

ID5 Project Proposal

Title: Indication for registered designs

Lead Offices: Japan Patent Office (JPO), United States Patent and Trademark Office (USPTO)

Introduced: ID5 Mid-term Meeting, June 20-22, 2022

Background

- In recent years, many countries and regions are seeing the design's growing presence and significance in industrial businesses.
- Accompanied by that trend, the number of design registrations is on the rise globally as many companies in each country and region are actively obtaining design rights expecting beneficial effects from containing competitors, eliminating counterfeits, and promoting designs to business partners and customers.
- However, the reality is that such effects may not always work efficiently because it is not evident to those other than the right holder whether the design rights have been obtained, solely from looking at products themselves or catalogues or websites where such product is included.
- The development of new technology environments has also created challenges for "marking" or identifying designs are covered by registered industrial design rights.
- Given the above, in this project, we will focus on an indication system for registered designs (a system where a number or mark is used to indicate an article embodying a registered design) in which a person other than a right holder can recognize whether the products are protected by design rights. In the meantime, as we come to recognize the ID5 partner Offices' introduction and utilization state of such system, we will confirm advantages¹ brought by the indication for registered design to the users under the design system.

¹ Benefits expected from affixing common registered design mark are, for example, the following:

- By affixing the mark on the product, the right holder can demonstrate the strength and ability of the company to design products of originality and expect to increase consumers'/clients' purchase intention or ensure their trust in the product.
- The design right holder is entitled to request for an injunction of counterfeit goods or claim the damages against the counterfeit trader through the procedures such as a lawsuit. However, in some cases, it is difficult to take such action, especially when the right holder is a SME or start-up company with limited financial resources. The common registered design mark indication, by

- We will also explore the feasibility of a common registered design mark indication system² introduced by the ID5 partner Offices. A mark, which is affixed by the design right holder to indicate that the design is the registered design, and communicates the fact that the design right has been obtained. Affixing the mark on a product itself or catalogues or websites where such product is included is expected to communicate such fact in a more active and effective manner than affixing a design registration number. Therefore, it enhances the effect of the deterrence to the third party or the chance to demonstrate the strength and ability to design.
- In addition, having more than one ID5 partner Offices included to adopt the common registered design mark indication system will bring more opportunities that the mark gets seen by businesses, design creators and consumers in each country or region and so increase the awareness of the system itself and also the design registration system behind that.

Project Definition

The project aims firstly to understand each country and region's system for identifying/indicating protected designs beyond the official design register or gazette. Additionally, the project will identify any information that each Partner Office, within its possible range, collected and recorded regarding how often the indications are utilized, and highlight any beneficial effects of clear indications for protected/registered designs (Phase 1). It also aims secondly to enhance the beneficial effect of design rights in ID5 partner countries and regions, while alternatively contributing to extensive promotion of the design system per se (Phase 2).

This project consists of two phases.

Phase 1: Conduct a comparative study on each country and region's means for indicating design protection for registered designs, if it is available. Additionally, the project will identify information that each Partner Office, within its possible range, collected and recorded regarding how often the indications are utilized by users, and then summarize the results of the Study, and highlight the beneficial effects and merits of the indication for registered designs.

being affixed by the right holder on their own product in advance, is expected to communicate the fact that the product is protected by the design right and work effectively to deter the third party before the product is counterfeited.

² For example, in 2018, the Japan Patent Office created a "Regional Collective Trademark Indication" and established the system, where the use of the indication is allowed, in order to help the ones who obtained regional collective trademark right promote their brand equity.

<https://www.jpo.go.jp/e/system/trademark/gaiyo/chidan/>

Further, this Study will include a preliminary evaluation of the feasibility of developing a common registered design mark indication system among the ID5 Partner Offices. The evaluation will include data collected by each Partner Office within its possible range, regarding interest by the Partners, interest by stakeholders, as well as the challenges and problems in introducing such system.

In the Phase 2 and based on the feasibility determination of Phase 1, the project aims to consider the establishment of the common registered design mark indication system among the ID5 Partner Offices. However, in this phase, only the Partner Offices which specifically agree to Phase 2 of the project will participate, and the project should advance with full consideration not to infringe on or violate laws/regulations of each country and relevant international treaties/agreements such as the Paris Convention³.

Project Scope

In Scope

- Conduct a comparative study on indication systems for registered designs in each ID5 Office, complete a report on the results of the Study and highlight any beneficial effects of the indication for registered designs. (Phase 1)
- Based on the feasibility and interest of Phase 1, develop a common registered design mark indication system for the ID5 Partners. (Phase 2)

Desired Outcome

- To deepen mutual understanding of the indication system for registered designs and to share the recognition concerning the beneficial effects of the indication for registered designs among the ID5 Offices. (Phase 1)
- To establish the common registered design mark indication system. (Phase 2)

Expected Resources

The Lead Offices intend to be responsible for any resources required for planning and coordinating the project. Unless specifically otherwise identified, each office is

³ Paris Convention for the Protection of Industrial Property Article 5 D

No indication or mention of the patent, of the utility model, of the registration of the trademark, or of the deposit of the industrial design, shall be required upon the goods as a condition of recognition of the right to protection.

responsible for their own costs and resources including personnel, IT and other resources required to collect and share information necessary to complete this project.

Proposed Project Timeline

(1) Phase 1: Study of the indication system, etc. for registered designs

2022 ID5 Mid-term Meeting	Submission of the new project proposal
2022 ID5 Annual Meeting	Adoption of the project
	Lead Offices share/adjust/decide proposed questionnaire Lead Offices share questionnaire Partner Offices answer questionnaire
2023 ID5 Mid-term Meeting	Lead Offices share results of collected answers
2023 ID5 Annual Meeting	Final results report, Preliminary evaluation of the feasibility* Adoption among partner Offices (if any): Proceeding to Phase 2

*Phase 2 can start later than initially scheduled if each Partner Office requires time for the preliminary evaluation of the feasibility.

(2) Phase 2: Creation of a common registered design mark indication system for ID5

2024 ID5 Mid-term Meeting	Proposal of a registered design mark indication system
2024 ID5 Annual Meeting	Final results report (Adoption: Proposed common registered design mark indication system)