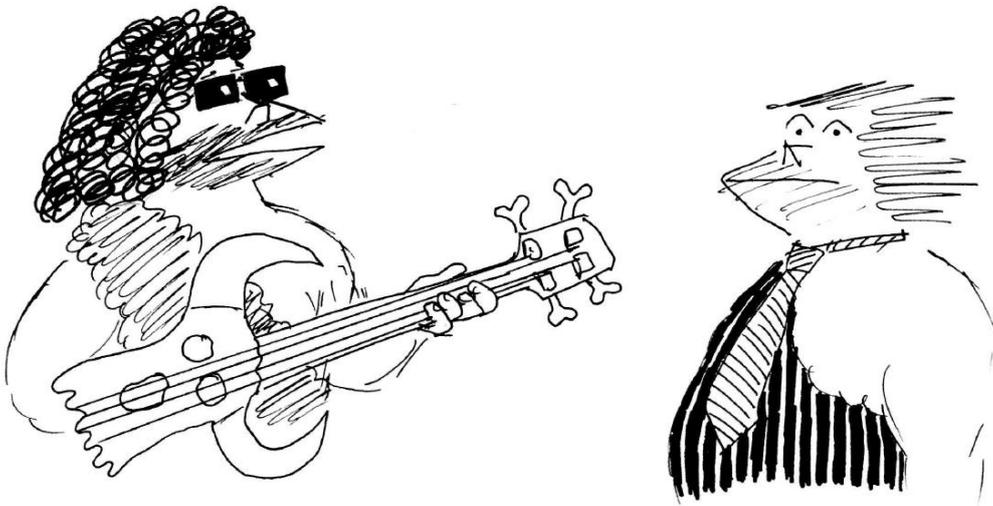
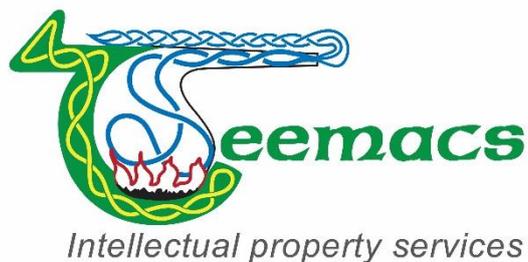


Intelligent Design

*An introduction to registered designs/design patents
(with some notes on **copyright**)*



Ah tell yo', man, dis here crittarr is da future of music! So, yo' git off ya overpaid butt an' protect mah yooneek shape from shameless imitators!



About the Author...

(with apologies to Gilbert and Sullivan)

*When I was a lad, I served a term
As patent tech. assistant in a big paint firm
I wrote applications and I argued and tried
Patent offices to show that grant was justified
And this sort of thing so suited me
That now I'm patent attorney in industry.*

Acknowledgement

This is entirely my own concoction, so I can acknowledge only me, which means that the fault is entirely mine, as is the responsibility for any errors (not to mention the mediocre drawings and terrible jokes (or is it mediocre jokes and terrible drawings?)). The responsibility for any views or opinions expressed herein is also entirely mine.

This little publication aims to give a general overview into designs and copyright law and practice. It does not pretend to be comprehensive, especially in the field of copyright, where there has been an explosion of developments (image rights, internet references, etc.). I am always happy for my aim to be corrected.

N.B.

Costs mentioned were correct at September 2013, but because of the tendency of official fees to fluctuation (and exchange rates to go up and down like yo-yos), any costs mentioned herein should be taken as general guides only.

Foreword

Registered designs (design patents in the USA) are the third leg of what is commonly called “industrial property”, the monopoly rights of the general territory of “intellectual property” (property residing in ideas and concepts, rather than physical objects).

Designs are often seen as the poor relative of the three, in that they are less visible than patents and trade marks in terms of public awareness. Yet they are very visible, because they relate to the shape and ornamentation of industrially-produced articles. This can be a major selling point – just look at the success of Apple products, thanks largely to the very nice design of its products (and look at the worldwide confrontation between Apple and Samsung over the latter’s allegedly iPad-lookalike). Many industries rely on design protection to protect their creativity, and they are a necessary consideration for full intellectual property protection of industrially-produced goods. They are also relatively cheap!

Appendix B – The Hague Agreement for the international registration of designs
Appendix C – The Contracting States of the Hague Agreement
Appendix D - A typical US design patent
Appendix E – A typical UK design registration

1. What is a design?

A design is a concept **applied to an industrially-produced article that gives** rise to a **unique appearance**. A design must present a shape or pattern that is new and original. The old English law definition described the aspects as “shape, configuration, pattern and ornament”. In other words, it gives the article itself a unique shape, or it provides a unique decorative surface on the article. It must make the article **clearly distinguishable by eye**. A design must be new and original.

2. Is it true that I can register my logo as a design?

In some places **yes**. Designs don't last so long as trade marks (maximum 25 years, v. forever), but they confer actionable protection very quickly (a matter of weeks), so they are worth considering in addition to trade mark protection.

3. How do I find out whether it is new or original?

Your patent attorney can organise a search. Be warned; as designs are visual, this means that someone has to look at them, and this can be expensive. Some patent offices offer the ability to search designs based on descriptions, but not many.

4. What is the nature of this unique appearance?

There is no definitive answer here. Shape and configuration are generally regarded as being related to the three-dimensional shape of the article (say, the novel shape of a Dyson™ vacuum cleaner or an iPhone™) and the pattern and ornament to two-dimensional aspects (say a design on a wallpaper or carpet). **Colour alone is not regarded as a design**, although colour can play a part in a design.

5. Must it be purely ornamental?

This is a tricky question without a universal answer, as it **depends on which country** (and therefore which national law) we're talking about. There was a long debate as to whether an object, whose shape was solely dictated by function, could be registered as a design, no matter how different and unusual was its shape. In UK law, this reached a climax in the House of Lords in the case of *AMP v. Utilux*. This involved an electrical connector for a washing machine, which looked different from every other connector, but simply because it was designed to make all the electrical connections and to fit within a particular space in the machine – and the only people ever to see it were the guys or gals who assembled or repaired it. As nothing other than practical considerations were involved in its design, the court held that it could not be the subject of design registration.

This approach is generally true throughout the world of designs – there **must be something more than mere functionality behind the new shape/configuration/pattern/ornament**. As a general rule, something that is there purely for a specific function cannot be considered as part of a registered design. However, it is not universal. For example, Australian design law makes no distinction between purely aesthetic features and functional ones – “A visual feature may, but need not, serve a functional purpose” (s. 7, *Designs Act*, 2003) - the sole requirement is that the object presents a novel appearance to the eye.

6. Eye, eye...

But whose eye? A patent is addressed to “the person skilled in the art”, a trade mark to the ordinary, reasonable person in the street (or, in a famous British judgement, “the man on the Clapham omnibus”). Designs? **The eye of the prospective customer**, although, ultimately it is the eye of a court.

7. What’s this “industrially-produced” business?

The article is **a manufactured article**. Some countries even define the number at which it is deemed “industrially-produced” (one example is 50). This **separates designs from** individual works of art, which are properly the subject of artistic **copyright**.

A **part of an article may be** the subject of an individual **registered** design, even though the article as a whole is covered by design protection. This also goes for replacement parts.

It is **possible to protect sets of articles** with a single design registration, provided those articles are commonly used together. An example would be a set of cutlery, in which the knives, forks and spoons all have a common design theme.

8. You mentioned copyright – what happens when something that is the subject of copyright is used in manufactured articles?

This can be a rather complicated subject. What happens **varies from country to country**. Some countries allow dual protection by both copyright and design, others hold that copyright (which lasts much longer than design registration) is lost with respect to the particular articles when the design registration expires.

In one celebrated case, Lego, the design protection of whose blocks had expired, tried to argue in the UK courts that, as all the features of the design were dictated by function (see **5** above), its original design protection had never really existed, and that therefore it still had copyright in the original drawings, and could therefore prevent others from making compatible blocks. When the court had finished laughing, it rejected the argument.

9. When did it all begin?

Designs are applied to industrially-produced articles, and they began as industrial processes started to take over from individual artisanal manufacture. The earliest protection was for textiles – in the UK, there was the *Designing and Printing of Linens, etc. Act* of 1787, giving protection to certain textile materials and conferring on their owners a monopoly right for 2 months (later 3).

Designs were sufficiently well established to be included in the 1883 Paris Convention, along with patents and trade marks. Designs share with trade marks the 6-month Convention period (as opposed to the 12 months for patents).

10. So, how do I get one?

You or your attorney needs to apply at your local designs office. What the office will need (apart from the inevitable fee) is an **application form** and **some representations** of your design as drawings or as photographs, sufficient to make clear the nature of your design

(you may need drawings or photos from several angles). Some places allow the sending of actual specimens of the design, if it is 2-dimensional (a pattern on a surface). Some even allow the submission of 3-D models. **And a fee**, of course.

If the design whose protection is sought forms only part of an article, attention should be drawn to this. This can be done by a statement, e.g., “novelty resides in this/these feature(s)” and/or a drawing that shows the claimed feature in bold and the remainder of the article in dotted outline (this is common in US practice).

On the right is an example of a tyre in which the tread and not the whole tyre is being claimed



11. Is it expensive?

No. Designs are bargain-basement compared with patents. Costs are very variable, as are attorneys' fees that go with them. For example, a US design patent will cost, in official fees, \$180 for filing, \$120 for search, \$460 for examination and \$1020 for issue, a grand total of \$1780. A UK design application will cost £60, plus a total maximum renewal cost (25 years) of £1100.

12. Can I show my design publicly before filing?

This very much depends on the country. There is no universal rule. For example, there is a 12-month grace period in the European Union, and the USA, a 6-month period in Australia and Japan and no grace period whatsoever in China. So think carefully about where you want protection before you exhibit publicly or publish in any way.

13. How long do I have to wait for my registration?

Not very. In most cases, the examination is concluded and the design is registered in a matter of months.

14. Examination? It gets examined?

Certainly does. In some countries, an Examiner will check it against existing designs, to see whether it closely resembles an existing design. In other countries, the examination is purely a formal one.

15. Can anyone stop me from registering?

Yes – most places have the **possibility of opposition** or revocation by third parties on the ground that your design is not as new or original as you think it is.

16. And how long does a design registration last?

That is very **country-dependent**. The term of a **US** design patent is a maximum of **15 years**, a Community Design (covering the **EU**) a maximum of **25 years** (an initial 5-year period, renewable for a maximum of four further 5-year periods), and in Australia it's 10 years (initial 5 years, with a possible further 5-year extension).

17. Should I indicate that my design is registered?

This depends on the country – **in some countries, marking is obligatory**, requiring an indication of registration (and even the registered number) on each individual article, in other countries it is merely recommended. The problem being, of course, that, when the registration expires, the number has to come off, which may mean changing (expensively) a mould.

18. What rights does a registration give me?

You have a **monopoly on the design** in respect of the **articles for which** it is **registered**.

19. Not all articles?

No. As part of your application, you have to indicate the nature of the articles to which the design will be applied. This is generally done with reference to a classification system, either to a local classification system, or, more likely these days, the generally-accepted International (Locarno) Classification system, which divides all articles into 32 classes. See list at Appendix A. Here's a link to the WIPO Locarno guide:

<http://www.wipo.int/classifications/nivilo/locarno/index.htm?lang=EN#>

20. Can I cover lots of design variants in the same application?

In many places, yes, provided they all fall within the same class – one application per classification. However, in many places, you can file multiple designs within that class. For example, the Hague Agreement (see **21** below) allows up to 100 designs per application – but they must all fall within a single class. On the other hand, the Japanese Office allows only one design per application.

21. How near can an appearance come without being an infringement?

This is a “how long is a piece of string?” question. It will **depend entirely on the facts of the case**, and on the natures of the article and market in question. In the recent Apple v. Samsung war over the iPad and the similar Samsung product (how do you make a rectangular object which consists of a large touch screen look different from another one?), a UK judge held that the Apple design was “cooler” and that therefore the Samsung article did not infringe.

22. On the subject of things international, how do I protect my designs abroad?

The **Paris Convention** gives design applications a **six-month Convention period**. That is, if you file your UK application today and your German application within six months of that date, the German application will take as its application date the date of your UK filing, and you will have the rights over a German applicant who filed an application for exactly the same thing one day after your UK filing date.

23. Do I have to ask for this Convention period?

Yes, complete with certified copy of the original filing.

24. Patents have the PCT, trade marks have the Madrid system, do designs have an equivalent?

Yes, the International (**Hague Agreement**) Registration system. It is possible to apply for registration through WIPO (World Intellectual Property Organisation) in a number of countries via a single application. Hague is not as encompassing as either the PCT or Madrid, but it does cover quite a lot of countries, and the list is constantly expanding (see list at Appendix C).

Hague filing is **restricted to applicants** who are either citizens or residents **of a Contracting State**.

For more details on the Hague Agreement see Appendix B.

25. How do I do a Hague filing?

The same six months' Convention date applies to Hague filings as it does to national filings. Instead of filing a number of national applications, you file **a single application at WIPO's** International Division, **designating the desired countries** and (naturally) paying the appropriate fees. If it complies with the formal requirements, it is published, and then transmitted to the designated countries, which then examine according to their normal procedures. If the country concerned does not come up with a refusal within 6 months of the publication of the International registration (12 months in some cases), the International registration is considered valid for that country.

26. Are there language requirements?

An international application may be filed in **English, French or Spanish**.

27. Cost?

Variable, depending on how many Contracting states are selected. The fees are (a) a basic fee, (b) a designation fee, and (c) a publication fee. WIPO's website has a fee calculator, here:

<http://www.wipo.int/hague/en/fees/calculator.jsp>

For example, a design originating from a Swiss applicant that seeks cover in Switzerland and the EU, with 2 drawings and 10 words of description will cost CHF551 in official fees.

28. What about Europe? There's a European patent and a Community trade mark, is there also a European design?

Yes, there is a **Community design**, like the Community trade mark (now EUTM) covering the EU. Also like the CTM, it is administered and examined by the European Union Intellectual Property Office (EUIPO, formerly OHIM (Office for the Harmonisation of the Internal Market)) in Alicante, Spain.

29. How often do I have to renew my design registration?

This is country-dependent, but **generally every 5 years**. There are exceptions – a US design patent lasts for 15 years and the registration fee is the last fee you pay.

30. What if I miss the renewal date?

The **Paris Convention** grants a **six-month grace period** within which a renewal fee can be paid with surcharge. No excuse is required. However, exceed that six months and be prepared for a much more difficult restoration procedure, where the patent office will want to know why. You may have to show that the lapse was inadvertent, and a rare glitch in an otherwise good-functioning system for monitoring and renewal.

