

Industrial design protection for products under the Hague System - Key to business success in Vietnam

Copying and mimicking the presentation and packaging design of other people's products has become a pretty typical occurrence in many fields. Meanwhile, protection of intellectual property rights (“IP”) for product designs is critical for all businesses since it helps to increase the perceived value of their brand distinctiveness among consumers. This has become even more critical in recent years, as counterfeiting has increased. Establishing intellectual property rights over industrial designs is not straightforward; therefore, before filing an application for protection of an industrial design (“ID”), manufacturers and businesses should consult with IP experts to grasp and comprehend the provisions of the law governing industrial design protection, as well as the nature of the industrial designs to be protected, particularly now that Vietnam has joined the Hague system for industrial design registration (“The Hague System”).

Role of industrial designs in business activities

The industrial design of a product provides value to it throughout its life, from concept to shelf, by ensuring that it meets diverse and demanding consumer needs.

Industrial design is in the DNA of most manufacturing businesses. In general, industrial design activities for products are primarily focused on contributing to innovation, developing brands for businesses, and enhancing products' competitiveness. Design entails bringing an unique perspective and specialized skills to the creative thinking required to create distinctive brands - brands that elicit emotional connections with consumers.

Industrial design enhances a product's look – its appearance, function – its usage and meaning for consumers; in short, it assists products and brands in emotionally connecting with and engaging consumers.

The industrial design of the product is a critical component of the business's brand development strategy. In essence, branding encompasses the emotional and psychological connections that firms form and maintain with their customers. Industrial design contributes to the expression of that relationship and ensures that the brand is deliberate and meaningful - from the logo, to the typeface, the colors used, the shape and the character of the brand.

The benefits of using the Hague System

Industrial design rights are territorial in nature and are only valid inside the territory of a country or group of countries that have joined to develop a system of industrial design protection. To establish the right to an industrial design under the territorial principle, the owner must submit a separate application to the industrial property offices of each country in which the industrial design is to be protected.

After acquiring a protection title, the owner has the right and obligation to initiate separate proceedings with national industrial property agencies to manage the industrial design's rights (renewal, license, assignment of rights). However, if the owner has a connection to Vietnam (for example, being a citizen, having a residential address, permanent residence, or having an industrial or commercial establishment), the owner has the right to use another attractive and superior solution that is both convenient and economical for establishing and managing rights to industrial designs in a number of countries (including Vietnam), by utilizing the Hague System of international registration of industrial designs that Vietnam joined in December 2019.

The Hague system is administered by the World Intellectual Property Organization (“WIPO”), a specialized agency of the United Nations, based in Geneva, Switzerland. The Hague System can assist holders in applying for industrial design protection in 90 countries worldwide by pursuing industrial design filing procedures and managing industrial designs in a simple and economical way. Like Vietnam and several other countries in the region, China has also now joined the Hague System. This provides incentive for enterprises in other nations to

improve product designs, contribute to the promotion of trade and investment between countries, and assist each country in deepening its integration into the global economy.

Through the Hague System, owners can file an international application for protection of industrial designs at the IP office of a member country or at WIPO, designating all member countries of the Hague system. The application is examined, registered and published by WIPO. After the filed industrial designs are recorded by WIPO in the international register, the international registration will be communicated to each designated member of the Hague Union. Those Member States will have to make a decision on whether to accept the protection of the filed industrial design within a strict time limit. If a designated Member State does not issue a refusal of protection within the specified period (6 or 12 months from the date of receipt of notification of international registration), the design on the international registration shall be deemed to be protected in that Member State’s territory as if it were registered directly with the Member State's IP Office.

The Hague system of international protection of industrial designs simplifies the registration process for industrial designs. The main advantages of the Hague System include:

- ✓ Simple procedure, cost-effectiveness: It is feasible to file a single international application covering numerous countries with a single ip office, considerably minimizing administrative work. Thus, the applicant is not required to file numerous separate applications in numerous countries, is not required to prepare documents in numerous different languages, is not required to pay fees in numerous different currencies, is not required to hire representation in each country, and is not required to pursue various procedures. This helps the applicant save on translation costs and many other costs.
- ✓ Easy management after being protected: When an industrial design is protected under the Hague System, the owner is required to monitor and manage it through a single system, a single time period, and a single procedure in a single location (WIPO) rather than through multiple systems, different timelines, and different procedures at separate country intellectual property offices. Additionally, the holder may request that an amendment to the industrial design registration (such as a transfer of rights, a change of name or address, a limitation of rights, or a waiver of rights) be recorded in a member state (effectiveness of the WIPO-maintained International Register) at a very low cost.

