



University of Catania  
Jean Monnet Chair in International Business  
for European Union (IB4EU)  
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# Essentials on establishment and exploitation of IPRs - II



**R o n c u z z i & A s s o c i a t i S . r . l .**

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2004 – 2015





# IPR

● IPR is the acronym for  
INTELLECTUAL  
PROPERTY RIGHTS





# IPR

- Intellectual property is an expansive and rapidly changing area of the law which deals with the formulation, usage and commercial **exploitation** of original creative works.

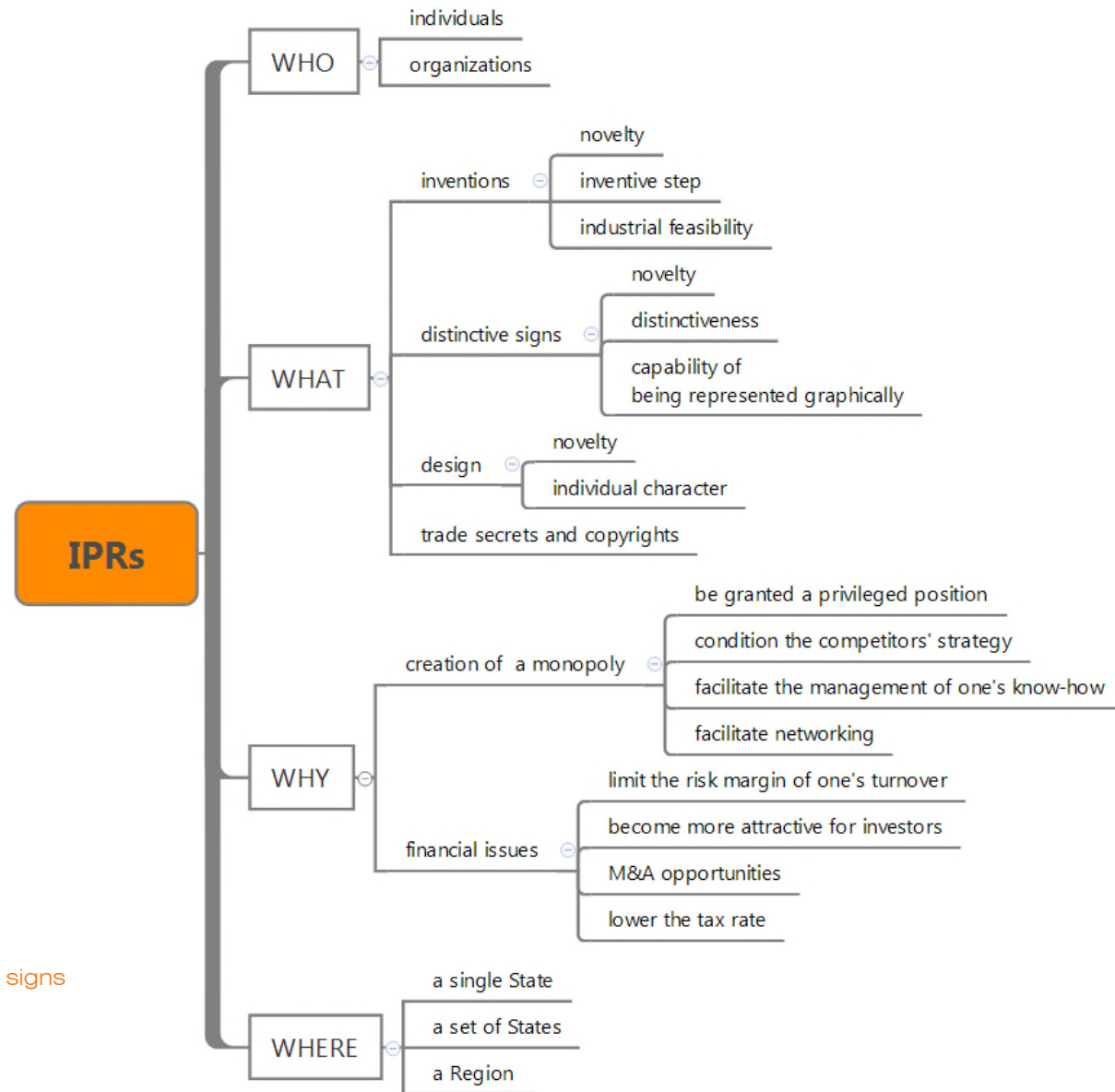




# IPR

- A majority of the issues that arise within this area revolve around the boundary lines of **intangible property rights** and which of those rights are afforded legal protection.





unregistered signs





# IPR - Who

- Individuals and organizations are allowed to file applications to get their asset registered.
- The problem is if seeking for a registration is really of use for them.





# IPR - Who

- Jump into Intellectual Property is very challenging and very often changes one's own scenario very deeply.
- Benefit from IPR needs entrepreneurial attitude, challenging approach to problems, being curious.





# IPR – What

- Patents, trademarks and designs are registered assets.
- They are grantable at the end of a formal procedure before Intellectual Property National or Regional Offices that starts with the filing of an application.







# IPR – What

- An examiner verifies if the object of the application fulfils determined requirements.
- The basic requirements are established by the “Paris Convention”.
- Each State or Regional Authorities rules the matter through a law system and its jurisprudence.





# IPR – What

- Each grant can be revoked in case it is possible to prove that the examiner misinterpreted the “position” of the object of the application within the prior art and the fulfilment of the requirements established by the law.





# IPR – What

- In certain systems, an administrative procedure called opposition might be launched before the Intellectual Property State Agency to limit or get a granted-to-be/a just granted IPR cancelled.
- Oppositions might be managed directly without the assistance of a lawyer, at a limited cost.





# IPR – What

- Local/ regional Courts can always manage limitation or nullity actions of granted IPRs after the definitive conclusion of their administrative procedure (when IPRs are fully enforceable rights).
- Notably, only lawyers are admitted to Courts. This usually makes the procedure more structured and the costs usually much higher.
- Additionally, time to goal is surely longer and decisions are not always more straightforward.





# IPR – What – Patents

- A patent is a registered title of property related to a solution of a technical problem.
- It grants the owner (or a licensee) the exclusive right to exploit the referred invention in a determined territory.





# IPR – What – Patents

- A patent can be granted only if its application clearly describes the invention, so that anyone familiar with the matter at the end of reading the wording.
- However, only after the expiry (of the patent) the invention becomes freely exploitable by anybody.





# IPR – What – Patents

Requisites of a patentable invention

- Novelty
- Inventive step
- Industrial feasibility





# Novelty

- Inventions are novel if their teachings are not comprised in the “**prior art**” for the skilled persons (at the filing date of the relative patent applications).
- Novelty does not matter with being smart or ingenious (the invention!).







# IPR – What – Patents

Prior art matters with (i.e.):

- written and/or oral publications:
- national and foreign patents,
- articles, books, catalogues, theses, dissertations or publications on websites,
- lectures, workshops, presentations and conferences.





# Inventive Step

- IP Codes usually define Inventive Step in the negative form.
- It is usually stated that it arises when the invention is **not obvious**, meaning that it performs a **surprising effect** for a **man skilled in the art**.





