright than to patent law. If the design was created independently (Art. 25 (1)) it can be considered as not infringing an identical design. Of course the requirements of novelty and

³⁴ Correa, 266

³⁵ Ibid.

originality must be taken under consideration and normally “the court will examine the particular features which form the essence of design in the eyes of typical consumer”³⁶.

Third, “the list of acts subject to the designer’s rights (making, selling, or importing articles) is shorter than for patents (which also apply to acts of ‘using’ and ‘offering for sale’) with an additional qualification that such acts are only prevented when ‘undertaken for commercial purposes’”³⁷. It means that protection of design is limited in comparison with patents. Any product incorporating design made for non-commercial purpose will not infringe the right of the owner of protected design.

Article 26 (2) provides that Members can introduce limited exceptions to the rights conferred by industrial design. The exceptions are allowed only if such exceptions :

- do not unreasonably conflict with the normal exploitation of protected industrial designs and
- do not unreasonably prejudice the legitimate interests of the owner of the protected design,
- taking account of the legitimate interests of third parties.

Important is that Section 4 TRIPS where there are provisions concerning industrial designs does not refer to compulsory licences as Section 5 on patents does (Article 31). However there is no exclusion of compulsory licences (there is an exclusion in Article 21 TRIPS³⁸ in relation to trademarks). It should not be interpreted that such licences for designs cannot be granted. They should be deemed as “limited exceptions” and are allowed under Paris Convention and copyright law.

TRIPS provides in Article 26 (3) the minimum duration of protection which shall amount to at least 10 years. Although this term is shorter than the term provided by European Union in Regulation 6/2002 or in Directive 98/71/EC (25 years) or in Copyright Law (for example in Poland - 70 years since the death of the author) it is still longer than the period offered by some national regimes. Nevertheless this provision seems to be very flexible because “it does not specify whether the term :

- is to be bound from the date of the design, the application, or its publication, or from the date of its grant or any other date;

³⁶ Blakeney, 79.

³⁷ Correa, 266.

³⁸ Members may determine conditions on the licensing and assignment of trademarks, it being understood that the compulsory licensing of trademarks shall not be permitted and that the owner of a registered trademark shall have the right to assign the trademark with or without the transfer of the business to which the trademark belongs.

- could be divided in a shorter original term plus a renewal totaling at least ten years;
- may be subject to renewal”³⁹.

Although TRIPS provides that Members of WTO are obliged to introduce the system of protection of design, the provisions are not very precise. It leads to the uncertainty. Members are not only free to choose the protection under copyright or sui generis system of design protection but also they can determine the requirements for protection, which can differ from country to country. However, TRIPS is a further step (in comparison with Paris and Bern Convention) towards international protection of designs.

³⁹ Correa, 266.

4 The Hague Agreement concerning the International Registration of Industrial Designs

4.1 Introduction

The Hague Agreement concerning the International Registration of Industrial Designs was introduced in 1925 and entered into force in 1928⁴⁰.

There are three main acts which constitute the modern system of international protection. There are : London Act from 1934 (later 1934 Act⁴¹), the Hague Act from 1960 (later 1960 Act⁴²) and the Geneva Act from 1999 (later 1999 Act). Some important provisions can be also found in Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement (later Common Regulations)⁴³.

The author of these thesis will focus mainly on 1999 Act because of its importance for the European Union.

1999 Act entered into force in 2004 but for the European Union on January 1, 2008. Since then the 1999 Act “provides for a link between the international system and regional registration systems of intergovernmental organizations, such as the Registered Community Design (RCD) system of the European Union (EU)”⁴⁴. It is very important because anyone from EU can apply for International Protection of designs. On the other hand everybody, also outside of the EU, but from a country which is a party of the Hague Agreement, can designate EU in the international application and can obtain the protection in the EU as a Registered Community Design (RCD).

The main advantage which is offered by the International System of Registration is the possibility to obtain the protection of designs in several Contracting States by only one application. The application must be filed with the International Bureau of the World Intellectual Property Organization (WIPO) in Geneva, Switzerland, because the whole system

⁴⁰ *Industrial Design and The Hague Agreement : An Introduction*, WIPO Publication No. 429 (E), 5.

⁴¹ The application of the 1934 Act has been frozen since January 1, 2010, see *Guide to the International Registration of Industrial Designs under the Hague Agreement*, WIPO, Geneva 2010, A.1. available on the WIPO webpage : http://www.wipo.int/hague/en/legal_texts/wo_hal0_.htm [accessed March 26,2011].

⁴² 1960 Act, available on the WIPO webpage : http://www.wipo.int/hague/en/legal_texts/wo_hah0_.htm [accessed March 26,2011].

⁴³ Common Regulation, available on the WIPO webpage : http://www.wipo.int/export/sites/www/hague/en/legal_texts/pdf/hague_common_regulations.pdf [accessed March 26,2011].

⁴⁴ *Industrial Design and The Hague Agreement*, 6.

is administered by this Organization. WIPO maintains the International Register and publishes the International Designs Bulletin.

It is to remember that the 1999 Act does not affect any other application for protection nor the copyright protection for works of art and works of applied art by international treaties and conventions (see Bern Convention). It does not affect also the TRIPS agreement.

The Act 1999 constitutes the link with Paris Convention by defining in Article 2.2 that “each Contracting party shall comply with provisions of the Paris Convention which concern industrial designs”.

