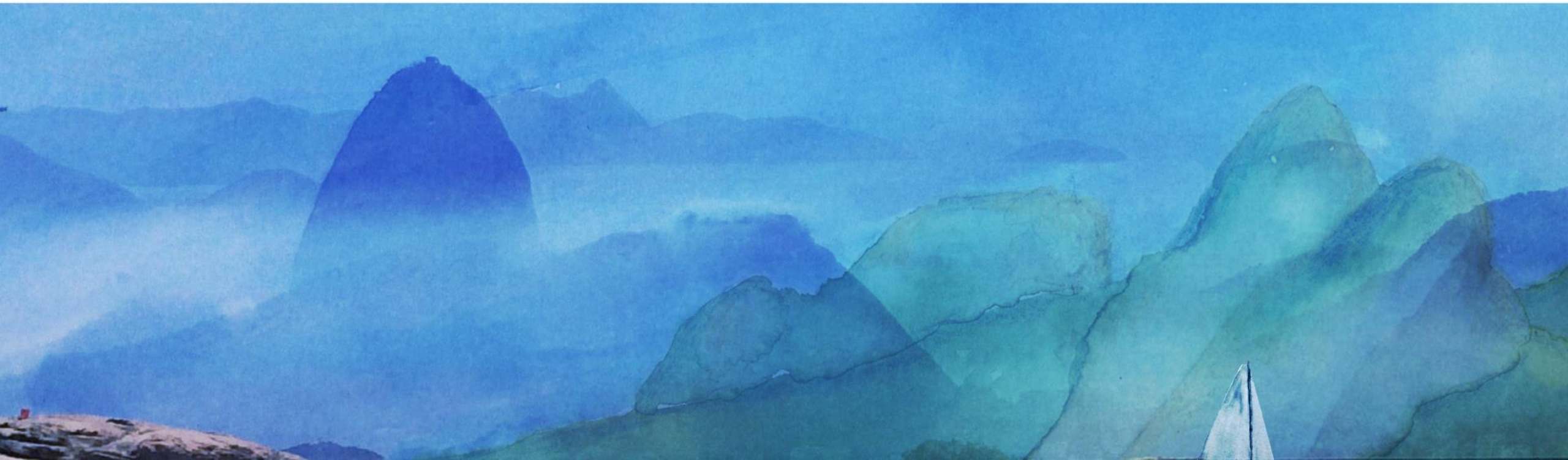


BPTO's Industrial Design Guidelines

A Brand New Guide

Di Blasi,
Parente &
Associados



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1. Introducing the Guidelines

- Public Consultation from August to September, 2017
- Much debated within IP community, national and international
- Official version published in January, 2019
- In force since March 9, 2019
- Upsides:
 - Transparency
 - Less discretion between examiners
 - Official grounds for challenging decisions
- Downsides:
 - Dubious interpretation of Priority Claiming
 - No advancement on Partial Designs

2 Industrial Designs

Either configurations or patterns applied to an object can be registered

2-D

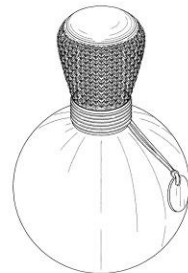


DI 7102778-5



BR 30 2015 005141-8

3-D



BR 30 2012 000635-0



BR 30 2015 002370-8.

2.1 Definitions

2.2 Requirements

2.3 Hidden Features

2.1 Definition

Industrial designs have 3 main aspects: novelty, originality and industrial fabrication

Industrial Design –
ornamental plastic form
of object or ornamental
aspects of lines and
colors applied to a
product

