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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	France
Contributors name(s)	Muriel ANTOINE-LALANCE, Géraldine ARBANT, Sylvie BENOLIEL-CLAUX, Noémie CARRON, Gabrielle DE SARS, Julie GEMPTTEL, Frédéric GLAIZE, Anne-Emmanuelle KAHN, Hubert KIEHL, Anne LAURENT, Pierre MASSOT, Marie-Christine PIATTI and Olivier PRATS
e-Mail contact	glaize@plass.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:

French law, resulting from the transposition of Directive EC No 98/71 of 13 October 1998, provides, under Article L. 511-1 of the Intellectual Property Code (Code de la propriété intellectuelle – 'CPI'), that protection may be granted for the appearance of a product or a portion of a product that is characterised in particular by the lines, contours, colours, shape, texture or materials thereof.

The features in question may relate to the product itself or its ornamentation.

Anything produced industrially or artisanally may be considered a product.

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.

In France, this right is called a *dessin et modèle enregistré* – registered design. The French terms *dessins et modèles* and *dessins ou modèles* are used indiscriminately (the choice of conjunction ‘and’ or ‘or’ varies). Most of the time, the reference to registration is implicit. This reference to registration stands mainly in contrast to the unregistered Community design system introduced by Regulation 6/2002; when it is a case of the latter, the term ‘unregistered’ is always used.

- 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 covered by Article 4 of the **Directive 98/71 of 13 October 1998 on the legal protection of designs**:

‘A design shall be considered new if no identical design has been made available to the public before the date of filing of the application for registration 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

Individual character is defined by Article 5 of the Directive:

‘1. 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 before the date of filing of the application for registration or, if priority is claimed, the date of priority.

2. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.’

For the assessment of individual character, the European Union General Court takes a sequential approach, with a ‘four-step test’ (see in particular: GC 18 March 2010, Case T-9/07, paragraphs 54 to 84; GC 28 January 2015, Case T-41/14, paragraph 36 *et seq.*; GC 15 October 2015, Case T-251/14, paragraph 40):

This analysis consists in determining:

- Step 1: the **sector** of the products in which the design is to be incorporated or to which it is to be applied
- Step 2: the **informed user** of said products according to their purpose and, with reference to this informed user, the degree of knowledge of the prior art and the level of attention in the comparison, direct if possible, of designs
- Step 3: the **degree of freedom of the designer** in developing the design
- Step 4: the result of the **comparison** of the designs in question, taking into account the sector concerned, the degree of freedom of the designer and the overall impressions produced on the

informed user by the contested design and by any earlier design made available to the public

The transposition of the Directive into **French law** lays down the same requirements for protection, with the exception of two differences in terminology:

- the term '*individual character*' used in the Directive is referred to as '*inherent character*' in French law;
- the reference person is '*the informed user*' in the Directive but '*the informed observer*' in French law.

In practice, these two differences between the Community text and the transposed text appear to be merely stylistic.

e) originality

f) aesthetic

g) ornamental

h) other, namely ...

For component parts of complex products, there is the additional explicit requirement of *visibility* (Article 3.3 of the Directive). For the design of this part to be eligible for protection, the component part, once it has been incorporated into the complex product, must remain visible '*during normal use of the latter*' (this use excluding maintenance, servicing or repair work).

Although not explicitly stated for products that are not component parts of complex products, this requirement of visibility nonetheless applies in essence: the protection of registered designs protects the *appearance* of a product or a portion of a product (a requirement clearly referred to in General Court decision GC, 9 September 2014, Case T-494/12, paragraph 20).

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:

1. Article L.511-8 1° CPI (based on the Harmonisation Directive 98/71/CE of 13 October 1998) states that:

'The following shall not be protected:

1° Features of appearance which are solely dictated by the technical function of the product.

2° features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either product may perform its function.'

The exclusion at 2° does not apply to designs serving the purpose of '*allowing multiple assembly or connection of mutually interchangeable products within a modular system*'.

Article L.511-8 as currently drafted applies to designs filed after 25 July 2001, the effective date on which the transposition order came into force.

