



Study Question

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Partial designs

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I. Current law and practice

Please answer all questions in Part I on the basis of your Group's current law and practice.

1 Is protection given to Partial Designs, and if so, are the laws for the protection of Partial Designs different to the laws for the protection of designs generally? If YES, please explain.

Yes

Please Explain

In Germany and the European Union (EU), protection is given to Partial Designs, understood as the Design for a portion, or portions, of a whole Product. A portion of a whole Product is therefore eligible for protection through registration of an independent Registered Design, or – on the basis of the Community Designs Regulation (CDR) – through an independent Non-Registered Design relating to such portion. There is, however, no protection for elements or parts of a Registered Design, even if these elements or parts are optically separable from the Design [\[1\]](#).

Partial Designs are subject to the same requirements for design protection as any other Design. That means in particular that a Design pertaining to a portion, or portions, of a whole Product must meet the two basic substantive requirements for protection of a Registered Design, which are whether the Design in question (the portion of a whole Product) is “new” and possesses “individual character” (Sec. 2 para. (1) German Designs Act [GDA]).

Footnotes

1. [↑](#) see *Bundesgerichtshof [BGH], GRUR 2012, 1139 – Decanter [Weinkaraffe]*.

2 How are Partial Designs specified, described and/or graphically depicted?

See below under 2 a) through 2 c).

2.a Is there a visual indication, e.g. by dotted or dashed lines, or shading or colouring, of those components that are not included in the Partial Design, i.e. of the Unclaimed Part?

Yes

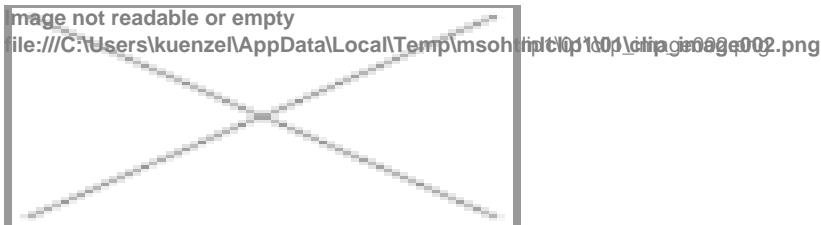
Please Explain

Yes, there is a visual indication of components that are not included in the Partial Design.

In Germany designs can be protected either by a registered German national Design or a Registered Community Design (RCD).

German Designs are registered before the GPTO. The German Patent- and Trademark Office (GPTO) refers to the Common Communication on graphic representation of designs [1], which has been developed during the Convergence program CP6 of the European Union Intellectual Property Office (EUIPO) with several national Offices. According to the common communication the GPTO accepts visual disclaimers that indicate that protection is not sought for certain features of the design shown in the representation [2]. The visual disclaimer indicates the unclaimed part. The GPTO will only accept visual disclaimers clearly indicating the features of the design that should not be protected shown in the representation.

The Common communication explains that four different types of visual disclaimers, namely broken lines, colour shading, boundaries and blurring can be used as visual disclaimers [3]. For a visual disclaimer Broken Lines are recommended:



Hungarian registered design No. D9900409-0001 (08.04)

(handle of screwdriver) Owner: Cooper Industries, Inc. [4]

The Broken Lines indicate the features that no protection is sought for – the Unclaimed Part.

Other disclaimers such as colour shading, boundaries and blurring can be used, but are recommended only for photographs or when broken lines cannot be used as a visual disclaimer as they are used to indicate features of the design such as stitching on clothing or patterns.