4.2 International Registration Procedure

4.2.1 Introduction

First of all “one international application replaces a whole series of applications which would be otherwise have to be filed with different national offices”. It means that nowadays anybody looking for protection in some different countries does not need to file an application for protection in every country, it is enough to file an application to WIPO.

Nevertheless not everybody can apply for an international registration. According to article 3 “Entitlement to File an International Application” it can be :

- any person (natural or a legal person)
- that is a national of a State that is a Contracting Party or of a State member of an intergovernmental organization that is a Contracting Party⁴⁵,
- or that has a domicile,
- or a habitual residence
- or a real and effective industrial or commercial establishment in the territory of a Contracting Party.

⁴⁵ See the list of Contracting Parties to 1934 Act, 1960 Act and 1999 Act <http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/hague.pdf>. On February 1, 2011 there are 58 Contracting Parties, inc. European Union. [accessed March 26,2011].

4.2.2 Contracting party

It has to be explained that Contracting Party can be a state or intergovernmental organization. If the State wants to be a Contracting Party it has to become first a member of the Convention Establishing WIPO⁴⁶. Although it was required by 1960 Act that the State must be bound by the Paris Convention for the Protection of Industrial Design, it is not a requirement according to 1999 Act. However as it was said above every State is required to comply with Paris Convention.

The intergovernmental organization can be only a Contracting Party to 1999 Act, the 1960 Act does not give this opportunity because it is open only for the States. Nevertheless not every intergovernmental organization can be a Party of 1999 Act. There are some requirements which have to be fulfilled. They are according to Article 27 (1) (ii) as follows :

- the organization maintains an Office in which protection of designs may be obtained with effect in the territory in which the constituting treaty of the intergovernmental organization applies and
- at least one of the member States of the intergovernmental organization is a member of WIPO.⁴⁷

The term “office” should mean “the agency entrusted by a Contracting Party with the grant of protection for industrial designs with effect in the territory of that Contracting Party” (Article 1 (xvi) 1999 Act). For example in the European Union it is Organization for Harmonization in the Internal Market (OHIM) in Alicante, Spain.

⁴⁶ Convention establishing WIPO, available on the WIPO webpage : http://www.wipo.int/treaties/en/convention/trtdocs_wo029.html [accessed March 26,2011].

⁴⁷ There are 184 Members of WIPO, all the countries which are members of European Union are also Members of WIPO <http://www.wipo.int/members/en/>. [accessed March 26,2011]. “To become a member, a state must deposit an instrument of ratification or accession with the Director General of WIPO. The WIPO Convention provides that membership is open to any state that: (i) is a member of the Paris Union for the Protection of Industrial Property, or of the Berne Union for the Protection of Literary and Artistic Works; (ii) or is a member of the United Nations, or of any of the United Nations' Specialized Agencies, or of the International Atomic Energy Agency, or that is a party to the Statute of the International Court of Justice; (iii) or is invited by the WIPO General Assembly to become a Member State of the Organization.

4.2.3 National, domicile, habitual residence and real and effective industrial or commercial establishment

The 1999 Act does not define any of the terms which are used in the Article 3. It is up to the national legislation to determine them. Nevertheless the Guide gives us some more information.

The term “national” should have “the same meaning as in Articles 2 and 3 of the Paris Convention”⁴⁸. This term includes the natural and legal persons but the criteria for deciding who has the nationality or when the legal persons can be regarded as national are determined by the legislation of the Contracting Party. The nationality is the legal tie with the state and can be easily proved. For example natural person has the nationality of the state if he or she was born there or if her or his parents have the nationality of the state. The company can be considered as having nationality of the state if it was registered there.

The same situation is with the term “domicile”. It can be interpreted different in every Contracting Party. The authors of the Guide are of the opinion that the expression “domicile” does not indicate the legal situation but “rather a more or less permanent situation of fact, so that a foreign national residing in a Contracting Party would, in most cases, be eligible to claim entitlement through domicile⁴⁹”. I fully agree with this statement. The proposed interpretation gives persons which are in fact closely connected with the Contracting Party the possibility to file an international application. Of course it can be in some cases difficult to prove that natural person has its domicile in the state but the natural person can present for example employment contract or a rental agreement. The legal persons can prove that place of its headquarters is in the state and it should be enough to consider it as being domiciled.

The given interpretation is also in accordance with the understanding of term “habitual residence”, which was taken from the Bern Convention for the Protection of Literary and Artistic Works. “It has been used in the 1999 Act in order to compensate for any excessively narrow interpretation that might be given to the concept of “domicile” under domestic laws”⁵⁰. As we can see the intention of the authors of the 1999 Act was to ensure that the broad circle of persons will be entitled to apply for the international application. Even the

⁴⁸ Guide, B.II.2.

⁴⁹ Ibid.

⁵⁰ Guide, B.II.3.

“habitual residence” is enough to have the right to file the application. This provision was added in 1999 Act. It does not exist in 1960 Act.

The last expression to define is “real and effective industrial or commercial establishment”. This is also taken from Article 3 of Paris Convention and the main reason by using “real and effective establishment” was to exclude fraudulent and fictitious establishments (term “real”) and to make clear that “while the establishment must be one at which some industrial or commercial activity takes place (...), it need not be the principal place of business”⁵¹ (term “effective”).

