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Legal Protection of Industrial Design

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Abstract

Industrial Design as one of Intellectual Property Rights legal systems play an important role in the trading of consumer goods or products. Industrial design is an Intellectual Property (IP) tools that contribute to a branding strategy and therefore need an industrial and legal protection. The protection conferred by the design law is necessary for industries to use the design and gain the market share by protecting new designed products or goods for a certain period of time. As applied in most countries, in order to be eligible for protection, the design should come into the register nationally or internationally. As the procedures applied for the design registration are different between countries, harmonization on the procedure will be necessary to provide a greater assurance in the protection of industrial design in the era of market globalization. As a member of World Intellectual Property Organization, Myanmar need to recognize and respect the protection and enforcement of intellectual property rights according to the ASEAN Framework Agreement on Intellectual Property Co-operation and also obliged to enhance ASEAN cooperation in intellectual property protection. Thus, Myanmar should enact specified law and regulation relating to the protection of Industrial Designs.

Key word: Intellectual Property, Industrial Design

Introduction

Nowadays, the economic development could not be separated from the increasing of international intellectual property-based trade activities. Industrial Design as one of the Intellectual Property Rights legal systems play an important role in the trading of consumer goods or products, and a proven in our daily life, most people do depend on the appearance of product resulted from work of designing. Due to its nature, industrial design is closed-linked in between form and function of an article or a product. Certainly, the main purpose of industrial design is to make products look good, to provide an attractive appearance that makes consumers prefer to buy and use them. Yet designers have other equivalent important goods. A good industrial designer also wants to make products easy (and perhaps even fun) to use, safe to have and operate easy and cheap to manufacture, and simple to repair. Thus, if creations of human creativity are involved in a certain marketable products or goods, then in certain conditions intellectual property rights exist, and need to be rewarded in the form of protection.

Material/Methods

Intellectual property law protects the property rights in creative endeavours and gives creators and inventors certain exclusive economic rights, generally for a limited time, to deal with their creative works or inventions. This legal protection is designed as a reward to creators to encourage further intellectual creativity and innovation, as well as enabling access by the community to the products of intellectual property.

Finding

Industrial design protection through its registration at the national or regional intellectual property office, the owner obtains the exclusive right to prevent its unauthorized copying or imitation by others. By registering a design you are able to prevent it from being copied and imitated by competitors, and thereby strengthen your competitive position.

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Registering a valuable design contributes to obtaining a fair return on investment made in creating and marketing the relevant product, and thereby improves your profits. Industrial designs are business assets that can increase the commercial value of a company and its products. The more successful a design, the higher is its value to the company. A protected design may also be licensed (or sold) to others for a fee. By licensing it, you may be able to enter markets that you are otherwise unable to serve. Registration of industrial designs encourages fair competition and honest trade practices, which in turn, promote the production of a diverse range of aesthetically attractive products.

Discussion

An industrial design adds value to a product. It makes a product attractive and appealing to customers, and may even be its unique selling point. So protecting valuable designs should be a crucial part of the business strategy of any designer or manufacturer.

Intellectual Property

Intellectual property is any innovation, commercial or artistic, or any unique name, symbol, logo or design used commercially.

Intellectual property is a category of intangible rights protecting commercially valuable products of the human intellect, in a concrete or abstract form, such as a copyrightable work, a protectable trademark, a patentable invention, or a trade secret.

Intellectual property is divided into two categories:

Industrial property, which includes inventions (patents), trademarks, industrial designs, and geographic indications of source; and Copyright, which includes literary and artistic works such as novels, poems and plays, films, musical works, artistic works such as drawings, paintings, photographs and sculptures, and architectural designs. Rights related to copyright include those of performing artists in their performances, producers of phonograms in their recordings, and those of broadcasters in their radio and television programs.

Industrial Designs

An industrial design is the ornamental or aesthetic aspect of an article. The design may consist of three-dimensional features, such as the shape or surface of an article, or of two dimensional features, such as patterns, lines or color.

