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2016 – Study Question (Designs)

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Requirements for protection of designs

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I. Current law and practice

- 1) Does your Group's current law provide for an intellectual property right (registered or patented) that specifically protects the outward appearance or ornamentation of an object or article of manufacture?

As set out in the Study Guidelines, copyrights and trademarks are not such rights in the context of this Study Question.

yes

Please explain:

Yes, the current Philippine Intellectual property laws and regulations provide for such protection.

- 2) If yes, what is this right called? (e.g. registered design, design patent, industrial design, industrial design patent)

References to design below are to be read as references to this right, irrespective of what it is called in your jurisdiction.

It is defined under the law as an "INDUSTRIAL DESIGN".

- 3) What are the statutory requirements for such right? Please tick any relevant boxes and explain the basis and application of these requirements.

- a) novelty

Similar to the requirements of patent, the industrial design must not form part of a prior art anywhere in the world.

b) non-obviousness

c) inventive step

d) individual character

e) originality

f) aesthetic

g) ornamental

The law specifically requires that the industrial design is ornamental or with a special appearance.

h) other, namely ...

4) Does your Group's current law deny design protection to a design with an appearance that is dictated solely by its function?

yes

Please explain:

YES. Under Rule 1501 of the Revised Implementing Rules and Regulations on Utility Model and Industrial Design (“Implementing Rules”), industrial designs that are dictated essentially by technical or functional considerations to obtain a technical result are not registrable.

5) If yes, what are the relevant factors to determine whether or not a design is deemed unprotectable as being functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

Philippine law and jurisprudence do not provide the factors in determining whether the design is functional. The law merely states that the design that must not be dictated essentially by technical or functional considerations.

The Intellectual Property Office (IPO) reviews only the drawings and the claims. Thus, the bases in evaluating industrial designs are only the formal drawings, a statement of the characteristic features of the design, if any, and the claims on the designs. If the statement of the characteristic features relates to the function/s of the article of manufacture or there is a claim of functionality, the examiner will issue a rejection.

b) whether each portion of the overall appearance is dictated solely by its technical function

c) the availability of alternative appearances that can obtain the same functional result

d) the need to achieve the product's technical function was the only relevant factor when the design in question was selected

e) other, namely ...

6) Does your Group's current law deny design protection to any portions (e.g. a "feature", "element") of the overall design that are deemed functional?

no

Please explain:

The law is silent on this point. But based on the definition of an industrial design under Rule 1500 of the Implementing Rules, the composition of shape, lines, colors, or a combination thereof, or any three-dimensional form, whether or not associated with shape, lines, or colors must produce an aesthetic and ornamental effect in their tout ensemble or when taken as a whole.

Thus, the answer is NO, the denial is for the whole design and not just the parts thereof.

7) If yes, what are the relevant factors to determine whether or not a portion is deemed functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

b) the availability of alternative appearances for the portion to obtain the same functional result

c) the need to achieve the product's technical function was the only relevant factor when the portion in question was selected

d) other, namely ...

8) What is the effect on the scope of protection of a design with one or more functional portions? Please tick any relevant boxes and explain as applicable:

a) any portions deemed functional will not be taken into account when assessing infringement

b) any portions deemed functional will not be taken into account when assessing validity

c) any portions deemed functional will not be taken into account separately when assessing infringement, but can play a role in the overall comparison

d) any portions deemed functional will not be taken into account separately when assessing validity, but may play a role in the overall comparison

e) no effect (e.g. so long as the overall appearance is not dictated solely by its technical function, all portions of the design are included in the scope of protection, irrespective as to whether any portions may be functional)

f) the Group's current law is unsettled

g) other, namely ...

If the design claims a function, the practice in the IPO is that the design application will be rejected under Rule 1501 (a) of the Implementing Rules as a non-registrable design. The applicant may then opt to file a new invention patent application or a utility model application on the subject matter of the rejected design and claim the functional features thereof. Under our law, a design application cannot be converted to a patent or utility model application.

II. Policy considerations and possible improvements to your current law

9) How can the following aspects of your Group's current law be improved, if at all?

a) the definition or meaning of a "design"

The definition should clearly state that this pertains to the physical appearance or aesthetic only, without regard to the function of the same, if such is the intention of the law.

b) the requirements for protection of a design

The requirement must clearly state that the design is protected only for its appearance and the novelty of such appearance, without considering the function of the design

c) the treatment of functionality in the sense described in paragraph 14) of the Study Guidelines or aspects of such functionality

The Implementing Rules must clearly specify what will happen if there is a partial claim of functionality in the design. The law and the Implementing Rules are silent on the same.