# IPR WHAT ● PATENTS





# IPR – What – Trademarks

- Signs are suitable to become trademarks if they are novel and capable to create distinguishability for determined product/service in a relevant territory.





# IPR – What – Trademarks

Sign



At least 1 class with determined  
categories according to the  
Nice Classification  
45 classes: 1-34 goods, 35-45 services



District





# IPR – What – Trademarks

- A registered trademark is a sign for which an established authority granted an exclusivity right, with the aim to let the owner collecting the public interest on products/services by making their origin clearly distinguishable.





# IPR – What – Trademarks

Trademarks limit:

- the **likelihood of confusion** among products/services of the same nature; and
- the **risk of association** among producers of similar products/services.





# IPR – What – Trademarks

- Identify the origin of products/services in determined fields;
- Ease the choice of a product or of a service provider.







# IPR – What – Trademarks

- Novelty has to be assessed by making a comparison with valid prior trademarks from a verbal, conceptual and phonetical point of view.





# IPR – What – Trademarks

- Distinguishability occurs when the names and logos are fancy, without any reference/link to the product / service to be distinguished.





# IPR – What – Trademarks

The choice of a weak trademark **imposes to accept coexistence** with very similar trademarks.

Simple variations of the wording or immaterial changes to the graphical representation make a similar trademark novel with reference to prior weak trademark rights.





# IPR – What – Designs

Designs are registered IPRs which relate to the aspect of a product, or of one of its own part if this aspect is characterized by:

lines, contours, colors, shape, texture, materials of the product itself, decoration of the goods, **on condition that** this aspect is **new** and presents **individual character**.





# IPR – What – Designs

A design is new for a determined kind of products

- If it differs from the prior design concepts or from the shapes of already divulged/traded products.





# IPR – Where

- Practically worldwide: the Paris Convention is ratified in 176 Contracting Parties/States.
- Focusing on a determined State or through a unitary procedure relative to a Region, if possible.
- Depending on the nature and on strategy of the company with regard to the object of the IPR.





# IPR – Where

- Community Registered Designs, Community Trademarks are available within UE, whereas Unitary Patent is not currently feasible, probably within by the end of 2016.





# IPR - Why

- Create a monopoly
- Origins financial benefits







# IPR - Why

Each IPR is a monopoly:

- grants a privileged position
- conditions the competitors' strategy
- facilitates the management of one's know-how and networking
- eases the restoration of infringed rights by simplifying the related legal activity.





# IPR - Why

- «Freezes» the company knowledge and know-how.
- Bans competitors to freely operate in a determined area of business.
- Forces competitors to make additional effort in developing new concepts to maintain their turnover and profits.





# IPR - Why

A robust and mixed IPR company portfolio makes the company far more attractive to investors:

- M&A opportunities
- lower company tax rate (i.e. Patent Box)





# IPRs

- Additionally, IPRs are a sort of guarantee for the investments in R&D and foster innovation.
- Particularly, granted patents communicate that the firm is in condition to increase its profits and to reduce its risk margin.





# Spread of knowledge

- Steep increase of mobility of managers and employees towards more wealthy competitors or promising business areas.
- Loss of territorial control of knowledge distribution.





# IPR WHAT

## ● Trademarks





## Capability of distinguishing Distance between sign and product/service

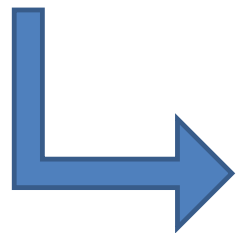
- The sign must be arbitrary, imaginative, “capricious” in relation to the product service to be distinguished.
- Adding a graphical representation is often not enough to lead to the grant of the exclusive right.
- Small verbal or graphical changes are sufficient to prevent from counterfeiting of a weak mark.





# Naming a soap

| Sign         | Type                            | Comment     |
|--------------|---------------------------------|-------------|
| Soap         | General                         | Descriptive |
| Clean dishes | Descriptive of the effect       | Weak        |
| Wash up      | Descriptive of the trade sector | Weak        |
| Tide         | Imaginative                     | Ok          |
| Aquos        | Imaginative                     | Ok          |



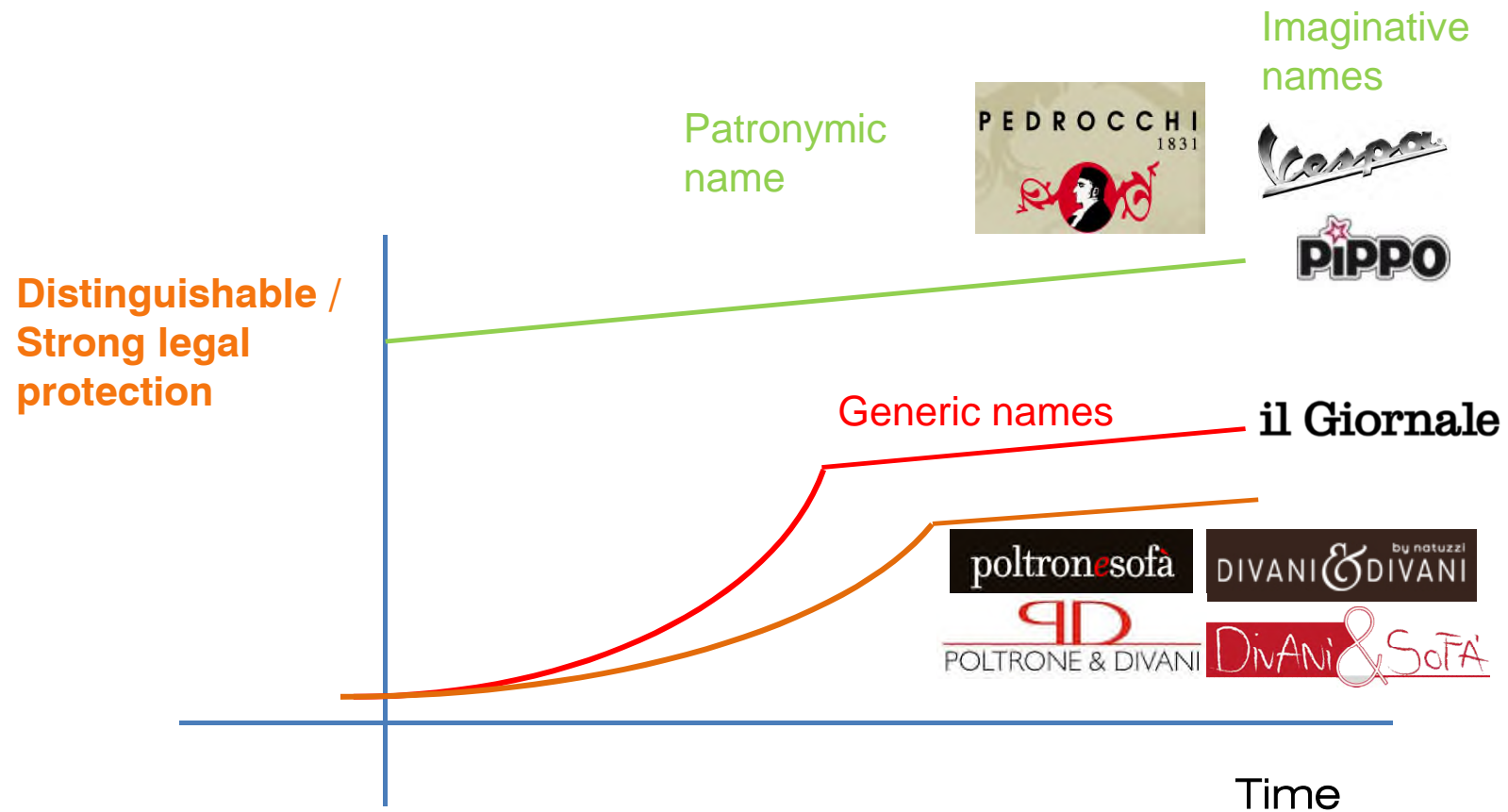
No matter Sharp gave the same name to a television –  
**Different classes of goods**







