



## ExCo MEETING Turin, Italy 31 March to 4 April, 2019

WORKING DOCUMENT			
TITLE:	Position paper on Virtual Designs		
DRAWN UP BY:	CET 2 – Stephen Perry, Mariano Soní, Chair Gabriel Di Blasi and Reporter Jürgen Buchhold		
PURPOSE:	For approval		
CONFIDENTIALITY:	<b>confidential</b> (accessible only to FICPI ExCo attendees):	<input type="checkbox"/>	{select one box only}
	restricted (accessible to all ExCo attendees):	<input checked="" type="checkbox"/>	
POST-ExCo AVAILABILITY:	access to remain restricted post-ExCo:	<input type="checkbox"/>	{select one box only}
	document to be made openly-available post-ExCo:	<input checked="" type="checkbox"/>	

### Design Protection for Virtual Designs

This document aims to discuss how jurisdictions view and manage protection of designs in a virtual environment (hereinafter referred to as “virtual designs”).

The initial suggestion for this topic was provided by CET President Coleen Morrison, and CET 2 group adopted it as an active topic in Toronto 2018. The group decided that Mariano Soní (MX) and Stephen Perry (CA) would act as Topic Owners, creating a questionnaire to be replied by members (hereinafter “survey”), with guidelines and suggestions provided by CET 2 Chair Gabriel Di Blasi (BR) and Reporter Jürgen Buchhold (DE).

#### 1. Background

Virtual designs become increasingly more prominent as all of us become further enmeshed in virtual environments.

Such environments, developed by companies within a wide spectrum of business activities such as entertainment and product design, are usually accessed by consumers via hardware capable of projecting virtual images of all sorts – such as virtual keyboards or memorabilia.



Virtual Reality (VR) environments are fundamentally different from Augmented Reality (AR) environments. Whereas VR is a three-dimensional, computer generated environment which can be explored and interacted with, AR is an interactive experience of a real-world environment whereby the objects that reside in the real-world are "augmented" by computer-generated perceptual information. CET 2 group focused its research solely on Virtual Reality environments.

As a consequence of the technological development of virtual realities, companies are increasingly using designs that are or could be protected as industrial designs in IPOs in multiple jurisdictions, creating a discussion regarding the enforcement of design protection in this new environment. Consequently, virtual designs are by-products of technological developments and intellectual property law must address the requirements of this new field. The future law of design patents and registrations will need to innovate.

Related efforts are already being made all over the world.

Several jurisdictions have already made their own legislative changes to meet the requirements of the new types of design, including animated designs, graphical user interfaces (GUIs), intangible objects, and other new forms of design representations.

This can be noted, for example, in the "Information Note on Virtual Designs and Non-Physical Products", updated October 6, 2017, released by the Intellectual Property Office of Singapore, according to which "Virtual designs refers to the designs of intangible objects. Such intangible objects may be projected onto a surface, or into a medium (including air)"<sup>1</sup>.

The search for a common definition can also be observed in latter discussions hosted by the international cooperation framework ID5. Recently, the ID5 Partners adopted a Joint Statement on the Fourth Industrial Revolution, pursuing the objective of strengthening protection of designs in a new technological environment, encouraging the adoption of new technologies for administrative systems of industrial designs and providing user friendly services using new technologies for applicants of design systems<sup>2</sup>. Furthermore, the ID5 compiled the results of a comparative research project concerning the design protection systems of the five offices,

---

<sup>1</sup> INTELLECTUAL PROPERTY OFFICE OF SINGAPORE. Information Note on Virtual Designs and Non-Physical Products", updated October 6, 2017. <<https://www.ipos.gov.sg/docs/default-source/resources-library/design/Guidelines-and-Useful-Information/information-note-on-virtual-designs-and-non-physical-products.pdf>>

<sup>2</sup> see <http://id-five.org/>



including practices for the protection of new technological designs which are derived from digital technologies <sup>3</sup>

Given the rise of the Fourth Industrial Revolution, the development and popularization of Virtual Designs (in particular corresponding new types of designs), the needs of the designers and the entrepreneurs, FICPI’s CET 2 group is exploring this topic to find out how the different countries are dealing with that subject matter.

