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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:

Art. 173 of Portuguese Code of IP provides that a design or model represents the appearance of a product in whole or in part by virtue of such characteristics as lines, contours, colours, forms, textures or materials used in the product itself and its ornamentation.

- 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.

Design or Model (in Portuguese "Desenho ou Modelo").

- 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 or model shall be new if, before the application for registration or priority claim, no identical design or model has been disclosed to the public in Portugal or abroad.

b) non-obviousness

c) inventive step

d) individual character

A design or model is considered to be distinctive if the overall impression that it gives to an informed user differs from the overall impression caused to that user by any model or design published prior to the date of the registration application or priority claim. In the appreciation of distinctive character shall take into account the degree of freedom afforded to the creator to create the design or model.

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?

no

Please explain:

The IP Code (and Guidelines for applicants) are silent about a design with a whole appearance that is dictated solely by its function. However, the visible characteristics of a product resulting exclusively from its technical function are not protected by registration.

Registration can only be refused for a design fully or partially dictated by any technical function following an opposition by a third party.

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

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:

See above.

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

The visible characteristics of the element result exclusively from its technical function.

d) other, namely ...

8) What is the effect on the scope of protection of a design with one or more functional portions? Please tick any relevant boxes and explain as applicable:

a) any portions deemed functional will not be taken into account when assessing infringement

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

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

At court, the value of any argument falls totally at the discretion of the judge interpreting the law.

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

At court, the value of any argument falls totally at the discretion of the judge interpreting the law.

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"

In our opinion there is no need for improvement.

b) the requirements for protection of a design

In our opinion there is no need for improvement.

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

In our opinion the law may be improved in better defining the concept of technical function and relevant factors for assessment.

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:

Nothing to add.

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:

Defining the concept of technical function and relevant factors for assessment

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

yes

Please explain:

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

Design or Model

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 protection should only be granted to Designs or Models provided that before the application for registration or priority claim, no identical design or model has been disclosed to the public.

b) non-obviousness

c) inventive step

d) individual character

A design or model is considered to be distinctive if the overall impression that it gives to an informed user differs from the overall impression caused to that user by any model or design published prior to the date of the registration application or priority claim.

Appreciation of distinctive character shall take into account the degree of freedom afforded to the creator to create the design or model.

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:

See below.

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

It should be stressed in the law, that protection can still be granted to all other characteristics (if any) that are not dictated by a technical feature.

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 ...

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:

See 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

The visible characteristics of the element result exclusively from its technical function.

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

These should not play any role when assessing infringement, except in the case that there is nothing left besides the technical features/portions.

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

These should not play any role when assessing infringement, except in the case that there is nothing left besides the technical features/portions.

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?

no

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.

The Portuguese IP Code and specifically the provisions referring to "Designs or Models" are harmonized with the Community Design Regulation.

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.

No further comments.

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

Shoe, textile and cork industries.

Summary

The Portuguese Group agrees that harmonization is advisable in order to increase clarity in the use of the system, also possibly contributing to an increase in the number of applications and protection of Designs and Models. To this effect, harmonization on the criteria for evaluation technical functionality should be achieved. All features of a design that are exclusively dictated by the technical functionality should be considered out of the scope of protection of Designs and Models.