# “Secondary meaning”





# Designating the class/es

- Nice Classification: as of 1957, it is revisited about every 4 years.
- The 10<sup>th</sup> is now effective.

<http://www.wipo.int/classifications/nice/en/>

## Examples

Class 9: spectacles, software, hardware, scientific instruments, compasses.

Class 18: leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas and parasols; walking sticks; whips, harness and saddlery.

Class 25: clothing, footwear, headgear,

Class 28: Treadmill, exercise machine, toys.





## Trademarks additional purpose (1/3)

- Allow evaluation of characteristics of a product/service even before buying it.





## Trademarks additional purpose (2/3)

A trademark may derive attractive power through the association to already known and appreciated elements, explicitly or implicitly reminded.





# Trademarks boosted

SPAZIO REINVENTATO.

LA SICUREZZA PRIMA DI TUTTO.

CONNETTIVITÀ.

MINI YOURS.

**NUOVA MINI CLUBMAN. RAGIONA D'ISTINTO.**

La Nuova MINI Clubman è più versatile che mai. È la MINI che sa distinguersi in ogni occasione, facendosi notare per il suo carattere e la sua eleganza.

> RICHIEDI UNA BROCHURE  
> RICHIEDI TEST DRIVE

DESIGN.

MINI CLUBMAN



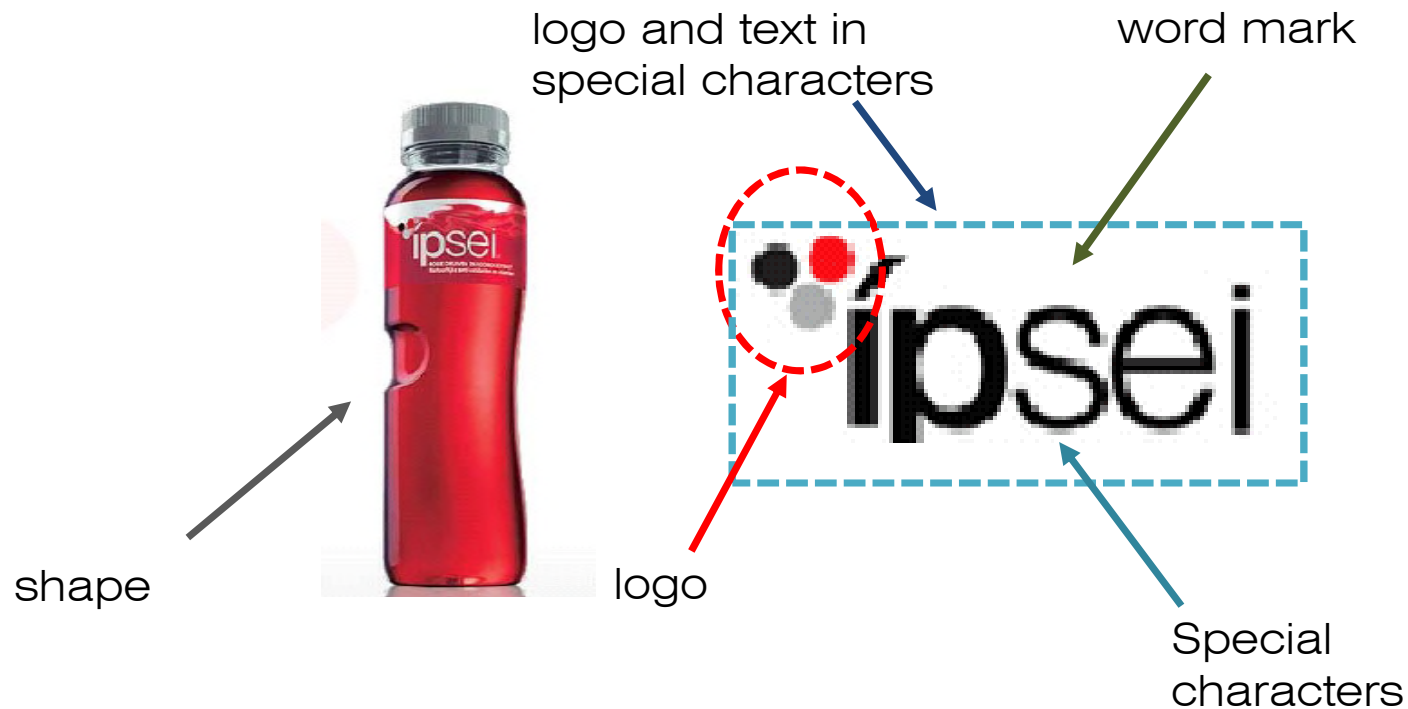
## Trademarks additional purpose (3/3)

- A trademark:
- summarizes corporate values: quality, image, reliability, creativity, type of target, ruggedness, organization, management, sales network
- produces extra-profit by communicating values.





# How many Trademark Applications?



At least 5 trademark applications!



## Therefore, a trademark (1/2):

- aroused the interest of the public;
- makes the product more attractive to customers;