Although the design of a product may have technical or functional features, industrial design, as a category of intellectual property law, refers only to the aesthetic nature of a finished product, and is distinct from any technical or functional aspects. Industrial design is relevant to a wide variety of products of industry, fashion and handicrafts from technical and medical instruments to watches, jewelry, and other luxury items; from household products, toys, furniture and electrical appliances to cars and architectural structures; from textile designs to sports equipment. Industrial design is also important in relation to packaging, containers and "get-up" of products.

As a general rule, an industrial design consists of:

- three-dimensional features, such as the shape of a product, shape means primarily external form of the article,
- two-dimensional features, such as ornamentation, patterns, lines or color of a product;
or
- a combination of one or more such features.

An industrial design adds value to a product. It makes a product attractive and appealing to customers, and may even be its unique selling point. So protecting valuable designs should be a crucial part of the business strategy of any designer or manufacturer.

International Standards on the Protection of Industrial Design

Paris Convention for the protection of industrial property (1883) is the first major international agreement covering general standards of protection to be provided by states in the area of patents, industrial designs and marks. The Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPs)(1994) is the most important agreement in the field of intellectual property rights. The Hague Agreement Concerning the International Deposit of Industrial Designs (1925) governs the WIPO, administered global protection system for registering designs. The Locarno Agreement Establishing an International Classification for Industrial Designs is a multilateral international treaty to establish the international classifications for industrial designs.

Registration as an industrial design

Industrial design protection is usually granted pursuant to a procedure for the registration of such designs.

As a general rule, to be able to be registered, a design must meet one or more of the following basic requirements, depending on the law of the country:

- The design must be "new". A design is considered to be new if no identical design has been made available to the public before the date of filing, or the application for registration.
- The design must be "original". A design is considered original if it has been independently created by the designer and is not a copy or an imitation of existing designs.
- The design must have "individual character". The requirement is met if the overall impression produced by a design on an informed user differs from the overall impression produced on such a user by any earlier design which has been made available to the public.

Industrial Designs that cannot be protected

Designs that are generally barred from registration in many countries include the following.

- Designs that do not meet the requirements of novelty, originality and/ or individual character (as explained above).
- Designs that are considered to be dictated exclusively by the technical function of a product; such technical or functional design features may be protected, depending on the facts of each case, by other IP rights (e. g. patents, utility models or trade secrets).
- Designs incorporating protected official symbols or emblems (such as the national flag).
- Designs which are considered to be contrary to public order or morality.

In addition, it is important to note that some countries exclude handicrafts from design protection, as industrial design law in these countries requires that the product to which an industrial design is applied is "an article of manufacture" or that it can be replicated by "industrial means".

The person who owns that rights over an industrial design

In general, the person who create the design, or if working under contract, his employer can apply for registration. The applicant can be either an individual (e.g. a designer) or a legal entity (e. g. a company).

The creator of a design, i.e. the designer, is usually the first owner of the design, unless there are special circumstances. For example, in most countries, if an employee has developed a design under the terms for an employment contract, that is, during his working house within the enterprise and as part of his regular duties within the enterprise, the design (and the related rights) will belong to the employer or may require to be transferred by a formal written assignment.

The time it takes to register a design

Depending on each national IP office, the process of registration of an industrial design generally takes six to 12 months or longer depending on a number of issues such as whether any objections are raised by the design examiner or if there is a provision for opposition prior to the registration of the industrial design under consideration.

The duration of the protection of industrial designs

The term of protection for a registered industrial design varies from country to country, but is usually at least 10 years (although it is often longer; for example, 14 years for design patens in the United States of America, and up to 25 years under the registered Community Design of the European Union). In many countries, rights holders are required to renew their design protection after five years.

Keeping design secret prior registration

If you wish to protect your industrial design under a registration system, keeping the design confidential is absolutely crucial. The reason for this is that the central requirement of design protection is generally, that the design must be "new". If you show your deign to others it is advisable to have confidentiality clauses in written agreements, clarifying that the design is confidential.

