

The WIPO And Fighting Global Design Knock-offs

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Many American companies depend on strong global sales of key products featuring innovative product design. Foreign knockoffs of these designs can be common and devastating to these companies, making the need for strong international legal protections obvious. A few weeks ago, this blog touched on an international registration system available to companies for efficiently protecting their brands in several jurisdictions across the globe. Additionally, a similar system for protecting a product's industrial design (i.e. appearance), has recently become available for companies in the United States making it easier to obtain robust global design protection.

The Hague System for the International Registration of Industrial Designs attempts to provide a streamlined application process for simultaneously obtaining rights in several countries around the world. If prepared for efficient registration, an application to The Hague system can save applicants significant time and money. Applicants, however, should be mindful that several prominent countries are not members of The Hague system, and an application prepared for efficient registration may unnecessarily narrow the scope of protection awarded.

The U.S. signed onto The Hague system just over a year ago. By comparison, it has been a member of the Madrid Protocol for more than a decade. The U.S. isn't the only recent addition to The Hague system, Japan and Korea only joined in the last couple of years. Other prominent industrial nations, including Canada, Mexico, China, India, and Australia, are still not members of the system. With the U.S., Japan, and Korea on board, the World Intellectual Property Organization (WIPO) is hopeful that these other prominent non-member nations will soon follow as members of the Hague system.

Convincing these nations, and others with their own existing design protection laws, to join a system whose intent is to harmonize of those laws, can be a challenge. As a compromise, The Hague system allows for "Declarations." By making declarations, a joining member of The Hague system is able to amend provisions of the system and alter the rights and responsibilities of filers for design protection in their countries.

Several recent, and hopefully forthcoming, members of The Hague system have existing domestic laws that call for a detailed examination process tasked with judging the clarity or completeness of a design. In several instances, the novelty and inventiveness of a design is compared to pre-existing designs prior to registration of the design. By contrast, several long-time members of The Hague system review applications for design registration for formalities of the application, but otherwise postpone substantive review until enforcement proceedings begin.

Countries such as the U.S. that perform substantive examination of design applications have used declarations in an effort to impose responsibilities upon The Hague filings that more closely mirror applications filed directly in their home country. One significant declaration made by the U.S. is to require unity of design. In other words, an application for protection in the U.S. can only include a single unique design. Most European countries do not require unity of design, and accept a single application with up to 100 related designs. For example, while the U.S. would accept only a single sofa design per application, the European Union Intellectual Property Office may accept a single application seeking each new sofa in that year's lineup.

In another example, the U.S. requires naming a specific person or persons involved in the creation of the new design. Most other jurisdictions will accept naming the company as sufficient.

Some provisions of The Hague system impose requirements that incorporate the laws and policy of the jurisdiction in which protection is being requested. Rule 9(4), for example, reads "A Contracting Party may however refuse the effects of the international registration on the ground that the reproductions contained in the international registration are not sufficient to disclose fully the industrial design." Because sufficient disclosure may have a different interpretation in each jurisdiction, the WIPO recently published [a set of guidelines](#) for preparing reproductions (i.e. design drawings). The guidelines address issues such as the minimum number of drawings necessary to fully represent a product, if and how it is possible to protect only a portion of a product as your design, and whether shading can or should be used to clarify contour or other surface features.

The guidelines are helpful, but the need for such guidelines at all, is an indicator of the growing disparities in practice among the members of The Hague system. This is only likely to increase, especially if China becomes a member, because of their relatively restrictive definition of a protectable design.

To prepare the best possible application, it is important to think ahead to the full range of countries and jurisdictions where protection of your product design is warranted. Countries for protection often include countries where significant sales occur and countries where the products are manufactured. With the playing field defined, drawings (reproductions) can be created that will abide by the rules of each jurisdiction where protection will be requested. This approach may result in limiting your maximum protection available from some jurisdictions in exchange for the cost savings of a single application filed under The Hague system.

An alternative approach would seek to provide a comprehensive initial application that can be revised or amended as the application is reviewed in each country of interest. Because the ability to revise your application and the scope of protection varies by country, there is some risk to this approach that protection will be completely denied in some countries of interest. Many U.S. companies may choose to file a U.S.-specific application and a more restricted application under The Hague system.

In conclusion, companies that wish to protect the innovative ornamental configurations of their products in several countries around the globe must be mindful while preparing their application. The Hague system can be an efficient manner to file a single application with a single representative to achieve protection across a large geography. On the other hand, The Hague is not a true one-size-fits-all system, and fitting a round peg into the larger square hole can leave a significant amount of additional protection on the table.

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