



NEW YORK STATE BAR ASSOCIATION
INTERNATIONAL SECTION

CROSS BORDER PROTECTION OF DESIGN
Global Conference 2019: A World of Many Voices, United in Our Diversity

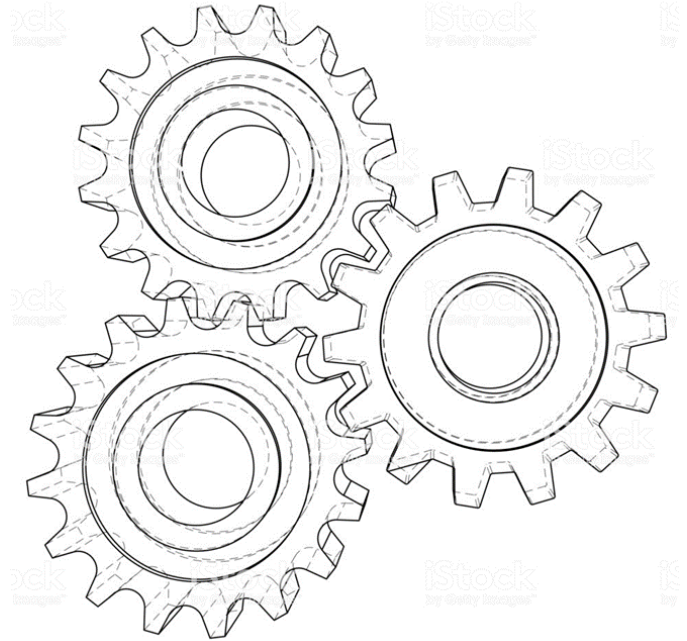
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Introduction to Industrial Designs

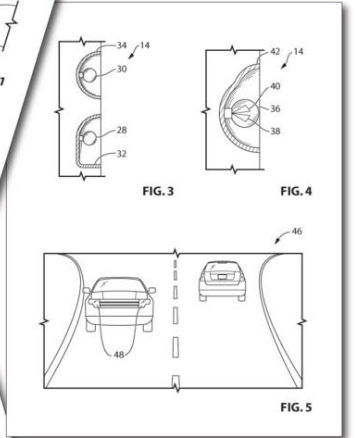
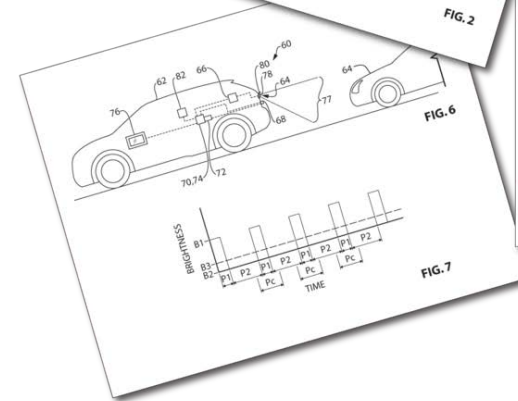
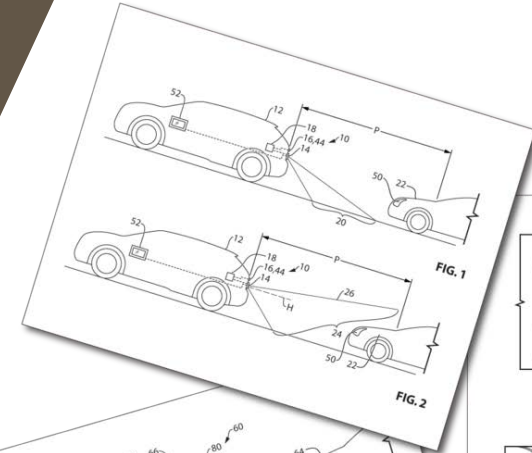
An industrial design may be any confluence of lines or combinations of colors or any external two-dimensional or three-dimensional form that affects the overall appearance or aesthetic of a product.

Legal requirement is NOVELTY.

Legal protection grants the right to exclude third parties from using or commercializing the design.



DOMINICAN REPUBLIC & CENTRAL AMERICA



Dominican Republic

- *Industrial Design: Any confluence of lines or combinations of colors or any external two-dimensional or three-dimensional form incorporated into an industrial or craft product.*

This definition may include pieces of a complex product, its presentation, packaging, graphic symbols and typographic characters, which provide a special appearance without changing the product's end purpose.

- *Complex Product means “a product made up of multiple replaceable components that can be disassembled and reassembled*

*Law No. 20-00 on Industrial Property, as amended by Law No. 424-06.
Office of Industrial Property (ONAPI).*

Legal Requirements

- The design must be “new and of unique character”.

