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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:

We have two registered rights available:

1. UK registered design; and
2. Community registered design.

Since 2001 UK registered design has been harmonised at EU level, UK law having been amended to implement the EU Designs Directive 98/71/ EC (the "Directive").

Community registered design is governed by the EU Designs Regulation 6/2002/EC (the "Regulation").

For the purposes of both UK registered design and Community registered design:

- "design" means *"the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation"* (note, this list of features of the product is non-exhaustive); and

- "product" means *"any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but*

excluding computer programs”.

While the focus on appearance directs attention to the look of products, there is no requirement that a design be attractive or pleasing to the eye, and a design does not have to have ‘aesthetic quality’ to be protected.

The representation of the design in a registration must consist of a graphic or photographic reproduction of the design, in black and white or in colour.

At the time of filing the application, the applicant must give an indication of the product(s) to which the design is intended to be applied, by reference to a Eurolocarno classification(s). That product indication (and Eurolocarno classification) does not limit the scope of protection of the design.

In the case of Community registered designs no explanatory text, wording or symbols other than the indication “top” can be displayed. An application can contain a 200 word description to assist the EUIPO in checking formalities of registrability, but that description is not reproduced on the registered design certificate, is not ‘searchable’ on the EUIPO database, and does not limit the scope of protection of the registered design.

In contrast, in the case of a UK registered design, a description and/or a disclaimer or limitation can be included which can be used to indicate what features are (or are not) claimed as comprising the design.

2) If yes, what is this right called? (e.g. registered design, design patent, industrial design, industrial design patent)

References to design below are to be read as references to this right, irrespective of what it is called in your jurisdiction.

‘registered design’

(Specifically, (1) ‘UK registered design’ and (2) ‘Community 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

A design will be considered ‘new’ if no identical design, and no design whose features differ only in immaterial details, has been made available to the public before the filing date for the application for registration or, if priority is claimed, the date of priority.

Therefore to be ‘new’ a design need only differ from any other design in some material respect, and it may be ‘new’ even though some or all of its component design features taken individually would not be.

UK tribunals have interpreted immaterial as “*only minor and trivial in nature, not affecting overall appearance*” and “*not substantial*”.

Novelty is an objective test.

For the purposes of assessing novelty the Directive and the Regulation both state that a design is deemed to have been “*made available to the public*” (and so, ‘not new’) “*if it has been published (whether following registration or otherwise) exhibited, used in trade or otherwise disclosed before that*

[relevant (filing or priority)] date”.

Certain prior disclosures are excepted from this, namely:

1. an ‘obscure’ disclosure – one that *“could not reasonably have become known before the relevant date in the normal course of business to persons carrying on business in the European Economic Area and specialising in the sector concerned”*. It is clear from case law that a disclosure needs to be very obscure indeed before this exception will apply.
2. a ‘confidential’ disclosure – one that has been disclosed to a third person under explicit or implicit conditions of confidentiality.
3. a ‘grace period’ disclosure – one made by the designer, his successor in title, or a third person as a result of information provided or action taken by the designer or his successor in title, in the 12 months before the relevant (filing or priority) date
4. an ‘abusive’ disclosure – one whereby the design has been made available to the public as a consequence of an abuse in relation to the designer or his successor in title.

b) non-obviousness

c) inventive step

d) individual character

To be protected the design must also have ‘individual character’.

A design has ‘individual character’ if the overall impression produced by the design on the informed user differs from the overall impression produced on such a user by any prior disclosure (taken individually, not by combining features drawn from a number of earlier designs), having regard to the degree of freedom of the designer.

This evaluation is through the eyes of an ‘informed user’. The informed user is a fictitious legal character who is deemed to be:

- a knowledgeable user of the design product;
- who is aware of the existing design corpus;
- is reasonably discriminatory;
- alert to design issues;
- has more extensive knowledge and is more discriminating than the ‘average consumer’ used as a test person in trade mark cases;
- someone who occupies an ‘intermediate’ position between trade mark’s average consumer (who will not see subtle differences) and the patent skilled person (who arguably will)

As with ‘novelty’, for the purposes of assessing individual character the Directive and the Regulation both state that a design is deemed to have been *“made available to the public” “if it has been published (whether following registration or otherwise) exhibited, used in trade or otherwise disclosed before that [relevant (filing or priority)] date”*.

