



Submission date: 19th May 2016

## 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	Spain
Contributors name(s)	Sempere IVÁN, Rosa MARTÍNEZ, Mónica DíEZ, Jordi ROMANÍ, Antonio SELAS, Ricardo GUERRAS, Isidro José GARCÍA, David MUÑOZ, Mariona BALDÓ, Fabriizio MIAZZETTO, Alicia ARROYO, M <sup>a</sup> cristina MARTÍNEZ-TERCERO and Néstor COROMINAS
e-Mail contact	i.sempere@padima.es
Date	11-05-2016

### 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:

Yes, it does under the Spanish Law 20/2003, of 07/07/2003 on Legal Protection of Industrial Designs – hereinafter, IDL –, within the framework of Directive 98/71/CE of 13/10/1998 on the Legal Protection of Designs –the Directive–.

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

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

Industrial Design.

3) What are the statutory requirements for such right? Please tick any relevant boxes and explain the

basis and application of these requirements.

a) novelty

(art. 6 of IDL: A design shall be considered to be new if no identical design has been made available to the public before the filing date of the application for registration or, if priority is claimed, before the priority date. Designs shall be deemed to be identical if their features differ only in non-relevant details).

b) non-obviousness

c) inventive step

d) individual character

(art. 7 of IDL: 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 filing date of the application for registration or, if priority is claimed, before the priority date. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration).

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:

Yes, it does. Article 11.1 of IDL establishes that the registration of an industrial design shall not confer any right over the 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

The Spanish IDL has no provision concerning these factors, and there is no domestic case-law (Spanish) relating this matter.

We understand that the regulation shall be interpreted in the light of the Directive, in the sense that protection should not be granted to the features solely dictated by technical functions. These features shall not be taken into account to assess the industrial design protection requirements (Recital 14 and Art. 7.1 of the Directive)

In view of the equivalence between the provisions under the IDL, the Regulation CE 6/2002 and the Directive, we understand that the Spanish Courts should follow the doctrine set in that scope by the ECJ.

From the following list, we can only refer to item c), which is the one that the Spanish European Union Trademark Courts (Community Design) apply. There is not additional information to confirm or reject the other criteria.

In case that the technical function of the feature examined can be reached by different formal appearances, the functional design is eligible for protection. This means following to the so called multiplicity-of-forms theory. Decision No. 201/2009 AP Valencia, of 20/07/2009.

- 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?

yes

Please explain:

Under article 11.1, the answer must be positive provided that it is a feature "solely dictated by its 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

The Spanish Law has no provision concerning these factors, and there is no domestic case-law (Spanish) relating this matter.

Nevertheless, and in view of the equivalence between the IDL provisions, the Regulation CE 6/2002 and the Directive, we understand that the Spanish Courts should follow the doctrine set in that scope by the ECJ.

From the following list, we can only refer to item b) which is the one that the Spanish European Union

Trademark Courts (Community Design) apply. There is not additional information to confirm or reject the other criteria.

In case that the technical function of the feature examined can be made by different formal appearances, the functional design is eligible for protection. This means following to the so called multiplicity-of-forms theory. Decision No. 93/12 Section 1 of the Commercial Court No. 1 of Alicante, decision No. 267/07 of the Commercial Court No. 1 of Alicante and decision No. 302/2012 of 28/11/2012, of the Commercial Court No. 2). It must be pointed out that these decisions apply to the Regulation and not the IDL.

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

The Spanish IDL has no provision concerning these factors, and there is no domestic case-law (Spanish) relating this matter.

However, taking into account article 11.1 of IDL, which establishes that the registration of an industrial design shall not confer any right over the features of appearance of a product which are solely dictated by its technical function, it seems obvious that said features cannot be taken into account to define the design scope of protection.

Nevertheless, and in view of the equivalence between the IDL provisions, the Regulation CE 6/2002 and the Directive, we understand that the Spanish Courts should follow the doctrine set in that scope by the ECJ.

Thus, a design with any feature solely dictated by its technical function could be legitimately protected while said design has other features which are not technical. However, and in this case, the protection will not reach the solely functional features.

From the following list, we can only refer to items a) and b). There is not additional information to confirm or reject the other criteria.

Protection is not granted to these features, so they cannot be taken into consideration to determine the individual character of the design and, thus, its scope of protection in terms of infringement.

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

Protection is not granted to these features, so they cannot be taken into consideration to determine the validity of the design.

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

- d) any portions deemed functional will not be taken into account separately when assessing validity, but may play a role in the overall comparison
- e) no effect (e.g. so long as the overall appearance is not dictated solely by its technical function, all portions of the design are included in the scope of protection, irrespective as to whether any portions may be functional)
- f) the Group's current law is unsettled
- g) other, namely ...

