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DESIGN PROTECTION STANDARTS IN INTERNATIONAL TREATIES

Summary

Despite the local application of the law, the attacks on intellectual property rights regardless of borders have created the necessity to protect these rights at the international level. The fact that each country has its own legal system and judicial system makes holders vulnerable in terms of protection and enforcement of their rights. In the global market, a consumer-approved design owner must register in 200 different countries and file a lawsuit against the offender.

A number of international agreements have been adopted, taking into account the difficulties associated with the protection and enforcement of intellectual property rights. This article describes some important international treaties about legal protection of industrial design.

Key words: *industrial design, convention, international law, agreement, international protection*

Introduction

Intellectual Property laws are almost always national in nature. However, there are many conventions and treaties under which nations agree to provide minimum levels of IP protection and to protect IP created by nationals of other countries.

The World Intellectual Property Organization (WIPO) administers over 20 treaties and conventions on the registration, classification and protection of IP.

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 describes 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), the Berne Convention for the Protection of Literary and Artistic Works (Berne Convention) and other treaties.

Thus, we will look through above mentioned international conventions which concerning about legal protection of industrial design.

The first international framework regulation that recognizes the industrial design as an intellectual property right and grants its owners a protection is the Paris Convention for the Protection of Industrial Property which was signed in France in 1883.

The Paris Convention applies to industrial property in the widest sense-including patents, trademarks, industrial designs, utility models, service marks, trade names, geographical indications and the repression of unfair competition. This international agreement was the first major step taken to help creators ensure that their intellectual works were protected in other countries (1, p.2).

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.

Article 1 of the Paris Convention (Stockholm Act of 1967) stipulates that "The protection of industrial property has as its object patents, utility models, industrial designs, trademarks, service marks, trade names, indications of source or appellations of origin, and the repression of unfair competition."

In Article 5 it is mentioned that, the Convention provides that "Industrial designs shall be protected in all the countries of the Union." However, the Paris Convention, not clearly providing a definition of industrial designs, leaves it to each individual country of the Union to decide how to protect them under a domestic law. (2, p.2). 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 laws. To satisfy the demands of article 5 quinquies, industrial designs must enjoy some form of protection.

Article 5B of the Paris Convention provides that the protection of industrial designs may not, under any circumstances, be subject to any measure of forfeiture as a sanction in cases of failure to work or where articles corresponding to those protected are imported. 'Forfeiture' in this provision includes equivalent

measures, such as cancellation, invalidation or revocation. This means that a member cannot provide for the revocation or cancellation of design protection where a design is not produced in, or is only imported into its territory (3).

Apart from that, the convention prohibits countries of the Union from imposing sanctions which forfeit protection of an industrial design under domestic law due to a failure to work or the importation of an article incorporating the said industrial design which should be otherwise protected. (2, p.2).

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 (4, p.394).

The substantive provisions of the Convention fall into three main categories: national treatment, right of priority, common rules.

(1) Under the provisions on national treatment, the Convention provides that, as regards the protection of industrial property, each contracting State must grant the same protection to nationals of the other contracting States as it grants to its own nationals. Nationals of non-contracting States are also entitled to national treatment under the Convention if they are domiciled or have a real and effective industrial or commercial establishment in a contracting State.

(2) The Convention provides for the right of priority in the case of patents (and utility models where they exist), marks and industrial designs. This right means that, on the basis of a regular first application filed in one of the contracting States, the applicant may, within a certain period of time (12 months for patents and utility models; 6 months for industrial designs and marks), apply for protection in any of the other contracting States; these later applications will then be regarded as if they had been filed on the same day as the first application. In other words, these later applications will have priority (hence the expression “right of priority”) over applications which may have been filed during the said period of time by other persons for the same invention, utility model, mark or industrial design. Moreover, these later applications, being based on the first application, will not be affected by any event that may have taken place in the interval, such as any publication of the invention or sale of articles bearing the mark or incorporating the industrial design. One of the great practical advantages of this provision is that, when an applicant desires protection in several countries, he is not required to present all his applications at the same time but has six or 12 months at his disposal to decide in which countries he wishes protection and to organize with due care the steps he must take to secure protection.

(3) The Convention lays down a few common rules which all the contracting States must follow (5, p.24).

The next major international copyright treaty-Berne Convention for the Protection of Literary and Artistic Works was concluded on September 9, 1886. It is the oldest of the international copyright treaties; it provides a high level of protection and gives authors the most comprehensive set of rights it is possible to give them (6, p.5).

Industrial design is not specifically regulated in the Berne Convention but might fall under the concept of “applied art” that is not further defined in the convention. According to Article 2 (7) of the Berne Convention it is in the discretion of the signatory states whether they want to protect industrial design as applied art, and if so, to set the conditions of protection (7, p.17).

