



Intellectual Property and Intellectual Property Management

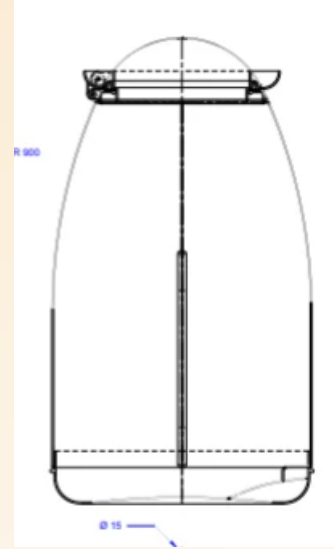
MN 3060

Session 03: Industrial Designs, Trade marks and Other Protection Methods

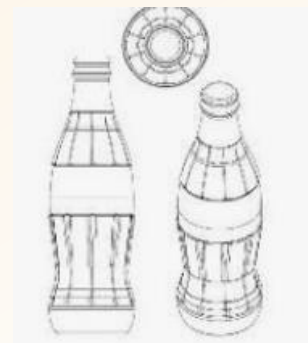
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What is Industrial Design?

- Ornamental or aesthetic aspects.
- protection to the shape / Outer appearance
- Does NOT have any functional characters (how it works, made of, etc.)
- Can be three dimensional (shape of a product) or two dimensional
- (patterns, lines, or colors)
- Combination



