In a world which places an emphasis upon aesthetics, the appearance of a product can be a determining element in the consumer’s final purchasing decision. The design, look and feel of a product may to a large extent contribute to its success or failure. The design creates the emotional connection with consumers and directly contributes to brand building. In short, success in the marketplace often depends upon how good a product looks rather than simply how well it works particularly when the market offers a large variety of products with the same or similar function.

How can a product design be protected? When can it be protected as an industrial design, a patent, a copyright and/or even a trademark?

This article is the first among a series of articles related to design protection and focuses on how should an entrepreneur or a business decide about its intellectual property rights and particularly in relation to their new product designs.

**Industrial Designs**

The Industrial Designers Society of America had a very unique take when defining the profession of industrial design: “Industrial design is the profession that determines the form of a manufactured product, shaping it to fit the people who use it and the industrial processes that produce it. Industrial Designers work to make our lives more comfortable, pleasurable and efficient. By studying people at work, at home and in motion, they create products like office chairs that promote proper posture, kitchen tools that are comfortable even for elderly hands and toys that provide safe play and learning for all children. In particular, Industrial Designers deal with the parts of a product that humans interact with, striving to give universal access to products that are ecologically responsible and safe to use. Also, they give a product with distinctive elegance that makes us want it”.

Industrial design is the main legal vehicle for the protection of a product design.

The simple legal definition of an “industrial design” as defined by the World Intellectual Property Organization is that “an industrial design constitutes the ornamental or aesthetic aspect of an article. An industrial design may consist of three dimensional features, such as the shape of an article, or two dimensional features, such as patterns, lines or color”.

In order to secure industrial design protection of a product design, it has to in principle be registered before the relevant authority depending on the country where protection is sought. There are national, regional and international vehicles for the registration of industrial designs which may be considered as part of the protection strategy depending on the particularities of each case. Industrial design protection has to be applied for while the product design is still in the confidential stages before being disclosed to the public through any means including online marketing even if the product is yet to be placed on the market. Only a limited number of countries provide a grace period for the protection of an industrial design after an initial disclosure is made by the designer.

In the GCC, industrial design protection is afforded by registering the product design in each country of interest separately through the national patent office. Industrial design registration is possible in all GCC countries except Qatar for now, though it is expected that Qatar will start to accept industrial design applications soon. There is no regional vehicle for the protection of industrial designs as it is the case for patents. In the UAE, industrial designs are covered under Chapter 3 of the UAE Federal No. 17 of 2002 ("UAE Patents and Design Law") and cover “any innovative three-dimensional shape that can be used in industry or craft” or “any innovative creation of lines or colors that generates a product that can be used in industry or craft”. The practical simple definition of an industrial design would be that it is the “visual”, “aesthetics” and basically “overall look and shape of a product”.
Application of Product Designs

Industrial designs are applied to a wide variety of products such as packages, furniture such as chairs, architectural products such as structures and buildings, vehicles such as aircrafts and cars, arms such as rifles, electronic products such as mobile phones, food products such as chocolate bars, jewelry items and many other products.*

Why protect?

It is important to protect a product design using the appropriate legal vehicles in a strategic manner. The objective behind protection is to prohibit third parties from misappropriating the design or using similar confusing designs for their own benefits. Also, intellectual property protection of product designs adds to the assets of the business and therefore increases its commercial value.

The aim of legal protection is to arm the product design owner with the proper legal tools to deter any third parties seeking to manufacture/sell knock offs of the same design or a very similar one that can be confused with the original design. Without adequate legal protection, the product design owner would not be able to pursue these copycats.

As noted above, without protection, a product design owner does not enjoy exclusive rights. This means that any competitor may imitate the design (copy or substantially copy) of a product and take it to the market.

Though industrial design is the main vehicle for the protection of a product design, other intellectual property vehicles including patents, trademarks and copyrights should also be considered to protect other dimensions of the product as part of the overall protection strategy.

The following will explain briefly how the other intellectual property vehicles can be used as part of the product design protection strategy.

Patents

Briefly, patents are for new inventions or processes that offer innovative and useful functions. Design features of a product can either be “ornamental” or “functional”. For example, let us take the example of a water bottle with newly designed strips. If the strips of the bottle are adapted to provide a better hand grip, then these strip designs are functional in nature. If the strips have no functional benefits and are designed solely to provide an aesthetic look of the bottle, then the strip designs are ornamental in nature.

