



Industrial Designs

*An Introduction to Industrial
Designs for Small and
Medium-sized Enterprises*



**KENYA INDUSTRIAL
PROPERTY INSTITUTE**



This publication is the nationally customized version of the WIPO publication entitled "Looking good: An introduction to Industrial designs for small and medium-sized enterprises"

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Preface

This is another guide in a series on “Intellectual Property for Business”. It focuses on industrial designs, a key factor in successful marketing of products.

In intellectual property terms, an industrial design relates to the aesthetic or outward appearance of a product. It is this appearance which makes a product attractive or appealing to customers. This visual appeal is one of the key considerations that influence the decision of consumers to prefer one product to another. Industrial designs support the importance of trademarks in helping companies or individuals to differentiate their products from those of competitors and enhance the brand image of their products. This is why ensuring the proper protection of industrial designs is that important.

Industrial designs is one aspect of industrial property rights, others being patents for invention, utility models, trademarks, servicemarks, geographical indications, layout designs and integrated circuits. In Kenya, the industrial designs protection is provided for under the Industrial Property Act 2001, administered by the Kenya Industrial Property Institute (KIPI). While KIPI facilitates national registration of industrial designs, regional protection is also achievable through the African Regional Intellectual Property Office (ARIPO). International protection of designs is possible through the Hague Agreement, administered by World Intellectual Property Organization (WIPO)

This guide is intended to be an introduction to the protection of industrial designs for Small and Medium-sized Enterprises (SMEs), who are the potential originators of industrial designs. The other prospective consumers of IP information will also find the guide useful. It includes questions and answers, examples and illustrations of protected industrial designs. It is not, however, a comprehensive text on the legal aspects pertaining to registration of industrial designs.

For more detailed information on how to register and to enforce your rights over your industrial design, you may visit the KIPI or consult the Industrial Property Act, 2001.

Managing Director



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1. Industrial Designs

What is an industrial design?

In everyday language, an industrial design generally refers to a product's overall form and function. An armchair is said to have a "good industrial design" when it is comfortable to sit in and we like the way it looks. For businesses, designing a product generally implies developing the product's functional and aesthetic features taking into consideration issues such as the product's marketability, the costs of manufacturing or the ease of transport, its storage, repair and disposal.

According to the Industrial Property Act, 2001, an industrial design means any composition of lines or colour or any three dimensional form whether or not associated with lines or colours ; provided that such composition or form gives a special appearance to a product of industry or handicraft and can serve as a pattern for a product of industry or handicraft.

Therefore, from an intellectual property law perspective, an industrial design refers only to the ornamental or aesthetic aspects of a product. In other words, it refers only to the appearance of an armchair. Although the design of a product may have technical or functional features, industrial design, as a category of intellectual property law, refers only to the aesthetic nature of a finished product, and is distinct from any technical or functional aspects.

Industrial design is relevant to a wide variety of products of industry, fashion and handicrafts from technical and medical instruments to watches, jewelry, and other luxury items; from household products, toys, furniture and electrical appliances to cars and architectural structures; from textile designs to sports equipment. Industrial design is

also important in relation to packaging, containers and "get-up" of products.

As a general rule, an industrial design consists of:

- three-dimensional features, such as the shape of a product,
- two-dimensional features, such as ornamentation, patterns, lines or color of a product; or
- a combination of one or more such features.

Example of a three-dimensional design



Example of a two-dimensional design:



<http://www.kipo.ke.wipo.net>



Creative Designs in Business

Enterprises often devote a significant amount of time and resources to enhancing the design appeal of their products. New and original designs are often created to:

1. Customize products to appeal to specific market segments: small modifications to the design of some products (e.g. a watch) may make them suitable for different age groups, cultures or social groups. While the main function of a watch remains the same, children and adults generally have very different tastes in design.
2. Create a new niche market: in a competitive marketplace, many companies seek to create a niche market by introducing creative designs for their new products to differentiate them from those of their competitors. This could be the case for ordinary items such as locks,

shoes, cups and saucers to potentially expensive items such as jewelry, computers or cars.

3. Strengthen brands: creative designs are often also combined with distinctive trademarks to enhance the distinctiveness of a company's brand(s). Many companies have successfully created or redefined their brand image through a strong focus on product design.



Why protect industrial designs?

An industrial design adds value to a product. It makes a product attractive and appealing to customers, and may even be its unique selling point. So protecting valuable designs should be a crucial part of the business strategy of any designer or manufacturer.

By protecting an industrial design through its registration at the Kenya Industrial Property Institute, the owner obtains the exclusive right to prevent its unauthorized copying or imitation by others. This makes business sense as it improves the competitiveness of a business and often brings in additional revenue in one or more of the following ways:



- By registering a design you are able to prevent it from being copied and imitated by competitors, and thereby strengthen your competitive position.

- Registering a valuable design contributes to obtaining a fair return on investment made in creating and marketing the relevant product, and thereby improves your profits.

- Industrial designs are business assets that can increase the commercial value of a company and its products. The more successful a design, the higher is its value to the company.

- A protected design may also be licensed (or sold) to others for a fee. By licensing it, you may be able to enter markets that you are otherwise unable to serve.

- Registration of industrial designs encourages fair competition and honest trade practices, which, in turn, promote the production of a diverse range of aesthetically attractive products.



Shedding Some Light on Designs

While the functional elements of a bottle do not generally differ significantly from product to product, its appearance is likely to be one of the major determinants of success in the marketplace. This is why industrial design registers in many countries have a long list of designs for simple products such as bottles.



2. Protecting Industrial Designs

How do you obtain protection for industrial designs?

In Kenya, an industrial design must be registered in order to be protected under industrial design law.

To register an industrial design you must file an application form 27 at the Kenya Industrial Property Institute. (a list of web sites of IP offices is provided in Annex I). For protection abroad, see Section

3. However, copyrighted designs that are the subject of a copyright protection are not registrable in Kenya.

A note needs to be made for some countries or common economic areas such as the European Union, where recent legislation has made it possible to obtain limited industrial design protection for unregistered designs for three years from the date on which the design has been published in the European Union.