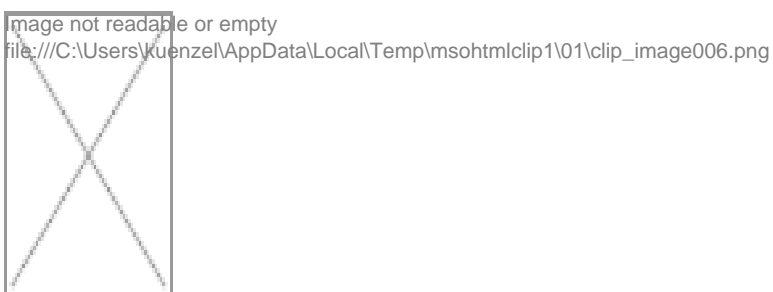
Colour Shading is a visual disclaimer using contrasting tones of colour to obscure the features for which protection is not sought for [5]:



RCD No. 000910146-0004 (12.08) (Automobiles (part of-))

Owner: TOYOTA MOTOR CORPORATION

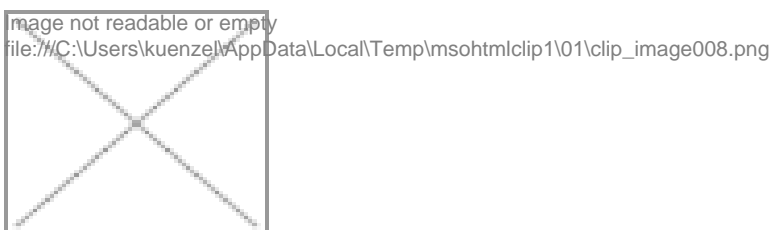
When Blurring is used as a visual disclaimer the same principle as for colour shading applies. The features for which protection is not sought or obscured by blurring instead of colour shading [\[6\]](#):



RCD No. 000244520-0002 (12.15)

(Tyres for vehicle wheels, pneumatic) Owner: Nokian Tyres plc

On the other hand boundaries indicate the features for which protection is sought as all features within the boundary form the claimed part while all features outside the boundary are unclaimed [\[7\]](#).



RCD No. 001873688-0003 (02.04)

(soles for footwear) Owner: Mjartan s.r.o.

Different types of visual disclaimers can be combined.

The same applies for registered community designs. The EUIPO also accepts visual disclaimers even if the Guidelines state that neither the CDR nor the Implementing Regulation to the CDR (CDIR) provide rules for the possibility to include a disclaimer for features of the design [\[8\]](#). The same types of visual disclaimers as for a German design [\[9\]](#) can be used. The visual disclaimer can either exclude features for which protection is not sought for with broken lines, blurring or colour shading or can include within a boundary the features of a design for which protection is sought.

Footnotes

1. [^ European Trade Mark and Design Network, "Convergence on graphic representations of designs - Common Communication", 15 April 2016 \(herein after referred to as Common Communication CP6\)](#)
2. [^ Common Communication CP6, p. 2 – 4, para. 2](#)
3. [^ Common Communication – CP6, p. 3, para. 2 – recommendations/guidelines](#)
4. [^ Common Communication – CP6, p. 3, para. 2 a\)](#)
5. [^ Common Communication – CP6, p. 3, para. 2 b\)](#)
6. [^ Common Communication – CP6, p. 3, para. 2 d\)](#)
7. [^ Common Communication – CP6, p. 3, para. 2 c\)](#)
8. [^ EUIPO Guidelines for Examination of Applications for registered Community Designs, para. 5.3](#)
9. [^ EUIPO Guidelines, Guidelines for Examination of Applications for registered Community Designs, para. 5.3](#)

2.b

Is there a written description of the Product, of which the Partial Design forms part?

Yes

Please Explain

A written description is not mandatory for a German registered design. A description for the explanation of the representation can be added (§ 11 (5) No. 1 German Design Act (GDA)).

The same applies for a registered community design. A written description is also not mandatory, but can be added (Art. 36 (3) a) CDR).

2.c

Can verbal disclaimers be used?*

****Verbal disclaimers may be used in Brazil. For example, in the case of a handle for a pan, the entire pan is shown but the applicant may indicate in writing that protection is sought only for the handle.***

Yes

Please Explain

Yes and no, verbal disclaimers can be used for a registered German national design, but not for a RCD.