## II. Policy considerations and possible improvements to your current law

9) How can the following aspects of your Group's current law be improved, if at all?

- a) the definition or meaning of a "design"
- b) the requirements for protection of a design
- c) the treatment of functionality in the sense described in paragraph 14) of the Study Guidelines or aspects of such functionality

Both the legal definition of industrial design and its protection requirements are deemed to be adequately established under the IDL within the Directive framework.

Concerning the functionality, while the IDL does not prohibit the registration of designs with technical or functional features, article 11.1 of IDL makes clear that those features solely dictated by its technical function are not eligible for protection. We understand that this level of protection is coherent with the Directive. However, an interpretation or clarification on what is understood by "features solely dictated by its technical function" is missing.

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

no

Please explain:

No, there are not.

## 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:

Yes, it does. The legal harmonization and a uniform interpretation in the mentioned areas (design definition, protection requirements and functional features treatment) shall be welcome.

- 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:

Yes, it should.

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

The term “industrial design” correctly includes the desired object of protection, that is, the appearance of the whole or a part of a product (individual or complex), resulting from features such as lines, contours, colors, shape, texture or materials of the product itself or its ornamentation.

- 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

in the sense of art. 6 of IDL.

b) non-obviousness

c) inventive step

d) individual character

in the sense of art. 7 of IDL.

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:

Yes, it should. The doctrine is unanimous as it is interpreted that the aim of the regulation lays in understanding that the technical or functional features should be protected by the patent and/or utility model (inventions) law. The Directive in its Recital 14 establishes that “technological innovation should not be hampered by granting design protection to features dictated solely by a technical function”. The Directive statutes in Article 7 that a design right shall not subsist in features of appearance of a product which are solely dictated by its technical function.

Following this Directive, the IDL indicates in its preamble that “both merely ornamental designs and functional designs are registered, excluding those with features solely dictated by their technical function”. In Article 11.1 of the said IDL it is specified that “the registration of the design shall not confer any right over the features of appearance of the product which are solely dictated by its technical function”.

- 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

This factor shall be taken into account to reject the design protection as far as the decisive or relevant formal features in the overall appearance of the design lay only on technical grounds. In this scenario, the protection shall be granted by a Patent or an Utility Model where appropriate.

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

This will be a decisive or relevant aspect to refuse a design protection as far as all these features lay only on technical reasons. In case that these features lay or have other additional *non-functional* aesthetic or ornamental features, fulfilling the protection requirements, they would be eligible for protection. The IDL explicitly specifies this issue in its preamble, stating that “Both merely ornamental and functional designs are registered, excluding those with features solely dictated by their technical function. The possibility of separating shape and function is what allows the external shape of an utilitarian product to be protected as design taking into consideration the features of appearance also fulfill with the novelty and individual character requirements”.

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

On the one side, this is for the European Union Trademark (Community Design) Courts in Spain (decision No. 93/12 of Section 1 of the Commercial Court of Alicante No. 1, decision No. 267/07 of the Commercial Court of Alicante No. 1, and decision No. 302/2012 of 28/11/2012, of the Commercial Court No. 2) and for a significant part of the Spanish doctrine, a relevant criterion condensed in the multiplicity-of-forms theory. According to this theory, a functional design is eligible for protection as far as it is proven that there are other possible ways (freedom of form) to achieve the technical result.

On the other side, the EUIPO (R690-2007; R1114-2007; R211-2008; R1517/2014; R 2114/2014, among others) sets aside the multiplicity-of-forms theory and considers that it is enough for the prohibition (art. 8.1 of RDC –equivalent to art. 11.1 of IDL-) to be applied, that the shape is solely dictated by a technical function, independently if there are (or not) other ways of making or achieving the same function. This does not mean rejecting a design protection only because it includes functional features,

but that these features cannot be eligible for design protection.

Consequently, a harmonization avoiding different interpretations among the diverse systems is required, as well as an uniform application (and delimitation) of such criteria.

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

This criterion could be also the relevant one to determine if a shape is technically necessary. Indeed, if an external appearance has been exclusively chosen with the aim that the product fulfills a technical function, then this appearance cannot be protected as design. The fact that the design's features are solely dictated by its technical function means that the need to achieve this technical function was the only relevant factor when creating the design. In case of using this criterion, it would be desirable to "objectify" its approach (EUIPO R 211/2008 p. 30).

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, it should be denied provided that it is a feature solely dictated by its technical function: protection cannot be granted to features solely dictated by their technical functions. These features shall not be taken into consideration to assess the design protection requirement or its scope of protection.

