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## 2016 – Study Question (Designs)

Sarah MATHESON, Reporter General  
John OSHA and Anne Marie VERSCHUUR, Deputy Reporters General  
Yusuke INUI, Ari LAAKKONEN and Ralph NACK, Assistants to the Reporter General  
**Requirements for protection of designs**

Responsible Reporter: Anne Marie VERSCHUUR

National/Regional Group	Finland
Contributors name(s)	Johanna LILJA, Åsa HENRIKSSON, Jerry HÄRKÖNEN, Tom JANSSON, Janne JOUKAS, Anni LAITINEN, Nina MIKANDER, Irmeli NOKKANEN and Lumi-Sirkku VIKIÖ
e-Mail contact	johanna.lilja@roschier.com
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### I. Current law and practice

1) Does your Group's current law provide for an intellectual property right (registered or patented) that specifically protects the outward appearance or ornamentation of an object or article of manufacture?

As set out in the Study Guidelines, copyrights and trademarks are not such rights in the context of this Study Question.

yes

Please explain:

Yes.

FI: According to Section 1 of the Finnish Registered Designs Act (221/1971)[<http://www.finlex.fi/fi/laki/ajantasa/1971/19710221>] (implementing the EU Designs Directive 98/71/EC), anyone who has created a design, or his or her successor in title, may through registration obtain the exclusive right to the design. Under Section 1a of the Finnish Registered Designs Act, a design is defined as the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product itself or its ornamentation.

EU: In addition, the Community Design Regulation [<http://eur-lex.europa.eu/lega-content/EN/TXT/PDF/?uri=CELEX:32002R0006&qid=1458885268043&from=FI>] (Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs) provides protection for Community designs. Under Article 3(1)(a) of the Community Design Regulation, a design is defined as the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation.

- 2) If yes, what is this right called? (e.g. registered design, design patent, industrial design, industrial design patent)

References to design below are to be read as references to this right, irrespective of what it is called in your jurisdiction.

FI: The Finnish Registered Designs Act refers to a “design right” (“mallioikeus” in Finnish and “mönsterrätt” in Swedish).

EU: The Community Design Regulation refers to a “Community design”, which includes both a “registered Community design” and an “unregistered Community design”.

- 3) What are the statutory requirements for such right? Please tick any relevant boxes and explain the basis and application of these requirements.

- a) novelty

FI: According to Section 2 of the Finnish Registered Designs Act, a design must be new and have individual character. A design is considered new if no identical design has been made available to the public before the filing date (or the priority date, if claimed). Designs shall be deemed to be identical if their features differ only in immaterial details.

EU: According to Article 4 of the Community Design Regulation, a design shall be protected by a Community design to the extent that it is new and has individual character. Pursuant to Article 5, a design shall be considered to be new if no identical design has been made available to the public (in the case of a registered Community design) before the date of filing of the application for registration of the design for which protection is claimed, or, if priority is claimed, the date of priority. Designs shall be deemed to be identical if their features differ only in immaterial details.

- b) non-obviousness

- c) inventive step

- d) individual character

FI: According to Section 2 of the Finnish Registered Designs Act, a design must be new and have individual character. A design is considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design that has been made available before the filing date (or the priority date, if claimed). In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.

EU: According to Article 4 of the Community Design Regulation, a design shall be protected by a Community design to the extent that it is new and has individual character. Pursuant to Article 6, a design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public (in the case of a registered Community design) before the date of filing the application for registration or, if a priority is claimed, the date of priority. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.

e) originality

f) aesthetic

g) ornamental

h) other, namely ...

4) Does your Group's current law deny design protection to a design with an appearance that is dictated solely by its function?

yes

Please explain:

FI: According to Section 4b(1) of the Finnish Registered Designs Act, a design right shall not subsist in features of appearance of a product which are solely dictated by its technical function.

EU: According to Article 8(1) of the Community Design Regulation, a Community design shall not subsist in features of appearance of a product which are solely dictated by its technical function.

5) If yes, what are the relevant factors to determine whether or not a design is deemed unprotectable as being functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

b) whether each portion of the overall appearance is dictated solely by its technical function

c) the availability of alternative appearances that can obtain the same functional result

d) the need to achieve the product's technical function was the only relevant factor when the design in question was selected

e) other, namely ...

The relevant factors to determine whether or not a design is deemed unprotectable as being functional is whether the features of the design are dictated solely by its technical function (please see question 7).

6) Does your Group's current law deny design protection to any portions (e.g. a "feature", "element") of the overall design that are deemed functional?

yes

Please explain:

FI: According to Section 4b(1) of the Finnish Registered Designs Act, a design right shall not subsist in features of appearance of a product which are solely dictated by its technical function.

