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Study Guidelines

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2018 – Study Question

Partial designs

Introduction

1) This Study Question concerns the protection of partial designs by registered rights. For the purposes of this Study Question:
   a) a Product is an object or article of manufacture;
   b) a 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; and
   c) a Partial Design is a Design for a portion or portions of a whole Product;
   d) the Unclaimed Part of a Product is the part of a whole Product indicated not to be within the Partial Design;
   e) the Surrounding Context of an accused product is the part or parts of the accused product that do not correspond to the Partial Design, i.e. they are outside the Partial Design; and
   f) Design Constraints are defined below in paragraph 48).

2) The objective of this Study Question is to examine issues that arise specifically in connection with Partial Designs.

3) This includes the graphical or other methods used to designate the design as a Partial Design, and methods used to designate the Unclaimed Part.

4) It also includes the scope of protection, i.e. issues that arise in connection with claims of infringement of Partial Designs, and claims of invalidity. The level of novelty required for Partial Designs is a key question, as is the assessment of the overall impression in relation to Partial Designs.

5) Another objective of this Study Question is to examine any exceptions that may apply to Partial Designs, for example, must fit / must match exceptions.
6) A design for a component, which is sold separately (as well as integrated into a whole Product), might be classified as a design for a whole Product instead of a Partial Design. If such a design can only be registered as a design for a whole Product, it may in some cases be open to challenge, as discussed below.

**Why AIPPI considers this an important area of study**

7) In many jurisdictions, copyright protection is not available for industrially applied designs. Protection for industrially applied designs is therefore more routinely obtained by the use of registered design rights / design patents. However, the copying of a part or even a substantial part of a design of an article might not infringe a registered design right. For example, in the EU, the test of infringement is whether the overall impression created by the accused product is not different to the overall impression of the design. If the accused product only has one feature (of several) taken from the registered design, the overall impressions may well be different. This makes it difficult to protect a part of an article as a Design, without a system of protection for Partial Designs.

8) For example, if a wing mirror for a car is copied and used in a different car with a different overall visual appearance, it may be that using the wing mirror is not enough for there to be infringement of a design right for the car. Accordingly, it would be desirable if design rights could be available for Partial Designs. It would also be more straightforward in a commercial context to protect a design for the wing mirror of a car by way of a registered design right, than it would be to seek to rely on copyright or other rights where complex issues can arise. For copyright, this includes issues such as the artistic merit of the copyright work and whether the part copied is a substantive part of the copyright work in qualitative rather than quantitative terms. For unregistered rights in general, a particular disadvantage is that limitations on the rights can only really be discovered / established when the right is asserted, rendering the scope of protection uncertain until such time.

9) There can be commercial value in the protection of parts of a Product (e.g. Partial Designs in wing mirrors, wheels, and other car parts; aesthetic additions to kitchen cabinets, the ornamental ends of an otherwise common bed, the clasp of a watch), and it would clearly be advantageous for Partial Designs to be protected by the same legal rules across many jurisdictions. This would increase legal certainty while lowering costs.

10) Alternative legal regimes for protecting Partial Designs may have significant limitations. For example, in some jurisdictions there are limitations on protecting industrially applied designs using copyright, and it may not be possible to protect Partial Designs with patents if they do not also address a technical problem.

11) Further, in terms of procedure, registered design rights arguably strike a good balance between the scope and duration of protection, speed of obtaining a

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1 In the EU, Council Regulation 6/2002 on Community Designs (CDR) creates a law of designs. This law is in addition to protection given to designs nationally in the EU under national laws.

2 Article 10 CDR.

3 Some jurisdictions, including the UK, recognise an unregistered design right.
registration and the formalities and costs to be expended in obtaining protection. These factors make Partial Designs a good form of protection in fields in which designs change rapidly.

12) Accordingly, by providing industry the flexibility to apply for protection for Partial Designs, a useful form of protection can be secured. It would seem especially beneficial for such rights to be harmonised, proving applicants with a more uniform procedure and with greater predictability as to the rights that can be obtained.

Relevant treaty provisions

13) Article 25(1) of TRIPs provides that:

   Members shall provide for the protection of independently created industrial designs that are new or original. Members may provide that designs are not new or original if they do not significantly differ from known designs or combinations of known design features. Members may provide that such protection shall not extend to designs dictated essentially by technical or functional considerations.

14) Article 26 of TRIPs provides that:

   1. The owner of a protected industrial design shall have the right to prevent third parties not having the owner’s consent from making, selling or importing articles bearing or embodying a design which is a copy, or substantially a copy, of the protected design, when such acts are undertaken for commercial purposes.

   2. Members may provide limited exceptions to the protection of industrial designs, provided that such exceptions do not unreasonably conflict with the normal exploitation of protected industrial designs and do not unreasonably prejudice the legitimate interests of the owner of the protected design, taking account of the legitimate interests of third parties.

15) TRIPS does not expressly envisage protection for Partial Designs, or exclude protection for Partial Designs.

Scope of this Study Question

16) This Study Question addresses the law of designs in the context of Partial Designs.

17) This Study Question is not intended to address:

   a) unregistered design rights;

   b) design rights generally outside the context of Partial Designs, including whether design rights (including Partial Designs) are required to possess aesthetic character;

   c) spare parts as such; issues concerning spare parts are not specific to Partial Designs and may arise generally in relation to designs; or
d) criminal liability for infringement of any rights in relation to designs (including Partial Designs).

Previous work of AIPPI

18) Partial designs were excluded from the study leading to AIPPI's Resolution on "Requirements for protection of designs" (Milan, 2016), hereafter referred to as the Milan Resolution. The background section of the Milan Resolution states:

The protection of "partial designs" (i.e. a portion or portions of a whole product) is outside the scope of this Resolution.

However, the Resolution states at paragraph 6 that:

A Registered Design should protect the Appearance\(^4\) of a Product\(^5\), but should not protect separately or independently any constituent visual portions of that Appearance.

19) Thus, the design of any parts or visual portions of a Product is not to be protected by a registered design for that entire Product. Separate protection would need to be sought for Partial Designs.

20) Other Resolutions have touched on this area less directly:

a) Resolution on Q231 – "The interplay between design and copyright protection for industrial products" (Seoul, 2012).

b) Resolution on Q148 – "Three-dimensional marks: the borderline between trademarks and industrial designs" (Boston, 2008).

c) Resolution on Q108A – "Protection of designs and models in the EC" (Tokyo, 1992).

d) Resolution on Q108 – "Improvement of international protection of designs and models" (Lucerne, 1991).

e) Resolution on Q73 – "Legal and Economic Significance of Protection by Designs and Models" (Moscow, 1982).

f) Resolution on Q34 – "International protection of works of applied art, designs and models" (London, 1960).

This Resolution states:

The appearance of an industrial object may be protected as a design; this appearance may result among other things from an assembly of lines, from the shape of the article itself or from its ornamentation.

\(^4\) Overall visual appearance (including ornamentation).

\(^5\) Defined in the same way is for this Study Question, i.e. an object or article of manufacture as a whole.
Discussion

Working assumptions and necessity for Partial Designs

21) Taking as an example the design of a handle for a pan, shown below (referred to as D1), the parts of the design that are "claimed" can be shown with solid lines and the parts that are not claimed (i.e. the Unclaimed Part) could be shown with dashed or dotted lines:  

22) One could ask why the design registration could not just as easily have been for the handle, as shown below (referred to as D2):

23) In D2, the proximal end of the handle (indicated by the arrow) is not depicted. One might argue that this portion should be completed, either in solid lines or dotted lines. However, this raises another issue of whether a portion of a Product that is not visible in normal use should nevertheless be depicted in the Partial Design, if it is permissible to depict Partial Designs as is done in D2.

24) If the test for infringement requires the accused product to be a complete article sold on its own, or if to be registrable a design has to be for a complete Product, D2 is not an advantageous form of protection unless handles are sold separately, which they might be if the attachment mechanism for handles allows the same handle to be used on a pan or a sieve. This was reflected in the Milan Resolution, paragraph 1 of which states:

*Design protection should be available, by way of registration, to protect the overall visual appearance (including ornamentation) … of an object or article of manufacture as a whole.* [emphasis added]

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6 Some jurisdictions do not permit this drafting convention. Other jurisdictions adopt different drafting conventions. In Argentina, for example, dotted lines are used for the CLAIMED portions, while solid lines are used for the UNCLAIMED portions.
On this basis, D2 would not be suitable for protecting a Partial Design, unless D2 is in fact the Product as a whole.

25) It would also lead to the undesirable situation in which the incorporation of something that looks like D2 into another design, perhaps as just an incidental, ancillary or small and insignificant component, would create a question as to whether D2 is infringed. For example, the design of a nut and bolt could be independently registrable, since nuts and bolts are products that are sold separately. However, if nuts and bolts are used in the construction of a different Product, is the design registration for nuts and bolts infringed?

26) A further question is whether D1 has the same legal effect, from an infringement and validity perspective, as a registration for a pan and a handle with all components drawn in solid lines. AIPPI’s position on this question, as per the Milan Resolution (at paragraph 6), is that a registered design should protect the appearance of a whole Product, but should not protect separately or independently any constituent visual portions of that appearance.

27) Accordingly, there are two working assumptions for this Study Question:

a) registered designs protect the appearance of a Product (being an object or article of manufacture as a whole – howsoever that “whole” is characterised);

b) registered designs do not protect separately or independently any constituent visual portions of the design for a “whole” Product.

28) It follows that it is necessary to protect the design of portions of the appearance of an object or article of manufacture with separate registrations, and these registrations should in some way indicate what object or article of manufacture of which they are part. Since the focus of a design right is what the design looks like, a graphical indication appears desirable. Another issue is whether a registration of a Partial Design should in some way describe, in writing, what Product it is a part of, and if that is the case, how it should be indicated, e.g. "a pan" or "a handle of a pan".

A whole Product / spare parts

29) A spare part is necessarily not the whole Product, and a design for a spare part could therefore be classified as a Partial Design. However, spare parts can be sold without the rest of the Product, and often many years after the Product as a whole has been sold.

30) In some jurisdictions, if the design (together with any Unclaimed Part) is not for a whole Product that is sold separately, the design could be considered invalid. In these jurisdictions, if a design is registered or sought to be registered for something that is not a whole Product, then there is the possibility that the registration may later be revoked. To alleviate this risk, it may be desirable in these jurisdictions to register a Partial Design that shows what the Unclaimed Part is. The Partial Design, together with the Unclaimed Part, indicates the whole Product.

7 For example, in the EU in the case of registered designs, and similar considerations arise in the context of unregistered designs under UK law.
31) When the court assesses whether the design, together with any Unclaimed Part, is for a Product that is sold separately, that assessment could take into account just the design as shown and any Unclaimed Part, and/or whether the accused product is in fact sold or advertised separately. The latter factor suffers from the disadvantage that it depends on a question of fact that will not be evident from the design registration itself.

32) Under EU law, replaceable component parts of complex products composed of multiple components can be protected by registered designs if they are visible when in normal use\(^8\), and subject to must fit / must match / functionality-driven design constrains as discussed below. Thus, replaceable spare parts which are not visible in normal use are in principle not protectable as Partial Designs, unless those spare parts are whole Products sold separately and possibly used for different purposes.

### Representation of Partial Designs

33) Graphical representation is a key element. In Procter & Gamble Co v Reckitt Benckiser (UK) Ltd [2008] FSR 8, Jacob LJ noted:

> The most important things in a case about registered designs are: (1) the registered design; (2) the accused object; and (3) the prior art. And the most important thing about each of these is what they look like.

34) Common methods of indicating the scope of the Partial Design include the use of dashed or dotted lines indicating those parts that are not part of the Partial Design, and with the description indicating the context into which the Partial Design fits. Shading and/or colouring may also be used, which may be beneficial where the "blank spaces" in dashed or dotted lines create breaks in the visual appearance of the design.

35) In the case of a design for a whole article, complex sub-issues can arise, such as whether the design can validly include non-contiguous elements that are physically separated (i.e. two separate elements that are "floating in space"). However, that appears less problematic for Partial Designs if the Unclaimed Part marked in dashed lines links non-contiguous elements.

### Infringement and validity

36) In EU design law, there is infringement if the overall impressions created by the design in question and the accused product are not different\(^9\).

37) A registered design can be revoked for lack of novelty\(^10\) or lack of individual character\(^11\). A design, in short, lacks novelty if it is found in the same form in the prior art, and lacks individual character if the overall impressions created by the design and

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\(^8\) Article 4(2) CDR. See also the opinion of the Advocate General of 28 September 2017 in joined cases C-397/16 (Acacia v Audi) and C-435/16 (Acacia v Porsche).

\(^9\) Article 10 CDR.

\(^10\) Article 5 CDR.

\(^11\) Article 6 CDR.
a prior art design are not different. In other words, if the prior art would infringe the
design, then the design is not valid.

38) Under EU law, this focuses the analysis on the overall impression test, both for
infringement and validity. For Partial Designs, this means that the Surrounding
Context in the accused product / Unclaimed Part in the design asserted complicates
the analysis.

39) As an example, if the accused product and prior art were a sieve (not used for frying,
but used for draining water out of foods) with the same handle, how would that impact
the analysis? This is shown below, first unshaded, and also with the Surrounding
Context (the sieve itself) shaded in light blue (D3):

![Sieve Diagram](image1)

40) D3 has the handle of the Partial Design D1, but the Surrounding Context for the
handle is different. The Surrounding Context in D3 is the sieve instead of the pan.

41) It could be said that if D3 infringes D1, then D3 should also deprive D1 of novelty if
D3 pre-dates D1.

42) Similarly, Unclaimed Parts (being the pan and the sieve respectively) could play a
critical role when assessing the overall impressions of D1 and D3. If those Unclaimed

Parts are not taken into account, the overall impressions of the two handles would be 100% the same. However, if the Unclaimed Parts are taken into account, it is no longer clear that the overall impressions would be close.

43) Under Japanese law, although the Unclaimed Part is not part of the registered design, the Unclaimed Part could still be considered in the context of assessing infringement and validity, in a sense that one must refer to the Unclaimed Part in order to determine the purpose of use and the function of the claimed design and also to determine the location, size and scope of the claimed design in relation to the entire article12.

**Must fit / must match / technical function**

44) The design freedom of a designer can be limited or constrained. For example, this may be the case if a product must fit or connect to another product, or if there is a technical or other reason driving the design in a particular direction.

45) “Must fit” refers to the situation where a component must be mechanically connected to or placed in, around or against another product so that either product may perform its function13. However, under EU law, a design serving the purpose of allowing the multiple assembly or connection of mutually interchangeable products within a modular system is considered not to fall within the “must fit” exception14.

46) “Must match” refers to the situation where the appearance of a Partial Design must match the appearance of other parts of the Product of which the Partial Design forms part.

47) The design of a component may also be constrained if the component performs a technical function.

48) In these Study Guidelines, the constraints on design freedom arising from must fit / must match / technical function are referred to as **Design Constraints**. Spare parts are a key example of designs frequently constrained by Design Constraints. A car door mirror must connect to a car by fitting into the relevant connector, and must also have a mirror which performs a technical function by reflecting light. The mirror body must be aerodynamic and durable. However, other aspects of the shape of the mirror body may not be as constrained, and there could be several different shapes which are aerodynamic, one of which is picked as a design15.

49) Design Constraints are relevant when considering the amount of notional "artistic input"16 that has gone into a design. For example, if there is a technical requirement that electrical systems must connect with 2-pin plugs and sockets, not much artistic

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12 IP High Court judgment dated 31 January 2007 (Case No. 2006 (gyoke) 10317, Tokyo District Court judgment dated 15 May 2015 (Case No. 2014 (wa) 12965)).

13 Article 8(2) CDR.

14 Article 8(3) CDR.

15 This leads to the “multiplicity of forms” argument under EU law that the mere existence of different design options does not mean that a feature is not functional, and if every possible design variant is driven by functional constraints, they must all be excluded on the ground that they are functional.

