



Office Locations:

Brazil, Mexico, Argentina, Colombia

Spain, Portugal



Speaker:

Manuel Tiedemann, LL.M.

H&A Spain, Partner

European and German Attorney



Office Locations:

Spain, Portugal

Brazil, Mexico, Argentina, Colombia

IP Firm:

Professional partnership,
founded in 1980

Staff:

More than 170 IP specialists

- Speak numerous languages including Japanese
- Country Desks (e.g. US, Asia, Germany)

Geographical Scope

H&A is a leading IP firm in the **European market** and **Latin American market** and represents its clients primarily at:

- European Patent Office (EPO; Munich) and European TM and Design Office (EUIPO, Alicante)
- Spanish (OEPM) and Portuguese (INPI) Patent and Trademark Office
- All Latin American Patent and Trademark Offices
 - Middle and South America
 - The Caribbean Islands

Focus on Latin America

H&A files every year around **2.000 Latin American patent, design and trademark applications** based on 2 working models:

Direct Office Contact:

Using our local Offices in Brazil, Mexico, Argentina and Colombia and its local IP teams straight forward.

Latin American Desk:

Using centralizing Latin American Desk in Spain to streamline patent, design and trademark families in various countries simultaneously.

- Single point of contact
- Overlapping timezone
- Sometimes EPO criteria in Latam

Agenda:

I. Short introduction to the firm

II. Design applications in EU and LATAM



1.) Design applications in EU

2.) Design applications in Brazil

3.) Design applications in Mexico

4.) Design applications in Argentina

5.) Design applications in Colombia

III. Comparison of Japanese design applications with EU and Latin American applications





Office Locations:

Brazil, Mexico, Argentina, Colombia

Spain, Portugal



Speaker:

Gustavo Gonzalez

Head of H&A Electro-/Mechanics Division, Partner
European and Spanish Patent Attorney

Design applications in EU and LATAM



Industrial design

Definitions

“**Design**” means the appearance of the whole or a part of a product resulting from the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation;

“**Product**” means any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces;

“**Complex product**” means a product which is composed of multiple components which can be replaced permitting disassembly and re-assembly of the product.

Industrial design Requirements (i)



A design shall be protected by a Community design to the extent that it is **new** and has **individual character**.

A design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character:

- (a) if the component part, once it has been incorporated into the complex product, **remains visible** during normal use of the latter; and
- (b) to the extent that those visible features of the component part **fulfil in themselves** the requirements as to novelty and individual character.

Industrial design Requirements (ii)

A design shall be considered to be **new** if no identical design has been made available to the public before the date of filing/priority of the application.

A design shall be considered to have **individual character** if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the date of filing/priority of the application.



Industrial design

Grace period

A disclosure shall not be taken into consideration for the purpose of analyzing novelty and individual character if a design for which protection is claimed has been made available to the public:

- (a) by the designer, his successor in title, or a third person as a result of information provided or action taken by the designer or his successor in title; and
- (b) during the **12-month period** preceding the filing/priority of the application.

Industrial design Not registrable



Designs contrary to public policy or to accepted principles of morality.

Designs whose appearance is dictated solely by **technical function**;

Designs consisting of forms whose reproduction is necessary in order to allow the mechanical assembly or connection of the product incorporating the design with another product of which it is a part.

Industrial design

Duration of protection

Upon registration by the Office, a Community design shall be protected for a period of **five years** as from the date of the filing of the application.

The right holder may have the term of protection renewed for one or more periods of five years each, up to a **total term of 25 years** from the date of filing.



Industrial design

Application requirements

An application **may be a multiple application** requesting the registration of several designs (no limit).

When several designs other than ornamentation are combined in a multiple application, the application **shall be divided** if the products belong to **more than one class of the Locarno Classification**.

The applicant shall number the designs contained in the multiple application consecutively, using arabic numerals.

No description is needed but can be provided by applicant (not published).

Industrial design

Drawings / Views and its particularities

The representation of the design shall consist in a graphic or photographic reproduction of the design, either in black and white or in colour.

Only **one view is mandatory** but all 7 isometric views are highly recommended.

In cases where more than seven views are provided, the Office may disregard for registration and publication any of the extra views. The Office shall take the views in the consecutive order in which the views are numbered by the applicant.

Industrial design Examination process

Only formal requirements

No examination on the merits is carried out ex officio, but...

Any natural or legal person may submit to the Office an application for a **declaration of invalidity** of a Community design. If considered admissible, the Office shall examine whether the grounds for invalidity prejudice the maintenance of the registered Community design and, if yes, the registered Community will be declared invalid. This decision may be appealed.

Industrial design Tips / Things to remember

The applicant may request the publication of the **Community design be deferred for a period of 30 months** from the date of filing the application or, if a priority is claimed, from the date of priority.

Unregistered Community designs have a 3 year protection period.

Community Designs **no longer applies in the UK.**

H&A is also based in Alicante (Spain), where the (EUIPO) Community Design and Trade Mark Office is located. Therefore, we have the possibility to contact in person the examiners, among whom are some former colleagues of our firm.

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Speaker:

Rafaela Mattos

H&A Brazil

Brazilian Patent Attorney

Industrial design

Protectable subject matter



- 2D: Ornamental set of lines and colors applied to a product

Example

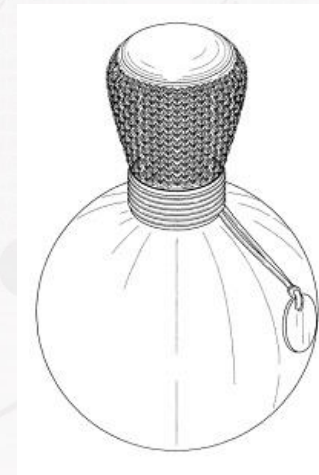


BR 30 2015 005141-8

Ornamental pattern applied to fabric.

