

International Design Law: Global Law and Policy

BY DANIEL A. GAJEWSKI

Design protection continues to be a priority for governments around the world. Global design protection is gradually becoming more modern and harmonized. Building on earlier developments, China made progress to implement examination of partial designs. Australia implemented a grace period for designs. And countries like Chile, the United Arab Emirates, and India simplified their design regimes. On the other hand, the European Union moved closer to limiting design protection for so-called “spare parts.” Meanwhile, the United States continued to evaluate how to improve protection for digital and virtual designs.

This summary will highlight some of the more significant developments of 2022, and how they point to some areas to watch for in 2023.

United States

In 2022, the United States Patent and Trademark Office returned to the issue of better protecting digital and virtual designs with design patents. As a further step in its now long-running review, in April the USPTO released a summary of public comments received in response to a December 2020 request. Most of the summarized comments were supportive of changing the examination guidelines to better protect digital/virtual designs, particularly comments from those having significant hands-on experience with the design patent system. It is not clear what action the USPTO may take on this issue, but upon releasing the summary, the USPTO Director indicated that it would “immediately” turn to reviewing its related examination guidelines.

The USPTO is also considering reducing the qualifications needed for attorneys and agents to prosecute design applications. Currently the same qualifications are needed to prosecute design applications as for utility applications. In late 2022, the USPTO requested public comments on whether to create an additional design-only practitioner bar, with its own unique qual-

ifications. These practitioners would not be able to prosecute or advise on utility applications. One apparent goal is to increase diversity among those prosecuting patent applications before the USPTO. The USPTO recently accepted public feedback on this issue.

China

China made some big changes to its design law in 2021, including allowing partial-design claiming—the practice of claiming only a portion of an entire article. This change was welcomed by the design IP community, and brought China more in line with international norms. The change should allow applicants to protect designs embodied in only portions of physical articles, as well as to protect digital image designs independently from the device that displays them.

Despite the law change occurring more than 18 months ago, China has yet to decide how to implement it, and as a consequence China has not been examining the many partial design applications that have been filed since then, creating a growing backlog. Draft examination guidelines were introduced in August 2021, and then again in October 2022. Based on the October 2022 draft, it appears that the most significant aspects of China’s implementation of partial design—including some limitations on it—will be analogous to practices in other countries, and so may be familiar to global design practitioners.

Continuing its trend toward international harmonization, in May 2022 China joined 76 other members of the Hague International Design System. Since then applicants have been able to file Hague International Design Applications designating China.

China is considered an “examining office” under the Hague system, one effect of which is that it has 12 months from publication to issue a refusal of a Hague application that designates China, otherwise the designs are deemed protected in China. The earliest

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continued

China-designating Hague applications began publishing in summer 2022, and some include partial designs. Even if China makes use of a special provision giving it 18 months to issue a refusal, it will need to examine these applications sometime in 2023 to meet its obligations under the Hague system. This gives some encouragement that the examination guidelines will be in place in early 2023 and the backlog of partial-design applications will start to go down.

European Union

The European Union continues its ongoing review and update to its rules on design protection. In 2022, the European Commission adopted a proposal for changes to EU design regulation. The most significant proposed change will be to strip design protection from so-called “spare parts” by making “registered and unregistered Community design rights unenforceable where the design of the component part of a complex product is used for the purpose of the repair of a complex product so as to restore its original appearance.” For years the EU has tolerated differing treatment and debate among its member states on this issue, particularly in the context of automotive spare parts, but now seeks to resolve it by reducing the protection available to repair parts EU-wide. The change would only immediately affect new designs, while older designs would retain a limited protection period of 10 years. The European Commission recently accepted public feedback on the proposal, which will be passed on to the European Parliament for consideration.

Australia

As of March 10, 2022, Australia has implemented a grace period for design applications. This brings Australia in better alignment with international design law norms: most jurisdictions have a grace period, though details differ. Australia’s grace period provides a period of 12 months following publication or public use of a design to validly file a design application. Under the previous regime a public disclosure before the application was filed would doom the application’s validity. This is a welcome advance in Australia’s design law, providing applicants with greater flexibility and predictability. It happened as part of the implementation of Australia’s Design Amendment Act of 2021, which also made other changes in 2022 that simplified the publication process and improved applicants’ ability to keep their designs confidential for a period of time after filing.

Chile

Chile adopted an optional abbreviated examination procedure for designs in May 2022. Rather than undergo substantive examination, applicants now have the option to file for a certificate of deposit for their designs. Like some other countries however, the design cannot be enforced unless and until examination has been requested and the design has been approved. Chile also extended the term of protection for designs from 10 years to 15 years.

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United Arab Emirates

Throughout 2022, the United Arab Emirates has been taking steps to implement changes in its IP laws that were made in late 2021. In doing so, it has streamlined its document requirements. To the particular benefit of foreign applicants, the UAE has removed the requirement for legalization for application documents such as power of attorney and assignment. Going forward, local notarization will suffice, which will be cheaper and quicker for applicants. Other notable changes arising from the 2021 law changes included extending the term of protection for designs from 10 years to 20 years, and introducing a 12-month grace period for designs.

India

As of December 2022 India has gone digital. Most requirements to submit physical forms and documents have been withdrawn and now electronic documents may be submitted. Unfortunately, assignments are an exception—they still must be filed as physical documents. On the other side of the process, India has begun issuing design certificates electronically, further streamlining its processes.

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