4.2.4 Applicant’s Contracting Party

If one of the above mentioned requirements is fulfilled the Contracting Party from which the applicant derives its entitlement is called “applicant’s Contracting Party” (Article 1 (xiv)). There is possibility that there are more than one Contracting Parties from which the applicant can derive its entitlement. In this case the “applicant’s Contracting Party” is the one which is mentioned as such in the application. For example if the designer is from Poland (bound by 1999 Act) but is domiciled in Estonia (also bound by 1999 Act), then his Contracting Party is among Poland and Estonia, the one which has been indicated in application by the designer.

The Guide mentions another possibility when “the applicant enjoying multiple and independent entitlements may cumulate these with a view to obtain protection on a broader geographical scale”⁵². As an example we can indicate the applicant having the nationality of Italy, which is exclusively bound by 1960 Act, but being domiciled in Poland, which is exclusively bound by 1999 Act. He or she could designate all Contracting Parties bound by the 1960 Act and 1999 Act. It means that entitlements may cumulate and they do not exclude each other. If one of the designated Contracting Parties is bound by the 1960 Act and 1999 Act then the designation will be governed by the most recent Act, it means the 1999 Act. Of course the applicant must enjoy the plurality of entitlements under 1960 Act and 1999 Act (Article 31 (1) 1999 Act). For example a Romanian (Romania is bound by 1960 Act and 1999 Act) designates Lichtenstein (bound by 1960 Act and 1999 Act) then the designation of Lichtenstein will be governed by the 1999 Act.

⁵¹ Ibid.

⁵² Guide, B.II.4.

Another possibility when the protection may be obtain on the broader geographical scale arises in respect “of States member of the intergovernmental organization that is Contracting Party to the 1999 Act, where those States are themselves bound by the 1960 Act”⁵³. For example a designer having nationality of Italy (bound by 1960 Act), which is also the Member of EU, could designate not only Contracting Parties bound by 1960 Act but also Contracting Parties bound by 1999 Act, because EU is bound by 1999 Act.

All the examples show the possibility for an applicant to obtain protection in States which are the part of 1960 Act and/or 1999 Act. It is up to the applicant to choose the most appropriate cumulation of entitlements which will result in the broadest geographical scale.

4.2.5 Application

Filing methods

First of all it is very important to remember that any of the national registration is required prior to international registration. The design must not be registered in any national office of Contracting Party to file an application. It can be the first application for protection of design.

Application may be filled directly or indirectly (Article 4). Directly means that it is filled with the International Bureau, which is the International Bureau of WIPO in Geneva in Switzerland. Indirectly means that application is filled the Office of the applicant’s Contracting Party.

Although in EU it should be OHIM we can find an official information that “ OHIM is not a receiving office for international registrations under this system, the Office has no role in the initial procedure and will not accept or forward applications. The Office only becomes involved after publication of international registrations by WIPO, when it examines the grounds for refusal”⁵⁴. Every Contracting party may notify the Director general that applications may not be filed through its Office (Article 4 1b)⁵⁵.

In case of indirect filing the transmittal fee can be imposed.

In Poland it is a Patent office in Warsaw and there is any transmittal fee.

⁵³ Ibid.

⁵⁴ See <http://oami.europa.eu/ows/rw/pages/RCD/protection/intRegistrations.en.do> [accessed March 26,2011].

⁵⁵ The parties which made declarations under Article 4 (1) (b) : African Intellectual Property Organization (OAPI), Croatia, European Union, France, Latvia, Slovenia, Ukraine. (see : <http://www.wipo.int/hague/en/declarations/declarations.html>). [accessed March 26,2011].

There are some filing methods :

- On paper – there is a special form DM/1
- Or electronically on the WIPO website

The WIPO recommends the electronic filing system which is better than a paper application because :

- the delivery of the application is faster,
- the fees are lower when the application contains many reproductions of the industrial designs to be registered,
- the automatic checking of the information is provided what reduces the likelihood of irregularities⁵⁶.

Contents of application

The WIPO delivers special form of “Application for International Registration” which has to be filed in English, French or Spanish. Nevertheless in case of indirect application that Office “may require that the application be in specific language (English, French, or Spanish)”⁵⁷.

There is a mandatory contents of the application. Pursuant to Article 5 The international application shall contain or be accompanied by

(i) a request for international registration under this Act;

(ii) the prescribed data concerning the applicant;

(iii) the prescribed number of copies of a reproduction or, at the choice of the applicant, of several different reproductions of the industrial design that is the subject of the international application, presented in the prescribed manner; however, where the industrial design is two-dimensional and a request for deferment of publication is made in accordance with paragraph (5), the international application may, instead of containing reproductions, be accompanied by the prescribed number of specimens of the industrial design;

(iv) an indication of the product or products which constitute the industrial design or in relation to which the industrial design is to be used, as prescribed;

⁵⁶ DM/1.inf (E), *How to File an International Application, Instruction*, WIPO 2010, 1.

⁵⁷ Ibid.

(v) an indication of the designated Contracting Parties;

(vi) the prescribed fees;

(vii) any other prescribed particulars.

The data concerning the applicant are name, address, telephone, fax and email, entitlement to file, applicant's Contracting Party, Appointment of a Representative.