From a legal perspective, the available protection would differ depending on the qualification of the design features as “functional” or “ornamental”. The protection of “ornamental” features of articles would fall under “industrial designs”, whereas the protection of “functional” features of articles would fall under “patents”.

The distinction between “functional” and “ornamental” is fundamental but it is not always easy to make. The qualification of a feature as “ornamental” can result in disqualifying the feature as “functional” and vice versa. Some products comprise both “functional” and “ornamental” design features, and it is important to carefully define the product categorization at the outset before applying for legal protection.

By carefully “segregating” the relevant “ornamental” features from the “functional” features, it is possible to obtain a patent for an article’s functional aspects and an industrial design for its aesthetic ones (provided that the protection criteria’s are met). If protection is to be sought under both patents and industrial designs, it is in principle recommended for the applications to be prepared and filed simultaneously.
It should be noted that the legal requirements for industrial design protection are generally less stringent than those for patent protection. However, the scope of industrial design protection is generally narrower as it is limited to the exact shape of the design. The period of protection for industrial designs is generally 5-15 years in comparison to 20 years for patents. Patent protection is afforded by filing a patent application before the relevant patent office.

**Trademarks**

A trademark is designed to identify the origin and source of goods. The trademark laws are designed to protect the name, design or other indicia of origin used by a seller to distinguish goods and services. In the UAE, trademark protection is afforded under Federal law No. 37 of 1992 as amended (“UAE Trademarks Law”).

Trademark protection can be afforded when the design of the product is non-functional and is also used as a source indicator. In fact, the shape of a product can be an aspect that distinguishes it from someone else’s product. In this case, the three-dimensional shape of the product would be considered as a non-traditional trademark and it would be recommended to register the product design as a trademark in addition to any industrial design registration.

The advantage of registering a trademark is that trademark protection can be afforded even if the design is not novel (for example when the product is already on the market) and provides its owner with ongoing protection as long as the trademark retains its distinguishing feature(s) as a source indicator, whereas the industrial design protection is more limited in time and can be afforded only if the design is novel. On the other hand, industrial design would allow protection of the design product to be secure even if the shape product loses its distinguishing feature as a source indicator.

Trademarks protect the distinctive non-functional features that relate to and indicate the source of origin of a product.

An example would be the “Hershey Kiss” design which serves to indicate the origin of the source (i.e. it identifies this chocolate from a single source or association) without the traditional words or logo.*

In addition to a product shape, there is also nowadays trademark protection afforded -subject to the applicable laws- for the “total image” or “overall appearance” of a place when this design serves as an origin indicator, such as a restaurant or store interior design. These would also fall under non-traditional trademarks.

An example of store trade dress is the storefront designs for 'Build a Bear’, which the company has trademarked at the United States Patent & Trademark Office (USPTO.) [2] *

The UAE has started to recognize at least some of these non-traditional trademarks and we have had the opportunity to register non-traditional trademarks before the UAE Trademarks Registration Office.

**Copyrights**

Copyrights protect the artistic creations of authors and artists that are original. In some occasions, a design can be protected under copyright. This has to qualify as a work of art under the applicable copyright law. In the UAE, copyright is regulated under the Federal Law No. 7 of 2002 pertaining to Copyright and Neighboring Rights (“UAE Copyright Law”).

Copyright is a form of protection under the UAE Copyright Law provided to authors and covers any creative work in the field of literature, or the arts, or the sciences, of whatever kind or manner of expression, or
whatever its importance or its purpose. A work need be original, that is not a copy. A “work” is defined under the UAE Copyright Law as any created compilation, in the scope of letters, arts, sciences, whatsoever its type, mode of expression, value or purpose. It includes sculptural works, works of applied art and plastic art, works of drawings by means of lines or colors, and various types of works in the field of fine arts. It also covers three-dimensional works relating to geography, topography and architectural designs.

 Mostly an industrial design at the embryonic stages of creation and design commences as a work of art before being integrated in useful articles and as such may be originally protected by copyright. Product designs meeting the requirements for protection under “industrial designs” can in some occasions be protected under “copyright” subject to the applicable laws in the country or countries where protection is sought. For example, some countries apply the doctrine of separability and consider that copyright protection can only be afforded when the artistic elements of the design must in some way be separable from the utilitarian functions it serves. All in all, there are various elements to consider for copyright protection of product designs and it is best to seek advice on a case by case basis.

