

2016 – Report on Resolution

Requirements for protection of designs

On 20 September 2016 at the AIPPI World Congress in Milan, AIPPI approved a resolution titled "Requirements for protection of designs", which concerns the definition of and the requirements for the protection of designs, with a particular focus on the role of functionality.

Members of the Agreement on Trade-Related Aspects of Intellectual Property Rights (*TRIPs*) may provide that protection for designs not extend to designs that are dictated essentially by technical or functional considerations. Almost all national Groups that responded to AIPPI's Study Question on this topic reported that their national laws contain such a restriction. However, many of those laws are silent on how to evaluate "technical functionality", and the effect of technical functionality of a portion of a design.

AIPPI resolved that design protection should be available, by way of registration, to protect the overall visual appearance including ornamentation (*Appearance*) of an object or article of manufacture as a whole (*Product*).¹ The Resolution states that the preferred term for this right is *Registered Design*.

While the Resolution focuses on the question of technical functionality, AIPPI also resolved that, at a minimum, novelty should be a requirement for protection of a Registered Design.

There was a general consensus that protection as a Registered Design should not be available for the Appearance of a Product that is dictated solely by the Product's functional characteristics or functional attributes (*Technical Function*). However, Registered Design protection should not be denied to the Appearance of a Product a *portion* of which is dictated solely by the Product's Technical Function.

The most debated question was how to assess Technical Functionality and in particular, whether the assessment should be based on a single or multi-factor test and what those factor(s) should be. AIPPI resolved that the assessment should include at least whether there is no alternative Appearance for the Product that would obtain substantially the same Technical Function (the so-called "multiplicity-of-forms" test). This test was considered to be the most objective. However, the Resolution acknowledges that in practice additional tests may be necessary. For example, there may be no real alternative where any alternatives are very costly or protected by another intellectual property right. An additional test may be to assess whether the need to achieve the Technical Function of the Product was the only relevant factor when the Appearance of the Product was arrived at.

¹ The Resolution addresses a registered or patented design right, whether or not examined. The protection of "partial designs", i.e., a portion or portions of a whole product, falls outside the scope of the Resolution.

Another debated issue relates to the significance of any portion with technical functionality when assessing the scope of Protection of a Registered Design. AIPPI resolved that in making such an assessment, no visual portion of the Appearance of the Product should be excluded from consideration. This should be the case even if the appearance of any such portion is dictated solely by the functional characteristics or attributes of that portion of the Product. Instead, such portion may be given less weight in the assessment. While the functional characteristics or attributes of such portion should not be protected, all visual aspects of that portion, including size, position and spatial relationship relative to the Appearance of the Product, should be considered when assessing the scope of protection of the Registered Design.

The question of technical functionality of designs is currently very topical, especially within the EU, because a referral for preliminary ruling has recently been made to the Court of Justice of the European Union (C-395/2016).

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