The unregistered design provides companies with the opportunity to test market their products before going through the effort and expense of registering all designs, many of which may not succeed in the marketplace. In addition, some designs may remain on the market for a very short time, especially in the fashion industry. For such products, the unregistered design provides a good alternative. However, once the product is manufactured,

designers have up to 6 months in which to register it. The protection provided to an unregistered design is limited, in that it is more difficult to enforce than for a registered design, and shorter, as it lasts for three years as opposed to the 25 years provided to registered designs in the European Union.

While this guide focuses mainly on registered industrial designs, it is important to point out that, in some countries, there may be alternative ways of protecting industrial designs:

- Depending on the particular national law and the kind of design, one such alternative for protecting designs is copyright law. In Kenya, some designs may fall under copyright protection. Copyright generally provides exclusive rights for literary and artistic works. As some designs may, in some countries, be considered works of art or applied art, copyright protection may apply and may represent an attractive option for SMEs. As indicated earlier, designs that are the subject of a copyright protection are not registrable in Kenya.

- In addition, in some countries, if an industrial design functions as a trademark in the marketplace, then it may be protected as a three-dimensional mark. This may be the case when the shape of the product or its packaging are considered to be distinctive.



- Laws on unfair competition may also protect a company's industrial design in some countries from imitation by competitors.

For more details on protecting your design under copyright, trademark or unfair competition laws, see Section 5.

What rights are provided by industrial design protection?

When an industrial design is protected by registration, the owner is granted the right to prevent unauthorized copying or imitation by third parties. This includes the right to exclude all others from making, offering, importing, exporting or selling any product in which the design is incorporated or to which it is applied. The Kenyan law offers the creator of an industrial design or his successors the exclusive right to sell or cause to be sold for commercial or industrial purposes the goods in which the design is incorporated.

What can be registered as an industrial design?

As a general rule, to be able to be registered, a design must meet one or more of the following basic requirements:-

- The design must be "new". An industrial design is deemed to be new if it has not been disclosed to the public, anywhere in the world, by publication in tangible form or, in Kenya by use or any other way prior to the filing date, or where applicable the priority date of the application for registration.
- The design must be "original". A design is considered original if it has been independently created by the designer and is not a copy or an imitation of existing designs.

- The design must have "individual character". This requirement is met if the overall impression produced by a design on an informed user differs from the overall impression produced on such a user by any earlier design which has been made available to the public.

NB. Apart from the above-mentioned requirements, there are other common sense issues. For example, the registration of a design may not prejudice morality, public health, safety e.t.c.

Traditionally, protectable designs relate to manufactured products such as the shape of a shoe, the design of an earring or the ornamentation on a teapot. In the digital world, however, protection is gradually extending in some countries to a number of other products and types of design. These include electronic desktop icons generated by computer codes, typefaces, the graphic display on computer monitors and mobile telephones, etc. In Kenya, however, the design law does not extend to icons and the like but cover any set of lines, patterns e.t.c usable as a pattern for production.

Exclusive Rights

Let us assume that your company has designed an umbrella with an innovative design, registered it at KIPI, and has therefore obtained exclusive rights over umbrellas bearing that design. What this means is that if you discovered that a competitor is making, selling or importing umbrellas bearing the same or substantially the same design you will be able to prevent him from using your design and, possibly, obtain compensation for damages which your business has suffered from the unauthorized use of that design.

So, while you cannot stop competitors from making competitive products you may prevent them from making products that look just like yours and having a free ride on your creativity. For details on how to enforce your rights you are advised to consult an IP lawyer or agent. This information is also obtainable at the Patent Registry of KIPI.



What cannot be protected by industrial design rights?

The following designs that are generally barred from registration in many countries, Kenya included:

- Designs that do not meet the requirements of novelty, originality and/or individual character (as explained above).
- Designs that are considered to be dictated exclusively by the technical function of a product; such technical or functional design features may be protected, depending on the facts of each case, by other IP rights (e.g. patents, utility models or trade secrets).
- Designs incorporating protected IPRs and/or official symbols or emblems (such as the national flag).
- Designs which are considered to be contrary to public order or morality.

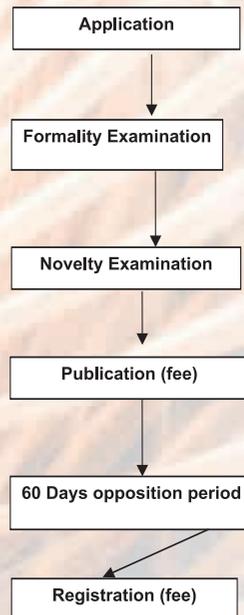
There may be further restrictions on what cannot be registered as a design. For more details it is advisable to consult an IP agent or the relevant national IP office.

How do you register a design?

To register a design in Kenya you must take the following steps:

- Fill in the application form, IP 27, provided. (see Annex I with a list of web sites of IP offices where you can register your designs) including your name, contact details and drawings, and/or photographs or other graphical representations of the design(s) in question (standard formats are usually specified).

- Where the applicant is not a creator, the request is accompanied by a statement justifying the applicant's right to the registration of the industrial design. You may also be required to file, or have the option of filing, a written description or statement of novelty of the industrial design(s). The description generally needs to be of the design and not of the product to which it has been applied. It should be accurate and adequate in differentiating it from any similar earlier designs. It should cover all the distinctive aesthetic features of the design and should describe which feature(s) is/are the most important. In some countries, the examiner may ask for a sample of the design to understand it better or to feel its texture or material.
- The most important features are listed as claims or novelty statement
- Pay the appropriate filing fee.
- You may choose to employ an IP agent to assist you in filing the application form and completing the registration process. In that event, the duly filled application form should be accompanied by the power of attorney.