As with ‘novelty’, certain prior disclosures are excepted from this, namely:

- an ‘obscure’ disclosure – one that *“could not reasonably have become known before the relevant date in the normal course of business to persons carrying on business in the European Economic Area and specialising in the sector concerned”*. It is clear from case law that a disclosure needs to be very obscure indeed before this exception will apply.
- a ‘confidential’ disclosure – one that has been disclosed to a third person under explicit or implicit conditions of confidentiality.

- a 'grace period' disclosure – one made by the designer, his successor in title, or a third person as a result of information provided or action taken by the designer or his successor in title, in the 12 months before the relevant (filing or priority) date
- an 'abusive' disclosure – one whereby the design has been made available to the public as a consequence of an abuse in relation to the designer or his successor in title.

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:

A right in a UK registered design or Community registered design shall not subsist in features of appearance of a product which are solely dictated by its technical function.

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

If an entire design (as depicted in the images relied on) is dictated solely by its technical function it is not registrable. If it has been registered, the registration will be invalid.

In an early case (*Landor & Hawa v Azure Designs*, [2006] EWCA Civ 1285), the Court of Appeal of England & Wales held that the exclusion from protection for designs dictated by technical function would not apply if there existed alternative appearances that produced the same result, in other words, if the same technical function could be achieved by another design. This approach is often called the 'multiplicity of forms' approach. Note, in *Landor & Hawa* the point was *obiter*.

However, in subsequent cases, several English judges have suggested that the 'multiplicity of forms' approach might not be dispositive and the approach of the Board of Appeal of the EUIPO in *Lindner Recyclingtech GmbH v. Franssons Verkstäder AB* [2010] ECDR 1 (R 690/2007-3) (see (d) below) is to be preferred. These observations were also *obiter*.

The correct approach therefore remains unclear.

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

question was selected

This approach – which can conveniently be referred to as the ‘non-technical function’ (aesthetic considerations) approach – was adopted by the Board of Appeal of the EUIPO in *Lindner Recyclingtech GmbH v. Franssons Verkstäder AB* [2010] ECDR 1 (R 690/2007-3) (the “Lindner” case).

The EUIPO Board of Appeal acknowledged that good design involves two fundamental elements. The product must perform its function and it should be pleasant to look at. And for most products a designer is concerned with both functional and aesthetic elements, but so long as functionality is not the only factor, a design is eligible for protection. It is only when aesthetics are totally irrelevant in the sense that no one cares what the product looks like and all that matters is that it functions well, that there is no protection under designs law.

The Board of Appeal explained [at 36]:

“It follows that [the technical function exclusion] ... denies protection to those features of a product's appearance that were chosen exclusively for the purpose of designing a product that performs its function, as opposed to features that were chosen, at least to some degree, for the purpose of enhancing the product's visual appearance. It goes without saying that these matters must be assessed objectively: it is not necessary to determine what actually went on in the designer's mind when the design was being developed. The matter must be assessed from the standpoint of a reasonable observer who looks at the design and asks himself whether anything other than purely functional considerations could have been relevant when a specific feature was chosen.”

In the Lindner case the entire design was invalidated because no aspect of it was determined by non-technical function (aesthetic considerations) at all.

Whilst several English judges have suggested that this non-technical function (aesthetic considerations) approach is to be preferred over the ‘multiplicity of forms’ approach, those judicial comments have been *obiter*.

The correct approach therefore remains unclear.

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:

‘Yes’ on the wording of the legislative provision, but apparently ‘No’ in practice in the case of *registered* designs.

Whilst the legislation states that a right in a UK registered design or Community registered design “shall not subsist in *features* of appearance of a product which are solely dictated by its technical function” (emphasis added), a registration will be validly registered unless *all* of its features are solely dictated by technical function. See our answers to Questions 4 and 5 above on the application of that exclusion.

As soon as the registration includes features which are not solely dictated by technical function, then the registration is valid.

See our answer to Question 8 below regarding the scope of protection of a registration of a design which includes a feature (or features) solely dictated by technical function.

