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THE INTERNATIONAL PROTECTION OF INDUSTRIAL DESIGNS UNDER THE INTERNATIONAL CONVENTIONS

Pierre Mauguet

I. INTRODUCTION

The international protection of industrial designs must be viewed not only as part of industrial property, but also as part of copyright law, since some national laws protect designs as works of applied art. This Article looks at the international protection of industrial designs within the framework of the Paris Convention for the Protection of Industrial Property (Paris Convention), The Hague Agreement Concerning the International Deposit of Industrial Designs (The Hague Agreement), and the Berne Convention for the Protection of Literary and Artistic Works (Berne Convention).

II. THE PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY

The Paris Convention contains a number of specific provisions relating directly to industrial designs and other more general provisions which are also applicable to industrial designs. Currently, the Paris Convention has ninety-nine countries as members, including the United States.

A. Specific Provisions

Article 5 quinquies of the Paris Convention sets out the general principle that industrial designs are to be protected in all countries within the Paris Union. Article 5, however, contains nothing regarding the type of protection to be afforded to industrial designs. Therefore, each country may meet its obligation to the Paris Convention not only through specific legislation requiring the deposit of industrial designs, but also by other means, such as providing protection under copyright or unfair competition

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To satisfy the demands of article 5 quinquies, industrial designs must enjoy some form of protection.

Article 5(B) of the Paris Convention states: "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." Member states are free to define what they understand by "failure to work." "Work" will normally be understood as meaning the manufacture of products representing or embodying the design.

Pursuant to article 5(D), no indication or mention of the deposit of an industrial design may be required as a condition of the recognition of the right to protection. This provision was inserted at the 1925 Revision Conference, held at The Hague, and related only to industrial designs. Subsequently, in London, during the 1934 Revision Conference, the provision was extended to patents, utility models, and trademarks.

Although national laws may require that there be an indication on the goods that they are protected by the deposit of an industrial design, under the Paris Convention, the presence of such an indication or mention may not constitute a condition of the right to protection. If that were not the case, the holder of the right would be penalized too heavily in the event of an omission.

Nevertheless, the member countries are free to stipulate in their national laws other consequences of the omission of such an indication or mention. For example, a country may decide that an omission would constitute an offense, or it may stipulate that in the event of an omission, no damages could be claimed for an infringement of the protected right. This could be the case even where recognition of the right to protection subsists.

B. General Provisions

Three general provisions of the Paris Convention also concern industrial designs in addition to patents, trademarks, and other industrial property rights.

1. National Treatment

"National treatment" or "assimilation to nationals," derived from article

7. Article 5(D) further states: "No indication or mention of the patent, of the utility model, of the registration of the trademark, or of the deposit of the industrial design, shall be required upon the goods as a condition of recognition of the right to protection." Paris Convention, supra note 2, 21 U.S.T. at 1638, T.I.A.S. No. 6923.
10. The only exception to this proposition is where the infringer had knowledge of the existence of the right despite the absence of any indication or mention.
2(1) of the Paris Convention, applies to industrial designs under article 1(2) of the Convention. Under the national treatment principle, each member country must afford, with respect to industrial property, the same protection to the nationals of the other member countries as it affords to its own nationals. The advantage of this principle, as opposed to the principle of reciprocity, is that any national of a Paris Union country can claim, in any member country, the application, without discrimination of domestic legislation, as it applies to nationals of the member country. National treatment, however, can also lead to unequal treatment, as a result of the differences in national laws. Indeed, highly favorable conditions of protection may be afforded by some countries to nationals of other countries that provide much more restricted protection.

2. Right of Priority

Article 4 of the Paris Convention, which sets forth the right of priority, is an important provision of the Convention and applies equally to patents, utility models, trademarks, inventors' certificates, and industrial designs. Right of priority concerns the point at which an applicant initially deposits a patent, utility model, trademark, or industrial design in a Paris Union country. When such an act occurs, the applicant enjoys a period of time in which to effect corresponding deposits in the other countries of the Paris Union. The industrial design deposits made within the six-month period cannot be invalidated on the ground that deposits have been made by other persons during that period. In addition, deposits made within the priority period...
cannot be invalidated on grounds of disclosure during that period, particularly by offering for sale copies of the design.

One of the practical advantages arising out of the right of priority is that, when an applicant wishes to obtain protection for an industrial design in several countries, he has six months to decide in which countries he wishes to obtain protection. Therefore, during the six-month period, an applicant can arrange, with all care, the necessary procedures to undertake without fearing that others may effect deposits that can oppose his deposit in a Paris Union country.