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

As far as the overall impression of said features is solely determined by technical grounds; or in other words, there are no additional or relevant aesthetical aspects. Nevertheless, this circumstance will not imply that the design of the whole product could not be registered if, apart from these technical features, the product has other features with individual character and novelty.

b) the availability of alternative appearances for the portion to obtain the same functional result

On the one side, this is for the European Union Trademark (Community Design) Courts in Spain (decision No. 93/12 of Section 1 of the Commercial Court of Alicante No. 1, decision No. 267/07 of the Commercial Court of Alicante No. 1, and decision No. 302/2012 of 28/11/2012, of the Commercial Court No. 2) and for a significant part of the Spanish doctrine, a decisive criterion condensed in the multiplicity-of-forms theory. It seems reasonable to understand that this theory applied to a product design is likewise applicable to a product's features under Article 11.1 of IDL: in this case, it will be considered that a functional feature is eligible for protection as far as it is proven that there are other possible ways (freedom of form) to achieve this technical result.

On the other side, the EUIPO (R690-2007; R1114-2007; R211-2008; R1517/2014; R 2114/2014, among others) sets aside the multiplicity-of-forms theory and considers that it is enough for the prohibition



(art. 8.1 of RDC – equivalent to art. 11.1 of IDL-) to be applied, that the shape or feature is solely dictated by a technical function, independently that there are (or not) other ways of making or achieving this same function. This does not mean rejecting a design protection only because it includes functional features, but these features cannot be eligible for design protection.

- c) the need to achieve the product's technical function was the only relevant factor when the portion in question was selected

This criterion could be also the relevant one to determine if a shape is technically necessary. Indeed, if an external appearance has been exclusively chosen with the aim that the product fulfills a technical function, then this appearance cannot be protected as design. The fact that the design's features are solely dictated by its technical function means that the need to achieve this technical function was the only relevant factor when creating the design. In case of using this criterion, it would be desirable to "objectify" its approach (EUIPO R 211/2008 p. 30).

- 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

The effect should be that the registration of this design shall not confer any right over the features of appearance of the product which are solely dictated by its technical function. These features shall not be taken into consideration to assess the protection requirements of the design or its scope of protection.

Protection shall not be granted to these features, so they shall not be taken into account to determine the individual character of the design and, thus, its scope of protection in terms of infringement.

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

Protection shall not be granted to these features, so they shall not be taken into consideration to determine the validity of the design.

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

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

- e) no effect (e.g. so long as the overall appearance is not dictated solely by its technical function, all portions of the design are included in the scope of protection, irrespective as to whether any portions may be functional)

- f) the Group's current law is unsettled

g) other, namely ...

20) If your answer to question 11) is no, is it your Group's view that a (registered or patented) intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture should not be available at all?

21) If yes, why?

22) If your answer to question 11) is no in relation to some but not all of the three areas set out in question 9) above, please state why your Group does not consider that harmonisation in that area(s) is desirable.

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.

According to the comments of this AIPPI Working Group, we understand that it will be the ECJ who shall finally interpret the meaning of the wording “features dictated solely by its technical function” to unify the practice of the administrative and jurisdictional Courts within the European Union. Until now, we observe certain distance between the EUIPO’s practice and the tendency of the Courts from some member States (e.g. the Spanish Courts (European Union Trademark Courts in Spain – Community Design –)). Harmonization in this point will be highly recommendable and welcome.

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

All kind of industry could be included or positively affected by the harmonization.

#### Summary

The Q is generally referred to the requirements for protection of designs, but particularly focused on the role of functionality within the scope of registered designs. Accordingly with the European Union legal framework, the legal requirements for design protection in Spain are novelty and individual character. In relation with the role of functionality, article 11.1 of the Industrial Design Law establishes that the registration of an industrial design shall not confer any right over the features of appearance of a product which are solely dictated by its technical function. The Spanish AIPPI Group understand that the regulation shall be interpreted in the light of the Directive, in the sense that protection should not be granted to the features solely dictated by technical functions. These features shall not be taken into account to assess the industrial design protection requirements (Recital 14 and Art. 7.1 of the Directive) nor to define the design scope of protection. Among the different criteria to interpret the application of this “functionality provision”, the European Union Trademark (Community Design) Courts in Spain, follows the multiplicity-of-forms theory, by which a functional design is eligible for protection as far as it is proven that there are other possible ways (freedom of form) to achieve the technical result. Taking into consideration there is not a uniform practice within the EU (e.g. the EUIPO’s practice seems to be far from the multiplicity-of-forms theory), we understand that it will be the ECJ who shall finally interpret the meaning of the wording “features dictated solely by its technical function” to unify the practice of the administrative and jurisdictional Courts within the European Union. Harmonization in this point will be highly recommendable and welcome.