EU: According to Article 8(1) of the Community Design Regulation, a Community design shall not subsist in features of appearance of a product which are solely dictated by its technical function.

7) If yes, what are the relevant factors to determine whether or not a portion is deemed functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

b) the availability of alternative appearances for the portion to obtain the same functional result

c) the need to achieve the product's technical function was the only relevant factor when the portion in question was selected

d) other, namely ...

The relevant factors have not been clearly clarified in the Finnish Registered Designs Act or in the Community Designs Act, which both merely state that a design shall not subsist in features of appearance of a product which are solely dictated by its technical function. There is no legal precedents on the issue either. However, there is some guidance in the preparatory works of the Finnish Registered Designs Act and in the EUIPO Guidelines:

FI: According to Section 4b(1) of the Finnish Registered Designs Act, a design right shall not subsist in features of appearance of a product which are solely dictated by its technical function. Pursuant to the Government Bill on the Finnish Registered Designs Act (HE 6/2002), said exclusion does not apply if alternative appearances are available. There are no precedents on the interpretation of this provision.

EU: According to Article 8(1) of the Community Design Regulation, a Community design shall not subsist in features of appearance of a product that are solely dictated by its technical function. Neither the Court of First Instance nor the European Court of Justice have given rulings on the interpretation of this article. According to the EUIPO Guidelines for Examination of Design Invalidation Applications, Article 8(1) CDR denies protection to those features of a product's appearance that were chosen exclusively for the purpose of allowing a product to perform its function, as opposed to features that were chosen, at least to some degree, for the purpose of enhancing the product's visual appearance. The interpretations adopted in the decisions from the EUIPO Invalidation Division and the Board of Appeal are not consistent.

8) What is the effect on the scope of protection of a design with one or more functional portions? Please tick any relevant boxes and explain as applicable:

a) any portions deemed functional will not be taken into account when assessing infringement

See answers to questions 6 and 7 above.

b) any portions deemed functional will not be taken into account when assessing validity

See answers to questions 6 and 7 above.

c) any portions deemed functional will not be taken into account separately when assessing infringement, but can play a role in the overall comparison

d) any portions deemed functional will not be taken into account separately when assessing validity, but

may play a role in the overall comparison

e) no effect (e.g. so long as the overall appearance is not dictated solely by its technical function, all portions of the design are included in the scope of protection, irrespective as to whether any portions may be functional)

f) the Group's current law is unsettled

g) other, namely ...

## II. Policy considerations and possible improvements to your current law

9) How can the following aspects of your Group's current law be improved, if at all?

a) the definition or meaning of a "design"

FI and EU: No need for improvement

b) the requirements for protection of a design

FI and EU: The term "informed user" should be clearly defined

c) the treatment of functionality in the sense described in paragraph 14) of the Study Guidelines or aspects of such functionality

FI and EU: The meaning of "solely dictated by technical function" should be clearly defined in the legislation

10) Are there any other policy considerations and/or proposals for improvement to your current law falling within the scope of this Study Question?

no

Please explain:

The Finnish Group has no other policy considerations or proposals for improvement within the scope of this study question.

## III. Proposals for harmonisation

11) Does your Group consider that harmonisation in the three areas in question 9) above is desirable?

If yes to some but not all of those three areas, please state in relation to which of the areas your Group considers harmonisation is desirable.

If yes in relation to any of those areas, please respond to the following questions without regard to your Group's current law.

Even if no in relation to any of those areas, please address the following questions to the extent your Group considers your Group's current law could be improved.

yes

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Please explain:

Harmonization is desirable in all those areas.

12) Should there be harmonisation of the definition of an intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture?

yes

Please explain:

13) If so, what should that right be called?

Registered Design

14) What should the requirements for such right be? Please tick any relevant boxes and explain the basis and application of these requirements:

a) novelty

The Finnish Group suggest that EU law is used as a basis for the harmonization. Accordingly, the requirements for such design should be similar to those stipulated by the Community Design Regulation. Thus, a design should be protected to the extent that it is new and has individual character. A design should be considered to be new if no identical design has been made available to the public before the date of filing of the application for registration of the design for which protection is claimed, or, if priority is claimed, the date of priority. Designs shall be deemed to be identical if their features differ only in immaterial details. A design should be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the date of filing the application for registration or, if a priority is claimed, the date of priority. In assessing individual character, the degree of freedom of the designer in developing the design should be taken into consideration.

b) non-obviousness

c) inventive step

d) individual character

Selected

e) originality

f) aesthetic

g) ornamental

h) other, namely ...