- 3D: Ornamental plastic form of an object

Example



BR 30 2012 000635-0

Configuration applied to perfume bottle.

The drawings may be colored, however the colors are not protected.

Industrial design

Requirements and exclusions



New and original look in its external configuration and that can serve as an industrial manufacturing type.

Exclusions:

The necessary common or ordinary form of an object, or even that essentially determined by technical or functional considerations, are not registrable.

Internal system components visible only when the object is dismantled.

Industrial design Duration of protection



The industrial design registration is effective for an initial period of 10 years, counting from the filing date of the application;

Upon payment of the five-year maintenance fee, and may also be extended for another three consecutive period of 5 years;

Total maximum of 25 years.

Industrial design

Multiple designs possible?



The application for industrial design registration shall refer to a single object, of which **20 (twenty) variations** shall be permitted, provided that they are intended for the same purpose, and all retain the same preponderant distinctive characteristic:

Example:



BR 30 2013 006074-8

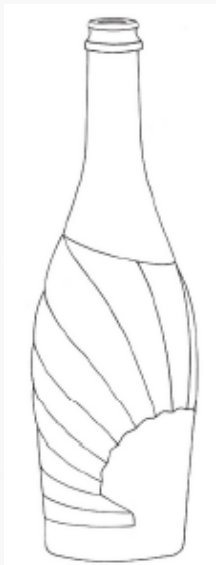
Chairs belong to the same class and share the same distinguishing feature

Industrial design

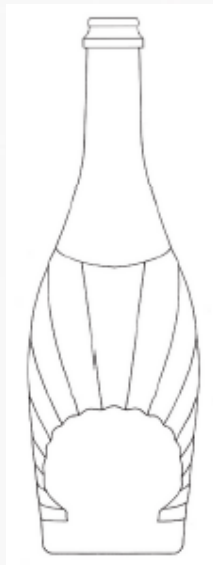
Drawings/ Views and its particularities



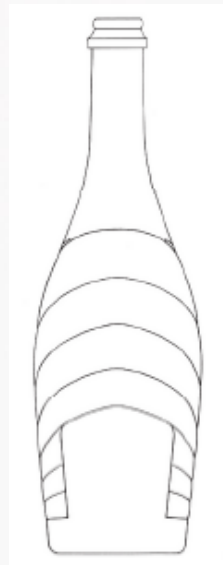
The application for registration of a 3D object must include all the 7 views (perspective, front, back, left side, right side, top, bottom) of the configuration claimed in the priority, without presenting merely illustrative elements:



Perspective



Front



Back



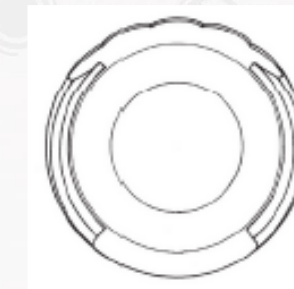
Left side



Right side



Top



Bottom

Industrial design Examination process



✓ FORMAL EXAM:

Verification of the data and documents.

Office action must be fulfilled in 5 (five) days, under penalty of the application being considered non-existent.

✓ SUBSTANTIVE EXAM:

No substantive examination is carried out;

Analysis if it corresponds to the priority document; non-registrable industrial designs; configurative variations; drawings, title and field of application;

Office action must be fulfilled in 60 (sixty) days, under penalty of permanent filing.

Observed these requirements, it will be automatically published and granted.

Industrial design

Nullity process



The nullity process may be initiated *ex officio* or upon request of a third party with a legitimate interest, within a period of 5 (five) years from the granting of the registration.

The request within 60 (sixty) days of the granting suspends the effects of the registration.

Novelty and originality are measured in relation to the state of the art and previous objects. It is not necessary for a prior art to belong to the same product class or market as the registration to be considered an impediment.

Industrial design Practical tips



Description is not necessary.

In case presented:

The descriptive report must list the drawings or photographs filed, contain only text and not include elements such as brands, initials, signatures and others of a similar nature on the page.

The claim constitutes a mandatory document only in cases where there is omission of views or presentation of merely illustrative figures.

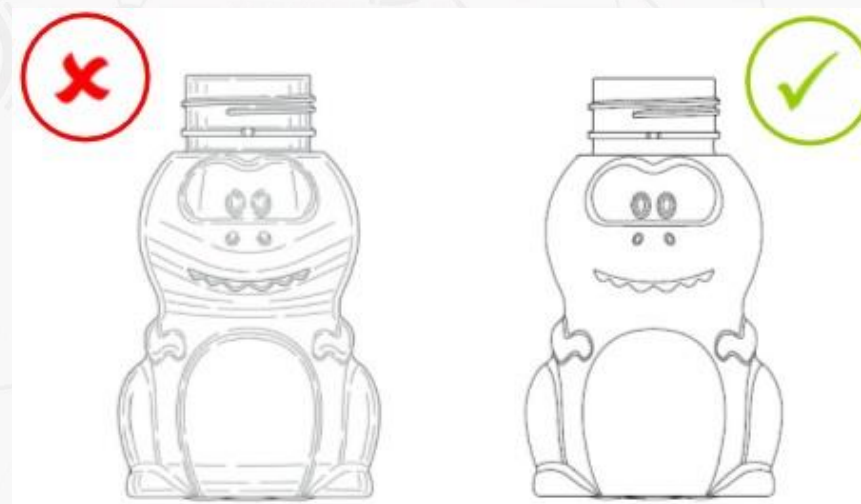
Searches are based in Locarno Classification which establishes the international classification for industrial designs.

Industrial design Further particularities



✓ Grace period:
180 days before filing;

✓ Graphic resolution
Sufficient contrast, sharpness and graphic resolution, without hatches, shadows or reflections. Minimum 300 dpi.