2D designs

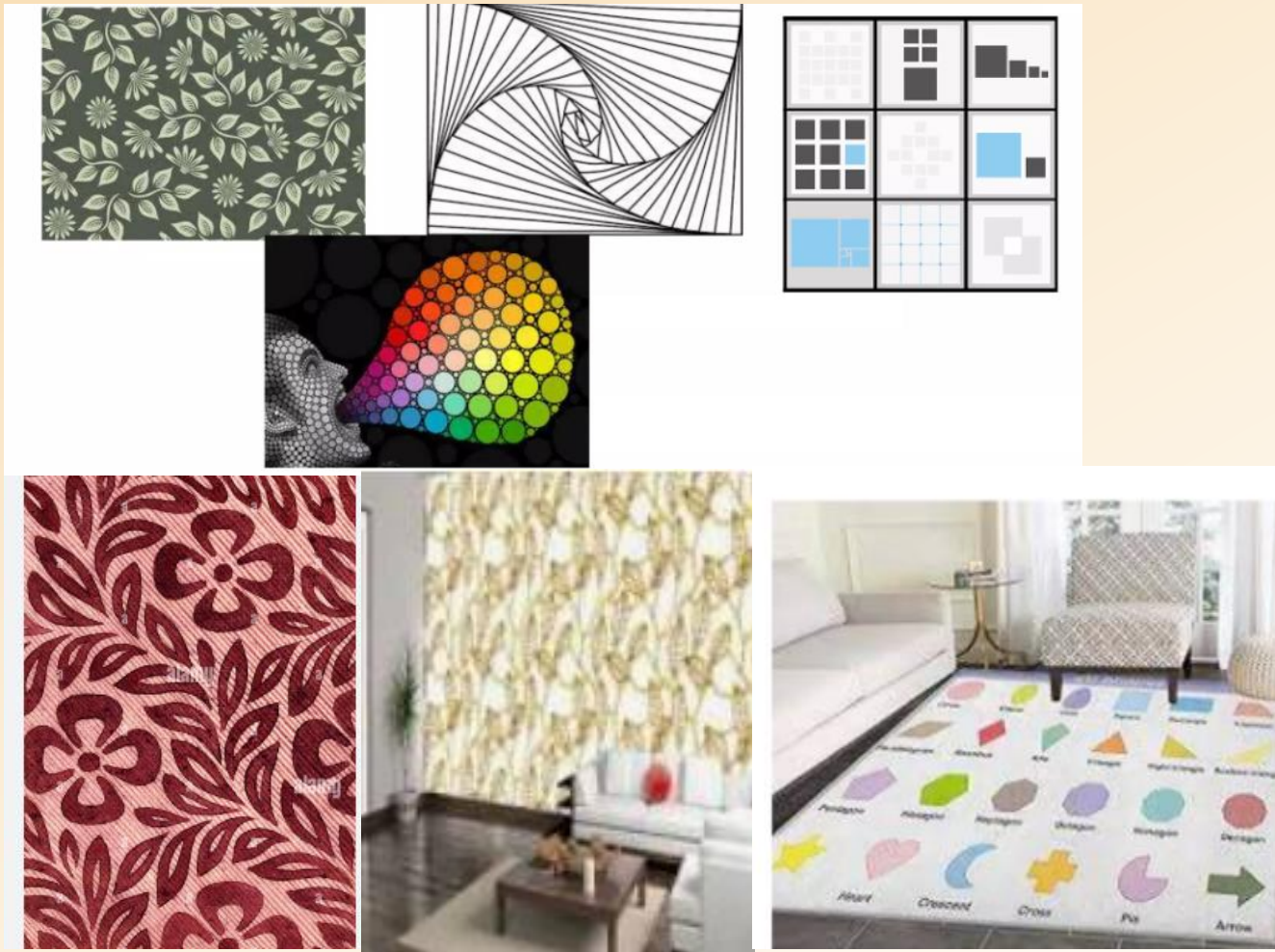


3D Designs

comprehensive design style that focuses on all aspects of design

Designs

- Can be 2D



- Can be 3D



- Combined



Ideas Needs to Keep in mind !

- Comprehensive design style that focuses on all aspects of design
- Design is where functions meets with the consumer
- one of the key factors that attracts customers to a product, or leads us to prefer using one product over another.



What type of Protection

- Owner of a registered industrial design has the right to prevent third parties from making, selling or importing articles bearing or embodying a design which is a copy, or substantially a copy, of the protected design, when such acts are undertaken for commercial purposes.
- Exclusive Rights
- Prevent unauthorized copyright
- Prevent others from reproducing the external design
- Territorial Rights



How to Protect Industrial Design?

- In most countries, an industrial design needs to be registered in order to be protected under industrial design law.
- Industrial design laws in some countries grant – without registration – time- and scope limited protection to so-called “unregistered industrial designs”.
- Depending on the particular national law and the kind of design, industrial designs may also be protected as works of art under copyright law.

In Sri Lanka

- An industrial design needs to be registered in order to be protected
- Protected upon registration with the Intellectual Property Office.
- A registered design is protected for five years and renewable for two more terms of five years.

Can we protect any appearance/shape through Industrial design?

- A design is protected if it is new (not made available to the public)
- Original (Independently created)
- Significantly distinguish by known design or combination of known designs
- Not technical or useful function of the product
- Design protection can only be sought when the intangible creative idea – e.g. a novel pattern - is embodied in physical form, such as in a specific fabric or item of clothing.

In Sri Lanka

- If it does not consist of scandalous design or a design contrary to morality, public order or public interest.
- A design is new if it has not been made available to the public anywhere in the world before the date of application for registration.

Unable to Protected as an Industrial Design?

- Not meet the requirement novelty and Originality
- Dictated exclusivity by the technical function of the product
- Designs incorporating protected official symbols

Can we claim Priority in Industrial Designs?

- Designs registered in Sri Lanka are valid only in Sri Lanka.
- If the owner expands the business to other countries it is advisable to register the said design in those countries.
- Applications in each country where the protection is sought under the respective national laws.
- However, Priority can be claimed under the Paris Convention for the protection of Industrial Property in its member countries. (within 6 months from the date of application in IP Office, Sri Lanka)

International Industrial Design?

- No “world” or “international” industrial design right exists.
- In general, in order to obtain protection in other countries, an application for the registration of an industrial design or for the grant of a patent for an industrial design must be filed in each country where protection is sought, in accordance with the law of that country.
- In other words, if protection is sought in countries A and B, an application should be filed with the intellectual property (IP) office of country A and another application with the IP office of country B.
- To avoid having to submit applications in each and every country where protection is sought, WIPO’s Hague System provides a practical business solution for registering up to 100 designs in a large number of territories – all through one single international application.
- In certain regions, it is also possible to obtain protection for industrial designs in the region concerned by filing an application with a regional IP office. This is the case in the [African Intellectual Property Organization \(OAPI\)](#), which registers industrial designs in states party to the Bangui Agreement; the [African Regional Intellectual Property Organization \(ARIPO\)](#), which registers industrial designs in states party to the Lusaka Agreement; the [Benelux Office for Intellectual Property \(BOIP\)](#), which registers industrial designs in the three “Benelux” countries; and the [European Union Intellectual Property Office \(EUIPO\)](#) which registers industrial designs in the member states of the European Union.

Hague System

- WIPO's Hague System allows you to secure design protection simultaneously in multiple countries or regions through one international application, in one language with one set of fees.
- Use **eHague** to file your international design applications and manage your registrations.
- Managed by WIPO
- Unable to protect designs originated from a country not in Hague agreement
- Have to individual application in each country



How to conduct a design Search?