31. Can I sit on a design registration and prevent others from using it?

Only to a limited extent. **Failure to use** for a period (typically 5 years) can give an aggrieved party a **ground** to ask **for** the **removal** of your registration **from the Register**.

32. If someone copies my design, I can sue him/her, right?

Yes.

32. What will I get out of this?

You're looking for an **injunction** (a court order that forbids the continuation of the infringement) **and** some sort of **recompense** (account of profits, damages, delivery-up of infringing goods for destruction).

33. What if someone sues me?

Are you infringing? Why do you think not? Talk to your patent attorney and let him/her judge.

34. Back to the Community design of 27. What happened to the UK part of a Community design after the UK "Brexit" vote?

As in the case of EU trade marks, the UK component of a Community design **automatically became a separate UK design registration**.

COPYWRONG

(Some notes on copyright protection)

So, what's a piece on copyright doing here? Well, since copyright is, with trade marks, the type of intellectual property most normally encountered by everyday people, whether or not they are (or wish to be) aware of it, it would be remiss to omit it. As it is a major specialised subject on its own, it really merits a booklet all of its own, but since I don't have the time for that, I thought I'd include this short overview in the designs booklet, with the slim justification that there is a copyright/design overlap, which is a major headache in some jurisdictions, no headache at all in others.

As previously mentioned, the subject is complex and is becoming increasingly so, so this small piece is meant to give only a general overview.

So, let's ask some questions:

1. What is copyright?

Copyright is a form of intellectual property that was intended to **protect works of literary or artistic merit**. In general, it protects the expression of an idea, but not the idea itself. In other words, Disney can prevent the copying of Mickey Mouse, but not all mouse cartoon characters, provided they are sufficiently removed from being copies of Mickey.

2. Was intended??

Well, it still does, but something funny happened along the way... It **started with printed matter**, and then it **progressed to other works**, musical scores, then recorded musical performances of all types. Now it covers things as diverse as engineering blueprints, house plans, computer programs, even perfumes. And of course we now have personalities claiming the rights to the use of their images – and in some recent cases their tattoos.

3. So, I have a monopoly over my work and can prevent people from using them?

Er, no, you can't. Copyright is exactly what it says – protection from copying. Unlike the other IP rights, it **does not confer a monopoly**. If someone were, completely independently, to come up with something identical or substantially identical to yours, there's nothing you could do about it.

Another thing to remember is that copyright **does not protect an idea, but the expression of that idea**. In other words, if you develop a computer program for performing a particular function, and a competitor comes up with a different program that performs that same function, that does not constitute copyright infringement.

4. What if someone takes my engineering blueprint or house plans and makes a component or a house from them?

That is **infringement** of your copyright in the plans.

There have been some exceptions. In a famous old British case *British Leyland v. Armstrong*, which ended up in the House of Lords, car replacement parts maker Armstrong

had taken a genuine exhaust system from a British Leyland vehicle, used it as the basis for making its own drawings and started to make replacement exhaust systems. BL sought to show that this was infringement of copyright in the original BL drawings, even though the drawings were never copied. It failed, mainly on the basis that the purchaser had the right of reasonable repair, and that the necessary parts did not have to come from BL.

In this judgement, Lord Templeman stated that the owner of a BL vehicle owed his soul to the company store. Whether he ever paid a royalty to Tennessee Ernie Ford for this use of copyright material is not known.

5. I presume that the making of copies of music and video files constitutes an infringement of copyright?

In general, **yes**, you presume correctly. Some countries make some exceptions – for example, the video recording of TV programmes for the purpose of “time shifting” for watching at a more suitable time, is allowed in many countries, e.g., the UK.

In days gone by, the arrival of the Philips compact cassette and the making of cassettes from vinyl records technically constituted infringement of copyright – by rights, the consumer should have bought the equivalent pre-recorded cassette (even though the recording quality was generally much poorer than that of the home-recorded article, thanks to superior tape and Dr. Ray Dolby). Now the governments could have stopped the whole thing by simply banning the import of the recorders, but they never did, which tends to indicate that it wasn't that much of a problem. What is a problem is the ability to make perfect digital copies and distribute them to a wide audience. This has led to a huge fall in revenue for the recording companies. They, on the other hand, are indulging in the age-old habit of closing the stable door long after the horse has vanished over the horizon. Technology has outrun them (again) and they need a new business model to cope with a new age. With its iTunes library, Apple has shown one way.

In addition, all countries have provisions for “fair dealing”.

6. What's “fair dealing”?

A general concept covering the **legitimate, non-profitable use of copyrighted material**. For example, university students commonly copy journal articles for use in their studies. This is generally regarded as “fair dealing” (although in some countries, university libraries have to pay a fee, which they extract from the students by means of pay copying machines). Similarly, journalists reviewing books are permitted to quote passages of the reviewed book in the production of their review.

Generally, the non-commercial quoting of small parts of a work presents no problems and does not require permission. However, larger parts, say, a table of results from a scientific paper, needs permission (and the original authorship must be acknowledged). In an example closer to home, I wanted to reproduce a plain wrapping cigarette packet in my companion booklet “To Mark It, To Mark It”. This necessitated getting permission from the Commonwealth of Australia, owner of the copyright.

7. When did all this begin?

The idea of some sort of moral right in written works is **very ancient**. Ancient Jewish Talmudic law shows recognition of the moral rights of the author and the economic or

property rights of an author. There are similar concepts in Greek and Roman law. Books were, of course, copied by hand, meaning that the cost of producing an original was the same as that of producing a copy, so there was no profit to be made from copying.



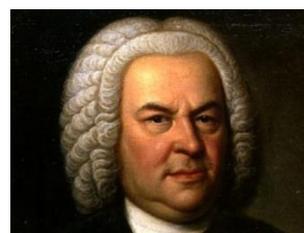
*Bless you and sod
the lot of you!*

According to legend, the first copyright lawsuit occurred in Ireland in 561. A monk called Colmcille made a copy of a psalter belonging to St. Finian of Moville. St. F. complained that this copy belonged to him. High King Diarmuid (roughly “DER-meed”) was asked to rule in the dispute and he declared for St.F. with the expression, “To every cow its calf, to every book its copy”. However, Colmcille was of royal blood and called on his relatives to back him up. The result was “the battle of the books” at Cúl Dreimhne (roughly “Coal-drenna”), said to have resulted in 3,000 dead. Mortified by what he’d done, Colmcille exiled himself to the Scottish island of Iona where he founded a famous monastery (there to this day) and became St. Columba. And presumably never violated anyone’s copyright ever again.

Things changed with the arrival of movable type and the printing press in the Middle Ages. Suddenly books became readily available, and the Church and state sought to control the publishing of books. That fine, morally upright gentleman Pope Alexander VI (Rodrigo Borgia) published a Papal Bull against the publishing of unpermitted books, and this led to the first *Index Librorum Prohibitorum* (list of prohibited books), which all good Catholics should avoid (the books, not the list, although I suspect it’s the list that is now avoided, except as a source of reading material).

Governments all over Europe sought to license printers, and restrict the trade to particular people, so that seditious and heretical books could be prevented. In England, all books had to be registered, and only people belonging to the Stationers’ Company could put books into the register. This ended in 1694. This, and the Union of England and Scotland and the desire for a uniform law led to the first true copyright act, the Statute of Anne of 1709, “An Act for the Encouragement of Learning, by vesting the Copies of Printed Books in the Authors or purchasers of such Copies, during the Times therein mentioned”, which protected written works.

With regard to musical works, nobody much bothered until the 19th century. Everyone happily plagiarised everyone else, and the plagiarised seemed to take it as a compliment. The big tune in Bach’s St. Matthew Passion, the passion chorale *O Haupt voll Blut und Wunden*, was taken from Hans Leo Hassler’s *Mein G’müt ist mir verwirret*, written a century before.



Ja, verdammtes gutes Tune!

The whole business with regard to music took off in the 1960s with the access to easy means of high-quality of reproduction, first the compact cassette of Philips aided and abetted by the Dolby noise reduction system, and then the arrival of digital recording and the possibility of mass production and sharing of perfect copies of video and audio files.

8. How do I apply for copyright?

Simple, **in most places, you don’t**. Most countries are signatories of the 1886 **Berne Convention**, which determines that **copyright exists in a work automatically from the moment of its creation**. There is no payment and no registration. Some countries still do have registration proceedings that are additional to Berne, and which can give additional

protection. One such country is the USA, where the US Copyright Office is in charge, under the ultimate authority of the Library of Congress. See:

<http://www.copyright.gov>



The USA acceded to the Bern Convention in 1989. Prior to that, copyright had to be registered. One of the biggest failures was with respect to the 1960s' comedy thriller *Charade*, featuring Cary Grant at his most suavely humorous and Audrey Hepburn at her most elfin gorgeous. The studio overlooked registering the copyright, so the film has been in the public domain ever since.

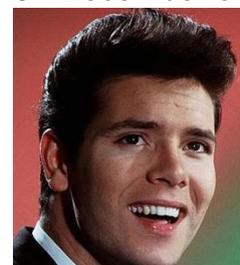
You did what with my copyright???

9. How long does copyright last?



I got you, babe!

This is **country dependent**. The **Berne Convention** (1971 Paris text) specifies a term of **at least 50 years from the death of the author**, that is, it lasts for the life of the author and expires at midnight on 31 December of the year 50 years from the death of the author. **Some countries have longer terms**. For example, the US "Sonny Bono" Act extended the copyright term in some works (including Disney's copyright on Mickey Mouse) to 95 years. The UK has 70 years. It had 50 years for sound recordings, but what's popularly known as the "Cliff Richard Act" (Sir Cliff had a hand in it) extended this to 70 years.



*Got myself a tryin', balkin',
fleecein', stalkin' copyright...*

President Trump has now signed into law the *Music Modernization Act*. This seeks to confront the new realities of the streaming scene (where so many people now get their music). It will have the effect of extending pre-1972 music copyright terms until 2067, which, in the case of a pre-1927 song, gives a term of over 140 years.

10. How do I ensure that my copyright is respected?

You **need to mark your work**, something like this:

© Fred Bloggs 2013

11. Can I use other people's copyrighted work?

As mentioned in 6, if it is **fair dealing**, there is **no problem**. To summarise:

Things (generally) that are not copyright infringements (can be country dependent):

- Making a single copy of a document for purposes of private study
- Time-shifting a TV programme
- Using a small part of a copyrighted work

Things that are copyright infringements:

- Making a copy of a recorded musical or cinematic work, including "ripping" it to your computer's hard disc (worse again, then sharing it with all your friends)
- Making a copy of a whole book or a substantial part thereof
- Making a 3-D object from a 2-D drawing or plan

In a recent interesting case, scientific publisher John Wiley tried to claim that US patent attorneys submitting copies of scientific publications to the USPTO as prior art was a violation of copyright. This was held not to be the case, but the USPTO has ceased putting non-patent literature on its websites.

In another case that has shaken the music world, recording artists Robin Thicke and Pharrell Williams were held to have violated copyright in Marvin Gaye's 1997 *Got to give it up*, with their 2013 mega-hit *Blurred lines*. The damages award was just under \$US7.4 million to Gaye's estate. This was in spite of the fact that the tune, lyrics and chord progressions are noticeably different. The jury verdict was not based on hearing the two songs, but on a comparison of the sheet music. It appears that Thicke and Williams were admirers of the Gaye song and were seeking a similar feeling. This could have a deadening effect on music creativity.

12. What about stuff on the Internet – that's free for everyone... isn't it?

Careful here. As Sportin' Life said in *Porgy and Bess*, **it ain't necessarily so**. In strictly legal terms, there's no difference between original material on the Web and the same in book form.

Of course, people who put stuff on the Web generally expect it to be read, copied, downloaded and generally disseminated, and so there's **generally an implied licence** to do so. It's a bit like a *Letters to the Editor* page in the local newspaper – the Editor does not expect to require permission to reproduce the letter, or to be sued for doing so.

The red line is **commercial use of Internet material** – unless specifically permitted, this is **NOT covered by implied licence** and should not be done without permission. This booklet is not for sale, so I do not need permission from the copyright owners of the photos I've used above. However, were this ever to be sold, I'd need to get permission.

The principles of fair dealing (see 6 above) apply to the Internet, so use for the purposes of research and study are generally OK, but again care is needed if large excerpts of original work (as opposed to small excerpts) are to be used – best to seek permission of the copyright owner.

13. What about linking to stuff on the Internet?

A recent decision of the CJEU (EU Court) held that hyperlinking does not constitute EU copyright infringement, even if the work appears to be on the website which houses the hyperlink ("framing"), **provided** the linked material is to a work freely available on the Internet. If it not freely available, or if the linking involves circumventing restrictions on publication, then it will constitute copyright infringement.

In a further key decision the CJEU has held that creating hyperlinks may be a communication to the public (and therefore may amount to copyright infringement), if the creator of the hyperlinks knows or should have known that the material to which s/he is linking has been posted without the copyright owner's consent. Further, if hyperlinks are created for financial gain there is a greater duty to check that the material is freely available before creating the link.

The EU Copyright Directive seeks to make things relating to copyright in the digital world fairer by requiring payment from the hosts of digital content (such as Facebook and

Google) to the providers of content. How this will work remains to be seen, but already there is widespread feeling that this will hinder, rather than help, the EU in the worldwide digital marketplace.

The US position is generally the same.

In a similar vein, the CJEU recently held that a provider of free Wi-Fi is not liable for third-party copyright infringements, but s/he may have to password-protect the network to prevent such infringements.

The Australian Government has recently had a face-off with Google and Facebook over a proposed new law that would make them pay for Australia news content. At one point, Facebook took down all its news content in Australia, much to the chagrin of users (apparently it's a primary news source for many Australians). Google even threatened to remove its Chrome search engine from Australia. The reaction caused Facebook to reverse course. Discussions are on-going, and the rest of the world is watching with interest.

14. What about parody?

Parodies of copyright material are often permissible, especially in the USA, where they may be seen as an extension of the First Amendment right of free speech. They also fall under the US "fair use" doctrine. Other countries, e.g., the UK, are stricter – in the UK, a would-be parodist needs to seek permission from the copyright owner. However, a bill that changes the law to allow parody is under consideration.

A recent opinion of the EU Advocate General held that certain parodies may be prohibited if they contravene the fundamental values of a society. This will differ according to the society, so implementation could be tricky. Would, say, a German parody of the Orange Order that causes major offence in Belfast's ultra-Loyalist Sandy Row be allowable? Where is the line? And who draws it?