Designs reproduction and description

An international application can include up to 100 designs⁵⁸ which have to belong to the same class of Locarno classification⁵⁹. There is also a notification made by Estonia, Kyrgyzstan, Romania, Singapore and Syrian Arabian Republic⁶⁰ that “all industrial design contained in a single international application are subject to a requirement of unity of design”⁶¹.

In application the reproduction of design must be delivered. Pursuant to the Rule 9 (1) Common regulations “Reproductions of the industrial design shall, at the option of the applicant, be in the form of photographs or other graphic representations of the industrial design itself or of the product or products which constitute the industrial design. The same product may be shown from different angles; views from different angles shall be included in different photographs or other graphic representations”. As an example some of the designs from WIPO database can be presented – see below.

There is also possibility to provide description and description should relate only to the characteristic visual features. The brief description is required only if Romania or the Syrian Republic is designated. However in the WIPO database we can find a lot of the designs which have description. If the description exceeds 100 words, an additional fee is payable for each word exceeding 100.

Description (excerpt)

⁵⁸ See Rule 7 (3) (v) of the Common Regulations under the 1999 Act and 1960 Act

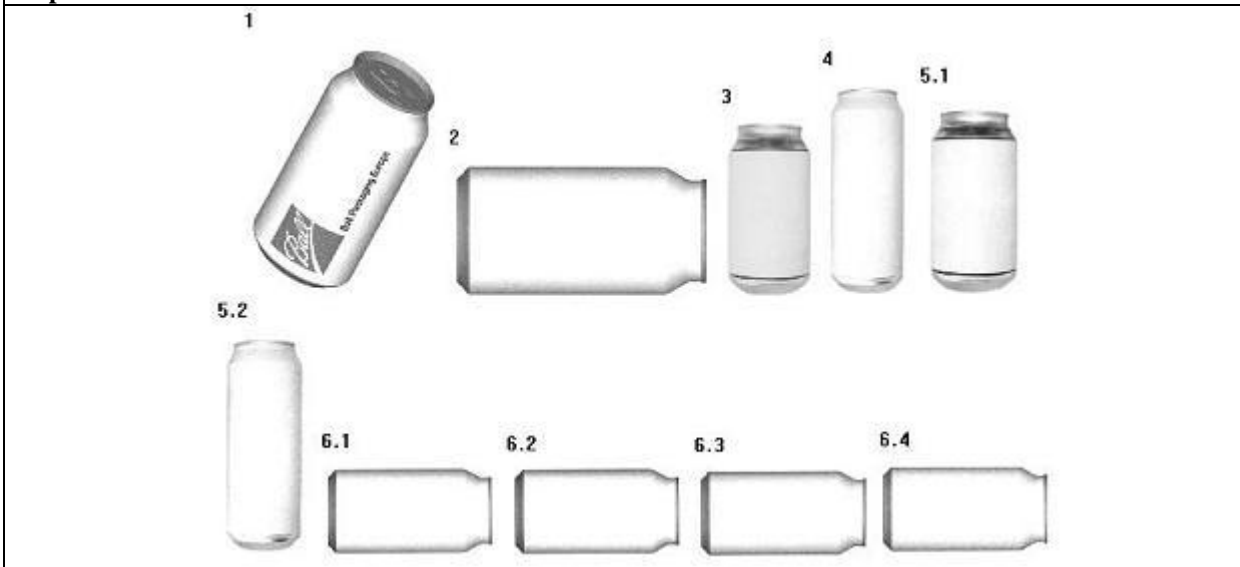
⁵⁹ “The Locarno Classification comprises a list of 32 classes and 219 subclasses with explanatory notes and an alphabetical list of goods in which industrial designs are incorporated, with an indication of the classes and subclasses into which they fall. This list contains some 7,024 indications of different kinds of goods” http://www.wipo.int/classifications/locarno/en/#P6_76. [accessed March 26,2011].

⁶⁰ See <http://www.wipo.int/hague/en/declarations/declarations.html> Article 13(1) (requirement of unity of design) :*Estonia, Kyrgyzstan, Romania, Singapore, Syrian Arab Republic* [accessed March 26,2011].

⁶¹ DM/1.inf (E), 6.

(11) DM/068967 (15) 17.03.2005 (18) 17.03.2010
 (22) 17.03.2005 (73) BALL PACKAGING EUROPE GMBH, Kaiserswerther Strasse 115, 40880 Ratingen (DE) (86)(87)(88) DE (74) Leonhard Olgemöller Fricke Postfach 10 09 62, 80083 München (DE) (72) Willem Leendert Pieter VAN DAM, Officiersweg 26, NL-8162 XL Epe (28) 6 (51) Cl. 09-01 (54) 1.-6. Beverage cans / 1.-6. Boîtes-boissons (57)(55) No. 1: Beverage can in a new format, suitable for 500 ml beverage; the surface decoration has no relevance (disclaimed); No. 2: Beverage can having aspect ratio of about 0.51 (between 0.49 and 0.53), a diameter between 72 mm to 74 mm (about 73 mm) and a height between 141 mm to 145 mm (about 143 mm); No. 3: new format beverage can (format equals diameter/height), suitable for 500 ml beverage; 4. beverage can in a known format (diameter/height) for taking 500 ml beverage, the aspect ratio diameter/height is with a height of 168 mm and a diameter of 66 mm, therefore 0.393 only; 5. set of beverage cans, the surface decoration is disclaimed, the shape and format of can 5.1 is claimed, can 5.2 of same volume is for direct comparison and is disclaimed; 6. beverage can in four side views having aspect ratio of 0.49 to 0.53, and a diameter between 72 mm to 74 mm and a height of 141 mm to 145 mm (81) I. EG, ID. II. HR, ME, RS. (30) 17.09.2004; 404 05 388.2; DE (45) 30.06.2007