15) Should design protection be denied to a design with an appearance that is dictated solely by its function?

yes

Please explain:

16) If yes, what should the relevant factors be to determine whether or not a design is deemed unprotectable as being functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

b) whether each portion of the overall appearance is dictated solely by its technical function

c) the availability of alternative appearances that can obtain the same functional result

The Finnish group considers that the assessment should be made based upon the features of the design, and accordingly, if all the essential features of the appearance of the product in question were solely dictated by its technical function, the design should be deemed unprotectable. As regards the assessment of the features, the relevant factor is to determine the availability of alternative appearances for the feature that can obtain the same functional result. For further motivations, please see our response to question 18.

d) the need to achieve the product's technical function was the only relevant factor when the design in question was selected

e) other, namely ...

17) Should design protection be denied to any portions (e.g. a "feature", "element") of the overall design that are deemed functional?

yes

Please explain:

18) If yes, what should the relevant factors be to determine whether a portion of a design is functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

b) the availability of alternative appearances for the portion to obtain the same functional result

As noted above, the Finnish Group suggest that EU law is used as a model for the harmonization. However, (i) since the concept of "functionality" has not been defined in the EU legislation, (ii) since no preliminary rulings by the European Court of Justice on the interpretation of this question yet exist and (iii) since the decisions of the EUIPO's Board of Appeal and Invalidity Division have not been consistent and several different criteria have been introduced, the Finnish AIPPI Group would propose that similar criteria as the one outlined in the preparatory works for the Finnish Registered Designs Act implementing EU Design Directive in Finland (Government Bill HE 6/2002) be used as the basis for harmonization. The criteria set forth in the said preparatory works is the availability of alternative appearances for the portion to obtain the same functional results. Legal literature suggests that this

kind of criteria has also found support in courts in several EU member states, in early OHIM invalidity decision and in Advocate General's Opinion in Philips/Remington case (C-299-99) (see Stone, D (2012): European Union Design Law, A Practitioner's Guide, p. 65-68).

c) the need to achieve the product's technical function was the only relevant factor when the portion in question was selected

d) other, namely ...

19) What should the effect be on the scope of protection of a design with one or more functional portions? Please tick any relevant boxes and explain as applicable:

a) any portions deemed functional will not be taken into account when assessing infringement

Selected

b) any portions deemed functional will not be taken into account when assessing validity

Selected

c) any portions deemed functional will not be taken into account separately when assessing infringement, but can play a role in the overall comparison

d) any portions deemed functional will not be taken into account separately when assessing validity, but may play a role in the overall comparison

e) no effect (e.g. so long as the overall appearance is not dictated solely by its technical function, all portions of the design are included in the scope of protection, irrespective as to whether any portions may be functional)

f) the Group's current law is unsettled

g) other, namely ...

20) If your answer to question 11) is no, is it your Group's view that a (registered or patented) intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture should not be available at all?

21) If yes, why?

From a business point of view, a uniformly interpreted, globally harmonized protection for designs (in relation to, inter alia, the definition, requirements for protection of designs or the role of functionality) is desirable to facilitate global business operations. Today, the various registration practices outside the EU and the resulting uncertainty and additional costs causes practical problems for the industry.

Further, a ruling from the European Court of Justice on the issues covered by this study question would



be welcome, as such ruling most likely would clarify both EU law and national law.

22) If your answer to question 11) is no in relation to some but not all of the three areas set out in question 9) above, please state why your Group does not consider that harmonisation in that area(s) is desirable.

N/A

23) Please comment on any additional issues concerning any aspect of the definition and requirements for protection of designs, or the role of functionality, you consider relevant to this Study Question.

N/A

Please indicate which industry sector views are included in part “**III. Proposals for harmonization**” of this form:

#### Summary

In Finland, both the Finnish Registered Designs Act as well as the Community Design Regulation provide for an intellectual property right that protects the outward appearance or ornamentation of an object or article of manufacture. Designs may thus be protected either as a national "design right" or as a "Community design". The Finnish Registered Designs Act is to a large extent harmonized with EU design law.

Both Section 4b(1) of the Finnish Registered Designs Act and Article 8(1) of the Community Design Regulation stipulates that design rights shall not subsist in features of appearance of a product which are solely dictated by its technical function. There are no national precedents on the interpretation of this provision. Within the EU, the interpretations adopted in the decisions of various bodies are not consistent, and neither the Court of First Instance nor the European Court of Justice have yet given rulings on the interpretation of this article. The inconsistent interpretations naturally causes practical problems, uncertainty and additional costs for applicants and competitors. Therefore, the Finnish Group suggest that the meaning of "solely dictated by technical function" should be clearly defined in the legislation. In addition, the Finnish Group suggest that the meaning of "informed user" be defined in the legislation to clarify the requirements for protection of a design.

In relation to international harmonization, the Finnish Group considers harmonization desirable and suggests that an intellectual property right called "Registered Design" should be adopted globally. EU legislation should be used as the model for the harmonization of such a right.