Global Design Database

<https://www.wipo.int/reference/en/designdb/>

Home > Global Design Database > Search

Global Design Database

A world-wide collection of designs data; including WIPO Hague registrations and information from participating offices.

SEARCH BY

DesignNamesNumbersDatesCountryPriority

Indication of product =

Design class ▾ =

Description =

search 🔍

FILTER BY

SourceStatusDesignationLocarno classReg. Year ✖Expiration ✖Holder ✖

AL Designs	325	BG Designs	19,483	BN Designs	191
BW Designs	203	CA Designs	202,616	CH Designs	138,477
CN Designs	8,043,152	CR Designs	1,681	CU Designs	772
DE Designs	1,316,288	EG Designs	9,687	EM Designs	1,658,091
ES Designs	497,211	FR Designs	823,852	GE Designs	3,020
ID Designs	86,365	IL Designs	20,034	IN Designs	136,817
IT Designs	52,576	JP Designs	508,850	IO Designs	2

Display: List ▾ Sort: Value - asc ▾ filter ▼

1 - 10 / 16,279,060

DESIGN view 🔗

Display: 10 ▾ per page options ⚙

Sort by Reg. Date - desc ▾

NZ ID 434171

Industrial Design OR Design Patent

- Both cover the same
 - In Sri Lanka it terms as Industrial designs
 - US, Japan, Canada, etc terms as Design patents
 - Applications varies from country to country
 - Industrial designs are protected under the patent law as design patent then terms as Design Patents
- OR
- Under copy right law

Fashion designs because they fear major losses from counterfeiting

Why we protected Industrial Design?

- An Industrial Design makes articles attractive and appealing to the customers and therefore increases the commercial value and the marketability.
- *Unique Selling point of a product:* Design drives consumer's choice: the appearance of a product can be a key factor in the consumer's purchase decision
- *Return on investments :* The protection assures a fair return to the creator and promotes investment.
- *Exclusive rights:* Protection provides exclusive rights for at least 10 years, so as to prevent or stop others from commercially exploiting or copying the industrial design.
- *Strengthen brands:* Industrial designs can be an important element of a company's brand. Protecting industrial designs contributes to protecting a company's brand.
- *Opportunity to license or sell:* Protection provides rights that may be sold or licensed to another enterprise, which will then be a source of income for the owner of the rights.
- *Positive image:* Protection helps convey a positive image of a company, since industrial designs are business assets which may increase the market value of a company and its products.

Success Story: Designing for business success

- Procter and Gamble (P&G), the world's largest consumer products company, topped the list of applicants using WIPO's Hague System for the International Registration of Industrial Designs with 167 international design applications.
- Design activities contribute to both innovation and brand building.
- Design involves bringing a unique perspective and particular skills to the creative thinking that can build innovative brands - brands that create emotional connections with consumers.
- Design helps improve the form of a product - how it looks, the function of a product - how it works, and its meaning for consumers; in sum, how the brand connects emotionally and engages with the consumer.
- Design adds value across the entire spectrum of a product's development - from concept to shelf.
- P&G's designers work with the company's research and development (R&D) team at the front end of innovation in conceptualizing consumer needs and creating solutions to fill those needs.



Examples of P&G's sustainable innovation products (SIPs)

- Pantene Nature Fusion is piloting the use of plant-based plastic in its packaging. This innovative recyclable material made from sugarcane uses over 70% less fossil fuel than traditional petroleum-based plastic. As the material looks, feels and behaves in the same way as regular plastic, there are no "trade-offs" in appearance or performance.
- Gillette Fusion ProGlide uses breakthrough packaging in Western Europe comprising a new fiber material made from bamboo, sugarcane and bulrush. It has eliminated PVC from the design, and reduced the amount of plastic by 57% compared with a standard Fusion outer pack and razor tray.





Trademark

- A trademark is a sign or indicator capable of distinguishing (distinctive) the goods or services of one enterprise from those of other enterprises.
- Trademarks are protected by intellectual property rights
- A word or a combination of words, letters, and numerals can perfectly constitute a trademark. But trademarks may also consist of drawings, symbols, three-dimensional features such as the shape and packaging of goods, non-visible signs such as sounds or fragrances, or color shades used as distinguishing features – the possibilities are almost limitless.

Sri Lanka

- A mark may consists of a word(s), a symbol(s), a device(s), letters, numerals, a name, surname or geographical name, a combination or arrangement of colors and shapes of goods or containers etc. A mark should be a visible and a distinctive sign and it should always be capable of distinguishing the goods or services of different enterprises.

