

# Global Design Law and Policy: Gains and Setbacks in Protecting Digital and Virtual Designs

BY DANIEL GAJEWSKI

The outlines of global design protection change regularly, with every year bringing significant updates in at least some major jurisdictions. In general the changes bend toward greater alignment and the emergence of international norms. 2023 saw the near-completion of global adoption of partial design practice (China and Brazil are now there, Australia nearly so). It also strengthened the now-clear global trend toward protecting the next frontier in design: digital and virtual designs, independent of a display screen, which is taking hold nearly everywhere but the United States.

This summary will highlight some of the more significant developments of 2023, and what to watch for in 2024.

## Australia

Australia has been a model in recent years for methodically evaluating and modernizing its design system. In 2023 IP Australia has focused on meeting the needs of modern designers, who create not only physical designs, but digital and virtual designs as well. Recognizing that its system failed to protect designers who work in non-physical or virtual mediums, IP Australia proposed to “protect virtual designs, including user interfaces, and product elements only visible when the product is used.” This would include icons, virtual reality, and augmented reality designs.

Simultaneously, IP Australia advanced proposals to protect partial designs—the practice of claiming only a portion of an entire article. It will be the last major jurisdiction to do so, completing a long global alignment that was advanced by similar changes recently in China and this year in Brazil. At the same time, IP Australia has proposed to improve its protection for incremental designs by making it possible to link an incremental design to a previously-filed main design, like can currently be done in other jurisdictions like Japan.

## United States

IP Australia’s proposals for protecting virtual designs were made in recognition that protection for virtual designs is available in many other countries. In recent years, other big countries like China and Japan have joined countries like South Korea, Singapore, and others in protecting virtual designs independent of their tie to a physical device. Not the United States. In 2023, after a years-long sporadic effort to clarify its protection for virtual designs, the USPTO issued guidance suggesting that only the most basic and limited forms of digital designs are protectable. The USPTO’s effort began in 2020 under Director Andre Iancu to explore whether its practice should be revised to better protect digital designs including “certain new

### Current

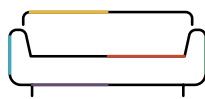
Designers can protect the overall look of products with physical and tangible form:



Wheelchair



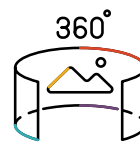
Shirt



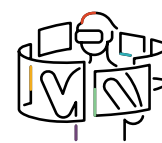
Couch

### Proposed

Designers can also protect the overall look of products with no physical form:



Icons



Virtual Reality



Augmented Reality

IP Australia’s Proposal for Protecting Virtual Designs

# Global Design Law and Policy: Gains and Setbacks in Protecting Digital and Virtual Designs

and emerging technologies, such as projections, holographic imagery, or virtual/augmented reality.” But in its new guidance the USPTO makes no mention of projections or holographic imagery, and instead appears to revive its antiquated practice of requiring that a digital design be tied to a display screen. This practice is concerning and lags well behind growing international norms.

The USPTO also moved forward in expanding qualifications to sit for the patent bar exam to design-centric degrees, and allowing for practitioners with such degrees to have limited recognition in design patent applications. Previously the USPTO made no distinction between practitioners that can represent applicants in utility patent matters or in design patent matters. All needed a qualifying technical background and to pass an examination. Starting January 2, 2024 a new category of “design-only” practitioners will be created. These practitioners will be permitted to practice *solely* in design patent matters, and can qualify to sit for the patent bar exam with different, more design-focused backgrounds.

Finally, in the US there will soon be some major organizational changes in the design function within the USPTO. Designs is being elevated to its own division and will be getting a dedicated new Deputy Commissioner for Designs. Little detail is available at the moment, but this promising development warrants attention in 2024.

## Brazil

2023 saw substantial modernization in Brazil’s design law. In August, Brazil became the 79th member of the Hague international design system, expanding the Hague system’s reach into this important market. In addition to its value proposition—often providing a



Patentable in the US as a design for a display screen

cheaper and less onerous path to design protection in an ever-growing portion of the world—the Hague system has had a great impact in harmonizing local design practices, which benefits the design community even outside of the Hague system. Brazil was no different: to meet the Hague system’s requirements, Brazil took big steps to modernize its design law and practice. Most significantly, Brazil now allows partial-design claiming.

Joining the Hague system had the same effect on China two years ago—its law was also changed to allow partial design claiming. But where China took well over two years to issue official guidelines on examining partial designs (only just issuing them in the final days of 2023), Brazil has already updated its Manual for Examination of Industrial Design Registration, giving applicants and examiners alike clear examples of how the new practices will be implemented. An early review suggests clearer and more flexible examination standards than had previously been the norm in Brazil, hopefully leading to faster and less costly examination.

## Myanmar

Myanmar makes our list this year not for a big *change* in its design law, but for adopting a framework for protecting industrial designs for the *first time* in its history. Expected since 2019 when related legislation was first passed, Myanmar began accepting design applications for registration on October 31. Its implementing regulations suggest that Myanmar’s framework will be generally in line with international norms.

## Design Law Treaty

The idea of a design law treaty to harmonize at least formal standards for industrial design protection has been raised from time to time over the years, but 2023 saw it gain some real momentum. In October the World Intellectual Property Organization held a

# Global Design Law and Policy: Gains and Setbacks in Protecting Digital and Virtual Designs

*continued*

preparatory committee meeting, and agreed to hold a diplomatic conference to conclude the Design Law Treaty, November 11–22, 2024 in Saudi Arabia. Topics expected to be considered include providing a uniform grace period, protecting partial designs, and reducing onerous formalities like document certification and legalization requirements.

\* \* \*

As has been the case in recent years, 2023 was a time of significant advancement and greater global harmonization for design law. Australia is close to expanding protection to modern virtual designs. Brazil now

allows partial designs. There is a new Design Law Treaty in the offing. And the waning days of 2023 finally brought about the adoption of formal rules for examining partial design claims in China. Looking ahead to 2024, the European Union may advance its ongoing efforts to limit design protection for spare parts and to better protect virtual designs, among other things. And India may take action on comments that it sought and received from the public this year on revising its manual of designs practice and procedure. Look for updates on these and more in our 2024 Design Law Year in Review.

## We're Hiring!

Our practitioners include patent and trademark prosecutors, litigators, and appellate attorneys, as well as scientists and engineers working as patent agents and technical specialists. Our team collaborates in a diverse and vibrant culture.

Consider joining us! Scan the QR code to learn more about career opportunities and firm culture at Sterne Kessler.