Some offices register the design only after undertaking a formal examination to ensure that administrative formalities have been complied with. In Kenya, a substantive examination is conducted to check the existing designs on the register for novelty and/or originality. More and more offices are accepting registration without checking for novelty and/or originality.

Once a design is registered, it is entered into the design register, published in the official Industrial Property Journal and a design registration certificate is issued. In some countries/regions (not applicable in Kenya) it may be possible to request deferment of publication in which case the design will be kept secret for a certain period specified by the relevant law. Preventing publication for a period of time may be preferable for strategic business reasons. But publication may be deferred by KIPi on grounds of ,say, state security.

Details on how to protect a design abroad are provided in Section 3.

How long does it take to register a design?

The minimum period for registering a design in Kenya is slightly over three months. However, the process of registration of an industrial design generally takes six to 12 months or longer depending on a number of issues such as whether any objections are raised by the design examiner or if there is a provision for opposition prior to the registration of the industrial design under consideration.

How important is it to keep the design confidential before registration?

If you wish to protect your industrial design under a registration system, keeping the design confidential is absolutely crucial. The reason for this

is that the central requirement for design protection is generally, that the design must be "new". If you show your design to others it is advisable to have confidentiality clauses in written agreements, clarifying that the design is confidential.

A design that has already been disclosed to the public by, for example, advertising it in your company's catalogue or brochure may no longer be considered "new". It becomes part of the public domain and cannot be protected, unless the applicable law provides for a "grace period" or unless the priority of an earlier application can be claimed (see also "How do you protect your industrial designs abroad?" on page ..)

Example: BABY AND CHILDREN

Taking into consideration the welfare and comfort of babies in the bath, the small French enterprise BABY AND CHILDREN designed and produced a baby hammock for the bathroom. Its simple and original design managed to appeal to mothers and babies worldwide. In order to ensure protection for its new product, BABY AND CHILDREN deposited an international application for industrial design registration in March 2000. Once the registration was completed, BABY AND CHILDREN managed to commercialize its product in over ten countries in three different continents, either directly or by granting licenses based on its registered industrial design. The success of this product has been considerable. The hammock is today one of BABY AND CHILDREN's leading products and the company, armed with the legal monopoly provided by industrial design protection, continues to market its product around the world.



Courtesy: Baby and Children



What is the “grace period”?

In some countries, Kenya included, the legislation allows for a grace period for registration of generally six months or a year from the moment a design was made public, disclosed or published.

This is the case when articles bearing the design are sold, displayed at a trade show, exhibition or fair, or are published in a catalogue, brochure or advertisement prior to filing an application. During that period, you may market your design without it losing its “novelty” and you may still apply for registration.

However, as this is not the case in all countries, and, in any event, is limited in time, it is often advisable to keep the design confidential until you apply for design protection. In addition, you will have no exclusive design rights during the grace period (although your design may be automatically protected under copyright or unfair competition law, depending on the provisions of the relevant national legislation; see more on copyright in Section 5).

How long does industrial design protection last?

In Kenya, the law provides the duration of protection of an industrial design shall expire at the end of the fifth year following the date of the application for registration. The registration of the design may be renewed for further two consecutive periods of five years upon payment of a prescribed fee, paid twelve months preceding expiration of the period of registration. A grace period of six months is allowed for the late payments of the renewal fee on payment of a surcharge, as may be prescribed. Therefore, maximum period of protection is up to 15 years.

The term of protection for a registered industrial

design varies from country to country, but is usually at least 10 years (although it is often longer; for example, 14 years for design patents in the United States of America, and up to 25 years under the registered Community Design of the European Union). In many countries, rights holders are required to renew their design protection after five years.

How much does it cost to protect an industrial design?

The actual costs will vary significantly from country to country. However, it is important to bear in mind the different types of costs that may be involved in the process: In Kenya, there is Kshs 3,000 filing fee ; Kshs3,000 publication fee ; Kshs 1,000 certificate fee and Kshs 10,000 renewal fee. See annex V for more details on fees. Below are some of fees one is likely to pay to IP office :

1. There will be registration fees to be paid to the national or regional IP office. The fees will generally vary depending on the number of designs to be registered and the number of countries in which registration is being sought. By way of example, an application for a single Community Design in the countries of the European Union costs 350 Euros. This amount would rise to 1,925 Euros if the application contained 10 designs. Details on the exact fees should be obtained from your IP agent or from the IP offices concerned.
2. There will also be costs associated with the hiring of the services of an IP agent to assist you in the registration process, if you choose to rely on expert advice to file your application.
3. Most countries require the payment of renewal fees, usually on a five-year basis, to maintain their exclusive rights over an industrial design.



4. There may be costs associated with the translation of the industrial design if it is to be protected abroad.

What should you do if your design combines functional improvements with aesthetic features?

To obtain exclusivity over the functional improvements of a product, it is generally advisable to apply for patent or utility model protection or, where the function is not obvious from the product, to keep it as a trade secret. However, it is often the case that a new product combines functional improvements with innovative aesthetic features. Let us say you have designed a new mobile phone. While the mobile phone may be the result of a series of improvements to the electronic components and could be protected by patent(s), the original design of your mobile phone could be registered as an industrial design. Can you apply for both? The answer is yes.

© Nokia and candle holder



Design Protection and Business Strategy

Decisions on how, when and where to protect a company's industrial designs may have an important impact on other areas of design management. It is crucial therefore to integrate issues of design protection into the broader business strategy of an enterprise. For example, the type of protection, the costs, the effectiveness of protection and issues of ownership of designs, may be important considerations when deciding:

- whether to undertake design development in-house or to commission an outside agency;
- the timing of the initial use of a new design in advertising, marketing or public display in an exhibition;
- which export markets to target;
- if, when and how to license or assign a design to be commercially exploited by other companies in return for economic remuneration.

Many designers protect different aspects of their products with different intellectual property rights. It is important, however, to keep in mind the basic difference between patents/utility models and industrial designs. Patents and utility models are for inventions that bring about functional improvements to a product and industrial design protection is for the appearance of the product.

