

Information Session on Temporary Protection Provided to Industrial Designs under Article 11 of the Paris Convention

The Experience of Users

Christopher V. Carani
Partner, McAndrews, Held & Malloy, Ltd.



Article 11

Article 11 Inventions, Utility Models, Industrial Designs, Marks: *Temporary Protection at Certain International Exhibitions*

- (1) The countries of the Union shall, in conformity with their domestic legislation, grant **temporary protection** to patentable inventions, utility models, **industrial designs**, and trademarks, in respect of goods exhibited at official or officially recognized international exhibitions held in the territory of any of them.

- (1) Such temporary protection shall not extend the periods provided by Article 4. If, later, the right of priority is invoked, the authorities of any country may provide that the period shall start from the date of introduction of the goods into the exhibition.

- (1) Each country may require, as proof of the identity of the article exhibited and of the date of its introduction, such documentary evidence as it considers necessary.



U.S. Approach

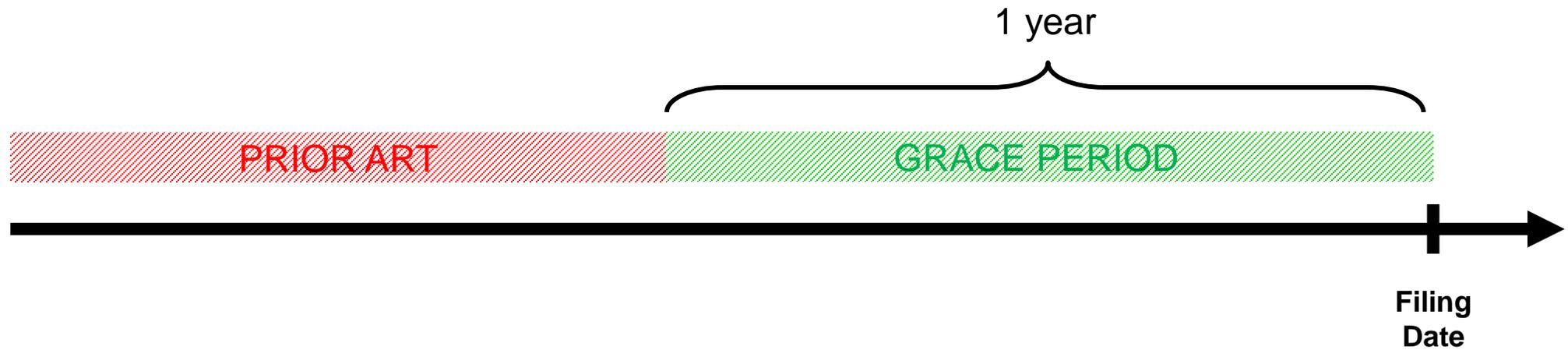
1-Year Novelty “Grace Period”, § 102 AIA