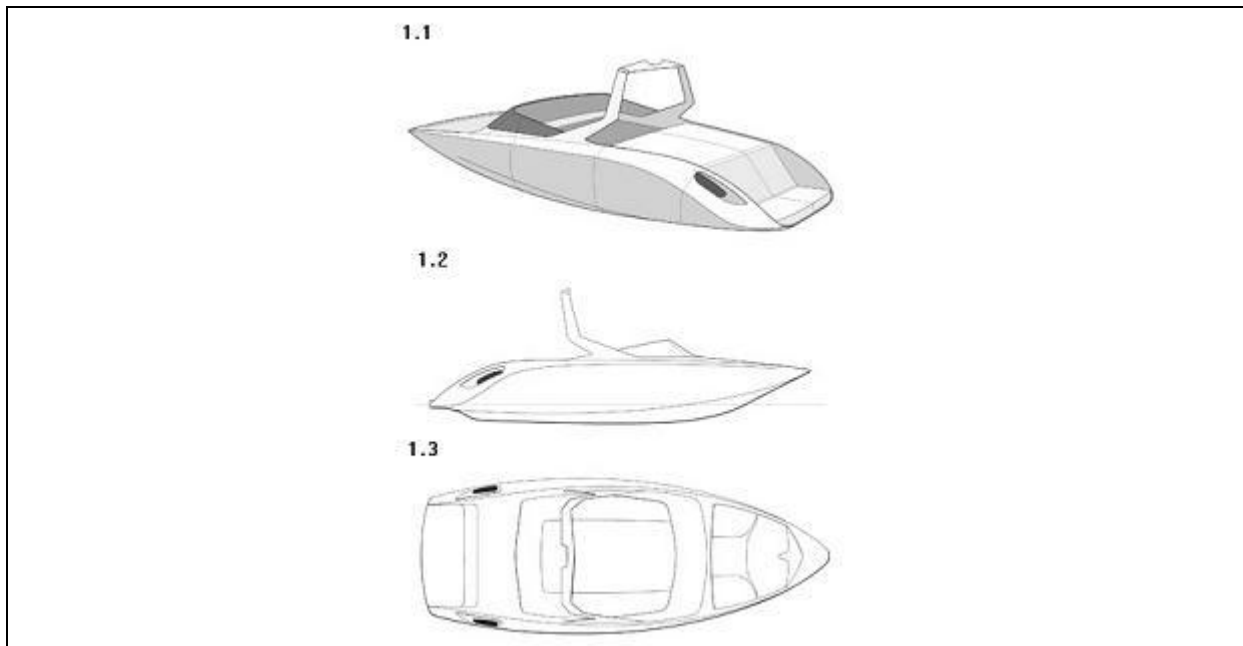
Reproduction



Description (excerpt)

(11) DM/073239 (15) 09.03.2010 (18) 09.03.2015
 (22) 09.03.2010 (73) OLUMIDE SOMEFUN, Van Twiskwater 23, NL-2497 ZW The Hague (NL) (86)(87)(88) BX,EM (89) EM (72) Olumide Somefun, Van Twiskwater 23, NL-2497 ZW The Hague; Marin Licina, Van Adrichemstraat 19, Delft (NL) (28) 1 (51) Cl. 12-06 (54) 1. Boat / 1. Bateau (57)(55) Boat with special hull design; the distinctive characteristics are: the positioning of the windshield; the ski/wakeboard tower; the side of the boat with a wide slope towards the end of the boat with integrated exhaust outlets; the integrated ski platform at the end of the boat (81) II. BX, MC. III. CH, EM, HR, TR (45) 30.04.2010

Reproduction



Every Contracting Party can also require that some additional information must be given by applicant (article 5 (2)). There are as follows :

- (i) indications concerning the identity of the creator of the industrial design that is the subject of that application;
- (ii) a brief description of the reproduction or of the characteristic features of the industrial design that is the subject of that application;
- (iii) a claim⁶².

Identify of the creator is needed if applicant designates Romania, Ghana, Iceland, Bulgaria, Norway and Serbia (see point 6 of Application Form).

First, Romania has made declaration pursuant to Article 5 (2)(b)(1). Second, Ghana and Iceland made a declaration according to Rule 8(1) Common Regulations because their legislation requires that in the application for the registration of designs the name of the

⁶² There are some declarations made by Contracting Parties concerning additional information (<http://www.wipo.int/hague/en/declarations/declarations.html>). [accessed March 26,2011].
 Article 5(2)(b)(i) (identity of the creator as additional mandatory content) : Romania
 Article 5(2)(b)(ii) (brief description as additional mandatory content) : Romania, Syrian Arab Republic
 Article 5(2)(b)(iii) (claim as additional mandatory content) : None

creator should be filed⁶³. Third, Bulgaria, Norway and Serbia “informed the International Bureau that their respective national laws require that element”⁶⁴.