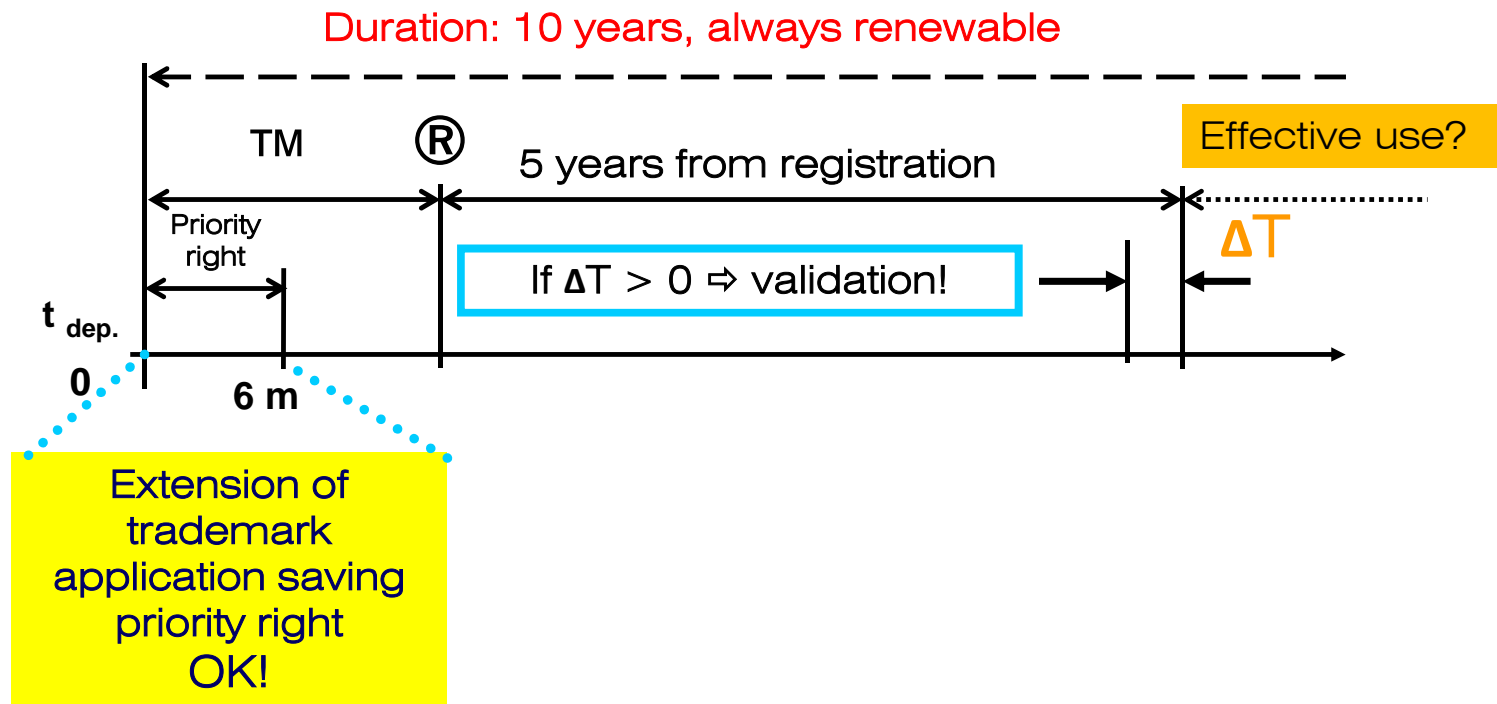
## Therefore, a trademark (2/2):

- generates a privileged position;
- collects value that can be objectively appraised.





# Deadlines





# UIBM – Opposition to trademark registration

- Internal procedure admitted against:
  - ▣ Italian trademark applications published in the UIBM Bullettin;
  - ▣ International registrations designating Italy and published in the WIPO Bullettin of International Trademarks





# UIBM – Opposable Trademarks

- **Identity** with an already registered trademark for identical products or services;
- **identity o similarity** with a trademark already registered for identical or similar products or services if likelihood of confusion between on the part of the public may arise, which may also consist in the likelihood of association between the two signs;
- **Lack of consent to registration** from the owner of rights on names of persons, signs used in the field of art, literature, science, politics and sports, etc.





# OHIM – Opposable Trademarks

- All the conditions admitted by UIBM;
- **unregistered trade marks or other signs used in business** (domain names, company names) and valid in anyone of the UE States;
- **unregistered trademarks** well known in a Member State of the Paris Convention (CUP) under art. 6a;
- **registered trademarks** or National applications that enjoy reputation for dissimilar products / services.





# IPR WHAT ●Design





# How to get the protection:

- through registration, by means of administrative procedure.
- through prior use (IT & UE).





## Advantages of the registration:

- Originates the exclusive right;
- Shifts the the burden of proof to the alleged infringer;
- Ease the trasfer of ownership and use rights.







# Community Unregistered Design Right

- It is protected only by a copy of a design regularly **disclosed** by the owner.





# Community Unregistered Design Right

- **But** ... it is not regarded as deriving from a copy of a CUD the independent creation made by an author who could not reasonably know the CUD.





# Complex Product

- Product made of multiple components assembled together, which can be replaced allowing disassembly and re-assembly (of its components).





# Novelty

- Novelty occurs for a certain design if no identical shape has been made available before the date of its prior disclosure.





# Grace Period

- Grace Period allows to ignore a disclosure of a design model occurred before the application date of its design patent.
- GP lasts 12 months and starts from the date of the first disclosure of the object of the application.





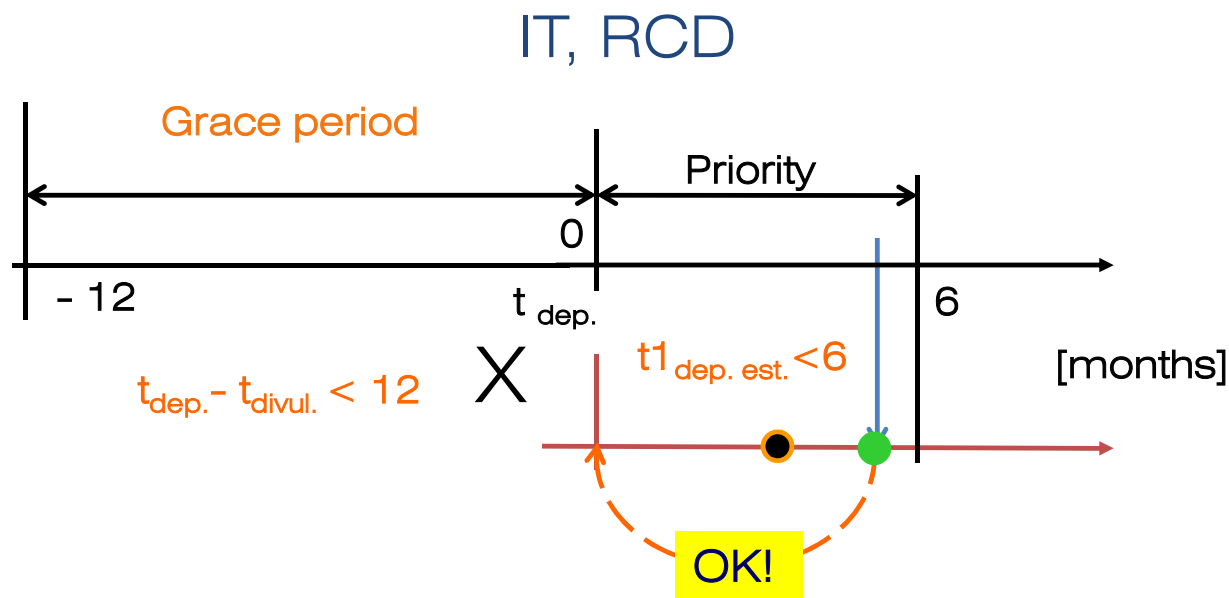
# IDENTITY

- Disegn models are identical when their own characteristics differ only for irrelevant details.





## When applying for registration? (IT&OHIM)



Publication of the application = after filing. Admitted deferred publication up to 30 months from the application date.

Duration of the registration = 5 years renewable 5 five times, up to 25 years of validity.