15. And computer software?

In some countries (notably the USA), software may be patented. In most countries, it falls under copyright. In line with the general principles that copyright protects the expression of an idea, not the idea itself, it means that a program with the identical functionality of, say, Microsoft WORDTM, can only be an infringement of the copyright in WORD if there had been use of the WORD source code – the fact that it performs the same function is irrelevant.

16. Speaking of computer software, what about AI? Can an AI be the recipient of copyright?

As things currently stand, no. The output of AI such as ChatGPT are considered the cumulations of human-made work. But who knows what the future holds, should computers become genuinely intelligent, as opposed to mere compilers?

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GLOSSARY

A glossary of design/copyright terms that are mentioned in the text, plus some others that may be encountered.

addition, design of A design which covers a variation in a main design. Feature of old British-type patent law, now generally extinct.

AIA Officially the Leahy-Smith *America Invents Act*. Major change in US patent legislation that came completely into force in 2013. Its provisions also apply to design patents, but how exactly such provisions as **first-inventor-to-file** will apply to design patents remains unclear.

Apostille A form of document legalisation under the 1961 **Hague Convention**. Formerly, many countries required that patent documents had to be notarised and then legalised by their consulates/embassies. Hague Convention signatories now dispense with consular legalisation with respect to other Hague Convention countries and local authorities apply the Apostille (usually a large rubber stamp) to the notarised document. Of course, really sensible countries require no notarisation or legalisation of any kind...

appeal A legal proceeding seeking to have an earlier judgement or finding overturned. Some patent offices (e.g., USPTO, EPO, JPO) have **Boards of Appeal**.

applicant for a design May be a real person or a judicial person (company or institution) everywhere. The previous exception, the USA (naturally), where the applicant(s) had to be the inventor(s) and the actual owner of the patent (usually the employer of the inventor(s)) was the assignee, changed with the **AIA**.

application Until registration, a design application is an application. “Design patent” or “registered design” is the name given to a registered design, i.e., an application that has passed examination and on which a registration certificate or certificate of **letters patent** has issued. Only at this point does a legally-enforceable monopoly exist.

ARIPO African Regional Industrial Property Office, covering Ghana, Gambia, Kenya, Lesotho, Malawi, Mozambique, Sudan, Sierra Leone, Swaziland, Tanzania Uganda and Zimbabwe (but not South Africa). Unlike **OAPI**, it is possible to designate ARIPO countries regionally or as individual countries.

assignment In its simplest meaning, the transfer of ownership of something from one person to another and the legal document used to achieve this. In patent matters, it may refer to the assignment of designs and design applications from one company to another, for example, as part of the sale of a business.

It also refers to the transfer of the rights in a design from a designer to a company as part of the designer’s employment. If a designer is an employee of the organisation that is the applicant for a patent, the designer’s contract of employment will generally require that all rights in any designs s/he makes are the property of the organisation, and an assignment is therefore often unnecessary. However, if the designer is not an employee of the applicant (e.g., if the applicant is a holding company), it is better that s/he assign the rights in the design directly to the applicant. This is a bit of legal legerdemain, because there’s actually nothing to assign, but it does in a single jump what would otherwise require two (assignment of design to employer, proof that applicant had right to invention because of relationship with employer). In addition, some countries will require an assignment specifically for that country.

An assignment is especially important in cases where a designer is not an employee, e.g. an outside contractor. The assignment should be concluded before the filing of a **Convention application**. The issue is still unclear, but an early assignment would remove any doubts.

barrister In British-type legal systems, a lawyer who presents cases in court. In some such professions, lawyers qualify as “barrister and **solicitor**”, but usually specialise in one.

The top rank of barristers are the Queen’s Counsel (QC) (KC when the monarch is a he), sometimes known as “silks” because of their particular robes. Like the barristers, they wear silly wigs, but they cost a lot more. Specialist QCs with technical backgrounds are frequently encountered in high-profile IP cases in British-type law countries (e.g., UK, Australia, New Zealand).

Berne Convention 1886 Convention covering copyright. Among its provisions are a minimum 50-year term from the death of the author and the automatic existence of copyright from the moment of creation, without need for registration. Current (October 2015) membership, 168.

block exemption See **Treaty of Rome**.

Board of Appeal A patent office body which can hear appeals against patent office decisions, such as rejections.

boycott declaration Document demanded from patent applicants by Arab countries to the effect that the applicant had no commercial dealings with Israel – failure to comply meant forfeiture of intellectual property rights. Part of the Arab League boycott of Israeli goods and run by the Central Boycott Office in Syria, it was once universal in the Arab world, but has never been applied consistently. After a period of decline, it seems to be making a minor comeback (Iraq is now requiring it). Oddly enough, Syria no longer requires it.

“Brexit” Popular name for the UK’s leaving the **EU** in the aftermath of a referendum vote on 23 June 2016 and due to come into effect on 31 January 2020. A Brexit would have major effects on IP matters – it would mean that the UK could no longer be part of the **Community design** system. Presumably there would be transition provisions that would allow the UK part of a Community design to be separately registered as a UK national design.

Bundesgerichtshof Germany’s Supreme Court and the ultimate authority on all matters IP. Most German IP cases never stray beyond the **Bundespatentgericht**, but it has happened.

Bundespatentgericht German Federal Patent Court, a specialised court dealing with IP matters. Appeals from decisions of the German Patent Office are heard by this court and *Patentanwälte* (German Patent Attorneys) are entitled to present cases before it. An appeal to the Federal Supreme Court (*Bundesgerichtshof*) is possible, but rare.

CAFC Court of Appeals for the Federal Circuit, US Federal Court that hears patent appeal cases.

Cartagena Agreement. Sometimes known as “the Andean Pact” (Comunidad Andina (CAN)). A Latin American free trade agreement governing the members of the Andean Community (Bolivia, Colombia, Ecuador, Peru – Venezuela was a member but is contemplating rejoining). Previously notorious for restrictive, patentee-unfriendly laws, especially on patent term and compulsory licensing, the members adopted a harmonised intellectual property law in 2000, which brought the countries into line with the **GATT-TRIPS** provisions.

case law The interpretation of the law as set forth by a court. The courts are the ultimate judges of what the law actually means. In the case of patents, this means that the meaning of a patent is what a court says it is. In **common law** countries, the decisions of the higher courts, especially the US and UK **Supreme Courts**, on a legal principle are binding on all lower courts, and a lower court can only differ if it can show that the principle does not apply to the case before it.

CASE Act Proposed US copyright law designed for small claims copyright cases. Instead of court, a Copyright Claims Board appointed by the Librarian of the Library of Congress will judge cases. Remedies are capped at \$US30,000 before costs and attorneys’ fees. Board decisions will be subject to limited review. It must be passed by a majority in both US houses of Congress.

“cease and desist” A type of warning letter, sent out by a design proprietor to an alleged infringer of the design. **Threats** of any kind should be avoided. An initial letter to an alleged infringer should be strictly factual and correct, stating no more than (a) it is believed that the other party may be infringing, (b) inviting the other party to cease immediately from the offending action, and (c) stating that prompt compliance will remove the need to consider other legal remedies.

certificate of correction Certificate affixed to the front of a US patent, showing an error made by the applicant in the patent and its correction.

certiorari See **writ**. Also **Latin**.

characters In UK law, fictional characters, apart from the stories in which they are included, are not capable of copyright. However, US law allows this, if the character is “sufficiently delineated”. For example, Rocky Balboa of the “Rocky “ series of films, was sufficiently delineated to be protectable. At the time of writing, there rages a US case involving the Estate of Sir Arthur Conan Doyle, which is seeking copyright protection for Sherlock Holmes.

China “Why file there? They’ll only copy it” is the inevitable comment. The People’s Republic of China is not yet as good at IP as the western countries, but in a relatively short time (China had no IP laws at all until the 1980s) it has come a very long way. The Chinese courts, initially completely unfamiliar with IP cases, are improving. In a big

country comprising one-quarter of all mankind, detection of infringement remains the big problem, but the problem for design owners is tiny in comparison with that of **copyright** owners (CDs, DVDs, computer games and software).

civil law Legal system in which laws are codified into a system and form a primary source of law, in contrast to **common law**, which is based on judicial precedent. It began with Roman law and is now the most widespread legal system in the world, followed by about 150 countries, including most of continental Europe, Russia, China and most of Latin America (Scottish law is a hybrid of the two systems). In civil law jurisdictions, case law is secondary to, and subject to, the written code. The differences can result in differences as to how intellectual property cases on the same subject-matter are decided in different countries.

CJEU (Court of Justice of the European Union). Formerly **ECJ**. Transnational high court of the **European Union** and the ultimate arbiter of EU law, including intellectual property law disputes. A European and European Union Patent Court is projected to handle cases relating to any future **EU patent**.

CLASSICS Act See **Music Modernization Act**

classification The organisation of design subject-matter into fixed categories of articles to make it more easily findable in a subject-matter search. In most places, as per trade marks, the applicant is required to give a classification, usually the **Locarno Classification**.

Cliff Richard Act EU copyright extension legislation (officially Directive 2011/77/EU), which extended EU copyright term from the Berne Convention's 50 years to 70 years. So nicknamed because the UK singer was one of the prime lobbyists for the extension.

collateral estoppel See **issue preclusion**

common law Legal principles covering individual rights, some of which date back to before the Norman conquest of England (1066) and based entirely on precedent. Common law is one of the major bases of the legal systems of the British Commonwealth and the USA, and it remains an influence on the interpretation of documents. See also **equity**

Community design Design protection covering the **EU**. It is administered by the **EUIPO**.

compulsory licence A licence which is obtained compulsorily by a third party on application to a court because a design owner has not worked his/her design to a sufficient extent in a particular country (see **working**). The **Paris Convention** contains provisions for the obtaining of compulsory licences, but some countries have much stiffer ones (not so many any more in these **WTO** days).

computer programs These are protectable by patent in some countries (e.g. the USA), but in others they fall under copyright protection. But what exactly does this mean? In days gone by, programs were written out or put on punched cards or magnetic tape or discs, and these physical embodiments were subject to copyright. However, the computer world has moved on since then, so what can be protected? The general principle of copyright, that it protects the expression of an idea, but not the idea itself, applies. Therefore things such as source code, object code and preparatory design materials are protected, but not the functionality operational interfaces or programming languages. IN a recent referral to the **CJEU** from the UK High Court (in *SAS Institute v. World Programming Ltd.*), it was held that data file formats were not protected by copyright, provided that the use did not involve the procurement of the source or object codes.

confidentiality See **secrecy**.

conflict of interest What happens when a private practice firm of patent attorneys finds itself representing both sides of a patent conflict. In days of old, when people were more honest and/or honourable and/or far less greedy than they now are, the solution was to pass both clients to other attorney firms. However, many now keep one (the more lucrative one naturally), and I know of one case where a firm tried to keep both, going as far as physically walling off the group handling one of the clients from the rest of the firm.

Congress, Library of The ultimate authority for the registration of US copyright.

Contracting States Those states which are party to an international agreement.

Convention application An application made under the **Paris Convention**, claiming **priority** from an earlier first application in another Convention country. Most (but not all) countries allow **internal priority**, the claiming of priority from an earlier application in the same country.

Convention date The anniversary of the date of filing of a first design application from which it is intended to claim **priority** under the **Paris Convention**.

Convention priority A concept which is one of the main features of the **Paris Convention**. If a person files a design application in a Convention country, and then files the same application in a second Convention country within six months of that original filing, s/he is entitled to claim the date of that first filing as his /her **priority date**. In the event of a conflict with someone claiming the same design the applicant with the earlier priority date has the right, even if the other party physically filed first in the second Convention country.

There remains in existence an old “Inter-Imperial Convention” by which priority could be claimed from a British national application in non-Paris Convention Commonwealth countries. Previously mainly relevant to India and Pakistan, but India’s accession to the Paris Convention (December, 1998) and Pakistan’s membership of the **WTO** have essentially reduced its relevance to nothing.

copyleft (as opposed to **copyright**) The practice of offering people the right to freely distribute copies and modified versions of a work, on condition that the same rights be preserved in later derivative works. In contrast to copyright, which seeks to prevent copying of a work (see next entry), under copyleft, an author may give every person who receives a copy of the work permission to reproduce, adapt, or distribute it, with the accompanying requirement that any resulting copies or adaptations are also bound by the same licensing agreement. It is common in the software industry and even has its own symbol (the copyright symbol reversed)



copyright An **intellectual property** right initially conceived as a protection for written works, later expanded to cover all works of literary or artistic merit. Now covers things as disparate as blueprints, architectural plans, computer programs and perfumes (yes, really, after the *Lancôme* decision in the Netherlands). Copyright does not give an exclusive right, only protection from copying, i.e., if you come up with a copyrighted work entirely independently, you cannot be stopped from making and selling it. Copyright is automatic under the Bern Convention – no registration is necessary, but it is still possible in some countries (e.g., the USA) and may be advantageous. Copyright generally expires at the end of the year 70 years after the death of the author of the work, but for recordings the term is 50 years. And in the USA, the so-called *Sonny Bono Act* extended some US copyright terms to 95 years (they’ve got you, babe).



Design documents and illustrations are NOT protected by copyright.

copyright-design overlap Should an artistic work produced industrially lose artistic copyright (and therefore the benefit of the long copyright protection term)? It depends on the country. Some countries don’t care and allow dual protection. Others void copyright in respect of the design as soon as the design has expired.

Copyright Directive There have been several of these **EU** directives. The first, Directive 2001/29/EC intended to enact the **WIPO Copyright Convention** and to harmonise copyright law across the EU member states. However, it did provide for some national exceptions.

The second (2019/790), now approved but as yet implemented only by a few countries, seeks to harmonise and update copyright law across the digital single market and bring the copyright law of member states into line with the reality of the digital age. It seeks to counter the “free riding” by the tech giants such as Google and Facebook. The most controversial parts are Articles 15 (“the link tax”) and 17 (“the upload filter”).

- Article 15: entitles content creators and publishers to charge a licence fee to information society service providers whenever those platforms share their content. This paradigm shift will mean that news aggregators, such as Google and MSN, may be required to pay mainstream publications for making digital use of their content.
- Article 17: places the onus on online content sharing service providers to prevent the users of those platforms from sharing unlicensed copyrighted material; social-media platforms like Facebook, Twitter and YouTube will be made liable for copyright infringement committed by their users.

Some believe that this will hinder, rather than help, the EU in the digital marketplace. 2019/790 has been welcomed by newspapers, publishers and media groups, but opposed by major tech companies and internet users, as well as human rights advocates (inhibition of free speech).