U.S. Approach

1-Year Novelty “Grace Period”, § 102 AIA

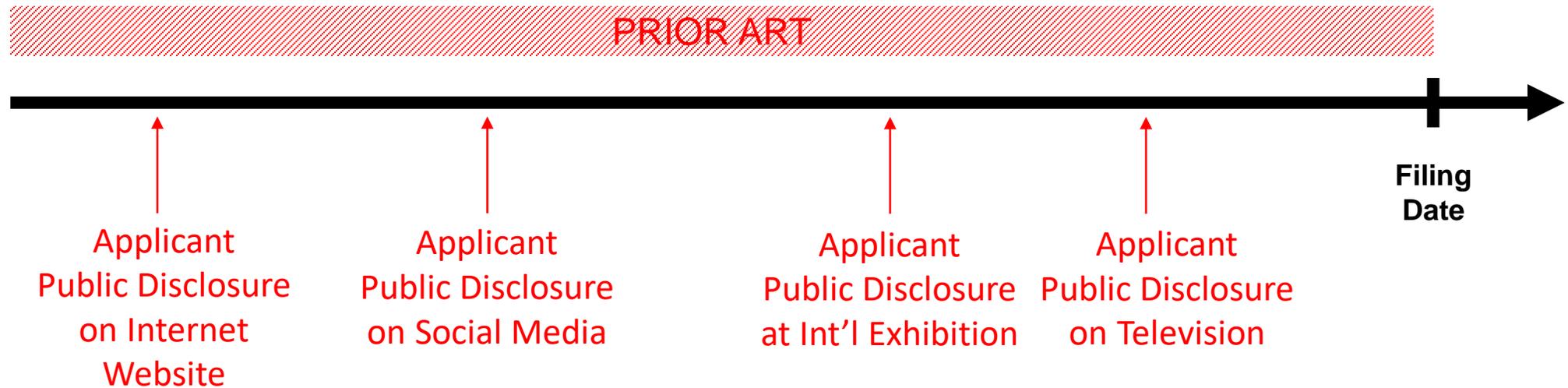


Note: Applicant’s public disclosures made during 1-year grace period are excepted from consideration as “prior art.”



U.S. Approach

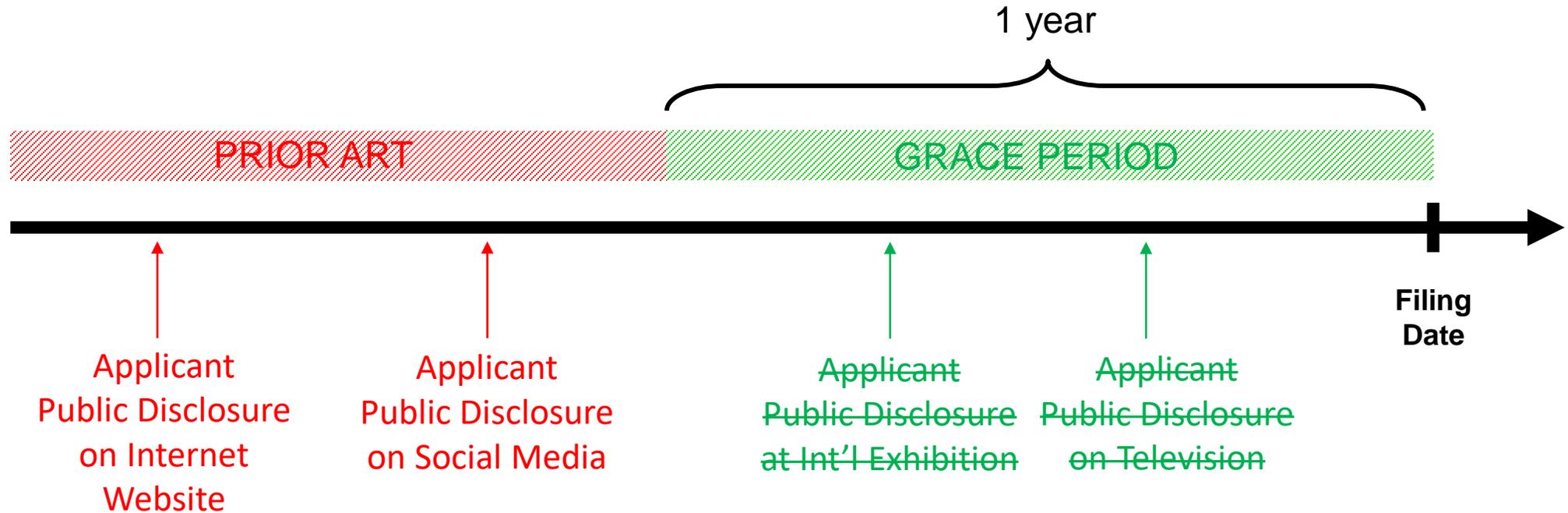
1-Year Novelty “Grace Period”, § 102 AIA





