



Comparison of Industrial Design protection in select Asian countries

Offices in the Rouse Group: Australia* | China | Hong Kong | India+ | Indonesia | Myanmar | Philippines | Russia | Saudi Arabia+ | Thailand | UAE | United Kingdom | Vietnam | * Liaison office | + Associated office

TAKE AWAY

- Litigation gives surprising results
- Practice does not necessary follow the written law
- Warning letters should be weapon of choice (especially in countries without groundless threats liability)
- Cost consideration/Time pressure in any filing strategy
- Consider copyright as fall back /after the fact protection
 - Register copyright
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SCOPE OF MY PRESENTATION

- Comparisons on the level of protection ASEAN countries
- A Malaysian case on PET bottle

AESTHETIC OR EYE APPEAL REQUIREMENT

Singapore	“features of shape, configuration, pattern or ornament applied to an article by any industrial process, but does not include...features which are dictated solely by function
Malaysia	Eye appeal (appeal to and judged by the eye)
Indonesia	“that which produces aesthetic impression” (part of definition of Industrial design in the law) But the Commercial Court in 2012 in Case No. 73/D.I/2012/PN.Niaga.JKT.Pst upheld a design registration for a gas pipe joint and awarded damages against a infringer/former employee
Vietnam	“An industrial design means a specific appearance of a product embodied by three-dimensional configurations, lines, colors, or a combination of these elements. ” Design cannot be “invisible during the use of the product”
Philippines	Probably – “shall not be dictated essentially by functional consideration”
Thailand	“any configuration of lines or colours that gives special character to the product and can serve as a pattern for a product of industry or handicraft” (Section 3 of Thai Patent Act B.E. 2522 as amended) Top Union Co Ltd v Department of Intellectual Property (2005) – the features were not designs “ of any form or composition of lines or colours that give a special appearance to the ornamental aspect of the product”. Court said in order to protect these products, the plaintiff needs to seek protection as an invention patent rather as a design.



AESTHETIC REQUIREMENT?

- Indonesian Commercial Court decision
- Gas pipe joints under Design No. ID0009708
- Issue – who was entitled to the design? Former employee
- No discussion whether it was a registrable in the first place?
- Does it produce “an aesthetic impression”?
- Important to get English translation of court arguments to see if points need to be supplemented

DUAL PROTECTION - BOTH COPYRIGHT AND INDUSTRIAL DESIGN

Where a design is registered under a country's design law, is copyright protection still available?

Singapore	No
Malaysia	No
Indonesia	Probably not where design is made for industrial purpose
Vietnam	Yes
Philippines	Yes
Thailand	Yes

PROTECTION OF UNREGISTERED DESIGN WITH COPYRIGHT

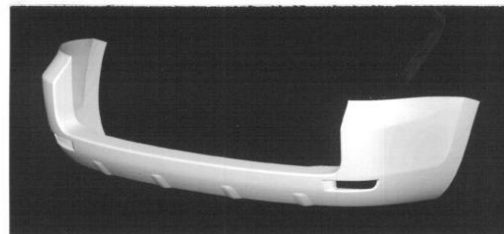
Where a design is capable of being registered but it is not registered, if it had been industrially applied or put into production, is copyright protection available?

Singapore	No
Malaysia	Probably yes
Indonesia	Probably, not where design is made for industrial purpose But case of copyright registration in catalogue for furnitures - used to stop 3 Dimensional reproduction of furnitures
Vietnam	Yes
Philippines	Yes
Thailand	No

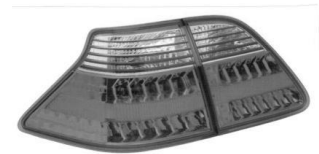
MUST FIT/MATCH EXCEPTION

In some countries, design not registrable if it is dependent upon the appearance of another article of which the article is intended by the designer to form an integral part;

Singapore	Design not registrable
Malaysia	Design not registrable
Indonesia	Design registrable
Vietnam	Probably not registrable. Functional Design In Vietnam, Subject matters not protected as industrial designs if Shape of a product, which is invisible during the use of the product.
Philippines	Design registrable.
Thailand	Design registrable



Perspective View



PERSPECTIVE VIEW

FUNCTIONAL DESIGN

Is copyright protection available for designs that are purely functional?