Who may apply for industrial design protection?

In general, the person who created the design or, if working under contract, his employer, can apply for registration. The applicant can be either an individual (e.g. a designer) or a legal entity (e.g. a company). In either case, the application may be made directly or through an agent. If you are a foreign applicant you may be required to be represented by an agent duly authorized by KIPI.



Example: DURACELL

Until the 1980s Duracell was virtually a one-product company manufacturing alkaline batteries. In 1981, Duracell employed consultant designers to produce a pocket flashlight, which was launched shortly after, in 1982. Two years later, the design of the flashlight won the United Kingdom Design Council Award. Over the years, Duracell has introduced several variations of the pocket flashlight with different designs for different target markets. Flashlights for young consumers were developed in fashionable colors.

The innovative functional features of the product are protected by patents, while the design has been protected in all the major countries where Duracell currently trades.

Duracell®



Who owns the rights over an industrial design?

The creator of a design, i.e. the designer, is usually the first owner of the design, unless there are special circumstances. For example, in most countries, Kenya being one of them, if an employee has developed a design under the terms of an employment contract, that is, during his working hours within the enterprise and as part of his regular duties within the enterprise, the design (and the related rights) will belong to the employer or may require to be transferred by a formal written assignment. The Kenya Industrial Property Institute is encouraging companies to have appropriate IP policies in place.

If the design was developed by an external designer under contract, the rights will generally belong to the company that commissioned the design. In such cases, it is considered that the design was produced for the use of the person who commissioned the design, who is therefore the owner. Misunderstandings at a later date can be avoided by clarifying the issue of rights ownership in the original contract with the designer. You should also bear in mind that the designer of the product may have automatic copyright protection over the drawings of the original design and the issue should also be covered by the contract.

Example: TRAX

TRAX is a public seating system designed by Rodney Kinsman and sold and marketed by DMK Design Ltd. TRAX public seating was originally designed to meet the requirements of British Rail, which was seeking public seating of good appearance, comfortable, weather-resistant and requiring little maintenance. Over the years, TRAX has become a successful product, partly due to its practical design, and has been installed in over 60 airports worldwide. The TRAX design is protected as a registered industrial design in the United Kingdom, Australia, the Benelux Countries, Germany, Italy, Japan and the United States of America. This gives DMK Design Ltd exclusivity over the commercialization of the product with the protected design in those countries. On occasions, DMK Design Ltd has licensed foreign companies to produce the TRAX public seating system on payment of royalties. Courtesy: TRAX®



<http://www.kipo.ke.wipo.net>



Can you apply for the registration of many different designs through a single application?

The answer varies significantly from country to country. In Kenya, you may apply for the registration of many designs (10, 20 or even 50 designs) through a single application as long as they all relate to the same product or "class" of products. The Act provides that two or more industrial designs may be the subject of the same classification provided that they relate to the same class under international classification or to the same set or composition of articles. (see explanation of "classes" on page 15).

This means that if you have designed a set of chairs, tables and dressers and would like to protect them, many countries would allow you to file a single application covering all of them, paying only one application fee, as they all belong to the same class of products. If, however, you also intended to protect an accompanying lamp you are likely to be required to file a separate application. Generally, although fees are charged for each additional design, they are significantly less than the cost of filing a separate application for each design. In some countries, however, you may have to file a separate application for each design. Many of these countries, while limiting an application to a single design, permit several variants of that design; others allow for an exception to the "single design" rule when all the designs relate to a "set of articles".

- Variants would include, for example, two earrings, which differ in that one is a clip-on and the other is for pierced ears. To be considered variants, the designs must be applied to the same article and must not differ substantially from one another.

- A "set", on the other hand, is defined as a number of articles of the same general character which are normally sold together, or intended to be used together, and which share some common design features. Examples include, cutlery (forks, spoons, knives) and household appliances (a hairdryer and its nozzles and brushes).

As you can see, there is a wide variation in what is possible in a single application; the exact details of the requirements and possibilities for seeking protection in a cost-effective manner should be established either with an IP agent or with the relevant IP office.

The International Classification System

Industrial designs are generally classified or grouped into classes for ease of retrieval. You may be asked to refer to the class of products for which you intend to use the design in question in your application form. Kenya uses the classification of the Locarno Agreement Establishing an International Classification for Industrial Designs (see List of Classes in Annex II). See also: www.wipo.int/classifications/en/locarno/about/

Can you license your industrial designs?

Industrial designs are licensed when the owner of the design (licensor) grants permission to another person (the licensee) to use the design for whatever mutually agreed purposes. In such cases, a licensing contract is generally signed between the two parties specifying the terms and scope of the agreement.

Licensing contracts often include limitations as to the countries where the licensee may use the design, the time for which the license is granted and the type of products for which it can be used.



In order to license the use of the design in foreign countries you would need to have previously obtained, or at least applied for, industrial design protection in the countries concerned.

Authorizing others to use your industrial designs through a licensing contract will enable your business to receive an additional source of revenue

and is a common means of exploiting a company's exclusivity over its registered designs.

Agreements to license industrial designs are often included in broader licensing agreements, which cover all aspects (i.e. not just the visual elements) of a product.

3. Protecting Designs Abroad

Why protect designs abroad?

If your company intends to export products bearing an original design, or intends to license the manufacture, sale or export of such products to other firms in foreign countries, it should consider protecting its designs in such countries in order to enjoy the same benefits of protection abroad as it enjoys in the domestic market.

How do you protect your industrial designs abroad?

Industrial design protection is territorial. This means that industrial design protection is generally limited to the country or region where you have registered your design. Hence, if you wish to have your industrial design protected in export markets you would have to make sure that protection is applied for in those specific countries.

It is important to bear in mind that you usually have six months from the date on which you applied for protection in the first country to claim the right of priority when you apply for design protection in other countries. Once this period has lapsed, you will be unable to apply for design protection in foreign countries, as your design will no longer be considered new.

There are three ways of protecting your industrial designs abroad.