U.S. Approach

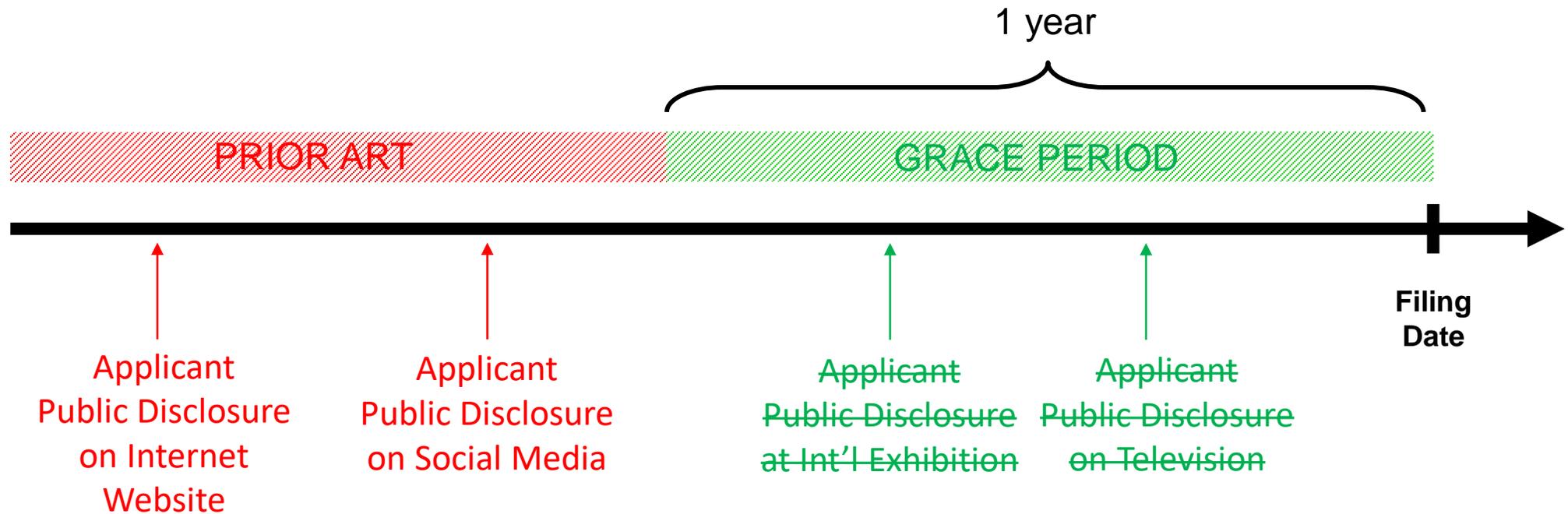
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U.S. Approach

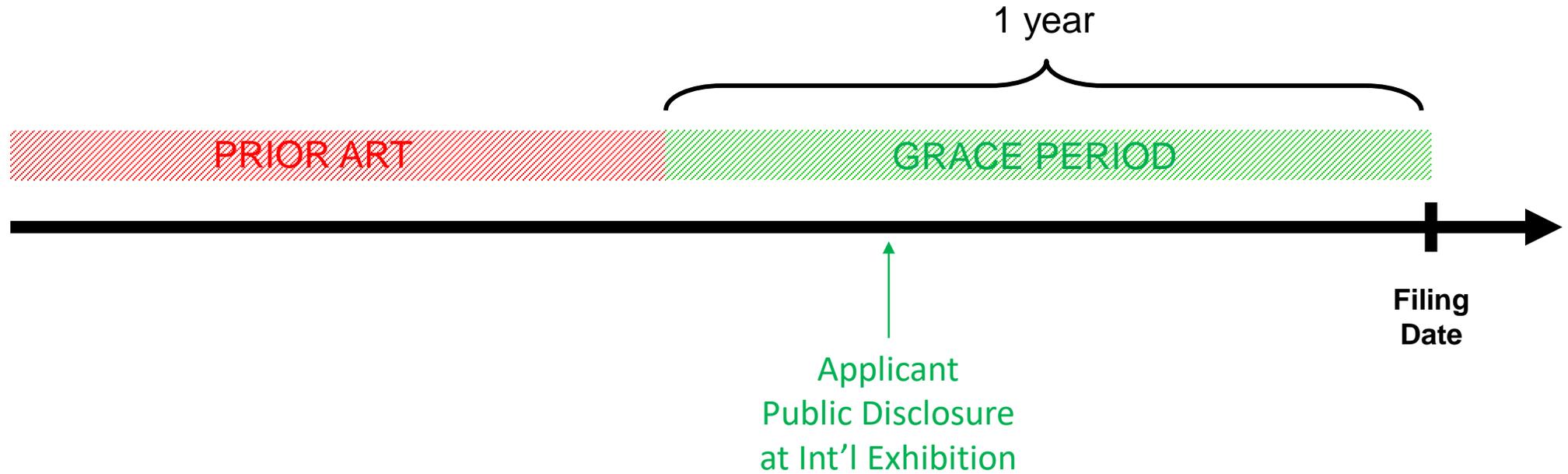
1-Year Novelty “Grace Period”, § 102 AIA