- ✓ Dominican Law requires **worldwide novelty** of the design to be protected.

Exceptions: (a) Disclosures made by the designer or its successors 12 months prior to the filing date of the application; (b) illegal publications of the design which resulted from a breach of trust or contract; or (c) disclosures that result from another illicit activity.

- ✓ A design is considered of **“unique character”** when the general impression produced on an informed user differs from the general impression caused by a previous article with known design.

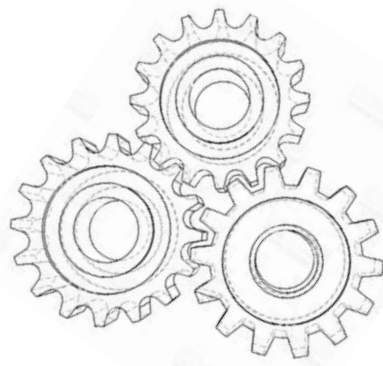


Could a complex product be protected as an industrial design?

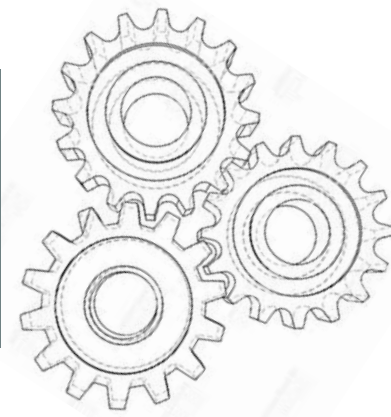
YES, but only if the design is visible when the product is being normally used and to the extent these visible characteristics of the component are in and of themselves new and unique.

Term of Protection

- ✓ Protection is acquired **through registration** before the ONAPI.
- ✓ 5 years from the filing date, with 2 additional periods of 5 years available when requested.

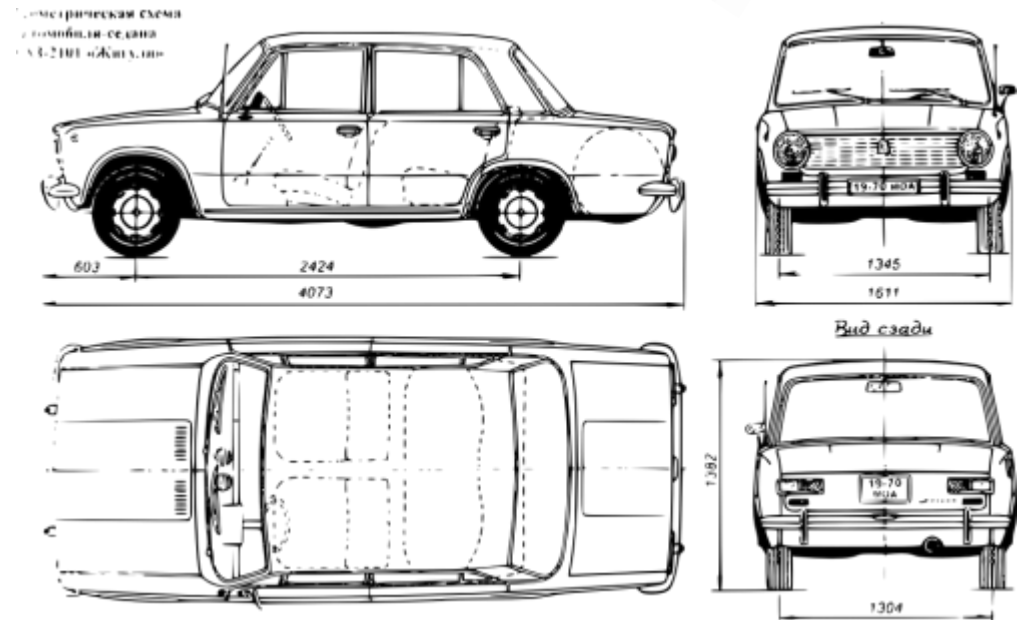


Phases of Registration Process & Estimated Fees



1. Filing of the application;
2. Formal examination;
3. Publication;
4. Third-party objections;
5. Merit examination;
6. Grant of protection & issuance of registration certificate.

Estimated expenses: US\$1,200.00



Scope of Protection

- Registration of an industrial design confers its holder the right to exclude third parties from commercially exploiting the design.
- This includes the right to act against any person who manufactures, sells, offers for sale, uses, imports or stores, a product which replicates or incorporates the protected industrial design or its appearance, without the holders' consent.

Protection by Other IP or Competition Laws



- Designs can simultaneously be protected by other legal provisions, such as copyright, trademark or unfair competition.