‘Yes’ on the wording of the legislative provision, but apparently ‘No’ in practice in the case of *registered* designs.

Whilst the legislation states that a right in a UK registered design or Community registered design “shall not subsist in *features* of appearance of a product which are solely dictated by its technical function” (emphasis added), a registration will be validly registered unless *all* of its features are solely dictated by technical function. See our answers to Questions 4 and 5 above on the application of that exclusion.

As soon as the registration includes features which are not solely dictated by technical function, then the registration is valid.

See our answer to Question 8 below regarding the scope of protection of a registration of a design which includes a feature (or features) solely dictated by technical function.

- 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 ...

The answer to question 6 is ‘yes’ on the wording of the legislative provision, but ‘No’ in practice in the case of registered designs. In the circumstances, the answer to this question is really ‘not applicable in practice’.

The relevant factors for determining whether or not a feature of a design is deemed to be solely dictated by its technical function are set out in our answers to Questions 4 and 5 above. A registration will be validly registered unless *all* of its features are solely dictated by technical function. As soon as the registration includes feature(s) which are not solely dictated by technical function, then the registration is valid. See our answer to Question 8 below regarding the scope of protection of a registration of a design which includes a feature solely dictated by technical function.

- 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 *Lindner* case was an example of an entire design being invalidated because no aspect of it was determined by any non-technical function (aesthetic considerations) at all.

None of the infringement cases there have so far been in the England & Wales courts have had to consider what is the effect on the scope of protection of a registered design which includes a feature (or portion) which is solely dictated by technical function.

Recital 14 to the Directive states:

“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; whereas, likewise, the interoperability of products of different makes should not be hindered by extending protection to the design of mechanical fittings; whereas 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;” (emphasis supplied).

Recital 10 to the Regulation makes an almost identical statement in relation to Community designs.

The recitals therefore suggest that any features, or portions, of a design which are solely dictated by technical function should not be taken into account at all when assessing validity (i.e. answer (b)).

The English courts have suggested that features, or portions, of a design dictated solely by technical function *“are not to be taken into account at all”* (*The Procter & Gamble Company v Reckitt Benckiser (UK) Limited* [2006] EWHC 3154 (Ch) at para 41), and should be *“disregarded”* (*Samsung Electronics (UK) Limited v Apple Inc.* [2012] EWHC 1882 (Pat)). However, both of these statements amount to little more than a restatement of the legislative provisions; no explanation was provided as to how such an approach is to be applied in practice, for example how the process of ‘disregarding’ is intended to be applied or to what extent features should be ‘disregarded’. In any event, in both of these cases the relevant portions of the design were deemed not to have been dictated solely by technical function, and so these comments were merely *obiter*.

The England & Wales case which has come closest to considering how to deal with features, or portions, of a design dictated solely by technical function is *Sealed Air Limited v Sharp Interpack Limited, Sharpak Aylesham Limited* [2013] EWPC 23. In that case in the course of determining the scope of protection of the design, the court considered the question of the weight to be given to features which were heavily functional and therefore barely valid, and gave them very little weight. Note, the court did not have to consider the potentially continuing relevance (or otherwise) to the scope of protection of the design of features that were *invalid*.

Nevertheless, in light of comments made in the *Sealed Air* decision, it seems likely that a feature dictated solely by technical function will not be disregarded entirely. Rather, the key issue is likely to be how much weight to give to that particular feature. In our view, the selection of any particular feature solely dictated by technical function, or the way in which that feature is incorporated into a design (i.e. its positioning or configuration), could have a significant impact on the overall impression created by the design, and could arguably be taken into account as part of the overall comparison.

However, unless and until the courts have to address the point, the position is unclear.

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"

The definition of "design" is acceptable subject to addressing the following:

(1) clarifying whether it is possible to protect a positive absence of surface decoration – in other words, to claim an 'unadorned' design – and, if so, in the case of Community registered designs how this is to be depicted in the registration images, or otherwise claimed.

(2) in the case of Community registered designs, implementing some means of enabling the proprietor if he so wishes to describe the design claimed (e.g.: whether the design claimed is for 'shape only', or 'shape plus surface decoration', and so on) and include any disclaimer or limitation (e.g.: 'no protection is claimed for the feature shown in dashed lines') and thereby limit its scope of protection.