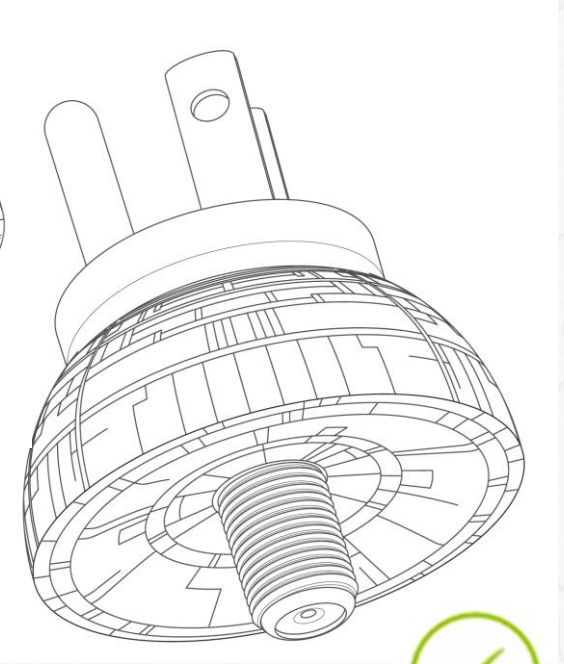
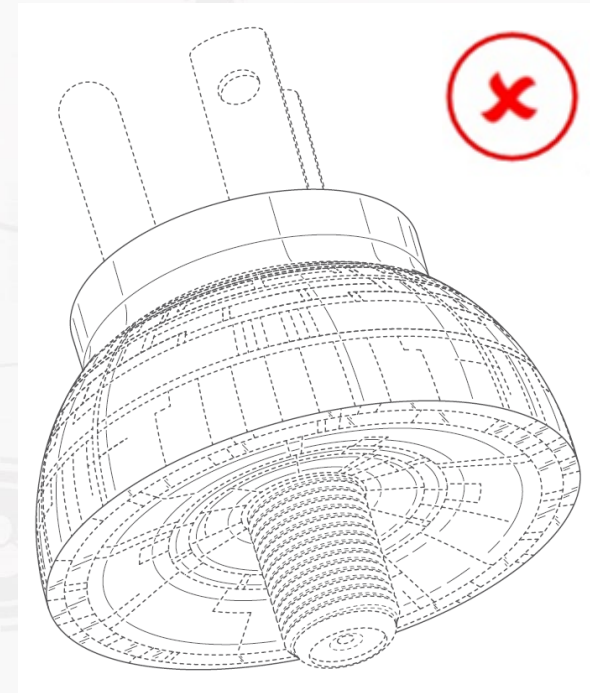


Industrial design

Further particularities



× Not allowed:
Brands or logos, dashed lines,
object parts that do not subsist separately.



Dashed lines

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Speaker:

Karla Islas

Head of H&A Mexico

Mexican Patent Attorney

INDUSTRIAL DESIGN OR MODEL?



Industrial design: Combination of figures, lines or colors applied into an industrial or handicraft product for ornamentation purposes.

Industrial model: Any three-dimensional form serving as pattern for manufacturing an industrial or handicraft product, providing a special appearance as long as it does not imply technical effects.

INDUSTRIAL DESIGN



Vase decoration



Tie Pattern

INDUSTRIAL MODEL



Chair



Lamp



Industrial design

Requirements and protectable subject matter.



- Novelty
- Industrial Application
- Independent creation.
- Significant degree: Unique ornamental feature that is not already in the state of the art.
- Time limit to file the application without affecting novelty: 12 months as from the first disclosure.



❖ Duration of protection?

Valid for 25 years. Renewable for periods of 5 years subject to the payment of the corresponding fees.

❖ Filing of Multiple designs possible?

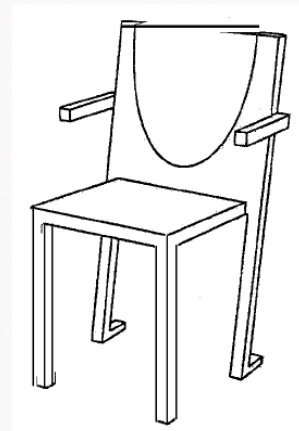
Allowed as long the design refers to a single or group of designs related to each other, in such a way that they form a single design concept.

Industrial design

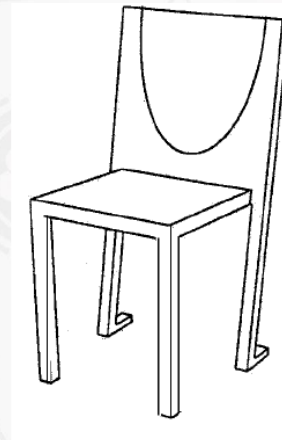
Multiple designs possible?



The chairs produce the same general impression, even if the designs differ from each other in irrelevant details.



Industrial Design Figure1

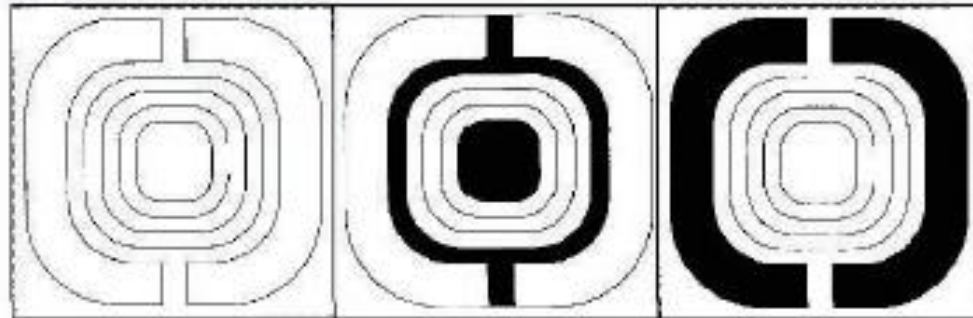


First embodiment of Figure 1

Industrial design Multiple designs possible?