Vagueness of some of the language (e.g. what exactly constitutes a “snippet”?) may lead to varying interpretations in national practice. How it will be applied, if at all, in **Brexit** UK remains to be seen.

corporate veil A US legal concept (in State law) that separates the personality of a corporation from those of its shareholders, thus rendering them not personally liable for any debts or other obligations of the company. It can be lifted under some circumstances. For example, an officer of the company who is personally responsible for the provision and sale of a patent-infringing article by the company may be personally liable.

countries where design cover isn't possible Not so many any more, and none of any great importance. Major example, Myanmar (Burma).

country codes Two-letter codes recognised by the ISO and used to identify countries in patent documents. Most are intuitive or already well known from car nationality plates (FR for France, US for the USA, GB for the UK, CH for Switzerland), but some are less obvious (EE for Estonia, HR for Croatia).

court Courts of law are the ultimate authorities as to what a patent covers. It's an expensive way to find out, so one should avoid them wherever possible.

criminal penalties In some countries, infringement of a design registration is a criminal offence. This has been suggested for the UK in the recently-introduced Intellectual Property Bill, because of the high cost of civil litigation in the UK, effectively placing it beyond the small business, and thus allowing large companies to copy, relatively free from worry about being sued. Whether criminal penalties actually would be a deterrent is unknown.

Crown use See **Government use of designs**

damages Monetary compensation awarded by a court to the patentee of an infringed design after a successful **infringement** action. It is based on an assessment of the damage suffered by the patentee as a result of the infringement, the principle being that the patentee should be placed in the position that s/he would have been in had the infringement not occurred (the test applied is the so-called "but for" test). This is often easier said than done, and an award of damages rarely ever compensates completely for the losses actually incurred, although in the USA, negligence or bad behaviour can be punished by treble damages. In some countries, there exists the alternative of an **account of profits** (based on how much the infringer profited from the infringement). The choice of which one to take is dependent on the circumstances.

database right A property right similar to, but distinct from, copyright. It basically recognises the rights of database compilers to their databases, and seeks to protect them from theft/misuse. Database right is a *sui generis* right recognised by some countries (EU, UK), but not by others (USA).

Daubert Standard In US practice, rules as to whether expert witness evidence is admissible in a court case. Now the standard in US federal cases, superseding the earlier Frye general acceptance standard (which still applies in many US state laws).

decision The final result handed down by a court or patent office tribunal on a contested matter. The date of a decision may be the starting point for a deadline, such as an **appeal**. Decisions on the interpretation of law can be **precedents** in further legal actions along the same lines.

declaratory judgement US civil law judgement that solely set out the rights, duties and obligations of the parties in a dispute. No order is made as to action and no damages are awarded. Typical judgements of this type are declarations of non-infringement or a holding that a patent is invalid. A **cease and desist** letter from someone alleging infringement and which is too harsh can be countered by a request for a declaratory judgement. This forces the accuser to appear in a court of the alleged infringer's choosing and at the accuser's expense.

delivery-up As part of an **infringement** settlement, an infringer may be required to deliver up his goods to the design owner or his agent for destruction or other disposal.

Dennemeyer Luxembourg firm of patent attorneys better known for its (relatively) inexpensive and successful worldwide IP **renewal** services. Its success has spawned a number of imitators.

dependent/overseas territories, patenting in See **overseas/dependent territories, registering in**

derivative work An artistic work based on an existing work, e.g., a new arrangement of a musical work. If the existing work is still covered by copyright, that copyright will usually extend also to the derivative work, and the deriver will need permission to exploit it.

design or registered design. A variety of **intellectual property** right that protects the shape of, or pattern or ornamentation applied to, industrially-produced articles. Called **design patent** in the USA. Design terms vary (maximum of 25 years in the UK, 14 years for a US design patent).

design patent US patent covering the shape of or pattern on an article. Equivalent to a registered **design** elsewhere in the world and nothing to do with patents for inventions. However, it is a patent, and is therefore subject to many of the same considerations as are US utility patents (but are handled by a different set of Examiners). The **AIA** will be relevant to many aspects of US design patents. The US design patent number bears a D.

design right Sometimes referred to as “unregistered design right”. A UK and EU right analogous to **copyright** that comes into existence when a new or original design is created. It lasts for 15 years from the creation of the design. Having no statutory protection, the owner of such a right can only defend it from alleged infringers by civil court action, such as a **passing off action** at common law in the UK. The fashion industry relies heavily on unregistered design right for its relatively short-lived creations.

designated states The **contracting states** which are designated for protection in a **Hague Agreement** application

designation fee Fee payable to individual countries in an **International design** application.

designer remuneration If the designer is an employee, the rights to the invention generally belong to the employer and no particular compensation is payable.

dictated by function, shape In some countries, a shape that is solely dictated by the function the article has to perform cannot be the subject of a design registration, no matter how different its appearance. In other countries, it is sufficient for it to have a suitably distinctive appearance.

digital exhaustion Does the **first sale doctrine** apply to digital products? In other words, can the owner of a digital product, e.g. software, that has been downloaded, pass it on to someone else without copyright infringement? As things currently stand in the USA, no. However, the **CJEU** has ruled that it is permissible to resell software, even if it was downloaded. The court required that the previous owner must no longer be able to use the licensed software after the resale, but found that the practical difficulties in enforcing this clause should not be an obstacle to authorizing resale, as they are also present for software which can be installed from physical supports, where the first-sale doctrine is in force.

Digital Millennium Copyright Act US copyright act that criminalises production and dissemination of technology, devices or services intended to circumvent measures that control access to copyright works, even when no actual infringement of copyright is involved. It also reduces the liability of internet service providers to charges of copyright infringement by their users.

Directive on the enforcement of intellectual property rights or Directive 2004/48/EC of the European Parliament. EU legislation covering remedies under the provisions of the EU. It has no effect on the substantive provisions of IP law, but seeks to harmonise the rules on matters such as standing, evidence, interlocutory measures, seizures, injunctions, damages and costs. Member States can be censured in the **ECJ** if their civil procedures on the infringement of intellectual property rights are "unnecessarily complicated or costly, or entail unreasonable time-limits or unwarranted delays".

discovery The ability during legal proceedings for **infringement** in **common law** countries to obtain internal documents from the other party to support the obtaining party’s position. Documents that are the subject of **privilege** cannot be discovered.

divisional application Application produced when a design application contains more than one design and the extra design is “divided out”, either voluntarily (by the applicant) or involuntarily (at the demand of a patent office during prosecution). It results in an independent design. A divisional must be filed before the prosecution of the “parent” application is complete.

DMCA See **Digital Millennium Copyright Act**

drawings for design applications These illustrate the design. It is common (especially in the USA) to use solid lines for design features and dotted lines for non-claimed features.

due diligence An assessment of intellectual property held by a person or organisation to ascertain its asset value. This is generally done at the time of a takeover or merger.

EAPC The Eurasian Patent Convention, covering many of the countries of the former USSR, now has a Protocol on the protection of Industrial designs. It came into force for Armenia, Azerbaijan and Kyrgyzstan on 17 March 2021, and will enter into force in respect of the Russian Federation and Kazakhstan on 11 and 12 April 2021. Other states may join and the Protocol will enter into force 3 months from ratification. As of April 2021, the office is not yet ready to receive applications.

ECJ (European Court of Justice) See **CJEU**.

employee, designs made by If it could reasonably be considered part of an employee’s remit to design, any such design is the property of the employer and this is usually set out in the contract of employment. They remain the property of

the company even after the employee has left the company. Thus, if an employee makes a design and he leaves before a design application is filed, he is still obliged to assign the rights to the former employer and to complete all formalities. In the common case of all company designs belong to a holding company, which is not the employee's actual employer, it is best to have the employee assign the design to the holding company early in the design process. This is of course a legal fiction (the design belongs already to the employer as of right and the designer has nothing to assign), but it is convenient in that avoids the pain of having to show that the holding company has the right to apply because it owns the employer.

en banc A court decision taken by a panel of judges, delivering a single judgement (i.e., no dissenting judgements).

Enforcement Directive In full, EU Directive 2004/48/EC on the enforcement of intellectual property rights. The Directive requires all Member States to apply effective, dissuasive and proportionate remedies and penalties against those engaged in counterfeiting and piracy and so create a level playing field for right holders in the EU. It means that all Member States should have a similar set of measures, procedures and remedies available for rightholders to defend their intellectual property rights (be they copyright or related rights, trademarks, patents, designs, etc) if they are infringed.

equitable estoppel Derived from the principles of **equity** (next entry). US judicial doctrine that prevents a patentee from alleging infringement if s/he delays unduly (of the order of several years) in filing an infringement suit, as a result of which the alleged infringer reasonably believes that no action will be taken and continues doing what s/he's doing. The questions as to whether this applies to continuations/CIPs or to all members of portfolios of related patents remain to be answered.

equity Ancient principles of law arising in England and encompassing principles of natural justice and fairness, and modifying the harshness of some aspects of **common law**. (If your cow strayed on to your neighbour's land, common law said it was now his cow, but equity overrode this and required him to return the cow, or reasonable compensation for it if the cow had already been invited to dinner). It applied to property transactions such as correction of property lines, taking possession of assets, dividing assets, or injunctive relief, and so it impinges on **intellectual property** law. The principles still exist in common law countries (UK, Ireland, British Commonwealth, USA).

In general, the terms "law" and "equity" have almost completely merged, as courts deal with both legal and equitable issues, but certain aspects of equity often remain (e.g., no jury in equity cases – the USA can be an exception here). An important principle is that a person comes to equity "with clean hands". This has recently become a major issue in patent law in the USA (see **inequitable conduct**).

equivalent The same design or design application filed in a different country.

estoppel A legal bar to a right of action arising from a person's own actions. Most commonly encountered in patents in the form of **file wrapper estoppel** in the USA.

EU See **European Union**

EUIPO See **European Union Intellectual Property Office**.

European Union (EU) The **European Union Intellectual Property Office**, unlike the **European Patent Office**, is an EU organisation. See also **Treaty of Rome**, **parallel importation**.

European Union Intellectual Property Office (formerly **OHIM**) EU organisation located in Alicante, Spain that includes the unitary European Union Trade Mark and **Community Design** systems.

evidence, standard of How persuasive does evidence need to be in a case? The EPO has two standards, depending on the nature of the case, "balance of probabilities" and "beyond reasonable doubt" (sometimes referred to as "up to the hilt"). These categories are to be found (in substance, if not in name) in other jurisdictions.

In the recent case *i4i v. Microsoft*, the US **Supreme Court** decided that the hitherto-accepted "clear and convincing" standard applied, in spite of Microsoft's efforts to convince courts that a lower standard be applied to issues that weren't considered by the USPTO.

examination of design applications The process by which a Patent Office decides whether a design application meets the requirements for patentability. They vary widely, from virtually none to mildly severe. Third parties get no say – their turn comes at **opposition**.

examination request In design cases, like trade mark cases, applying for a design registration automatically sets the examination process in train.

Examiner Patent office employee charged with examining design applications.

fair dealing (also **fair use**) The legitimate, non-profitable use of copyrighted material. Such use does not infringe copyright in a work. Examples include small excerpts quoted either for non-commercial purposes, or for the purpose of review (for example, some song lyrics quoted as part of a newspaper review of an album). Larger excerpts, or any sort of commercial use, require permission from the copyright holder. The US case of *Authors Guild v. Google* extended the concept to **orphan works**.

false marking See **marking**

Federal Trade Commission (FTC) US government agency whose principal functions are the promotion of consumer protection and the prevention of anti-competitive business practices. Abuse of IP rights can sometimes fall within its ambit.

first inventor-to-file (FITF) Priority system introduced in the USA by the *AIA*. “So,” you might ask (but then, you might not, but anyway...), “what’s the difference between this and **first-to-file**? In practical terms, nothing, it seems, apart from the continued existence in the US of a **grace period** (bit somewhat reduced) but I’m sure the USPTO and court system will find ways to toss assorted spanners in the works. How it will apply to design patents remains unknown.

first-sale doctrine US legal concept in trade mark and copyright law, which allows an individual purchaser to sell his or her legitimately-acquired article to a third party without there being any infringement of copyright or trade mark laws. Recently seen in the US trade mark case *Costco v. Omega*, where the Swiss watch maker was not allowed to invoke the trade mark rights in its logo to prevent Costco from selling discounted Omega watches.

first-to-file The **priority** system prevalent in most of the world. If there are two applications or patents for the same invention, the one with the earlier application or **priority date** has the right to the invention.

first-to-invent The **priority** system formerly prevalent in the USA. Replaced by **first inventor-to-file**.

FITF See **first inventor-to-file**.

foreign filing The filing of an application in countries other than the country of first filing. Generally done near the end of the **priority period** for the purposes of claiming **priority**, but can be done later. (see **non-Con filing**).

foreign filing licence Permission by the patent office of a country on whose territory a design has been made to file a **priority application** outside that country. The usual reason is **national security**.

forum shopping The selection of a court/legal system for a trial that offers the chance of the best/quickest result. This is possible in some jurisdictions, e.g. the “**rocket docket**” of some US courts. It is also possible in the Chinese system, where it is better to bring a case in a large city court, where knowledge of intellectual property matters is more sophisticated.

freedom to operate The ability to perform a process or make and market a product without infringing anyone else’s design, and usually without trying to register anything. Before proceeding with any new design, **clearance** should be obtained. Having a design registration does **NOT** automatically give you the right to practise the design.

Frye Standard See **Daubert Standard**

functional shapes See **dictated by function**

GATT-TRIPS (General Agreement on Tariffs and Trade - Trade-Related Aspects of Intellectual Property) A part of the successful GATT Uruguay round which set up the **World Trade Organisation** and which led to a general agreement among signatories to make intellectual property laws more uniform. As of 1st. January, 2000, the **PCT** authorities recognise the **priority** claimed from an application filed in any WTO member, even if that member is not a signatory to the **Paris Convention**.

General Court Division of the **CJEU** which hears, among other things, appeals from decisions by **OHIM**.

Geschmacksmuster German registered design.

Government use of designs In the UK and some Commonwealth countries “Crown use”. The ability of a Government or a Government authority to use a design without having to seek permission and without it being considered

infringement. Many design s legislations confer such power. The Government may be required to pay compensation, but it may not.

grace period A time period within which an action can be taken without detriment to a design application. Two basic types:

- (a) time periods before the application date of a design within which **publication** is considered not destructive of **novelty**, e.g. 12 months in the case of **USA** patent applications;
- (b) time periods after an action deadline within which that action can be completed (usually with an extra fee), e.g. **renewals** in all **Paris Convention** countries, certain **EPC** deadlines (examination request, filing fee payment).

grant The award of a design, and the time point at which the applicant actually owns property in a design. The earliest time point at which action for **infringement** can be started.

