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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:

The Danish Designs Act provides protection of the outward appearance of a product. The object that is protected is set out in The Danish Designs Act, section 1 according to which the creator of a design (the designer), or his successor in title, may in accordance with the act by registration obtain an exclusive right to the design (design right). According to section 2 (i) "design" means, the appearance of a product or part of a product resulting from the features of the product itself or its ornamentation, in particular with respect to lines, contours, colors, shape, texture or materials.

The Danish Designs Act implements Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs. The directive harmonizes among other the rules about the definition of a design and also the requirements for obtaining a design right. The member states are obliged to interpret the rules in accordance with EU-case law. Therefore EU-case law impacts the application of these rules.

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.

The right is called 'Registered 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

According to section 3 (2) a design shall be considered to be new if no identical design has been made available to the public before the date of filing of the application or, if priority is claimed, the date of priority, cf. section 16. Designs shall be deemed to be identical if their features differ only in immaterial details.

The elements that are subject to this evaluation, are first whether there has been identical design and second whether this has been available to the public before the day of filing or the priority date.

The evaluation of identity is objective and is focused solely on the appearance of the product. The evaluation of whether a product is identical comprises an evaluation of whether there are objective differences between the design in question and the older design. Differences in immaterial details will not influence the evaluation of whether the design is new according to section 3 (2).

The evaluation of whether the design has been publicly available is made according to section 5 (1) of The Danish Designs Act, according to which a design shall be deemed to have been made available to the public if it has been published following registration or otherwise, or if it has been exhibited, used in trade or otherwise disclosed.

In section 5 (2) it is set out, when a design has not become publicly available. According to this section the design shall be deemed not to have been made available to the public, if (i) the events referred to in subsection 1 could not reasonably have become known in the normal course of business to the circles specialized within the sector concerned, operating within the European Union, before the date of filing of the application or, if priority is claimed, the date of priority, cf. section 16, or (ii) the design has been disclosed to a third party under explicit or implicit conditions of confidentiality.

Novelty will be evaluated based on the circumstances on the day when the application is filed with the PTO or the day of priority. In case, that several designers file identical or similar designs on the same date, both of the designers are entitled to the right of the design.

b) non-obviousness

c) inventive step

d) individual character

According to section 3 (3) a design shall be considered to have individual character if the overall impression the design produces on the informed user differs from the overall impression produced on such a user by any design which has been available to the public before the date of the application or, if priority is claimed, the date of priority, cf. section 16. In assessing the individual character of a design the degree of freedom of the designer in developing the design shall be taken into consideration.

The requirement of individual character implies that the design shall distance itself from what is already public available. Because the evaluation of individual character is made on the basis of the whole impression, small details shall not be taken into account. Furthermore the evaluation shall be made based upon the view of the 'informed user'. According to EU-case law this term shall not be understood as a user that is average observant, but a user that can be categorized as particularly observant in the light of personal experiences or comprehensive knowledge of the sector in question.

Whether or not the designer's freedom has been reduced when making the design, shall be taken into consideration when evaluating individual character of the design. The designer's freedom is for example reduced when the design is partly decided by functional or technical requirements. This criterium extends the possibility of design protection.

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:

According to section 8 (1)(ii) a design right may not be obtained with respect to the features of the appearance of a product which are solely dictated by the technical function of the product.

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

The very fact that the overall appearance/design is functional, i.e. designed with a due consideration to its functionality, does not in itself make the design unprotectable. However, if the design is solely dictated by its technical function, design protection is not possible.

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

Each portion/aspect of the overall design, which is solely dictated by its technical function, will be deemed unprotectable.

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

If a designer was forced to choose the given appearance(s) in order to achieve the desired technical function of the design, i.e. there were no other available options or alternatives, this appearance/portion of the design is unprotectable.

Although it is not completely established in Danish law, it is generally held that if alternative appearances that can obtain the same functional result are available, the overall design can be protected.

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:

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

If the portion's appearance is solely determined by its technical function, design protection is generally not possible.

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

It is generally held that the availability of alternative appearances for the portion to obtain the same functional result may make the portion of the design protectable.

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

Regardless of what the underlying need behind designing the portion in question was, if there are alternative appearances for the portion, protection may be possible.

d) other, namely ...

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

The exact scope of the Danish provision (Section 8 of the Danish Design Law) is unclear. There are two possible interpretations.