U.S. Approach

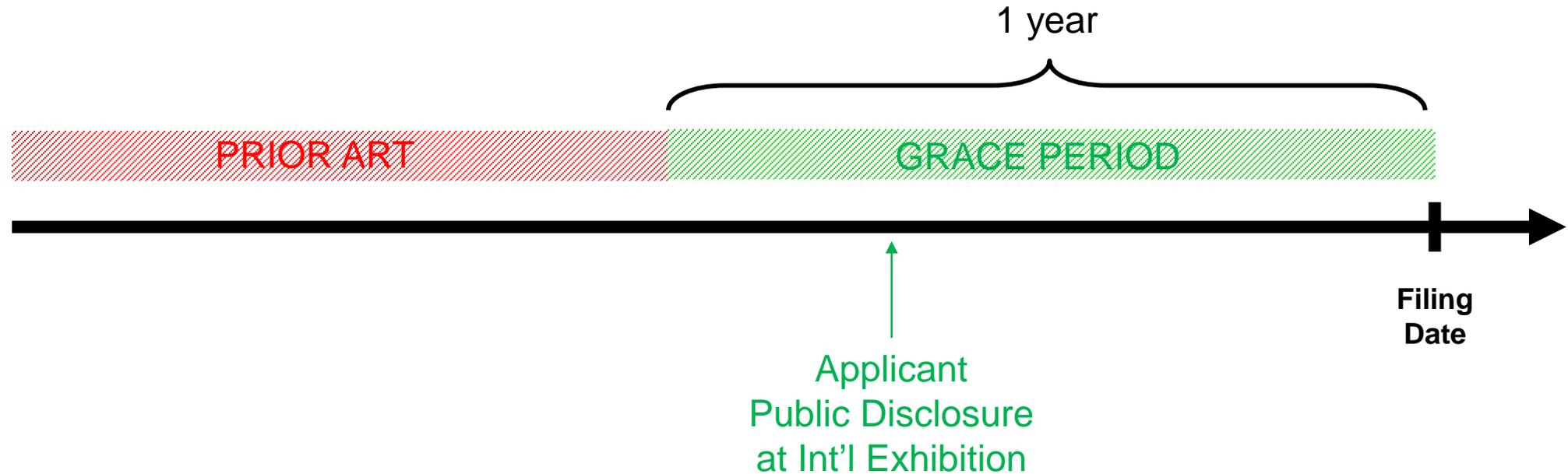
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U.S. Approach

1-Year Novelty “Grace Period”, § 102 AIA



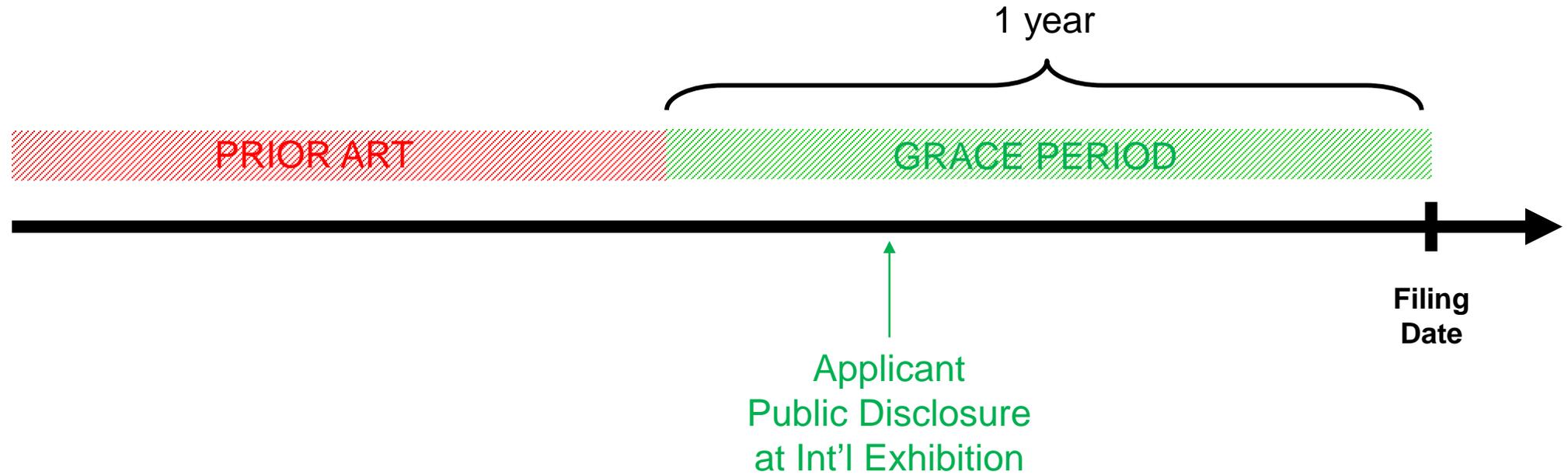
Note: Public disclosure at Int'l Exhibition **does not**