Graphical User Interface (GUI) The touch-sensitive interface on a smartphone or tablet. Protectable by design/design patent but only in association with particular articles, e.g. smartphones. Copyright protection may also be possible.

“grey market” goods Goods subject to an **intellectual property** right legitimately acquired in one country and imported into another country in which there is an equivalent intellectual property right in the name of the same IP owner. The act is known as **parallel importation** and it is generally forbidden. It most commonly involves goods bearing registered trade marks genuinely applied by the proprietor or his/her agent, but it can also involve patents.

GUI See **Graphical User Interface**

Hague Agreement (not to be confused with next entry) International agreement which allows for the international registration of industrial **design** applications. Essentially a designs version of the **Madrid Agreement/Protocol** for trade marks, and managed by **WIPO**.

Hague Convention International convention dealing with the authentication of documents in civil matters (any civil documentation, not just patent-related documentation). The practical upshot is that, instead of **notarisation** being followed by consular legalisation by the country to whom the document is directed, a local authority in the country of origin can affix the **Apostille**.

“Happy birthday to you” has been ruled to be in the public domain by the US courts, despite the attempts of Warner /Chappell Music to claim copyright in it. It is probably the world’s best known **orphan work**.

harmonisation It has long been a goal to make IP procedures (especially the formalities) more uniform throughout the world, so as to impose a lesser burden on applicants. The traditional hold-out has been the USA with its “everyone else is out of step” attitude, but this has changed, first with the **GATT-TRIPS** provisions, and more recently with the **AIA**.

holding company Often used as the applicants for IP rights for tax reasons. However, as designers rarely work for holding companies, they should assign their design s to the holding company early in the registration process. See also **employee, design made by**.

Hong Kong has a separate designs registry from the PRC. If you want design protection in Honkers, you have to apply there.

House of Lords Former highest UK court and the absolute authority on the interpretation of UK IP law. Its judgements are not binding anywhere else but are highly persuasive in the **common law** jurisdictions of the British Commonwealth.

As of 1 October 2009, this function was taken over by a newly-formed UK **Supreme Court**.

hyperlinking Providing a clickable link on a website to material on another website. Infringement of copyright in that material? Generally no, provided the material is freely available on the Internet. If it isn’t, or if the hyperlink seeks to avoid prohibitions on publication placed by the owner of the material, it may be copyright infringement. If the hyperlink is created for financial gain, there is a greater onus on the creator of the hyperlink to ascertain that there is no copyright infringement of the material thus linked. The **CJEU**’s ruling in *GS Media* was recently applied by German courts to mean that a provider may need to ensure that the material carried is in fact freely available to the public.

image rights The rights of a celebrity (such as a sportsperson or entertainer) in his or her image. They can include rights regulating the use of still, moving or animated images, name, signature, recorded voice and any associated logos and trade marks. They are not, as such, legally protected everywhere, but can be used in contracts as a valuable asset. Their attempted use by Barcelona superstar Lionel Messi to avoid tax landed him in hot water with the Spanish tax

authorities, resulting in a hefty fine and a suspended jail sentence. Image rights are often transferred by assignment of licence to companies for future exploitation.

The Bailiwick of Guernsey (Channel Islands) has established the world's first image rights register.

industrial property Subset of **intellectual property**. Generally considered to comprise patents, trade marks and designs (not copyright).

inequitable conduct Inappropriate behaviour at **equity** (failing to come "with clean hands"), leading to loss of the case. This has existed since 1684 (when the UK High Court of Chancery repealed a patent as a matter of fraud), but it recently briefly became a major patent issue in the USA, notably in the **CAFC** case *Therasense v. Becton, Dickson & Co.*, in which the court held that clear and convincing proof of deliberate intent to deceive was needed. (In the original case, a patentee made a declaration to the USPTO that was contrary to attorneys' arguments made at the EPO. The patent was invalidated as a result.). The brief storm of inequitable conduct cases now seems to have subsided, as it's very difficult to prove that a defendant made a deliberate decision to withhold a relevant reference of which it was aware. Nevertheless, clearly inconsistent positions in different national prosecutions are to be avoided. The latest is that the US **Supreme Court** may look again at *Therasense*.

InfoSoc Directive EU Directive (formally *Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society*) that seeks to harmonise aspects of copyright across the EU. It includes a reproduction right, a right of communication to the public and a distribution right.

infringement The manufacture without permission of articles complying with someone else's registered design in a country where the design is registered by that someone else. Very risky and potentially very expensive, unless the registration is, for some reason, invalid.

infringement remedies Include **damages, account of profits, injunction, delivery-up.**

injunction Court order prohibiting a person found guilty of infringement from continuing to infringe. In some countries, courts will grant a preliminary injunction prior to the hearing of a case, on presentation of a *prima facie* case of infringement.

Integrated Circuit Topography The newest form of intellectual property protection, covering the pattern, shape and configuration of the three-dimensional disposition of the elements of an integrated circuit and the maskworks used to produce them. About 20 countries (including USA, Canada, Australia, Japan, Switzerland) have such protection – many others consider that integrated circuits are adequately covered by copyright or registered design protection. Term is 10 years, typically expiring on 31 December of the tenth year after application.

intellectual property Property that resides in ideas and concepts, rather than physical objects. The best known intellectual property rights are patents, trade marks, designs and copyright. However, there are other types, such as plant variety rights, circuit topography, trade secrets and confidential information and know-how, and traditional knowledge.

"Inter-Imperial Convention" See **Convention priority.**

International Bureau Part of **WIPO** that supervises the workings of the **Hague Agreement**. Also handles the Madrid Arrangement/Protocol for International trade mark registration.

International design Design application filed through the Hague Agreement and designating a number of **contracting states** to the Agreement.

International Exhibition Exhibiting at such an exhibition is one of the few exceptions where public showing of an invention prior to the filing of a patent application on the invention does not destroy **novelty**, even in **absolute novelty** countries. However, certification must be obtained from the organisers of the Exhibition, showing its status and this must be presented when filing the application (to be filed within 6 months of the opening of the Exhibition).

International Trade Commission US Government body that regulates (surprise, surprise) US international trade. It can become involved in patent matters, e.g. in seeking to prohibit the import of a product that infringed a US patent. To achieve this, the plaintiff must establish that a domestic industry exists or is in the process of being established for the product protected by the patent.

Internet Copyright also applies to original material on the Internet, but there is often an implied licence to use the material. However, commercial use of Internet material requires permission. The situation is currently (January 2014) under review by the **CJEU**.

intervening rights The US term for the concept that it is possible that a third party might acquire rights in a design or part of a design in spite of the existence of a design registration or design patent. One common way is when a registration/patent is inadvertently allowed to lapse, and then restored. If a person makes use of the design between lapse and restoration, that person may be allowed to continue doing what s/he was doing (but no more than that).

interview Most patent offices allow applicants and their attorneys to interview examiners, either or both telephonically and in person. This can often result in a quicker resolution of difficult points than relying purely on a written procedure.

IP see **intellectual property**.

issue preclusion Previously known as collateral estoppel, a **common law** estoppel that prevents a person from relitigating an issue. In general, once a court has decided an issue of fact or law necessary to its judgment in a case, that decision precludes relitigation of the issue in a suit on a different cause of action involving a party to the first case. However, a recent US patent decision has applied the doctrine in a case involving a different sued party.

joint applicants Completely OK, but can cause complications – it will involve multiple signatures, which can be a nuisance, and of course the parties can fall out. Therefore, avoid, if at all possible.

jury trial The right to a trial by jury in civil matters is guaranteed under the 7th Amendment of the US Constitution, and this applies to IP cases. Depending on circumstances, some US lawyers may seek a jury trial if they think their chances may be improved. Jury trials can become a form of lottery, and many are wondering whether it's a good idea.

laches Legal term meaning negligence in the performance of any legal duty, delay in asserting a right, claiming a privilege or making an application for redress. Sometimes arises in patent cases, e.g., in the USA, an inventor wrongfully omitted from a patent application must take action within six years of becoming aware of the fact, or laches will apply.

lapse End of a design registration or application through failure of the applicant or patentee to take some necessary step, e.g., failure to pay a **renewal fee** or respond to an **office action** in due time. In many circumstances **restoration** is possible. See also **intervening rights**.

Latin A dead language, which, instead of being allowed to rest in its grave with dignity, is frequently disinterred in some odd fields of human endeavour, examples being the Swiss school system, medicine and the law, presumably as a way for some folk to show that they're **so** much cleverer than you are. Thankfully, in patent law, it is relatively rare, but it does occur. Some odd examples of this oddity:

a fortiori – “from the stronger”. Denotes proof of a claim by reference to an already decided stronger claim.

a priori – “from what is before”. Deductive reasoning (proceeding from causes to effects).

ab initio - “from the beginning”. A revoked patent is revoked *ab initio*, that is, there was never any time at which it was valid (i.e., it was not valid up to the point at which it was held invalid).

amicus curiae – “friend of the court”. Normally given to a legal brief on a point of law not from a participant in the proceedings. Such briefs are often invited on contentious matters from third parties.

certiorari – “to be searched”. Writ seeking the legal review of the judgement of a lower court by a higher court.

ex nunc – “from now”. Something that has effect for the future and is not retroactive. For example, the amendment of a patent application is valid only from the time that it is made.

ex parte – “from one party”. Legal proceedings brought by one party and without reference to any other parties.

ex post facto – “after the fact”. Often, with hindsight. *Ex post facto* analysis by patent offices is forbidden.

ex tunc – “from then”. Something that has retroactive effect. A document corrected *ex tunc* is deemed always to have been in this corrected state.

in re – “in the matter of”. Generally refers to a case which is not contested by third parties.

inter partes – “between parties”. Legal proceedings, in which a third party has the right to make observations or otherwise intervene or be involved (e.g., opposition and infringement proceedings).

ipso facto – “by the deed itself”. Often used to say that something that is contrary to law is automatically void.

locus standi – “place of standing”. A right to be heard by a court in a legal matter. There are certain matters in patent law where only persons with a specific interest have the right to be heard.

mandamus – “we command”. A common law writ from a higher court to a lower court or government officer requiring him/her/it to perform an action that he/she/it is required by law to do.

mens rea (state of mind) Consideration as to what was in the mind of the accused. It has become a point in questions of **inducement to infringe**, which have recently become fashionable in the USA.

mutatis mutandis – “changes changed”. Often seen in relation to articles of a law, which are to be applied with any necessary changes with respect to a known article and known set of changes.

obiter dictum – “said by the way”. A remark made in a judgement that is not central to the judgement, and that is therefore not legally binding.

ratio decidendi – “the reason for the decision”. ←What he said.

reformatio in peius – *reformatio* means “improvement” and *peius* means “worse”. It refers to a decision from a court of appeal that is amended to make it worse. It surfaces in **EPO** practice, where it is forbidden in the case of a sole appellant (s/he cannot be placed in a worse position).

restitutio in integrum – “restoration to original condition”. For example, a patent that is restored after the proprietor has accidentally (and excusably) allowed it to lapse, is considered never to have lapsed.

sui generis – “of its own kind”. In IP matters, it refers to subjects meriting protection, but that do not fit into the usual categories. Examples include protection for integrated circuits and databases.

legalisation Authentication of application documents for a particular country, following **notarisation**. Many countries requiring legalisation are signatories of the **Hague Convention** and are satisfied with the application of the **Apostille**. However, there are others that demand legalisation at a consulate or embassy – a major trial if the country in question doesn’t happen to have a consulate or embassy in the country in which the documents need to be signed. Mercifully, most major countries no longer need legalisation.

linking of content on the Internet Legal or not? If the linked content is in the public domain, or is freely available, linking is generally OK, particularly if the linking is not for commercial purposes. However, commercial purposes can be problematic, so the specific situation needs to be considered.

letters patent The official grant certificate of a patent. The date of this grant is the beginning of the legally-enforceable monopoly.

licensing Giving someone else the right to produce a design (not necessarily registered, but advantageously so) for a monetary return (generally a down payment and a percentage royalty based on sales). The licensor continues to own all rights to the design.

logos can now be protected by registered designs in some places, e.g. the EU and the UK. Although designs don’t last as long, registration is very quick, making enforceable protection against infringers available within weeks. Best protection is obtained by having both.

mandamus See **writ**. Also **Latin**

marking In some countries, the marking of articles with a design registration number is compulsory. With **copyright**, marking is very important, and takes the form

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“master and servant” British **common law** principles that decide who has the right to ownership of an invention in an employer/employee situation. They probably also apply to designs. The basic position is that, if an employee makes an invention related to the company’s business interests in company time, using company materials and it can reasonably be said that part of the employee’s duties is to invent, that invention belongs to the company. The basic principles hold good in most places, but the right of the company to inventions is usually enshrined in the contract of employment.

MERCOSUR (*Mercado Común del Sur*) Latin American free trade organisation, member states, Argentina, Brazil, Paraguay, Uruguay (and recently Bolivia). A regional patent organisation has been proposed, with the Brazilian Office acting as the central office. Nothing has ever come of it.

mere conduit defence Under the **EU** E-Commerce Regulations of 2002, network providers have no legal liability for the consequences of traffic delivered via their networks.

Middle East A very mixed bag with respect to IP, ranging from Israel, which has a well-organised and good-functioning European-type system, to Qatar, where “protection” is obtained by publishing cautionary notices in a local newspaper. However, interest is gradually stirring – some of the conservative Gulf monarchies have joined the Paris Convention, and the **GCC** (Gulf Cooperation Council) patent system is a major step forward.

Formerly, all the Arab states required the signing of the **boycott declaration** as a condition of IP protection. This has fallen into nearly complete disuse – even Syria, home of the Central Boycott Office, no longer requires it (but Iraq now does).

moral right Rights of creators of works subject to copyright, even if the copyright has been assigned or sold to a third party. They include the right of attribution, the right to have a work published anonymously or pseudonymously and the right to the integrity of the work. It is more extensive in civil law countries.

MPEP Manual of Patenting Examining Practice, the Bible of the Examiners of the **USPTO**. Most patent offices have similar manuals, available publicly.

Music Modernization Act. Recently-passed US legislation dealing with the realities of streaming and loss of income by songwriters/performers. It is actually a combination of the original MMA and the **CLASSICS** (Compensating Legacy Artists for their Songs, Service and Important Contributions to Society) Act. It proposes to extend the copyright of all pre-1972 music to 2067 – meaning that a 1927 song would have a copyright life of 140 years).