At the time of the 'Green Paper on the Legal Protection of Industrial Design' (June 1991), it was acknowledged that *"sometimes there might be a need to explain the features which constitute the design and which might not easily be perceived simply by looking at the reproduction. This should be made possible by joining a description to the application"*.

Such a description (and a disclaimer or limitation) is possible for UK registered designs. In the case of Community registered designs difficulties or ambiguities in how to interpret the design could be resolved or avoided if a description (and any disclaimer or limitation) which formed part of the registration was permitted (as was originally acknowledged might be necessary in some cases).

(3) In the case of both UK registered designs and Community registered designs, permitting the applicant to opt to limit the scope of protection of his design to the product indication included in the application. Exercising this option would have implications for the 'novelty' and 'individual character' requirements for protection of the design in question.

b) the requirements for protection of a design

UK registered design applications and Community registered design applications are not examined by the UK Design Registry or EUIPO (as the case may be) for anything other than checking administrative formalities have been complied with.

In the absence of any description (either, in the case of the UK registered design, because the applicant chose not to include a description (or any disclaimer or limitation) in his application or, in the case of Community registered design, because none is permitted for the purposes of identifying or limiting the scope of protection of the design claimed), the scope of protection at the point of registration may be unclear.

An examined application system would obviously assist in interpreting the design and understanding its scope as there would be the opportunity to submit comments or arguments to the relevant registry prior to registration. However, we do not advocate adopting a full substantive examination system; we consider the speed and low cost of an unexamined streamlined application system is preferable.

However:

(1) we do consider that the applicant for a Community registered design should have the option of including a description which forms part of the registered design (as originally envisaged in the Green Paper), in the same way as a description (and any disclaimer or limitation) can be included in a UK registered design. So far as the requirements for protection of the design are concerned, this would assist in the interpretation of the images in the registered design, and clarify the comparison that needs to be made, for the purposes of assessing ‘novelty’ and ‘individual character’, between any prior designs and the images in the registration.

(2) we also consider that the applicant could be given the option (potentially by way of a simple ‘check box’ on the application form) to limit the scope of protection of his design to the product indication included in the application (see point (c) below). If this approach were adopted, it is envisaged that the ‘novelty’ and ‘individual character’ requirements for registration would be adjusted to reflect the relevant product limitation claimed.

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

The treatment of functionality in the sense described in paragraph 14) of the Study Guidelines or the aspects of such functionality is currently unclear.

The benefits of resolving this uncertainty, at least on an EU harmonised basis, are clear.

However, a UK registered design or a Community registered design protects the design *per se*, and is not limited to the product to which it is applied or intended to be applied. Whilst a product indication or Eurolocarno classification is given at the time of application and included on the registration details, the Directive and Regulation make clear that that product indication and Eurolocarno classification do not limit the scope of protection of the registered design. This is a potential impediment to achieving clarity, because if the protected design is independent of product type, it is impossible to conclude definitively that any particular *feature* is dictated solely by technical function, because determining a ‘function’ requires a designation of product type from which to extrapolate the function in question.

For example, if one produces a picture frame to be hung on a wall to the design of a tablet computer, the functional requirements of the picture frame will be different from the functional requirements of a tablet computer, but their appearance might be very much the same and the same registered design should protect both product types. Likewise, a functional limitation of a car may not be equally relevant to the function of a toy car, yet a single registered design in the EU would arguably cover the design of both types of car. If a protected design is to be ‘independent’ from the product type to which it has been or is intended to be applied, then the question of whether any features are dictated solely by technical function cannot be resolved.

It is suggested that there are a number of options for bringing greater certainty to the treatment of registered designs, or features of registered designs, which are arguably solely dictated by technical function:

1. rely on judicial decisions to clarify how such features are to be assessed;
2. *allow* the applicant to opt to limit the scope of protection to the product indication given on the application (see answer to 9(a) above at (3) and answer to 9(b) above at (2)) – this could be achieved by including a simple ‘check box’ on the application form;
3. *require* the applicant to limit the scope of protection to the product indication given on the application (this is a mandatory version of 2 immediately above);
4. in the case of Community registered designs (as is already the case for UK registered designs) *allow* the applicant to include a description which forms part of the registered design identifying the

- design claimed and including any disclaimers or limitations, for example, in relation to functional features not claimed (see answer to 9(a) above at (2) and answer to 9(b) above at (1));
5. *require* the applicant to include a description which shall form part of the registered design identifying the design claimed and including any disclaimers, for example, in relation to functional features not claimed (this is a mandatory version of 4 immediately above).