Registered TM

Registered Trademark (®)

Trademark that has been officially registered with a government trademark office

Protection: Registration grants the owner exclusive rights to use the trademark in connection with the goods and services listed in the registration. It provides legal protection and the ability to enforce trademark rights in court.

Symbol: The registered trademark symbol is ®. Only trademarks that have been officially registered can use this symbol.

Unregistered TM

Unregistered Trademark (™)

A mark that is being used in commerce to identify and distinguish goods or services but has not been officially registered.

Protection: Even without registration, the owner of an unregistered trademark may still have some legal rights under common law (in countries that recognize common law trademark rights) based on the actual use of the mark in commerce. However, these rights are generally limited to the geographic area where the mark is used.

Symbol: The unregistered trademark symbol is ™. This symbol can be used by anyone to indicate that a word, phrase, logo, or other mark is being used as a trademark, regardless of whether it is registered.

Protect Trademark

- At the national/regional level, trademark protection can be obtained through registration, by filing an application for registration with the national/regional trademark office and paying the required fees.
- At the international level, you have two options: either you can file a trademark application with the trademark office of each country in which you are seeking protection, or you can use WIPO's [Madrid System](#).

Trademark-related treaties administered by WIPO

- Paris Convention
- Madrid Agreement
- Nice Agreement

Paris Convention

- Paris Convention for the Protection of Industrial Property
- The Paris Convention, adopted in 1883, applies to industrial property in the widest sense, including [patents](#), [trademarks](#), [industrial designs](#), utility models, service marks, trade names, [geographical indications](#) and the repression of unfair competition.
- This international agreement was the first major step taken to help creators ensure that their intellectual works were protected in other countries.

Paris Convention;

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

(1) Under the provisions on **national treatment**,

Each Contracting State must grant the **same** protection to nationals of other Contracting States that it grants to its own nationals.

(2) The Convention provides for the **right of priority**

On the basis of a regular first application filed **in one** of the Contracting States, the applicant may, 6 months for industrial designs and marks), apply for protection **in any of the other** Contracting States.

(3) The Convention lays down a few **common rules** that all Contracting States must follow. The most important are:

Marks;

- The Paris Convention does not regulate the conditions for the **filing and registration of marks** which are determined in each Contracting State by domestic law.
- No application for the registration of a mark filed by a national of a Contracting State may be refused, nor may a registration be invalidated, on the ground that filing, registration or renewal **has not been effected in the country of origin**.

Paris Convention Continue....

- The registration of a mark obtained in one Contracting State is **independent** of its possible registration in any other country, including the country of origin; consequently, the lapse or annulment of the registration of a mark in one Contracting State will not affect the validity of the registration in other Contracting States.
- Where a mark has been **duly registered in the country of origin**, it must, on request, be accepted for filing and protected in its original form in the other Contracting States.

Madrid Agreement

- Concerning the International Registration of Marks
- The [Madrid system](#) for the International Registration of Marks is governed by the Madrid Agreement, concluded in 1891, and the [Protocol relating to that Agreement](#), concluded in 1989.
- The system makes it possible to protect a mark in a large number of countries by obtaining an international registration that has effect in each of the designated Contracting Parties.
- An application for international registration (international application) may be filed only by a natural person or legal entity having a connection – through establishment, domicile or nationality – with a Contracting Party to the Agreement or the Protocol.
- A mark may be the subject of an international application only if it has already been registered with the trademark office of the Contracting Party with which the applicant has the necessary connections
- However, where all the designations are effected under the Protocol, the international application may be based simply on an application for registration filed with the office of origin.
- An international application must be presented to the International Bureau of WIPO through the intermediary of the office of origin.

Madrid Agreement and Protocol Continue...

The filing of an international application is subject to the payment of a basic fee, a supplementary fee for each class of goods and/or services beyond the first three classes, and a complementary fee for each Contracting Party designated.

However, a Contracting Party to the Protocol may declare that, when it is designated under the Protocol, the complementary fee is replaced by an individual fee, whose amount is determined by the Contracting Party concerned but may not be higher than the amount that would be payable for the registration of a mark, at the national level, with its office.

Once the International Bureau receives an international application, it carries out an examination for compliance with the requirements of the Protocol and its Regulations.

This examination is restricted to formalities, including the classification and comprehensibility of the list of goods and/or services.