“new and original” A registered design must be new and original, that is, it must present to the eye a unique appearance. How unique is “unique” is a matter for each case and each country. Some (few) countries consider newness only with reference to what is known and used in those countries, most consider what is known and used elsewhere (a sort of equivalent to patent law’s “absolute novelty”).

newspaper advertisement Formerly in some countries, particularly in the Middle East, the only way to obtain some sort of IP protection was to place a cautionary notice in a local newspaper. This has now virtually died out, only Qatar maintaining the system.

non-Con filing Foreign filing of a design application without claiming **Convention priority**, usually applied to applications filed outside the priority year for reasons of late decision, etc. The **filing date** is the actual filing date in the country.

notarisation Signing documents before a notary public, who, after receipt of identification, witnesses that the signatories are who they say they are. The necessary first step to **legalisation**. Thankfully, not necessary for most places.

novelty; acts not constituting publication Generally there are only two of these, publication of a design prior to application without the proprietor’s permission, and presentation of the design at an **International Exhibition**. In both cases, the proprietor must file within 6 months.

OAPI *Organisation Africaine de la Propriété Industrielle*. African Regional Office covering the countries of French-speaking Africa (Burkina Faso, Benin, Central African Republic, Chad, Congo, Côte d’Ivoire, Cameroon, Gabon, Guinea, Equatorial Guinea, Guinea-Bissau, Mali, Mauritania, Niger, Senegal, Togo). Can be designated in a **Hague Agreement** application. OAPI designs are unitary, covering all OAPI countries; it is not possible to select particular countries and ignore others.

obviousness What, you might ask, is a consideration of obviousness doing here? (On the other hand, you might not, but anyway...). Well, in the USA, one gets a design patent, meaning that the US patent laws apply to designs. It is judged by the eye if the “designer of ordinary skill in the art”. When assessing the potential obviousness of a design patent, a finder of fact employs two distinct steps: first, find a single primary prior art reference with design characteristics that are basically the same as the claimed design; and second, once the primary reference is found, other references may be used to modify it to create a design that has the same overall visual appearance as the claimed design. It actually sounds a bit like the EPO’s “problem-solution” approach.

official (or office) action The name used in the patent profession for an official correspondence from a patent office commenting on a design application and requiring a response.

OHIM (Office for the Harmonisation of the Internal Market). See **European Union Intellectual Property Office**.

opposition Patent Office procedure that allows third parties to object to the registration of a design. Cheaper and simpler than court action.

orphan work A work whose authorship (and therefore whose copyright status) is indeterminate. Many countries have state licensing schemes to handle them. In the US, in the copyright case *Authors Guild v. Google*, the Authors Guild attempted (and failed) to stop Google’s making available the contents of orphan works, the judge holding that Google met all the conditions for **fair use**.

overseas/dependent territories, protection in IP rights in a country often also apply to at least some of its overseas territories. Some examples:

French patent – DOMs (Overseas *Départments*) (Guadeloupe, Martinique, Réunion and French Guyana), TOMs (Overseas Territories) (French Polynesia, Wallis and Futuna, the French Austral Islands and the French Antarctic territories), in *Collectivités Territoriales* (St Pierre et Miquelon, Mayotte) and in New Caledonia and dependencies.

UK patent – British Indian Ocean Territory, Swaziland (see **registration**)

Dutch patent - Sint Maarten, Curaçao, Bonaire, Sint Eustatius and Saba,

USA – Guam, Puerto Rico, US Pacific Islands, US Virgin Islands.

parallel importation Parallel importation generally arises more in the trade marks area, but in a design sense, it is the import into a country by someone other than the owner or his or her agent in the country of articles covered by a design in that country and legitimately acquired outside the country. Allowable? Generally no, but there are exceptions. In the BBS “Aluminium Wheels” patent case, the Japanese Supreme Court held that BBS could not stop the importation of patented BBS wheels by a non-agent.

One particular patent case arises in the **EU**, and involves the purchasing of patented goods in one EU state and reselling in another where there is an equivalent patent. In most EU countries, the equivalent patent cannot be used to stop the importation, because the patent right is deemed “exhausted” in all EU member states once a sale has been made anywhere in the EU. This is particularly prevalent in the pharmaceutical industry, in which the ease of transport of high-value drugs and the price differentials in various countries caused by national policies can make such transport and sale worthwhile.

Paris Convention 1883 treaty which regulates international industrial property affairs. One basic principle is that a foreign applicant for an industrial property right in a Convention country should receive treatment equal to that accorded to a local of that country. Part of this is the concept of **Convention priority**. Current membership (May 2013) 174 states, significant non-member, Taiwan.

parody Can parody be an infringement of copyright? It depends on where. For example, the US Constitutional right to free speech permits much more than would be permitted in the UK, where a copyright owner has to give permission for a parody.

passing off action A legal action at **common law** seeking to prevent the “passing off” of the alleged infringer’s goods as genuine goods. Applicable only to non-statutory rights (trade marks, unregistered design right). For success, a court has to be satisfied that the complainant has suffered damage to his or her business and/or reputation (not always easy to do).

patent agent (a) Former British name for a **patent attorney**. Only practitioners who have passed the examinations of the Chartered Institute of Patent Attorneys (formerly Agents) are entitled to call themselves patent attorneys. (b) In those countries in which an “attorney” must be qualified in law, a patent practitioner who does not have a law degree, but who has passed a patent exam. The only practical difference is that the patent agent cannot represent clients in court, but in **private practice**, it makes a big difference in pay and prestige.

patent attorney Legal professional who works in the field of patents and is entitled represent clients before a national or regional patent office, and in some cases (UK, Germany) before specialised patent courts. The name means different things in different countries. In some countries (e.g., USA, S.Africa), the title “attorney” is restricted to qualified lawyers. On the other hand, a European Patent Attorney requires a pass in the European Qualifying Examination, but no law degree. See *Patentanwalt*

patent office General term for Government body charged with the granting of IP rights. The term is a misnomer; all patent offices also handle trade marks, designs, and, where available, plant variety rights and semiconductor protection. Many offices, e.g., the UK’s, now style themselves “Intellectual Property Office”.

Patents County Court British specialised court for hearing simple intellectual property matters. Relatively cheap and quick. Patent attorneys and **solicitors** can appear before it – no need for a **barrister**.

Patentanwalt German for **patent attorney**. In Germany, the title is used only for private practice **patent attorney**. The industry equivalent is a *Patentassessor*. The only difference is that one works in industry and the other in the private profession. Both have to do training periods in the German Patent Office, the *Bundespatentgericht* and private practice and do the same set of exams. Both are entitled to represent clients before the *Bundespatentgericht*. In Switzerland, as of 1 July 2011, it is a protected title, and only appropriately-qualified people on an official register can use the title.

Patentassessor See previous entry.

perfume Can it be the subject of copyright? French courts, including the top court, the *Cour de Cassation*, have held no, whereas Dutch courts in the *Lancôme* decision held yes. The problem is that, unlike other works, such as music and literature, whose form is set down identically for all to read, perfumes are perceived differently by different people, so the expression of the idea is never the same.

personality right See **right of publicity**.

'phone wars Mammoth patent struggle between the goliaths of the mobile phone world, primarily Apple and Samsung, although Apple's real target is certainly Google and its Android system. One issue is Apple's attempt to stop sales of Samsung's tablet computer, partially on **design** aspects. This has had only partial success, partially (in the UK) because of Apple's clearly "cooler" design.

photographs Often used as illustrations in design applications.

postal problems Patent Offices have procedures for dealing with documents lost in the post, but only for things sent by registered mail. A good feature of US practice is that an application is deemed filed as of the moment it is presented to and stamped by the US Postal Service, for delivery by registered mail. In the case of wider postal disruption, e.g., strikes or natural disasters, patent offices can extend periods for lodging applications or other documents. These are usually gazetted.

precedent A previous legal instance which is taken as an example or a rule in a similar case. Especially important in **common law** jurisdictions, in which a lower court will only deviate from a ruling of a higher court if the facts are appreciably different.

preliminary injunction Injunction allowing rapid stop of alleged infringement. For award of such an injunction, plaintiff must establish that s/he is likely to succeed on the merits, that s/he is likely to suffer irreparable harm in the absence of preliminary relief, that the balance of equities tips in his/her favor, and that an injunction is in the public interest

prior art search Before filing a design application, it is essential to know (as well as you can) what is already out there, so a prior art search is an essential first step. Easily arranged.

prior user rights See **USA**

priority Should two people independently come up with the same design, the design is deemed to belong to the person who got there first; he is said to have "priority". The definition of "got there first" recognised by most of the world is the earlier date of filing of an application (the "first to file" system). The USA previously used an entirely different system, the "first to invent" system, but this ended with the **AIA**. Under the provisions of the **Paris Convention**, priority may be recognised internationally (see next item). As of 1st. January, 2000, PCT recognises the priority of patent applications originating from **WTO** members which are not signatories of the Paris Convention. This will allow priority to be claimed from, e.g., a Pakistani application.

priority, Convention See **Convention priority**.

priority application A first application whose filing date is claimed as **priority date** in a subsequent filing, most often in a **foreign filing** situation .

priority date The date of filing of a **priority application**. In a **Convention application** for a design, this date is regarded as the date of filing in another Convention country, provided that the filing is made within 6 months of the priority date and priority is claimed.

priority document First application from which priority is claimed. Certified copy must be lodged in order to claim priority in a **foreign filing** application.

priority period The six months which starts on the date of first application and the end of which is the deadline for filing foreign **Convention** applications, if **Convention priority** is to be claimed.

priority right Simply, the right to claim priority, which is part of filing a patent application under the **Paris Convention**. As most inventors are employees, the right passes to the employer either as part of the employee's employment contract, or by means of **assignment**. If an inventor is not an employee (e.g., a consultant or a contractor) the right to file a patent application must be obtained from him or her by assignment. This must be done prior to filing a **Convention application**. If it is not done, the applicant may lack right of priority for that inventor's contribution.

private practice One or more patent attorneys operating independently and able to work for a variety of clients. In French and German, the private profession is called the "free profession". Nothing could be further from the truth...

privilege In many (but not all) countries in which patent attorneys are not lawyers, communications between patent attorney and client are considered privileged (not subject to being produced in a court of law to the detriment of the client) to the same extent as are communications between solicitor/lawyer and client. However, this is not universally applicable, and in cases of doubt, expert opinion should be sought.

prosecution The effort to persuade a Patent Office to register a design. (See **examination**).

public use of a design prior to filing a registration application **Not** recommended unless you intend to file only in countries with a **grace period**. In many countries, such as the European countries, this will destroy any chance of registration.

publication This word is used in two senses with respect to designs:

(a) The publication of a design application by a patent office. This usually happens on registration, or for the purposes of opposition.

(b) The disclosure of your design to the public in such a way that it is no longer new or original and you can no longer register it. Ideally, the application should be on file before any kind of disclosure to anyone is made.

Some things not regarded as publications destruction of newness in various countries are:

- exhibiting at a certified international exhibition - application to be filed within 6 months of the opening of the exhibition (universal);

- disclosure of the invention by a third party in contravention of the rights of the applicant - application to be filed within 6 months of the publication (universal);

- use in public for purposes of reasonable trial, where that use was unavoidably in public - application to be filed within one year of trial (old British, now rare).

publicity right See **right of publicity**

QC Queen's Counsel – see **barrister**.

“Raising the bar” Australian revision to IP laws, entering into force on 15 April 2013. It seeks to make Australian standards compatible with generally-recognised International ones

registration in dependent/overseas territories See **overseas/dependent territories, protection in**

renewal fee Fee required to keep a registered design in force. The **Paris Convention** provides a 6-month **grace period** for their late payment (usually with extra fees).

restitution of designs Another name for restoration of patents/applications that have inadvertently been allowed to lapse. See next entry.

restoration of designs Design registrations or applications that have been inadvertently allowed to lapse can be restored. However, the hurdles to be jumped are very high. The applicant for restoration must show that (a) lapse was not intended (not a decision to allow to lapse, followed by a change of mind), and (b) lapse came about as the result of an inadvertent error in an otherwise well-functioning system of deadline oversight. Restoration can usually be obtained only for a certain time after lapse.

revocation The cancellation of a registration after legal action seeking its invalidation. Generally this is as a result of court action, but in some post-grant **opposition** countries (e.g, the UK), an opposition before the Patent Office is called revocation. Revocation is possible (but rare) for non-**working**.

right of publicity (sometimes called personality rights) The rights of individuals, especially those in the public eye, to prohibit misuse of their images in connection with commercial activities in which they are not involved, and to which they have not given permission. This issue has exploded with the increase in use of digital technology. It can continue after death (e.g., a recent case in which General Motors was taken to court by the Hebrew University of Jerusalem because of the former's use of the image of Albert Einstein, the latter being the inheritor of Einstein's literary rights and property). However, it is not governed by either trade mark or copyright laws, and there is no official expiry date (although some US states use the old copyright term of 50 years from the date of death).. In the USA, in which the whole business has taken off on a large scale, it is largely governed by **common law** and may be the subject of a **passing off action**. However, the various US states have their own interpretations.

It is generally considered to consist of two types of rights: the right of publicity, or to keep one's image and likeness from being commercially exploited without permission or contractual compensation, which is similar to the use of a trade mark; and the right to privacy, or the right to be left alone and not have one's personality represented publicly without permission.

It works differently in civil law jurisdictions, e.g. Germany, where the right is written into the law. Curiously, the world's only registrable personality and image rights legislation has been enacted in Guernsey (Channel Islands).

“rocket docket” US court proceedings that proceed to completion very quickly, usually by strict adherence to filing deadlines. In patent matters, the US District Court for the Eastern District of Texas established a reputation for quickly bringing matters to trial and having a plaintiff-friendly percentage much higher than the national average. One of the major cases held there was *Microsoft v. i4i*, over the use of XML documents in Microsoft Office.

rule of reason A consideration in US **antitrust** cases. It holds that only combinations and contracts unreasonably restraining trade are subject to provisions under antitrust law. Possession of monopoly power is not in itself illegal. The doctrine was developed by the US Supreme Court in applying the Sherman Antitrust Act in the famous case of *Standard Oil v. USA*, which broke up the Rockefeller Standard Oil empire.

saisie-contrefaçon French method of obtaining proof of infringement. It permits the holder of an intellectual property right, upon receiving the authorisation of a judge, to call upon a bailiff (in certain cases, a police commissioner or a judge) to record an infringement. The order authorises the requesting party to dispatch the bailiff of its choice, possibly accompanied by an expert of its choice or by a member of the police force, to any place where proof of the infringement might be found, to make either a detailed description of alleged infringements or a physical seizure of them. The bailiff records the operations performed. Frequently used.