We favour options 2 and 4 from this list.

Limitation to product indication

In the case of suggested reform 2 (or 3), we did consider whether the limitation should be by reference to the Eurolocarno class to which the product indication belongs. After all, limitations to goods or services within Nice classes are required in trade mark applications and they do have an affect on the scope of protection. However, the risk of introducing an '*IP Translator*'-type problem to design law should be avoided; instead, at the time of application the applicant already considers carefully what product indication to include in his application and, in our view, that is the better limitation, if there is to be one. Our view is that this limitation to product indication should be optional (i.e.: number 2 in the list above) but, where exercised, would assist in the identification of any feature solely dictated by technical function, because the function of the product would be known.

To implement such a proposal administratively, the application form could include a simple check box that the applicant could use to indicate that the scope of protection is to be defined by the design representations alone or to indicate that the design be interpreted by reference to a combination of the design representations and the product indication.

Including a description (and any disclaimer or limitation)

In our view implementing reform 4 (or 5) could be in addition to reform allowing or requiring any indication of product (as per reform 2 (or 3) above). The description (and any disclaimer or limitation) might assist in identifying the scope of the design claimed and that would assist in the identification of any feature solely dictated by technical function, because the description would explain what is shown in the images, even if the design was not limited to any particular product indication.

In particular, whilst there is considerable uncertainty concerning the correct interpretation of dashed lines (see answers to question 10 below) it is possible that dashed lines could be used in a manner that is parallel to features dictated solely by their function. That is to say, if a feature is found to be dictated solely by its function, a court could elect to regard that feature as if it were shown in dashed lines, in order to replace the current uncertainty over how to interpret such features. The current Community registered design system could be improved if the application included a description and disclaimer or limitation, addressing the meaning of any dashed lines in the case of the registered design in issue, which would allow an applicant to pro-actively disclaim aspects of the design that are dictated solely by their technical function. The inability of the applicant for a Community registered design to use words to disclaim such features at present means that any uncertainty over functional features is not normally addressed until a conflict has already arisen.

Examples of clarifying description/disclaimers:

- "the chain line markings indicate a reflective surface"
- "the dashed lines represent the silhouette of features behind the transparent material"
- "the chain line markings indicate features dictated solely by their function for which protection is disclaimed"
- "the broken line indicates features of an associated structure usually connected to the design in use and do not represent part of the design itself"

A standardised format for disclaimers or explanations submitted by the applicant could be generated. Defining a list of predetermined expressions from which the applicant can select would be in line with current EUIPO practices and might help reduce uncertainty over interpretation.

On 15 April 2016, The IP Offices of the European Trade Mark and Design Network issued a Common Communication on the Convergence on Graphic Representations of Designs. This seeks to create greater certainty as regards drawing conventions (including disclaimed elements) but unfortunately it did not address how to take account of functional elements in making comparisons.

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:

As mentioned at Answer 9, there is considerable uncertainty concerning the correct interpretation of dashed lines. Whilst the EUIPO guidance suggests that dashed lines can be used to disclaim certain features, in UK case law, in different contexts dashed lines can appear to have different meanings. This was commented on particularly in *Samsung Electronics (UK) Limited v Apple Inc.* [2012] EWHC 1882 (Pat). Various practices concerning use of dashed lines are arising in other countries. There does not appear to be a common, harmonised approach.

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?

'registered design'

14) What should the requirements for such right be? Please tick any relevant boxes and explain the basis and application of these requirements:

a) novelty

The 'novelty' and 'individual character' requirements are already harmonised at EU level.

In the case of ‘novelty’, our understanding is that this is the usual requirement for countries that grant monopoly rights on registration.