Novelty

Originality

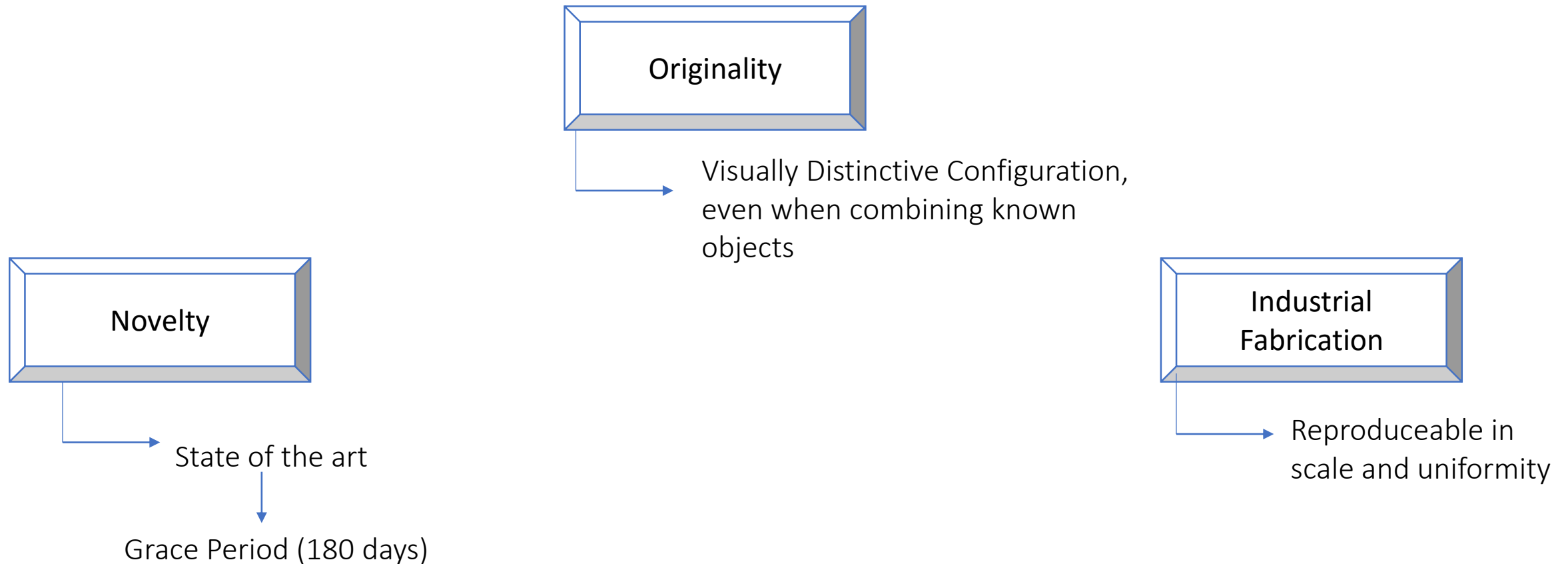
Industrial Fabrication



Configuration applied
on a chair. (lider
industria e comercio de
estofados Ltda - Design
nº BR 30 2017
005665 2)

2.2 Requirements

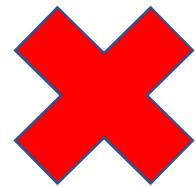
Making sure the application meets the requirements is determinant for effective protection



2.3 Hidden features

Design protection is only available for visible parts of objects

Design protection is granted to a design as a whole, which means parts that are not visible will not be granted protection and should not be displayed in pictures



Exploded view



3 Formal Examination

Important parts of the application that the BPTO considers before granting design register

Titles of the chapters of Design Guidelines give a false impression that the BPTO conducts two distinct examinations – a formal and a technical one.

As we will see, the BPTO does not conduct a technical analysis.

In this session of the presentation, we will see what the BPTO named formal examination, which it defines as the verification of data and documents that a design application should have.

3.1 Parts of an application

3.2 Deferral of Publication

3.1 Parts of the Application

Every application needs to have distinctive separated well-defined sessions



3.2 Deferral of Application

It is possible to request late publication of the design

As a general rule, provided that (a) design applications are not against morality, (b) contains all the variations requested (which we will see soon) and (c) the application itself has the correct structure, the design application is published online.

However, the applicant may request, upon filing, **deferral of publication for 180 days.**



4 Technical Examination

In what the BPTO considers “technical examination”, the guidelines state that the Brazilian Office will check compliance within the topics of the application, including if it is an unregistrable design and variations requested.