Sarbanes-Oxley Act In full, the *Public Company Accounting Reform and Investor Protection Act*. US legislation enacted in the wake of a series of US corporate and accounting scandals, most notoriously the Enron affair. It sets new standards in accounting practices for public companies. Among other requirements, the Act requires a public company to provide enhanced disclosure in its filings with the U.S. Securities and Exchange Commission of matters that materially affect, or are likely to have a material impact on, its business and financial performance. This includes IP assets, whose values should realistically be assessed.

search report Report produced by a patent office, giving details of the **prior art** found by the office and on which the office will rely during **prosecution**. Many offices now demand to see search reports of other offices.

secrecy In most countries, it is essential that secrecy or confidentiality be maintained prior to the application for a patent, as prior **publication** may invalidate any patent granted (see **oral disclosure**, **public use**, **grace period**). If working, e.g. commercial trials, has to take place before third parties, a secrecy agreement should be obtained.

secrecy order see **national security**.

seizure of infringing goods In some countries, it is possible, on presentation of suitable evidence, to get a court order to seize infringing goods. The seizure may be enacted by the police or, in the case of imported infringing goods, Customs officers.

small entity status In some countries (e.g., Canada, USA), individuals, non-profit organisations and for-profit companies having fewer than a specified low number of employees (500 in the USA) are classified as small entities and qualify for reductions in some official fees (50% in the case of some fees). However, as small entities are the people least likely to have in-house patent counsel, they will need private attorneys who generally charge everyone the same, so the small entity status may not help much. The *AIA* has introduced a further micro-entity category, eligible for a 75% reduction.

solicitor In British-type legal systems, a lawyer who engages in general legal work and who prepares cases for court, but provides them to a **barrister** for presentation in court.

Sonny Bono Act Technically the *Copyright Term Extension Act* of 1998. US legislation named for its prime mover, US Congressman and ex-singer Sonny Bono (he got you, babe). It substantially increased US copyright term to 95 years (and in some cases to an absurd 120 years). It is often derisively known as the Mickey Mouse Act, because it extended Disney's copyright on the character (Disney lobbied hard for it). Unlike the EU's equivalent Copyright Extension Act (the so-called **Cliff Richard Act**, named for the British singer who pushed hard for it), it did not extend the copyright of works already in the public domain because their previous copyright term had finished.

statute law Law enacted by a legislature. This generally covers patent law, but issues at **equity** can arise in **common law** countries.

Statute of Anne UK 1709 legislation, which was the world's first true Copyright Act. It covered written works only.

statutory bar US legal term for a specific act that will bar an inventor from obtaining a patent on an invention. Acts include the **publication** of the invention or its use or placing on sale more than one year before the US filing (the **US grace period** is the reason for the year).

streaming Depending on what is being streamed, can be problematic from a copyright point of view. In the recent US **Supreme Court** decision in *ABC v. Aereo*, a service that streamed television programmes to subscribers minutes after their original broadcast was held to infringe copyright.

summary judgement Judgement (usually in a **common law** country) given by a judge for one party against another without resorting to a full trial. It may be on the complete case or on discrete issues in the case. Rare in IP cases, but can happen, if a judge thinks s/he has sufficient material (as in *Virgin Atlantic v. Delta*)

Supreme Court The highest court of a country and the ultimate interpreter of national IP law. Its judgements are binding on all lower courts. In the US in particular, the ability of Supreme Courts to pass sensible judgements on matters of patent law has been called into question.

Taiwan The major non-member of the **Paris Convention**. Initially, this suited the Taiwanese, because it allowed them to make fake Rolex® watches and Louis Vuitton® handbags to their hearts' content. However, Taiwan is now a respectable major economy in its own right, but it is careful not to do anything which could look like a declaration of independence to Another Large Chinese-Speaking Country not a million miles away. Taiwan has bilateral treaties with some countries (e.g., USA, Australia, Germany, UK, Switzerland), wherein there is mutual recognition of each other's filings for **priority** purposes, and Taiwan now has a **PPH** arrangement with the **USPTO**. As a result, the consequences of Taiwan's becoming a **WTO** member (in January, 2002) are currently not noticeable, but that may change with time.

tattoo Is a tattoo capable of copyright? Apparently yes. A recent attempt in a computer game to reproduce the authentic tattoos of famous sportsmen and -women was held to be copyright infringement.

temporary import of registered design The design registration in a particular country is not infringed by the temporary entry into the country of the invention on a vehicle, ship or aircraft from a second country in which the use is legitimate (e.g., there is no registration or the registration is owned by someone else who has permitted the use).

term The length of time for which a design registration/patent lasts, usually dated from application date. Term varied from 10 years (Australia, New Zealand) through the USA (14 years) to Europe (25 years).

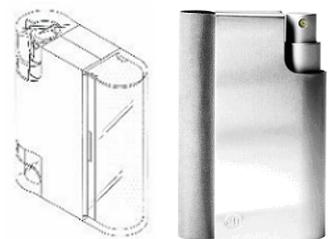
Copyright is guaranteed a minimum 50-year term under the **Berne Convention**. However, some countries allow longer – up to 95 years in the USA under the **Sonny Bono Act**. The proposed **Trans-Pacific Partnership** is proposing a 70-year term.

threats To be avoided when writing to alleged infringers. Use of unjustified threats can allow the alleged infringer to sue you.

tort A civil wrong in **common law**. A person committing a tortious act is a tortfeasor. Causing loss or harm in a patent matter is a tort, but it is generally governed by **statute law**. In the relatively few cases where this doesn't apply, the tort is actionable at common law, like any other.

trade mark Type of **intellectual property** covering words and symbols that are the exclusive property of the trade mark proprietor. They are renewable every 10 years and last forever, if properly cared for.

trade mark, infringed by design Is this possible? Yes. In a recent case, the **General Court** held that the design on the left (for cleaning products) infringed the shape trade mark on the right (ditto)



traditional knowledge, genetic resources and traditional cultural expressions/folklore

(TK) Knowledge that has arisen within and that is a part of particular communities, especially of indigenous peoples. Prior to the recognition of the existence of this knowledge, it was all too easy for more “advanced” societies and organisations to misappropriate such knowledge, for example, to isolate the working principle of a traditional medicine known for generations and patent it. The concept of TK as **intellectual property** is in its infancy and there is as yet no universal legal framework for registration and/or protection (China grants patents for traditional medicines). However, **WIPO** is heading efforts to protect TK, to see that its owners are rewarded and to place it in the hands of patent offices as **prior art** (in one case, ancient Sanskrit texts were used in the invalidation of a US patent claiming the use of turmeric for wound healing).

Recently, it has been suggested that the importance of TK has been greatly exaggerated, and perhaps even exploited – see, for example:

<http://ipkitten.blogspot.be/2015/07/indias-claims-to-traditional-knowledge.html>

transformative work In copyright law, a work based on an earlier work, but sufficiently changed from it that it constitutes fair use. The concept originated in US copyright law, and typical examples include combinations of previous works, fan-fiction based on favourite television shows, remixes, etc. The position of such works is not so clear in other national laws.

transitional provisions Provisions in a new law that provide special exceptions for cases pending under the old law, which might otherwise be disadvantaged. In the case of patent legislation, they typically provide that the conditions of the old law will continue to apply to pending patent applications, at least to some extent. For example, the USA once had a patent term of 17 years from grant. When a new law giving 20 years from application came in, applications pending under the old law were given a term of the longer of 17 years from grant and 20 years from application.

Trans-Pacific Partnership (TPP) Proposed controversial trade agreement between 12 Pacific Rim countries, seeking to lower trade barriers and establish common frameworks in certain laws, among them intellectual property. Seen by some as a US attempt to counter the growing power and influence of China in the region, much of the negotiation has been in secret. The leaked IP provisions have been especially controversial, with the US appearing to be potentially the big beneficiary. Poorer countries, as always, appear to get the short end of the stick. One proposal is a 70-year term for copyright.

travaux préparatoires Literally, “preparatory works”. The preparatory papers setting out positions prior to a diplomatic conference leading to the creation or the modification of an International Convention. Continental jurisprudence often goes back to them, to find out what was originally intended, in contrast to British/US-type law, which interprets the words of an article or rule according to their ordinary meanings as they sit on the page.

Treaty of Rome Treaty that is the founding document of the **European Union**. Its basic principle of free movement of goods and services across national borders raises an inherent conflict with patent rights, which seek to impose national monopolies. As a result, where patent rights conflict with the Treaty, especially where they are seen to distort free trade, they cannot be exercised. In the particular case of patent licence agreements, which are theoretically in breach of Art.81, those that meet certain conditions and that lack certain specific objectionable clauses are permitted under a so-called “block exemption”, that is, they need not be notified to the EU authorities for permission.

Twitter Are tweets protectable by copyright? If suitably original, apparently yes.

unregistered design right See **design right**

USA With respect to design patents, the US law isn’t so bizarre as is the country’s patent law. The basic principles are the same as those elsewhere, the differences lying in the grant of a design patent, as opposed to a design registration, and the 15-year term, with no renewal fees payable during it. As the USA grants design **patents**, the **AIA** is also applicable to these. Most of the arguments about the AIA have concerned utility patents, and design patents have rarely, if ever, been mentioned. Yet design patents in the USA are becoming more important (see the great Apple v. Samsung tablet wars). To what extent the new AIA provisions will affect design registrations remains to be seen.

USPTO The United States Patent and Trademark Office.

wifi Many public places provide free wifi. Is the network liable if a user violates copyright (for example, downloads a film)? Generally, no, the **mere conduit defence** applies, but the provider of the network may be required to password-protect it (thus saith the **CJEU** in *McFadden v. Sony*).

WIPO World Intellectual Property Organisation, specialised UN agency dealing with all aspects of intellectual property (patents, trade marks, designs, copyright, circuit layouts, software protection, confidential information, traditional knowledge), headquarters Geneva. Custodian of the **Paris Convention** and operator of the **Hague Agreement**.

WIPO Copyright Treaty (WCT) Treaty adopted by member states of WIPO. It seeks to provide additional protections for copyright deemed necessary as a result of advances in information technology. Among the things protected are computer programs and database contents.

working In order to remain valid, a design should be worked in the country in which it is registered. The **Paris Convention** provides penalties for non-working (**compulsory licensing**, then **revocation**) which are rarely invoked. Some Third World countries (e.g. India) have stiffer requirements, which require the applicant to file working statements, giving details of working, or if none, why not.

World Trade Organisation (WTO) UN specialised agency set up as a result of the Uruguay Round of GATT. Its provisions include the intellectual property aspects of trade called **GATT-TRIPS**. Current membership (May 2013) 159. As of 1st. January, 2000, the **priority** of patent applications of WTO members is recognised by the **PCT**, even if the member in question is not a member of the **Paris Convention** (e.g., Taiwan, Pakistan, Kuwait).

writ. Old term for an official order under English **common law**, directing the behavior of another arm of government, such as an agency, official, or other court. The two most commonly encountered in the world of intellectual property are:

certiorari - a court process to seek judicial review of a decision of a lower court or administrative agency.

mandamus – an order issued by a higher court to compel or to direct a lower court or a government officer to perform mandatory duties correctly

WTO See **World Trade Organisation**.

APPENDIX A

The Locarno Classification System

See

<http://www.wipo.int/classifications/nivilo/locarno/index.htm?lang=EN#>

for full details

- Class 1: FOODSTUFFS
- Class 2: ARTICLES OF CLOTHING AND HABERDASHERY
- Class 3: TRAVEL GOODS, CASES, PARASOLS AND PERSONAL BELONGINGS, NOT ELSEWHERE SPECIFIED
- Class 4: BRUSHWARE
- Class 5: TEXTILE PIECEGOODS, ARTIFICIAL AND NATURAL SHEET MATERIAL
- Class 6: FURNISHING
- Class 7: HOUSEHOLD GOODS, NOT ELSEWHERE SPECIFIED
- Class 8: TOOLS AND HARDWARE
- Class 9: PACKAGES AND CONTAINERS FOR THE TRANSPORT OR HANDLING OF GOODS
- Class 10: CLOCKS AND WATCHES AND OTHER MEASURING INSTRUMENTS, CHECKING AND SIGNALLING INSTRUMENTS
- Class 11: ARTICLES OF ADORNMENT
- Class 12: MEANS OF TRANSPORT OR HOISTING
- Class 13: EQUIPMENT FOR PRODUCTION, DISTRIBUTION OR TRANSFORMATION OF ELECTRICITY
- Class 14: RECORDING, COMMUNICATION OR INFORMATION RETRIEVAL EQUIPMENT
- Class 15: MACHINES, NOT ELSEWHERE SPECIFIED
- Class 16: PHOTOGRAPHIC, CINEMATOGRAPHIC AND OPTICAL APPARATUS
- Class 17: MUSICAL INSTRUMENTS
- Class 18: PRINTING AND OFFICE MACHINERY
- Class 19: STATIONERY AND OFFICE EQUIPMENT, ARTISTS' AND TEACHING MATERIALS
- Class 20: SALES AND ADVERTISING EQUIPMENT, SIGNS
- Class 21: GAMES, TOYS, TENTS AND SPORTS GOODS
- Class 22: ARMS, PYROTECHNIC ARTICLES, ARTICLES FOR HUNTING, FISHING AND PEST KILLING
- Class 23: FLUID DISTRIBUTION EQUIPMENT, SANITARY, HEATING, VENTILATION AND AIR-CONDITIONING EQUIPMENT, SOLID FUEL
- Class 24: MEDICAL AND LABORATORY EQUIPMENT
- Class 25: BUILDING UNITS AND CONSTRUCTION ELEMENTS
- Class 26: LIGHTING APPARATUS
- Class 27: TOBACCO AND SMOKERS' SUPPLIES
- Class 28: PHARMACEUTICAL AND COSMETIC PRODUCTS, TOILET ARTICLES AND APPARATUS
- Class 29: DEVICES AND EQUIPMENT AGAINST FIRE HAZARDS, FOR ACCIDENT PREVENTION AND FOR RESCUE
- Class 30: ARTICLES FOR THE CARE AND HANDLING OF ANIMALS
- Class 31: MACHINES AND APPLIANCES FOR PREPARING FOOD OR DRINK, NOT ELSEWHERE SPECIFIED
- Class 32: GRAPHIC SYMBOLS AND LOGOS, SURFACE PATTERNS, ORNAMENTATION

APPENDIX B

The Hague Agreement for the international registration of designs

The Hague Agreement is a slightly complicated affair. It is actually constituted by three different Acts. These are

- The London Act (1934), entered into force in 1939
- The Hague Act (1960), entered into force in 1984
- The Geneva Act (1999), entered into force in 2003.

