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2016 – Study Question (Designs)

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Requirements for protection of designs

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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:

Austrian IP-Law provides for registered design.

- 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.

Its name is "Muster" ("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

Novelty is not absolute but restricted to what can be known to the experts within the EU.

b) non-obviousness

c) inventive step

d) individual character

Individual character is present if the overall appearance of the design sufficiently differs from the overall appearance of any single other known design.

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:

Art. 2b para 1 of the Austrian design law stipulates that a design-right does not subsist in features of appearance of a product which are solely dictated by their technical function (see Art 7 para 1 EU Design Directive).

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

When remaining non-functional elements of the design itself cannot form a valid design (e.g. because they are common for such designs) the whole design is still unprotectable.

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 ...

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:

Purely functional elements in a design are not considered to be part of the protection (are excluded).

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 ...

A portion or element of the overall appearance of a design is functional if it is solely dictated by technical necessity.

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

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

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"

Since the definition of design is quasi open-ended (it only speaks of the appearance of a product and the enumeration of specific possibilities is only given as example) we cannot see how this can be improved.

b) the requirements for protection of a design

However, regarding the requirements for protection there are two political questions to be answered: First, should novelty not be somehow extended or in other words should designs having already been available in other parts of the world outside the EU be still protectable within the EU? Second, should practically every appearance be protectable or should the very low level of individual character be raised? Connected to these questions is that what is the basis of judging novelty and individual character – comparison with only one piece of prior art or can also an obvious combination of elements out of different similar pieces of prior art lead to a lack of novelty or individual character?

The Austrian Group considers with regard to these questions:

- that we understand that the extension to true worldwide novelty would lead to difficult questions of proof wherefore we do not advocate such a large change. However, we do advocate an enlargement of the definition of novelty by cancelling the geographical borders "within the EU" i.e. also the knowledge of relevant experts of other (non-EU) countries should count.

- that the reasons in No. 13 of the Harmonization Directive state that the comparison for individual character is to be made against the existing design-corpus which would include also the obvious combination of features of different similar prior designs while Art. 5 para 1 of the Directive defining the law only speaks of a comparison with any prior design which is interpreted as a separate one-b-one comparison; we advocate the change of the wording to "the whole existing design-corpus" so as to come also to a comparison with a combination of features of closely related prior designs.

- we think that in the same line the scope of protection has to be enlarged thus raising the importance and value of design registration.

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

The treatment of functionality would have the right balance if the determination of functionality would be made in the following way:

- neither the availability of alternatives nor the subjective intentions of the designer should count;

- features clearly solely dictated by their technical function should be discounted.

- features having also a technical function besides other (aesthetical etc.) functions are to be given less weight than purely arbitrary features when judging the overall appearance.

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:

Since this study is limited (e.g. excluding all questions of exclusion from design protection) we have no further proposals within the scope of this study.

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

Please explain:

According to the above we consider harmonisation regarding the requirements for protection as especially desirable. The definition of design should be broad and centered only on outer appearance, while especially functionality should be excluded and judged according to the principles explained above in 9) c).

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:

In all countries an IPR specifically protecting the outer appearance of a product should be available for everybody

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

It should 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

Novelty defined as not being known to the relevant design experts anywhere.

b) non-obviousness

c) inventive step

d) individual character

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:

Design protection should be denied when the appearance of a design is dictated solely by its function.

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

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 ...

This exclusion should be present when the whole design is technically functional and when all portions of its appearance are dictated solely by their technical function. The availability of alternatives should not play a role in this assessment. Likewise not the intentions of the designer.

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:

Any portion solely functional in an overall design should be denied protection.

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
- 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 for the denial of protection for functional elements should only be that their appearance is only technically functional without considering alternatives.

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

- 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.

Harmonisation as the definition of “design”, the requirements for protection and the exclusion of solely technical functionality for the whole design or its elements is desirable.

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.

There are no additional issues which we consider relevant beside those already mentioned above.

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

Summary

Austria has a design-system following closely the EU-Directive 98/71/EC on the legal protection of designs. The requirements for protection are novelty and individual character. A design right does not subsist in features which are solely dictated by their technical function. The Austrian Group advocates a certain enlargement of the notion of novelty by cancelling geographical borders: The knowledge of experts in the field should count and e.g. not only those within the EU. For judging individual character also an obvious combination of features of different similar prior designs should count. For raising the importance of designs their scope of protection should be enlarged on the above mentioned basis. For determining functionality neither the availability of technical alternatives nor the intentions of the designer should count. Features of a design having also a technical functions besides others (arbitrary, aesthetical etc.) are to be given less weight than those without a technical function.