16 Under EU law, the aesthetic merit of a design is not relevant as such, but it is relevant to consider whether "other" considerations have driven the design, instead of functional or other excluded considerations.
input will have been expended when deciding to use 2 pins in a design for a plug. This informs the scope of protection, which could be said to be broader when the designs are not constrained, but narrower when the designs are constrained. Where the design freedom is great and the design is not totally constrained, it possible to incorporate non-constrained or aesthetic features.

50) Under EU law\textsuperscript{17}, the assessment will be an objective one to determine if the design is driven exclusively by Design Constraints, or whether there are features that are entirely non-constrained or a mixture of constrained and non-constrained. However, the actual designer's thoughts, and whether there was a conscious effort to introduce aesthetic features when creating the design, may also be relevant\textsuperscript{18}.

51) Design Constraints may also be relevant if the constrained features are excluded from the scope of the design.

52) At paragraph 7 of the Milan Resolution, AIPPI resolved that:

\begin{quote}
In the assessment of the scope of protection of a Registered Design, no visual portion of the Appearance of the Product should be excluded from consideration, even if the appearance of any such portion is dictated solely by the functional characteristics or functional attributes of any such portion of the Product, but such portions may be given less weight in the assessment.
\end{quote}

53) Articles 8(1) and 8(2) of the European Regulation on Community Designs (Council Regulation (EC) No 6/2002) provide that:

\begin{enumerate}
\item A Community design shall not subsist in features of appearance of a product which are solely dictated by its technical function.
\item A Community design shall not subsist in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either product may perform its function.
\end{enumerate}

54) The Board of Appeal's approach in \textit{Nintendo} was to explain that Article 8(1) denies protection to features of the design solely dictated by function. Thus, under \textit{Nintendo}, while features dictated by Design Constraints in the design should not receive protection, they will still need to be taken into account, at least to some extent, when

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\textsuperscript{17} \textit{Nintendo} R 1772/2012-3, Board of Appeal, 14 April 2014 (\textit{Nintendo}). If a feature having a functional purpose is not entirely functionally driven, it may not be excluded as functional. This can be a response to the multiplicity of forms argument, but immediately leads to the question of what other drivers a design has, and in particular whether a level of aesthetic design is required for a feature to not be entirely functional. This question applies more generally to designs and not specifically to Partial Designs. It is therefore not addressed in this Study Question.

\textsuperscript{18} See the opinion of the Advocate-General in \textit{Doceram} (C-395/16): “It is not impossible that criteria which, in my view, cannot in themselves show that features of appearance of a product have been dictated solely by its technical function within the meaning of Article 8(1) of Regulation No 6/2002, such as the subjective intention of the designer or the existence of alternative forms, may nevertheless be included in the body of specific evidence which courts must take into consideration in order to form their own opinion regarding the application of that provision.”
assessing the scope of protection of the design and therefore also when assessing overall impressions19.

55) By way of contrast, this piecemeal approach, whereby individual features of an overall design are denied protection, is contrary to the laws of other jurisdictions. For example, in the United States, the Court of Appeals for the Federal Circuit has repeatedly ruled that it is legal error to eliminate any portions of the claimed design from its scope of protection20.

56) In the context of Partial Designs, the design constraint may come from outside the design itself, i.e. from the Unclaimed Part. This can also be seen from D1: the pan handle fixes into the pan and the fixing mechanism is driven at least to some extent by technical considerations that come from the Unclaimed Part.

57) When the same handle is used for a sieve in D3, which has a very thin rim, the handle must be fixed on in some other way – not the same way as to the pan. A question that arises is whether Design Constraints that flow from an Unclaimed Part, should be taken into account when assessing the scope of protection, and in the case of D1 and D3, whether it would be right to take Design Constraints into account that arise from D1 when the same constraints do not arise in the accused product D3.

You are invited to submit a Report addressing the questions below. Please refer to the 'Protocol for the preparation of Reports'.

Questions

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.

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

   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?

19 Strictly speaking Article 8(1) states that design rights do not subsist in functional features. If the correct legal approach is to exclude all functional features, conceptually they could still be taken into account when considering the overall impression of the accused product since they are present in the accused product even if they do not form part of the design. Similarly, conceptually they could be taken into account when considering the overall impression of the design, in the same way that the Unclaimed Part might be taken into account.

20 Sport Dimension, Inc. v. Coleman Co., 820 F.3d 1316 (Fed. Cir. 2016) ("By eliminating structural elements from the claim, the district court improperly converted the claim scope of the design patent from one that covers the overall ornamentation to one that covers individual elements. Here, the district court erred by completely removing the armbands and side torso tapering from its construction."); see also, Ethicon Endo-Surgery, Inc. v. Covidien, Inc., 796 F.3d 1312 (Fed. Cir. 2015) (rejecting arguments that any portions of the overall design should be excluded from design’s overall scope of protection; Apple, Inc. v. Samsung Electronics Co. 786 F.3d 983 (Fed. Cir. 2015) (refusing to eliminated features of the overall appearance of a design right on the basis that the feature was purely functional.)
b) Is there a written description of the Product, of which the Partial Design forms part?

c) Can verbal disclaimers be used? 21

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.

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.

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.

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.

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

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

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

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:

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

b) whether the Product is normally sold separately?

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?

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?

13) Is harmonisation of the law of Partial Designs desirable?

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21 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.
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.

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.

   a) SC is the same as UP
   b) SC is not the same as UP, but SC and UP relate to products that are used in the same way
   c) SC is not the same as UP, but SC and UP relate to products that look the same
   d) SC is not the same as UP, but SC and UP relate to products that categorised in the same way when registering designs
   e) SC is not the same as UP, and SC and UP are entirely unconnected.

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.

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.

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.
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

Protection is granted to partial designs in Argentina, as this is allowed by the current practice and is not barred either by the statute (decree-law No. 6673/63) or the implementing regulations.

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

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

Parts not included in the Partial Design are indicated by dotted or dashed lines.
### 2.b Is there a written description of the Product, of which the Partial Design forms part?

Yes

**Please Explain**

Description is not mandatory in Argentina. In those cases where a description is provided, some are drafted in detail, some provide a very short description, and finally some only list the drawings.

### 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**

Verbal disclaimers may be used.

### 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**

This situation is governed by div 19 of decree-law No. 6673/63 according to which “[t]he owner of an industrial model or design may bring a legal action against whomsoever, without the owner's authorization, exploits industrially or commercially, with regard to the same or different products, a registered design or imitations thereof”. In this question the infringer is using the registered design of a Partial Design of Product X “with regard to (…) different products”, i.e. Product Y. This reply assumes that the expressions “Product X” and “Product Y” refer to two different objects, as for instance a soccer ball and a pencil sharpener, where the pencil sharpener takes the shape of the soccer ball protected by a registered design.

### 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**

Here the answer depends on the specific facts of the case. If the products involved are different and the younger product took some part of an older product, but the products are different, then novelty probably will not be compromised and the design registration for the younger product may well be valid. Case law has held that the fact that isolated elements of the design are anticipated is irrelevant if the combination is not anticipated (Federal Court of Appeals, Division 2, June 3, 1998, case No. 19,500/95, "Colorín Industria de Materiales Sintéticos S.A. v. Driganí Mario Héctor").

### 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.

The statute does not address this situation, as it merely states that "those models or designs publicly exploited or published in the country or
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

It would probably be advantageous to amend the statute to address the situation set forth in question 5).

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

No

Please Explain

Since description of designs, whether partial or not, is voluntary, there are practically no rules on this point. On the other hand, the existing guidelines on drawings are quite unsatisfactory. In Argentina we have a very confusing regulation issued in 1974 (Regulation No. 21/74 issued June 26, 1974) which, in this connection, provides as follows:

“Drawings and references shall be made with one ink only (black, Indian ink). Where appropriate, parts already known and in the public domain shall be illustrated in a broken or fine line, to distinguish it correctly from the novel part, which shall be highlighted.” (…)

“If embodiments are submitted of the model or design illustrated in the first sheet include details which modify the appearance of the basic model or transform it into another product, the edited part shall be drawn with a fine or dotted line to distinguish it correctly from the basic model, as is established for models or designs which complement parts belonging to the public domain.”

Accordingly, variations of the basic design must be illustrated with a fine or dotted line, which is counterintuitive. New guidelines are expected to be issued some time this year.

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

Yes

Please Explain

The unclaimed part may influence the protection of the claimed parts insofar as the former defines the context of the latter. It is not possible to rule out this influence ex ante.

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

No

Please Explain

The concept of “design constraints” does not exist in Argentina, either in the statute, case law, authors’ opinions, or day-to-day practice.
### 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:

- the design as shown and any Unclaimed Part; and/or  
- whether the Product is normally sold separately?

**Yes**  
Please Explain

Both circumstances should be taken into account when assessing whether the design is Partial Design, as they will help to make a better decision.

### 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

### 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

**13. Is harmonisation of the law of Partial Designs desirable?**

**Yes**  
Please Explain
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.

The same rules should be applied to a Partial Design as are used to specify, describe and depict a regular design, i.e. a design for the whole product.

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.

15.a SC is the same as UP

Under the broad terms of div 19 of decree-law No. 6673/63 (transcribed above in the reply to question 3), it is likely that in the situations a) through e) shall issue a finding of infringement.

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

Under the broad terms of div 19 of decree-law No. 6673/63 (transcribed above in the reply to question 3), it is likely that in the situations a) through e) shall issue a finding of infringement.

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

Under the broad terms of div 19 of decree-law No. 6673/63 (transcribed above in the reply to question 3), it is likely that in the situations a) through e) shall issue a finding of infringement.

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

Under the broad terms of div 19 of decree-law No. 6673/63 (transcribed above in the reply to question 3), it is likely that in the situations a) through e) shall issue a finding of infringement.
through e) shall issue a finding of infringement.

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

Under the broad terms of div 19 of decree-law No. 6673/63 (transcribed above in the reply to question 3), it is likely that in the situations a) through e) shall issue a finding of infringement.

**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.**

In Argentina the language of div 19 of decree-law No. 6673/63 (transcribed above in the reply to question 3) addresses adequately this situation.

**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.**

Not applicable in Argentina, where the concept of “design constraints” does not exist.

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

We have no additional comments here.

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

Packages, machines (valves), cleaning products, oil.
Study Question

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

Yes, protection is given to Partial Designs. The laws for protection of partial designs are not different to the laws for protection of designs generally. That is, there is no separate legislation relating to Partial Designs as opposed to designs generally.

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

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

Partial Designs can be specified by different means including by graphical indication. Thus, dotted or dashed lines can be used to identify components which are not included in the Partial Design.
2.b Is there a written description of the Product, of which the Partial Design forms part?

Yes

Please Explain

Design registration applicants have the option of filing a “Statement of Newness and Distinctiveness” in order to provide a written description of those parts of the design shown in the design drawings, that the applicant considers to be new and distinctive. This has the effect of attaching greater importance to some part of the design over other parts, and can have the effect of disclaiming parts of a design. By this statement, a Partial Design can be created despite that the drawings filed in the application for design registration show a full or complete design.

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

The Statement of Newness and Distinctiveness can be used to disclaim certain parts of a design. For example, in design registrations for automotive vehicles, the Statement of Newness and Distinctiveness is often used to disclaim parts of the vehicle, such as the wheels and tyres, so that no importance is placed on those parts when considering the scope of monopoly of the design registration.

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

Potentially Yes. The title (i.e. product name) of a design registration limits the type of product to which infringement applies, and so in relation to the examples of D1 and D2 earlier, a registration for the handle shown in combination with a pan, might be considered a “handle for kitchen implement” or a “Pan Handle” or the like. Either of these titles/product names would limit the scope of the design registration to use of the handle in a particular field, i.e. the kitchen utensil field, and so use of the handle say in an automotive context would not be an infringement. Usually, the AU Designs Office requires the field of use of the product to be indicated in the title/product name.

Otherwise, use of the handle of D1 and D2 in respect of a pan or sieve would be an infringement of the design registration as long as the pan or sieve was excluded in some way to create a Partial Design for the handle (i.e. through mechanisms such as dotted or dashed lines and/or in a Statement of Newness and Distinctiveness).

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

Whereas infringement is determined in relation to the “product” that is registered, validity is determined in relation to the “design” that is registered. Further, the Australian designs legislation defines a design “in relation to a product” as meaning “the overall appearance of the product resulting from one or more visual features of the product”. The reference to “one or more” indicates that the “design” may be in respect of just one feature. Hence, if this same one feature forms part of the prior art base, then there is an argument that the particular prior art may be used to challenge the novelty of the design. However, there is also a requirement for the design to be “in relation to a product”, and also that the one or more visual features are “of the product”. Thus, if the product of the prior art is different and/or the product of the partial
II. Policy considerations and proposals for improvements of your Group’s current law

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.

In general, no. Whilst Australia does not allow for the enforcement of design rights for “spare parts” (i.e. a component part used for the purpose of repair), Australia also does not specify a must fit/must match exception. Indeed, in Australia purely functional designs are registrable.

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

No

Please Explain

In relation to Partial Designs, there is a potential tension between scope (for infringement) and validity. However, that tension is likely to be resolved through the courts, on a case-by-case basis, rather than requiring legislative intervention. The choice of product name, the use of dotted or dashed lines and the Statement of Newness and Distinctiveness each help to facilitate protection for Partial Designs in a manner that is well understood.

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

Yes

Please Explain

The ability to specify a Partial Design in the product name, Statement of Newness and Distinctiveness, and the use of dotted or dashed lines provide satisfactory ways of establishing a Partial Design.

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

Yes

Please Explain

Yes. The unclaimed part does influence the scope of a design registration to the extent that it contributes to the definition of the product in respect of which the design is registered, and thus establishes the field or area of the design. However, the specific shape of the unclaimed part should not unduly influence or limit the scope of the design registration.
### 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

13 Is harmonisation of the law of Partial Designs desirable?

Yes

Please Explain

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.

The Partial Design and the Unclaimed Part can be appropriately specified in words and by graphical depictions in the drawings. Through these two mechanisms, Partial Designs can be appropriately identified and protected. The Unclaimed Part should be considered as identifying the general field or area of the design registration (e.g. the product in respect of which the design is registered) but should not otherwise be considered as restricting the scope of the design registration.

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.

15.a SC is the same as UP

The Australian Group position is that in relation to the Partial Design for the handle of a pan, where the pan itself is unclaimed, the handle should be freely adopted in other like parts, i.e. kitchen utensil parts, without the pan unduly influencing the scope protection of the handle in the field of kitchen utensils. Based on this understanding, in this circumstance, there would clearly be infringement of the partial design by the accused product.

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

...
In this case, as explained above, given that the products are used in the same way and providing that the product name is not unduly restricted, there should still be infringement, with the differences between the SC and UP being irrelevant.

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

In this case, as explained above, given that the products look the same and providing that the product name is broadly specified, there should still be infringement, with the differences between the SC and UP being irrelevant.

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

In this case, as explained above, given that the products are used in the same way and providing that the product name is not unduly restricted, there should still be infringement, with the differences between the SC and UP being irrelevant (i.e. in Australia, the classification/categorisation does not restrict scope).

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

In this case, the Partial Design registration will be in a different field or area to the accused product and therefore there will most likely be no infringement of the registered design by the accused product.

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.

The unclaimed part should only be taken into account when determining the product to which the design relates (i.e. a product name should be adopted that is not inconsistent with the unclaimed part of the registered design), so that an infringement of the registered design only occurs in relation to products in respect of which the design is registered.

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.

Design Constraints arising from the Unclaimed Part should not affect a Partial Design. In particular, must fit/must match Design Constraints should not affect Partial Designs.

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

No additional issues come to mind at this stage.
Please indicate which industry sector views are included in your Group’s answers to Part III.

Patent attorney views only.
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.

No

Please Explain

There is no protection for Partial Design in Belarus.

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

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?

2.b. Is there a written description of the Product, of which the Partial Design forms part?
II. Policy considerations and proposals for improvements of your Group's current law

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.

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.

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.

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.