Details as to who signed what and when are shown in Appendix C.

The application of the 1934 Act has been frozen since 1 January 2010, so the two effective Acts are the 1960 and 1999 Acts. Countries that have signed up only to, say, the 1960 Act, cannot designate countries that have only signed up to the 1999 Act, and *vice versa*. For example, a Danish applicant (1999 Act only) cannot file an International application designating the Benelux countries (currently 1960 Act only) – but of course there is now a Community Design legislation covering all EU members.

The whole affair has a parallel in the Madrid Agreement/Protocol for International trade mark filings. The 1960 Act was set up for countries that allowed relatively quick registration – countries with stiffer examination requirements could not meet the provisions of the 1960 Act. The 1999 Act was introduced to overcome this, and to permit the entry of these stiffer examination countries. The two Acts have a common set of regulations.

APPENDIX C

The Contracting States of the Hague Agreement

7. Hague Agreement Concerning the International Registration of Industrial Designs¹

Hague Agreement (1925), revised at London² (1934), at The Hague (1960)³ (supplemented by the Additional Act of Monaco (1961)², the Complementary Act of Stockholm (1967) amended in 1979, and the Protocol of Geneva (1975)),⁴ and at Geneva (1999) (Hague Union)

Status on December 14, 2023

State/IGO	Date on which State/IGO became party to the Agreement	Date on which State became party to the Hague Act ⁵	Date on which State became party to the Complementary Act of Stockholm	Date on which State/IGM became party to the Geneva Act
African Intellectual Property Organization (OAPI)				
Albania	September 16, 2008	–	–	September 16, 2008
Albania	March 19, 2007	March 19, 2007	March 19, 2007	May 19, 2007
Armenia	July 13, 2007	–	–	July 13, 2007
Azerbaijan	December 8, 2010	–	–	December 8, 2010
Belarus	July 19, 2021	–	–	July 19, 2021
Belgium ⁷	April 1, 1979	August 1, 1984	May 28, 1979	December 18, 2018
Belize	July 12, 2003	July 12, 2003	July 12, 2003	February 9, 2019
Benin	November 2, 1986	November 2, 1986	January 2, 1987	–
Bosnia and Herzegovina	December 24, 2008	–	–	December 24, 2008
Botswana	December 5, 2006	–	–	December 5, 2006
Brazil	August 1, 2023	–	–	August 1, 2023
Brunei Darussalam	December 24, 2013	–	–	December 24, 2013
Bulgaria	December 11, 1996	December 11, 1996	December 11, 1996	October 7, 2008
Cambodia	February 25, 2017	–	–	February 25, 2017
Canada	November 5, 2018	–	–	November 5, 2018
China ⁶	May 5, 2022	–	–	May 5, 2022
Côte d'Ivoire	May 30, 1993	May 30, 1993	May 30, 1993	–
Croatia	February 12, 2004	February 12, 2004	February 12, 2004	April 12, 2004
Democratic People's Republic of Korea				
Denmark	May 27, 1992	May 27, 1992	May 27, 1992	September 13, 2016
Denmark	December 9, 2008	–	–	December 9, 2008 ⁷
Egypt	July 1, 1952	–	–	August 27, 2004
Estonia	December 23, 2003	–	–	December 23, 2003
European Union	January 1, 2008	–	–	January 1, 2008
Finland	May 1, 2011	–	–	May 1, 2011
France ⁸	October 20, 1930	August 1, 1984	September 27, 1975	March 18, 2007
Gabon	August 18, 2003	August 18, 2003	August 18, 2003	–
Georgia	August 1, 2003	August 1, 2003	August 1, 2003	December 23, 2003
Germany	June 1, 1928	August 1, 1984	September 27, 1975	February 13, 2010
Ghana	September 16, 2008	–	–	September 16, 2008
Greece	April 18, 1997	April 18, 1997	April 18, 1997	February 13, 2024
Hungary ⁹	April 7, 1984	August 1, 1984	April 7, 1984	May 1, 2004
Iceland	December 23, 2003	–	–	December 23, 2003
Israel	January 3, 2020	–	–	January 3, 2020
Italy	June 13, 1987	June 13, 1987	August 13, 1987	March 14, 2024
Jamaica	February 10, 2022	–	–	February 10, 2022
Japan	May 13, 2015	–	–	May 13, 2015
Kyrgyzstan	March 17, 2003	March 17, 2003	March 17, 2003	December 23, 2003
Latvia	July 26, 2005	–	–	July 26, 2005
Liechtenstein	July 14, 1933	August 1, 1984	September 27, 1975	December 23, 2003
Lithuania	September 26, 2008	–	–	September 26, 2008
Luxembourg ³	April 1, 1979	August 1, 1984	May 28, 1979	December 18, 2018
Mali	September 7, 2006	September 7, 2006	September 7, 2006	–
Mauritius	May 6, 2023	–	–	May 6, 2023
Mexico	June 6, 2020	–	–	June 6, 2020
Monaco	April 29, 1956	August 1, 1984	September 27, 1975	June 9, 2011
Mongolia	April 12, 1997	April 12, 1997	April 12, 1997	January 19, 2008
Montenegro	June 3, 2006	June 3, 2006	June 3, 2006	March 5, 2012
Morocco	October 20, 1930	October 13, 1999	October 13, 1999	July 22, 2022
Namibia	June 30, 2004	–	–	June 30, 2004
Netherlands (Kingdom of the) ⁵	April 1, 1979	August 1, 1984 ¹⁰	May 28, 1979 ¹⁰	December 18, 2018 ¹⁰
Niger	September 20, 2004	September 20, 2004	September 20, 2004	–

State/IGO	Date on which State/IGO became party to the Agreement	Date on which State became party to the Hague Act ³	Date on which State became party to the Complementary Act of Stockholm	Date on which State/IGO became party to the Geneva Act
North Macedonia.....	March 18, 1997	March 18, 1997	March 18, 1997	March 22, 2006
Norway.....	June 17, 2010	–	–	June 17, 2010
Oman.....	March 4, 2009	–	–	March 4, 2009
Poland.....	July 2, 2009	–	–	July 2, 2009
Republic of Korea.....	July 1, 2014	–	–	July 1, 2014
Republic of Moldova.....	March 14, 1994	March 14, 1994	March 14, 1994	December 23, 2003
Romania.....	July 18, 1992	July 18, 1992	July 18, 1992	December 23, 2003
Russian Federation.....	February 28, 2018	–	–	February 28, 2018
Rwanda.....	August 31, 2011	–	–	August 31, 2011
Samoa.....	January 2, 2020	–	–	January 2, 2020
San Marino.....	January 26, 2019	–	–	January 26, 2019
Sao Tome and Principe.....	December 8, 2008	–	–	December 8, 2008
Senegal.....	June 30, 1984	August 1, 1984		June 30, 1984
Serbia.....	December 30, 1993	December 30, 1993	December 30, 1993	December 9, 2009
Singapore.....	April 17, 2005	–	–	April 17, 2005
Slovenia.....	January 13, 1995	January 13, 1995	January 13, 1995	December 23, 2003
Spain.....	June 1, 1928	–	–	December 23, 2003
St. Kitts and Nevis.....	July 8 2024			October 8 2024
Suriname.....	November 25, 1975	August 1, 1984	February 23, 1977	September 10, 2020
Switzerland.....	June 1, 1928	August 1, 1984	September 27, 1975	December 23, 2003
Syrian Arab Republic.....	May 7, 2008	–	–	May 7, 2008
Tajikistan.....	March 21, 2012	–	–	March 21, 2012
Tunisia.....	October 20, 1930	–	–	June 13, 2012
Türkiye.....	January 1, 2005	–	–	January 1, 2005
Turkmenistan.....	March 16, 2016	–	–	March 16, 2016
Ukraine.....	August 28, 2002	August 28, 2002	August 28, 2002	December 23, 2003
United Kingdom.....	June 13, 2018	–	–	June 13, 2018
United States of America.....	May 13, 2015	–	–	May 13, 2015
Viet Nam.....	December 30, 2019	–	–	December 30, 2019
(Total: 80)	(80)	(34)	(34)	(73)

Belgium, Netherlands and Luxembourg are considered a single state.

APPENDIX D

A typical US design patent



US00D607778S

(12) **United States Design Patent** (10) **Patent No.:** **US D607,778 S**
Ramaciotti (45) **Date of Patent:** **** Jan. 12, 2010**

(54) **CAR INCLUDING TOY-CAR, MOTOR CAR, REPLICA CAR AND SCALE-MODEL-CAR**

(75) Inventor: **Lorenzo Ramaciotti**, Turin (IT)

(73) Assignee: **Fiat Group Automobiles S.p.A.**, Turin (IT)

(**) Term: **14 Years**

(21) Appl. No.: **29/333,751**

(22) Filed: **Mar. 13, 2009**

(30) **Foreign Application Priority Data**

Feb. 13, 2009 (EM) 001087969
Feb. 13, 2009 (EM) 001087977

(51) **LOC (9) CL.** **12-08**

(52) **U.S. CL.** **D12/90**

(58) **Field of Classification Search** D12/86,
D12/90-92; D21/424, 433, 434; 296/181.1,
296/181.5

See application file for complete search history.

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D578,436 S * 10/2008 Tsuchiya D12/90
D592,102 S * 5/2009 Kim D12/90
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* cited by examiner

Primary Examiner—Melody N Brown

(74) *Attorney, Agent, or Firm*—Cowan, Liebowitz & Latman, PC

(57) **CLAIM**

The ornamental design for a car including toy-car, motor car, replica car and scale-model-car, as shown and described.

DESCRIPTION

FIG. 1 is a front view of the car including toy-car, motor car, replica car and scale-model-car showing my design thereof;

FIG. 2 is a rear view thereof;

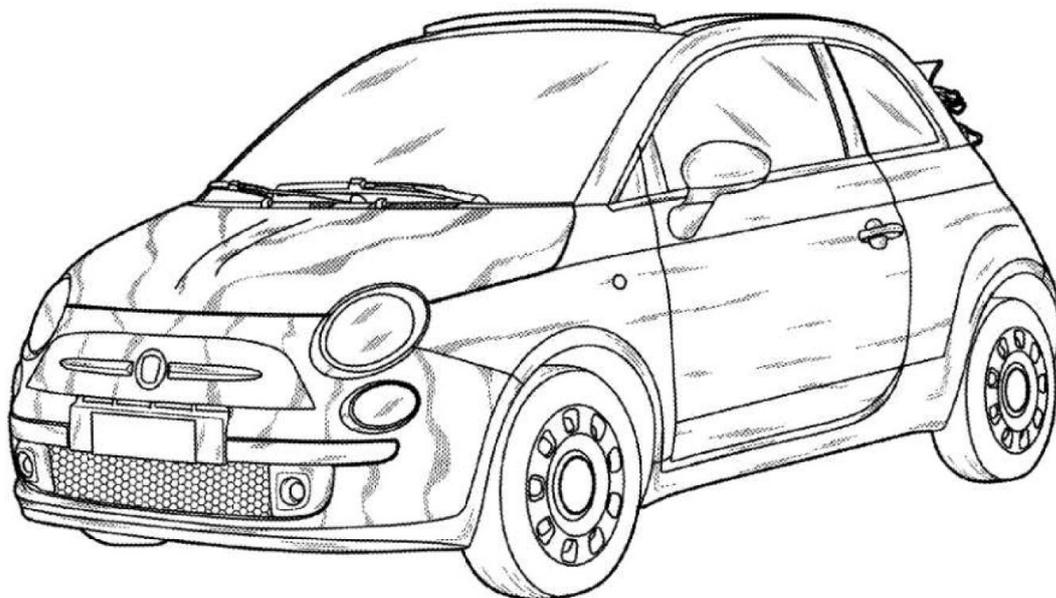
FIG. 3 is a right side view thereof;

FIG. 4 is a left side view thereof;

FIG. 5 is a front perspective view thereof; and,

FIG. 6 is a rear perspective view thereof.

1 Claim, 6 Drawing Sheets



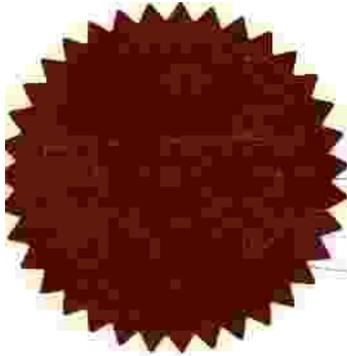
APPENDIX E

A typical UK design registration (illustration on next page)



CERTIFICATE OF REGISTRATION OF DESIGN

Number of Registration	2067002
Date of Registration	28th June 1997
Date of grant of Certificate	8th October 1997



This is to certify that,

in pursuance of and subject to the provisions of Registered Designs Act 1949, the Design of which a representation or specimen is attached, has been registered as of the date of registration shown above in the name of Nelson James Kruschandl

in respect of the application of such design to:

A racing motor vehicle

Registrar of Designs

NELSON J KRUSCHANDL

SHEET 1/1

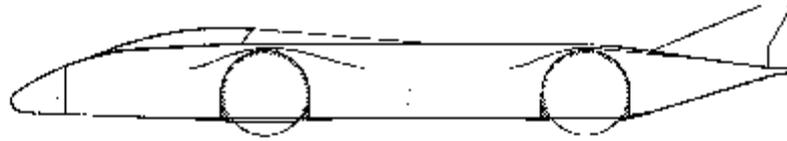
ARTICLE: A MOTOR VEHICLE

STATEMENT OF NOVELTY:

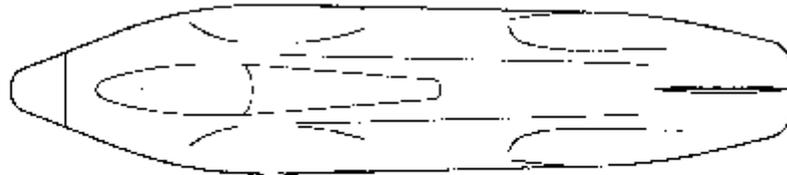
THE FEATURES OF THE DESIGN FOR WHICH NOVELTY IS CLAIMED ARE THE SHAPE AND CONFIGURATION APPLIED TO THE ARTICLE AS SHOWN IN THE REPRESENTATION



FRONT ELEVATION



SIDE VIEW



PLAN VIEW

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