2. The former Article L.511-3 CPI is still applicable to designs filed before 25 July 2001. It granted protection to 'any new design, any new plastic form, any industrial object which differs from similar objects, either by virtue of a different, recognisable configuration which renders it **novel**, or by virtue of one or more external effects giving it an **inherent novel physiognomy**'.

However, it was added that 'if one and the same object can be considered to be both a new design and a patentable invention and if the elements constituting the novelty of the design are inseparable from those of the invention, said object may only be protected [by a patent]'.

These provisions, although they have been repealed, are still applicable when assessing the validity of designs registered under the old law, the most recent of which will expire in 2026.

- 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

No.

French case law seems to favour an approach distinguishing the 'relevant features/portions of the design' to determine whether or not each one is a technical feature.

Some poorly reasoned decisions have denied protection to a design on the ground of its technical nature, merely stating the general features/portions of the design without performing a thorough analysis feature by feature (for example, *Paris Court of Appeal, 4 April 2007, RG No 05/24044, Douai Court of Appeal, 28 May 2014, RG No 13/01383*). However, the fact that said features were stated, however briefly, seems to confirm that the French courts ultimately do not base the decision on the sole criterion of overall appearance.

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

Yes.

1. During the reform, the Community legislator clarified that the assessment of the functionality of a design must be performed according to the features of the product:

'[...] features of a design which are excluded from protection for these reasons should not be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection' (Recital 14 of Directive of 13 October 1998).

2. The French courts tend, in the vast majority, to first identify the various features of the design for which a declaration of invalidity is sought and then decide whether each of these features is or is not solely dictated by their technical function.

2.1. Thus, if each of the features of the overall appearance of the design is solely dictated by its technical function, the design will not be eligible for protection.

For example, it was found that a golf club head design was not eligible for protection because each of its features, the plastic head, the toe and the sole, fulfilled only technical functions of a golf club (*Paris Court of Appeal, 29 May 2015, RG No 14/04295*, concerning a Community design).

2.2. On the other hand, if some features are not only or solely dictated by technical function, a design may be found to be eligible for protection (about a cup design, *Paris District Court, 22 May 2015, RG*

No 12/06475).

A recent decision even held that the same feature is eligible for protection when it has both a technical function and an aesthetic vocation (*Paris District Court, 17 December 2015, No 14/12789*, handed down in a case concerning a Community design).

In conclusion, eligibility for protection is assessed in relation to the various portions of the design. The inclusion of features which are not purely functional can avoid exclusion.

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

Sometimes.

This factor is known in French doctrine as the '*multiplicity of forms criterion*'.

Said criterion holds that if the technical result can be achieved by means of a form/appearance different from that which has been used, it is because the chosen appearance can be separated from the technical effect and the design application should therefore be accepted.

The application of the rule of Article L. 511-8 CPI thus depends on an objective fact; to validate a design, it is sufficient to note that there is a plurality of possible appearances for achieving the technical aim sought. If by changing the appearance the technical effect is not modified, it means that this form can be separated from the functional result.

1. Under the old law, this criterion was considered irrelevant by the doctrine and the case law had almost abandoned it with the exception of some isolated decisions of the lower courts (*Paris District Court, 27 September 2003, RG No 11/16656*; and also in this regard: *Paris Court of Appeal, 4 March 2005, RG No 03/03989*).

2. Since the transposition of the Directive of 13 October 1998, both doctrine and case law are divided as to the applicability of this criterion.

2.1. For the most part, the doctrine considers it necessary to apply the criterion of multiplicity of forms.

However, some authors still contest the application of this theory on the basis, in particular, of the case law of the EUIPO's Third Board of Appeal which exclude the application of this theory.

For example, the Third Board of Appeal of OHIM recently invalidated a design of an extendable hose covered with wood even though it had been shown that materials other than wood produced the same technical result (*OHIM, Board of Appeal, 27 January 2016, R1517/2014-3*).

2.2. French case law too is divided on the applicability of the multiplicity of forms criterion.

In some decisions, the judge has asked if other forms are likely to achieve the same function (*Paris District Court, 27 March 2015 RG No 13/12096*; see also *Paris District Court, 27 March 2015, No 12/03021*).

The availability of alternative appearances that allow to obtain the same technical result in general forms part of the set of indications that characterise eligibility for protection.