INDSTRIAL DESIGN OF APPLICABLE
PACKAGING FOR LOGO



Industrial Design Figure 1

First embodiment

First embodiment

Industrial design

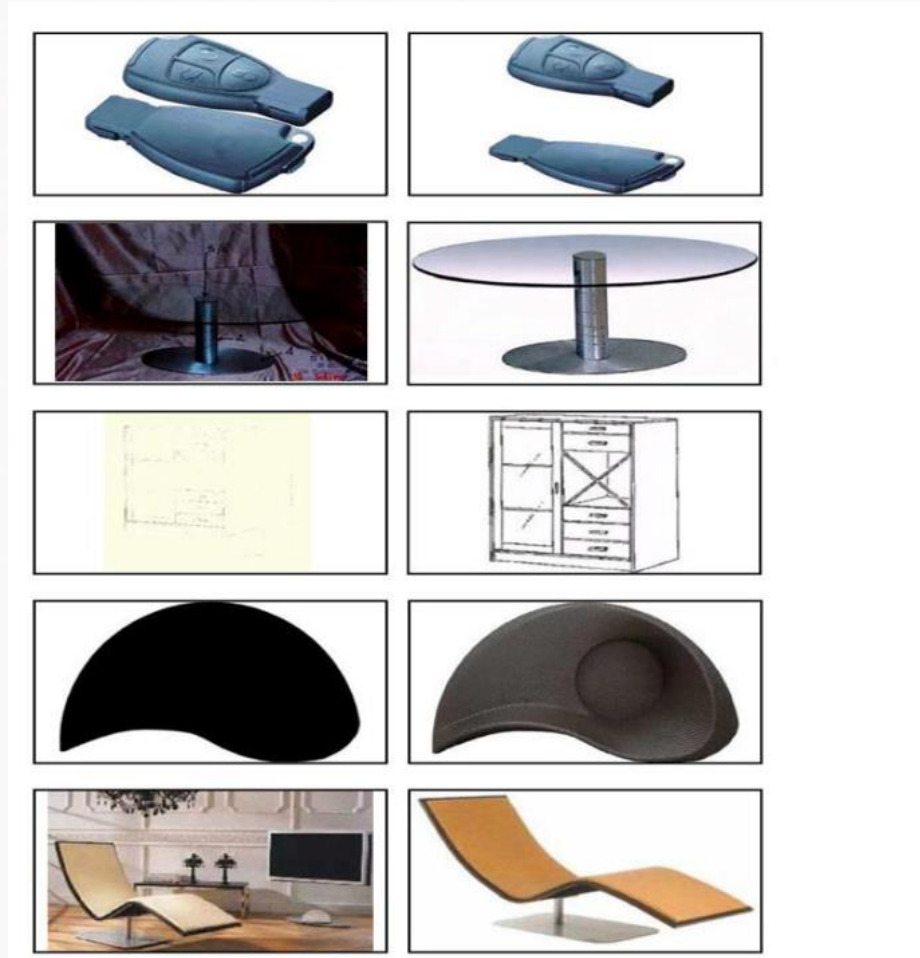
Drawings/ Views and its particularities



- I. Number of perspectives: The necessary to clearly and completely illustrate the design.
- II.- The features that comprise the design shall be clearly illustrated by means of continuous lines.
- III. By contrary, illustrated elements that do not form part of the claimed design shall be identified with broken or blurred lines.

Industrial design

Drawings/ Views and its particularities



Images should be separated

Background does not allow to see the design.

Good quality in line drawing

Poor printing quality

Background should be neutral

Industrial design

Description necessary?



Yes, it is mandatory and must be brief and clear.

- ADDITIONAL MATTER CANNOT BE ADDED to the description once the application has been filed. (i.e. figures that were not described).
- Indicate the title as indicated in the application form.
- Include a preamble (*optional*), different from already known ones and must include shape and ornamentation features.
- Must contain list of drawings, each one must indicate which view of the design is illustrated.

Industrial design Examination



- ❑ **Formal Examination** 4-5 months counting after requirements are satisfied.
(2 office actions maximum)

Important: *Publication* is carried out once the formal examination is satisfied.

- ❑ **Substantive examination** is carried out to verify: Novelty and Industrial application (2 office actions maximum).
- ❑ **Granting:** 1- 1,5 years from filing date if formal and substantive examination are complied.

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Spain, Portugal



Speaker:

Rocio Natalia Gendra

H&A Argentina

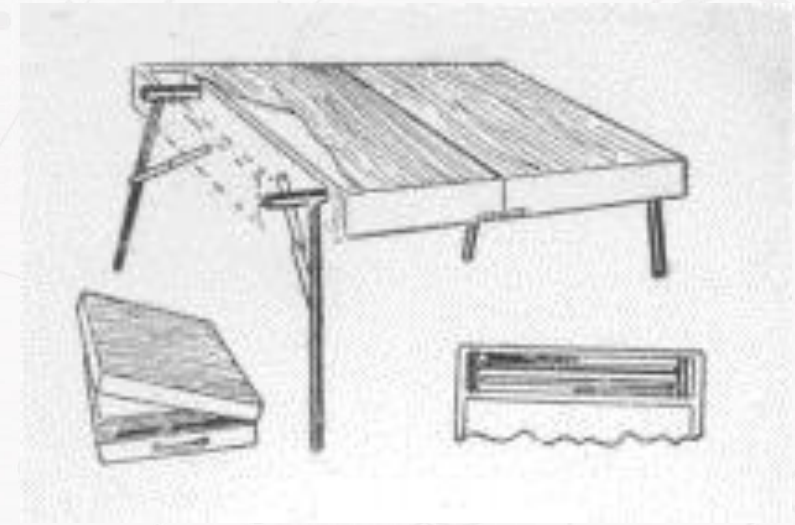
Argentinean Patent and Trademark Attorney

Industrial design

Requirements and protectable subject matter



- Main requirement: Novelty
- Protectable subject matter: Incorporated forms and/or the aspect applied to an industrial or artisanal product that confers an ornamental character.
- Time limit to file application without affecting novelty: 6 months as from the first disclosure or priority filing date.



