

ID5 Project Proposal

Title: *Remedies and Relief for Industrial Design Infringement*

Lead Office: KIPO & USPTO

Introduced: 2018 ID5 Midterm Meeting (June 2018) & 2018 Annual Meeting

Background

Industrial design rights promote innovation and foster competition. The protection of these rights often drive design research and development in relation to both new and existing technologies and products alike. These rights however are only as valuable as they are enforceable and enforcement requires that the rights' holders have access to valuable remedies and relief for industrial design infringement. Each of the Partner jurisdictions implement varied remedies and relief for instances of industrial design infringement. The availability of criminal penalties, monetary damages, and injunctive relief are least some areas of consideration as we review the current remedies and relief framework for design infringement in the ID5 Partner jurisdictions. Additionally, better understanding available remedies will help guide users in effectively filing for design protection at ID5 Offices.

Project Definition

The aim of the project “Remedies for Industrial Design Infringement” is to give an overview of the available remedies and relief for industrial design infringement for each of the Partners, and how this remedy/relief is determined. The project shall consist of a Study that compares the legal provisions, rules/regulations and guidelines regarding potentially available remedies and relief for industrial design infringement amongst the Partner jurisdictions. The Study will be formatted and structured in a way that allow easy identification of the available remedy and relief mechanisms for each of the Partners.

The Study shall be created in collaboration with all Partners. The structure of the Study will be agreed by the Partners and each will provide the respective contents on remedies and relief for design registration/patent infringement in their national/regional jurisdictions. The Lead Offices will be in charge of drafting a first proposal for the structure of the Study and will act as an editorial office compiling the contributions from the Partners. The draft Study will be distributed among the Partners for comments. The final version of the Study is expected to be presented for approval at the 2019 Annual Meeting. The Partners acknowledge approval of the Study will be through consensus of the Partners. The project is considered to be completed upon approval of the Study. A copy of the project timetable and the proposed format for the Study's structure are included in Appendices A and B respectively.

Project Scope and Exclusions

In scope:

- Develop a format and structure of the Study allowing a comparison of any relief and remedies available for industrial design infringement in the Partner jurisdictions.

- Create an agreed upon list of elements to be considered by the Study which would provide a comprehensive view of the various remedies and relief available in relation to infringement of industrial design rights. *See Appendix B.*
- Create a first draft of the Study upon receipt of all contributions and distribute the draft among the Partners for comments.
- Create a final draft of the Study taking into account the comments of the Partners and present the final draft in 2019.
- Publish the result of the study on the ID5 website.

Out of Scope:

- The project does not aim to make proposals for amendments to the legal provision of any remedy provisions for enforcement of industrial design rights of the Partners.
- The project does not seek to involve input of external users. At the present stage the study is intended to capture only the current status of Partner jurisdiction practices in this area.

Desired Outcome

The desired outcome of the study is to enhance and update the knowledge of each Partner about the remedies and relief structures available for industrial design infringement. The results of this project create opportunities for increased understanding and legal certainty of industrial design protection across the Partner Offices. These benefits may be shared with users through the publication of the study.

User Benefits

Effective enforcement of designs rights is an important component of the global industrial design system. Incentives for new design creation are undermined by inadequate or ineffective remedy provisions that allow copycat and infringing products to compete with genuine products without fear of repercussion. Through study of the various remedies available across Partner jurisdictions, users will be able to more effectively decide how and when best to enforce industrial design rights and what remedy and relief may be available. Understanding remedies also assists design filers in crafting effective design applications for improved enforcement.

Expected Resources

The Lead Offices intend to be responsible for any resources required for planning and coordinating the project. Unless specifically otherwise identified, each office is responsible for their own costs and resources including personnel, IT and other resources required to collect and share information necessary to complete this project.