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

No

Please Explain

There are no possibility to protect Partial Design in Belarus. It should be added.

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

No

Please Explain

No way of specifying, describing or depicting Partial Designs in the Belarusian Patent Law.

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

Yes

Please Explain

No practice in Belarus.
### III. Proposals for harmonisation

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

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

No

Please Explain

To stimulate industrial designs creators.

**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:

- the design as shown and any Unclaimed Part; and/or
  
  Yes
  
  Please Explain

- whether the Product is normally sold separately?
  
  Yes
  
  Please Explain

**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

**III. Proposals for harmonisation**

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

Yes

Please Explain

**13** Is harmonisation of the law of Partial Designs desirable?

Yes

Please Explain

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

The components that are not included in the Partial Design are to be shaded. The name of the design should contain design’s function.

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.

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

This variant is the most sensible.

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

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.

When analysing the overall impression of a Partial Design for both individual character and infringement, the design class (e.g. Locarno class) of the Partial Design and the function of the accused product are to be taking into account.
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.

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

There is no possibility to claim a Partial Design in Belarus.

"An industrial design eligible for legal protection under the Law shall be construed as an artistic, or both artistic and technical, solution that determines the outward appearance of an article and that is novel and original. The article shall be held to be an industrial or handicraft object. The scope of the legal protection conferred by an industrial design patent shall be determined by the sum of its essential features as shown in the graphic representations of the article."

In the practice we need Partial Design for example for protecting designs for puppets with huge heads. The head of the puppet is original and novel but its body should be depicted as the Unclaimed Part as the applicant does not want limit protection by specific clothes and limbs. The head of the puppet is not sold separately, thus it cannot be protected as a design of the whole product. Meanwhile it defenetely dominates in the overall impression.

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

Toy industry.
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 Belgium, two legal regimes may apply to registered designs: (i) the Benelux Convention on intellectual property (hereafter “BCIP”), implementing i.a. the Directive 98/71/EC on the legal protection of designs (hereafter “Community Design Directive” or “CDD”) in Benelux law and (ii) Council Regulation 6/2002 on Community Designs (hereafter “Community Designs Regulation” or “CDR”).

None of these legal regimes provide for a separate legal framework for partial designs. In other words, partial designs can be protected pursuant to the BCIP or CDR but will fall under the general regime for design rights.

In general, and as discussed in the Belgian group AIPPI report in 2016, protection is granted to the appearance of the whole or a part of a product, which appearance results from the features, in particular the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation (Article 3.1 BCIP, Article 3.a CDR and Article 1.a CDD).

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

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, generally the features of a registered design which are disclaimed (and thus disregarded for the purposes of the validity and the infringement assessment) are indicated with dotted or broken lines. The EUIPO’s guidelines (although they are not binding) state that the features of a Community Design represented with dotted lines, boundaries or colouring or in any other manner make clear that protection is not sought in respect of such features[1].

Section 5.3 of the Examination Guidelines of 10 October 2017 states the following:

“5.3 Use of visual disclaimers to exclude features from protection

[...]

Use of a description, within the meaning of Article 36(3)(a) CDR, is not appropriate in this regard since a description ‘shall not affect the scope of protection of the design as such’ according to Article 36(6) CDR. Moreover, only an indication that a description has been filed is published, not the description as such (Article 14(2)(d) CDIR).

Disclaimers must therefore be apparent from the representation of the design itself.

In accordance with the Common Practice (CP6), visual disclaimers indicate that protection is not being sought, and registration has not been granted, for certain features of the design shown in the representation. Thus, they indicate what is not intended to be protected. This can be achieved:

- by excluding with broken lines, blurring or colour shading the features of the design for which protection is not sought; or

- by including within a boundary the features of the design for which protection is sought, thus making it clear that no protection is sought for what falls outside the boundary.”

This approach to dotted lines and unclaimed parts of a design has also been confirmed by some Benelux courts[2] as well as the General Court in its decision of 14 June 2011 with respect to a watch attached to a lanyard[3]. Also the Benelux Office explicitly states on its website that visual disclaimers can be used. With respect to a drawing, dotted lines are capable of showing elements that do not form part of the design. With respect to photographs, these elements in the photo can be blurred[4].

However, not in all circumstances do the dotted lines refer to the disclaimed part of a registered design.[5]

Footnotes

1. ^ EUIPO “Guidelines for examination in the Office for Harmonization in the Internal Market (trade marks and designs) on registered community designs: Examination of Design Invalidity Applications”, p. 35-36.

2. ^ President Court The Hague 8 July 2015, IEFbe 1425 (Kind Group tegen JPMC) and President Court Overijssel 22 February 2016, ECLI:NL:RBOVE:2016:600 (Modelrecht gedecoreerde klompen).


5. ^ GCEU, 28 January 2015, T?41/14, Argo Development and Manufacturing Ltd / OHIM and Clapbanner Ltd, para 59: “The applicant’s argument that the handles are in the same place in the designs at issue is manifestly not well founded in so far as, inter alia, the handle in the contested design is represented as a line of perforations to be pressed out, whereas the handle is attached in the earlier designs.”

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

No
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Not necessarily, but it is possible.

2. 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 under art. 36 (3)(a) CDR for “explaining the representation or the specimen”, although such information “shall not affect the scope of protection” (Article 36 (6) CDR).

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

As the Belgian Group is of the opinion that the assessment of infringement of a registered design and the assessment of novelty and individual character of the design at issue compared to a prior design are the two sides of the same coin, questions 3 and 4 will be considered together.

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

The response to questions 3 and 4 depends first of all on the applicability of the so-called speciality principle in design law, according to which the validity assessment and the scope of protection of a given design are restricted to the same product or at least to the products belonging to the same sector as the product(s) as those indicated by the application or registration.

In its recent Groupe Nivelles judgment, pronounced on 21 September 2017, the E.U. Court of Justice stated in that respect and a.o. the following:

“96 In such circumstances, the General Court was right to hold in paragraph 116 of the judgment under appeal that, having regard to the interpretation of Articles 10, 19 and 36 of Regulation No 6/2002, a Community design cannot be regarded as being new, within the meaning of Article 5(1) of that regulation, if an identical design has been made available to the public before the dates specified in that provision, even if that earlier design was intended to be incorporated into a different product or to be applied to a different product. The fact that the protection granted to a design is not limited only to the products in which it is intended to be incorporated or to which it is intended to be applied must therefore mean that the assessment of the novelty of a design must also not be limited to those products alone.

129 In addition, as follows from paragraphs 98 to 103 of this judgment, the ‘sector concerned’, within the meaning of Article 7(1) of Regulation No 6/2002, is not limited to that of the product in which the contested design is intended to be incorporated or to which it is intended to be applied. If”

Nevertheless, the Court did not rule on the question whether the sector concerned is relevant for the purpose of assessing the individual character, within the meaning of Article 6 of Regulation No 6/2002, of a design.

The CJEU essentially based its decision on the text of Article 36 (2) and (6) CDR, titled “Conditions with which applications must comply”, which provides:
II. Policy considerations and proposals for improvements of your Group's current law

AIPPI 2018 - Study Question - Partial designs

2. The application shall further contain an indication of the products in which the design is intended to be incorporated or to which it is intended to be applied.

[…]

6. The information contained […] in paragraph 2 […] shall not affect the scope of protection of the design as such.”

This Article was viewed by the Court as excluding the application of the speciality principle, given that any information on the products in which the design is intended to be incorporated (and thus the category of products or the sector concerned) shall not “affect” the scope of protection of the design as such.

Hence, in the hypothesis of questions 3 and 4, both products X and Y should be considered, irrespective their natures. Product Y shall not be disregarded for determining whether the partial design incorporated in product X is infringed by its use on, or is regarded as not novel in view of, said product Y.

Footnotes


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.

Yes, as with all designs, the context, i.e. the industrial sector, product category and purpose, is relevant when assessing the Design Constraints of partial designs.

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. The Belgian Group is of the opinion that the abandonment of the so-called speciality rule constitutes a negative development of EU design law as an industrial property law, a development whereby the latter comes closer to a copyright protection system (where the scope of protection is not limited by the nature of the products) and loses its specificity and usefulness for the design creators and users.

Although not legally binding, recital 14 in the preamble of the CDR should have been given greater consideration and weight in the interpretation of said regulation: “The assessment as to whether a design has individual character should be based on whether the overall impression produced on an informed user viewing the design clearly differs from that produced on him by the existing design corpus, taking into consideration the nature of the product to which the design is applied or in which it is incorporated, and in particular the industrial sector to which it belongs and the degree of freedom of the designer in developing the design” (own emphasis).

Furthermore, art. 36 (6) could have been interpreted as meaning that the information referred to (art. 36 (2) and (3) (a) and (d)) shall not affect the scope of protection in the sense that (i) the representation as such of the design (art. 36 (1)(c)) remains the decisive basis for validity and infringement assessments, and (ii) the notion of the informed user is not limited to the specific products mentioned and the classification but can extend to the sector in which the user is knowledgeable.

From a policy point of view, it should be stressed that absent a speciality rule, it will become more difficult to obtain a valid design protection. Indeed, all shapes, forms and appearances of products in all sectors whatsoever will constitute novelty and individual character destroying prior art. For example, the registration or commercialisation of a pan handle for cooking utensils will prevent the design registration of a similar shape for a door handle, a spectacle case or a chocolate bar (which however might have a novel and individual character for that type of
products). In turn, the larger protection resulting from the absence of a speciality rule means that once (and if) a design is recognised as valid, the scope of protection is not limited while such extended protection is very often not needed. The abandonment of the rule makes the protection far more difficult to obtain and, if admitted, generally extending far beyond the actual need of the creator or the proprietor/user. It should be also stressed in that respect that if there is a need for a protection for multiple kinds of products, registration can be sought for in respect of each of them (apart from other legal ways of protection, e.g. copyright, with a more or less similar effect: see art. 96 CDR).

One can legitimately wonder whether such abandonment, and consequently the difficulty in obtaining design protection and the broader risk of infringing a prior design right, comply with the purposes of CDR as worded in its recitals 7 and 8, in particular “a more accessible design-protection” and the encouragement of the “innovation and development of new products and investment in their production”.

Legal certainty would be better served by a system whereby the nature of the products at stake in taken into account.

This would also be also more coherent with the concept of informed user (who is not an average consumer, on the one hand; and nobody can be informed in all domains, on the other hand) and the statutory exclusion of features solely dictated by the technical function (art. 8 CDR), the verification of which should primarily consider the nature of the product(s) claimed.

The previous approach in Benelux design law, where the speciality principle was applied (although perhaps in a somehow too strict manner), is preferred.

Therefore, most members of the Belgian Group adhere to the application of the speciality principle, thus requiring the partial design to be examined in consideration of the type of product X as regards its function and purpose, or at least its sector, for the assessment of the novelty (and individual character) in front of a prior product Y or the infringement by a later product Y.

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

No

Please Explain

No, the meaning of dotted lines should be clarified in the statutory texts and case law.

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

Yes

Please Explain

Yes, the Belgian Group in its majority recommends that registered design rights remain linked to their industrial application, their function and destination and thus the application of the speciality principle (for the reasons explained here above), general and this also in case of Partial Designs.


Yes

Please Explain

Yes, there is no reason to treat Partial Designs differently from designs for a whole product (except for spare parts, which are outside of the scope of this report).

### 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:


III. Proposals for harmonisation

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

<table>
<thead>
<tr>
<th>Question</th>
<th>Answer</th>
<th>Explanation</th>
</tr>
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<tbody>
<tr>
<td>10.a</td>
<td>the design as shown and any Unclaimed Part; and/or</td>
<td>Yes</td>
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<tr>
<td></td>
<td>Please Explain</td>
<td>This question is irrelevant to the extent that Partial designs and Designs are assessed in a similar manner, given that the requirements for protection are identical. The Belgian group is in favour of keeping this system.</td>
</tr>
<tr>
<td></td>
<td></td>
<td>The Belgian group recommends adopting a clear definition of “Product” and “Partial Design” in relation to the products considered. In its view, a Partial Design may be limited to those portions of a product that are not normally sold separately. The group suggests that definition not be limited to sales (which is a commercial term) and to cover any separate use. To the extent the (partial) design can be separated from the Product, it may in itself be considered as a design of a Whole Product and registered as such. Alternatively, where the Partial Design constitutes an inseparable part of a Whole Product, it should clearly indicate (by means of dotted lines and/or the context given in the description of the registration) the Product in which it is incorporated.</td>
</tr>
<tr>
<td></td>
<td></td>
<td>The question then remains whether that indication will be taken into account for determining its function, its validity and any infringement thereof. The Belgian group believes that it should. In the example of the pan handle given above, the handle is normally not sold or used separately and should thus be considered as a Partial Design. However, the assessment of novelty, individual character and infringement should take into account its function, incorporated in kitchen appliances for the purpose of handling and lifting them. Hence, the exact same handle used on a sieve would be novelty defeating / infringing, but the exact appearance used on a door handle, could still enjoy design protection / would not infringe the design right in the (pan) handle.</td>
</tr>
<tr>
<td>10.b</td>
<td>whether the Product is normally sold separately?</td>
<td>Yes</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
<td>cf. answer to 10.a.</td>
</tr>
<tr>
<td>11</td>
<td>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?</td>
<td>No</td>
</tr>
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<td></td>
<td>Please Explain</td>
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<tr>
<td>12</td>
<td>Should a Partial Design be registrable as an independent design?</td>
<td>Yes</td>
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<td></td>
<td>Please Explain</td>
<td></td>
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<tr>
<td>13</td>
<td>Is harmonisation of the law of Partial Designs desirable?</td>
<td>Yes</td>
</tr>
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<td></td>
<td>Please Explain</td>
<td></td>
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</tbody>
</table>
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.

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

The Belgian Working Group considers the European rules to provide a good framework, to the extent some of the notions are further explained and clarified (such as the meaning of dotted lines or other graphical representations of Unclaimed Parts and the consequences of such graphical representation for the validity and infringement of the Partial Design, in particular in relation to the application of the speciality principle).

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.

SC is the same as UP

Before discussing this question in depth, the Belgian group notes that the relevant sector would be the same in this particular example. Also the informed user would be the same. Both products are used in the kitchen and will fall under the sector of small kitchen appliances. This obviously has an impact on the group's answers to the following questions, which may have been different if the sectors were unconnected and the informed users were not the same.

The Belgian Group has interpreted the question as follows: does it matter whether or not an Unclaimed Part is shown? Does that limit the scope of protection of the registered design?

a) SC is the same as UP

In such case, the accused product is using the registered design in the exact same sector, and furthermore with the same function. Hence the infringement is established. SC is not the same as UP, but SC and UP relate to products that are used in the same way.

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

The group believes that is irrelevant whether a product is used in the same way or not, if that does not affect the definition of the relevant sector or informed user. For the question of infringement, what counts is the overall visual impression of the informed user. If the registered design is used in the same sector and in particular for similar types of products, the infringement should be established.
SC is not the same as UP, but SC and UP relate to products that look the same

Again, the relevant criterion here should be that of the “informed user” (cf. point b). The informed user may be defined by the purpose, functioning and sector resulting from the Partial Design registration at hand. The question then is whether the speciality principle should apply to Partial Design (cf. supra). The Belgian group believes that it should. This means that there would be no finding of infringement if for the informed user the overall visual appearance of the litigious product would not remind him of that of the registered design when considering the infringement. In the hypothesis at hand, a finding of infringement would be unlikely considering that the respective UP and SC relate to the same sector.

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

The Belgian Group refers to the proposed assessment criteria in (c): for there being an infringement, the purpose, functioning and sector, which determine the informed user, should be identical or similar to the extent that the industrial application of the design is the same.

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

No infringement should be established. The difference between SC and UP should play a role to exclude infringement.

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.

The Belgian Working Group proposes to adopt the speciality principle in a harmonised manner, or at least for Partial Designs. As a consequence thereof, the UP may be taken into account to identify the type of product concerned and the relevant sector to which the product relates.