**Protection Strategy**

The possibility of protecting a product design through other forms of intellectual property vehicles in addition to an industrial design should be considered on a case by case basis. It is important to note that use of one legal vehicle can disqualify use of another legal vehicle for the protection of a design. The overall protection strategy must be crafted carefully with the different protection vehicles coordinated accurately prior to applying for any protection. Industrial design and patent protection should normally be considered first before filing for any trademark or copyright protection to avoid any public disclosure of the design which can destroy its novelty and disqualify the product for industrial design and patent protection. Again this is assessed on a case by case basis and subject to the totality of circumstances.

**Testimonials...**

We had the opportunity to work with our client, Anna Szonyi, the winner of the Urban Commissions for her design then known as the “Boomerang Bench” which was unveiled at Design Days Dubai in 2015. The design, formerly known as the “Boomerang Bench is now known and commercialized as IDO by Aubrilam (“IDO”). The concept behind the IDO entailed a 3.6m long bench comprised of 73 boomerang-shaped pieces of solid Burma teak wood which rotate to create a continuous fanning effect and innumerable seating forms.

The IDO was protected using both the industrial design and patent vehicles in the UAE and abroad. The ornamental and aesthetic features of the IDO bench were the crux of industrial design protection, where the functional features thereof were the crux of patent protection.

The IDO is a good example of how different intellectual property rights can dovetail if handled carefully. Most importantly, registration enabled Anna as an entrepreneur to leverage the commercialization of her product. With the industrial design protection, Anna would acquire monopoly on the shape of the bench. With the patent protection, Anna’s monopoly would extend as well to cover the pivoting bench assembly regardless of the exact external shape of the bench. Patent protection would allow Anna to catch any potential infringer trying to design around the shape of the bench but using the same concept of the pivoting mechanism of the bench. Equally, design protection would allow Anna to catch any potential infringer exploiting a bench product with the same shape but using a different pivoting mechanism. Protection is therefore maximized by using the different forms of intellectual property to protect the different dimensions of the product. This is a crucial link between protecting ones designs and innovations with promoting entrepreneurship.
Nelepa, CEO and founder of D Idea Media, the company behind the Smart Palm®. Viktor is also the inventor of the Smart Palm®; a palm shaped self sustainable solar power system where solar cells form the leaves of the palm (“Smart Palm®”). The Smart Palm® adapted for providing pedestrians with a resting station equipped with an electronic kiosk with innovative applications, device charging slots, complementary Wi-Fi access, a camera, an emergency button and smart info application which provides users with smart city information. This is in addition to much other innovative functionality. Additionally there is a seating area for pedestrians to rest.

The shape of the Smart Palm® has been protected through industrial design, where the functional innovative features have been covered under patent protection. With the industrial design protection, Viktor would acquire monopoly on the shape of the Smart Palm®. With the patent protection, Viktor’s monopoly would extend as well to cover the innovative functional aspects of the Smart Palm®. Patent protection would allow Viktor to catch any potential infringer trying to design around the shape of the Smart Palm® using the same innovative concepts of the Smart Palm®. Equally, design protection would allow Viktor to catch any potential infringer exploiting a Smart Palm® with the same shape even if using it for different applications. Protection is therefore maximized by using the different forms of intellectual property to protect the different dimensions of the product. The industrial design and patent protection enabled Viktor to leverage the commercialization of the six meter tall Smart Palm stations to be commercially used in Dubai which are now being installed in Dubai beaches and parks for public use.

Both Anna and Viktor’s innovations enjoyed successful commercialization which has been leveraged by obtaining adequate intellectual property protection over these innovations paving the way for a budding growth in business success with more innovations to come.


[2] http://tsdr.uspto.gov/#caseNumber=78239473&caseType=SERIAL_NO&searchType=statusSearch

[3] Urban Commissions is a design initiative launched by Dubai Culture & Arts Authority and Dubai Design District (d3) in 2014 to celebrate the UAE’s growing design-conscious urban development and engage with the local design community and product industries.

* Image courtesy of wikipedia.com