AR INDUSTRIAL DESIGN no. 7903
TABLE WITH FOLDING LEGS CONVERTIBLE
INTO A SUITCASE

Industrial design

Duration of protection

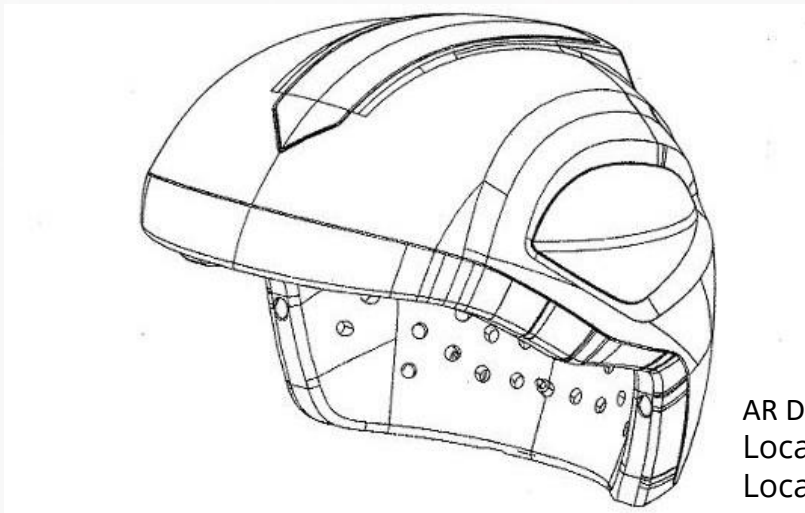


5 years, renewable for two more periods of 5 years each = Maximum duration: 15 years

Industrial design Multiple designs possible?



- Yes, provided all the designs are part of the same Locarno Class (subclass may vary).
- Maximum designs allowed per application: 20



AR Design 94258
Locarno Class: 24
Locarno subclass:: 01



AR Design 91608
Locarno Class: 24
Locarno subclass:: 04

Industrial design Drawings/ Views and its particularities



- Only 7 views allowed per application.
- One positional view per sheet.
- Figure 1 MUST always be a perspective view.
- Each figure must be numbered sequentially using a two-digit pattern (For instance: Fig. 1.1, Fig. 1.2, etc).
- Dotted lines allowed to establish the already known part of the public domain.

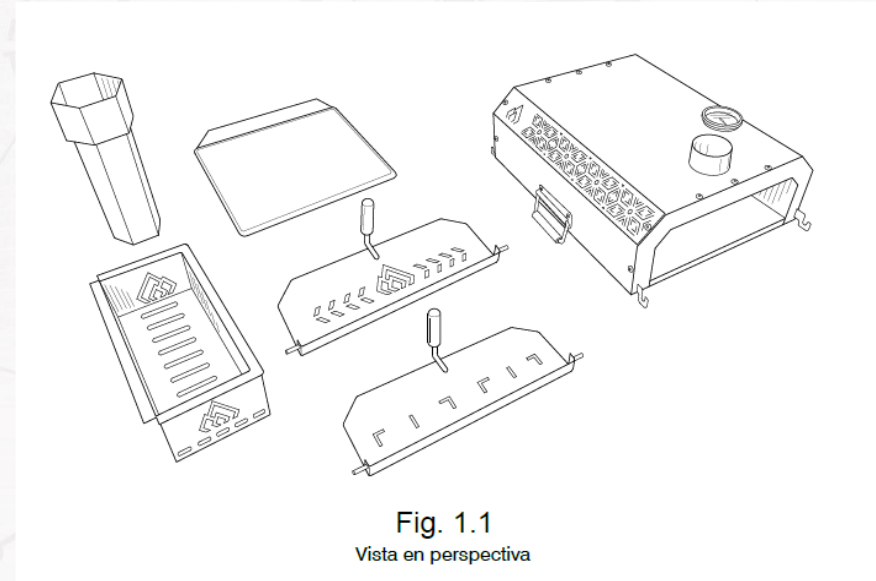
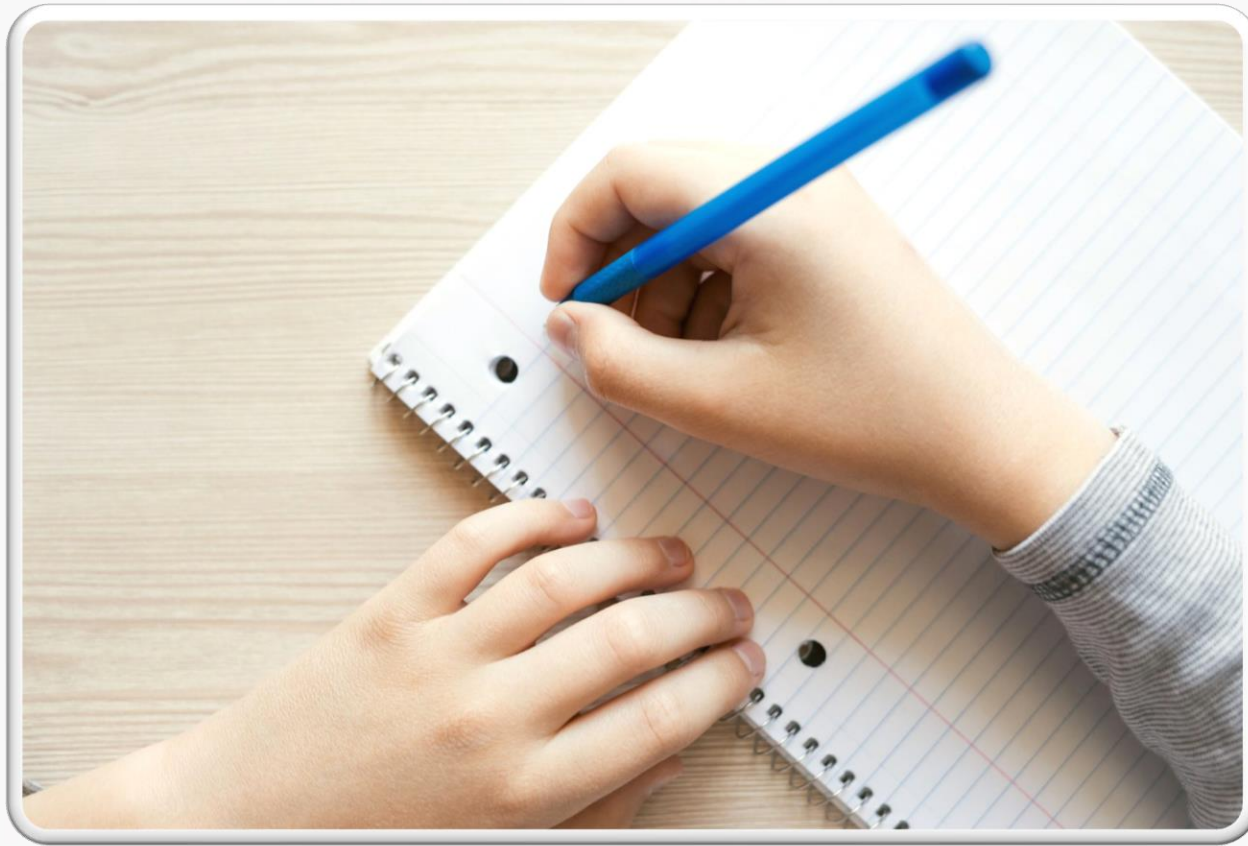