The Implementing Rules and/or Examination Guidelines should have clear provisions on how to evaluate functionality in design applications.

10) Are there any other policy considerations and/or proposals for improvement to your current law falling within the scope of this Study Question?

no

Please explain:

None at the moment.

III. Proposals for harmonisation

- 11) Does your Group consider that harmonisation in the three areas in question 9) above is desirable?
- If yes to some but not all of those three areas, please state in relation to which of the areas your Group considers harmonisation is desirable.
If yes in relation to any of those areas, please respond to the following questions without regard to your Group's current law.
Even if no in relation to any of those areas, please address the following questions to the extent your Group considers your Group's current law could be improved.

no

Please explain:

No. Current Philippine law and rules provide for two (2) existing systems, the industrial design scheme which focuses on the aesthetic, and the utility model scheme which can cover functionality. Harmonizing the same would require amending the law.

- 12) Should there be harmonisation of the definition of an intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture?

yes

Please explain:

Yes, there should be a uniform definition of an intellectual property right that protects outward appearance. This would avoid conflict of definition between two (2) countries in case dispute arises.

- 13) If so, what should that right be called?

Industrial design, following the term used in the Philippines.

- 14) What should the requirements for such right be? Please tick any relevant boxes and explain the basis and application of these requirements:

a) novelty

Already provided for in the existing law.

b) non-obviousness

c) inventive step

d) individual character

This requirement is related to novelty of the design.

e) originality

This requirement is related to novelty of the design.

f) aesthetic

This requirement is related to ornamental feature of the design.

g) ornamental

Already provided for in the existing law.

h) other, namely ...

15) Should design protection be denied to a design with an appearance that is dictated solely by its function?

yes

Please explain:

Yes, to avoid conflict in our present law.

16) If yes, what should the relevant factors be to determine whether or not a design is deemed unprotectable as being functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

This is in accordance with the present law.

b) whether each portion of the overall appearance is dictated solely by its technical function

c) the availability of alternative appearances that can obtain the same functional result

d) the need to achieve the product's technical function was the only relevant factor when the design in question was selected

e) other, namely ...

17) Should design protection be denied to any portions (e.g. a "feature", "element") of the overall design that are deemed functional?

yes

Please explain:

- 18) If yes, what should the relevant factors be to determine whether a portion of a design is functional?
Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

This is in accordance with the present law.

b) the availability of alternative appearances for the portion to obtain the same functional result

c) the need to achieve the product's technical function was the only relevant factor when the portion in question was selected

d) other, namely ...

- 19) What should the effect be on the scope of protection of a design with one or more functional portions?
Please tick any relevant boxes and explain as applicable:

a) any portions deemed functional will not be taken into account when assessing infringement

b) any portions deemed functional will not be taken into account when assessing validity

c) any portions deemed functional will not be taken into account separately when assessing infringement, but can play a role in the overall comparison

d) any portions deemed functional will not be taken into account separately when assessing validity, but may play a role in the overall comparison

e) no effect (e.g. so long as the overall appearance is not dictated solely by its technical function, all portions of the design are included in the scope of protection, irrespective as to whether any portions may be functional)

f) the Group's current law is unsettled

There is currently no jurisprudence on the matter. Under our law, the alleged infringer in an design infringement suit may raise as a defense the fact that the design is dictated essentially by technical or functional considerations to obtain a technical result and, therefore, invalid.

g) other, namely ...

- 20) If your answer to question 11) is no, is it your Group's view that a (registered or patented) intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture should not be available at all?

no

21) If yes, why?

22) If your answer to question 11) is no in relation to some but not all of the three areas set out in question 9) above, please state why your Group does not consider that harmonisation in that area(s) is desirable.

Our current legal system offers separate protection to intellectual property which is focused solely on design (industrial design) and those that focus on function or utility (invention patent or utility model). Harmonizing these two concepts would require an amendment of the law.

23) Please comment on any additional issues concerning any aspect of the definition and requirements for protection of designs, or the role of functionality, you consider relevant to this Study Question.

Please indicate which industry sector views are included in part “**III. Proposals for harmonization**” of this form:

Summary

The laws and the Implementing Rules must make clear provisions and guidelines on how to evaluate functionality in design applications since they are currently silent on this point. This will lessen confusion on the scope of protection of the design registration during enforcement.