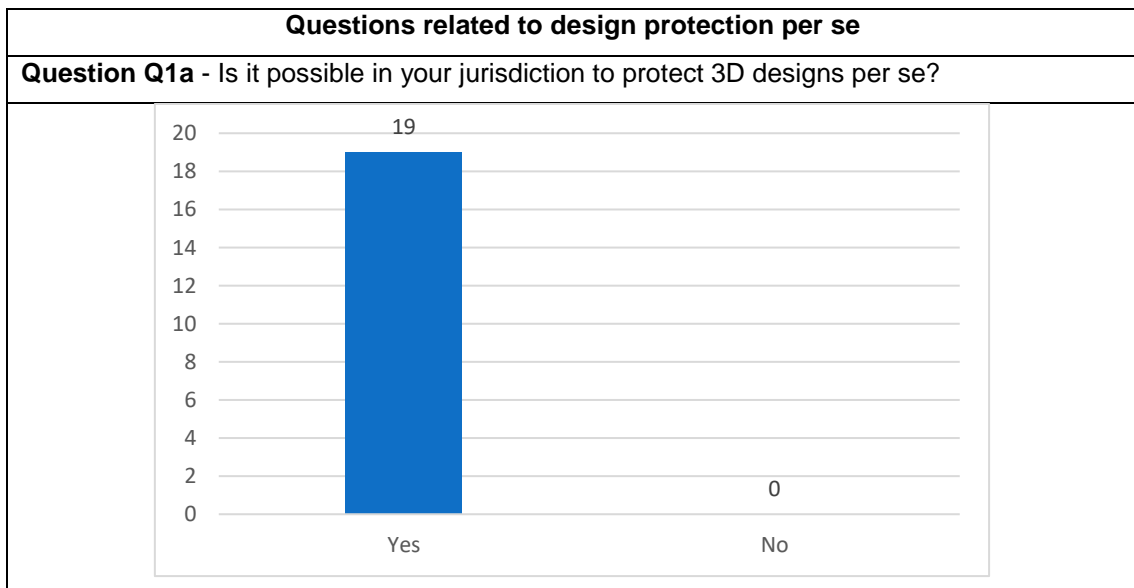
**2. The Survey**

In order to evaluate the current status of Virtual Design protection within multiple jurisdictions, CET 2 carried out an internal survey with its members. The survey collected the replies of representatives of 19 countries: AR, AU, BR, CA, CN, CH, DE, IE, GB, IT, MX, NZ, NO, PT, RO, TR, US, ZA.

The full questionnaire and the responses per jurisdiction can be accessed in the annex (EXCO/IT19/CET/1204-annex).

**2.1 The Findings**

Hereinafter we have summarized the questions and their answers:



<sup>3</sup> see <http://id-five.org/projects/?f=recent-project>, <http://id-five.org/projects/?f=finished-project>



**Analysis:** It is possible to protect three-dimensional designs per se through design rights in all jurisdictions.

**Question Q1b -** If yes, is such protection secured through registered design right?

Response	Count
Yes	19
No	0

**Analysis:** Three-dimensional designs can be filed in every jurisdiction surveyed. They will be registered as IP rights if the registration requirements are met.

**Questions related to computer-generated designs**

**Question Q2a -** Is it possible in your jurisdiction to obtain design protection for computer-generated designs?

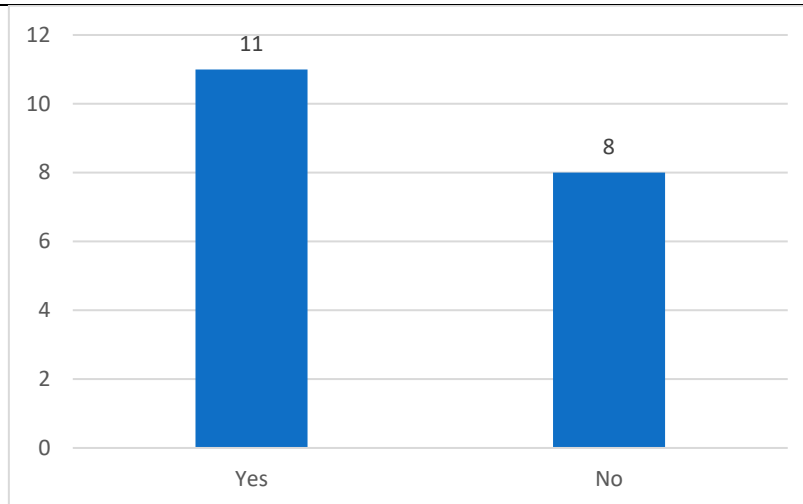
Response	Count
Yes	19
No	0

**Analysis:** In principle, in every jurisdiction surveyed, it does not matter how a design is created, whether as a three-dimensional model, as a three-dimensional representation in a photograph, as a two-dimensional drawing on paper, or as a three-dimensional representation in a computer program



(e.g., a drawing program or a CAD program). All 3D objects can be depicted either by 2D representations or 3D images.