3. Temporary Protection at International Exhibitions

Another general provision of the Paris Convention concerning industrial designs is article 11. This provision deals with the temporary protection Paris Union countries undertake to grant, in conformity with their domestic legislation, to patentable inventions, utility models, trademarks, and industrial designs, with respect to goods exhibited at official or officially recognized international exhibitions held in a Paris Union country.

The primary purpose of the temporary protection principle is to prevent the exhibit of a product from being considered a disclosure that damages the novelty of the design, and therefore, under certain national laws constitutes an obstacle to any subsequent deposit. The measures taken by the various Paris Union countries to ensure such temporary protection, however, vary dramatically. Some laws make protection subject to an administrative act at the time of exhibition, while others grant such protection without requiring any specific formalities.

The term of protection afforded is also variable. Indeed, article 11 of the Paris Convention provides that temporary protection at international exhibitions may not extend the period of priority set out in article 4 of the Paris Convention. If the right of priority is invoked at a later date, the authorities of any country may provide that the period should start from the date of introduction of the product into the exhibition.

17. Article 11—“Inventions, Utility Models, Industrial Designs, Marks: Temporary Protection at Certain International Exhibitions” reads as follows:

(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.

(2) Such temporary protection shall not extend the periods provided by Article 4. If, later, the right of priority is invoked, the authorities of any country may provide that the period shall start from the date of introduction of the goods into the exhibition.

(3) Each country may require, as proof of the identity of the article exhibited and of the date of its introduction, such documentary evidence as it considers necessary.

Paris Convention, supra note 2, 21 U.S.T. at 1649, T.I.A.S. No. 6923.
III. THE HAGUE AGREEMENT CONCERNING THE INTERNATIONAL DEPOSIT OF INDUSTRIAL DESIGNS

The institution of an international registration of industrial designs was the subject of a wish expressed by the Washington Diplomatic Conference in 1911. It was not until November 6, 1925, however, that The Hague Agreement was adopted.\(^\text{18}\) That Agreement, which constitutes a "special agreement" within the meaning of article 19 of the Paris Convention, took force on June 1, 1928, and has been revised several times.\(^\text{19}\) Depending on the contracting state, the provisions of substance that currently apply are those of the 1934 and 1960 Acts. This Article focuses on the provisions of the 1960 Act which were finalized by the 1967 Act.\(^\text{20}\)

The principle of international deposit of industrial designs arose from the need for simplicity and economy. Its main purpose was to enable protection to be obtained for one or more industrial designs in a number of countries through a single deposit filed with the International Bureau of the World Intellectual Property Organization (WIPO).

Under the provisions of The Hague Agreement, any person entitled to effect an international deposit may obtain, by means of a single deposit, protection for his industrial designs in a number of countries involving a minimum of formalities and expense.\(^\text{21}\) Consequently, the applicant is relieved of the need to make a separate national deposit in each of the countries in which the design requires protection, and avoids the inherent complication of procedures that vary from one country to another. The applicant does not have to submit the required documents in various languages or keep watch on the deadlines for renewal of a whole series of national deposits. Also avoided is the need to pay a series of national fees and agents' fees in varying currencies.

Under The Hague Agreement, the same results can be obtained through a single deposit made with a single office, in one language, on payment of a single set of fees, and in one currency. Presently, there are

\(^{18}\) Act of The Hague, Nov. 6, 1925, 47 Stat. 1789, T.S. No. 834, reprinted in 1 INDUSTRIAL PROPERTY CONVENTIONS, supra note 2.

\(^{19}\) The Hague Agreement was first revised at London, June 2, 1934, 205 L.N.T.S. 179, reprinted in 1 INDUSTRIAL PROPERTY CONVENTIONS, supra note 2, item A-1 (the 1934 Act), and was later amended at The Hague, Nov. 28, 1960 (not yet in force), 1 INDUSTRIAL PROPERTY CONVENTIONS, supra note 2, item B-1 (the 1960 Act). The Agreement has been supplemented by the additional Act of Monaco, Nov. 18, 1961, 1 INDUSTRIAL PROPERTY CONVENTIONS, supra note 2, and the Complementary Act of Stockholm, July 14, 1967, reprinted in 3 S. LADAS, PATENTS, TRADEMARKS, AND RELATED RIGHTS: NATIONAL AND INTERNATIONAL PROTECTION, app. 5B, at 1946 [hereinafter S. LADAS, PATENTS, TRADEMARKS AND RELATED RIGHTS].