If the speciality principle would be adopted, Partial Designs will have a fairly limited scope of protection, narrowed down to the specific context and (type of) product included in the registration. Simultaneously however, the prior art which should be taken into consideration when assessing the validity of the Partial Design will be equally limited, thus favouring the novelty and individual character of the design.

Furthermore, the Belgian Group notes that if the speciality principle would not be accepted in a harmonised manner for all designs but only for Partial Designs, this might incentivize people to only register Partial Designs, because designs as such will become difficult to obtain / will have a too large scope of protection. Adopting the same rules for all designs seems preferable.

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.

Design Constraints arising from the Unclaimed Part should affect a Partial Design if the speciality principle is applied. Conversely, if the scope of protection is not limited by the Unclaimed Part, and other products (with other technical functions) may be covered by the Partial Design, no Design Constraints resulting from the Unclaimed Part should be taken into account. The same goes for restrictions arising from the must fit with the Unclaimed Part (and thus the incorporation of the Partial Design in the Design as a whole).
<table>
<thead>
<tr>
<th></th>
<th>Please comment on any additional issues concerning any aspect of Partial Designs you consider relevant to this Study Question.</th>
</tr>
</thead>
<tbody>
<tr>
<td>None</td>
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<tr>
<th></th>
<th>Please indicate which industry sector views are included in your Group’s answers to Part III.</th>
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<tbody>
<tr>
<td>No industry members participated in the Belgian Working Group, which consists exclusively of practitioners. Nevertheless, the group tried to give an objective and unanimous opinion so as to make sure to incorporate a broad industry view.</td>
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</tbody>
</table>
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.

No

Please Explain

No, as a general rule, Partial Designs are not allowed in Brazil since the Brazilian PTO has a conservative approach regarding Article 95 of Brazilian IP Law, as transcribed below:

*Article 95* - An industrial design is considered to be any ornamental plastic form of an object or any ornamental arrangement of lines and colours that may be applied to a product that provides a new and original visual result in its external configuration, and that may serve as a type for industrial manufacture.

According to the Brazilian PTO, the “ornamental plastic form of an object” may be considered as an Industrial Design. Actually, there is no provision regarding the possibility of protecting a portion of an object by means of an Industrial Design.

Nevertheless, if the part of an object can be dissociated/separated from the article as a whole, it may be protected in a separate Industrial Design. In other words, a part of an object may be protected in a specific application if it is independently manufactured.

It should be also noted that, according to Article 20 of Brazilian Normative Instruction 44/2015 (below), the Industrial Design should show the object in an assembled manner, without highlighting details or parts separately, only with solid and continuous lines (dashed or dotted lines are not allowed).

*Article 20 – The figures should:*

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

Not applicable (see answer for item 1).

#### 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?

No

Please Explain

Not applicable (see answer for item 1).

#### 2.b Is there a written description of the Product, of which the Partial Design forms part?

No

Please Explain

Not applicable (see answer for item 1).

#### 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.*

No

Please Explain

Not applicable (see answer for item 1).

### 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.

No

Please Explain

Not applicable (see answer for item 1).
<table>
<thead>
<tr>
<th>Question</th>
<th>Answer</th>
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<tbody>
<tr>
<td>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.</td>
<td>No, Not applicable (see answer for item 1).</td>
</tr>
<tr>
<td>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.</td>
<td>Not applicable (see answer for item 1).</td>
</tr>
<tr>
<td>6. Are there aspects of your Group’s current law or practice relating to Partial Designs that could be improved? If YES, please explain.</td>
<td>No, Not applicable (see answer for item 1).</td>
</tr>
<tr>
<td>7. Is the way of specifying, describing or depicting Partial Designs satisfactory?</td>
<td>No, Not applicable (see answer for item 1).</td>
</tr>
<tr>
<td>8. Should the Unclaimed Part influence the protection of the parts of the design that are claimed? Please explain why or why not.</td>
<td>No, Not applicable (see answer for item 1).</td>
</tr>
<tr>
<td>9. Should Design Constraints restrict the subsistence and scope of protection of Partial Designs? Please explain why or why not.</td>
<td>No, Not applicable (see answer for item 1).</td>
</tr>
</tbody>
</table>
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

Yes, provided that the design of any parts or visual portions of a product could be also protected by a registered design for the entire product and not only separately. Actually, protection of partial design could be made using both possibilities in order to facilitate its enforcement.
Is harmonisation of the law of Partial Designs desirable?

Yes

Please Explain

YES, there is a need for a regulation and/or guidelines with clear provisions concerning this matter.

It is our understanding that the Brazilian IP Law does not provide clear directives. The adoption of such a guideline would be helpful for examiners and owners of IP rights. In this sense, a harmonized procedure with clear regulations to be followed by the Brazilian PTO, would facilitate the examination as well as an infringement analysis.

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.

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

Due to the absence of guidelines, on December 07, 2015, the Industrial Design Committee of the Brazilian IP Association (local group of AIPPI) submitted a draft guideline as a proposal, in which, among other aspects, recommended the adoption of standard procedures on how to analyse Partial Designs. The draft was originated from a work group of members of such association. A passage detached from the draft is transcribed:

The protection for parts of a product is allowed in case they are susceptible to be manufactured independently, for example, a display or keyboard for a telephone or similar device, which can be integrated to the device independently. This understanding is also applied to a tire tread, that can be manufactured separately and joined to a tire by a vulcanization process. In case of portions and parts that are not dissociable from a product, it is necessary to show the whole product. However, the parts that are not relevant to the design may/should be shown by broken lines, in which the portion considered irrelevant to the design should be excluded from the scope of protection.

Tooth brush handle  https://ibb.co/jXdh4H &  https://ibb.co/cLJ4Jc

Tooth brush handle

Telephone keyboard  https://ibb.co/iQGDBx

Telephone keyboard

Tire tread -  https://ibb.co/lRFUjH

Tire tread
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.

15.a SC is the same as UP

If the handle can be dissociated/separated from the article as a whole, independently manufactured and it was protected in a separate Industrial Design, the fact of being coupled to a sieve or a pan is irrelevant. In such situation, the accused product infringes the Design since both are identical in aesthetic/ornamental aspects.

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

See the information provided in item a) however, the use per se should not be considered in an infringement analysis since designs are intended to protect the aesthetic/ornamental aspects of a product and not its functionality.

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

There is infringement if the accused product comprises a portion that substantially imitates the Design that may lead to error or confusion to the user. See answer provided to item a).

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

Same answer of item c) above.

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

Same answer of item c) above.

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.
The Unclaimed Part should not be considered in the context of assessing infringement and validity since it cannot be individually claimed. Thus, it will just consist in an example of an article that may be connected/joined to the handle, not limiting the scope of protection.

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.

Based on the same reasons explained in the answer to Question 16 above, Design Constraints that are related to an Unclaimed Part should not be considered in the context of assessing infringement and validity.

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

Currently, in some situations, the Brazilian PTO accepts turning the dashed/dotted lines of the priority drawings into solid lines (dashed/dotted lines are not accepted in Brazil). However, deleting the dashed/dotted lines are usually not allowed since the Brazilian PTO understands that the application drawings would represent a different object from the one shown in the priority.

There is an ongoing discussion regarding the validity of the priority claim when the dashed/dotted lines are turned into solid lines. However, the Brazilian PTO has not issued a definitive decision about this matter yet. Our Group is of the opinion that it would be a misinterpretation of the Law and has already submitted a petition against this strict understanding.

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

The views of agents and attorneys of various industry sectors such as automotive, aviation, among others, are included in our Group’s answers.
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

Yes, the protection is given to partial designs. According to the provisions of Bulgarian Industrial Design’s Act “design” shall be the visible outer appearance of a product or part of it determined by the peculiarities of the form, the lines, the depiction, the ornaments, the colour blend or a combination thereof. A product in the sense of para 1 shall be any article obtained in industrial or craft way, including parts designated for assembly in a composite article, sets or composition of articles, packing, graphic symbols and printed fonts except software. There are no major differences between the laws for the protection of ID generally and the Bulgarian one.

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

The requirements to the application for partial designs are set fourth in the ORDINANCE FOR DRAWING UP, PRESENTATION AND INVESTIGATION OF APPLICATIONS FOR REGISTRATION OF INDUSTRIAL DESIGN.

In particular, the depiction of the design shall present it in one basic view and in as many additional views as needed (no more than 7) for its clear-cut, complete and detailed reflection. On each depiction there shall be the type of the view, for example “basic view”, “rear view”, “rear from above”, etc. When the application includes several designs, presented shall be depictions pursuant to para 1 of each one of them. Each design shall be presented in depictions of similar style - photographic or graphical. The products, to which the design is applied, shall be
presented in the position in which they are usually used. Where the products, when normally used, are closed, folded, etc., they shall be presented opened or unfolded.

<table>
<thead>
<tr>
<th>2.a</th>
<th>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?</th>
</tr>
</thead>
<tbody>
<tr>
<td>Yes</td>
<td>Please Explain</td>
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</table>

The photographic depictions shall be made on even lighting, against a neutral background without any other articles and without retouching. The graphic depictions shall be contrast, drawn in thick lines and shall present the design. The depictions shall be presented on a white non-transparent paper, shall be in good quality, without special effects or hologram signs, so that they can be reproduced. All specifics of the design shall be easily visible. Where the design specifics are determined by the color composition, color depictions shall be presented. Where the application concerns a type font, its depiction shall be in font size at least 16 and shall contain at least a sequence of all small and big letters of the alphabet, of all Arabic numerals, accompanied by a text in the font, covering five rows.

<table>
<thead>
<tr>
<th>2.b</th>
<th>Is there a written description of the Product, of which the Partial Design forms part?</th>
</tr>
</thead>
<tbody>
<tr>
<td>Yes</td>
<td>Please Explain</td>
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</table>

The depictions for each design shall be consequently numbered in Arabic figures, starting from the basic view. If a design has been presented with additional views, each view shall be marked by noting the number of the design, a dot after it and the consequent number of the view.

<table>
<thead>
<tr>
<th>2.c</th>
<th>Can verbal disclaimers be used?*</th>
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<tbody>
<tr>
<td>No</td>
<td>*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.</td>
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</tbody>
</table>

No

Please Explain

There is no such option similar to the example described for Brazil. In view of Bulgarian laws, verbal disclaimers are typical only for the registration of trade marks.

<table>
<thead>
<tr>
<th>3</th>
<th>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.</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td>Please Explain</td>
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</table>

The scope of the legal protection shall be determined by the image, respectively the images of the registered design and shall cover every design that does not produce on the informed user a different overall impression.

The rightholder can prohibit to third parties without his consent to copy or to use in the commercial activity a design included in the scope of protection. The use of the design of para 1 shall include the production, the offering and the exhibiting on the market or the use of a product in which is included or to which has been attached design of the scope of
II. Policy considerations and proposals for improvements of your Group's current law

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.

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<tbody>
<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
<tr>
<td>No, it is not possible. As explained above, the Bulgarian relevant laws stress on the overall impression of the entire design rather than a part or parts of the same.</td>
<td></td>
</tr>
</tbody>
</table>

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.

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<tbody>
<tr>
<td>The examiner is obliged to assess the application as it filed with the PTO, meaning based on the depiction of the design and the brief description of the particularities if any.</td>
<td></td>
</tr>
</tbody>
</table>

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

<p>| | |</p>
<table>
<thead>
<tr>
<th></th>
<th></th>
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</thead>
<tbody>
<tr>
<td>Yes</td>
<td>Please Explain</td>
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<tr>
<td>One of them could be the legal possibility for the applicant to use a Verbal disclaimer when seeking protection for his design.</td>
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</table>

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

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<tbody>
<tr>
<td>Yes</td>
<td>Please Explain</td>
</tr>
<tr>
<td>As explained above the ORDINANCE FOR DRAWING UP, PRESENTATION AND INVESTIGATION OF APPLICATIONS FOR REGISTRATION OF INDUSTRIANAL DESIGN provides detailed list of requirements related to the depiction and describing of the designs and their parts when an application is filed with the Bulgarian PTO.</td>
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</table>

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

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<table>
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<tbody>
<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
<tr>
<td>Considering the applicant himself is willing to file his design application without claiming that particular part ot it apparently the same part is irrelevant for the applicant. The example given above with the pan and its handle is proving my point. It is up to the applicant ot decide which</td>
<td></td>
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</table>
part of the design is important for him.

<table>
<thead>
<tr>
<th>9</th>
<th>Should Design Constraints restrict the subsistence and scope of protection of Partial Designs? Please explain why or why not.</th>
</tr>
</thead>
<tbody>
<tr>
<td>Yes</td>
<td>Please Explain</td>
</tr>
<tr>
<td>When the design is applied to or included in a product that is component of a complex product, it shall be deemed novel and original if:</td>
<td></td>
</tr>
<tr>
<td>1. the component of the complex product remains visible during the normal use of the said product, and</td>
<td></td>
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<tr>
<td>2. the visible features of the component meet the novelty and originality requirements.</td>
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<tr>
<th>10</th>
<th>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:</th>
</tr>
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<tbody>
<tr>
<td>10.a</td>
<td>the design as shown and any Unclaimed Part; and/or</td>
</tr>
<tr>
<td>No</td>
<td>Please Explain</td>
</tr>
<tr>
<td>In any case, when overall assessment is made all particularities of the case should be taken into account.</td>
<td></td>
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</table>

<table>
<thead>
<tr>
<th>10.b</th>
<th>whether the Product is normally sold separately?</th>
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<tbody>
<tr>
<td>Yes</td>
<td>Please Explain</td>
</tr>
<tr>
<td>Please see the answer to Q 10a.</td>
<td></td>
</tr>
</tbody>
</table>
III. Proposals for harmonisation

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

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?

Yes

Please Explain

According to the statistics for 2017 the number for design applications is not exceeding 300 and on the other hand we have a little case law generated on those issues in Bulgaria.

However, the Bulgarian PTO managed in the last two years to improve the design registration process in terms of deadlines for examining the applications and period of time for closing the whole registration proceedings.

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

Yes

Please Explain

It is debatable and depends on the current needs and preferences of the industry and their business strategy as the laws have to protect people interests and encourage them to invent after all.

13 Is harmonisation of the law of Partial Designs desirable?

Yes

Please Explain

Bulgaria is an EU Member-State for more than a decade, therefore the harmonization is at least desirable.

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.
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. SC is the same as UP

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

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

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

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

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.

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.

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

Please indicate which industry sector views are included in your Group’s answers to Part III.
**Study Question**

Submission date: May 10, 2018

Sarah MATHESON, Reporter General
Jonathan P. OSHA and Anne Marie VERSCHUUR, Deputy Reporters General
Yusuke INUI, Ari LAAKKONEN and Ralph NACK, Assistants to the Reporter General

Partial designs

Responsible Reporter(s): Yusuke INUI and Ari LAAKKONEN

National/Regional Group: Canada
Contributors name(s): Fred BARBIERI, Curtis B. BEHMANN, Brian W. GRAY, Jean-Charles GREGOIRE, Kevin SHIPLEY, Matthew ZISCHKA

e-Mail contact: cbehmann@blg.com

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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**

   The Canadian Industrial Design Act (hereinafter the “Act”) div 2 defines a design as “features of shape, configuration, pattern or ornament and any combination of those features that, in a finished article, appeal to and are judged solely by the eye.”. The Act does not deal with Partial Designs, as such. Designs are applied to “finished articles”, which in case law have also been referred to as articles of manufacture or manufactured articles and which the Canadian Industrial Design Office interprets to mean articles that are capable of being made sold and delivered separately. There is no provision for filing an application for a partial design which is not integral to a finished article or which cannot be sold as a separate article of commerce.

   The Federal Court has held that the test used for determining the originality of the design is that of a purely visual assessment of the features of the finished article (Rothbury International Inc. v. Canada (Ministry of Industry) 2004 FC 578. Thus, the finished article as a whole must be considered, but it is uncertain the extent of the consideration which is to be given to the part of the article which does not form part of the original design or affect its original character.