Fig. 1.1
Vista en perspectiva
AR Design No. 98926
illustration of an allowed
perspective view

Industrial design Description necessary?



No, it is not mandatory

Industrial design Examination process



- No substantive examination carried out.
- Deferred publication available: 6 months as from the granting date.
- Approximate granting time: 2 months, counted since all the documents are filed (priority documents, Translations and PoA).

Industrial design Opposition and invalidation



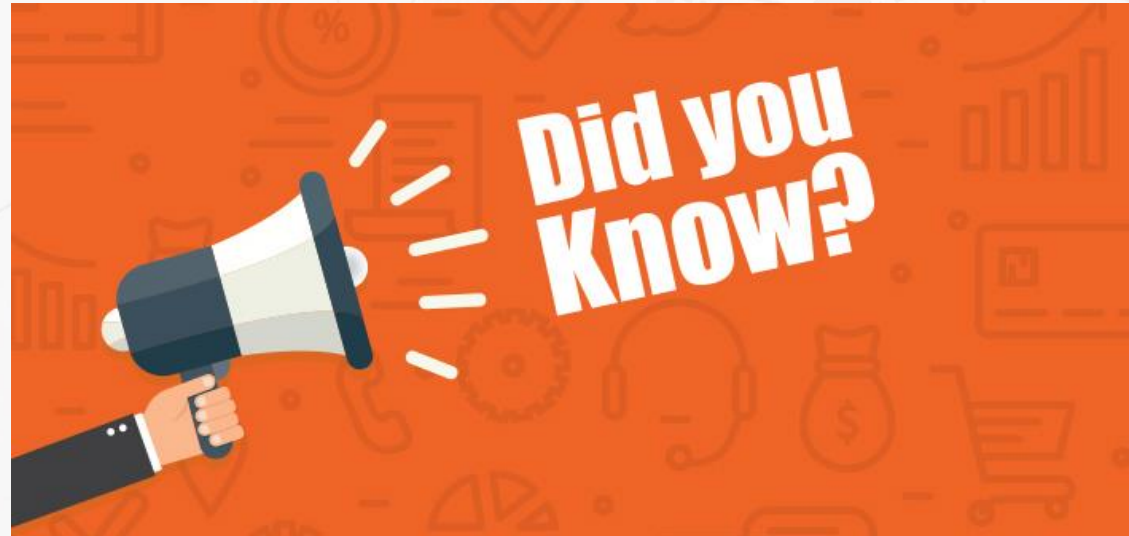
- No opposition procedure available.
- Once the design is granted, any natural or legal person with a legitimate interest can initiate an action for annulment before the Federal Courts.
- The designs granted in contravention of the law are null, totally or partially.
- Precautionary measures are also available.

Industrial design

Practical examples and further particularities



If all the documents are filed along with the application (meaning no belated filing of documents takes place) granting decision may be issued within the subsequent 20 days.