4.1 Priority Right Analysis

4.2 Unregistrable Designs

4.3 Variations

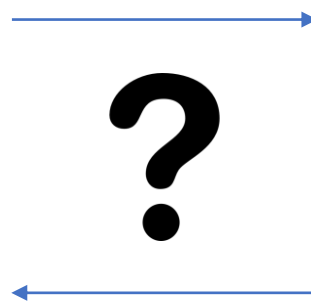
4.4 Views and Representations

4.5 GUIs

4.1 Priority Right Analysis

The most controversial aspect of the guidelines

The BPTO will analyze if the design claimed in the Brazilian application identically match the representations of the priority application. If there is no identical correspondence, priority right will not be granted



In case an object has elements that are not claimed in the application (e.g. broken lines) in the priority application, those should be incorporated in the claim of the Brazilian application (solid lines).

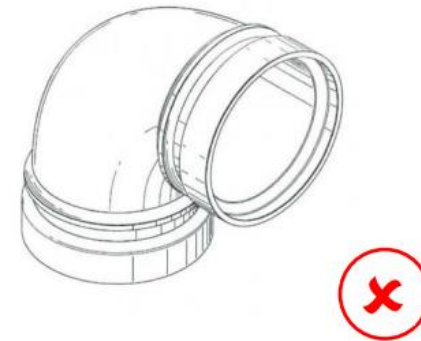
It is possible to appeal from the decision within 60 days

4.2 Unregistrable Designs

Some designs are not registrable

- anything contrary to morals and standards of respectability
- the common or ordinary necessary shape of the object or, yet, that shape which is essentially determined by technical or functional considerations.

Obscene designs or designs that somehow support crime or drugs



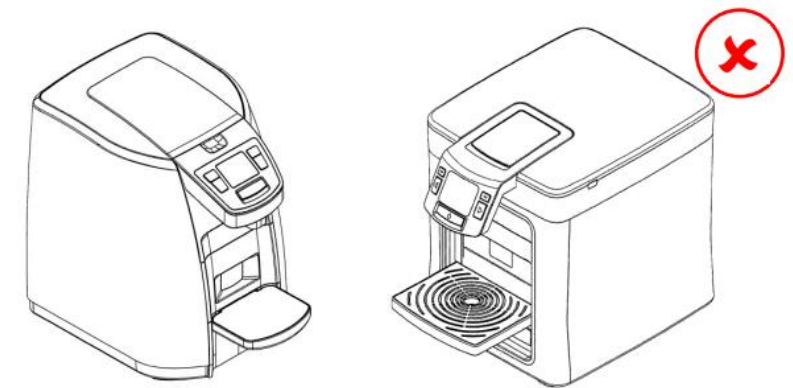
4.3 Variations

It is possible to request protection for one design with multiple variations

Up to twenty variations are allowed to each design, provided that:

- They are intended for the same purpose and
- Maintain the same preponderant characteristic

Locarno
Classification's
and subclass class



4.4 Views and Representations

Most important part of the application, as they define the scope of protection

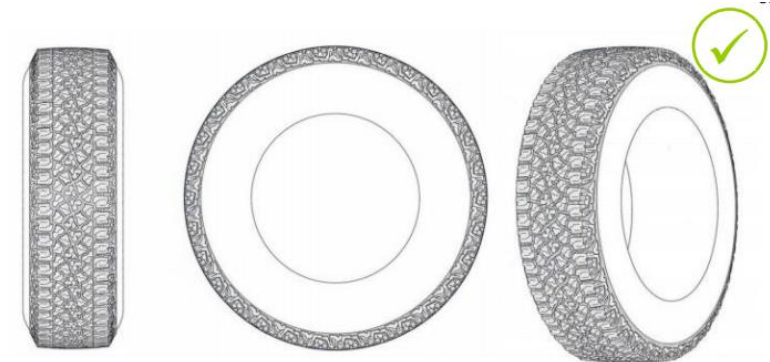
Views

- Usual: One perspective and all the orthogonal views (front, rear, sides, top and bottom)
- Exceptions: Symmetric or mirrored views can be omitted, but it must be informed in the specifications.