1. The National Route: Companies may seek protection by applying separately to the national IP offices of each country in which they intend to obtain protection. The process can be rather cumbersome and expensive as translation into the national languages is generally required as well as payment of administrative (and sometimes legal) fees.

2. The Regional Route: If you are interested in a group of countries that are members of regional agreements which enable the registration of designs in more than one country, then you can consider filing a single application at the regional IP office concerned. Regional IP offices include:

- the African Regional Industrial Property Office (ARIPO) for industrial design protection in English-speaking African countries; An industrial design in respect of which Kenya is a designated state registered by ARIPO has the same effect in Kenya as an industrial design registered under the Industrial Property Act, 2001.

- the Benelux Designs Office (BDD) for protection in Belgium, the Netherlands and Luxembourg;

- the Office for Harmonization in the Internal Market (OHIM) for Community designs in the countries of the European Union;

<http://www.kipo.ke.wipo.net>



- the Organisation Africaine de la Propriété Intellectuelle (OAPI) for protection in French-speaking African countries. See Annex I for website addresses of regional IP offices.

3. The International Route: Companies that wish to register their designs internationally in several countries may also use the procedures offered by the Hague Agreement Concerning the International Deposit of Industrial Designs, a WIPO-administered treaty. An applicant from a Member country to the Hague Agreement can file a single international application with WIPO; the design will then be protected in as many Member countries of the treaty as the applicant wishes. The agreement provides applicants with a simpler and cheaper mechanism

for applying for industrial design registration in various countries. For a list of Member States of the Hague Agreement see Annex III. Kenya is not yet a member of the Agreement. Full information about the Hague Agreement, including the application form, can be obtained from the WIPO website at: www.wipo.int/hague/

The costs of an industrial design registration under the Hague Agreement vary depending on the number of designs to be protected and the number of countries where protection is sought. For example, the cost of protection for five designs in 11 countries using the international route offered by The Hague system is approximately 900 Swiss francs.

4. Enforcing Your Industrial Designs

How can you enforce your rights when your design is being imitated, copied or infringed?

Enforcing any IP right may be a complex issue for which it is usually advisable to seek professional assistance from a competent IP lawyer. It is important to bear in mind that the main responsibility for identifying and taking action against imitations or infringement of an industrial design lies with its owner. In other words, you are responsible for monitoring the use of your design in the marketplace, identifying any imitators or counterfeiters and deciding whether, how and when to take action against them.

An IP lawyer or agent would normally be the competent person to give you information about the possibilities to take legal action against imitators, infringers and counterfeiters and provide you with advice on how to settle any dispute. Enquiries may also be directed to KIPI.

Whenever you believe there is infringement, you may choose, as a first step, to send a "cease and desist letter" informing the infringer of a possible conflict between his design and your exclusive rights. The assistance of a lawyer in drafting such a letter is recommended. If the infringement persists, it may be necessary to take legal action against the infringer. If you know the location of the infringing activity, it may be possible to take surprise action by obtaining a search and seize order (usually from a competent court or the police) to conduct a raid, without prior notice to the allegedly offending company/individual.

In order to prevent the importation of infringing goods, measures at the international border are available to the design owner in many countries through the national customs authorities. As a general rule, if infringement is identified, it is highly advisable to seek professional legal advice.



International Design Protection

In 2001, the ten largest users of The Hague System for the international deposit of industrial designs in terms of the number of applications were the Swatch Group, Interior, Sony Overseas, Hermès, Daimler Chrysler, Nokia, Villeroy + Boch A.G., Moulinex, Philips Electronics and Salomon. In that year, the Swatch Group, the largest user of the system, deposited 103 applications for design registration using The Hague System. The distinctive “look” of its watches is considered a crucial feature that influences the choice of its customers

in favor of its products. In view of this, companies like the Swatch Group invest large sums of money and expertise in the development of winning designs and make sure they have exclusive rights to the exploitation of their designs through registration in many countries.

Photo Swatch : Courtesy: Swatch AG



5. Other Legal Instruments for Protecting Industrial Designs

What are the differences between copyright protection and industrial design protection for designs?

In some countries, the applicable law recognizes copyright protection for certain designs, for example, in the design of textile and fabrics.

In many countries you may obtain cumulative protection, (i.e., copyright protection and industrial design protection) which can exist concurrently for the same design, while in a few countries, the two forms of protection are mutually exclusive.

The first step before taking any decision on how best to protect your design is to understand the differences between these two forms of protection. Some of the main differences are outlined below:

Registration

- Under industrial design law the industrial design generally needs to be registered by the applicant before publication or public use anywhere, or at least in the country where protection is claimed. The registration certificate, provided by protection

under industrial design law, may prove useful in cases of infringement, as it provides a more solid basis from which you may enforce your exclusive rights.

- Copyright in works considered to be original subsists without formalities. While registration is not necessary for protection, copyright depositaries exist in some countries where you may deposit your design and obtain a certificate. You should note that in Kenya the design must not have been in the disclosure for more than twelve months before filing. An applicant is, however, not required to deposit a copyright.

Duration

- Industrial design protection generally lasts for a period that varies between 10 and 25 years depending on the country where protection is sought. It must also be borne in mind that the process of registration of industrial designs may take some time, and may not always be adequate for products that are linked to passing trends (e.g. fashion products). In Kenya it may be enforced for a maximum of 15 years.



- It must also be borne in mind that the process of registration of industrial designs may take some time, and may not always be adequate for products that are linked to passing trends (e.g fashion products).

- Copyright endures in most countries for the life of the author and 50 or 70 years after his death.

Scope of protection

- The right conferred by registration of an industrial design is an absolute right in the sense that there is infringement whether or not there has been deliberate copying.

- To enforce rights under copyright law, the copyright owner must prove that the allegedly infringing work is a direct or indirect reproduction of the work protected by copyright.

Types of products

- In most countries, not all designs can be protected by copyright but primarily those that may be considered as works of art. While the distinction may not always be clear, some designs, such as the shape of manufactured products, are unlikely to be protectable under copyright law, while others, such as textile designs, are often covered by both forms of protection.