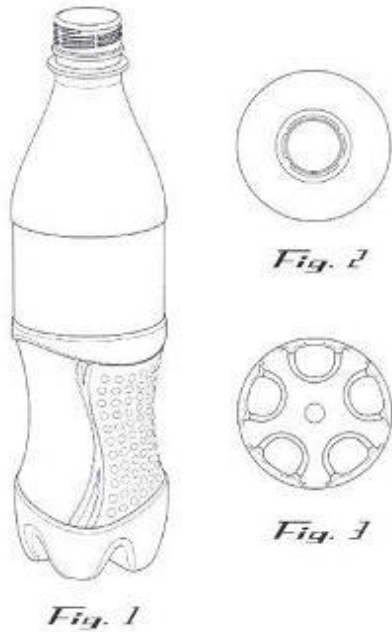
Singapore	Probably, but note British Leyland v Armstrong principle
Malaysia	Probably, but note British Leyland v Armstrong principle
Indonesia	Probably not, where design is made for industrial purpose
Vietnam	Probably not
Philippines	Probably not
Thailand	No

LIABILITY FOR GROUNDLESS THREATS

Country	Position
Singapore	Yes, there is liability in making unjustified threats
Malaysia	Yes, there is liability in making unjustified threats
Indonesia	No
Thailand	No
Vietnam	No.
Philippines	No

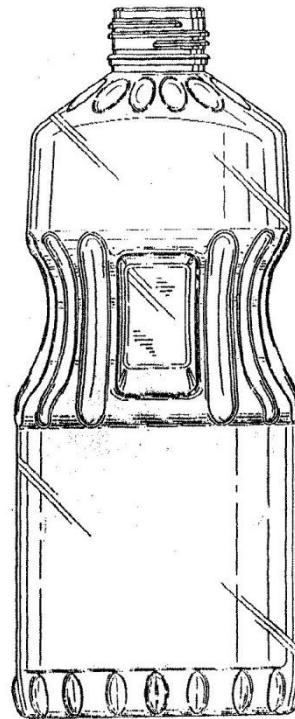
Sample Registration For A Plastic Bottle

Vietnam

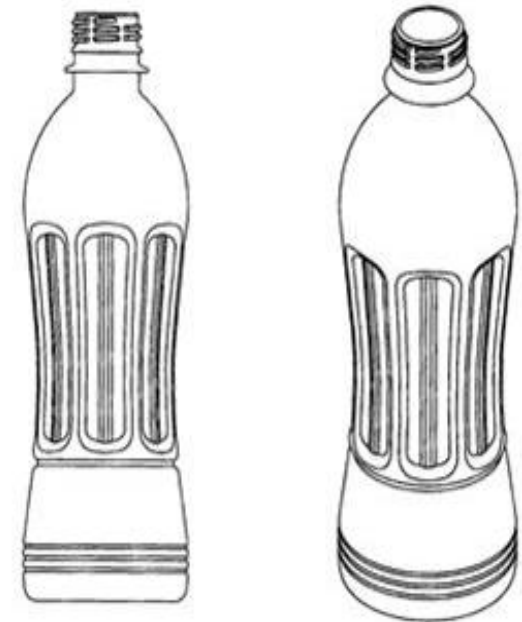


This is the design bottle (on the Go) in the name of The Coca-Cola Company, registered since 07 April 2008

Philippines



Thailand



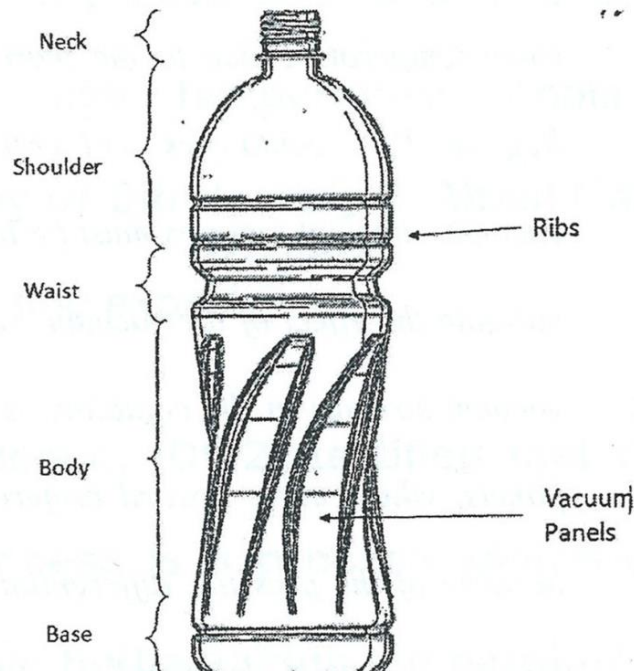
Granted TH Design No. 39545 in the name of Kirin Beverage Company Limited (Granted on 3 April 2014)

FRASER&NEAVE DIARIES V TROPICANA (M'SIA DISPUTE)