According to the *narrow* interpretation, the provision will only apply to cases where the feature is dictated solely by its technical function (and because there are no alternative appearances available to obtain the same functional result). This interpretation leaves room for the possibility of protecting designs where alternative appearances for the design are available to obtain the same desired functional result (this is sometimes called 'the multiplicity-of-forms theory'). The literature seems to suggest that this narrow interpretation is more appropriate, partly due to the wording of the provision 'solely dictated'. There is no Danish case law on the provision, but the Swedish decision T-3469-09, published in *NIR 2013/31-33*, indicates that the corresponding provision in the Swedish law should be given the narrow interpretation.

According to the *broad* interpretation, the very fact that a feature is dictated by its technical function will lead to the design being unprotectable. The availability of alternative appearances to obtain the same functional result will not in itself make the design protectable.

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"

In the Group's view the present definition of a "design" in section 2(i) of the Danish Designs Act is appropriate.

b) the requirements for protection of a design

In the Group's view the requirements for protection of a design as stipulated in section 3(1)-(3) of the Danish Designs Act (novelty and individual character) are appropriate.

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

This limitation with respect to possible design rights is in the Group's view well-chosen and

appropriate.

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:

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:

1. *the definition or meaning of a "design"*

The Group considers that a harmonization of the definition of the meaning of a "design" is desirable.

1. *the requirements for protection of a design*

The Group considers that a harmonization of the requirements for protection of a design is desirable.

1. *the treatment of functionality in the sense described in paragraph 14) of the Study Guidelines or aspects of such functionality*

The Group considers that a harmonization and specification of the treatment of functionality in relation to design right are very desirable. It would eliminate the discussions about how the rules about this shall be interpreted.

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:

The Group considers that it would be desirable.

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

(Registered) Design right.

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 evaluation of novelty shall be an objective evaluation. The evaluation of novelty shall be an evaluation of the identity between disclosed designs. Differences in small details shall not be taken into account. We think that it is desirable that novelty is evaluated based on what is disclosed to the public on the day of registration or the day priority, so that non-disclosed designs not shall be taken into consideration when evaluating novelty.

b) non-obviousness

c) inventive step

d) individual character

We think that the evaluation of individual character shall be an evaluation of whether the design distance itself enough from what is already known. We think that individual character should be an evaluation based on the whole impression. We also think that it is desirable that this is evaluated seen from the view of a user that has a certain knowledge about the sector.

Furthermore we think that it is desirable that the freedom of the designer is taken into account when evaluating 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:

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

This Group favours the "narrow" interpretation explained in the answer to question 8, however, the Group does emphasize that in infringement matters the fact that a design contains portions that are dictated solely by their technical functions should influence the court's assessment of infringement, *i.e.* narrow the scope of protection - regardless of whether or not alternative appearances are possible.

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

This Group favours the "narrow" interpretation explained in the answer to question 8, however, the Group does emphasize that in infringement matters the fact that a design contains portions that are dictated solely by their technical functions should influence the court's assessment of infringement, *i.e.* narrow the scope of protection - regardless of whether or not alternative appearances are possible.

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

This Group favours the "narrow" interpretation explained in the answer to question 8, however, the Group does emphasize that in infringement matters the fact that a design contains portions that are dictated solely by their technical functions should influence the court's assessment of infringement, *i.e.* narrow the scope of protection - regardless of whether or not alternative appearances are possible.

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

Please see the answer to question 16.

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

Please see the answer to question 16.

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

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

Please see the answer to question 16.

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

Please see the answer to question 16.

- 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?

no

- 21) If yes, why?

x (our answer was no - but I cannot remove the 'no' indication in Q 20

- 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.

Our answer was 'yes'

- 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.

We have no further comments to any aspect of the definition and the requirements for protection of designs, or the role of functionality as comprised of this Study Question.

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

none

Summary

Denmark as part of the European Union offers a protection system for designs named 'Registered Design' and based upon the EU harmonizing directive. The system is a deposit system. According to Danish law designs are registrable to the extent the design is novel and has individual character, i.e. the appearance differs from prior publically available designs. The freedom of the designer is also relevant when evaluating the individual character of the design.

Designs that are dictated solely by the technical function of the design are not protectable, and it is unsettled, how to treat functional elements of registered designs when considering the scope of protection of the registered design.

The Group finds that harmonization is desirable and recommend to harmonize the name for design protection to 'Registered Design' and to harmonize the requirements for protection to the rules implemented by the European Union including the rules relevant for functional elements.