\(^{21}\) The Hague Agreement does not define an industrial design, rather this function is reserved to the Paris Union countries.
twenty-one member countries of the Hague Union established by The Hague Agreement. 22

Any national of a contracting country can make an international deposit, and an international deposit does not require any prior national deposit. 23 One makes an international deposit directly with the International Bureau of WIPO, through the depositor or his representative on a form provided free of charge by the International Bureau. The deposit may be effectuated, however, through the national office of a contracting country, if the law of the country so permits. 24

The law of a contracting country also may require, in cases where that country is the state of origin, that the international deposit be made through the national office of that country. 25 Noncompliance with this requirement, however, does not prejudice the effects of the international deposit in the other contracting countries. 26 The international deposit has the same effect in each of the countries for which protection is requested, as if the designs included in the deposit had been deposited directly in that state on the date of the international deposit, subject to the special rules established under The Hague Agreement. This is true particularly in regard to the term of protection.

Protection also may be requested and obtained by means of an international deposit in the country of origin, unless the domestic legislation of that country provides otherwise. Any contracting country whose domestic legislation offers the possibility of refusing protection as the result of an ex officio administrative examination, or of opposition by a third party, may refuse protection for any industrial design, if it fails to meet the requirements of its domestic law.

Refusal of protection may not, however, extend to the formalities and other administrative acts that are to be considered by each contracting country as having been accomplished at the time the international deposit is recorded at the International Bureau. No contracting country may require publication of the international deposits other than the requirements put forth by the International Bureau.

22. Belgium, Benin, Egypt, France, German Democratic Republic, Federal Republic of Germany, Holy See, Hungary, Indonesia, Italy, Liechtenstein, Luxembourg, Monaco, Morocco, Netherlands, Senegal, Spain, Surinam, Switzerland, Tunisia, and Vietnam.

23. A "national" is any natural or legal person having the nationality of one of those countries included in the Union or any individual having his domicile, headquarters, or a real and effective industrial or commercial establishment, in one of those countries.


25. The state of origin is to be understood as the state party to The Hague Agreement in which the depositor has a real and effective industrial or commercial establishment, or where the depositor has such establishments in more than one state party to the Agreement, the state he has designated in the application or, failing this, the state party to the Agreement in which he has his residence (or headquarters) or, failing this, the state party to the Agreement of which he has the nationality.

26. See Berne Convention, supra note 4, art. 4(2).
The national office of a contracting country must notify the International Bureau and address the depositor on the refusal to publish the deposit within six months of the date on which the national office received the periodical bulletin in which the international deposit was published. The depositor has the same remedies against the decision to refuse protection that he would have had if he had deposited the refused design at the national level with the office of the country that refused protection. If the refusal is not noted within the applicable six-month period, the international deposit then achieves the same status as a deposit entered in the national register of each of the countries for which protection has been requested.

International deposits are published by the International Bureau in a monthly periodical called the *International Designs Bulletin*. This publication includes a reproduction of the article or articles in which the deposited designs are to be incorporated. The national office of each contracting country is entitled to receive, free of charge from the International Bureau, copies of the *International Designs Bulletin*.

The depositor may request that publication be deferred for a period not to exceed twelve months from the date of the international deposit or, where appropriate, from the date priority is claimed. The owner of an international deposit enjoys the priority right afforded under article 4 of the Paris Convention, if he claims this right and if the international deposit is made within six months of the first national, regional, or international deposit made in one of the countries party to the Paris Convention, or if he makes a deposit having effect in one of those countries.27

An international deposit is made for an initial term of five years, and can be renewed at least once for an additional period of five years for all or part of the designs included in the deposit, or for all or only some of the countries in which it has effect. For those contracting countries whose domestic legislation allows a term of protection greater than ten years for national deposits, an international deposit may be renewed more than once.

In each case, a renewal may be made for an additional period of five years, with effect in each country up to the expiration of the total allowable term of protection for national deposits under that country's domestic legislation. International deposits are subject to the payment of fees in Swiss francs. The amounts of the payments are decided by the Assembly and Conference of Representatives of The Hague Union. A portion of these fees is distributed to the national offices of the contracting countries.

The working languages for the implementation of The Hague Agreement are English and French. International deposits and any amendment affecting the deposits are entered in the international register and published in English or French. Correspondence between the International Bureau and the depositor is drafted in English or French, depending on the language.

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27. See Paris Convention, supra note 2, 21 U.S.T. at 1631, T.I.A.S. No. 6923.
used in completing the application for the international deposit. The text of
The Hague Agreement, its regulations and any document drawn up by the
International Bureau for the Assembly of The Hague Union or for expert
committees, are available in English and French.

