STATE OFFICE OF INDUSTRIAL PROPERTY
of The Republic of Macedonia

Protection of Industrial Design

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PROCEDURE FOR RECOGNITION OF
THE RIGHT OF INDUSTRIAL DESIGN

- Law on Industrial Property ("Official Gazette of RM" no. 21/09)

- Regulation for industrial design ("Official Gazette of RM" no. 92/09)
WHY IS IMPORTANT PROTECTION?

- The design makes the product attractive and appealing, and it contributes significantly to the competitiveness and marketing of the product and increases its commercial value. The protection of industrial design is an effective marketing tool manufacturer can protect its investment in the development and production.

- The protection of industrial designs promote creativity in the industrial and craft sector, which contributes to the expansion of economic activity and increase the export potential of national products, and thus enhance the market value of a company.

- By protecting an industrial design, the owner gets an exclusive right against unauthorized copying or imitation by third parties.
CONCEPTS OF INDUSTRIAL DESIGN

- The industrial design right protects:
  - design that is new and has individual character;
  - "Design" is the external appearance of the product in whole or in part which is determined by its characteristics, especially the lines, contours, colors, shape, texture and materials from which the product is made or decorated and / or its ornamentation.
EXAMPLES
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CONCEPTS OF INDUSTRIAL DESIGN

- Product Definition:

  - "Product", shall be an industrial or handcraft item, including, *inter alia*, also parts intended to be combined in a complex product, packaging of the product, graphic symbols, typographical signs, except computer programs.
# National Database

![Image of National Database interface]

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CONDITIONS FOR PROTECTION OF INDUSTRIAL DESIGN

- Novelty and individual character, and
- Absolute and relative grounds for refusal
NOVELTY OF DESIGN

- If an identical design has not become available to the public prior to the date of filing of the application, or if there has been a claim for a priority right prior to the date of the claimed priority right or
- If there is no any earlier application filed for acknowledgement of an identical design.
- The design is considered identical and when they differ in unimportant details.
A design shall be considered to have individual character if the total impression it makes to the informed user differs from the total impression that any other design makes to such a user, and which has become available to the public prior to the date of filing the application for an industrial design or if a priority right has been claimed prior to the date of the acknowledged priority right.

In assessing the individual character of a design, the degree of freedom that the author has had while creating the design, shall be taken into consideration.
Design conditioned by technical functions and design of connected elements

- A design shall not be protected by an industrial design, if:
  - it is exclusively determined by the technical functions of the product, or
  - it has to be reproduced in its accurate shape and dimensions so the product in which it is contained or on which the design is applied to, could be mechanically connected to other product or placed inside, close to or around other product so that the two products could perform their function.
ABSOLUTE GROUNDS FOR REFUSAL

A design shall be protected by a right of an industrial design if:

- it is not in accordance with Article 127 paragraph (2) of this Law (subject to protection);
- it is contrary to the public order or the morality;
- it represents a technical plan or a scheme;

- it represents exclusively cartographic or photographic work;
- it contains state or other public coat of arms, flag or emblem, title or abbreviation of the title of some international organization, unless it has provided a permission from the competent authority of the respective country or organization;
- it contains or imitates figure or name of a historical or deceased famous person from the RM, unless it has provided a permission from a competent state administrative body
- it contains or imitates name, shape or other recognizable part of protected cultural inheritance in the Republic of Macedonia, unless it has provided a permission from a competent state administrative body.
RELATIVE GROUNDS FOR REFUSAL

- A design may not be protected by an industrial design right, if:
  - it is not new;
  - it does not have an individual character
  - it can not be protected in accordance with Article 131 of this Law (by technical functions);

- An industrial design may not protect a design which infringes previously acquired rights of:
  - the holder of the previously protected right from industrial property;
  - the person who has copyright to a work identical or similar to the design.

- The reasons for excluding from the protection of the right to industrial design, could be invoked only by the applicant of a previously filed application or the holder of a previously acquired right.

- Industrial design that has been declared earlier shall be a reason for refusal only if it is registered.
Procedure for acquiring a right to industrial design may be initiated by

1. the author or
2. his successor only.
IF is a creation of several authors

Then all the authors and their successors shall be entitled to the right to initiate the procedure

AUTHOR shall be a natural person who has created the design by his creative labour

LEGAL SUCCESSOR to the author shall be a legal or natural person whose acquirement of the right to industrial design is based on law, legal work, inheritance and court decision
The procedure for grant an industrial design right shall be initiated by filing an application for industrial design right to the Office;

Procedure for acknowledgement of a right to industrial design may also be initiated by filing an application in accordance with the Hague Agreement.

Procedure for international registration of an industrial design, in accordance with the provisions of the Hague Agreement, shall be initiated by filing an application for international registration of an industrial design directly to the International Bureau, of the World Intellectual Property Organization.
CONTENTS OF THE APPLICATION

- request for recognition of the right to industrial design (form);
- data related the applicant;
- representation of the design for which protection is requested;
- description, if necessary for determining the novelty.
Uniqueness of a design

- For each design shall be filed separate application

- It shall be possible to claim protection of more designs of products (multiple applications) through one application

- If a multiple application is filed, all designs from the application shall have to be intended to be applied to products classified in same class according to the Locarno classification.