The written description of a German design can be used as an explanation of the representation with a maximum of 100 words. It can also include verbal disclaimers to disclaim features shown in the representation [1]. Verbal disclaimers are not very common in design registration practice in Germany.

On the other hand, the CDR defines that the written description has no influence on the scope of protection (Art. 36 (6) CDR) of a registered community design. As a verbal disclaimer would be part of the written description, a verbal disclaimer to disclaim certain features shown in the representation is not possible for an RCD [2].

Footnotes

1. [^ Eichmann, v.Falckenstein, Kühne “Designgesetz“, 5. Auflage, C.H. Beck Verlag, para. 11, Rn 66](#)
2. [^ Guidelines for Examination of Applications for registered Community Designs, para. 5.4](#)

3 Can a Partial Design forming part of a Product X be infringed by the use of the same Partial Design on a Product Y? If so, please explain any required link or nexus between X and Y.

Yes

Please Explain

Infringement of a partial design is governed by the same standards as infringement of any other design category, the test being whether the allegedly infringing design does not produce on the informed user a different overall impression (Sec. 38 para. (2) GDA).

If design protection relates to a Partial Design, it is the overall impression of the comparable portion of the accused product that needs to be taken into consideration^[1].

Design features of surrounding portions have no bearing on the overall impression of the relevant portion of the accused product and can thus not contribute to producing a different overall impression. So the answer to the question is that a Partial Design forming part of a Product X may indeed be infringed by the use of that same Partial Design on a Product Y ^[2].

Footnotes

1. [^ BGH GRUR 2011, 1112, at margin No. 56 – Writing utensils \[Schreibgeräte\]](#).
2. [^ see BGH, I.c., Writing Utensils \[see footnote No. 14\]](#).

4 Can a Partial Design forming part of a Product X be considered not novel in view of the same Partial Design in prior Product Y? If so, please explain any required link or nexus between X and Y.

Yes

Please Explain

There are some decisions of the EUIPO indicating that there may be situations in which a Partial Design forming part of a Product X may be considered not new in view of the same Partial Design disclosed in a prior Product Y ^[1]. The relevant question in each particular case seems to be whether the relevant portion of a prior design may be regarded as being disclosed *as such* in the prior Product Y, and not only in connection with the particular shape of the Product in or on which it is shown. That may depend on the design in question and may not be determined by way of a general rule for all designs.

Footnotes

1. [^ See, for example, HABM \[EUIPO\] NA ICD 000 002 665 of 22 September 2006. This decision relates to decorations disclosed in a prior design for shoes. The same decorations formed a part of a later design that was attacked for lack of novelty. The board did apparently assume that the decorations as such \(and not only their combination with a certain shape of shoes\) were disclosed in the prior design so that novelty and/or individual character of the later design could be attacked based on the prior design. This decision is cited by Ruhl, Community Design \[Gemeinschaftsgeschmacksmuster\], 2nd ed. 2010, Article 7, at margin No. 38 \[footnote No. 46\]](#).

5 Please explain if your Group’s laws take into account elements outside the scope of the Partial Design (i.e. the Unclaimed Part) when considering the application of Design Constraints, such as must fit / must match exceptions.

Both German national design laws and the CDR take Design Constraints, in the form of both an exception for features that are solely dictated by a technical function (Art. 8 para. (1) CDR) and an exceptions for must fit parts (Art. 8 para. (2) CDR). However, there is no must match exception for Community Design or national design protection (Art. 8 para. (3) CDR and Sec. 3 para. (2) GDA).

II. Policy considerations and proposals for improvements of your Group's current law

6 Are there aspects of your Group's current law or practice relating to Partial Designs that could be improved? If YES, please explain.

Yes

Please Explain

Yes, there are aspects of German and European practice that could be improved (see answers to questions No. 7 et seq.).

