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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:

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.

Industrial 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

• if no identical or confusingly similar industrial design is disclosed prior to filing or priority date (worldwide)

b) non-obviousness

c) inventive step

d) individual character

- if the overall impression produced to a persons skilled in the art differs from the overall impression produced on such persons by the filing or priority date of the applied industrial design.

e) originality

f) aesthetic

g) ornamental

h) other, namely ...

- may be used for manufacturing industrial or handicraft products.

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:

unless the industrial design allows specific assembly or connection of products within a modular system or parts of products.

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 issue is not regulated by the national law, while the case law should establish the criteria. No local case law yet (i.e. the decisions and positions of CJEU should be followed).

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?

no

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

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 ...

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"

b) the requirements for protection of a design

•

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

•

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

yes

Please explain:

Setting the rules how the functionality should be evaluated.

## 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:

The harmonisation would be welcome by exploring the requirements for protection of a design and/or through the treatment of functionality in the separate provision(s). Some guidance may provide EUIPO's BoA decisions in Cases R 690/2007-3 „Chaff cutters“, para. 35 *et seq.*; R 211/2008-3 „Fluid distribution equipment“, para. 36; R 998/2013-3 „Insulation blocks“, para. 44 *et seq.*)

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:

Such harmonisation would be welcome, especially in sense that such right would be understood similarly in different jurisdictions.

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

Industrial 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

•

b) non-obviousness

c) inventive step

d) individual character

•

e) originality

f) aesthetic

g) ornamental

h) other, namely ...

• it may be considered adding the technical functionality exclusion.

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

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 ...

- if all the essential features of the overall appearance are solely dictated by its technical function, which must be assessed objectively, and not in perception of the informed user who may have limited knowledge of technical matters (e.g. EUIPO BoA decision in Case R 998/2013-3 „Insulation blocks“, para. 44 *et seq.*).

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

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 same factors as assessing the overall appearance, while applying these factors specifically in respect of this portion.

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.

We do not envisage that the definition or meaning of a „design“ should be improved in context of functionality, while this issue may be solved through widening the scope of requirements for protection of a design (Q. 9)b) above) and/or inserting provisions for the treatment of functionality (Q. 9)c) above).

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.

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

#### Summary

The Estonian Industrial Design Protection Act („Design Act“), effective since January 11, 1998, has remained unchanged as far as the definition of and the requirements for the protection of designs are concerned. Specifically, no changes have been passed regarding the functionality of designs. Our local legislation recognizes the design rights under the term „industrial designs“, while the legal protection is granted to such designs, which are new, possess an individual character and which may be used for manufacturing industrial or handicraft products. Technical functionality of a product is regulated under the terms precluding the legal protection to a design. The designs are registered in Estonia by formal registration system, i.e. the Estonian Patent Office examines only the compliance of formal requirements, while does not examine a design as to its novelty, individual character, industrial or handicraft applicability, also does not examine the technical functionality according to the local law.

Therefore, such disputes are solved only by the civil court, if any interested party brings a challenge against a design right based on any of these criteria. Moreover, the assessment of technical functionality is under the discretion of a civil court, while no relevant local court decisions have been passed yet to provide some guidance in this issue.

As a design terminology and the requirements for the protection of designs vary in different jurisdiction, also the precise parameters of functionality of designs are not precisely clear, the harmonisation in this field may be supported and might be welcome.