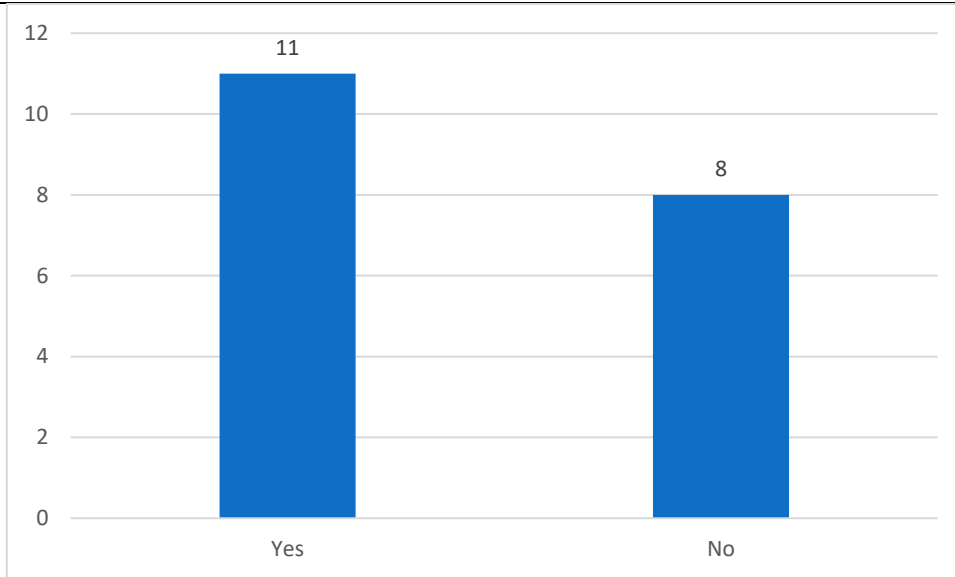
**Question Q2b** - If yes, must the design be applied to an article of manufacture (e.g. a graphic representation on a display screen)?



**Analysis:** Mostly outside of Europe, it is in principle necessary for a registered design to be applied to a product of manufacture, whereas in most European countries, especially within the sphere of influence of the European Union, this is not necessary.

The unity of the European countries is justified by the EU regulations on design rights, in particular the Directive 98/71/EC of the European Parliament and of the Council of October 13, 1998 on the legal protection of designs. On this basis, the legal texts dealing with design rights have converged within the European Union.

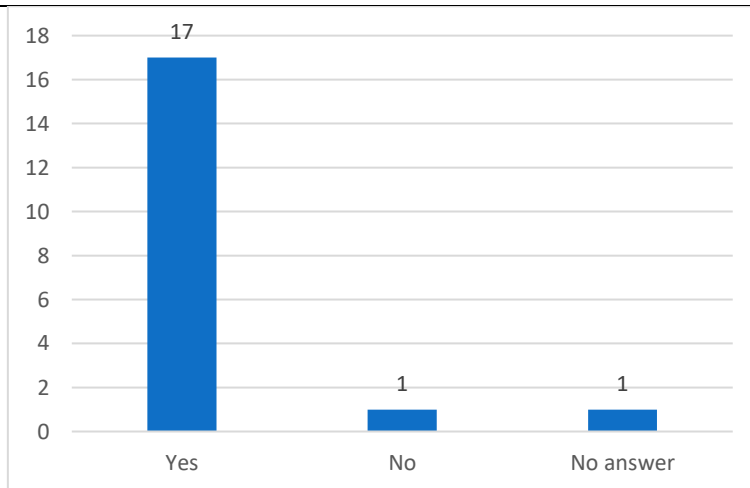
**Question Q2c** - If yes, is it possible for such a registered design to be infringed by a different real-work article (e.g. a graphic representation on a T-shirt)?



**Analysis:** In this case, although there is a slight tendency to conclude that in principle possible for a registered three dimensional Virtual Design to be infringed by a different real-work industrial or handicraft item, this is not a uniform understanding of the matter.