7 Is the way of specifying, describing or depicting Partial Designs satisfactory?

No

Please Explain

- a. Visual disclaimers using broken lines are usually satisfactory. However **boundaries** are often not very clear and open to interpretation regarding the item for which protection is sought. While broken lines, colour shading and blurring all depict the features for which protection is not sought for, boundaries differ as they mark the features protection is sought for. What is claimed if a boundary is drawn using dotted lines?
- b. Verbal disclaimers can be used for German designs, but not for RCDs. Harmonization is necessary. Verbal disclaimers can be quite helpful for example to exclude writing or a trademark on a packaging.

8 Should the Unclaimed Part influence the protection of the parts of the design that are claimed? Please explain why or why not.

No

Please Explain

We think the Unclaimed Part should not influence the protection of the Design that is claimed if this Design consists of a Partial Design, understood as a portion of a whole Product. As it is the current law and practice in Germany now, we think that the current approach taken by Germany's Federal Supreme Court (BGH) in the "Writing Utensils" case [\[1\]](#) should be generally adopted. This approach affords the appropriate protection for designs consisting of a portion, or of portions, of a whole Product. Since the claimed portion of a whole Product must itself meet all substantive requirements for design protection (i.e. novelty and individual character), there is in our mind no reason for including Unclaimed Parts of Surrounding Context into the determination of whether the overall impression of the design in question is different from the overall impression of the corresponding portion of the accused product. The claimed portion of the whole Product, which in itself constitutes the Design in question, and nothing else, determines the overall impression of the Design and thus its scope of protection. There is, thus, no room for any further limitation of its scope of protection.

Footnotes

1. [^](#) see *BGH, I.c., Writing Utensils* [see footnote No. 14].

9 Should Design Constraints restrict the subsistence and scope of protection of Partial Designs? Please explain why or why not.

Yes

Please Explain

Design Constraints should restrict the subsistence and scope of protection of Partial Designs in the same way as they should, or already do, restrict subsistence and scope of protection of Designs in general. There is no difference in the application of Design Constraints, like the exception for features that are solely dictated by a technical function, on either Partial Designs (which are no different than Designs in general) or Designs. If a Design subsists in a portion of a whole Product, and this portion is regarded as both new and having individual character, there is no reason to treat a Design relating to such portion differently from other Designs. If the portion of a whole Product partly consists in features that must be regarded as being solely dictated by a technical function, these features must be excluded from the determination of whether that portion meets the requirements of novelty and individual character. If the remaining features of the portion still meet these substantive requirements, there is no room for the application of rules that may differ from the normal application on Designs in general.

10 Should the assessment of whether a design is for a portion of a whole Product, i.e. that design is a Partial Design, take into account:

0.a the design as shown and any Unclaimed Part; and/or

No

Please Explain

We think that the aspect under a) mentioned above should be relevant in the assessment of whether the Design relates to a whole Product or to a portion of it. However, as Partial Designs are in principle treated in the same way as Designs in general, both in terms of validity and scope of protection, the assessment whether a design is for a portion of a whole Product, and what aspects should govern this assessment, do not seem as relevant as in jurisdictions where the category of "Partial Design" has different legal consequences, for example, for the scope of protection. This is not the case in Germany.

0.b whether the Product is normally sold separately?

No

Please Explain

We think that the aspect under a) mentioned above should be relevant in the assessment of whether the Design relates to a whole Product or to a portion of it. However, as Partial Designs are in principle treated in the same way as Designs in general, both in terms of validity and scope of protection, the assessment whether a design is for a portion of a whole Product, and what aspects should govern this assessment, do not seem as relevant as in jurisdictions where the category of "Partial Design" has different legal consequences, for example, for the scope of protection. This is not the case in Germany.

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

No

Please Explain

See below under III. 14.

III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

12 Should a Partial Design be registrable as an independent design?

Yes

Please Explain

As is currently the law in Germany and the EU a Partial Design should be registrable as an independent design, in order to afford optimal protection for parts that itself are worthy of protection, without regard to other parts that are used with the design in question, or in which the design is used.