   The Industrial Design Regulations (hereinafter the “Regulations”) div 9.1, specifically allow for the identification of those portions of the article that do not form part of the design by showing them in stippled, dashed or wavy lines. It has long been the practice to require (and now simply to allow) some separate identification by words or in some other fashion of the portions of the finished article that constitute the design of the finished article.

   Few cases in Canada have considered the effect of the separate identification in the drawings of portions of the finished article. It is however possible to disclaim the portions of the finished article which do not constitute the design.

   The laws for the protection of Partial Designs are the same as the laws for the protection of designs generally. Infringement occurs when “the
design” or “a design not differing substantially therefrom” has been applied to an unauthorized finished article.

The court will assess which portions of the design of the finished article contribute to the originality or novelty of the design and serve to both distinguish the article from prior art articles and conversely are most relevant to the resemblance between the registered design and the allegedly infringing article. Presumably in doing so the court will take into account all of the circumstances, including the title or the name of the article sought to be registered and any separate identification of those portions of the article to which the design applies or any disclaimer, statement or identification of those portions of the article to which the design does not apply.

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

#### 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?

<table>
<thead>
<tr>
<th>Yes</th>
<th>Please Explain</th>
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</table>

Yes the Regulations (div 9.1) and the Design Office practice allow an identification of those portion of the finished article that incorporate the design, but there is no “claim” as such. However by identifying the portions of the article that constitute the design, the design owner is in effect disclaiming the non-identified portions.

#### 2.b Is there a written description of the Product, of which the Partial Design forms part?

<table>
<thead>
<tr>
<th>Yes</th>
<th>Please Explain</th>
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Currently the Design Office requires a simple written description identifying the features that constitute the design as depicted in the drawings. As soon as the new revisions to the Act are proclaimed in force a description will become optional.

#### 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.

<table>
<thead>
<tr>
<th>Yes</th>
<th>Please Explain</th>
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</table>

Office practice permits verbal disclaimers, which can be useful in the case of photographs.

### 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.

<table>
<thead>
<tr>
<th>Yes</th>
<th>Please Explain</th>
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</table>

It must be the same “article”. This may turn to some extent on the specificity or genericism of the title of the application and the description of the article to which the design is applied. To constitute an infringement, paragraph 11(1)(a) of the Act requires a sale or other prohibited activity of any article in respect of which the design is registered, and to which the design or a design not differing substantially therefrom has
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

A design will be considered novel if it shows a substantial difference from a design previously disclosed for the same or an analogous art. If a design application or design registration including a Partial Design has been applied to Product X and the Partial Design is found in a prior Product Y that is of an analogous character, the Partial Design will not be original. In Clatworthy, the Supreme Court of Canada held it could not call a registration of a design for display garments an original design, relying on evidence of a prior bedside table, Exhibit F. It found that the alleged original feature of the design of the rack, was found in the base footings of the bedside table in Exhibit F, an article of analogous function/class: Clatworthy at 433-435.

Footnotes


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.

Canadian courts will consider functional Design Constraints when deciding originality and scope of protection for any design, noting that Canadian legislation excludes solely functional features from protection. This would apply to a consideration of the design applied to the finished article as a whole or any partial design. To the extent any design or part of the design of a finished article must fit or must function in a certain way, the scope of protection for the design could be correspondingly reduced. It is probable that a Canadian court would not consider “must match” as a relevant criteria, if by that is meant to imply that there is an exemption from infringement to allow a finished article to match in appearance a protected article. However to the extent that articles generally of a certain type match in appearance this could be relevant to originality.
analagous article with an analogous design effect.

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

Yes

Please Explain

Yes, but the effect to be given to such specifying, describing or depicting is uncertain.

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

Yes

Please Explain

The Unclaimed Part should be given less weight, and should have minimal influence in most cases unless it can be shown to affect the appreciation of the design or the overall impression of the design. In most cases this should depend on whether the partial design in the finished article and the partial design in the alleged infringement are both conceptually severable from the finished articles as a whole so that their design impressions can be compared head to head and in which the designs produce on the informed user the same overall impression.

An example of how the analysis might work in practice can be seen in the example of the handle for the pan and the handle for the sieve. The handles in both cases are identifiably separate or conceptually severable to the eye of an observer although they may be integral and not detachable. They also perform a similar function in a similar way and they are positioned on the article in approximately the same place (on the edge) and it is easy then to compare the designs for each handle to judge infringement and the unclaimed portion would have little or no impact. Conversely we can imagine a situation where the Partial Design is a portion of the article which is hard to discern as separate or severable because it may be a somewhat artificial division of parts of the article which to the observer are seen as one, and the separate Partial Designs may be in a different orientation or relation/proportion to the rest of the article so that the two designs, if taken in isolation might be considered the same but are not so when looked at in context. In the end the final determination is the overall visual impression between the two Partial Designs including their relationship to the article as a whole.

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

Yes

Please Explain

Yes, but only in respect of those Design Constraints dictated by purely functional needs of the article. The Canadian Industrial Design Act provides that design protection does not extend to features applied to a useful article that are dictated solely by a utilitarian function of the article or to any method or principle of manufacture or construction. "Utilitarian function" is defined as "a function other than merely serving as a substrate or carrier for artistic or literary matter." In a recent case the Federal Court has made it clear that industrial designs protect the visual features of the article, not its functionality. Functional features of designs may, however, be protected under the Act. However design protection does not extend to those features whose form are dictated solely by a function of the article or where the design seeks to protect a method or principle or manufacture or construction.

Footnotes

1. Bodum USA Inc. Trudeau Corp (1889) Inc. 2012 FC 1128

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:
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?

No

Please Explain

No if it is not a separate finished article.

13. Is harmonisation of the law of Partial Designs desirable?

Yes

Please Explain
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.

This should be flexible and include current practice of stippled or dotted lines for the unclaimed part and sold line for the claimed part. However circling or colours showing the unclaimed part should also be acceptable.

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.

15.a SC is the same as UP

Differences not relevant. This context here does not affect the overall impression and visual appearance of the design.

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

Likely differences not relevant for the reasons expressed above. Analogy of function may effect overall visual impression and the conceptual severability of each design from the UP or SC as the case may be, enabling more easy comparison of the two Partial Designs without recourse to differences between UP and SC.

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

Obviously analogy of appearance with effect make it easier to perceive each Partial Design separately but the overall impression of each Partial Design on the articles as a whole will still be paramount.

15.d SC is not the same as UP, but SC and UP relate to products that categorised in the same way when registering designs
This should not be a factor. The differences in categorisation should not be relevant.

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

Unconnected how? In appearance and function and design impression? Then the differences are clearly relevant.

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.

The unclaimed part should only be considered where the differences in the unclaimed part relate to or affect the overall impression of the design in the articles, taking into account the appearance and functioning of the design in the respective articles and the conceptual severability of the Partial Designs when applied to the finished articles. In such a scenario, the Unclaimed Part should be given less weight than the claimed part.

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.

Where functional requirements dictate that a design must be in a certain shape or have a certain character to fit the required functional purpose, this should be a factor in deciding the scope of protection to be given to such design, or indeed whether the design is valid at all. However where the requirement to “must match” is asserted because of design constraints relating to the appearance of the article, this should not be taken into account.

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.
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.

   No

   Please Explain

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

   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?

   No

   Please Explain

   In China, the protection scope of design patent is determined by all that shown in the graphic representatives. There is no view disclaimer.

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

   No
There is no partial design concept in current patent law and practice in China.

**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.*

No

According to the law, it keeps silence regarding verbal disclaimers. In practice, some of the design patents have verbal disclaimers in the brief description; but there is rare case confirming that the practice works well to disclaimer some elements.

**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.**

No

**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.**

No

**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.**

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

Yes

The released patent law amendment draft allows to protect the partial design, but the draft is under the review and further amendments. It is not quite sure if the final amendment has the same.

**Is the way of specifying, describing or depicting Partial Designs satisfactory?**
The graphic representatives shall dominate the protection scope of a design right. The written description shall be avoid unless it is really needed to clarify the scope.

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<tr>
<th>Question</th>
<th>Answer</th>
<th>Explanation</th>
</tr>
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<tbody>
<tr>
<td>Should the Unclaimed Part influence the protection of the parts of the design that are claimed? Please explain why or why not.</td>
<td>No</td>
<td>The scope of partial design shall be decided by the partial design itself, other factors shall not be considered.</td>
</tr>
<tr>
<td>Should Design Constraints restrict the subsistence and scope of protection of Partial Designs? Please explain why or why not.</td>
<td>No</td>
<td>No. Again, the scope of protection of Partial design shall be decided by graphic representatives.</td>
</tr>
<tr>
<td>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:</td>
<td></td>
<td>No. Because this draws a clear line of protected and un-protected.</td>
</tr>
<tr>
<td>the design as shown and any Unclaimed Part; and/or</td>
<td>Yes</td>
<td>Because this draws a clear line of protected and un-protected.</td>
</tr>
<tr>
<td>whether the Product is normally sold separately?</td>
<td>No</td>
<td>If this factor is considered, it means the part where the design is carried on is an independent product.</td>
</tr>
<tr>
<td>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?</td>
<td>Yes</td>
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</table>
Please Explain

With more and more innovations focus on details, it is the time for the laws to protect the designs in certain aspect of a product, i.e., partial design.

### 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

To protect the innovations. Small innovations in part of a product might take much effort, and truly valuable to industry.

#### 13 Is harmonisation of the law of Partial Designs desirable?

Yes

Please Explain

Design right protects appearance, which is a universal rule around the world, and is then the basis for harmonizing the specific rules for partial designs. Harmonisation of the law of partial designs may provide industry prediction of value of partial design, reduce the cost for industry to obtain and maintain the partial design.

**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 recommended to simply draw a line between the elements to be protected and the elements not willing to protect.
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.

15.a SC is the same as UP

No, both SC and UP should not be considered when making comparison between the handle in partial design and the handle in sieve, because the protection scope is the handle.

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

No, both SC and UP should not be considered when making comparison between the handle in partial design and the handle in sieve, because the protection scope is the handle.

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

No, both SC and UP should not be considered when making comparison between the handle in partial design and the handle in sieve, because the protection scope is the handle.

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

No, both SC and UP should not be considered when making comparison between the handle in partial design and the handle in sieve, because the protection scope is the handle.

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

No, both SC and UP should not be considered when making comparison between the handle in partial design and the handle in sieve, because the protection scope is the handle.

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.
The unclaimed part shall not be considered when deciding the protection scope of a partial design; and therefore when making the comparison between partial design and the prior design/infringing product the unclaimed part and corresponding parts in the compared design shall not be considered.

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.

The partial design is not patentable subject matter, if it is designed for must fit/must match reason or for only for achieving certain function.

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

GUI has to connect to product in many jurisdictions around the world. When bring lawsuits, the infringing product shall be hardware carrying GUI although GUI is protected as partial design. This is a big issue for software companies who do not make any hardware and whose GUI can be applied to all kinds of electronic devices. We would recommend either admit software is an independent product for GUI design or allow to decide the protection of GUI without considering hardware.

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

software and automobile
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

   Partial Designs are protected under the same conditions as designs generally.

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

   In cases when the design contains parts of the product for which no protection is sought, a visual disclaimer may be used. The visual disclaimer may only be used when it is impossible to separate the part for which the protection is sought from the rest of the product.

   The disclaimer is only acceptable by the Czech Industrial Property Office provided that the following conditions are met:

   • the disclaimer clearly indicates that protection is not sought for certain features of the design used in the representation;

   • the disclaimer is shown consistently in all the views where it appears.
In addition, the disclaimer must be clear and obvious. The substance of the design, i.e. its identifying features, must be unambiguously comprehensible from the depiction of the design. In addition, there must be a clear distinction between the claimed and disclaimed features.

**2. 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

When the design is depicted by means of line drawings, it is recommended to use as the visual disclaimer the **broken lines**. Broken lines consist of a trace made up of dots or dashes (or a combination of both). Broken lines should be combined with continuous lines which are used for parts for which protection is sought. In cases where broken lines represent the feature of the design and part of the design needs to be disclaimed, this can be done by using other types of disclaimers (i.e. boundaries, colour shading and blurring).

Although broken lines are the preferred type of the disclaimer, there are alternatives if it cannot be used. Firstly, **boundaries** could be an option. In order to be accepted, the features for which protection is sought, should be clearly indicated within the boundaries.

Secondly, **colour shading** could be an option. This type of visual disclaimer uses contrasting tones of colour to obscure the features for which protection is not sought. The features for which protection is sought must be clearly shown so that they are clearly perceptible, whereas the disclaimed features must be represented in a different tone of colour and in a way that they appear blurred or imperceptible.

Lastly, **blurring** could be an option. This type of visual disclaimer obscures the features for which protection is not sought. The features for which protection is sought must be clearly distinguishable from the disclaimed (blurred) features.

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

Yes

Please Explain

Written description of the Product is a non-mandatory part of the Design and it has no impact on scope of protection of the Design. Consequently, it is not possible to make a written disclaimer as part of the written description.

**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.*

No

Please Explain

Written description of the Product is a non-mandatory part of the Design and it has no impact on scope of protection of the Design. Consequently, it is not possible to make a written disclaimer as part of the written description.

**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.**

69
Under express provision in the Czech Design Act, the title of the Design and determination of the product to which the Design is applied shall not have effect on scope of protection.

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

A partial design constitutes prior art irrespective of the type of product to which it is applied.

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.

Under express provision of the Czech Design Act, when assessing registrability of a design, the Office does not take into consideration features which must be necessarily reproduced in their exact form and dimensions so as to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to, or placed in, around another product so that either product may perform its function.

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.

No

Please Explain

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

Yes

Please Explain

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

The applicant intentionally disclaims the Unclaimed Part from scope of protection of the design and hence the Unclaimed Part should...
generally have an effect on its scope of protection other than assessing its overall impression.

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

Yes

Please Explain

Yes, both when assessing registrability and scope of protection of design, the freedom of designer when designing the relevant product should be taken into consideration in order to provide fair and balanced conditions of registrability and scope of protection in case of alleged infringement.

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:**

- the design as shown and any Unclaimed Part; and/or

Yes

Please Explain

10.a. **whether the Product is normally sold separately?**

No

Please Explain

The fact that a product is sold separately should not be relevant for assessment whether it is a whole Product as spare parts are often sold separately without being functional whole products.

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

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

Yes

Please Explain

III. Proposals for harmonisation

*Please consult with relevant in-house / industry members of your Group in responding to Part III.*
Partial designs are helpful in defining the scope of protection better and more clearly and thus are to the benefit of both IP owners and public at large.

13 **Is harmonisation of the law of Partial Designs desirable?**

Yes

Please Explain

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.

Czech National Group considers graphical depiction of the Partial Design and Unclaimed Part by broken lines to be optimal.

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.

15.a SC is the same as UP

No, unclaimed part and surrounding context should have no effect on scope of protection. Nevertheless, it will have an impact on assessment of overall impression created by the Partial Design and Accused Product.

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

No, unclaimed part and surrounding context should generally have no effect on scope of protection. Nevertheless, they will inevitably have an impact on assessment of overall impression created by the Partial Design and Accused Product.

15.c SC is not the same as UP, but SC and UP relate to products that look the same
No, unclaimed part and surrounding context should generally have no effect on scope of protection. Nevertheless, they will inevitably have an impact on assessment of overall impression created by the Partial Design and Accused Product.

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

No, unclaimed part and surrounding context should generally have no effect on scope of protection. Nevertheless, they will inevitably have an impact on assessment of overall impression created by the Partial Design and Accused Product.

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

No, unclaimed part and surrounding context should generally have no effect on scope of protection. Nevertheless, they will inevitably have an impact on assessment of overall impression created by the Partial Design and Accused Product.

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.

The Unclaimed Part should be taken into account when analysing the overall impression of a Partial Design. All relevant factors are to be considered including prior art and freedom of designer when assessing both individual character and infringement. As both Unclaimed Part and Surrounding Context will be visible during the assessment of the designs by the examiner or judge, it will play a role in assessment of the overall impression.

