



NEW YORK STATE BAR ASSOCIATION
INTERNATIONAL SECTION

CROSS-BORDER PROTECTION OF DESIGN

Mock case

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Mock case scenario 1/7

- ▶ Company A ("A") is an international company whose head office is in the US.
- ▶ A wants to develop a new electric desk lamp. A wants designer Z ("Z") to design the new electric desk lamp for A.
- ▶ Z has completed a design for the new electric desk lamp.
- ▶ A has obtained, from Z, all of the intellectual property rights necessary to make applications for design registration, entering into a proper contract with Z.

Mock case scenario 2/7

- Z's design: an electric desk lamp with a touch screen panel which allows users to enjoy multiple functions, for instance, changing the color of the light, listening music, using the Internet, etc.
- Z's design includes graphic images displayed on the touch screen.
- The graphic images are supposed to be provided through a cloud base system.
- The design and engineering have been fully completed and approved.

Mock case scenario 3/7

- ▶ A wants to register the design of the new electric desk lamp in the following area. A considers whether to utilize the Hague Agreement Concerning the International Registration of Industrial Designs.
 - ▶ The US
 - ▶ Central America (Dominican Republic)
 - ▶ The EU
 - ▶ China
 - ▶ Japan

Mock case scenario 4/7

- A wants to start promoting and selling the new electric desk lamp in the US, Central America, the EU, China, Japan through the following sales channels.

	The US	Central America	The EU	China	Japan
Direct sale	○				
Distributor		○			
Licensee(exclusive/ non-exclusive)			Non- exclusive license		Exclusive registered license
Selling the project to local company				○	

Mock case scenario 5/7

- Shortly after A has discovered that the new electric desk lamps are copied by third parties in all the above countries and A wishes to stop illicit manufacturing and sales.
- A considers utilizing design law protections as well as other intellectual property related law protections.
- A also considers what kinds of legal proceedings to use.

Mock case scenario 6/7

- ▶ A becomes also aware that the illicitly copied lamps have been sold on each local e-commerce websites by third parties.
- ▶ In addition, what if the e-commerce website is not operated by a local company, but is operated by a foreign company based in a country other than all the aforementioned countries, In addition, no server hardware for the e-commerce website is placed in any of the aforementioned countries. However, the e-commerce website can be used by local customers.

Mock case scenario 7/7

- ▶ A becomes also aware that the new electric desk lamps with discount price (90% compared to a local price) are sold on local e-commerce websites. It turns out that the new electric desk lamps sold on the local e-commerce websites are the ones which were properly and legally sold in other countries through the sales channels written above.