Thus, decisions that are based on the multiplicity of forms criterion also rely on other grounds, such as the choice in the arrangement of different elements, or the presence of ornamental elements.

However, the criterion of the multiplicity of forms that may fulfil the same function **has not been**

systematically applied and has even sometimes been rejected (*Paris Court of Appeal, 29 May 2015, No 14/04295*, concerning a Community design).

In conclusion, French case law appears to be divided as to the applicability of the multiplicity of forms criterion. Moreover, when applied, it is usually not the only criterion considered and is one indication among others of the lack of functionality of the contested design.

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 ...

(i) The absence of an aesthetic nature or the lack of ornamental character of the design

Sometimes.

Some decisions applying the former Article L.511-3 CPI and the new Article L.511-8 take into account the aesthetic or ornamental appearance of the design to determine whether the exclusion should be applied (under the old law, *Paris District Court, 26 October 2007, No 05/06576*; under the new law: *Paris Court of Appeal, 4 April 2007, RG No 05/24044*).

The Court of Cassation nevertheless decided that 'a form which is inseparable from the function, **be it aesthetic**, it produces during its implementation, does not come under the protection of Book V of the Intellectual Property Code' meaning by this that the aesthetic quality or otherwise of the design should be irrelevant (Cass. Com., 29 June 2010, No 09-15737; in the same vein: *Paris Court of Appeal, 20 May 2009, No 08/01048*).

This consideration of the aesthetic quality of the form of the design by the lower courts also seems to go against the intention of the Community legislature, which stated in Recital 14 of the Directive of 13 October 1998: 'Whereas technological innovation should not be hampered by granting design protection to features dictated solely by a technical function; **whereas it is understood that this does not entail that a design must have an aesthetic quality** [...]'.
does not entail that a design must have an aesthetic quality [...].

(ii) The reference to the originality criterion of copyright law

Sometimes.

Some decisions at times refer to the criterion of originality as applied in copyright law. For example, in the case of a spray holster design and a belt design: *Paris Court of Appeal, 28 November 2012, No 11/09734*, or a lunchbox design: 'It follows that the features described by the applicant give the box a balanced form, a well-rounded, non-aggressive line that reflect the **genuine creative effort of its designer**' (*Paris District Court, 17 December 2015, No 14/05439*).

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:

Yes, if the appearance of the portion of the design is solely functional.

Under French law, protection as a design covers both 'the appearance of a product' and 'the appearance of **a portion** of a product' (Article L. 511-1 CPI, taken from Article 1(a) of Directive 98/71/EC of 13 October 1998).

Accordingly, only the appearance of a **portion** of a product that is **solely** dictated by its technical function is excluded from protection as a design (Article L. 511-8 CPI, taken from Article 7(1) and Recital 14 of the Directive).

Thus, it was held, in relation to a French design of an '*Electronic mirror incorporating an Eye-T camera*', i.e. a terminal for opticians, that the portions deemed to be functional (the column, the stand, the screen, the two-way mirror, the metal material, the white colour) were to be excluded from protection (*Paris District Court, 16 April 2015, AcepFrance*, see Question 8).

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 ...

There is no criterion other than those mentioned above, but rather differences in terms of the wording used by the courts (e.g. '*solely functional features, form inseparable from the technical result or dictated by technical requirements*').

The French Courts use the same method to assess the functionality:

- of a design as a whole,
- of a portion or feature of a design.

Two mutually exclusive criteria are proposed by the doctrine:

- the 'multiplicity of forms' criterion
- the 'contours' criterion

Their implementation by the courts is much less clear-cut, meaning that they are often mixed up.

1. The 'multiplicity of forms' criterion (see Question 5 c) has been applied to portions or features of designs

a) by the French courts, for a long time now (Paris Court of Appeal, 4th chamber B, 7 April 2006, *Fleury Michon v Herta*, RG No 04/18301; concerning French designs for packaging for ham, shown below; Paris Court of Appeal, 11 January 2013, *Normandie Structure Sàrl v Catherine Dalo and Dalo Frères Sas*, RG No 2012/01304: concerning Community designs relating to playground canopies).

b) recently, by Community bodies (3rd Board of Appeal, EUIPO, 8 December 2015, *VelekeySzerelvénygyártókft. v Rotovillkft*, R 2162/2014-3 concerning a valve design; - 3rd Board of Appeal, EUIPO, 12 February 2015, *Austrotherm GmbH v Termo Organika Sp. Z.o.o.*, R998/2013-3 : using the concept of '**alternative forms**').

