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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.

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

Israeli law requires a registered design to be new or original and not previously published.

Novelty is found by comparing prior art to the application through "the eye of the consumer" to

determine if the consumer may be confused between them.

b) non-obviousness

c) inventive step

d) individual character

e) originality

"Originality" means that the design was made by the original creator or lawfully obtained by the applicant from the original creator. The requirement for "originality" also means that very basic designs inherently devoid of any creativity, such as a line or a circle, may not be registered. The Patent Office further includes under originality situations where a known design is applied to a new object.

f) aesthetic

Protection is granted for shapes that appeal to the eye of the consumer.

g) ornamental

Article 1 of the design Act defines the subject matter of protection as "features of shape, configuration, pattern or **ornament** (...)"

h) other, namely ...

Object - Any industrial product and any substance, artificial or natural, or partly artificial and partly natural.

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:

A design which is solely dictated by its function will not be eligible for registration. The test to determine if the design is dictated solely by functional considerations is whether there are other shapes that may achieve the same functional objective. The design of an object that is solely dictated by the need to integrate it into other objects, such as spare parts, is considered solely dictated by its function and thus not eligible for registration.

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

Yes.

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

Yes.

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

The test to determine if the design is dictated solely by functional considerations is whether other shapes may achieve the same functional objective.

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?

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"

**Note:** On July 13, 2015, a new Designs Bill passed its first reading in the *Knesset* (Israel's legislature). The new Designs Law, when finally enacted, will replace the old Patent and Design Ordinance (from 1924) that has been the legal basis for design registration and protection in Israel to date and will modernize the designs regime in Israel. The improvements suggested in this section are basically similar to the improvements as manifested in the Designs Bill.

The definition of "design", as suggested in the Designs Bill<sup>[1]</sup> is:

**"the appearance of the whole or a part of a product resulting from one or more features of the product or part thereof, as the case may be, in particular, the contours, color, shape, ornamentation, texture or the materials of which they are made".**

The suggested definition resembles (with some modifications) the EU definition<sup>[2]</sup>.

According to the bill 's explanatory notes, it does not broaden or narrow the definition of "design" of the current act, but reflects the technological developments since the act came to force (for example – replacing the term "*article*" with "*product*").

The authors' position is that the definition in the Designs Bill is an improvement in comparison to the current definition.

### Footnotes

1. [^ Article 2](#)
2. [^ Council Regulation \(EC\) No 6/2002, Art. 3.](#)

- b) the requirements for protection of a design

The current act<sup>[1]</sup> provides that a design shall be protected by a registered design to the extent that it is "**new or original**" (alternative requirements). These requirements are replaced in the Designs Bill<sup>[2]</sup> with "**new and has individual character**" (accumulative requirements).

The accumulation of the requirements and the individual character test should pose a significantly higher threshold than the current requirements. While according to current requirements, a design may be eligible for registration if it was known and familiar, but was implemented on an article in a different field, according to the suggested bill, such design will not be eligible for registration.

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, of any class, which has been made available to the public before the determining date<sup>[3]</sup>.

Since this study does not concern the requirements for **novelty**, it is not discussed in our response.

The authors' position is that the requirements, as set forth in the Designs Bill, are an improvement to the current requirements.

#### Footnotes

1. [^ Art. 30\(1\)](#)
2. [^ Article 3](#)
3. [^ Art. 7](#)

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

The current act provides that "design"<sup>[1]</sup> **"does not include (...any mode or principle of construction) or anything which is in substance a mere mechanical device"**. Meaning, mechanical devices whose form is dictated entirely by their technological function are not considered "design" for the purpose of the act. An auxiliary test for determining whether a form is dictated entirely by its technological function is whether other shapes can achieve the same purpose.

The use of the phrase **in substance** may result in the exclusion of designs in fields in which the designer's freedom is limited, although, according to practice, in these cases the designed features should get greater attention when assessing the design.

The Designs Bill provides that "design" is: **"The appearance of the whole or a part of a product (...)"<sup>[2]</sup>**; however **"the appearance of a product or part thereof which is solely dictated by its technical function will not be eligible for protection as Registered or Unregistered Design"<sup>[3]</sup>**.

The authors' position is that the current provision is a useful clarification to the current Act.

#### Footnotes

1. [^ Art. 2 of the Patents and Designs Ordinance](#)
2. [^ This part of the definition is similar to the definition in Council Regulation \(EC\) No 6/2002, Art 3\(a\)](#)
3. [^ Art 10\(01\)](#)

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:

It is not clear whether, when assessing the scope of protection of a design, the functional features of the design should be considered as an integral part of the design, be disregarded, or have a reduced role in the overall design.

### 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:

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

yes

Please explain:

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

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

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 for registration of the design for which protection is claimed, or, if priority is claimed, the date of priority<sup>1</sup>.

#### Footnotes

1. <sup>1</sup> [^](#) Since this study does not concern the issue of grace period, it is not discussed in our response.

b) non-obviousness

c) inventive step

d) individual character

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 determining date.

e) originality

f) aesthetic

g) ornamental

h) other, namely ...

Appearance – A design should refer to the features of an object that appeal to the eye.

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

Yes.

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

Yes. The implementation of several functional features together, should not be considered as "design".

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

Yes.

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

No. The process of creation is irrelevant. As long as the product is not dictated solely by its technical function, and there are other shapes that can achieve the same function, it should be eligible for design protection.

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?

no

Please explain:

Design protection should provide protection to the overall impression of the object, perceived by the eye.

- 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 ...

- 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

Yes.

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.

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

Yes.

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.

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

Israeli law is on a brink of a revolution in regard to the protection of designs. After almost a century, the old patents and designs Ordinance is to be replaced by a new Act, which passed its first reading a few months ago in the Knesset (the Israeli Parliament).

The new Act's explanatory notes present 3 objectives to the reform: The public interest to encourage small businesses; The importance of legal certainty; Updating the legal regime to recent developments in the field of designs.

As discussed in the questioner, the new Act clarifies the definition of the subject matter of design and the requirements for obtaining legal protection. Thus, clarifying the rule of functionality in the fields of prosecution and infringement.