A design that has already been disclosed to the public by, for example, advertising it in your company's catalogue or brochure may no longer be considered "new". It becomes part of the public domain and cannot be protected, unless the applicable law provides for a "grace period" or unless the priority of an earlier application can be claimed.

Grace period

In some countries, the legislation allows for a grace period for registration of generally six months or a year from the moment a design was made public, disclosed or published.

This is the case when articles bearing the design are sold, displayed at a trade show, exhibition or fair, or are published in a catalogue, brochure or advertisement prior to filing an application. During that period, you may market your design without it losing its "novelty" and you may still apply for registration.

Using Industrial Design as a business asset (Licensing)

Industrial designs are license when the owner of the design (licensor) grants permission to another person (the licensee) use the design for whatever mutually agreed purposes. In such cases, a licensing contract is generally signed between the two parties specifying the terms and scope of the agreement.

Licensing contracts often include limitations as to the countries where the licenses may use the design, the time for which the license is granted and the type of products for which it can be used. In order to license the use of the design in foreign countries you would need to have previously obtained, or at least applied for, industrial design protection in the countries concerned.

Authorizing others to use your industrial designs through a licensing contract will enable your business to receive an additional source of revenue and is a common means of exploiting a company's exclusivity over its registered designs.

Agreements to license of industrial designs are often included in broader licensing agreements, which cover all aspects (i.e. not just the visual elements) of a product.

The Enforcement of Industrial Designs Protection

When an industrial design is protected by registration, the owner is granted the right to prevent unauthorized copying or imitation by third parties. This includes the right to exclude all others from making, offerings, importing, exporting or selling any product in which the design is incorporated or to which it is applied. The law and practice of a relevant country or region determine the actual scope of protection of the registered design.

Whenever you believe there is infringement, you may choose, as a first step, to send a "cease or desist letter" informing the infringer of a possible conflict between his design and your exclusive rights. The assistance of a lawyer in drafting such a letter is recommended. If the infringement persists, it may be necessary to take legal action against the infringer.

If you know the location of the infringing activity, it may be possible to take surprise action by obtaining a search and seize order (usually from a competent court or the police) to conduct a raid, without prior notice to the allegedly offending company/ individual.

In order to prevent the importation of infringing goods, measures at the international border are available to the design owner in many countries through the national customs authorities.

As a general rule, if infringement is identified, it is highly advisable to seek professional legal advice.

Conclusion

An industrial design is the ornamental or aesthetic aspect of an article. The design may consist of three-dimensional features, such as the shape or surface of an article, or of two dimensional features, such as patterns, lines, or color. In most ASEAN countries, in order to be eligible for protection, the design may be registered nationally or international. In order to be registered, the design must be "new" or "original". Most ASEAN countries are going by enacting and revising their legislation to be consistent with the provisions of TRIPS agreement.

As a member of World Trade Organization and World Intellectual Property Organization, Myanmar should implement the national legislation of industrial design in line with the TRIP agreement's compliance. In the modern Intellectual Property regime, it is necessary to adopt specific law as the industrial design law.

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References

WIPO Intellectual Property Handbook Policy, Law and Use

Milan Chromecek & Stuart C. McCormack Stikeman, Elliot, World Intellectual Property Guidebook, Canada, 1991

Paris Convention For the Protection of Industrial Property (1883)

The Hague Agreement Concerning the International Deposit of Industrial Design (1925)

The Locarno Agreement Establishing on International Classification For Industrial Designs (1968)

The Agreement on Trade. Related Aspects of Intellectual Property Right (TRIPS) (1994)

www.wipo.int/sme

www.wipo.int/design/en

www.domainhandbook.com/gloss.html

www.stopfakes.gov/sf-what.asp

www.wisegeek.com/what-is-intellectual-property.htm

www.wpo.int/about-ip/en/studies/publications/p-definition.htm