- establish exhibition priority date
- trigger protection, such as unregistered design rights.



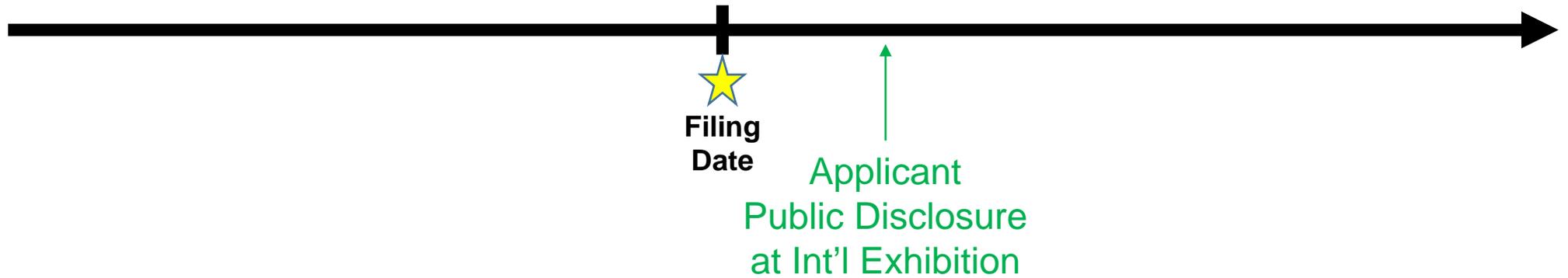
U.S. Approach

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#1

Best Practice – File Before First Public Disclosure





Implementation of Article 11

Uncertainty, Variation and the Unknown

- Establish “Protection”? What Protection?
- Definition of Int’l Exhibition
- Separate Int’l Exhibition novelty grace period? 6mos? 1 year? More?
- Duration? Starting Point? Ending Point?
- Establish Priority Date?
- Proving Documents?
- What exactly was disclosed?
 - Shape only?
 - Shape + Surface ornamentation?
 - Partial Designs?
- Public Notice sufficiently served?
- Potential abuses?
- Is Article 11 Good Public Policy?

QUESTION Q33

Temporary protection at expositions

Resolution

The Congress,

reverts to and confirms the resolution of the Paris Congress favoring the abrogation of article 11 of the Convention.

QUESTION Q38

The problem of exhibitions

Resolution

The Congress expresses the wish that Article 11 of the Union Convention be replaced by the following:

„The countries of the Union undertake not to regard the validity of a patent, utility model, design or industrial model as hindered by publication occurring at an international exhibition organised in the territory of one of such countries prior to the filing of an application for protection, provided that the first filing be made within six months from the date of the opening of the exhibition.“



Simply a Safeguard Against Anti-Novelty Event?

University of Baltimore Law Review

The International Protection of Industrial Designs under the International Conventions