Plaintiff



Defendant



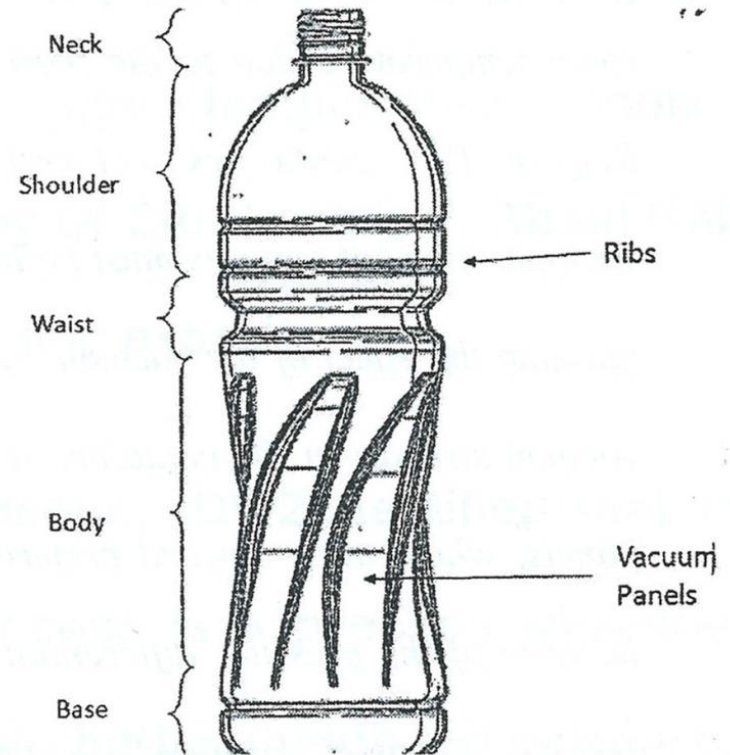
FRASER&NEAVE DIARIES V TROPICANA

- **Malaysian Court of Appeal Decision on PET beverage container bottle**
- In Malaysia,
 - Eye appeal, **whose eye is it?**
- In the case of PET bottle design -
 - Customers for bottles are those in the business of producing juices and beverage in the bottle
 - Not the ultimate consumer.
 - Plaintiff produced the end-consumer to testify , appeal court said did not produce relevant customers
 - Burden of proof therefore not discharged that design has eye appeal

FRASER&NEAVE DIARIES V TROPICANA

- **Malaysian Court of Appeal Decision on PET beverage container bottle**
- Exclusion - Not solely dictated by function
- Absolute one, no answer that other articles bearing other features of shape and configurations also serve the same function
- Court below said not dictated solely by function since possible to make a pet bottle differently
- Appeal Court -
 - The components “show that every feature of the Respondent’s Design is functional
 - Shaped to counter the effect of hot-filled bottling process
- **HOT FILLED** – pouring hot liquid into PET bottles and sealed them before cooled down. Shapes need to be strengthened with vacuum panels and ribs to prevent collapse

FRASER&NEAVE DIARIES V TROPICANA

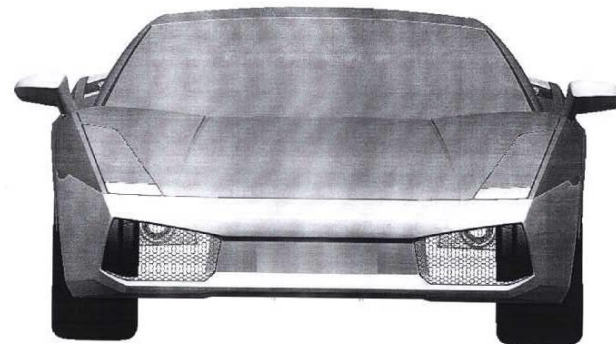


FRASER&NEAVE DIARIES V TROPICANA

- If we take the decision to its logical conclusion - Registration AU 153610 S

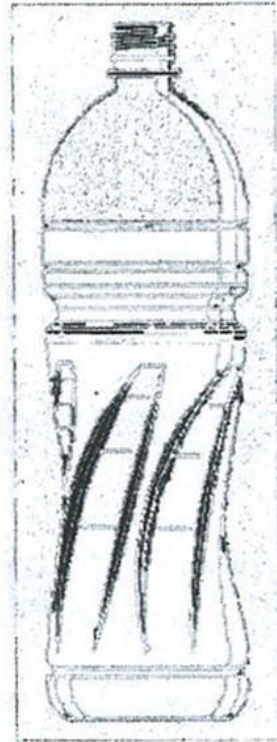


Design dictated solely by function?
Based purely on aerodynamics consideration?

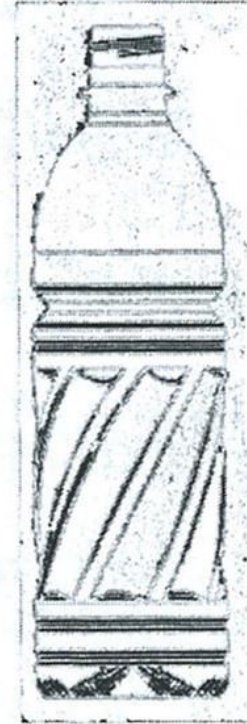


F&N DIARIES V TROPICANA

*The Respondent's
624 Design*



The POKKA bottle



USE OF DOTTED LINES



Philippines

FIG.1



Indonesia

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The logo for Rouse, featuring the word "ROUSE" in a bold, sans-serif font. Each letter is filled with a different color: 'R' is purple and green, 'O' is teal and purple, 'U' is green and teal, 'S' is purple and teal, and 'E' is teal and purple. The letters are slightly overlapping and have a soft shadow effect.

ROUSE

Thank You!

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www.rouse.com

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