Designation of the Contracting Parties

In point 10 of the Application form the designated Contracting Parties have to be indicated. According to the instructions of the form “the designated Contracting Party must be bound by an Act – the 1999 Act and/or the 1960 Act – to which one of the Contracting Parties indicated in item 3 (Entitlement to file) is also bound”.

It means if the applicant is from Poland and is domiciled in Poland he or she can only designate the Contracting Parties bound by 1999 Act or bound by 1999 Act and 1960 Act. He or she cannot designate the Party bound only by 1960 Act. Because Poland is a member of the EU and EU is the Party to the 1999 Act in some cases it would be possible to designate Parties bound only by 1960 Act. It would be the case with Italy which is bound only by 1960 Act.

It is important that an applicant can also designate and request protection in the applicant’s Contracting Party. However pursuant to Article 14 (3) 1999 Act “any Contracting Party whose Office is an Examining Office may, in a declaration, notify the Director General that, where it is the applicant's Contracting Party, the designation of that Contracting Party in an international registration shall have no effect”. If the applicant indicates applicant’s contracting party then the International Bureau disregards the designation. Nowadays it is only Bulgaria.

4.2.6 Priority

In the international application the priority can be claimed under Article 4 of the Paris Convention⁶⁵. It means if there was a first national or regional filed in or for any country party to the Convention or any Member of the WTO. According to Rule 7(5)(c) Common

⁶³ See <http://www.wipo.int/hague/en/declarations/declarations.html> : Rule 8(1) (special requirements concerning the applicant) : Ghana, Iceland [accessed March 26,2011].

⁶⁴ See DM/1.inf (E), 6.

⁶⁵ Article 4 A (1) Paris Convention “Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed”.

Regulations the applicant should indicate the name of the Office where the first filing was made, the date and if it is possible the number of that filing.

It is important to remember that “the International Bureau disregards any claimed priority which bears a date which is more than six months than the filing date of the international application”⁶⁶.

Another opportunity is to look for International Exhibition Priority under Article 11 of the Paris Convention⁶⁷. In this case it should be also filed in the application form by indicating the place, name and date of exhibition.

4.2.7 Publication

According to the Rule 17 (1)(iii) Common regulations the international registration shall be published six months after the date of the international registration or as soon as possible thereafter. The registration can be also published where the applicant so requests immediately after the registration or the deferment can be requested. The period of deferment cannot exceed 30 months from the date of international application. However there are some exceptions : if Iceland, Poland or Singapore is designated, or if Bulgaria or Ukraine is designated under 1999 Act the deferment of publication cannot be requested. In case when Denmark or Norway are designated then the period of determent cannot exceed 6 months. The third exception is when Contracting Party is designated under 1960 Act or Croatia, Estonia, OAPI, Slovenia or the Syria Arab Republic are designated the period of deferment cannot be longer than 12 months.

4.2.8 Signature and payments

Application must be signed by applicant or his representative (Rule 7 (1) Common Regulations).

The international application is not for free. The fees has to be paid in Swiss Francs directly to the International Bureau. They are due at the time of filling unless there is a request for deferment of publication. As it is mentioned in Rule 12 Common regulations there are :

- Basic fees

⁶⁶ Article 4 C (1) The periods of priority referred to above shall be twelve months for patents and utility models, and six months for industrial designs and trademarks. (2) These periods shall start from the date of filing of the first application; the day of filing shall not be included in the period.

⁶⁷ (1) The countries of the Union shall, in conformity with their domestic legislation, grant temporary protection to patentable inventions, utility models, industrial designs, and trademarks, in respect of goods exhibited at official or officially recognized international exhibitions held in the territory of any of them.

- A standard designation fee or an individual designation fee
- A publication fee

The schedule of the fees can be found on the WIPO webpage⁶⁸. The WIPO offers also a fee calculator which allows to calculate all fees.

For example the fee which the Polish applicant has to pay for protection in all Contracting Parties (incl. EU and AIPO) of his one design with only one reproduction is 3011 Swiss francs. If he or she wants to protect two designs the fee of 3953 Swiss francs is to be paid. But in case if he or she seeks protection in 10 countries outside the EU for one design he or she is going to pay 1079 Swiss francs. As we can see the amount of the fees can differ markedly and it is very important to reasonably designate the Contracting Parties.

4.2.9 Examination by the International Bureau and by the Office

When the application is ready and paid it can be sent to the International Bureau. Upon receipt of application the International Bureau “checks that it complies with prescribed formal requirements”⁶⁹. It is only formal examination. There is any substantive examination, the Bureau does not appraise for example the novelty of the design. It cannot reject the application on any substantive ground. If the application conforms to the applicable requirements the Bureau shall register the industrial design in the International register and send a certificate to the holder (Rule 15 (1) Common Regulations). The international registration is published in International Designs Bulletin⁷⁰ which is available on-line. Pursuant to the Rule 15 (2) Common Regulations the International Registration shall contain :

- all the data contained in the international application
- any reproduction of the industrial design
- the date of the international registration
- the number of the international registration
- the relevant class of the International Classification

Below there is an example of all information published in the International Designs Bulletin of a pen.