13 Is harmonisation of the law of Partial Designs desirable?

Yes

Please Explain

Harmonization of the law of Partial Designs is desirable in order to give all interested parties the opportunity to claim protection for the same Products or portions of them in as many countries and jurisdictions as possible.

If YES, please respond to the following questions without regard to your Group's current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group's current law or practice could be improved.

14 Please propose a suitable framework for specifying, describing and/or graphically depicting (a) the Partial Design and (b) the Unclaimed Part.

It is interesting to note that the Regulation (*de lege lata*) already provides for a useful tool regarding the use of partial disclaimers which could – *de lege ferenda* – possibly be enacted for use on Partial Designs. Another suggested way is to consider Art 36 (6) and take a fresh view on its possible interpretation.

In contrast to Art. 36 (6), which provides – on the basis of plain reading – a statement (which will be revisited later) against the impact of descriptions (in particular in litigation issues), Art. 25 (6) CDR provides for a provision regarding a partial disclaimer in invalidity proceedings. It is notable to highlight the contrast between the brief description in Art. 36 (6) versus the allowance of partial disclaimers in Art. 25 (6).

According to Art. 25 (6) a CDR which has been declared invalid pursuant to Art. 25 (1) (b), (e) or (f) or (g) may be maintained in amended form, if in that form it complies with the requirements for protection and the identity of the design as maintained.

“Maintenance” in an amended form may include registration accompanied by a partial disclaimer by the holder of the CDR or entry in the registry of the Court or a decision by the Office declaring the partial invalidity. One way to cope the practical problems in connection with the use of partial disclaimers is de lege ferenda for use on Partial Designs.

Another approach could be a stronger impact of the description within the meaning of Art. 36 (6). Where a matter other than the design is present (for example a background, or another part of a product) the description could be used to explain that such matter does not form part of the design. Where the representations use a convention such as dashed lines, blue wash or red ringing the description may indicate the significance of these conventions. Since the brief description is not examined, a patent type claim type of description could be used indicating, for example, that the design consists of a transparent circular disk no more than 5 cm in height. It is possible, but doubtful, that such statement could act to broaden the protection given, on the basis perhaps that it “explains” that the figures shown are merely exemplars of a more general class.

Finally, where the nature of the product itself is not self-evident, it may be possible to use the “brief description” to explain the product. [1]

Footnotes

1. [△] see also *The CITMA & CIPA Community Designs Handbook, Chartered Institute of Trade Mark Attorneys (C.I.T; Chartered Institute of Patent Attorneys (C.I.P.A.); Patricia Collins; William Jones (Eds.), September 2017 p. 52).*

15

Taking the example of a Partial Design for a handle for a pan, and an accused product consisting of a sieve with the same handle, the:

- **Unclaimed Part (UP) of the Partial Design is the pan without the handle;**
- **Surrounding Context (SC) is the part of the accused product without the protected Partial Design, i.e. the sieve without the handle,**

Please explain whether differences between the SC and UP should be relevant when considering the overall impressions of the accused product and the Partial Design, in the following circumstances. In each case, please briefly explain why.

5.a

SC is the same as UP

With regard to all of the above mentioned factual situations, the Surrounding Context is not relevant for establishing the overall impression of the portion of the accused product relevant for determining infringement of the partial design [1]. Consequently, it does not matter whether (a) SC is the same as UP or whether SC is different from UP regardless of whether (b) the products are used in the same way, (c) the products look the same, (d) the products are categorised in the same way when registering designs, or (e) whether SC and UP are entirely unconnected.

Footnotes

1. [△] see *BGH, I.c., Writing Utensils [see footnote No. 14].*

5.b

SC is not the same as UP, but SC and UP relate to products that are used in the same way

With regard to all of the above mentioned factual situations, the Surrounding Context is not relevant for establishing the overall impression of the portion of the accused product relevant for determining infringement of the partial design [1]. Consequently, it does not matter whether (a) SC is the same as UP or whether SC is different from UP regardless of whether (b) the products are used in the same way, (c) the products look the same, (d) the products are categorised in the same way when registering designs, or (e) whether SC and UP are entirely unconnected.