2. The 'contours' criterion whereby the mere participation of elements of form in any functional effect leads to refusal of protection as a design.

This criterion was applied to portions or features of designs in the following cases:

- a. by the Community bodies which, until very recently, strongly rejected the criterion of multiplicity of forms (3rd Board of Appeal, EUIPO, Cases Nintendo v Compatinet, 14 April 2014, R 1770/2012-3, R 1771/2012-3, R 1772/2012-3, concerning electronic cartridges for video games consoles: *'the mere existence of alternative forms does not mean that the appearance of the product was dictated by anything other than technical considerations'* ; 3rd Board of Appeal, EUIPO, 22 October 2009, Case R-690/2007-3, Lindner Recyclintech GmbH v Franssons Verkstäder AB).
- b. by some French courts, focusing on characterising the technical function itself, rather than seeking the existence of alternative forms for the same technical function (Cass. Com, 9 June 2009, Sté Flashmer v Sté Quadri and Sté Kersaudy & Le Meur, Appeal No 08-13.727: fishing jig designs refused protection simply because they have a functional purpose.

The case law has applied these various criteria inconsistently, which does not make it possible to identify a clear trend in favour of one or the other.

It is thus very difficult to clearly pinpoint the position of the French and Community courts in relation to the criteria of functionality.

- 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

NB: We interpret this whole question as referring to the scope of protection of a design having one or more portion(s) whose appearance is solely dictated by their function.

Example from the case law:

- Ruling on a design of a terminal for opticians, a recent decision of Paris District Court excluded from the assessment of the overall impression the features deemed to be *'solely technical'*: the column, the stand, the screen, the two-way mirror, the metal material, the white colour (Paris District Court, 16 April 2015, No 13/00845).

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

When the various features of the design are not all technical, the design, as a whole, can access protection under design law.

There follow some examples taken from French and Community case law.

1. On the French side:

- in finding in favour of the validity of a design of a container with a transparent double wall resembling a cup, Paris Court of Appeal held that said designs **'also offer features (...)** *resulting from the choice of forms and proportions made by their designer in an arrangement that was not dictated either by the material or the function, but was deliberately sought for aesthetic purposes'*. The Court thus concluded that the form of the design invoked was *'not solely imposed by the technical function'* (Paris Court of Appeal, 10 October 2012, Mr Romain Gauthrot v Sté Nespresso).
- in finding in favour of the validity of a shower head design, the Court held that the functional

elements, in this case spikes designed to prevent a build-up of limescale, should not be 'taken into account in the description of the appearance of the product within the meaning of Article L. 511-1 CPI' in so far as they were not eligible for protection (Paris Court of Appeal, 1st chamber, 9 September 2009, Hansgrohe AG v DGK Productions Europe, RG 07/21674).

2. Community case law provides additional clarification on how to approach these functional elements when assessing the validity of the design as a whole. It states that the design will be valid despite containing functional elements, **if such elements are not 'essential'**

- see, in this regard, the abovementioned Lindner case relating to a chaff cutter design: the design as a whole will be invalid **only if the essential features of the appearance of the product in question are solely dictated by their technical function** (3rd Board of Appeal, EUIPO, 22 October 2009, Case R-690/2007-3, Lindner Recyclintech GmbH v Franssons Verkstäder AB)

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

Yes, but the importance of this role will depend on whether the functional element is a main or secondary element, or sometimes on the proportions thereof in relation to the whole.