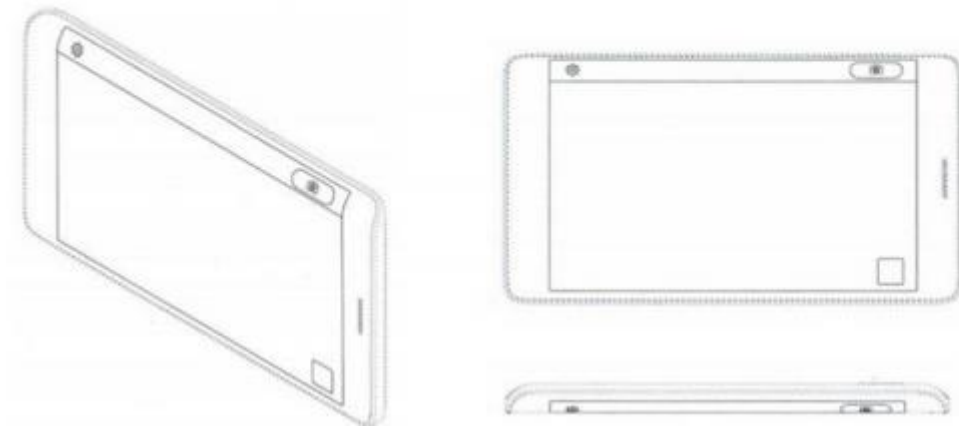
Representations

- Graphical representation: solid lines
- Photographical representation: object must be sharp and clear



4.5 GUIs

Graphical Representations can be registered in Brazil



BR 30 2015 000117-8
Ornamental Pattern Applied to Graphical Interface

5 Post-Grant

After the design is granted, the titleholder has a wide range of rights.

Also, the titleholder may request substantial examination.

The term of protection, however, is counted from the filing date, once the design is granted.