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.

Design Constraints including must fit/must match features arising from the Unclaimed Part should not be taken into consideration when assessing individual character of a Partial Design.

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

No further comments

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

No specific industry views were put forward in the report and the answers are neutral.
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

The Danish Design Act is an implementation of the Directive 98/71/EC of The European Parliament and of The Council of 13 October 1998 on the legal protection of designs. The Design Act is formulated entirely in accordance with the Directive. The Danish Patent and Trade Mark Office does also closely adhere to EUIPO. Thus, there exists an EU-harmonization and references to Danish design law must be understood as EU-compliant.

In Denmark, the definition of a “design” is “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. Thus, it is possible to obtain design protection for a part of a product’s appearance, even if the part in question does not constitute a product in itself.

The laws for protection of a partial design is no different from the laws for protection of the whole design.

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


The definition of a “product” – which is contained in the definition of a “design” – 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. By this it is under Danish law (as in all EU-countries) possible to register a part of a product. As seen in the definition of a “product”, this is not only limited to physical objects.

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

When applying for a registered design at the Danish Patent and Trade Mark Office, the application must contain depictions of the design, cf. Executive Order 2008-11-20 no. 1099 on application and registration of designs, art. 2(1)(2).

These depictions must only show the design and can be photographs or drawings, cf. Executive Order 2008-11-20 no. 1099 on application and registration of designs, art. 4(1)(2). The application only covers those parts of the design which are shown in the depiction. It is also possible to submit a physical replica of the design instead of pictures.

A number of graphic measures may be used to indicate that the application covers a partial design.

- Broken lines may be used in a view either to indicate the elements for which no protection is sought or to indicate portions of the design that are not visible in that particular view, that is, non-visible lines.

- Boundaries may be used to surround features of the design for which protection is sought, the remaining parts being considered as having a purely illustrative purpose, that is, to show the environment in which the claimed features are placed.

Color shading and bluring may be used to eliminate parts that should not be covered by the application.

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

No

Please Explain

The application must contain an indication of the product for which the design is intended to cover, cf. Executive Order 2008-11-20 no. 1099 on application and registration of designs, art. 2(1)(3). This indication shall be short, accurate and may not contain any technical explanations. Just a description of the design, but with no depictions, is not sufficient for a design to be registered.

While it is possible to file a description of the design together with the design application, such description does not form part of the registration and has no influence on the scope of protection of the design. Thus, in evaluating the scope of protection of a design, courts will look almost exclusively at the representations covered by the registration.

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.

No

Please Explain
Verbal disclaimers are not used in Danish design applications. The reason for this is that the scope of protection is almost exclusively based upon the representations covered by the registration, i.e. the depictions in either photographs or drawings.

### 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

In general, the scope of protection of a Danish design registration shall include any design which does not produce a different overall impression on the informed user, cf. the Danish Design Act, art. 9(2). As described above, the scope of protection is almost exclusively based upon the representations covered by the registration; not by the product on which the design is applied upon.

Thus, for a Partial Design forming part of a Product X to be infringed by the same use of the Partial Design on a Product Y depends on whether or not the design does or does not produce a different overall impression on the informed user. In that connection, the Courts would look to the representations of the partial design, and if they find the same design used on another product, even though it only forms part of that product, it would constitute an infringement.

Under Danish design law, protection for designs categorised as “must match” are allowed. However, this only relates to a design for a component part which is used to the reparation of a complex product. The duration of the protection is 15 years. In this regard, it should be noted, that if the interoperability is required due to technical or mechanical requirements, the design is still subject to art. 8(1)(2) on must-fit parts.

This is contrary to the Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs art. 110, where protection as a Community design shall not exist for a design which constitutes a component part of a complex product used within the meaning of Article 19(1) for the purpose of the repair of that complex product so as to restore its original appearance. Thus it is possible to obtain an EU-design registration on a spare part, but this does not exclude third parties with the possibility to repair these spare parts.

### 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

A design will be considered to be new if it is not predated by an identical design disclosed, cf. the Danish Design Act art. 3(2). According to the Danish Patent and Trade Mark Office, a design is new if no identical or very similar design previously has been published. An identical design is understood so that the designs must differ on essential points from previously known designs. If a design differs sufficiently from a previous design, it will be considered new.

The issue, whether a Partial Design forming part of the Product X is considered not to be novel in view of the same Partial Design in a prior Product Y, is not discussed in Danish design law nor by the Danish Patent and Trade Mark Office. However, it must be assumed that the assessment and outcome would be the same as if the assessment was made on two Community designs at EUIPO.

Therefore, there is identity between the Partial Design forming part of Product Y and the Partial Design forming part of Product X if the latter discloses each and every element constituting the former. The framework of the comparison is limited to the features making up the Partial Design in Product Y. Thus it is irrelevant whether the Partial Design in Product Y discloses additional features.

### 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.

Under Danish design law it is not possible to register a design which subsists in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions to permit the product in which the design is incorporated, or to which it is applied, to be
mechanically connected to or placed in, around or against, another product so that either product may perform its function, cf. the Danish Design act. Art. 8(1)(2). By this must fit exception, must fit-parts must be considered a special type of functional feature as appearance which are excluded from protection.

Even though it is not stated in the law, it is quite clear that the law will require an analysis of elements outside the scope of the partial design to decide, to what extent the question is of a must-fit part of the design.

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.

No

Please Explain

Not really, since the protection is very flexible and quite far reaching.

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

Yes

Please Explain

-

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

No, because a protected element may be important in itself as a business identifier or a distinctive an valuable element, which is important for the whole design no matter, how the remaining elements of the whole design looks like.

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

No

Please Explain

No, since a partial design may be as important, valuable and costly to develop as the whole design and protection of a partial design will allow the creator to protect the elements of a whole design, which he or she believes are of most relevance to their business. Furthermore design constraint restrictions on partial designs could be used by infringers to add irrelevant elements to the remaining design and in that way limit the protection of the protected partial design.

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:
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

Yes we believe so. They may be as important as the whole design

13. Is harmonisation of the law of Partial Designs desirable?

Yes

Please Explain

Indeed

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.

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

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.

**15.a SC is the same as UP**

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

**15.c SC is not the same as UP, but SC and UP relate to products that look the same**

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

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

n/a

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.

n/a

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

n/a

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

n/a
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

Partial designs are protectable with basis on the same Law that generally regulates designs. Partial designs would be protectable if they fulfill with the general definition: Design protection would be provided to a particular appearance of a product that results from any arrangement of lines or combination of colors, or any two-dimensional or three-dimensional outward shape, line, outline, form, texture, or material, without the intended use or purpose of the said product being thereby changed.

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

Partial designs do not have special requirements and therefore they must be described and graphically depicted using the same regulations as general designs.

The unclaimed part should be depicted by dashed or dotted lines and the full explanation of the claimed and unclaimed matter should be provided in writing.
2. 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

The visual indication of the unclaimed parts are dashed or dotted lines.

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

Yes

Please Explain

Yes, the description of the product of which the partial design forms part is necessary for verifying the requirement’s fulfilment.

2. 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

A full explanation of the claimed and unclaimed matter is recommended to be provided in writing.

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

A partial design forming part of a product X can be infringed by the use of the same partial design on a Product Y, provided that product X and Y are obviously related.

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

A partial design forming part of a product X can be considered not novel in view of the same partial design in prior product Y, provided that...
II. Policy considerations and proposals for improvements of your Group's current laws

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.

Since we do not have specific laws for partial designs, in theory, partial designs need to comply with the general provisions regarding designs. In practice the Authority does take into consideration the unclaimed part in the case of partial designs.

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

Since we do not have specific laws for partial designs it would be advisable to include provisions for them.

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

No

No, we do require regulations allowing us to have clear guidelines on how to protect, describe, depict and specify partial designs.

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

Yes

The unclaimed part should be used to understand the design, and therefore could influence the protection if from said part the lack of compliance of the protection requirements is deducted.

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

Yes

Please Explain
II. Proposals for harmonisation

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

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

Yes

Please Explain

The unclaimed part should be used to understand the design and valuate its registrability.

0.b whether the Product is normally sold separately?

No

Please Explain

The fact that the product is normally sold separately, should not be taken into consideration, as it not always the case and the use would be together.

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?

Yes

Please Explain

We require general regulations for partial designs.

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

Design constraints should restrict the subsistence and scope of protection of partial designs, as partial designs requirements are the same as for general designs.
We do not have in houses in the group; however we conducted consultations with the appropriate professionals. In general terms the industry is willing to obtain full protection for partial designs as independent designs. The mentioned professionals believe that the applicable regulations are not allowing full protection to all designs.

Is harmonisation of the law of Partial Designs desirable?

Yes

Please Explain

We do have harmonization of laws in the Andean region, and this harmonization has allowed to avoid politics getting into the IP laws; however, the Country adopted a law that is in clear violation of the Andean Law and restricting IP rights. It would be desirable that the country only follows the harmonized regulations.

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.

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

The partial design shall be explained by itself and as part of the whole article. The part of the design for which protection is sought shall be shown in solid lines and the unclaimed part shall be shown in broken or dashed lines. The title of the article for a partial design must include the title of the whole article of which the partial design is included.

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.

SC is the same as UP

If SC and UP are the same there are no differences between them to consider.

SC is not the same as UP, but SC and UP relate to products that are used in the same way
In this case the difference should not be taken into consideration as use is the same. If the partial design is not technically necessary for the use of the product, the difference between the SC and UP is irrelevant.

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

The SC and UP differences should not be taken into consideration as the SC and UP have the same appearance and therefore overall impression.

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

The SC and UP differences should not be taken into consideration as if the products have the same categorization use an the overall impression would be the same/related.

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

The SC and UP differences should be taken into consideration as use and the overall impression would be different.

**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.

The analysis should focus on the overall impression of the partial design. The unclaimed matter should be taken into consideration to determine validity and not necessarily infringement.

**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.

We would agree with AIPPI resolution:
In the assessment of the scope of protection of a Registered Design, no visual portion of the Appearance of the Product should be excluded from consideration, even if the appearance of any such portion is dictated solely by the functional characteristics or functional attributes of any such portion of the Product, but such portions may be given less weight in the assessment.

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

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

The industries we consulted in our responses are plastic manufacturers and furniture designers.
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

Partial designs are capable of protection in Estonia. There are Industrial Design Protection Act for the protection of industrial designs generally in Estonia and some provisions in the Industrial Design Protection Regulation regarding the representation of Partial Designs. Furthermore, in Estonia legal protection is not granted to an industrial design which is a spare part or component which is not visible upon normal use when assembled in the product.

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

Parts of the industrial design shown in the reproduction to which protection is not sought must be represented by dotted or broken lines. A single magnified view is acceptable provided that the magnified part is already visible in one of the other submitted views and it is presented in a separate single view.

2a. 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

Parts of the industrial design shown in the reproduction to which protection is not sought must be represented by dotted or broken lines. A single magnified view is acceptable provided that the magnified part is already visible in one of the other submitted views and it is presented in a separate single view.

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

Yes

Please Explain

A registration application may be accompanied by a description disclosing the subject matter of the industrial design. However, reproduction itself must not contain titles, descriptive text or dimensional markings. Reproduction may only depict the protected industrial design, it must not contain any foreign objects or illustrative examples of the use of the industrial design.

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.

No

Please Explain

A verbal disclaimer may be used in the description disclosing the subject matter of the industrial design, but is alone not sufficient, as in such case parts of the industrial design shown in the reproduction to which protection is not sought must be also represented by dotted or dashed lines.

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

However, the current law does not provide a clear answer to this question.

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.

No

Please Explain

However, the current law does not provide a clear answer to this question.

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.
The current law does not provide a clear answer to this question.

## 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

The current law and practice in this regard is very poor. The current law needs to be improved especially for the purposes of determining infringement and novelty of the Partial Design.

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

No

Please Explain

There are a number of permissible ways to exclude certain features from the scope of protection afforded to a registered design, but Estonian law is limited by dotted or broken lines only. Although dotted or broken lines are the preferred disclaimer, they cannot always be used due to technical reasons. Furthermore, the applicant may need to provide complementary/additional views in order to further disclose the features of the design.

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

Yes

Please Explain

All features of the design as a whole must be considered, including the Unclaimed Part. The Unclaimed Part can be used to interpret the product that embodies the Partial Design or the relationship between the environment surrounding the claimed portion and the claimed portion itself.

### 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. However, this aspect must determined on a case-by-case basis.

### 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:
III. Proposals for harmonisation

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

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

Yes

Please Explain

Both aspects need to be taken into account.

10. whether the Product is normally sold separately?

Yes

Please Explain

Both aspects need to be taken into account.

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

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?

13. Is harmonisation of the law of Partial Designs desirable?

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.
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. SC is the same as UP

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

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

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

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

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.

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.

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.
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

Under the Finnish Registered Designs Act (221/1971, as amended) protection is given to the appearance of the whole or a part of a product. This means that also Partial Designs are covered, and the laws for the protection of Partial Designs are no different to the laws for the protection of designs generally. The Registered Designs Act implements the EU Directive on the legal protection of designs (98/71/EC). The “part of a product” means a part which is not independent from the product and cannot be removed from the product as such, for instance a bottleneck.

EU:

Finland is a member of the European Union, and thus, the Community Design Regulation (EC) No 6/2002 is also applicable in Finland. Registered Community Designs are valid in Finland and protection is given to Partial Designs as well.

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

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

Finland: The Registered Designs Act (221/1971) and the Registered Designs Decree (252/1971) do not contain provisions on how the Partial Designs should be exactly specified, described and/or graphically depicted.

However, the Finnish Patent and Registration Office has issued a decision (PRH/1969/01/2011) that design registration matters shall be processed in accordance with the administrative rules issued by the Office ("Mallioikeusmääräykset") concerning the contents of the application and the application procedure.

These binding rules include more specific requirements for the representation of the design. According to the said rules, in case the design concerns the appearance of a part of a product, i.e. some specific detail area, the pictures must illustrate clearly for which details protection is claimed. If line drawings are used, the claimed detail area (Partial Design) can be illustrated in solid lines and the disclaimed area (Unclaimed Part) in dashed lines. Alternatively, the claimed area can also be marked off by using a square or a circle.

Examples of pictures presenting a whole product (a whole chair on the left) and a part of a product (the chair with circled detail on the right) [1]:

Footnotes


EU: European Union Intellectual Property Office (EUIPO) follows the Common Practice on the Convergence on graphic representation of Designs (CP6) of 15 April 2016 issued by the European Trade Mark and Design Network (consisting of EUIPO and national offices). Under the Common Practice, dashed lines are recommended as a visual indication of the Unclaimed Part. Only when dashed lines cannot be used due to technical reasons (e.g. when they are used to indicate stitching on clothing or patterns; or when photographs are used), other indications can be used: colour shading, boundaries and blurring. Thus, the EUIPO accepts dashed lines, blurring, colour shading and boundaries as visual disclaimers.

Although the Finnish Patent and Registration Office has not implemented the Common Practice CP6, the Finnish Patent and Registration Office generally supports the Common Practice.

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

Yes

Please Explain
Finland:

The product, for which registration of the design is sought, must be named concisely and unambiguously. Designs are classified according to their purpose of use under the [Locarno Agreement](https://www.prh.fi/stc/forms/mallin_rekisterointihakemus.pdf). The name can be for example, “Chair” or “Bottle neck”.

However, the description of the product is used only to confirm the correct classification of the design. The scope of protection is determined solely by the pictures and written descriptions are not used to indicate the parts or details for which the registration is sought for.

EU:

The applicant is asked to indicate the name of the product which the design is intended to be applied to or incorporated in. The specification of products should clearly indicate their nature and purpose of the designated product, preferably using the terminology of the [Locarno Classification](https://euipo.europa.eu/rcd/efiling/wizard.htm?execution=e2s1), established by the Locarno Agreement. However, the scope of protection depends solely on the pictures.