Costs

- Registering your design in the countries you are interested in means that you will have to pay the applicable fees. In addition, it may be useful or necessary to use the services of an IP agent to assist you in drafting the application, which will incur additional costs.

Given that no formal registration of works protected by copyright is required by most national

copyright laws, there are generally no direct costs relating to copyright protection. However, there may be costs related to (a) the deposit of the work at the copyright depositary, in countries where it exists, and (b) demonstrating proof of ownership in case of disputes.

In summary, while the protection granted by registered industrial designs is stronger in that it covers even unintentional infringement and provides a registration certificate which may be an important proof in case of infringement, it involves more effort (financial and administrative) because it requires registration, and is shorter in duration.

In any case, and particularly if the design is not registered, it is generally advisable to keep good records of every step in the development of the design. Signing and dating each sketch, and properly archiving them, may help in case of infringement.

Example: In a recent survey of fabric designers in the United Kingdom, 80% of respondents said they always kept a record of their original design documents and were aware of their importance for proving copyright ownership.

When can trademark law protect a design?

A trademark is a distinctive sign (generally a word, a logo or a combination of the two) used to differentiate the products of one company from those of others. There are circumstances in which the form, design or packaging of a given product may be considered to be a distinctive feature of the product in question and may be protectable as a three-dimensional trademark. The bottle of Coca-Cola or the triangular shape of the Toblerone chocolate bar are some such examples.



It is advisable to consult an IP agent to determine whether a particular design may be considered a three-dimensional trademark.

Trademark protection has the advantage of being renewable indefinitely, while industrial design protection is usually protectable for a limited period of time (generally 10 or 25 years). There may also be a difference in the costs of registering trademarks as compared with industrial design protection. Depending on the legal system, the two types of protection may co-exist.

Do laws on unfair competition protect your design?

In many countries, industrial designs are often protected under laws on unfair competition. Thus, a design may be protected against acts of unfair competition including, in particular, slavish copying and acts that may lead to confusion, acts of imitation or use of a third party's reputation. However, protection under unfair competition is generally significantly weaker and infringement is more difficult to prove. Kenya is yet to enact a law on unfair competition.

Useful websites for further information:

On other intellectual property issues from a business perspective:
www.wipo.int/sme/

On industrial designs generally:
www.wipo.int/about-ip/en/

On practical aspects relating to the registration of industrial designs, see list of websites of national and regional intellectual property offices available in Annex I or:
www.wipo.int/news/en/links/ipo_web.htm.

On the Hague Agreement for the International Deposit of Industrial Designs:
www.wipo.int/hague/en/

On the Locarno Agreement Establishing an International Classification for Industrial Designs:
www.wipo.int/classifications
(under Locarno Agreement)

On arbitration and mediation:
<http://arbiter.wipo.int/>

<http://www.kipo.ke.wipo.net>



ANNEX I

Website Addresses of National and Regional Intellectual Property Offices

African Regional Industrial Property Organization (ARIPO)	http://www.aripo.wipo.net/
Algeria	http://www.inapi.org
Andorra	http://www.omp.ad
Argentina	http://www.inpi.gov.ar/
Armenia	http://www.armpatent.org
Austria	http://www.patent.bmwa.gv.at/
Australia	http://www.ipaustralia.gov.au/
Barbados	http://www.caipo.gov.bb/
Belgium	http://www.european-patent-office.org/patlib/country/belgium
Belize	http://www.belipo.bz
Benelux (Benelux Designs Office - BDD)	http://www.bbtm-bbdm.org/
Bolivia	http://www.senapi.gov.bo
Bosnia and Herzegovina	http://www.bih.net.ba/zsmpt
Brazil	http://www.inpi.gov.br
Bulgaria	http://www.bpo.bg/
Canada	http://www.cipo.gc.ca
China	http://www.sipo.gov.cn
China: Hong Kong (SAR)	http://www.info.gov.hk/ipd
China: Macao (SAR)	http://www.economia.gov.mo
Chile	http://www.proind.gov.cl
Colombia	http://www.sic.gov.co
Congo	http://www.anpi.cg.wipo.net
Costa Rica	http://www.registracional.go.cr
Croatia	http://www.dziv.hr/
Cuba	http://www.ocpi.cu
Czech Republic	http://www.upv.cz
Denmark	http://www.dkpta.dk/
Dominican Republic	http://www.seic.gov.do/onapi/
Egypt	http://www.egypa.gov.eg
Estonia	http://www.epa.ee
European Union (Office for the Harmonization in the Internal Market-OHIM)	http://oami.eu.int/
Finland	http://www.prh.fi
France	http://www.inpi.fr
Georgia	http://www.sakpatenti.org.ge/
Germany	http://www.dpma.de



Greece	http://www.gge.gr
Hungary	http://www.hpo.hu/
Iceland	http://www.els.stjr.is
India	http://www.patentoffice.nic.in
Indonesia	http://www.dgip.go.id
Ireland	http://www.patentsoffice.ie
Israel	http://www.justice.gov.il/rasham+haptentim/
Italy	http://www.european-patent-office.org/it/
Japan	http://www.jpo.go.jp
Jordan	http://www.mit.gov.jo
Kazakhstan	http://www.kazpatent.kz
Kenya	http://www.kipo.ke.wipo.net
Kyrgyzstan	http://www.krygyzpatent.kg
Lao People's Democratic Republic	http://www.stea.la.wipo.net/
Lithuania	http://www.vpb.lt/
Luxembourg	http://www.etat.lu/EC/
Macao	http://www.economia.gov.mo
Malaysia	http://www.kpdnhq.gov.my/
Mexico	http://www.impi.gob.mx/
Monaco	http://www.european-patent-office.org/patlib/country/monaco/
Mongolia	http://www.mongol.net/ipom
Morocco	http://www.ompic.org.ma/
Netherlands	http://www.bie.minez.nl
Nepal	http://www.ip.np.wipo.net
New Zealand	http://www.iponz.govt.nz
Norway	http://www.patentstyret.no
Organisation Africaine de la Propriété Intellectuelle (OAPI)	http://www.oapi.wipo.net/
Panama	http://www.mici.gob.pa/comintf.html
Peru	http://www.indecopi.gob.pe/
Philippines	http://www.ipophil.gov.ph/
Poland	http://www.uprp.pl/
Portugal	http://www.inpi.pt/
Republic of Korea	http://www.kipo.go.kr
Republic of Macedonia	http://www.ippo.gov.mk/
Republic of Moldova	http://www.agepi.md/
Romania	http://www.osim.ro
Russian Federation	http://www.rupto.ru
Serbia and Montenegro	http://www.yupat.sv.gov.yu
Singapore	http://www.ipos.gov.sg
Slovak Republic	http://www.indprop.gov.sk

