

Test for infringement, acts that constitute infringement and remedies

- I) Test for infringement
- II) Acts that constitute infringement
- III) Remedies

(2) Producing a car with side mirrors which show a registered side mirror design of another holder or owner (The side mirror is produced without authorization.)

Yes No

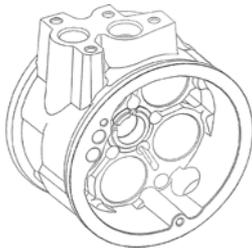


Registered design for side mirrors



(3) Producing a car with a compressor to which a registered design of another is applied (The compressor is produced without authorization and is set inside the engine room so that it is hidden from view under normal conditions.)

Yes No



Registered design



Registered design hidden from view

(4) If the design on the left is registered in your country, will the design on the right be regarded as a design infringement?

Yes No



Actual car (registered design)



Toy car

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(Yes. Our law protects the design itself. It does not limit or restrict the product on which the design is applied. Thus, a replica toy car that copies the patented design of a real car may be regarded as design infringement.)

(5) If the design on the left is registered in your country, will the design on the right be regarded as a design infringement?

Yes No



Doll (registered design)



T-shirts

(No. What is registered is an industrial product in the form of a stuffed toy or doll, which has a three-dimensional form. The special appearance of this 3D form is what is protected by the registered design. In this case, the Pikachu character only appears as a surface ornamentation, i.e., flat illustrations, on a t-shirt. A case for design infringement is unlikely to prosper.)

4.1 Are there any provisions regarding how to treat preliminary acts of infringing a design right that are likely to lead to the acts listed in Question 1.2 (hereafter called “indirect infringement”) in the law? If applicable, please specify what kinds of acts are considered to be “indirect infringement” and how “indirect infringement” would be treated by the law.

(Anyone who actively induces the infringement of a [design] patent or provides the infringer with a component of a patented product knowing it to be especially adopted for infringing the patented [design] and not suitable for substantial noninfringing use shall be liable as a contributory infringer and shall be jointly and severally liable with the infringer. [Section 1191.1 in relation to Section 76.6 of the IP Code of the Philippines].)

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4.2 In the following cases, would each act constitute a design right infringement (direct or indirect) under current law in your country? Also, are there any other laws that prevent parties from conducting these acts?

(1) Creating 3D CAD data from which one can reproduce a product embodying a registered design by using a 3D printer, or selling, downloading, or copying the 3D CAD data through the Internet

Yes No

(2) Producing and selling a mold that might be used to manufacture products of a registered design.

Yes No

III Remedies for infringement: injunction

1-1. Is it possible to enforce an injunction against a third party who has infringed design rights?

Yes No

1-2. Which organization would usually assist when a design holder needs to enforce his design rights?

Civil court

Administrative organization (e.g., Patent Office)

Police

Customs

Other organization

1-3. How long does it take to complete injunction procedures in an infringement case with the above organization?

Within half a year (for preliminary injunctions)

Between half a year to one year

One to three years

Three to five years

More than five years (for permanent injunctions. This is because the injunction can be enforced only after the decision on the main case becomes final.)

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1-4. What documents are necessary to be submitted to the above organization in such procedure?

Please check all applicable.

- √ Original certificate of the design registration
- √ Expert opinion or official examination result regarding the similarity of infringing product(s) and the registered design
- √ Information regarding prior similar designs
- √ Other documents (documents showing the infringing act [such as sales receipts] and photos of or the actual infringing product.)

2. Remedies for infringement: damages / public apology

2-1. Is it possible to claim compensation of damages along with demanding an injunction?

Yes No

2-2. If the answer of the above question 2-1 is Yes, what is the starting point for calculating the amount of damages, the date of publication of the registered design or the date of the request to cease distributing/manufacturing infringing products?

(Damages cannot be recovered for acts committed before the infringer had known, or had reasonable grounds to know, of the patents. If there is no constructive notice on products embodying the patented design, calculation of damages begins from the date when infringer has actual knowledge of the design patent. [Sec. 119.1 in relation to Sec. 80 of the IP Code of the Philippines.])

2-3. May a design-holder seek damages in an amount equal to:

- √ Lost profits
- √ Reasonable royalty
- The infringer's profit
- √ Other (e.g., two times the amount of the license fee)

(The rule is the design holder can recover an amount equal to the damages he sustained. If the amount cannot be readily ascertained or if

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the amount of damages that can proven appears inadequate, the court may award a sum equal to reasonable royalty. Finally, if circumstances warrants [the law is silent as to what these circumstances are] the court may award a sum above the actual damages sustained, but in no instance could this award exceed three times the amount of actual damages sustained. [Sec. 119.1 in relation to Sec. 76 of the IP Code of the Philippines])

2-4. Is it necessary to show the design registration number on products or packages of the product for claiming compensation of damages?.

Yes No

(No, but it is advisable. When the registration number is indicated together with the words “Philippine Patent”, notice is presumed to have been given to the person dealing with said goods. Damages may therefore be recovered.)

2.5. Is it possible to enforce that the infringer makes a public apology, for example, newspaper or other media?

Yes No

If yes, by what media? (Issuance of public apology is not one of the remedies available to the design holder under the law. But if prayed for in the complaint and granted in the decision, it is enforceable. The type of medium will depend upon the decision or the design holder’s choice.)