- The multiple application may contain maximum of a hundred designs.
EXAMPLES – multiple application

Дизајн на амбалажа
EXAMPLES – multiple application
The Office shall determine the filing date of the application

- Entry into the Register of Applications
- Formal examination
- Examination ex officio – absolute grounds for refusal, the Office shall adopt a decision for total or partial refusal of the application
Payment of expenses

If the application for industrial design fulfils the requirements according to the Law, the Office shall advise the applicant to pay, within a certain time limit which cannot be longer than 30 days, for the costs made with the publication of the application data in the Official Gazette of the Office.
Publication of the application

- If the applicant proceeds in accordance with regulation of the Law, the Office shall publish the application data in the Official Gazette of the Office within 90 days at the latest.

- Official Gazette is issue every two months on the Office Wed site.
Deferment of publication

- The applicant for an industrial design may, at the same time with submission of the application, ask for deferment of the publication for a period of 12 months, counted from the date of filing the application or, if priority right has been claimed, from the date of the priority right.

- The Office shall publish the application data in the official newsletter, in a way as established by a regulation adopted by the director of the Office.
OPPOSITION

- Opposition to the published application for industrial design could be lodged to the Office, within 90 days, starting from the date of the publication, by:
  - an applicant of previously registered industrial design and holder of previously recognized industrial design right;
  - holder of previously acquired industrial property right, if the subject of that right is identical or similar with the published industrial design;
  - person who has copyright to a work identical or similar to the published industrial design; and
  - an interested person who believes that the published industrial design is not in compliance with the requirements for innovation and individual character or it is exclusively restricted by the functional characteristics of the product.

- The time limit for lodging an opposition shall not be extendable.

- Written notice of the reasons listed in the opposition

  ➔ Advice the applicant, to explain the reasons stated in the opposition, within a period not longer than 60 days.
Deciding on opposition

- If the applicant for an industrial design explains the reasons stated in the opposition and submits a reply to the opposition, the Office shall examine the basis for the opposition, taking into consideration the reasons for the opposition and the reply to the opposition.

- If the Office finds that there is no ground for the opposition, it shall reject the opposition by a decision forwarded to both, the applicant and the person who lodged the opposition.

- If the Office finds that the opposition is founded, it shall take a decision to reject the application and shall forward it to both, the applicant and the person who lodged the opposition.
Grant of industrial design right and entry in register

- If there is no opposition lodged within a defined period or if the opposition is rejected, the Office shall notify the applicant, to pay the maintenance fee for the first five years of the validity of the industrial design, the costs for the publication in the Official Gazette of the Office, and the costs for issuance of a certificate for industrial design.

- If the applicant pays the fees and costs the Office shall issue a decision for grant the right to industrial design and enter the granted right in the register for industrial designs.

- If the applicant does not pay the fees and costs, the Office shall reject the application by a decision.
Validity of the industrial design

- The industrial design shall be valid for a period of five years, starting from the date of filing the application.

- The validity of the industrial design may be extended several times for a period of five years, but not more than 25 years.
Systems of Protection of Industrial Designs Right consist:

- **Administrative procedure**
  - State Office of Industrial Property (the first instance)
  - Administrative court (Upraven sud)
  - Supreme Court

- **Security measures, IP Enforcement Institutions**
  - Customs Administration
  - Ministry of Interior - police
  - State Market inspectorate

The owner whose right was infringed may request court proceedings, through administrative or civil procedures.
Enforcement – Coordinative Body for IPRs

- The Body undertakes joint inspection actions and has already produced good results;
- **The activities** in this moment and in the future will be focused not only on the inspections of the counterfeit and pirated goods in the market, but they will be focused on the inspection and stamping out of the source of producing the counterfeit and pirated goods.
Regulation for Industrial Design

Integral parts of the regulation are Forms:

- **DZIS-ID1** - request for recognition of the right to industrial design;
  - representation of the design for which protection is requested;
- **DZIS-ID2** — recording changes in the Registers;
- **DZIS-ID3** — request for renewal.

**FEES AND EXPENSES**

- Law on Administrative Fees ("Official Gazette" no.6/2010)
- Tariff of the State Office of Industrial Property of the Republic of Macedonia ("Official Gazette" no.128/09)
In the course of 2010, a total of 760 applications for ID were filed to the SOIP. Of the total number of filed applications, 45 were filed with the Office (most are multiple, with a total 168 industrial designs), and 715 through the Hague Agreement, of which 279 were new and 436 refer to the industrial designs for which the validity was extended on the territory of the RM.

During 2010, Office issued 31 decisions for granting ID right, 24 of which were national and 7 were foreign, and 279 were foreign, internationally.

According to the Hague Agreement, by origin, Switzerland (46,9%) has the biggest share in the total number of ID valid on the territory of the Republic of RM, followed by Germany (19%), Netherlands (3,8%), Turkey (3,3%), France (3,0%) etc.
Statistics

- In accordance to the Locarno Classification:
  - Most of the national applications belong to the class 9 referring to packing and containers for transport and transfer of goods; than class 25, construction and construction materials; followed by classes 13 and 6, which relate to devices for production, distribution and transformation of electrical energy and various furniture products.
  - Through the Hague Agreement, structurally most common were ID of the class 10, referring to watches, other instrument, control and signalization; next are class 12, referring to the means of transport or cargo lifting; class 9 referring to packing and containers for transport and transfer of goods, followed by class 23 and class 11, fluid distribution equipment, sanitary, heating, ventilation and air-conditioning equipment, solid fuel and Articles of adornment.
THANK YOU FOR YOUR ATTENTION!

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