1. Examples from French case law:

- Regarding designs of playground canopies, the Court of Cassation confirmed that secondary or functional elements should be disregarded so as to focus on the upper part of the canopies likely to have individual character:

'the informed user will dwell only very secondarily on the differences concerning the base of the opposing design, and will instead take greater account of the overall appearance of the roofs of the designs and consider that they give an overall visual impression that is identical, the judgment finds that the upper part of the shelters from the companies Tenso Forma and laso is perfectly detachable in its basic structure, shaped like a Chinese hat with a finishing dome, and that the informed user will focus on the essential parts consisting of the shape of the roof, ignoring the secondary or functional elements, such as the bases or the particular appearance of the finishing dome, and therefore he will get the same overall visual impression when he considers the earlier structures and the three Community designs filed; it further finds that the arrangements of the upper part of the canopy as a flat cover or curved finishing dome will not hold the attention of the informed user since they have a functional purpose of protection against rain and, to perform this function, must not be flat' (C. Cass, 21 October 2014, No A 13-11, Catherine DALO & Dalo Frères v Normandie Structures)

- Regarding the abovementioned optician terminal design, the same reasoning based on the features protected (Paris District Court, 16 April 2015, 13/00845, cited above).

2. The Community bodies have also found:

- concerning a design for harvesting carrots, for coupling to a tractor, the Board of Appeal concluded that *'although the presence of certain elements is necessitated by their technical function, which certainly limits the degree of freedom of the designer, they nonetheless contain differences that cannot escape the notice of the informed user'* (EUIPO, 3rd Board of Appeal, 20 December 2012, Case R-971/2011-3, Marzena Karczmarek, Agrotop Karczmarek v Weremczuk FMR sp. Z.o.o).

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

As seen above (in particular the answer to Question 6), it all depends on whether or not the element is

solely functional.

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"

No particular comment.

b) the requirements for protection of a design

We believe it is necessary to clarify the French approach to aesthetic quality.

Recital 14 of the Directive provides that '*technological innovation should not be hampered by granting design protection to features dictated solely by a technical function; **whereas it is understood that this does not entail that a design must have an aesthetic quality***'.

According to Recital 14, the national court should therefore not require that the contested form be the result of an aesthetic goal, independent of its participation in the technical result.

When transposing the Directive, however, the French legislature did not consider it appropriate to formally rule out the consideration of the aesthetic criterion during the assessment of whether not the appearance is eligible for protection, and French case law remains inconsistent on the subject (see the answer to Question 5 e) (i)).

While some judgments appear to have adopted the exclusion approach (the Court of Cassation has clearly held that "*a form which is inseparable from the function, be it aesthetic, it produces during its implementation, does not come under the protection of Book V of the Intellectual Property Code*" (Cass. Com., 29 June 2010, No 09-15737, although handed down when the previous text was in force); see also the judgment of Paris District Court of 27 March 2015, RG No 12/03021), others still consider the aesthetic quality of the design to be a valid assessment criterion.

In a judgment dated 4 April 2007, Paris Court of Appeal held as follows: '*it is clear that an ornamental and aesthetic goal cannot be inferred from such features, which are solely functional, and therefore this design cannot be eligible for any form of protection under Book V of the Intellectual Property Code*' (RG No 05/24044).

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

This criterion of functionality must be considered to be one of several indications, not a criterion

sufficient in itself for assessing the validity of a design taking into account all factors relevant to the case.

Functionality should not be assessed from the viewpoint of the *'informed user'* (or *'informed observer'*), who only serves as the reference in the assessment of inherent character. Indeed, to consider the *'informed user'* (or *'informed observer'*) to be the judge of whether or not a design, or a feature of a design, is functional would introduce too much subjectivity in the approach and thus legal uncertainty.

To avoid the lack of clarity evident in some decisions in the case law regarding how the concept of *'functionality'* is treated, one suggestion could be to make clear in the applicable law that *'the informed observer / informed user must not serve as the reference when dealing with the concept of functionality of a registered design'*.

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:

Yes, regarding the means for 'identifying' portions of designs.

The EUIPO allows an applicant to highlight certain portions of the design, either to show that protection is only claimed for a specific portion, or to indicate specifically that protection is not claimed for a particular portion of the design. For this purpose, one of the following indicators may be used:

- **dotted line** to indicate the elements for which protection is not sought;
- **circling or boundaries** to highlight the features of the design for which protection is sought;
- **shades of colour and blurring** to exclude certain features from the protection sought;
- **separations** to indicate that the exact length of the design is not claimed.