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Speaker:

Adriana Peñaranda

Head of H&A Colombia

Colombian Patent and Trademark Attorney

Industrial design

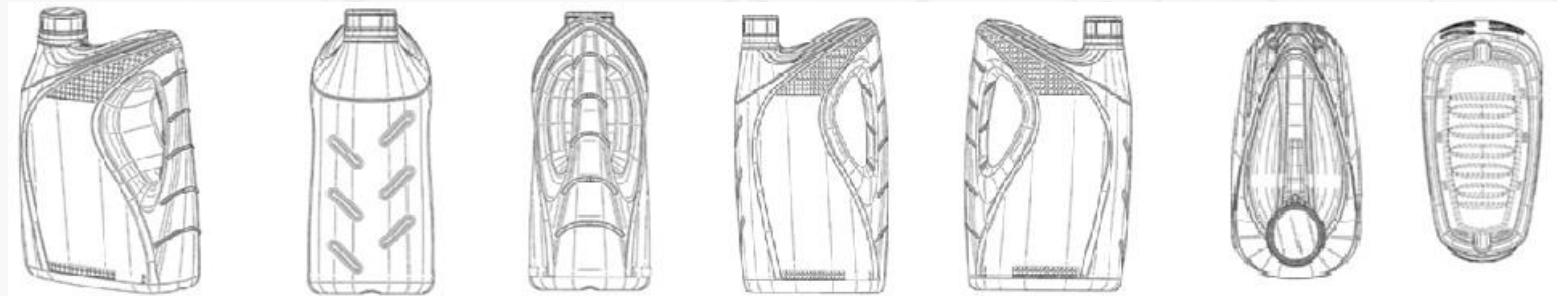
Requirements and protectable subject matter



- Only legal requirement: **Novelty** ↓

Not having been made accessible to the public by any means, before the filing date or validly claimed priority date.

- **Protectable subject matter:** the particular appearance of a product, or any two-dimensional or three-dimensional shape, line, outline, form, texture, or material.



Industrial design Grace Period



For determining the protection, no account shall be taken of any disclosure of the Industrial Design **during the year** prior to the filing date of the application in Colombia, providing that the disclosure was attributable to:

- a) the Designer or the Designer's assignee;
- b) a competent national office that publishes the contents of a Design application filed by the Designer or the Designer's assignee, in contravention of the applicable provision; or,
- c) a third party who obtained the information directly or indirectly from the Designer or the Designer's assignee.

Not registrable



- Designs contrary to moral and public order;
- Designs whose appearance is dictated essentially by technical or functional considerations;
- Designs consisting of forms whose reproduction is necessary in order to allow the mechanical assembly or connection of the product incorporating the design with another product of which it is a part.

Duration of protection



Ten (10) years, counted from the application date in Colombia.

The Industrial Designs are not renewable. Once they expire, they will be of public domain.

Are Multiple designs allowed?



In Colombia, multiple design applications are not allowed.



Industrial design

Drawings/ Views and its particularities



Drawings shall not include frames, measurements, distinctive signs, indicative lines, cuts, or any other graphology or form that do not belong to the industrial design.

If it is a **two-dimensional Design**: it is mandatory to file 1 drawing: the front part.

If it is a **three-dimensional Design**, it is mandatory to file 7 drawings:

- 6 views, one per each face (top, lower, right side, left side, front and rear part), and
- 1 isometric perspective that lets the Examiner see the object in the 3 dimensions.

Required documents/information

Description needed?