# Multiplicity

- Ok for OHIM and UIBM on condition that all the designs grouped together in the same application share the same class of the Locarno Classification.





http://www.wipo.int/classifications/locarno/index.htm?lang=en

Locarno Classification

WIPO RESOURCES

WORLD INTELLECTUAL PROPERTY ORGANIZATION

INTERNATIONAL CLASSIFICATION FOR INDUSTRIAL DESIGNS under the Locarno Agreement Ninth Edition

Class 1 Foodstuffs

| Serial No. (En)    | Indication of Goods or Services   | Serial No. (Fr) |
|--------------------|---|-----------------|
| <b>Subclass 01</b> | Bakers' products, biscuits, pastry, macaroni and other cereal products, chocolates, confectionery, ices |                 |
| B0058              | Bakers' products  | B0448           |
| B0288              | Biscuits  | B0265           |
| B0519              | Bread   | P0006           |
| C0037              | Cakes   | G0051           |
| C0114              | Caramels [candy]  | C0178           |
| C0288              | Cereal preparations   | C0326           |
| C0358              | Chewing gum   | G0129           |
| C0383              | Chocolates  | C0566           |
| C0654              | Confectionery   | C0789           |
| C0730              | Cornets (ice cream —) [edible]  | C0861           |
| F0024              | Farinaceous food pastes   | P0154           |
| G0093              | Gingerbread   | P0011           |
| I0006              | Ice cream   | G0096           |
| I0009              | Ice cream cornets [edible]  | C0861           |
| L0229              | Lollipops   | S0403           |
| M0001              | Macaroni  | M0001           |
| M0143              | Meninges  | M0171           |
| N0061              | Noodles   | N0064           |
| P0117              | Pasta   | P0154           |
| P0118              | Pastes (Farinaceous food —)   | P0154           |
| P0119              | Pastries  | P0163           |
| P0192              | Petits fours [cakes]  | P0258           |
| P0284              | Pizzas  | P0412           |
| P0449              | Pralines  | P0777           |
| R0318              | Rusks   | B0264           |
| S0281              | Sherbets [ices]   | S0316           |
| S0558              | Sorbets [ices]  | S0316           |
| S0574              | Spaghetti   | S0348           |
| S0941              | Sweetmeats [candy]  | B0381           |
| T0086              | Tarts   | T0111           |
| V0076              | Vermicelli  | V0077           |
| Z0006              | Zwiebacks   | P0013           |
| <b>Subclass 02</b> | Fruit and vegetables  |                 |
| F0241              | Fruit   | F0196           |

Classes A-Z

1 | 2 | 3 | 4 | 5  
6 | 7 | 8 | 9 | 10  
11 | 12 | 13 | 14 | 15  
16 | 17 | 18 | 19 | 20  
21 | 22 | 23 | 24 | 25  
26 | 27 | 28 | 29 | 30  
31 | 32





# Images/drawings

- It is advisable that the filing documents of a design application comprises images that allow a precise interpretation of the object.





# UIBM

- Any kind of image is accepted (photo, drawing, sketch).
- Example: [Borse testo](#)  
[Borse figure](#)





# OHIM

- Almost as for UIBM, but some guidelines have to be followed with regard to the image format if the application is filed on-line.





# Description of the design

- It is optional both for Community and Italian design applications.





# Deferment of publication

- The applicant (for a registered Community design) may request that the publication of the registered Community design be deferred for a period of 30 months from the date of filing the application or from the date of priority.
- How? By the application form.





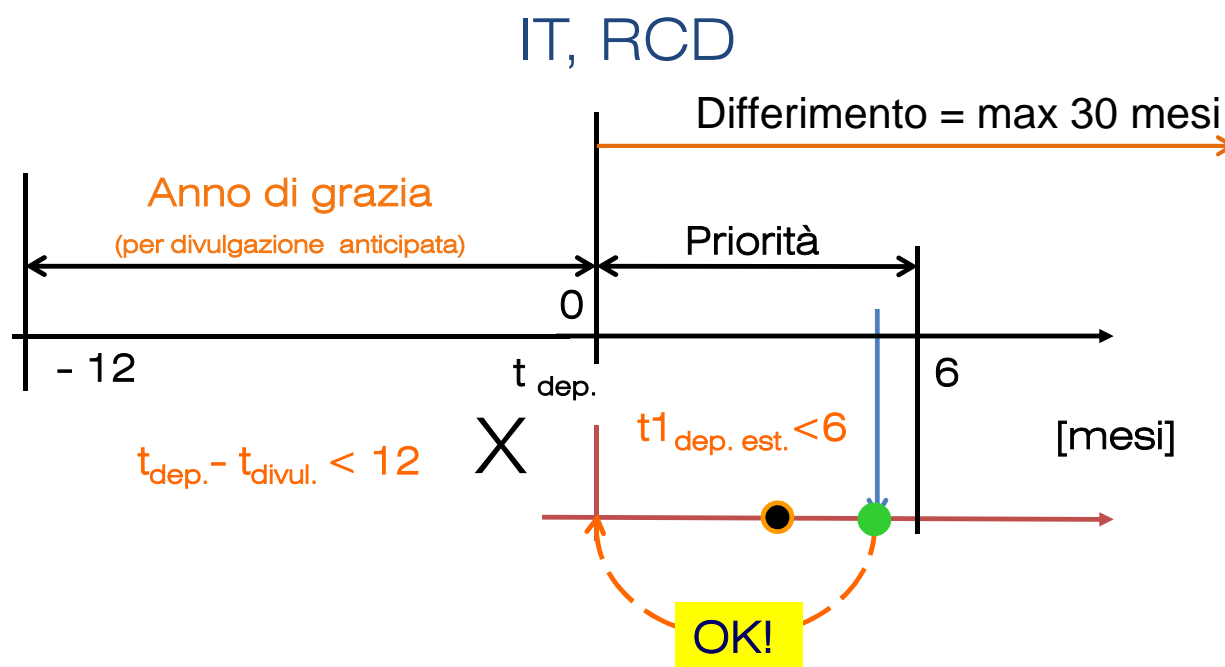
# Attenzione!

- ▣ Mancanza di uniformità nella valutazione di requisiti della descrizione e dei modelli;
- ▣ Tendenza allo schematismo nell'interpretazione dell'oggetto della domanda.





# Quando registrare? (IT & RCD)



Accessibilità della domanda = dopo la registrazione a meno di differimento fino a 30 mesi da data deposito o data di priorità.