<http://www.kipo.ke.wipo.net>



Slovenia	http://www.sipo.mzt.si
Spain	http://www.oepm.es
Sweden	http://www.prv.se
Switzerland	http://www.ige.ch
Tajikistan	http://www.tipat.org
Thailand	http://www.ipthailand.org
Turkey	http://www.turkpatent.gov.tr
Ukraine	http://www.ukrpatent.org/
United Kingdom	http://www.patent.gov.uk
United States	http://www.uspto.gov
Uruguay	http://www.dnpi.gub.uy
Uzbekistan	http://www.patent.uz
Venezuela	http://www.sapi.gov.ve

ANNEX II

International Classification for Industrial Designs of the Locarno Agreement

LIST OF CLASSES

1. Foodstuffs
2. Articles of clothing and haberdashery
3. Travel goods, cases, parasols and personal belongings, not elsewhere specified
4. Brushware
5. Textile piece goods, artificial and natural sheet material
6. Furnishing
7. Household goods, not elsewhere specified
8. Tools and Hardware
9. Packages and containers for the transport or handling of goods
10. Clocks and watches and other measuring instruments, checking and signalling instruments
11. Articles of adornment
12. Means of transport or hoisting
13. Equipment for production, distribution or transformation of electricity
14. Recording, communication or information retrieval equipment
15. Machines, not elsewhere specified
16. Photographic, cinematographic and optical apparatus
17. Musical instruments
18. Printing and office machinery
19. Stationery and office equipment, artists' and teaching materials
20. Sales and advertising equipment, signs
21. Games, toys, tents and sports goods
22. Arms, pyrotechnic articles, articles for hunting, fishing and pest killing



- 23. Fluid distribution equipment, sanitary, heating, ventilation and air-conditioning equipment, solid fuel
- 24. Medical and laboratory equipment
- 25. Building units and construction elements
- 26. Lighting apparatus
- 27. Tobacco and smokers' supplies
- 28. Pharmaceutical and cosmetic products, toilet articles and apparatus
- 29. Devices and equipment against fire hazards, for accident prevention and for rescue
- 30. Articles for the care and handling of animals
- 31. Machines and appliances for preparing food or drink not elsewhere specified
- 99. Miscellaneous

ANNEX III

Members of the Hague Agreement Concerning the International Deposit of Industrial Designs (as of September 2003)

Belgium
 Belize
 Benin
 Bulgaria
 Côte d'Ivoire
 Democratic People's Republic of Korea
 Estonia
 Egypt
 France
 Gabon
 Georgia
 Germany
 Greece
 Holy See
 Hungary
 Iceland

Indonesia
 Italy
 Kyrgyzstan
 Liechtenstein
 Luxembourg
 Monaco
 Mongolia
 Morocco
 Netherlands
 Republic of Moldova
 Romania
 Senegal
 Serbia and Montenegro
 Slovenia
 Spain
 Suriname
 Switzerland
 The former Yugoslav Republic of Macedonia
 Tunisia
 Ukraine

Member States: 36

<http://www.kipo.ke.wipo.net>



ANNEX IV

FORM IP 27
Regulation 47

THE INDUSTRIAL PROPERTY ACT, 2001

The Managing Director,
Kenya Industrial Property Institute.

APPLICATION FOR REGISTRATION OF AN INDUSTRIAL DESIGN

Applicant's/agent's reference		
Name and address of applicant(s)		
Nationality (country)		Residence (country)
Telephone number	Facsimile number	E-mail address
Name and Address of the creator(s)		
Name and address of agent (if any)		
<u>Address for service</u>		
What article is the design to be applied to?		
Is the design to be applied to: -	<input type="checkbox"/> A single article? Or <input type="checkbox"/> A set of articles?	
Declaration of priority (see note 4)		
Disclaimer (if any) limiting rights applicant is seeking		

Reminder:

Have you attached?

Representations or specimens of the design?	
Any continuation sheet if appropriate?	
The prescribed fee?	

NOTES:

1. If space provided is not sufficient, use a separate sheet of paper.
2. Please enter the names of each applicant. Names of individuals should be entered in full and the surname or family name should be underlined.
3. Please name concisely the specific articles as shown in the representations for which protection is required.
4. The declaration of priority should comply with the requirements in Regulation 21

Dated at this.....day of....., 20.....

Signature.....

