

Congress Milan 2016
Adopted Resolution
September 20, 2016

Resolution

2016 – Study Question (Designs)

Requirements for protection of designs

Background:

- 1) This Resolution concerns the definition of and the requirements for the protection of designs, with a particular focus on the role of functionality. The protection of "partial designs" (i.e. a portion or portions of a whole product) is outside the scope of this Resolution.
- 2) Pursuant to Article 5quinquies of the Paris Convention for the Protection of Industrial Property, industrial designs shall be protected in all the countries of the Union. Article 25 of the Agreement on Trade-related aspects of Intellectual Property Rights (TRIPS) requires members to provide for the protection of independently created industrial designs that are new or original.
- 3) The scope of design protection, and the role of functionality in relation to eligibility for that protection, are current and important topics surrounded by considerable uncertainty. Harmonisation in these respects is desirable.
- 4) Recognising that terminology may differ between jurisdictions, this Resolution addresses a registered or patented intellectual property right (whether or not examined) that specifically protects the outward appearance or ornamentation of an object or article of manufacture.
- 5) This Resolution does not address whether independent protection for constituent visual portions of that whole product may be pursued in independent design registration(s).
- 6) For the purposes of this Resolution, the terms **functional** and **function** refer to technical functionality, not "aesthetic functionality", which has its origins in trademark law in certain jurisdictions.

- 7) 43 Reports were received from AIPPI's National and Regional Groups and Independent Members providing detailed information and analysis regarding national and regional laws relating to this Resolution. These Reports were reviewed by the Reporter General of AIPPI and distilled into a Summary Report (See below links.)
- 8) At the AIPPI World Congress in Milan in September 2016, the subject matter of this Resolution was further discussed within a Study Committee and again in a full Plenary Session, which led to the adoption of the present Resolution by the Executive Committee of AIPPI.

AIPPI resolves that:

- 1) Design protection should be available, by way of registration, to protect the overall visual appearance (including ornamentation) (**Appearance**) of an object or article of manufacture as a whole (**Product**).
- 2) The preferred term for the right referred to under paragraph 1) is "Registered Design" and is used hereafter.
- 3) At a minimum, novelty should be a requirement for protection of a Registered Design.
- 4) Protection as a Registered Design should not be available for the Appearance of a Product that is dictated solely by the Product's functional characteristics or functional attributes (**Technical Function**). Protection as a Registered Design should be available for the Appearance of a Product even if a portion of the Appearance is dictated solely by the Product's Technical Function.
- 5) The assessment of whether the Appearance of a Product should be considered dictated solely by its Technical Function should include at least:
 - a) whether there is no alternative Appearance for the Product that would obtain substantially the same Technical Function, and optionally
 - b) whether the need to achieve the Technical Function of the Product was the only relevant factor when the Appearance of the Product was arrived at.
- 6) A Registered Design should protect the Appearance of a Product, but should not protect separately or independently any constituent visual portions of that Appearance.
- 7) In the assessment of the scope of protection of a Registered Design, no visual portion of the Appearance of the Product should be excluded from consideration, even if the appearance of any such portion is dictated solely by the functional characteristics or functional attributes of any such portion of the Product, but such portions may be given less weight in the assessment. While the functional characteristics or functional attributes of any such portion should not be protected, all visual aspects of such portion, including its size, position and spatial

relationship relative to the Appearance of the Product, should be taken into account when assessing the scope of protection of the Registered Design.

Links:

- Study Guidelines
<http://aippi.org/wp-content/uploads/2015/12/2016-Study-Guidelines-Requirements-for-protection-of-designs.pdf>
- Summary Report
http://aippi.org/wp-content/uploads/2016/08/2016_Summary_Report_Designs_FINAL_090816.pdf
- Reports of National and Regional Groups and Independent Members
<http://aippi.org/committee/requirements-for-protection-of-designs/>