Durata registrazione = 5 anni rinnovabile ogni 5 anni fino a 25 anni totali







# USA

- Alto rischio di Azioni ufficiali per formalità (spesso pretestuose).
- Impostazione e qualità dei disegni: spessore delle linee, ombreggiature.
- ESEMPI:



TGM\_USD557758S1.pdf.lnk



TGM\_Citterio\_USD586410S1.pdf.lnk



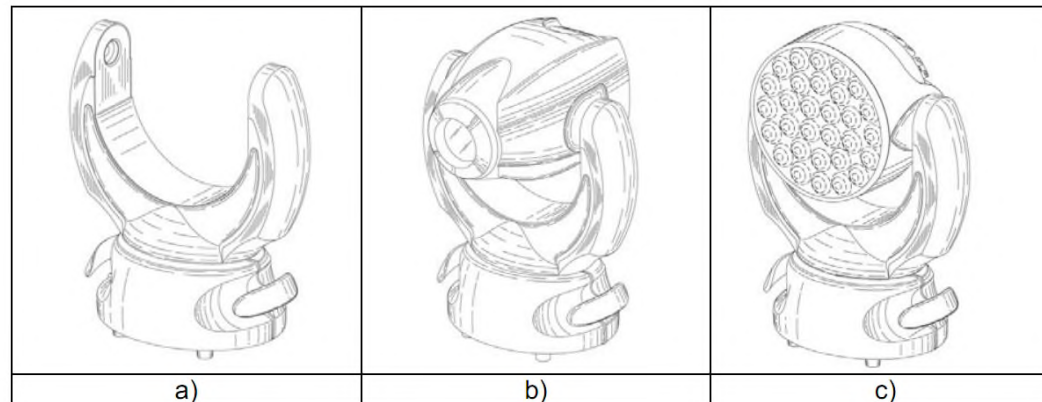


# USA - Modelli multipli

- Accettati a discrezione dell'esaminatore.  
Normalmente richiesta elezione di un sottogruppo o anche di un solo modello

In particolare, con riferimento alle figure sotto riportate, l'esaminatore ha individuato i seguenti gruppi di design:

- a) Figg. 1-6: prima forma di attuazione di una forcella di supporto;
- b) Figg. 7-12: prima preferita forma di attuazione di un proiettore;
- c) Figg. 13-18: seconda preferita forma di attuazione di un proiettore.





# Cina

- Obbligatoria sintetica descrizione.
- No forme linee tratteggiate.
- No ombreggiature.
- Prodotti raggruppabili in un unico modello a condizione di:
  - ❖ appartenere ad una stessa sottoclasse
  - ❖ essere venduti assieme
  - ❖ essere impiegati nello stesso tempo
  - ❖ presentare lo stesso concetto progettuale



# Cina – Modelli multipli

OK!



Design of Products in  
Set :

床上用品



3 front view



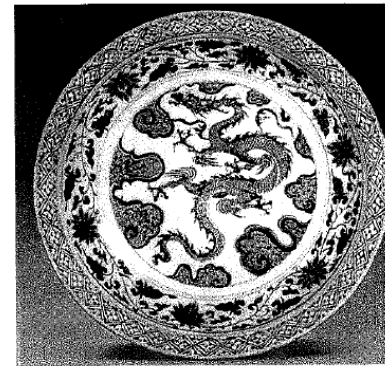
2 front view

4 front view

No!



Vaso



Vassoio

Solo se  
venduti  
assieme!



# Cina

- Alto rischio di Azioni ufficiali per formalità, a causa di problemi interpretativi della nuova normativa.





# Russia

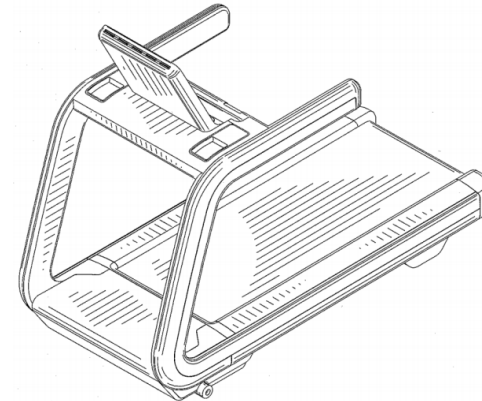
- È necessario accompagnare le tavole con una descrizione sintetica che elenchi le caratteristiche essenziali del modello.
- La registrabilità del modello è condizionata dalla combinazione delle caratteristiche indicate come essenziali nella descrizione e non dall'impressione generale suggerita dalle tavole.





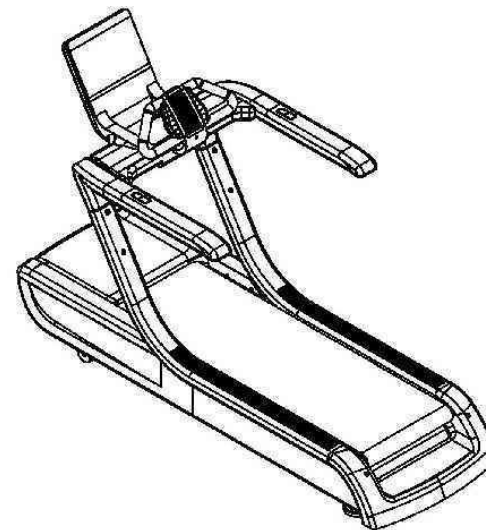
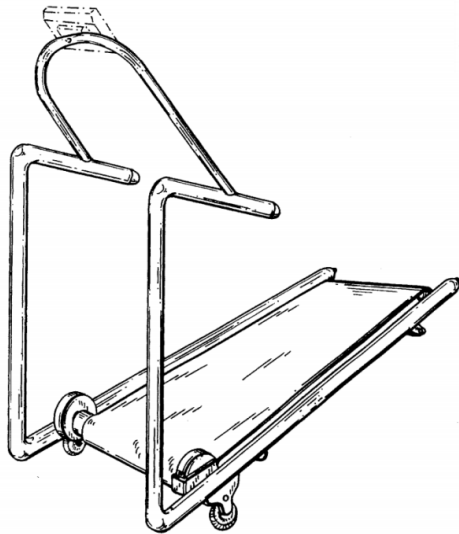
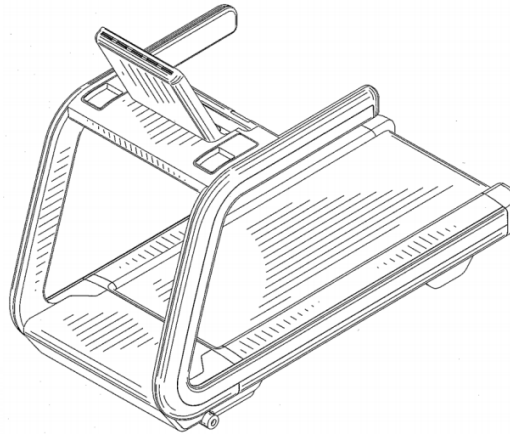
# Russia

esempio di descrizione sintetica



- LIST OF ESSENTIAL FEATURES
- Running machine, characterized by:
  - - make-up of composition elements: a casing, an upper horizontal panel, a display block, a lower horizontal panel, and a running surface;
  - - arrangement of the upper horizontal panel between the upper portions of the lateral components of the casing;
  - - arrangement of the display block on the upper horizontal panel;
  - - arrangement of the running surface between the lower portions of the lateral components of the casing behind the lower horizontal panel;
- distinguished by:
  - - implementation of the lateral components of the casing of inverted  $\Pi$ -like form in profile with rearwardly and upwardly inclined front portion;
  - - arrangement of the lower horizontal panel between the front parts of the lower portions of the lateral components of the casing.