The ‘novelty’ requirement appears to conform with the requirements of Article 25 of the Agreement on Trade Related Aspects of Intellectual Property Rights 1994 (‘TRIPS’).

Some commentators have queried the feasibility or even legitimacy of having ‘novelty’ and ‘individual character’ as *cumulative* criteria for design protection, as this may appear to clash with the wording of Article 25 of TRIPS (“new or original”). Whilst it might be possible to adopt a single threshold of ‘individual character’ that complies with Article 25 of TRIPS, the cumulative criteria have worked effectively in practice: *“the assessment usually proceeds in two logical steps, testing first whether exactly the same configuration has existed before, and, having denied that, assessing whether the difference vis-à-vis the pre-existing wealth of forms is such that the design actually merits protection. To distinguish expressly between both steps – calling the first one ‘novelty’ and the second ‘individual character’ – therefore amounts to a clarification rather than to imposing additional barriers against protection.”*

This question is still engaging the European Commission, which in 2014 published a Letter of Invitation to Tender and Call for Tenders for a legal review on industrial design protection in the European Union (MARKT/2014/083/D,17). The aim of the Letter was to investigate whether the existing legal framework for design protection both at national and EU level met its objectives, particularly in the light of the fact that the Directive and the Regulation were adopted more than a decade previously. The Commission tasked itself to examine whether these instruments required *“any update due to the technological progress that has taken place in recent years”*. One of its objectives for consideration is *“whether the novelty test remains necessary, separate from the requirement for individual character”* (MARKT/2014/083/D,17, 11.43.). The Study has however not yet been published.

b) non-obviousness

c) inventive step

d) individual character

The ‘novelty’ and ‘individual character’ requirements are already harmonised at EU level.

As stated at 14(a) above, some commentators have queried the feasibility or even legitimacy of having ‘novelty’ and ‘individual character’ as *cumulative* criteria for design protection, as this may appear to clash with the wording of Article 25 of TRIPS (“new or original”). Whilst it might be possible to adopt a single threshold of ‘individual character’ that complies with Article 25 of TRIPS, the cumulative criteria have worked effectively in practice: *“the assessment usually proceeds in two logical steps, testing first whether exactly the same configuration has existed before, and, having denied that, assessing whether the difference vis-à-vis the pre-existing wealth of forms is such that the design actually merits protection. To distinguish expressly between both steps – calling the first one ‘novelty’ and the second ‘individual character’ – therefore amounts to a clarification rather than to imposing additional barriers against protection.”*

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
- 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 prevailing tests are the ‘multiplicity of forms’ approach (essentially (c) above) and the ‘non-technical function’ approach (essentially (d) above) (see our Answer to Question 5).

The ‘multiplicity of forms’ approach makes the availability of alternative features not only relevant as a factor but a dispositive inquiry. Such a test would render the exclusion of designs dictated by technical function almost meaningless; few functions can be performed by only one shape. This was a driving rationale for the decision of the UK House of Lords under prior law in *Amp v. Utilux*, and was also mentioned by the Board of Appeal in *Lindner* and the UK courts following that decision. See Answer to Question 5. It is a persuasive critique; adopting multiplicity of forms to preclude the application of the exclusion would potentially undermine the goal of limiting protection of technical function to patent law, and forestalling circumvention of the patent system (with its enhanced disclosure requirements, rather than any substantially different term). This is illustrated by positing the possibility that two designers (or one designer applying for two designs) filed applications on the two forms by which the technical function can be performed. Some commentators have described this concern as unrealistic. See David Stone, *European Design Law: A Practitioners’ Guide* (2d. ed. 2016). However, even if the existence of alternatives is not dispositive, it is not clear the extent to which this consideration might have continued relevance. (To some extent it might effectively do so if courts blend analysis of design freedom and the exclusion of functionally dictated features in performing analysis of overall impression to determine individual character or infringement).