If there are no irregularities in the application, the International Bureau records the mark in the International Register, publishes the international registration in the **WIPO Gazette of International Marks** and notifies it to each designated Contracting Party.

In Sri Lanka

- A mark which is registered at the National Intellectual Property Office under the law is considered as a registered mark. A mark can be used even without registration. Unregistered marks can be protected under the unfair competition law or common law action for passing off.
- highly recommended to register a mark.
- Any person or body of persons corporate and unincorporated. (individual (s), companies, partnerships, associations etc).
- The registration is valid for a period of 10 years from the date of application and is renewable on the payment of the fee for further periods of 10 years

In Sri Lanka Continue....

- Marks registered in Sri Lanka are valid only in the territory of Sri Lanka.
- If the applicant does business in other countries, it is advisable to register the mark in those countries.
- Applications should be filed in each country in which the applicant seeks the protection under the respective national law.
- priority can be claimed under the Paris Convention for the protection of Industrial Property in its member countries. (within 6 months from the date of application in Sri Lanka).

Sri Lanka is not yet a member of the Madrid Protocol. When Sri Lanka becomes a member, an applicant may make one single application with one single fee calculated according to designations of countries by which his mark can be protected in over 114 member States.

Search for a Brand?

Global Brand Database

The [Global Brand Database](#) provides access to the [collections](#) of:


- International trademarks under the [Madrid System](#)
- Appellations of origin and Geographical Indications under the [Lisbon system](#)
- [INNs](#) of the World Health Organization
- Trademarks from participating national and regional offices

Global Brand Database

[BRAND NAME](#) [BRAND LOGO](#) [ADVANCED SEARCH](#) [EXPLORE](#) [VIENNA ASSISTANT](#) [G&S EXPLORER](#) [REPORTS](#)

Searching Trademark applications, appellations of origin, emblems and international non-proprietary names. Covering 66,129,702 records from 82 data sources. [Check our data coverage](#)


Search

Brand name	Search strategy Embedded (results contain entered term) 
Owner name	Application / Registration Number
IP office	Designation country

Nice Classification

The Nice Classification (NCL), established by the [Nice Agreement](#) (1957), is an international classification of goods and services applied for the registration of marks.

A new edition is published every five years and, since 2013, a new version of each edition is published annually.



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[Nice Classification](#) >
[NCLPUB](#)

NICE HOME PAGE

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EDITION-VERSION

11-2021

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LANGUAGE

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Classes

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List of Classes with Explanatory Notes

Class 1

Chemicals for use in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; fire extinguishing and fire prevention compositions; tempering and soldering preparations; substances for tanning animal skins and hides; adhesives for use in industry; putties and other paste fillers; compost, manures, fertilizers; biological preparations for use in industry and science.

Explanatory Note

Class 1 includes mainly chemical products for use in industry, science and agriculture, including those which go to the making of products belonging to other classes.

This Class includes, in particular:

- sensitized paper;
- tyre repairing compositions;
- salt for preserving, other than for foodstuffs;
- certain additives for use in the food industry, for example, pectin, lecithin, enzymes and chemical preservatives;
- certain ingredients for use in the manufacture of cosmetics and pharmaceuticals, for example, vitamins, preservatives and antioxidants;
- certain filtering materials, for example, mineral substances, vegetable substances and ceramic materials in particulate form.

This Class does not include, in particular:

raw natural resins (Cl. 3), semi-processed resins (Cl. 17)

Rights of a Trademark

A trademark registration will confer an exclusive right to the use of the registered trademark.

This implies that the trademark can be exclusively used by its owner, or licensed to another party for use in return for payment.

Registration provides legal certainty and reinforces the position of the right holder, for example, in case of litigation.

Functions such as :

- Distinguishes the goods or services of its owner from those of others
- Indicates the source of the goods or services
- Individualizes the goods or services of the owner
- Enables the owner to reach the customers
- Helps the consumers to make the choice in the market etc.



The Synergy of Trademarks and Marketing

- Erick Estrada, senior product manager for Pfizer Inc., points out that once a product has been developed, any delay in launching the product could forfeit an opportunity and result in the loss of money to the company. Therefore, planning-ahead for the final trademark is needed to achieve a successful launch.
- marketers want to use **descriptive marks** because they are easier to market, while trademark lawyers tend to insist on selecting unique and "**own-able**" marks.



Geographical Indications (GIs)

- A sign used on products that have a specific geographical origin and possess qualities, reputation, or characteristics inherent to that location
- Protects the name of the product and ensures that only products genuinely originating from that region can be marketed under the GI.
- Tied to a specific location, such as a town, region, or country.
- Derived from the geographic area, including natural factors (climate, soil) and human factors (traditional production methods).