The offices of the contracting countries have no specific tasks in the
implementation of The Hague Agreement except in those cases where the
domestic or regional legislation of the country permits or requires the inter­
national deposit to be effected through them or calls for a novelty examina­
tion for deposited designs.

The International Bureau provides forms for the application for interna­
tional deposits and any other forms necessary for the entry of an amend­
ment to an international deposit. These forms are supplied to any offices
that wish to receive and transmit international deposit applications to the
International Bureau and to any office wishing to assist its nationals with
respect to international deposits.

More than 88,000 international deposits of industrial designs have
been effected since the adoption of The Hague Agreement in 1928. In
1988, 2706 deposits were made, of which ninety-five percent were pub­
lished in accordance with the 1960 Act. The adoption of the 1960 Act has
made The Hague Agreement more attractive and compatible with the most
developed national legislations.

IV. THE BERNE CONVENTION FOR THE PROTECTION OF
LITERARY AND ARTISTIC WORKS

The initial 1886 Act of the Berne Convention for the Protection of Lit­
erary and Artistic Works, in a nonexhaustive list, did not include coverage
of works of applied art. It was not until the 1908 Berlin Revision that this
category of works was mentioned. At that time, however, there was still
no general agreement as to whether works of applied art should enjoy copy­
right protection.

Although protection of all the other categories of works was obligatory
for the member countries of the Berne Union, article 2 of the Berlin Revision
simply contained the following provision regarding this controversial cate­
gory of works: "Works of art applied to industrial purposes shall be pro­
tected so far as the legislation of each country allows."

It was not until the Brussels Revision Conference of 1948 that compul­
sory protection for works of applied art was introduced. Since then, these
works appear in the nonexhaustive list of works to be protected in article

28. Sept. 9, 1886, reprinted in 3 BERNE COPYRIGHT UNION, COPYRIGHT LAWS: MULTILAT­
ERAL CONVENTIONS, item A-1 [hereinafter COPYRIGHT LAWS].
29. Nov. 13, 1908, reprinted in COPYRIGHT LAWS, supra note 28, item C-1, 1 L.N.T.S. 217
(1920).
(1959).
2(1) of the Berne Convention. However, article 2(5) of the Brussels Act adds:

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 other countries of the Union only to such protection as is granted to designs and models in such countries.

Article 2(5) of the Brussels Revision recognizes that the protection of works of applied art and industrial designs are at the boundary between copyright protection and industrial property. Article 2(5) also provides for the result that national laws will vary considerably as to which system of protection is to be applied and what conditions will be used as applied to different cases. Thus, the article leaves the Berne Convention countries free to protect such creations under copyright laws, under sui generis design legislation, or under both. The member countries of the Berne Union also are free to determine the conditions under which works of applied art and industrial designs may be protected.

Article 2(5) of the Brussels Revision also provides for an exception to the principle of national treatment. Under this article, it is possible for one to claim protection under design legislation in the other countries of the Berne Union only for works protected solely as designs, that is under sui generis design legislation in his country of origin. Even where no such legislation exists, it is still not possible to claim copyright protection for such works.

Article 2(7) of the 1967 Stockholm Revision, not amended by the 1971 Paris Revision, provides a remedy to this situation. The article provides that:

31. Article 2(1) of the Berne Convention reads as follows:
The expression "literary and artistic works" shall 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 dramatic-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; illustrations, maps, plans, sketches and three-dimensional works relative to geography, topography, architecture or science.


Subject to the provisions of Article 7(4) of this Convention, 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.34

This section indicates that a country of the Union that has no sui generis legislation on designs is nevertheless required to protect designs as artistic works under copyright legislation without any formality.

As far as the term of protection is concerned, the Brussels Revision gives some latitude to the countries that are parties to that Revision. Article 7(3) of the Act states: "In the case of works of applied art, the term of protection shall be governed by the legislation of the country where protection is claimed, but shall not exceed the term fixed in the country of origin of the work." Article 7(4) of the 1967 Stockholm Revision amended the provisions on the term of protection for works of applied art; the provisions remained unchanged in the 1971 Paris Revision.

In the case of works of applied art, a minimum term of protection of twenty-five years from the making of the work was adopted by the Paris Revision. As stressed in article 7(3), however, the minimum term in question is compulsory only for works of applied art insofar as they are protected as artistic works. In other words, where these works are protected as designs under sui generis legislation, the term of protection may be shorter.

34. Berne Convention, supra note 4, art. 2(7) (emphasis added).