Exhaustion Principle



- The holder of the rights may not prevent the sale, rental, use, usufruct, importation, or any mode of marketing of a product protected by the patent and obtained by the patented process, once said product has been placed in the commerce of any country, with the consent of the patent holder or of a licensee or in any other lawful form. Products or processes in violation of industrial property rights are not considered lawfully placed.

Article 30, Law No. 20-00

Infringement

- Online infringement: The successful resolution of an online infringement will depend on where the infringed goods are stored or manufactured, and where the illicit activity takes place. **Unfortunately, the general rule of territoriality of IP laws applies.**
- Seizure of Goods: Article 173 of Law 20-00 confers the holder of the registration the right to demand infringers to seize the goods manufactured, sold, offered for sale, or used in infringement of the registered industrial design.
- Litigation Best Practices:
 - Conduction of a design search to determine its compliance with the law and its distinctive features will serve to prepare for invalidation actions and to enhance possibilities of launching successful infringing actions.
 - A warning letter- cease and desist- is always a recommendable action prior to launching a full-fledged litigation.



INDUSTRIAL DESIGN PROTECTION IN CENTRAL AMERICA







Definition

Panama	Costa Rica	Honduras	Guatemala	El Salvador	Nicaragua
<p>An <u>industrial design</u> is any combination of figures, lines or colors that provide a unique and peculiar appearance to an industrial product.</p> <p>An <u>industrial model</u> is any tridimensional shape that serves as a pattern for the manufacturing of an industrial product, and which provides it with a special appearance that does not imply technical effects.</p>	<p>An <u>industrial design</u> is any combination of lines or colors that are incorporated into an industrial or artisanal product, for ornamental purposes and that provides the article of a distinct appearance.</p> <p>An <u>industrial model</u> is any new form or disposition that is obtained or introduced in tools, work materials, or familiar objects, that provide a special function for its use.</p>	<p>Any two-dimensional or tridimensional shape that provides a special appearance to an utilitarian product, and that is suitable to serve as a pattern for its manufacturing.</p>	<p>An <u>industrial drawing</u> is any combination of figures, lines or colors that are incorporated into an industrial or artisanal product, for ornamental purposes and that provides the article of a distinct appearance.</p> <p>An <u>industrial model</u> is any tridimensional form that is suitable to serve as a pattern for the industrial manufacturing of a product, that provides it with special appearance, and which does not add technical features.</p>	<p>Any two-dimensional or tridimensional shape that when incorporated into a useful product it provides a special appearance, and that is suitable to serve as a pattern for its manufacturing.</p>	<p>It is a particular feature of a product that results from its lines, shapes, configuration, color, material or ornamentation, and it can comprise industrial drawings and models.</p>


Legal Requirements

Panama	Costa Rica	HONDURAS	GUATEMALA	EL SALVADOR	NICARAGUA
					
Novelty and industrial application	Novelty, originality and independency	Original and industrial application	Novelty	Novelty	Novelty, industrial application and inventive level.

Is registration required to obtain legal protection?

Panama	Costa Rica	HONDURAS	GUATEMALA	EL SALVADOR	NICARAGUA
					
No, it can be obtained through the holder's first disclosure	Yes	Yes	No, it can be obtained through the holder's first disclosure	No, it can be obtained through the holder's first disclosure	No, it can be obtained through the holder's first disclosure

Term of Protection

Panama 	Costa Rica 	HONDURAS 	GUATEMALA 	EL SALVADOR 	NICARAGUA 
<p>10 years + 1 additional term of 5 years available, when requested</p> <p>If the design was protected upon its disclosure, its term is for 3 years.</p>	<p>10 years, non-renewable</p>	<p>5 years + 2 additional term of 5 years available, upon request</p>	<p>10 years + 1 additional extension of 5 years, upon request</p> <p>If protection was granted upon the disclosure of the design, its term is for 3 years.</p>	<p>10 years, non-renewable</p>	<p>5 years + 2 additional periods of 5 years available, when requested</p> <p>If protection was granted upon the disclosure of the design, its term is for 3 years.</p>