Footnotes

1. [^](#) see *BGH, I.c., Writing Utensils* [see footnote No. 14].

5.d

SC is not the same as UP, but SC and UP relate to products that look the same

With regard to all of the above mentioned factual situations, the Surrounding Context is not relevant for establishing the overall impression of the portion of the accused product relevant for determining infringement of the partial design [1]. Consequently, it does not matter whether (a) SC is the same as UP or whether SC is different from UP regardless of whether (b) the products are used in the same way, (c) the products look the same, (d) the products are categorised in the same way when registering designs, or (e) whether SC and UP are entirely unconnected.

Footnotes

1. [^](#) see *BGH, I.c., Writing Utensils* [see footnote No. 14].

5.d

SC is not the same as UP, but SC and UP relate to products that categorised in the same way when registering designs

With regard to all of the above mentioned factual situations, the Surrounding Context is not relevant for establishing the overall impression of the portion of the accused product relevant for determining infringement of the partial design [1]. Consequently, it does not matter whether (a) SC is the same as UP or whether SC is different from UP regardless of whether (b) the products are used in the same way, (c) the products look the same, (d) the products are categorised in the same way when registering designs, or (e) whether SC and UP are entirely unconnected.

Footnotes

1. [^](#) see *BGH, I.c., Writing Utensils* [see footnote No. 14].

5.e

SC is not the same as UP, and SC and UP are entirely unconnected.

With regard to all of the above mentioned factual situations, the Surrounding Context is not relevant for establishing the overall impression of the portion of the accused product relevant for determining infringement of the partial design [1]. Consequently, it does not matter whether (a) SC is the same as UP or whether SC is different from UP regardless of whether (b) the products are used in the same way, (c) the products look the same, (d) the products are categorised in the same way when registering designs, or (e) whether SC and UP are entirely unconnected.

Footnotes

1. [^](#) see *BGH, I.c., Writing Utensils* [see footnote No. 14].

16

In light of your answers to Question 15, please propose appropriate rules specifying whether and how the Unclaimed Part should be taken into account when analysing the overall impression of a Partial Design for both individual character and infringement.

As is the current law and practice in Germany, we think that the current approach taken by Germany's Federal Supreme Court (BGH) in the "Writing Utensils" case^[1] should be adopted. This approach affords the appropriate protection for designs consisting of a portion, or of portions, of a whole Product (Partial Designs). Since the portion of a whole Product must itself meet all substantive requirements for design protection (i.e. novelty and individual character), there is in our mind no reason for including Unclaimed Parts or Surrounding Context into the determination of whether the overall impression of the design in question is different from the overall impression of the corresponding portion of the accused product. The claimed portion of the whole Product, which in itself constitutes the Design in question, and nothing else, determines the overall impression of the Design and thus its scope of protection. There is, thus, no room for any further limitation of its scope of protection.

Footnotes

1. [^] see *BGH, I.c., Writing Utensils* [see footnote No. 14].

17

Please propose appropriate rules specifying whether and how Design Constraints arising from the Unclaimed Part should affect a Partial Design. In particular, please explain whether and how must fit / must match Design Constraints affect Partial Designs.

As we are of the opinion that the Unclaimed Part of a Partial Design should not be decisive or relevant for either the subsistence or scope of protection of a Partial Design (see above under No. 8 and No. 16), we also believe that the Design Constraints from the Unclaimed Parts should not affect the Partial Design.

18

Please comment on any additional issues concerning any aspect of Partial Designs you consider relevant to this Study Question.

19

Please indicate which industry sector views are included in your Group's answers to Part III.

The group report considered the views of the steel manufacturing industry.