**Protection of Virtual Designs**

**Question Q3** - Noting that AR/VR designs can be static or animated, does your jurisdiction permit protection of animated designs?



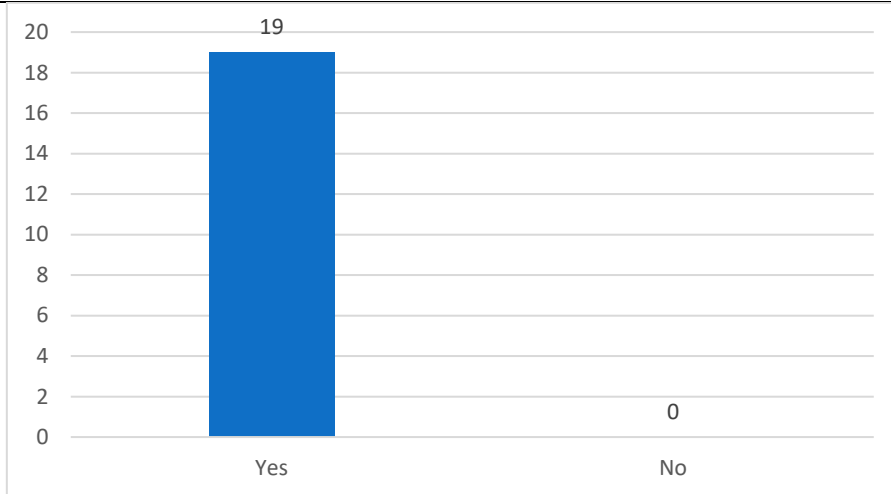
**Analysis:** There is a broad agreement in the various jurisdictions, as almost all jurisdictions allow the protection of registered animated designs.



However, there remain differences in the possibilities to represent the animated designs. While in some countries it is technically and legally possible to submit dynamic images (dynamic files), in other countries it is only possible to deposit the animated design in a sequence of static images. If then, in addition, the number of allowed images is limited (as in the case of the EUIPO), this may lead to further limitations.

New Zealand did not offer an answer for the question but commented that “there is no option to protect an animated design per se. Instead, it may be possible to protect the design using a series of static images that show the animation. However, there is no jurisprudence available on animated designs in New Zealand” – which indicates an instability on the matter for that country.

**Question Q4** - Noting that AR/VR designs are most often in colour, does your jurisdiction permit protection of colour as a design element?



**Analysis:** It is generally possible to protect colour as a design feature in all jurisdictions.

### 3. Conclusions

The results collected in this first survey show that the various legal systems in design law provide for uniform rules, in particular for fundamental requirements such as the possibility of depositing and registering three-dimensional designs and computer-generated designs.

However, we can infer from the data collected so far that there are uneven regulations in other important areas. In particular, the protection of designs of intangible objects is not uniform within the countries that responded to the survey, as approximately half of these countries consider that a design must be related to an article of manufacture – and, therefore, to a physical object.



Consequently, the protection of virtual designs currently depends on whether and to what extent a virtual model, a virtual product, or a virtual surrounding, for example an object projected onto a surface or into a room, is accepted by a jurisdiction of a country as a subject of protection, namely in the scope of the conceptual Idea of the design and not related on a physical or real product.

Of course, a physical reproduction of a design must be possible, but should not be considered as a sine qua non condition for an effective design protection.

Furthermore, in order to guarantee that designs are duly protected, it should be considered that design right titleholders should be able to take action against companies that reproduce a protected design in Virtual/Augmented realities.

If suing for infringements in the case of design violation within virtual environments is not possible, the protection of virtual designs and the creation of those environments themselves is diminished, as free reproductions will be available within new types of design reproduction.

BACKGROUND/HISTORY	
a. (i) When was this topic first studied and (ii) by which group?	August 2018 CET 2
b. (i) Who introduced this topic and (ii) what was the initial motivation?	Coleen Morrison The topic "Virtual Designs" is discussed worldwide and controversial.
c. At what occasion the resolution was discussed the first time?	Within CET 2, it was first discussed during the Toronto 2018 meeting.
d. For what organization or country/region is the resolution mainly of interest?	All jurisdictions
e. Is the resolution an outcome of a workshop, a survey of the delegates, a survey of the group members, a group discussion, a	The resolution was made possible after conducting and analysing a survey.





general discussion  
during a CET meeting?

f. Relevant **key words** Virtual Designs; new types of design  
for the purpose of later  
recovery of resolutions.

*[End of working document]*