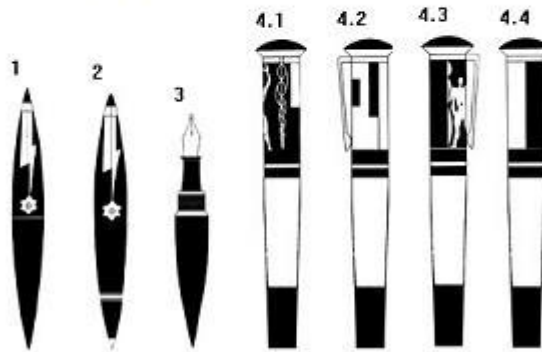
⁶⁸ <http://www.wipo.int/hague/en/fees/sched.htm> [accessed March 26,2011].

⁶⁹ Guide, A 4.

⁷⁰ “The WIPO International Designs Bulletin is the official publication of the International Register of the Hague System. Every month the International Bureau publishes data regarding new international registrations, renewals, and modifications affecting existing international registrations”, It is available on the webpage of WIPO : <http://www.wipo.int/hague/en/bulletin/> [accessed March 26,2011].

Enregistrements internationaux /
International Registrations /
Registros Internacionales

(11) DM/074968 (15) 13.12.2010
(22) 13.12.2010 (73) KARÈNE G. LE DRIAN, Rte de Frontenex 59, CH-1207 Genève (CH) (86)
CH (87) FR, EM (88) CH (85) FR, EM (89) CH (72) Karène G. Le Drian, 59 Rte de Frontenex,
1207 Genève, Suisse (28) 4 (51) Cl. 19-06 (54) 1. Stylographe; 2. Stylo bille; 3.-4. Stylographes
/ 1. Stylograph; 2. Ball-point pen; 3.-4. Stylographs / 1. Estilográfica; 2. Bolígrafo; 3.-4.
Estilográficas (81) Ill. E.M. (30) 15.09.2010; 137365; CH



The registered design for a pen in WIPO DM/074968

After the publication of the design in the International Design Bulletin the Office any designated Contracting Party may refuse the effect of the international registration where the conditions for the grant of protection under the law of that Contracting party are not met in respect of any or all of the industrial designs that are the subject of an international registration (Article 12 1999 Act). Nevertheless the Office cannot refuse the effect “on the ground that requirements relating to the form or contents of the international application that are provided for in this Act or the Regulations or are additional to, or different from, those requirements have not been satisfied under the law of the Contracting Party concerned”⁷¹. This is a substantive examination as opposed to formal examination which is carried out by the International Bureau. The Office may notify that protection was refused for its territory. In this case it has to communicated the Bureau about refusal stating the grounds on which the refusal is based. The period for the notification of refusal shall be six months from the publication of the international registration (Rule 18 (1)(a) Common Regulations). In Iceland, Kyrgyzstan, Lithuania, Republic of Moldova, Romania, Spain, Syrian Arab Republic, Turkey⁷² the period of 6 months was replaced by period of 12 months (the extensions is possible pursuant to Rule 18 (1)(b) Common Regulations).

⁷¹ Article 12 1999 Act.

⁷² See <http://www.wipo.int/hague/en/declarations/declarations.html> [accessed March 26,2011].

4.3 Effect of the International Application and duration of protection

According to Article 14 1999 Act “the international registration shall (...) have at least the same effect in each designated Contracting Party as a regularly-filed application for the grant of protection of the industrial design under the law of Contracting Party”.

This is probably the most important advantage of International registration. An applicant can seek protection of his or her industrial designs in each country which was designated in application unless the protection is refused.

Normally he or she would have to file all the application separately in each country. It would be more expensive and time-consuming. The applicant can fill the given form and pay the fees without going out from home using English, Spanish or French. The procedure seems to be quite easy and inexpensive in comparison with obtaining registration separately in all Contracting Parties (there are almost 60 Parties).

It is important to mention that the initial term of protection is five years counted from the date of international registration. This term can be renewed for additional terms of five years in accordance with special procedure and subject to the payment of the renewal fees⁷³. The duration of protection (if the holder renews the international registration) shall in each designated Contracting party be 15 years counted from the date of international registration (Article 17 (3) 1999 Act). It means that 5 years period of protection can be extended twice (5 (basic) +5 (1st renewal) +5 (2nd renewal)). However if the law of designated Contracting Party provides longer period of protection than 15 years, the duration of protection shall be the same as that provided by the law of the Contracting Party. Pursuant to Article 17 (3) (c) each Contracting Party shall notify the maximum duration of protection. The table below presents the maximum duration of protection in each Contracting Party.

African Intellectual Property Organization 15 years	Latvia 25 years
Albania 15 years	Liechtenstein 25 years
Armenia 15 years	Lithuania 25 years
Azerbaijan 15 years	Mali 15 years
Belize 15 years	Monaco 50 years
Benelux 25 years	Montenegro 15 years
Benin 15 years	Morocco 50 years

⁷³ The basic fee is 200 Swiss francs for one design (see <http://www.wipo.int/hague/en/fees/sched.htm>) but there are also special, individual fees (see : <http://www.wipo.int/hague/en/fees/individ-fee.html>) [accessed March 26,2011].