The ‘non-technical function’ approach, as interpreted by the Board of Appeal in *Lindner*, runs the risk of violating Recital 14 of the Designs Directive (Recital 10 of the Regulation). Recital 14 of the Directive, in discussing the functionally dictated exclusion, warns “*that this does not entail that a design must have an aesthetic quality.*” Yet, the upshot of this test is that a claimant will secure protection provided that the design has an aesthetic function. (Theoretically, the *Lindner* test requires only some function other than a technical function, but in practice that other function is an aesthetic one). Cf. Lavinia Brancusi *Designs Determined By The Product's Technical Function: Arguments For An Autonomous Test*, 2016 Eur. Intell. Prop. Rev. 23 (“*a look at the official documents preparatory to the introduction of the [Directive] and [Regulation] shows that, at the beginning, the rationale of this*

exclusion was justified rather by the argument that the designer of such functional designs had not displayed any personal creativity—understood as being unable to choose among various forms when designing a product with a given functional effect—and therefore the design itself was considered as lacking an individual character and devoid of protection.”)

Thus, both prevailing tests – which rely on single considerations to avoid the application of the exclusion (either ‘multiplicity of forms’, or a ‘non-technical (aesthetic) function’) – appears to be problematic, at least if applied without regard to other considerations. Yet finding a satisfactory alternative approach is not easy.

Arguably the solution is to make no single factor dispositive, and consider both factors as interpreted in light of the purposes of the provision. The importance of this consideration to analysis of the exclusion is seen in *Sealed Air Ltd v Sharp Interpack Ltd & Anor* [2013] EWPC 23. In that case the registered design was held to be valid (despite its features being heavily functional) and no feature, or portion, of the registered design was held to be solely dictated by technical function. In that case the judge emphasised that [at 76]:

“I think the fallacy in Sealed Air’s reasoning . . . is to argue that once the designs are recognised as valid despite their numerous functional features (because aesthetic considerations do play a part) it therefore follows that one can pray in aid many of the visual similarities between the Sealed Air and Sharpak designs, ignoring the fact that these similarities derive from functional and/or conventional elements. Mr Howe submitted that there was a spectrum between totally functional objects and totally aesthetic objects and that this case was further towards the aesthetic end of that spectrum than the industrial products mentioned by the OHIM Board of Appeal in Lindner. I agree but only up to a point. These designs have an aesthetic element but in truth their appearance is very largely driven by functional considerations and to an important degree the elements which are not constrained by function are conventional.”

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 see our answer to question 19 below.

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 ...

See our answer to question 16.

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 ...

In our view, a feature, or portion, of a design the appearance of which is solely dictated by technical function should not be ignored entirely for the purposes of assessing validity or its scope of protection for the purposes of infringement.

It is possible that a design will incorporate solely functional features but that the selection of those specific features from the available options and/or the way in which they are arranged/incorporated into the design as a whole has been chosen for non-functional reasons, and could significantly affect the overall impression created by the design.

For example, a design may be made up of only functional components (excluded if they were claimed in themselves) but which together make up something which is non-functional and dictated by aesthetic considerations. Imagine a watch face which has a collection of visible screws, which are not individually protectable, but which form part of the pattern of the design. In such circumstances, if the functional components were ignored entirely, nothing would remain and consequently the overall design would not be valid.

Alternatively, a design may be a combination of a functional component and an artistic component. For example, consider a design for a key in which the protruding key element/blade used to unlock the door is purely functional but the head element is a purely artistic design, and the alleged infringement combines the artistic head with a different functional element (such as a screwdriver). In determining infringement, if one excluded the functional elements (by crossing them out mentally) what is left would be identical to the protected design. But if you consider the functional and artistic elements together, the one design produces a different overall impression from the another. It would seem odd to us if this were to be an infringement, as the design owner has chosen to register the combination of the functional element and the artistic element and not the artistic element on its own.

In our view, therefore, in general it should be possible to protect a design which is made up (in whole or in part) of individual features which are dictated solely by technical function, provided the way in which those functional features have been selected or arranged is not wholly dictated by technical function. Similarly, functional features ought to be taken into account in determining the scope of protection of a design, as they can significantly impact upon the overall impression.

That is to say, portions deemed functional *should* be taken into account when considering the overall impression for the purposes of validity and infringement, but such features ought to be *appropriately weighted* in order to reflect their functional nature.

While this answer may be closest to answers (c) and (d) above, it is not clear to us what exactly is meant by taking a feature into account “separately” rather than it playing a “role in the overall impression”.

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?

N/A

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.

N/A

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