Footnotes

1. [^](https://www.prh.fi/stc/forms/mallin_rekisterointihakemus.pdf)
2. [^](https://euipo.europa.eu/rcd/efiling/wizard.htm?execution=e2s1)

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.

No

Please Explain

Finland:

No, verbal disclaimers cannot be used to indicate that protection is sought only for the Partial Design and not for the Unclaimed Part. There must always be a visual indication (e.g. dashed lines or circled area) in the pictures of the parts for which the registration are / are not sought for as protection is determined solely by the pictures in the register.

EU:

Neither the [Community Design regulation](https://www.prh.fi/stc/forms/mallin_rekisterointihakemus.pdf) (CDR) nor [Community Design implementing regulation](https://euipo.europa.eu/rcd/efiling/wizard.htm?execution=e2s1) (CDIR) provides rules for the possibility of including in the application a statement that the applicant disclaims any exclusive right to one or more features disclosed in the views.

However, the applicant may use a description and explain the representation of the design in the application form. The description must relate only to those features which appear in the reproduction of the design.

Nevertheless, use of a description, within the meaning of Article 36 (3) a CDR, is not appropriate in this regard since a description “shall not affect the scope of protection of the design as such” according to Article 36 (6) CDR. Disclaimers must therefore be apparent from the representation of the design itself.

If the applicant is explaining the representation of the design, the description is not examined, but may be used by the examiner to take away any doubt. Examiners will record any verbal element in a design as a part of the examination of the application (once submitted) for search/identification purposes. Moreover, only an indication that a description has been filed is published, not the description as such (Article 14 (2) (d) CDIR).

Thus, it is notable that the protection is determined solely by the pictures in the register.

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

Finland:
Yes, a Partial Design forming part of a Product X may be infringed by the use of the same Partial Design on a Product Y.

The law does not limit the scope of protection to certain products. According to Section 5 of the Registered Designs Act, the scope of the protection conferred by a design shall include any design which does not produce on the informed user a different overall impression.

No link or nexus is required between Product X and Product Y. The scope of a design protection is not restricted to a specific product and thus, the products do not have to be the same. However, it should be noted that there is limited case law on registered designs in Finland, and even fewer regarding Partial Designs. We are not aware of any precedents in which the infringement of a Partial Design would have been discussed.

EU:
In EU design law, the applicable rule is similar (Article 5 of Community Design Regulation). The scope of the protection conferred by a Community design shall include any design which does not produce on the informed user a different overall impression. Thus, infringement exists if the accused design does not produce on the informed user a different overall impression.

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

Finland:
Yes, a Partial Design forming part of a Product X can be considered not novel in view of the same Partial Design in prior Product Y.

According to Section 2 of the Registered Designs Act a design shall be considered new if no identical design has been made available to the public before the date of filing of the application for registration or, if priority is claimed, the date of priority. Designs shall be deemed to be identical if their features differ only in immaterial details.

No link or nexus is required between Product X and Product Y. The scope of a design protection is not restricted to a specific product and thus, the products do not have to be the same.

EU
In EU design law, the applicable rule is similar (Article 10 of Community Design Regulation).

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.
Finnish and European Union 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 in the same way as other designs.

Finland:

According to Section 4 b of the Registered Designs Act “A design right shall not subsist in features of appearance of a product (2) which must be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated to be mechanically connected to or placed in, around or against another product so that either product may perform its function”

EU:

According to Article 8 (2) of the Council Regulation on Community designs “A Community design shall not subsist in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either product may perform its function”.

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.

No

Please Explain

The current law and practice relating to Partial Designs in Finland and in the European Union are good as Partial Designs and other designs are treated similarly.

However, it should be noted that there is limited case law on registered designs in Finland, and even fewer regarding Partial Designs. We are not aware of any precedents in which the infringement of a Partial Design would have been discussed.

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

Yes

Please Explain

Yes, the way of specifying, describing and depicting Partial Designs in Finland and in the European Union is satisfactory. However, there are currently some differences with the practice of the EUIPO mainly because the Finnish Patent and Registration Office has not implemented the Common Practice on the Convergence on graphic representation of designs.

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

No, the Unclaimed Part should not influence the protection of the parts of the design that are claimed. If Unclaimed Parts influenced the protection, the scope of protection would turn out to be indefinite and difficult to enforce and it would dilute the whole purpose of Partial Designs.
### III. Proposals for harmonisation

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


<table>
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<tr>
<th>Yes</th>
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**Please Explain**

*Design Constraints should restrict the subsistence and scope of protection of Partial Designs in the same way as other designs. There is no ground why Partial Designs and other designs should be treated differently.*

#### 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:

1. the design as shown and any Unclaimed Part; and/or
2. whether the Product is normally sold separately?

<table>
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<tr>
<th>Yes</th>
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**Please Explain**

*Yes and No: The design as shown should be taken into account, however, any Unclaimed Part or the fact whether the Product is normally sold separately should not be taken into account.*

#### 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?

<table>
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<th>No</th>
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**Please Explain**

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

<table>
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<tr>
<th>Yes</th>
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**Please Explain**
A Partial Design should be registrable as an independent design globally. For industry, companies and all applicants it is an effective and important weapon in the fight against copying and a very useful form of protection. By Partial Designs the applicants can e.g. protect new product features which they have created to differentiate their brands, many times the copycats try to steal these brand features and do not copy the complete product. Partial Designs make possible to protect the most important and innovative design features of the product and by protecting Partial Designs innovatively and wisely the applicants can get very strong and wide protection against others.

Partial Designs are also useful when facelift products are launched, the new design features of the facelift, e.g. new handle of a tool can be protected.

13 Is harmonisation of the law of Partial Designs desirable?

Yes

Please Explain

Yes, global harmonisation of the law of Partial Designs is desirable. It would make the protection processes easier and more cost-effective for industry, companies and all applicants. The harmonisation would mean also greater predictability for the applicants.

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.

The easiest and most cost-effective way is to use solid lines to specify (a) the Partial Design; and dashed lines to indicate (b) the Unclaimed Part. When solid lines and dashed lines cannot be used due to technical reasons, for example when photographs are used, other methods, such as use of boundaries and blurring, can be used to indicate the features for which protection is sought and not sought.

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 SC is the same as UP
Differences between the SC and UP should not be relevant when considering the overall impressions of the accused product and the Partial Design. If the differences between the SC and UP were considered, it would dilute the whole idea and purpose of Partial Designs. By registering a Partial Design, the applicant has claimed protection for specific design features and disclaimed the other features on purpose, e.g. industry, companies and applicants want to use the same handle for all kinds of pans. If the SC and UP were relevant, the scope of protection would be unclear and unpredictable and a Partial Design would not be any more useful form of protection for applicants.

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

Differences between the SC and UP should not be relevant when considering the overall impressions of the accused product and the Partial Design. If the differences between the SC and UP were considered, it would dilute the whole idea and purpose of Partial Designs. By registering a Partial Design, the applicant has claimed protection for specific design features and disclaimed the other features on purpose, e.g. industry, companies and applicants want to use the same handle for pans and pots. If the SC and UP were relevant, the scope of protection would be unclear and unpredictable and a Partial Design would not be any more useful form of protection for applicants.

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

Differences between the SC and UP should not be relevant when considering the overall impressions of the accused product and the Partial Design. If the differences between the SC and UP were considered, it would dilute the whole idea and purpose of Partial Designs. By registering a Partial Design, the applicant has claimed protection for specific design features and disclaimed the other features on purpose, the idea is to get as wide protection as possible, e.g. the applicant does not want that toy pans with the same handle are sold. If the SC and UP were relevant, the scope of protection would be unclear and unpredictable and a Partial Design would not be any more useful form of protection for applicants.

Design laws should be harmonised globally so that the product classes and terms used do not limit the scope of protection, in the same way as in Council Regulation on Community designs and in Directive.

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

Differences between the SC and UP should not be relevant when considering the overall impressions of the accused product and the Partial Design. If the differences between the SC and UP were considered, it would dilute the whole idea and purpose of Partial Designs. By registering a Partial Design, the applicant has claimed protection for specific design features and disclaimed the other features on purpose, e.g. industry, companies and applicants want to use the same handle for frying pans and sauce pans. If the SC and UP were relevant, the scope of protection would be unclear and unpredictable and a Partial Design would not be any more useful form of protection for applicants.

Design laws should be harmonised globally so that the product classes and terms used do not limit the scope of protection, in the same way as in Council Regulation on Community designs and in Directive.

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

Differences between the SC and UP should not be relevant when considering the overall impressions of the accused product and the Partial Design. If the differences between the SC and UP were considered, it would dilute the whole idea and purpose of Partial Designs. By registering a Partial Design, the applicant has claimed protection for specific design features and disclaimed the other features on purpose, the idea is to get as wide protection as possible, e.g. the applicant does not want that the handle designed by them for pans and pots is used for paintbrushes. If the SC and UP were relevant, the scope of protection would be unclear and unpredictable and a Partial Design would not be any more useful form of protection for applicants.

Design laws should be harmonised globally so that the product classes and terms used do not limit the scope of protection, in the same way as in Council Regulation on Community designs and in Directive.
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.

Unclaimed Part should not be taken into account when analysing the overall impression of a Partial Design for both individual character and infringement as the Unclaimed Part should not influence the protection of the parts of the design that are claimed. A Partial Design should be treated as any other design.

If Unclaimed Parts influenced the protection, the scope of protection would turn out to be indefinite and difficult to enforce and it would dilute the whole purpose of Partial Designs.

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.

Partial Designs should be treated as any designs and therefore the Design Constraints should be taken into account in a similar manner as with any designs.

Must fit / must match Design Constraints have increased popularity of Partial Design protection among applicants. By protecting a Partial Design the problematic with must fit / must match features can be avoided many times.

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

No additional comments

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

Consumer goods
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

Yes, protection is given to partial designs.


The legal system relating to partial designs, a concept which is unknown under French or European Union law, is identical to that relating to designs covering a whole product.

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

3. 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.

It is important to note that visual indications relating to exclusions are based on practice and are not derived from legislative or regulatory provisions.

Exclusions may be used where the graphic or photographic representation of the design contains parts of the product for which no protection is being claimed. In such cases, exclusion has to be clear and obvious: the elements that are being claimed and those that are not being claimed have to be clearly differentiated.

A common communication from the European Trade Mark and Design Network dated 15 April 2016 sought to harmonize conditions for the graphical representation of designs by different Offices, including INPI (for applications after 15 July 2016) and EUIPO (for pending applications and applications after 15 April 2016) (Convergence on graphic representations of designs: https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/about_euipo/who_we_are/common_communication/common_communication_7/common_communication7_en.pdf).

This communication makes clear reference to visual exclusions to designate those parts of the design that are not being claimed when that design is being represented.

Accepted visual indications of exclusions are:
- Broken lines,
- Colour shading,
- Boundaries,
- Blurring.

However, as these techniques are based on practice and recommendations, there is nothing to stop new techniques being taken into account in the future.

As far as the Hague System is concerned, the Administrative Instructions for the Application of the Hague Agreement (which came into force on 1 July 2014) (http://www.wipo.int/treaties/en/text.jsp?file_id=337316), instruction 403 relating to disclaimers states that “matter which is shown in a reproduction but for which protection is not sought may be indicated … (ii) by means of dotted or broken lines”. However, the use of colours is tolerated.

As a result, elements which are shown in a reproduction but which do not form the subject of an application for protection may be indicated in a reproduction by means of dotted or broken lines or colours.

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

No

Please Explain

No.

A description may be given, but it has no legal scope under either French or European Union law (Article R. 512-3.2 of the French Intellectual Property Code and Article 36(6) of Regulation (EC) No 6/2002).

Under French law, the description is provided exclusively for documentation purposes and, under European Union law, the above Regulation states that the subject and extent of protection of a registered Community design are determined only by the views which are supplied during registration and cannot be replaced or supplemented by the description.

This solution is applied by the case law: “The subject and extent of protection of a registered Community design are determined only by the views which are supplied during registration and cannot be replaced or supplemented by the description” (General Court, 21 June 2017, T-286/16, Ernst Kneidiger v. EUIPO, Topseat International – (toilet seat), paragraph 44).

Administrative instructions and practical advice on the filing of international designs encourage the provision of a description to specify the graphic representations in dotted lines, broken lines or colours. However, given that France and the European Union are the Contracting Parties, this description will have no legal value pursuant to the above provisions.
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.

No

Please Explain

No.

A verbal disclaimer can be included in the description before INPI or EUIPO, but it has no legal scope (see Q. 2.b hereinabove).

Conversely, it is possible to use a verbal disclaimer in order to exclude the unclaimed parts of a product in the Hague System, but only with regard to Contracting Parties who accept such wording, which excludes the legislation under consideration (see Article 7.5.a of the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement and instruction 403 relating to Disclaimers and Matter That Does Not Form Part of the Industrial Design or the Product in Relation to Which the Industrial Design is to be Used).

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

Yes.

A Partial Design representing part of a Product X can be infringed by the use of the same Partial Design within a Product Y.

The protection afforded to a design extends to any design which does not produce on the informed user a different overall visual impression. It is therefore necessary to consider the overall visual impression given by the earlier design based on the views as filed.

However, as will be examined in question 4, the overall impression is assessed by taking into account elements outside the scope of protection claimed, and possibly the unclaimed portion of the product during filing. Nevertheless, the unclaimed portion will be one of a number of indications and cannot under any circumstances be a differentiating and determining factor as it is outside the scope of protection being claimed.

The same approach will be adopted with the supposedly infringing product within which the portion corresponding to the reproduced design will be isolated, whether the latter otherwise be a partial design or a design covering the whole product. The overall impression given by this portion will be assessed, ignoring the rest of the product.

This reasoning is consistent with the fact that the protection of a design protects the appearance of a product through its overall impression and that the regulations require that the overall impressions be identical (même/same), not that there is a likelihood of confusion. Consequently, it is normal for unclaimed elements or other elements of the infringing product not to be differentiating.

Unlike in trade mark law, which is governed by the principle of speciality, design law affords proprietors the right to object to any imitation irrespective of the nature of the incriminated products, even if they are different. Again, taking unclaimed elements or a portion that is supposedly not infringing into account would be contrary to this principle.

The following Court decision may be cited by way of example:

Accordingly, it must be held that if ESS’s position that a design’s protection depends on the nature of the product in which that design is incorporated or to which it is applied were to be accepted, such protection would be limited only to the designs belonging to a specific sector. Such a position cannot therefore be accepted.

In addition, as the General Court was right to hold in paragraph 115 of the judgment under appeal, it follows from both Article 36(6) and Article 19(1) of Regulation No 6/2002 that a registered Community design confers on its holder the exclusive right to use the relevant design in all types of products, and not only in the product indicated in the application for registration (CJEU, No C 361/15 - 21 September 2017, Easy Sanitary Solutions BV).

The Working Group is unaware of any case law involving a partial design for which the views contain visual indications of exclusion from protection. However, the decision below illustrates the previously described approach:

‘[…] Whereas the two CARTIER designs represent empty dials; whereas, contrary to the respondents’ assertion, it is not a question of
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.

Yes.

A partial design protecting only part of a product may jeopardize the novelty and individual character of a later partial design used in another product.

It should be noted that the Working Group has considered not only the novelty of a design, but also its individual character, the validity of the right being conditional upon each of the two concepts.

The French and European courts have been found to adopt a harmonized approach to the subject in accordance with several decisions by the latter setting out the principles. A common approach has also been found to have been adopted in relation to the question of whether an earlier design relating to a partial design should be taken into account in respect of novelty or individual (or personal) character.

In its Karen M F Ltd v. Dunnes Stores et Dunnes Stores (Limerick) Ltd decision (case C-345/13) handed down on 19 June 2014, the CJEU declared that Article 6 of the Regulation had to be interpreted as meaning that, in order for a design to be considered as having individual character, the overall impression produced by that design on the informed user must be different from that produced on such a user not by a combination of features taken in isolation and drawn from a number of earlier designs, but by one or more earlier designs taken individually as a whole, and not by an amalgamation of various elements of earlier designs.