Industrial design protection strategies for products

<p>Consulting with IP experts</p>	<p>Apart from trademarks, attention is increasingly being paid to the industrial design of the product. Manufacturers are increasingly valuing industrial design as part of their product development and marketing efforts. Consumers always choose products with sophisticated and aesthetically beautiful designs because industrial design establishes an emotional connection with them and adds value to the product. Industrial design contributes to market differentiation, brand development, and client acquisition and retention.</p> <p>A registered industrial design in Vietnam is a critical and vital legal tool if the owner intends to effectively enforce the right to prohibit parties from infringing on the industrial design rights and counterfeiters in Vietnam. Additionally, only when the industrial design is protected does the owner have the authority to transfer and license the industrial design's use rights to a third party. Thus, establishing a legal right to an industrial design enables the owner to enjoy exclusive usage, prevents unauthorized use, and serves as a tool for commercializing the brand through collaboration, mergers, and franchising.</p> <p>Manufacturers and enterprises should engage IP experts prior to filing an application for industrial design protection in order to grasp and understand the provisions of the law governing industrial design protection and the nature of the industrial design to be protected. The consultation is aimed at maximizing the area of protection, ensuring that it is neither excessively comprehensive nor excessively broad, and that it closely adheres to</p>
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	<p>applicable legal rules. When filing an international application, the business must prepare the application file in accordance with the laws of the jurisdiction in which the industrial design is being sought for registration (for example, regulations on lines, sharpness, the expression of design concepts, the quantity of drawings/photos, and industrial design colors.</p>
<p>Keeping the industrial design confidential before applying</p>	<p>If the applicant wants to protect the industrial design, it is critical to keep the industrial design confidential. To be protected, an industrial design must satisfy the "novelty" criteria. If the applicant discloses his or her creative design to others, it is best to have a written contract that indicates unequivocally that the industrial design is confidential. The public disclosure of an industrial design, for example, by advertising in a company's catalog or marketing materials, may result in the industrial design losing its "novelty" - a requirement for protection. When an industrial design loses its novelty, it becomes public property and cannot be protected, unless the disclosure of the industrial design occurs under "grace" circumstances in accordance with Vietnam's intellectual property legislation. However, filing an application for an industrial design during the grace period has unforeseen risks. The best course of action is to maintain complete confidentiality regarding the industrial design until the application is filed.</p>
<p>Checking the novelty of industrial design before applying</p>	<p>As mentioned above, novelty is one of the important requirements for an industrial design to be protected. Before filing an industrial design application, in any form, under national route or via the Hague System, it is necessary to verify that the industrial design being registered has not been made or published by anyone else. Non-novel designs will be denied protection. An industrial design is regarded novel if it is significantly different from one that has been publicly disclosed in the country or abroad prior to the filing date or prior to the priority date, if the industrial design application enjoys priority.</p> <p>Applicants may conduct industrial design searches on the following websites to determine whether the industrial design he or she creates and wishes to protect is significantly different (with novelty) from previously created industrial designs, upon which to decide whether or not to file an industrial design application.</p> <ul style="list-style-type: none"> - http://www.wipo.int/designdb/en/index.jsp. It is an online portal managed by WIPO containing more than 13 million records from 32 national, regional and international industrial design databases. - https://www.tmdn.org/tmdsview-web/welcome. This is a platform for industrial design information developed by 67 intellectual property (IP) agencies worldwide (national, regional, and international) with the purpose of making industrial design data and images more widely accessible, easily accessible, and free. - http://asean-designview.org/designview/welcome. This is an industrial design database built by 9 ASEAN member countries. - http://wipopublish.noip.gov.vn/wopublish-search/public/designs. This is a database containing industrial designs protected in Vietnam. <p>To achieve more trustworthy search results, the applicant may request the appropriate IP office undertake an industrial design search in the nation where the application is intended to be filed, either directly or through the industrial property agent.</p>
<p>Increasing level of protection for industrial designs</p>	<p><i>Industrial design protection in the form of copyright:</i></p> <p>An industrial design is a product packaging that can be protected as a work of applied art in Vietnam. Therefore, if protection as an industrial design is not attainable, the owner may file an application for protection of the industrial design that is the product's packaging</p>

under Vietnam's copyright law.

Industrial design protection in the form of trademark rights:

If the industrial design functions as a trademark in the market, then that industrial design may be protected as a three-dimensional mark under Vietnam IP Law.

**By Nguyen Vu QUAN
Partner & IP Attorney**

Contact

KENFOX IP & Law Office

Building No. 6, Lane 12/93, Chinh Kinh Street, Nhan
Chinh Ward, Thanh Xuan District, Hanoi, Vietnam

Tel: +84 24 3724 5656

Email: info@kenfoxlaw.com / kenfox@kenfoxlaw.com