According to the information we have been able to obtain to date, the French industrial property office now accepts the use, in the views of the design, of symbols or graphics such as those mentioned above, to exclude protection of certain elements, features or portions of the design, provided that the meaning of such symbols or graphics is specified in the description of the design.

We believe harmonisation in this sense is highly desirable for the exclusion from protection of certain elements, features or portions of the design (especially those which the applicant considers functional and thereby wishes to exclude from protection).

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:

a) the definition or meaning of a "design"

The definition itself of the term ‘design’ does not appear to be necessary.

However, harmonisation seems possible on the following aspects as well as on the term ‘design’ (see answer to Question 13)

b) the requirements for protection of a design

In France and in Europe, there is already complete harmonisation in terms of requirements for protection (novelty, individual character and visibility - see answer to Question 3.h).

Harmonisation on a larger scale, beyond the European Union, seems desirable.

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

Harmonisation would be welcome. The French and European case law are inconsistent on the concept of functionality and in particular on the application of the criterion of multiplicity of forms.

Within the Group, there are various points of view on this matter: for some, the multiplicity of forms should be sufficient to rule out the solely functional character of the design; for others, the fact that the form may vary is irrelevant in the assessment of functionality.

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:

We believe harmonisation would be desirable.

This definition should stick to what can be protected, without any reference, in this definition, to the requirements for protection (some countries, like Brazil, appear to define the right with the incorporation of the concepts of novelty and originality).

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

The term ‘*dessin ou modèle*’ (or ‘*dessins et modèles*’, see the answer to Question 2) used in French could be replaced by ‘*modèle*’.

The latter term seems to be sufficiently understood in practice to also include two-dimensional designs. In addition, a shortened French term would be closer to the term used in English, at least in Europe, which is ‘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

Criterion f) (aesthetic) is open to debate.

The clarification in Recital 14 of Directive No 98/71 that '[the exclusion of functional forms] does not entail that a design must have an aesthetic quality' may in fact be interpreted as an indication that this is not the only feature that a design can or must fulfil and not as an exclusion of the aesthetic/ornamental character of the design.

On this point we agree with the position taken by the Third Board of the EUIPO in the above-cited decision on the design of a cutter integrated in a shredder (EUIPO, 3rd Board of Appeal, 22 October 2009, Case R690/2007-3, Lindner Recyclingtech GmbH, paragraph 34, cited in response to Question 7, point 2, d, a).

As indicated in the answer to Question 6, the design right was created for industrial design (aesthetic), namely 'the quest for harmony between the form and function of objects.'

Recital 7 of Regulation No 6/2002 moreover refers to 'enhanced protection for industrial design (...)'. This concept is thus inherent in the design right, although, as it is not a 'criterion' in the strict sense, it cannot be considered as important as novelty and individual character. However, rather than deleting any reference to the notion of aesthetic, we feel that it must be repositioned, its importance must be more specifically determined within the assessment of the eligibility for protection of a design (see the answer to Question 16.c).

g) ornamental

h) other, namely ...

Visibility (see the answer given to Question 3) f)).

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

NB: In all cases, we interpret the question as referring to the relevant factors for determining whether or not the appearance of a design is solely dictated by the function of the product.

Although from a reading of French and Community legislation there is no reason to exclude said criterion outright, it appears, however, that in practice the first instinct is to assess the appearance of a design by examining each of its various features.

This criterion could be applicable to those few designs that do not comprise a plurality of features/portions or to only those portions/features of an overall appearance.

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

In the case of an appearance composed of several portions/features, it is preferable to assess functionality portion by portion so as to be satisfied that the overall appearance of the design is not solely functional.

An overall assessment would undoubtedly be likely to result in some designs being excluded from protection too quickly.

It is worth noting here the tendency of the French courts to identify and assess the various portions/features of the overall appearance of the design for which a declaration of invalidity is sought (see the answer to question 4, point b, 2).

We therefore believe it is desirable to facilitate said assessment on the basis of objective elements provided by the applicant itself.

The examination of the various portions/features making up the appearance and the assessment of whether or not they are solely functional by the judge could indeed be simplified by better defining the boundaries of the protection sought at the time of filing.