# Russia







# Modelli Internazionali secondo l'Accordo dell'Aja

<http://www.wipo.int/hague/en>



7. Hague Agreement Concerning the International Registration of Industrial Designs<sup>1</sup>

Hague Agreement (1925), revised at London (1934) and at The Hague (1960)<sup>2</sup> (supplemented by the Additional Act of Monaco (1961)),<sup>3</sup> the Complementary Act of Stockholm (1967) and the Protocol of Geneva (1975),<sup>4</sup> and amended in 1979, and the Geneva Act (1999) (Hague Union)

Status on October 14, 2013

| State/IGO   | Date on which State/IGO became party to the Agreement | Date on which State became party to the London Act | Date on which State became party to the Hague Act <sup>5</sup> | Date on which State became party to the Complementary Act of Stockholm | Date on which State/IGO became party to the Geneva Act |
|---|---|--|--|--|--|
| African Intellectual Property Organization (OAPI) ..... | September 16, 2008                                    | —  | —  | —  | September 16, 2008                                     |
| Albania .....   | March 19, 2007  | —  | March 19, 2007   | March 19, 2007   | May 19, 2007   |
| Armenia .....   | July 13, 2007   | —  | —  | —  | July 13, 2007  |
| Azerbaijan .....  | December 8, 2010                                      | —  | —  | —  | December 8, 2010                                       |
| Belgium .....   | April 1, 1979   | —  | August 1, 1984   | May 28, 1979   | Not yet in force <sup>6</sup>                          |
| Belize .....  | July 12, 2003   | —  | July 12, 2003  | July 12, 2003  | —  |
| Benin .....   | November 2, 1986                                      | November 2, 1986 <sup>7</sup>                      | November 2, 1986   | January 2, 1987  | —  |
| Bosnia and Herzegovina .....                            | December 24, 2008                                     | —  | —  | —  | December 24, 2008                                      |
| Botswana .....  | December 5, 2006                                      | —  | —  | —  | December 5, 2006                                       |
| Brunei Darussalam .....                                 | December 24, 2013                                     | —  | —  | —  | December 24, 2013                                      |
| Bulgaria .....  | December 11, 1996                                     | —  | December 11, 1996  | December 11, 1996  | October 7, 2008  |
| Côte d'Ivoire .....                                     | May 30, 1993  | May 30, 1993                                       | May 30, 1993   | May 30, 1993   | —  |
| Croatia .....   | February 12, 2004                                     | —  | February 12, 2004  | February 12, 2004  | April 12, 2004   |
| Democratic People's Republic of Korea .....             | May 27, 1992  | —  | May 27, 1992   | May 27, 1992   | —  |
| Denmark .....   | December 9, 2008                                      | —  | —  | —  | December 9, 2008 <sup>8</sup>                          |
| Egypt .....   | July 1, 1952  | July 1, 1952                                       | —  | —  | August 27, 2004  |
| Estonia .....   | December 23, 2003                                     | —  | —  | —  | December 23, 2003                                      |
| European Union .....                                    | January 1, 2008                                       | —  | —  | —  | January 1, 2008  |
| Finland .....   | May 1, 2011   | —  | —  | —  | May 1, 2011  |
| France .....  | October 20, 1930                                      | June 25, 1939 <sup>9</sup>                         | August 1, 1984   | September 27, 1975   | March 18, 2007   |
| Gabon .....   | August 18, 2003                                       | —  | August 18, 2003  | August 18, 2003  | —  |
| Georgia .....   | August 1, 2003  | —  | August 1, 2003   | August 1, 2003   | December 23, 2003                                      |
| Germany .....   | June 1, 1928  | June 13, 1939 <sup>11</sup>                        | August 1, 1984   | September 27, 1975   | February 13, 2010                                      |
| Ghana .....   | September 16, 2008                                    | —  | —  | —  | September 16, 2008                                     |
| Greece .....  | April 18, 1997  | —  | April 18, 1997   | —  | —  |
| Hungary <sup>12</sup> .....                             | April 7, 1984   | —  | August 1, 1984   | April 7, 1984  | May 1, 2004  |
| Iceland .....   | December 23, 2003                                     | —  | —  | —  | December 23, 2003                                      |
| Italy .....   | June 13, 1987   | —  | June 13, 1987  | August 13, 1987  | —  |
| Kyrgyzstan .....  | March 17, 2003  | —  | March 17, 2003   | March 17, 2003   | December 23, 2003                                      |
| Latvia .....  | July 26, 2005   | —  | —  | —  | July 26, 2005  |
| Liechtenstein .....                                     | July 14, 1933   | January 28, 1951 <sup>15</sup>                     | August 1, 1984   | September 27, 1975   | December 23, 2003                                      |
| Lithuania .....   | September 26, 2008                                    | —  | —  | —  | September 26, 2008                                     |
| Luxembourg <sup>16</sup> .....                          | April 1, 1979   | —  | August 1, 1984   | May 28, 1979   | Not yet in force <sup>6</sup>                          |
| Mali .....  | September 7, 2006                                     | —  | September 7, 2006  | September 7, 2006  | —  |
| Monaco .....  | April 29, 1956  | April 29, 1956 <sup>14</sup>                       | August 1, 1984   | September 27, 1975   | June 9, 2011   |
| Mongolia .....  | April 12, 1997  | —  | April 12, 1997   | April 12, 1997   | January 19, 2008                                       |
| Montenegro .....  | June 3, 2006  | —  | June 3, 2006   | June 3, 2006   | March 5, 2012  |
| Morocco .....   | October 20, 1930                                      | January 21, 1941 <sup>15</sup>                     | October 13, 1999   | October 13, 1999   | —  |
| Namibia .....   | June 30, 2004   | —  | —  | —  | June 30, 2004  |
| Netherlands <sup>17</sup> .....                         | April 1, 1979   | —  | August 1, 1984 <sup>16</sup>                                   | May 28, 1979 <sup>18</sup>   | —  |
| Niger .....   | September 20, 2004                                    | —  | September 20, 2004   | September 20, 2004   | —  |
| Norway .....  | June 17, 2010   | —  | —  | —  | June 17, 2010  |
| Oman .....  | March 4, 2009   | —  | —  | —  | March 4, 2009  |
| Poland .....  | July 2, 2009  | —  | —  | —  | July 2, 2009   |
| Republic of Moldova .....                               | March 14, 1994  | —  | March 14, 1994   | March 14, 1994   | December 23, 2003                                      |
| Romania .....   | July 18, 1992   | —  | July 18, 1992  | July 18, 1992  | December 23, 2003                                      |
| Rwanda .....  | August 31, 2011                                       | —  | —  | —  | August 31, 2011  |
| Sao Tomé and Príncipe .....                             | December 8, 2008                                      | —  | —  | —  | December 8, 2008                                       |
| Senegal .....   | June 30, 1984   | June 30, 1984 <sup>17</sup>                        | August 1, 1984   | June 30, 1984  | —  |