Infringement

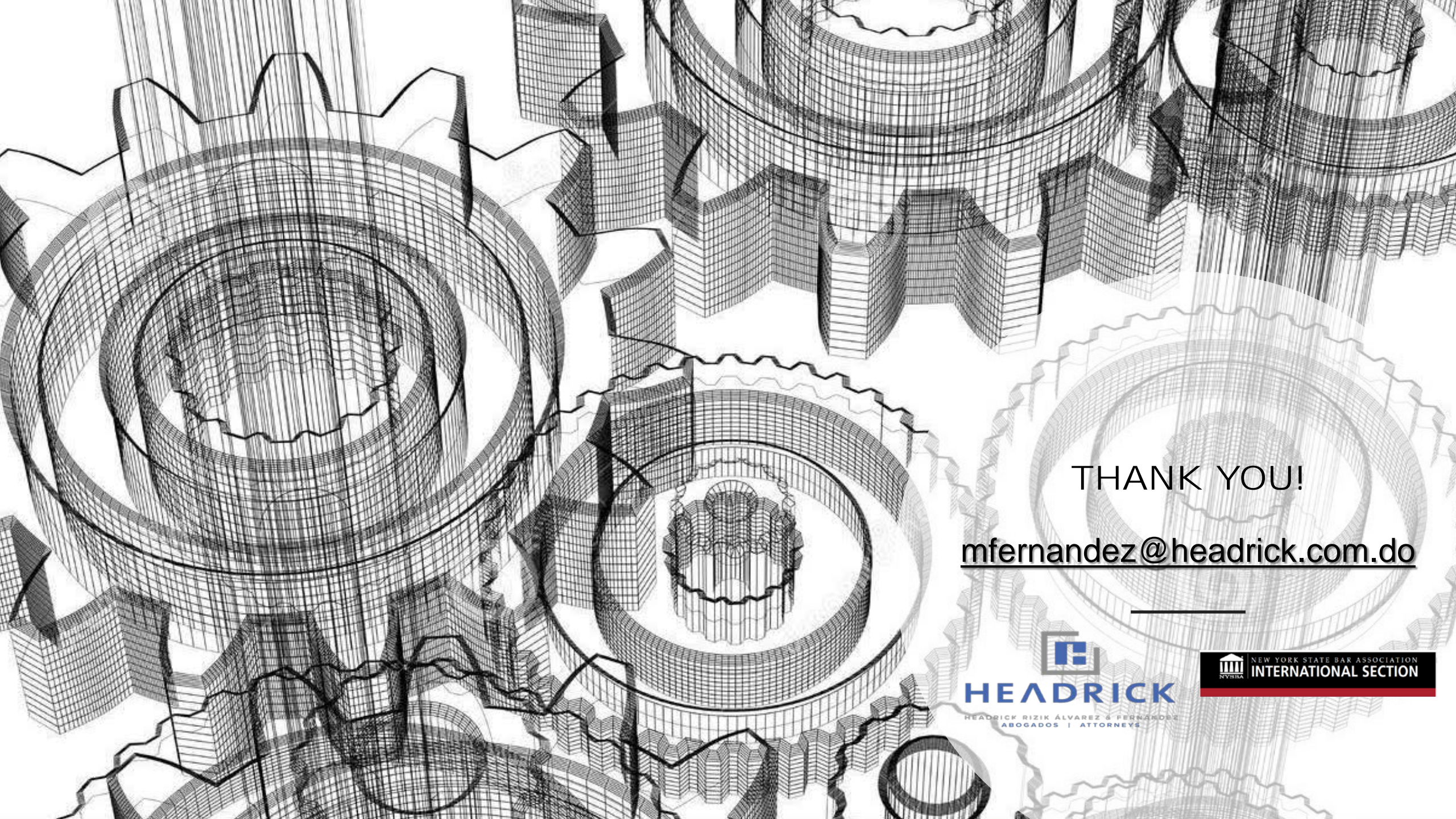
- Online infringement:
 - Precedents of online infringement are not available.
 - The holder may use the Notice and Takedown (DMCA), to report the web page.
 - Territoriality of IP: Authorities will require that infringed goods are inside the country.
- Seizure of Goods: The holder of the registration may seize infringed goods with an injunctive relief granted by a judge.
- Litigation Best Practices:
 - Conduction of a design search to determine its compliance with the law and its distinctive features will serve to prepare for invalidation actions and to enhance possibilities of launching successful infringing actions.
 - A warning letter- cease and desist- is always a recommendable action prior to launching a full-fledged litigation.

SIMILARITIES IN CENTRAL AMERICA

- General requirement of **novelty** and **non-functionality**.
- **Scope of protection:** Right to exclude third-parties from using and exploit the protected design.
- Designs may be also **protected by other legal provisions**, such as copyright and trademarks.
- Application of International Exhaustion Principle
- **Licensing and transference** of IP right is permitted.
- Neither Dominican Republic or any of the CA countries are members of the **Hague Agreement**

DIFFERENCES IN CENTRAL AMERICA

- In Panama, El Salvador, Guatemala and Nicaragua **registration is not required to receive legal protection** on an industrial design.
- In Panama, Costa Rica, Honduras, Guatemala and Nicaragua **industrial models** are comprised in the definition of industrial designs.
- Nicaragua and Honduras require the design to have **industrial application** to receive legal protection.



THANK YOU!

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ABOGADOS | ATTORNEYS



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