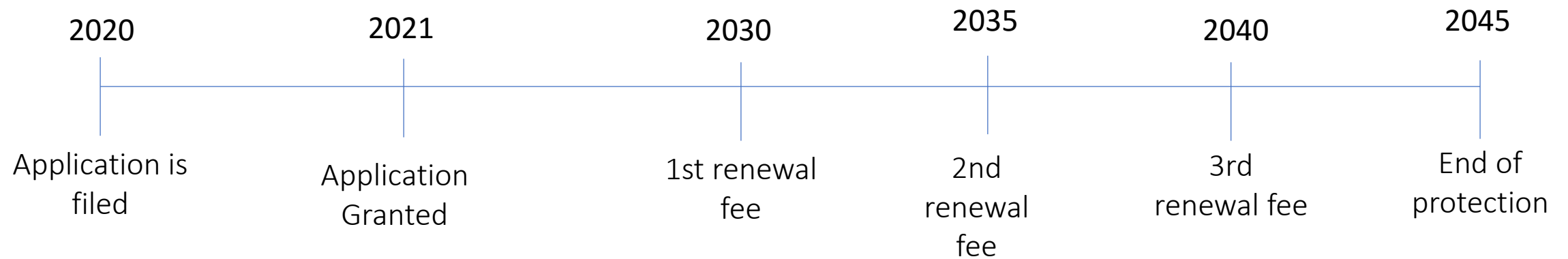
5.1 Term of Protection

5.2 Substantial Examination

5.3 Rights granted to design titleholder

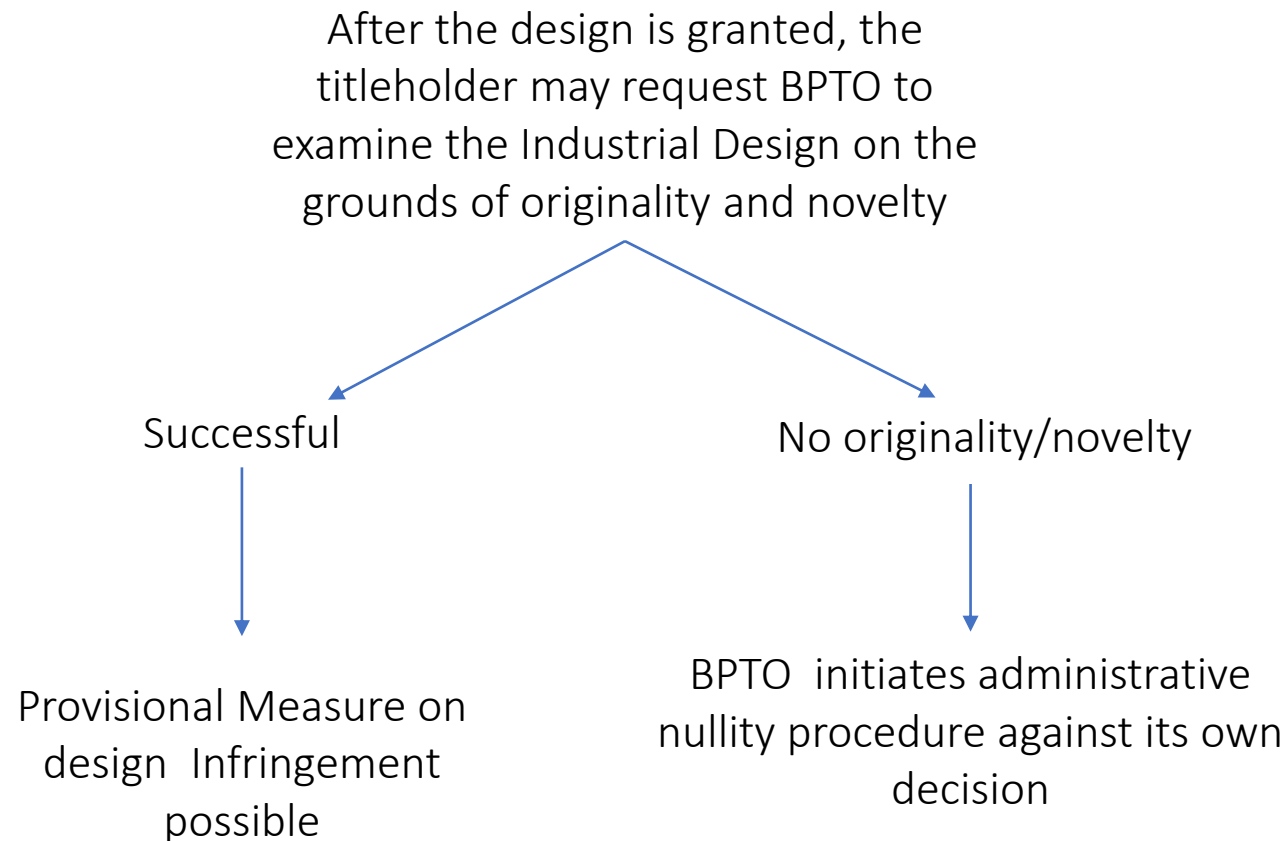
5.1 Term of Protection

Design rights may be protected for up to 25 years



5.2 Substantial Examination

BPTO can conduct analysis of originality and novelty features



5.3 Rights granted to design titleholder

Design titleholders have rights that are similar to patent rights

Prevent, without consent, anyone from using, selling, or importing AND prevent third parties to contribute with infringement

Exceptions:

Unauthorized acts done privately without commercial purpose, not harming economic interests of titleholders

experimental purposes, in connection with scientific or technological studies or researches

a product manufactured in accordance with a process or product patent that has been introduced onto the domestic market directly by the patentholder or with his consent

6 Conclusion

- The Industrial Design Guidelines benefits the IP Community and entrepreneurs in Brazil, once there is now further transparency to BPTO's administrative decisions on the topic.
- There are, however, controversial topics on the guidelines, specialty the aspects related to Priority Claiming
- Nonetheless, protecting designs is essential for assuring maximum IP protection and economic growth, as Market exclusivity for known products, specially ornamental shapes such as the case for Design protection, tend to boost up sales and increase Market value.

**Di Blasi,
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Obrigado!

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