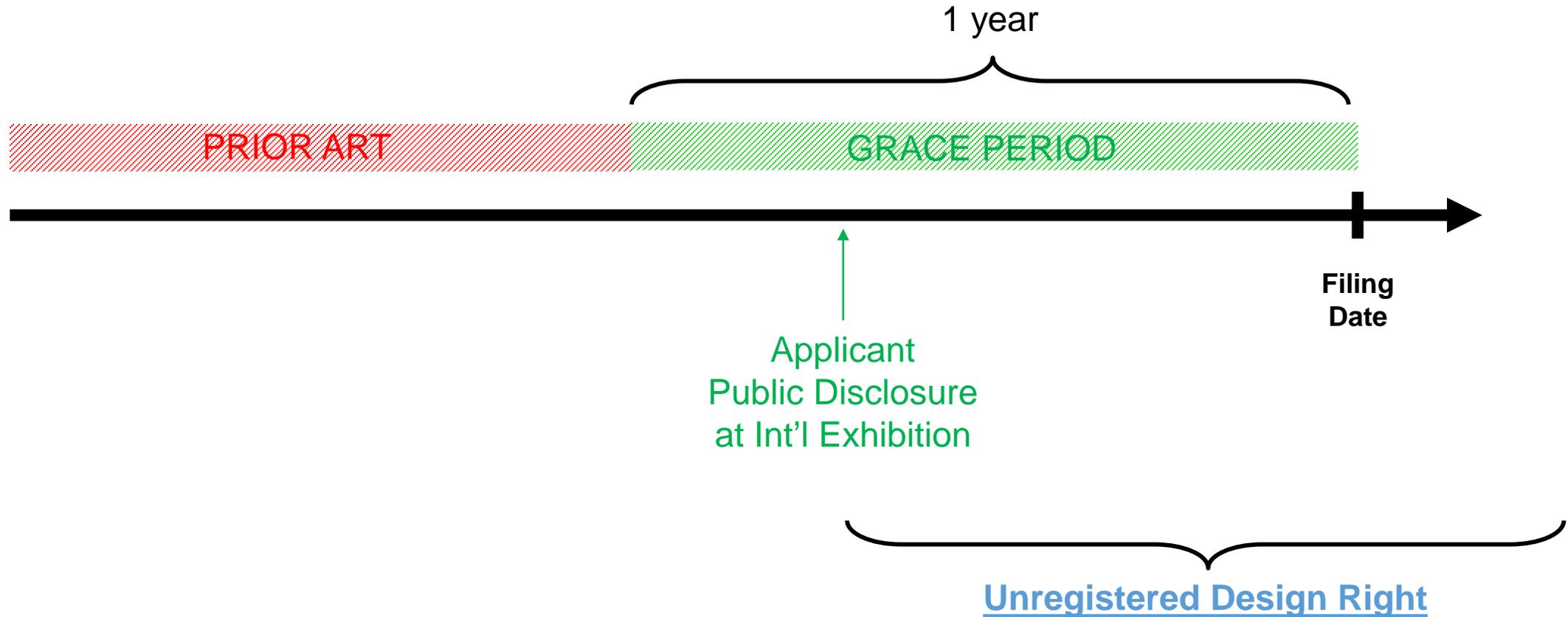
Pierre Maugué

World Intellectual Property Organization (WIPO)

The primary purpose of the temporary protection principle is to prevent the exhibit of a product from being considered a disclosure that damages the novelty of the design, and therefore, under certain national laws constitutes an obstacle to any subsequent deposit. The measures taken by



Dare to dream...



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Christopher V. Carani, Esq.
Partner
McANDREWS HELD & MALLOY LTD.
500 West Madison St., Suite 3400
Chicago Illinois 60661
(Tel) 312 775 8000
ccarani@mcandrews-ip.com
www.mcandrews-ip.com

Christopher V. Carani, Esq. is a partner and shareholder at the intellectual property law firm of McAndrews, Held & Malloy, Ltd. based in Chicago, Illinois. For two decades he has been a leading voice in the field of design law. Chris counsels clients on a wide range of strategic design protection and enforcement issues, both in the U.S. and abroad.

Chris is the current Chair of AIPPI-US and chair of AIPPI Committee on Designs. He is past chair of the American Bar Association's Design Rights Committee, and the American Intellectual Property Law Association (AIPLA) Committee on Industrial Designs. In the landmark design patent case *Egyptian Goddess v. Swisa*, he authored *amicus* briefs on behalf of the AIPLA at both the petition and *en banc* stages.

Prior to joining McAndrews, Chris served as a law clerk to the Honorable Rebecca R. Pallmeyer at the U.S. District Court for the Northern District of Illinois. Chris was conferred his Juris Doctorate from The Law School at The University of Chicago. He also holds a Bachelor of Science in Engineering from Marquette University. He is a registered patent attorney licensed to practice before the USPTO.

He is on the faculty of Northwestern University School of Law and Chicago-Kent College of Law as an Adjunct Professor teaching IP Law. In 2017, his book "*Design Rights: Functionality and Scope of Protection*" was published by Wolters Kluwer.