Having noticed the great differences between distinct national systems as to the copyright protection of industrial design, it must be mentioned the Berne Convention for the Protection of Literary and Artistic Works of 1886 that provides for an automatic copyright protection for every kind of designs, include the works of applied art. But the Convention expressly leaves the states completely free to provide for that protection: it will be a matter for national legislators to determine the extent of the application of their laws to works of applied art and industrial design and models, as well as the conditions under which such works, designs and models must be protected.

In addition, as far as pure artistic designs are concerned, the Berne Convention establishes the national treatment clause (art. 5, par. 1), in virtue of which the author enjoy, in the countries parties to the Union, the rights which their respective laws do or may afterwards grant to their nationals. It is evident that the national treatment clause is limited to the pure aesthetic design and not to the industrial designs; as to the latter the Berne Convention (art. 2, par. 7) establishes a reciprocity principle, in the light of which, the author, who is

established in a country where there is not copyright protection, cannot claim that protection in a country where that possibility is conceived. In fact, taking into account the great legislative differences between national systems, the application of the national treatment clause would be illogical: how would it be possible and conceivable that, for example, an English author of a registered industrial design can enjoy copyright protection in Guatemala and not in his own country and that the same inverted situation is not possible. Conversely, the reciprocity principle is more consistent with the system since it makes sure that the authors from a particular Contracting State can be granted in the other countries the same kind of protection which is granted to them in their own country, provided that the cumulative protection is admitted. (8, p.6)

TRIPS became effective in 1994 and is administered by the World Trade Organization (WTO). It imposes minimum standards for the protection of intellectual property in general. However, only two provisions of TRIPS directly refer to industrial design protection.

The TRIPS Agreement provides that (1) Members shall provide for the protection of independently created industrial designs that are new or original, and (2) Members may provide that such protection shall not extend to designs that are not new or original because they do not significantly differ from known designs or combinations of known design features (9, Article 25(1)).

Although TRIPS gives some guidance as to the requirements of protection (independently created, new or original), it does not provide a definition of industrial design or the subject matter constituting industrial design. TRIPS adopted both the Berne and the Paris Conventions but did not take a position as to their different classifications regarding the nature of design protection. It remains unclear, therefore, what type of protection should be applied to industrial design by the member states. The “independent creation” as well as the “originality” requirement seems to point to copyright protection; whereas the novelty requirement might refer to patent-like protection or a sui generis design regime (10, p. 42). Since TRIPS did not settle the dispute about the nature of protection and only guarantees a minimum standard, member states are still relatively free in drafting their national laws in such a way as to match their local objectives.

Further, the TRIPS Agreement provides that Members may provide limited exceptions to the protection of industrial designs, provided that such exceptions do not unreasonably conflict with the normal exploitation of protected industrial designs and do not unreasonably prejudice the legitimate interests of the owner of the protected design, taking account of the legitimate interests of third parties (Article 26 (2)). In addition, the TRIPS Agreement provides that the duration of protection available for industrial designs shall amount to at least 10 years (Article 26 (3)).

Thus, the TRIPS Agreement can be seen as the first international treaty to include substantive provisions relating to the protection of industrial designs. (11, p.26).

The Hague Agreement is an international registration system which offers the possibility of obtaining protection for industrial designs in a number of States and/or intergovernmental organizations by means of a single international application filed with the International Bureau of the World Intellectual Property Organization (WIPO) (12, p.4).

The Hague Agreement's purpose is to simplify registration of industrial designs for several countries. Therefore, it provides an international deposit system that allows national design proprietors to obtain protection in all member states by filing one application and depositing one sample. The eligibility for and scope of protection, however, are subject to the national laws of the member states in which protection is sought. As a result, it can be concluded that the international legal framework does not give sufficient guidance as to the definition of design and the nature of protection (7, p.18).

The above agreements and treaties provide holders of design-related intellectual property with a coherent set of rules and regulations whereby they can expect to receive fair and unbiased treatment so long as they work within the established system of a member state.

Conclusion

According to a variety of studies, “design is increasingly being recognized as important for national competitiveness” in the global economy. Certainly governments, particularly in Europe and Asia, as well as some corporations, are becoming considerably more aware of the effects of design on market performance. Although comparable data on national design industries are relatively hard to collect, thus making reliable comparisons between nations difficult, several studies have linked business success to the use of design.

With respect to design, however, there has always been a lack of international agreements that clearly determine its legal protection. One possible reason for this might be the ongoing debate about the nature of design. Different jurisdictions classify industrial design differently. The classification, however, is essential for determining which international treaty covers the subject matter of industrial design protection.

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