This could in particular take the form of a generalised description of the design by the applicant, although this would not be mandatory, in which the applicant would identify the various features of its design (on this point see the proposal set forth in relation to question 10.2.).

Such identification could also be simplified by the use of 'indicators' at the time of filing.

The changes announced by the INPI, which echo on this point the EUIPO's Convergence Programme 'CP6', would therefore appear to be a good thing (see the proposal set forth in relation to Question 10.3).

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

The multiplicity of forms criterion is attractive because it is **simple** to implement and **objective**. To validate a design, it is sufficient to note that there is a plurality of possible forms for implementing the invention or achieving the technical result, that there are one or more alternative form(s). If by changing the form the technical effect is not modified, it means that this form can be separated from the industrial result. In strictly logical terms, the criterion is appealing.

However, this binary logic disregards the criticism, which is not entirely unfounded, levelled at the multiplicity of forms criterion; Community bodies have already held that '*functionality is not the only relevant factor for a design to be eligible for protection*'.

While the '*multiplicity of forms*' criterion is not perfect, it is still of interest.

How, then, can it be put to good use without abandoning it completely?

The multiplicity of forms criterion should be considered as one indicator among several and not as a self-sufficient criterion.

To adapt a Community phrase, the validity of a design should be appreciated globally, taking into account all relevant factors of each case. The existence of alternative forms that perform the same function could have a place, **alongside other factors**.

The multiplicity of forms criterion (possibly redefined) would have a place if there were other indicators

pointing to the non-solely functional character of the design, or the features thereof, including:

- lack of solely functional character of all the various portions/features making up the overall appearance;
- an effort to arrange these functional forms in relation to one another (novel combination of known forms);
- aesthetic or ornamental character of the overall appearance or of a portion of the appearance;
- the fact that the need to achieve the product's technical function was the only relevant factor when the design was selected.

The importance of the multiplicity of forms criterion would therefore be mitigated by its being just one indication among several.

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

Yes, as mentioned in the previous point. This criterion is not currently taken into account in the French case law, but we believe it is relevant to consider it as one indication among several.

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:

Yes, but only on condition that the appearance of said portion is solely functional.

In this case, the relevant factors should be those used for assessing the functionality of all of the portions/features of the design (answer to question 18), namely:

- the overall appearance is dictated solely by its technical function,
- the availability of alternative appearances that can achieve the same functional result,
- the possible aesthetic quality of the appearance of this portion/feature.

However, if the portion of the design is functional but not solely functional, protection as a design right must be granted since, in addition to its functionality, it may also have a special appearance.

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

NB: we interpret the whole question as referring to the relevant factors for determining whether or not the appearance of a portion of a design is solely dictated by its 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 ...

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

NB: we interpret the question as referring to the effect of one or more portion(s) of a design that are solely dictated by their function.

Functional elements should not in principle be taken into account when assessing whether or not there is infringement of the design.

Indeed, we believe it is necessary to avoid the situation whereby a design can be invoked to incriminate the functional elements which, in principle, can only be protected by patent law, under certain conditions.

Community law (Article 7(1) of Directive 98/71 and Article 8(1) of Regulation 6/2002), and consequently French law, have adopted this solution.

For example, Paris Court of Appeal held, in a judgment of 27 January 2015 regarding the assessment of infringement of garden furniture designs:

'Noting that the informed user is especially observant and has some knowledge of the wealth of designs relating to the product in question;

*Considering further that if infringement is assessed on the basis of the similarities and not the differences, **similarities can be explained by common links to the public domain, by the functionality of some of the elements, by the rules of the art or by the genre; it is therefore appropriate to identify the elements characterising the individuality of the designs claimed without taking into account the elements that by their nature fall into the public domain, their functionality or the reproduction of a genre'** (Paris Court of Appeal, Division 5, Chamber 1, 27 January 2015, RG No 13/15460).*

We believe this solution should be approved to avoid the reservation of forms dictated by technical requirements.

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

Solely functional elements should not be taken into consideration when assessing whether or not a design is eligible for protection.

Indeed, the inclusion of functional elements in the assessment of whether or not a design is eligible for protection could lead to protection being granted for elements that by nature come under patent law.

Therefore, in order to assess the validity of a design, the functional elements for assessing novelty and individual character should be removed from the other elements of the design.