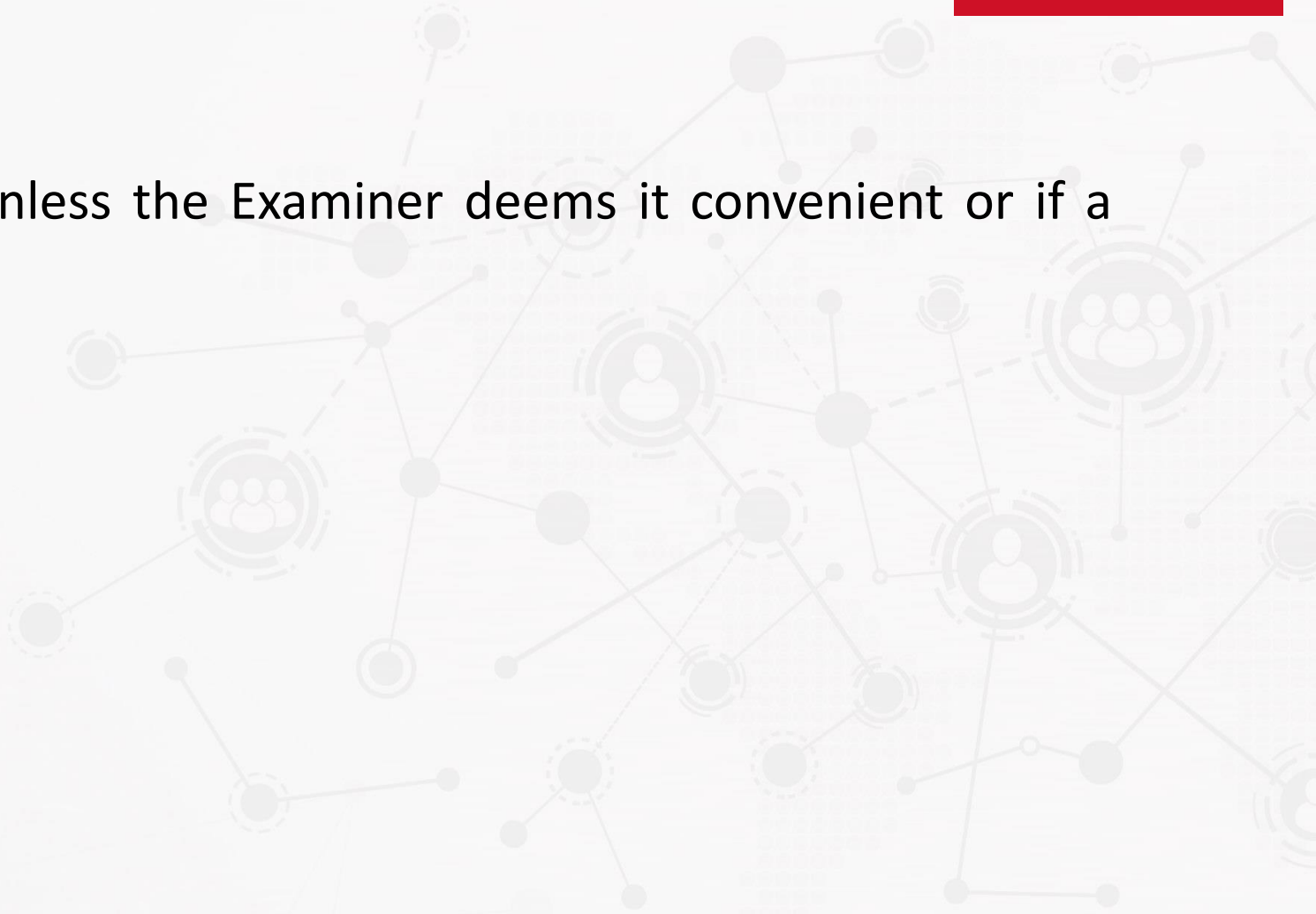


- No description is needed.
- Required documents or information:
 - ✓ Details of the Applicant and Designers (name; address).
 - ✓ Title of the Industrial Design.
 - ✓ Locarno Class Number of each Design.
 - ✓ Drawings (with specifications of the previous slide)
 - ✓ Assignment document from the Designer to the Applicant.
 - ✓ Power of Attorney.
 - ✓ Certificate of Priority.

Industrial design Examination process



No substantive examination, unless the Examiner deems it convenient or if a third party files an opposition.



Industrial design Oppositions



In case of facing an opposition, it is suggestable to study the case, with a technical expert in industrial designs, and define as many arguments as possible to defend the applicant's right to get the industrial design granted.

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Speaker:

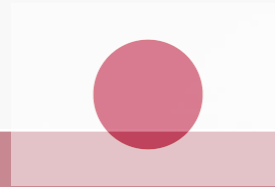
Gustavo Gonzalez

Head of H&A Electro-/Mechanics Division, Partner
European and Spanish Patent Attorney

Comparison

Topic			
Term of protection			
Grace Period?			
Multiple application allowed?			
Description mandatory?			
Views			
Examination			

Comparison



Topic	JAPAN	EUIPO	
Term of protection	20 years from registration 25 years from filing Extensions not allowed	5 years from filing Renewable up to 25 years	
Grace Period?	Yes 12 months	Yes 12 months	
Multiple application allowed?	Yes	Yes if same Locarno Class	
Description mandatory?	Under certain circumstances	No	
Views	Set of 6 views / perspective views	1 minimum view 7 views maximum	
Examination	Formal and substantive	Formal	

III. Comparative chart

Comparison

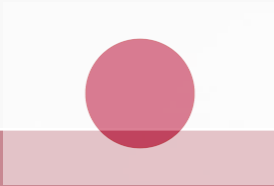




Topic	JAPAN	EUIPO	BRAZIL
Term of protection	20 years from registration 25 years from filing Extensions not allowed	5 years from filing Renewable up to 25 years	10 years from filing Renewable up to 25 years
Grace Period?	Yes 12 months	Yes 12 months	Yes 180 days
Multiple application allowed?	Yes	Yes if same Locarno Class	Yes. Up to 20 if same preponderant features
Description mandatory?	Under certain circumstances	No	No
Views	Set of 6 views / perspective views	1 minimum view 7 views maximum	7 views
Examination	Formal and substantive	Formal	Formal

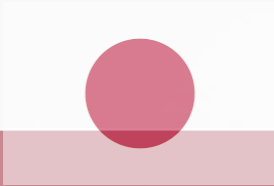


Comparison

Topic	JAPAN	EUIPO	MEXICO
Term of protection	20 years from registration 25 years from filing Extensions not allowed	5 years from filing Renewable up to 25 years	5 years from filing Renewable up to 25 years
Grace Period?	Yes 12 months	Yes 12 months	Yes 12 months
Multiple application allowed?	Yes	Yes if same Locarno Class	Yes if they form a single design concept
Description mandatory?	Under certain circumstances	No	Yes
Views	Set of 6 views / perspective views	1 minimum view 7 views maximum	Not specified. The necessary to illustrate it
Examination	Formal and substantive	Formal	Formal and substantive

Comparison

			
Topic	JAPAN	EUIPO	ARGENTINA
Term of protection	20 years from registration 25 years from filing Extensions not allowed	5 years from filing Renewable up to 25 years	5 years from filing Renewable up to 15 years
Grace Period?	Yes 12 months	Yes 12 months	Yes 6 months
Multiple application allowed?	Yes	Yes if same Locarno Class	Yes. Up to 20 if same Locarno Class
Description mandatory?	Under certain circumstances	No	No
Views	Set of 6 views / perspective views	1 minimum view 7 views maximum	1 minimum view 7 views maximum
Examination	Formal and substantive	Formal	Formal

Comparison

			
Topic	JAPAN	EUIPO	COLOMBIA
Term of protection	20 years from registration 25 years from filing Extensions not allowed	5 years from filing Renewable up to 25 years	10 years from filing Extensions not allowed
Grace Period?	Yes 12 months	Yes 12 months	Yes 12 months
Multiple application allowed?	Yes	Yes if same Locarno Class	No
Description mandatory?	Under certain circumstances	No	No
Views	Set of 6 views / perspective views	1 minimum view 7 views maximum	7 views
Examination	Formal and substantive	Formal	Formal



Thank you !



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**& H
A**

Argentina (Buenos Aires)

Brasil (Río de Janeiro)

Colombia (Bogotá)

México (Ciudad de México)

Portugal (Lisboa)

Spain (Madrid)