

Appreciating Aesthetic Appeal – Protecting Design Investments

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Differentiation by design: In a world competing for eyeballs, securing rights in aspects of the appearance of products should be at the top of the mind of the manufacturers, producers and retailers of especially consumer goods. For consumer goods to be aesthetically pleasing or to contain characteristics that are unique, provides a significant advantage in the struggle for the attention and purchasing power of consumers.

Considering that the first experience a consumer has with a new product is in most cases a visual one, it can hardly be contested that how a product looks is of paramount importance in attracting consumers.

With respect to many products in the market it is possible to take the view that functionality on its own is not enough to differentiate products in a world where the level of functional similarity of products is increasing. Being better designed is critical to standing out from the crowd and enhances the chances of successfully competing for the attention of consumers. Features of the design and ornamentation of products that contribute to the overall aesthetic appeal thereof can make products stand out in the crowded market place and can often be protected as industrial designs or models.

Protecting design investments

The UAE Patents, Industrial Designs and Models Law (Law No. 17 of 2002) distinguishes between designs and models. Industrial designs are defined as any original formation of lines or colours, or both, giving a special feature that can be utilised as an industrial or vocational product. Industrial models on the other hand are defined as any original dimensional object giving a special feature that can be utilised as an industrial or vocational product. The UAE law accordingly goes a long way to protect the shape, configuration and general appearance of products, as long as the aspects of the design that are sought to be protected falls within the scope of the law. Examples of the subject matter of design protection may include the tread pattern of a shoe, the shape and configuration of a mobile phone handset, the shape and configuration of a product container or even that of a piece of candy.

Design registration is valuable in the protection of new shapes and configurations of products, as well as trade dress in a competitive environment where “me-too” products will emerge if intellectual property rights are not protected. In addition to the protection afforded to intellectual property rights through copyright laws and the registration of trademarks and patents, the registration of designs provides yet another very important mechanism for the protection of creative effort and the considerable investment that underpins it.

A registered design can be a valuable asset as part of an intellectual property portfolio and an advantage in the perpetual race against competitors. In order for subject matter to be registrable as a design or model, it is required that the design or model should be novel or innovative, that it can be used as an industrial or vocational product and that it does not cause prejudice to public order or violate morals. In the UAE as in many other countries in the region, the novelty required is absolute novelty, meaning that the disclosure of the design or model in markets inside or outside the UAE

prior to applying for the protection thereof will have an impact on the rights that may be secured.

Particular points of interest in applying for the registration of, and prosecuting a design application in the UAE are that:

- There is generally no substantive examination of a design application. The application is merely examined with respect to application formalities. This means for example that a design application is unlikely to be examined with respect to the novelty requirement and it is left to industry to assess new design applications and oppose or cancel those that may not comply with the requirements of the Patents, Industrial Designs and Models Law.
- It currently takes roughly 18 months to 2 years from the date of applying for the registration of a design to the registration thereof.

Exclusivity in designs

Once a registered design or model has been obtained, following examination and issuance of a certificate of registration, the proprietor of the right has the exclusive and legally enforceable right to use and exploit the registered design. If another person uses the registered design without authorisation, the proprietor may take action to stop such unauthorised use.

The proprietor of a registered design enjoys the right to prevent third parties from:

- using the design;
- importing any product that incorporates the design; and
- possessing a product incorporating the design with the intention to use, offer for sale or selling the same.

In addition to the rights set out above, a registered design also affords the proprietor the exclusive right to authorise others to use the design, which may represent a significant revenue stream in the form of licence fees or royalties.

Thinking about the future

The protection of designs is territorial in nature, meaning for instance that, a registration in the UAE will afford the rights set out above in the territory of the UAE only.

The protection of potentially valuable designs and models must accordingly be approached strategically with a view to seeking protection not only in the “home market”, but also in those markets where the distribution of a product is likely to expand to. Bearing in mind the requirement of novelty, an appropriate protection strategy must also take into consideration the first disclosure of the design and how design and model registration applications can be prioritised or staggered (as priority may be claimed for a short period from design or model applications filed in certain other countries) in order to provide the most appropriate protection.

The registration of designs and models are valid for a limited period of time only and in the UAE this is ten years, provided that annual maintenance fees are paid on time. Once the registration has lapsed, the design becomes freely available for anyone to use as it passes into the public domain. However, the design subject matter may still be protected by other intellectual property laws such as the law related to copyright, while the branding associated with the design can remain protected by way of trade mark registration.

A best practice to consider

A best practice with respect to the development of new design matter is for the appropriate intellectual property protection strategy to be considered before the design matter is introduced to the market or published in any way. As absolute novelty is a requirement for the protection of designs and models, the absence of an internal process that ensures the consideration and protection of intellectual property rights prior to the use or disclosure thereof can cost a business the exclusive use of its design investments. Such a loss translates directly to (i) the possible loss of exclusivity in the use of the design, (ii) the possible loss of a competitive advantage, and (iii) the likely loss of revenue.

Taking care of design investments

Al Tamimi & Company's intellectual property department offers comprehensive advice on the protection of product design and design features, including product shapes and ornamentation, packaging design and trade dress. From the very inception of a new design or model, our team can assist in the identification of protectable intellectual property and the development of the most appropriate protection strategies in the UAE and the wider region. In addition to advising on the protection of rights, our intellectual property department also supports clients in maintaining these rights and perhaps most importantly, in protecting their valuable design investments through the enforcement of their rights against infringers.

Authored by Stephen Jiew. Certain details of the above first appeared in the UAE chapter on Industrial Design Protection in the publication entitled 2012 International Design Protection: A Global Handbook published by Globe Law and Business