7. Hague Agreement Concerning the International Registration of Industrial Designs<sup>1</sup>

Hague Agreement (1925), revised at London (1934) and at The Hague (1960)<sup>2</sup> (supplemented by the Additional Act of Monaco (1961)),<sup>3</sup> the Complementary Act of Stockholm (1967) and the Protocol of Geneva (1975),<sup>4</sup> and amended in 1979, and the Geneva Act (1999) (Hague Union)

| State/IGO                                       | Date on which State/IGO became party to the Agreement | Date on which State became party to the London Act | Date on which State became party to the Hague Act <sup>5</sup> | Date on which State became party to the Complementary Act of Stockholm | Date on which State/IGO became party to the Geneva Act |
|---|---|--|--|--|--|
| Serbia <sup>18</sup> .....                      | December 30, 1993                                     | —  | December 30, 1993  | December 30, 1993  | December 9, 2009                                       |
| Singapore .....                                 | April 17, 2005  | —  | —  | —  | April 17, 2005   |
| Slovenia .....                                  | January 13, 1995                                      | —  | January 13, 1995   | January 13, 1995   | December 23, 2003                                      |
| Spain .....                                     | June 1, 1928  | March 2, 1956 <sup>19</sup>                        | —  | —  | December 23, 2003                                      |
| Suriname .....                                  | November 25, 1975                                     | November 25, 1975                                  | August 1, 1984   | February 23, 1977  | —  |
| Switzerland .....                               | June 1, 1928  | —  | August 1, 1984   | September 27, 1975   | December 23, 2003                                      |
| Syrian Arab Republic .....                      | May 7, 2008   | —  | —  | —  | May 7, 2008  |
| Tajikistan .....                                | March 21, 2012  | —  | —  | —  | March 21, 2012   |
| The former Yugoslav Republic of Macedonia ..... | March 18, 1997  | —  | March 18, 1997   | March 18, 1997   | March 22, 2006   |
| Tunisia .....                                   | October 20, 1930                                      | October 4, 1942 <sup>20</sup>                      | —  | —  | June 13, 2012  |
| Turkey .....                                    | January 1, 2005                                       | —  | —  | —  | January 1, 2005  |
| Ukraine .....                                   | August 28, 2002                                       | —  | August 28, 2002  | August 28, 2002  | December 23, 2003                                      |
| (Total: 61)                                     | (61)  | (12)   | (34)   | (34)   | (46)   |

<sup>1</sup> The Geneva (1999) Act of the Hague Agreement Concerning the International Registration of Industrial Designs was adopted on July 2, 1999. The Geneva Act entered into force on December 23, 2003.

<sup>2</sup> The Protocol to the Hague Act (1960) is not yet in force. It has been ratified by or acceded to by the following States: Belgium, France, Germany, Italy, Liechtenstein, Monaco, Morocco, Netherlands and Switzerland.

<sup>3</sup> The Additional Act of Monaco (1961) is in force in respect of the following States as from the dates indicated: France (December 1, 1962), Germany (December 1, 1962), Liechtenstein (July 9, 1966), Spain (August 31, 1969) and Monaco (September 14, 1963).

<sup>4</sup> The Protocol of Geneva (1975), in accordance with Article 11(2)(a) thereof, ceased to have effect as of August 1, 1984; however, as provided by Article 11(2)(b), States bound by the Protocol (Belgium (as from April 1, 1979), France (as from February 18, 1980), Germany (as from December 26, 1981), Hungary (as from April 7, 1984), Liechtenstein (as from April 1, 1979), Luxembourg (as from April 1, 1979), Monaco (as from March 5, 1981), Netherlands (as from April 1, 1979), Senegal (as from June 30, 1984), Suriname (as from April 1, 1979) and Switzerland (as from April 1, 1979)) are not relieved of their obligations thereunder in respect of industrial designs whose date of international deposit is prior to August 1, 1984.

<sup>5</sup> The territories in Europe of Belgium, Luxembourg and the Netherlands are, for the application of the Hague Agreement, to be deemed a single country.

<sup>6</sup> The Geneva Act will enter into force, with respect to Belgium and Luxembourg, at a later date in accordance with Articles 27 and 28.

<sup>7</sup> Benin has notified acceptance of the termination of the London Act (1934), on September 19, 2013. The termination of the London Act will become effective three months after the Director General of WIPO receives the last required notification of acceptance.

<sup>8</sup> Not applicable to the Faroe Islands but applicable to Greenland as of January 11, 2011.

<sup>9</sup> Including all Overseas Departments and Territories.

<sup>10</sup> France has notified acceptance of the termination of the London Act (1934), on September 20, 2010. The termination of the London Act will become effective three months after the Director General of WIPO receives the last required notification of acceptance.

<sup>11</sup> Germany has notified acceptance of the termination of the London Act (1934), on August 16, 2010. The termination of the London Act will become effective three months after the Director General of WIPO receives the last required notification of acceptance.

<sup>12</sup> With the declaration that Hungary does not consider itself bound by the Protocol annexed to the Hague Act (1960). The London Act ceased to be effective in respect of Hungary as of February 1, 2005.

<sup>13</sup> Liechtenstein has notified acceptance of the termination of the London Act (1934), on December 13, 2010. The termination of the London Act will become effective three months after the Director General of WIPO receives the last required notification of acceptance.

<sup>14</sup> Monaco has notified acceptance of the termination of the London Act (1934), on March 9, 2011. The termination of the London Act will become effective three months after the Director General of WIPO receives the last required notification of acceptance.

Non designabili: Canada, USA, Cina, Giappone, Australia, Nuova Zelanda, India, Emirati Arabi





# Design or trademark?





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## ● Design model or trademark?

Community Trademark: 8732811

Registered Community Design:  
001645946-0001/00005





## Reference for the comparison

- Trademarks: Average Consumer
- Designs: Informed User

“Abbracci ®”  
(Hugs)








# Warning!

- The **concept of individual character of design models** has very much in common with the **concept of distinctiveness of marks**.
- According to some interpretations, the **minimum distance between the shapes of two distinct designs which avoids counterfeiting is lower than the distance commonly admitted when comparing two distinct marks**.















Warning!

|   |  |   |   |   |   |
|---|--|---|---|---|---|
|    |    |   |    |  |  |
| Community Design 46693-1  | Community Trade Mark: 5651369  |   | Community Design 477104-3   | Community Design 757992-2   | Community Trade Mark: 6045488   |
|    |    |    |    |  |  |
| Community Design 116450-3   | Community Design 316815-53   | Community Trade Mark: 5554753   | Community Trade Mark: 5505037   | Community Trade Mark: 5146899   | Community Trade Mark: 5047598   |
|  |  |  |  |   |   |
| Community Design 67053-17   | Community Trade Mark: 5077904  | Community Trade Mark: 5336235   | Community Trade Mark: 5014089   |   |   |





Warning!

| COMMUNITY DESIGNS  |   |  |   |  |  |
|--|---|--|---|--|--|
|   |   | VALENTINO  |    |   | VALENTINO  |
| * 000003124-0001   | * 000000989-0004  | 000260328-0002   | 000137047-0002  | 000069299-0007   | 000260328-0003   |
| COMMUNITY TRADE MARKS  |   |  |   |  |  |
|  |  |  |  |  |  |
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