Botswana 15 years	Namibia 15 years
Bulgaria 25 years	Niger 15 years
Côte d'Ivoire 15 years	Norway 25 years
Croatia 25 years	Oman 15 years
Denmark 25 years (except: spare parts, 15 years)	Poland 25 years
Egypt 15 years	Republic of Moldova 25 years
Estonia 25 years	Romania 25 years
European Union 25 years	Sao Tome and Principe 15 years
France 25 years	Senegal 15 years
Gabon 15 years	Serbia 25 years
Georgia 15 years	Singapore 15 years
Germany 25 years	Slovenia 25 years
Ghana 15 years	Spain 25 years
Greece 25 years	Switzerland 25 years
Hungary 25 years	Syrian Arab Republic 15 years
Iceland 25 years	The former Yugoslav Republic of Macedonia 25 years
Italy 25 years	Turkey 25 years
Korea (Democratic People's Republic of) 15 years	Ukraine 15 years
Kyrgyzstan 15 years	

We have to keep in mind that the system of international registration does not provide any system of protection. The protection of design is granted by the law of each Contracting Party. Although the Hague Agreement is an important step to international system of designs protection its role cannot be overestimated. It is only the equivalent to national registration and it can also “facilitates the maintenance protection with a single request to renew the international registration and to record any changes, e.g., in ownership or address” . In case we seek protection for our designs in designated Contracting Parties we still have to know the procedure of each Contracting Party and the rights we are granted. It is probably the biggest disadvantage and I would recommend to harmonize also the system of protection of design on the international level and Hague Agreement is a good step to achieve this goal.

Conclusions

1. The design protection plays an important role in developed and developing countries. It provides compensation for investment, and encourages producers to create more and better products which are more attractive for consumers. It is necessary to point out some important aspects in giving protection to design which are as follows :

- the wish to promote investment in design development as an element of industrial policy,
- the need to protect creativity in respect of industrial design,
- the need to avoid confusion among consumers as to the origin of products having identical or similar appearances,
- and the respect of the principle of fairness in trade.

These assumptions are basic for free movement of products, and it seems that the best solution would certainly be the same basis of protection in the whole World

It is important to keep in mind that the grant of intellectual rights to design should not distort competition to a great extent.

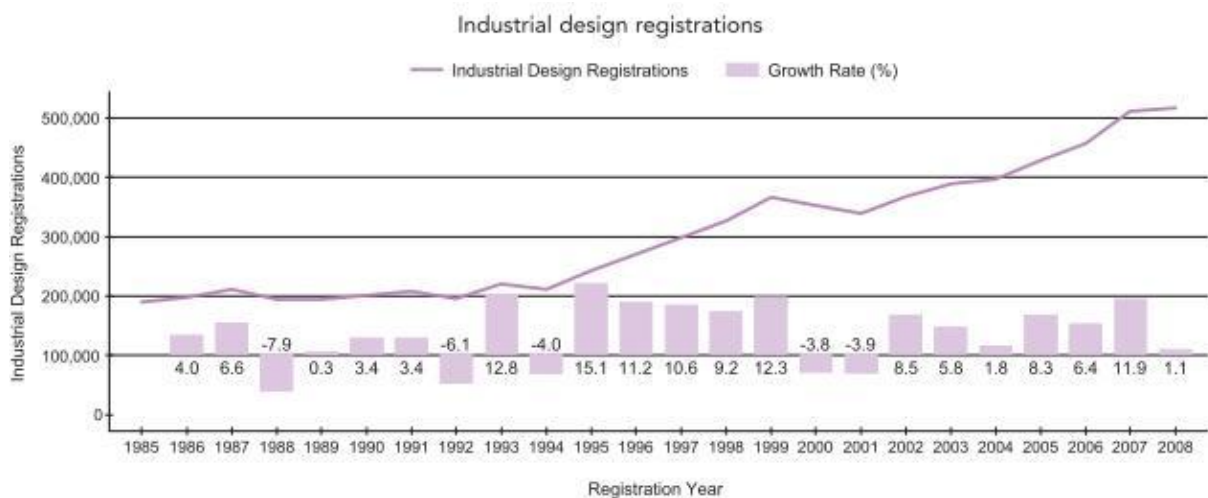
2. I think that International Convention like Paris Convention and Berne Convention are losing on the importance in developed countries. Most of the developed countries provides system for protection of designs. The above mentioned Convention are too general to harmonize system of protection of designs. However, they introduce the principles which are internationally recognized and the Conventions can still be very important in developing and in the least developed countries. TRIPS Agreement is more precise and regulates the protection of design more appropriate but it is still not enough. It lacks for example in definition of design etc.

3. The Hague Agreement which provides a very efficient and clear system for international registration of design is a good step toward international system not only for registration but also for protection of design.

4. Nowadays in my opinion the possibility of cumulative protection is a big disadvantage for the clarity of design protection. Cumulative protection may give rise to problems because a product can be protected not only as a design under sui generis system created especially for designs, but also as a work of applied art and industrial design under copyright law, as well as a trademark, or as a utility model and also under patent law and unfair competition rules. The

main question is whether there is a possibility to exclude some forms of protection or to limit the scope of protection. Probably there is no unequivocal answer but it seems some forms of protection should be excluded.

5. There is a growing number of registrations of designs (see below) and because of it the international system of protection of designs should continue to develop.



Source : World Intellectual Property Indicators 2010, WIPO 2010, Publication No. 941 (E), 98 [accessed March 26,2011].

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