ANNEX V

PATENTS AND INDUSTRIAL DESIGNS

Description of fee	Local Fee		Foreign Fee	Corresponding form
	KSh	US\$		
1. Fee for a request for written authority under s. 28(1) of the Act	1,000	N/A		1
2. Fee for a request for certificate that person has right to inspect files	1,000		50	2
3. Fee for application for a patent				
With a provisional specification	1,000		50	3
With a final specification	3,000		150	3
4. Excess claims fee, for each claim in excess often (see Regulation 14(11))	100		20	3
5. Fee for filing a final specification	3,000		150	3
6. Fee for a request for amendment or division of an application	2,000		100	5
7. Fee for request for amendment of application to change name, address or other contact information	1,000		50	6
8. Fee for a request for extension of time	1,000		50	7
9. Fee for publication of patent application (see Regulation 25)	3,000		150	N/A
10. Fee for a request for a substantive examination	5,000		250	8
11. Fee for grant of a patent (see Regulation 29)	3,000		150	N/A
12. Fee for a request for a certified copy	2,000		100	11
13. Fee for a request for an un certified copy	500		50	12
14. Transmittal fee (see Regulation 31)	5,000		250	N/A
Plus actual cost of transmittal				
15. Fee for request to have an international application treated as an application under the Act (refused application)	3,000		150	13
16. Fee for request to have an international application treated as an application under the Act (entry into national phase)	3,000		150	14
17. Fee for request to have a regional application treated as an application under the Act (refused application)	3,000		150	15
18. Annual fee for an application or patent:				
For 2nd year	2,000		300	16
For 3rd year	2,000		300	16
For 4th year	2,000		300	16
For 5th year	2,000		300	16
For 6th year	2,000		300	16
For 7th year	2,000		300	16
For 8th year	6,000		300	16
For 9th year	7,000		350	16
For 10th year	8,000		400	16
For 11th year	10,000		500	16
For 12th year	12,000		600	16
For 13th year	14,000		700	16
For 14th year	16,000		800	16
For 15th year	18,000		900	16
For 16th year	20,000		1,000	16
For 17th year	30,000		1,500	16
For 18th year	35,000		1,750	16
For 19th year	40,000		2,000	16
For 20th year	50,000		2,500	16
19. Surcharge under s. 61(2) of the Act	3,000		150	16
20. Fee for a request to restore an application or patent	6,000		300	17
21. Fee for an application to have a change of ownership recorded in the register:				

<http://www.kipo.ke.wipo.net>

For a change effected by a contract assigning the application or patent	1	7,000	350	18
For a change effected in any other way		5,000	250	18
22. Fee for a petition for registration of a licence contract or modification to a registered licence contract		30,000	1,500	20
23. Fee for a request for an entry that licences are to be available as of right		1,000	50	22
24. Fee for notice of opposition to an entry that licences are to be available as of right		5,000	250	23
26. Fee to convert patent application into application for Utility model certificate under section 83(1) of the Act		500	50	N/A
27. Fee to convert application for utility model certificate into patent application under section 83(2) of the Act		2,500	150	N/A
28. Fee for an application for registration of an industrial design		3,000	150	27
29. Publication fee for notice of application to register an industrial design (see Regulation 48)		3,000	150	N/A
30. Fee for notice of opposition to an application for registration of an industrial design		5,000	250	23
31. Fee for a counter-statement (in relation to an application for registration of an industrial design or a request for an		4,000	200	28
32. Fee for a notice to appear at a hearing (in relation to an application for registration of an industrial design or a request for an entry that licenses are to be available as of request for an entry that licenses are to be available as of right)		5,000	250	29
33. Fee for a request for reasons for a decision to refuse to register an industrial design		1,000	50	30
34. Fee for registration of an industrial design (see Regulation (51)		1,000	501	N/A
35. Fee for an application for a renewal of an industrial design		10,000	500	32
36. Fee for an application for the restoration of protection granted to an industrial design		2,000	100	33
37. Surcharge under section 88(3) of the Act for late renewal		3,000	150	N/A
38. Fee for a request to examine representations or specimens		1,000	50	34
39. Fee for an application to register a technovation certificate		1,000 (same as local fee)		36
40. Fee for a surrender of a patent or utility model, industrial design certificate		1,000	50	38
41. Fee for an appointment of an agent		1,000	50	39
42. Fee for application for admission to practice before the Institute		10,000	500	40
43. Annual fee to maintain admission to practice before the Institute		2,000	100	41
44. Fee for a request for a lost or destroyed certificate		2,000	100	42
45. Fee for a search		2,000	100	43
46. Fee for request for amendment of register to change name, address or other contact information		2,000	100	44
47. Fee for request to have a caution or notice included in or removed from a register		1,000	50	45



For a change effected by a contract assigning the application or patent	1	7,000	350	18
For a change effected in any other way		5,000	250	18
22. Fee for a petition for registration of a licence contract or modification to a registered licence contract		30,000	1,500	20
23. Fee for a request for an entry that licences are to be available as of right		1,000	50	22
24. Fee for notice of opposition to an entry that licences are to be available as of right		5,000	250	23
26. Fee to convert patent application into application for Utility model certificate under section 83(1) of the Act		500	50	N/A
27. Fee to convert application for utility model certificate into patent application under section 83(2) of the Act		2,500	150	N/A
28. Fee for an application for registration of an industrial design		3,000	150	27
29. Publication fee for notice of application to register an industrial design (see Regulation 48)		3,000	150	N/A
30. Fee for notice of opposition to an application for registration of an industrial design		5,000	250	23
31. Fee for a counter-statement (in relation to an application for registration of an industrial design or a request for an		4,000	200	28
32. Fee for a notice to appear at a hearing (in relation to an application for registration of an industrial design or a request for an entry that licenses are to be available as of request for an entry that licenses are to be available as of right)		5,000	250	29
33. Fee for a request for reasons for a decision to refuse to register an industrial design		1,000	50	30
34. Fee for registration of an industrial design (see Regulation (51)		1,000	501	N/A
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37. Surcharge under section 88(3) of the Act for late renewal		3,000	150	N/A
38. Fee for a request to examine representations or specimens		1,000	50	34
39. Fee for an application to register a technovation certificate		1,000 (same as local fee)		36
40. Fee for a surrender of a patent or utility model, industrial design certificate		1,000	50	38
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45. Fee for a search		2,000	100	43
46. Fee for request for amendment of register to change name, address or other contact information		2,000	100	44
47. Fee for request to have a caution or notice included in or removed from a register		1,000	50	45





**For more information contact the:
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:254-2-606312
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kipi@swiftkenya.com
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[Http://www.kipo.ke.wipo.net](http://www.kipo.ke.wipo.net)**