This is currently the solution used in Community law and in France, and it appears to be satisfactory.

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

This does not appear to be a desirable solution.

It would in fact lead to protection being granted indirectly for solely functional elements which do not, in principle, come within the scope of protection of designs.

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

This does not appear to be a desirable solution as it would lead to protection being granted indirectly for solely functional elements which do not, in principle, come within the scope of protection of designs.

In this respect, while it may seem useful to indirectly take into account functional elements at the infringement stage, once the validity of the monopoly right has been established, it seems more questionable for this to occur at the stage of assessing the validity of the design.

Indeed, the design right is intended to protect the visual effect of a product and the taking into account of functional elements when assessing the novelty or individual character of this effect would inevitably create monopolies on the basis of elements that fall under another protection regime.

- 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)

We find this to be the least desirable solution of all.

It would probably make functional elements eligible for protection by way of a design, thus undermining the requirements for protection under patent law.

In our view, it is therefore necessary to take into account the functional elements of designs, whether at the stage of assessing validity or at the stage of assessing infringement.

- f) the Group's current law is unsettled

Under French law, solely functional elements should not in principle be taken into account at the stage of assessing the validity of the design.

These elements are therefore in principle excluded from the assessment of novelty and individual character.

Regarding the assessment of infringement, the functional elements of a design should in principle also be excluded from the overall impression produced by the designs in question.

Harmonisation and clarification of the applicable rules on the latter point could nevertheless be desirable.

- 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?

It is essential to protect the visual appearance of products, since said appearance is an essential way for companies to stand out from the competition.

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.

Not applicable.

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.

Although paragraph 13 of the Study Guidelines states that the protection of 'partial designs' is outside of the scope of this study, our Working Group would like to see harmonisation of protection of 'portions' of products for which protection is sought by the filing of a design. Specifically, protection relating to a portion of a product is not available in all countries (protection of a portion of a product by a design is excluded in China, for example).

Harmonisation is also desirable so that it is not necessary to provide a description at the time of filing. Such a requirement is considered too restrictive, unpredictable and costly for the applicant.

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

Summary

En France les conditions de validité des dessins & modèles sont issues de la Directive CE 98/71 du 13 octobre 1998. Pour les modèles déposés avant sa transposition, leur validité reste régie par la loi antérieure.

La jurisprudence apparait hésitante sur la place à donner à l'existence de formes alternatives :

- En France : depuis la transposition de la Directive, la jurisprudence française semble partagée sur le critère de multiplicité des formes.
- Au niveau communautaire : si la 3^{ème} chambre de recours de l'EUIPO a clairement rejeté ce critère, cette même chambre en a ultérieurement mis en œuvre le principe, en faisant référence à la notion de formes alternatives.

La jurisprudence française semble également partagée sur le caractère esthétique d'un modèle, parfois érigé en critère d'appréciation de sa validité.

Propositions d'amélioration de la législation française actuelle:

Il apparaît nécessaire de :

- clarifier l'approche française sur le fait que la recherche d'un caractère esthétique ne constitue pas une exigence spécifique pour la validité d'un modèle, ce qu'exprime le Considérant 14 de la Directive 98/71.
- favoriser une approche objective du caractère exclusivement fonctionnel (sans référence à la perception d'un utilisateur/observateur averti).
- encourager l'utilisation par le déposant d'une description (qui doit rester facultative) et d'identifiants délimitant les parties pour lesquelles une protection est revendiquée.

Propositions d'harmonisation :

L'expression "dessins et modèles" ou "dessins ou modèles" pourrait être remplacée par le seul terme « modèles ».

Il est proposé de faire du critère de multiplicité des formes un indice parmi d'autres au sein d'un faisceau, au même rang que

- l'absence de caractère exclusivement fonctionnel de l'ensemble des différentes parties/caractéristiques composant l'apparence globale ;
- la présence d'un effort dans l'agencement de ces formes fonctionnelles entre elles ;
- le caractère esthétique ou ornemental de l'apparence globale ou de l'une des parties de l'apparence ;
- le fait que le besoin d'obtenir la fonction technique du produit était le seul facteur pertinent quand le dessin ou modèle a été sélectionné.