Eg: Ceylon Tea from Sri Lanka,




Agreements related to GI

- **TRIPS Agreement (WTO):** Establishes minimum standards for GI protection.
- **Lisbon Agreement:** Provides for the international registration of GIs.

Why we need to protect GI?

- **Economic Value:**
Enhances market value and can lead to premium pricing.
- **Rural Development:**
Supports local economies and preserves traditional knowledge and methods.
- **Consumer Trust:**
Provides assurance of quality and authenticity.
- **Cultural Preservation:**
Helps preserve the cultural heritage associated with the product.
- **Social Impact:**
Supports small-scale farmers and local communities.



Case Study: Ceylon Tea (Sri Lanka) as a Geographical Indication (GI)

Geographical Indication of Ceylon Tea

GI Registration:

Ceylon Tea was registered as a Geographical Indication (GI) to protect the brand and ensure that **only tea grown and processed in Sri Lanka could be labeled as "Ceylon Tea."**

Criteria for GI:

- **Origin:** Must be grown and processed entirely within Sri Lanka.
- **Quality:** Must meet specific quality standards, which are regulated by the Sri Lanka Tea Board.
- **Regions:** Different sub-regions within Sri Lanka, such as Nuwara Eliya, Kandy, Uva, and Dimbula, produce tea with distinctive characteristics.



Factors Contributing to Ceylon Tea's Unique Qualities

Climate and Geography:

- **Diverse Elevation:** Tea is grown at various elevations, from low-grown (below 600 meters) to high-grown (above 1,200 meters). The altitude influences the flavor profile, with high-grown teas being lighter and more aromatic.
- **Monsoon Patterns:** The island's weather, influenced by monsoons, contributes to the unique growing conditions.
- **Soil Composition:** The rich, loamy soil in Sri Lanka's tea-growing regions enhances the flavor and quality of the tea.

Traditional Processing Methods:

- Ceylon Tea is traditionally processed using techniques passed down through generations, ensuring consistency and quality. The process includes plucking, withering, rolling, fermentation, drying, and grading.

Economic and Cultural Impact of GI Protection

Economic Benefits:

- **Premium Pricing:** GI status allows Ceylon Tea to command higher prices in international markets due to its recognized quality and authenticity.
- **Market Access:** Helps Sri Lankan tea producers maintain access to premium markets and protects against imitation products.
- **Employment:** The tea industry supports over a million people in Sri Lanka, including smallholder farmers, plantation workers, and those in related industries.

Cultural and Heritage Preservation:

- **Brand Identity:** The GI status helps preserve the cultural heritage associated with tea production in Sri Lanka, maintaining the identity and reputation of Ceylon Tea.
- **Consumer Trust:** The GI provides consumers with assurance of the tea's origin and quality, fostering trust and brand loyalty.

Challenges in GI Implementation

Global Enforcement: Ensuring that the GI is respected globally and preventing the misuse of the "Ceylon Tea" name by producers outside Sri Lanka can be challenging.

Counterfeiting: The market is susceptible to counterfeit products that claim to be Ceylon Tea but do not meet the GI criteria, potentially damaging the brand's reputation.

Sustainability Issues: Balancing the demand for high-quality tea with sustainable farming practices is crucial to maintaining the GI's value.

What type of Protection coverage?

1. Lisbon Agreement (WIPO)

International Registration: Ceylon Tea is registered under the **Lisbon Agreement for the Protection of Appellations of Origin and their International Registration**. This system, administered by the **World Intellectual Property Organization (WIPO)**, allows for the international registration of GIs and ensures protection in all member countries.

Geneva Act of the Lisbon Agreement: Sri Lanka is a signatory to the **Geneva Act of the Lisbon Agreement** as well, which extends the protection and makes it easier to enforce the GI across borders.

2. Bilateral Agreements

European Union: Sri Lanka has entered into bilateral agreements with the European Union, under which Ceylon Tea is recognized as a protected GI. This agreement ensures that only tea grown and processed in Sri Lanka can be sold under the name "Ceylon Tea" within the EU.

3. National Registrations in Key Markets

Country-Specific Registrations: In addition to the international registration under the Lisbon Agreement, Sri Lanka has taken steps to register Ceylon Tea as a GI in individual countries where it is exported. This includes countries like India, China, and others where tea is a significant product, ensuring protection against misuse in these markets.

Thank you!