In those circumstances, the answer to the first question is that Article 6 of Regulation No 6/2002 must be interpreted as meaning that, in order for a design to be considered to have individual character, the overall impression which that design produces on the informed user must be different from that produced on such a user not by a combination of features taken in isolation and drawn from a number of earlier designs, but by one or more earlier designs taken individually as a whole, and not by an amalgamation of various elements of earlier designs.

This solution applies mutatis mutandis to the assessment of novelty which cannot be destroyed by a combination of elements originating from a number of earlier designs or by isolating one element of an earlier design.

Conversely, the inclusion of the earlier partial design in a separate product does not prevent it being taken into account in the assessment of novelty as long as the designs are examined as a whole taking into account all of the parts that are still visible and assessing whether or not there are any differences which are not immaterial. What is not allowed, is to artificially isolate the partial design from the product in which it is incorporated or to which it is applied.

The decision of the General Court in case T-15/13, Group Nivelles, is very clear on this point:

In order to assess the novelty of the contested design it should have examined whether there were differences that were not immaterial between all the visible features of that design and all those of the earlier design in question, without limiting itself only to the cover plate that was part of the earlier design (paragraph 84).

(…) Accordingly, an earlier design incorporated in or applied to a product that is different from the one to which the later design relates is, in principle, relevant for the purposes of assessing the novelty, within the meaning of Article 5 of Regulation No 6/2002, of that later design (paragraph 123).

The court also points out that the nature of the product does not matter because it is not the product that is being protected but its appearance:

With regard to that finding, it should also be held that a Community design cannot be regarded as being novel, for the purposes of Article 5(1) of Regulation No 6/2002, if an identical design has been made available to the public before the dates specified in that provision, even if that earlier design is intended to be incorporated into a different product or to be applied to a different product (paragraph 116).

This reasoning has also been favourably received by the French courts. The judgment of the High Court of Paris, Court 3, Section 1, 12 January 2017 – No 15/07865, may be cited by way of example:

The novelty of a Community design, a concept distinct from originality in respect of which its validity is irrelevant, is objective. It is assessed by means of an overall comparison between the design as filed upon registration or, if not, as described and produced, and the design disclosed
earlier which is being cited against it, both taken as a whole consisting of the combination of their characteristic features, and not by means of an examination of each of the features of which they consist taken in isolation. Novelty is only destroyed if the design and the creation disclosed are identical, this identity being derived from the absence of any differences or from the existence of immaterial differences found during this overall examination. It is not destroyed by the designs merely being similar.

It will therefore be necessary, without taking the nature of the products into account, to examine them as a whole and assess whether or not there are any differences which are not immaterial.

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.

No.

There is no legislative provision under the law in question requiring the unclaimed part to be taken into account in the assessment of constraints placed on the partial design. However, this is derived from the case law.

The definition of constraints provided in the Study Guidelines limits them to constraints derived from functional and interconnectional forms, excluding legal constraints (standardization) which are also taken into account under the law in question.

The constraint associated with functional form may be found when assessing individual character and when assessing the exclusively functional characteristics of the appearance of a product. The constraint associated with interconnectional form is associated with the functional form in terms of its intended use and not its form per se.

Individual character will be assessed taking into account the overall impression produced by the design on the informed user, whereas the other two constraints, the exclusively functional form and the interconnectional form, relate to the appearance of the product without reference to the informed user.

If individual character is considered, it should be noted that when assessing the individual character of a design (…), it is necessary to take into account the nature of the product to which the design applies or in which it is incorporated and, in particular, (…), the degree of freedom of the creator in producing the design, (…), (General Court, 29 October 2015, T-334/14, paragraph 17).

European Union case law therefore requires an analysis in concrete based on the nature of the product in order to evaluate, in particular, the freedom given to the creator. However, the degree of freedom of the creator of a design is defined on the basis, in particular, of constraints associated with characteristics imposed by the technical function of the product or of an element of the product (General Court, 29 October 2015, T-334/14, paragraph 35).

It will therefore be necessary to carry out an overall analysis taking into account all of the facts, such as the title of the design, its normal use, the relevant class in the Locarno classification, or any other element and, in particular, the unclaimed part represented on filing. But there is no obligation to take the unclaimed part into account.

References to the product in which the design is incorporated or to an element of the product clearly indicate that this reasoning applies to partial designs.

This reasoning has been transposed into internal law:

In itself, the claimed design, despite being entitled “electronic cigarette”, consists of just one of the components of an electronic cigarette, that is to say the atomizer. In this respect, although not zero, the degree of freedom of the creator has to be considered to be small because this product has to meet certain technical constraints in that it plays a role in the functioning of an electronic cigarette as it has to be inserted between the battery and the cartridge and enable the vaporization of the liquid contained in the cartridge by heating it by virtue of resistance connected to the battery (High Court of Paris, Court 3, Section 2 – No RG 14/17280 - 16 September 2016).

As far as the exclusively functional form and the interconnectional form are concerned, Article 8 of the Regulation and Article L. 511-8 of the French Intellectual Property Code refer to the appearance of the product and not to the concept of the overall impression. It is also important to note that these articles relate to the product, whereas the articles defining protection of a design relate to the appearance of the product or part of a product. The difference is no accident.

By product, Article 8 of the Regulation and Article L. 511-8 of the French Intellectual Property Code refer to the product as a whole, even if the design is partial and protects only part of it. This is also inferred from the reference to the “features of the appearance”.

This wording makes it possible to treat as functional those partial designs partly covering an exclusively functional form, even though the portion of that form covered by the partial design, taken on its own, is not functional.

There is certainly a need here to consider the product as a whole and therefore to take the unclaimed portion thereof into account whether or not it was represented on filing.
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.

There has been found to be a lack of harmonization in the practices of INPI, EUIPO and the International Bureau (WIPO) in terms of the representation of excluded parts (dotted lines, chain-dotted lines or others), and practices concerning descriptions.

As far as rights which may be enforceable in the same territory are concerned, a harmonized interpretation of claimed or unclaimed parts upon filing is desirable. A solution recommended by the Working Group would be to align the practices of WIPO within the framework of the Hague System with the rules adopted by the European Trade Mark and Design Network (CP6).

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

No.

Please Explain

As mentioned in relation to question 6, the Group thinks that the harmonized practices of INPI and EUIPO are satisfactory, but not the practices of WIPO which are perceived to be still too restrictive in terms of the graphic methods that can be used.

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

No, the unclaimed parts of a product should not influence the protection of the only part that is claimed.

This is because, when one or more elements of a product are not being claimed, they are quite simply outside the scope of protection.

That said, in situations where the only representation of the partial design does not give a sufficiently precise idea of the nature of the product and therefore of its function and the constraints placed upon its creator, one cannot completely ignore contextual elements such as the unclaimed parts of a partial design, but should give them no greater importance than other contextual elements such as the title given to the design, any description thereof, details of the Locarno Class in which it falls, and the practical methods of using the specific product to which the design applies.

In this respect, paragraph 5.3.2 of the EUIPO guidelines for examination of design invalidity applications states as follows:

“In order to determine whether the essential features of the appearance of the product into which the contested Community design will be incorporated are solely dictated by the technical function of the product, it is first necessary to determine what the technical function of that product is. The relevant indication in the application for registration of the design (Article 36(2) CDR) should be taken into account, but also the design itself, insofar as it makes clear the nature of the product, its intended purpose or its function (see by analogy, judgment of 18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, §56).”

These principles appear to make good sense. According to this logic, the context of a partial design could be taken into account, but it seems to us that this only has to take place in cases where there is no other obvious way of determining the technical function of the product or the
Should Design Constraints restrict the subsistence and scope of protection of Partial Designs? Please explain why or why not.

Yes

Please Explain

As mentioned, the law in question does not distinguish between “whole” designs and designs referred to as partial designs. Consequently, constraints on design are assessed in the same way for a “whole” design and a partial design and it would be inconsistent to establish a specific system for the latter. A contrary solution would result in a dual system that would be the source of complications and difficulties for operators.

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:

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

No

Please Explain

The answer is no in terms of assessing novelty, but yes if one is looking at the overall impression upon which personal or individual character is conditional, and the scope of protection.

Novelty is assessed objectively without taking the informed user into account, whereas the overall impression is a partly subjective construction because it refers to that same user which is determined by the function of the product in which the design is incorporated.

It follows that identification of the product to which an earlier design applies or in which the latter is incorporated, relied on in order to dispute the individual character, within the meaning of Article 6 of Regulation No 6/2002, of a later design, is relevant for that assessment. It is through the identification of the product concerned that it will be possible to determine whether the informed user of the product to which the later design applies or in which the later design is incorporated is aware of the earlier design. It is only if that latter condition is fulfilled that the earlier design may prevent the later design from being recognised as having individual character (General Court, 13 May 2015, T-15/13, Group Nivelles v. OHIM and Esay Sanitary Solutions BV, paragraph 132).

It is therefore important to know the product or products in which the partial design might be incorporated or to which it might be applied. The reasoning is similar to that for question 8.

10.b. whether the Product is normally sold separately?

No

Please Explain

No, because this state of affairs is solely down to economic operators and the validity or scope of an industrial property right cannot be based on such circumstantial factors.

Moreover, the General Court has already had occasion to state that commercial considerations do not have to be taken into account when assessing the freedom given to the creator (General Court, 29 Oct. 2015, T-334/14).
It would be illogical to take such considerations into account in order to determine the nature of a design and it would harm the unity of the system.

**III. Proposals for harmonisation**

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

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

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

Yes

Please Explain

13. Is harmonisation of the law of Partial Designs desirable?

Yes

Please Explain

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.

We think that the guidelines entitled “European Trade Mark and Design Network – Convergence on graphic representations of designs - Common Communication – 15 April 2016” are suitable.

- Visual exclusions = these indicate the elements for which protection is not being claimed

The visual exclusion has to be obvious from the representation of the design. There has to be a clear distinction between claimed elements and elements to which an exclusion relates (page 21 of the above document).

The visual exclusion has to be obvious from the context of the design as a whole.

Where the representation of the design consists of a drawing, it is recommended that broken lines be used to show the visual exclusion.

However, where broken lines cannot be used for technical reasons (for example, where they serve to indicate seams on clothing or motifs, or where photographs are used), the use of blurring, colour shading or boundaries is recommended.
Different types of visual exclusions (page 22 et seq. of the above document)

- Broken lines
- Blurring
- Coloured shading
- Boundaries

As to a description, we are of the opinion that this should remain optional and for documentation purposes.

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.

15.a SC is the same as UP

No. SC and UP are not taken into account, irrespective of whether they are identical.

Only the claimed part of the protected design and the contested part of the accused product are compared.

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

No. SC and UP are not taken into account, irrespective of whether they relate to products that are used in the same way.

Only the claimed part of the protected design and the contested part of the accused product are compared.

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

No. SC and UP are not taken into account, irrespective of whether they relate to products that look the same.

Only the claimed part of the protected design and the contested part of the accused product are compared.
SC is not the same as UP, but SC and UP relate to products that are categorised in the same way when registering designs.

No.

The fact that SC and UP refer to products belonging to the same class of products in the Locarno classification or any other classification is irrelevant.

Only the claimed part of the protected design and the contested part of the accused product are compared.

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

No.

Only the claimed part of the protected design and the contested part of the accused product are compared, SC and UP are irrelevant.

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.

The unclaimed portion of a design is outside its scope of protection and should not influence the overall impression produced, whether this is when assessing individual character or infringement. It is one of the specific benefits of partial filing, that is to say of restricting said assessment to what is being claimed, ignoring UC. The aim is to achieve independent protection of the claimed part and not make this protection conditional upon elements outside what is being claimed.

This answer is applicable whether the designs in question belong to identical, different or associated sectors.

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.

There is no difference between partial designs and other designs in relation to the question of assessing the exclusively functional nature of the form or the must fit/must match criteria.

This lack of difference has to be maintained because there is no objective reason to introduce a differentiated approach.

These constraints have to be assessed exclusively on the basis of the design as filed, taking into account only the part for which protection is being claimed. It would not be consistent, in particular with the principles governing the assessment of individual character or of infringement, to examine a filed design from the point of view of elements for which protection is not being claimed.

Conversely, UP, like the title, the classification or the normal use of the product, will be one of the non-binding factors which will be taken into account when determining whether the form has a technical purpose or whether it is intended to be incorporated into another product. This is because filing does not necessarily provide any information on these points and the assessment thereof sometimes requires a body of evidence.

Please comment on any additional issues concerning any aspect of Partial Designs you consider relevant to this Study Question.
Please indicate which industry sector views are included in your Group’s answers to Part III.

Electrical goods
Motorization for doors, gates; home automation
Sports equipment
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 Designs, 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].
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:

![Image not readable or empty](file:///C:/Users/kuenzel/AppData/Local/Temp/msohtmlclip1/01/clip_image002.png)

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]:

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[1]: [Link]
[2]: [Link]
[3]: [Link]
[4]: [Link]
[5]: [Link]
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]:

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].

Different types of visual disclaimers can be combined.
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

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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).

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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].

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Footnotes
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

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, l.c., Writing Utensils [see footnote No. 14].

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

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 [Gemeinschaftsgeschmacks muster], 2nd ed. 2010, Article 7, at margin No. 38 [footnote No. 46].

Please explain if your Groupâ€™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 improve (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

**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:

- **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.

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**

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

**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

Harmonisation 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).

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.

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, l.c., Writing Utensils [see footnote No. 14].

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.
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].

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.

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

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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.
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

Yes, under Hungarian law partial designs may be protected. The Hungarian Design Act[^1] states that the design means the appearance of the whole or a part of a product, therefore partial designs are accepted. There is no difference in applicable law for partial designs and designs in general.

Footnotes

1. ^ Act XLVIII of 2001 on Legal Protection of Designs

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

3. 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
In 15 July, 2016 Hungary amended the provisions of design applications pursuant to CP6. Thus, since then it is allowed to indicate in the application non-solid lines (dotted or dashed lines), shading or colouring, or boundaries. The Hungarian design law does not expressly provide for specified acceptable ways for visual disclaimers, it only states that the visual disclaimer must indicate clearly which part of the design is sought to be protected and which part is unclaimed.

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

Yes

Please Explain

The application may contain a so called ‘declaration of alteration’. Before 15 July, 2016 such declaration served as a verbal disclaimer, and there was no other way of indicating the disclaimer. Now, under the new regime it is only for the purpose of clarification. The declaration of alteration may be lodged either with the application form or later, but must clearly indicate which part of the design is unclaimed. However, the applicant must enclose the graphical representation of the design including the visual disclaimers to the declaration of alteration, therefore the importance of the declaration is rather low nowadays.

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. The declaration of alternation used to serve as a verbal disclaimer. Under the current regime, in case of attaching the declaration of alteration, the verbal disclaimer must be indicated graphically in the design itself as visual disclaimer and such disclaimers must not be contradictory.

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

Yes, general infringement test is applicable. The registered partial design X and accused partial design Y should produce different overall impression on the informed user to avoid the infringement.

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

Yes, general objective novelty test is applicable. The partial design is considered new if no identical partial design has been made available to the public before the date of priority. The partial designs are deemed identical if their features differ only in immaterial details.
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. The Hungarian Group is of the view that the possibility of attaching a declaration of alternation (verbal disclaimer) should be considered to be discontinued. A verbal disclaimer is not that important since the visual declaimers may be placed on the design, therefore with the opportunity of submitting a verbal disclaimer, there is a risk of unwanted reduction in terms of the scope of protection. Likewise, a verbal disclaimer might impose further risks if the visual and verbal disclaimers are not fully consistent.

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

Yes

Please Explain

Yes, as visual disclaimers may be used pursuant to CP6.

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

No. The “what you see is what you get” approach is relevant in the European and also in the Hungarian design law. In case the applicant does not wish to protect the unclaimed part, then such part should not influence the scope of protection of the design.


Yes

Please Explain

Yes, in the same ways as regarding the “normal” designs. No differentiation is necessary in this respect.
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:

- the design as shown and any Unclaimed Part; and/or

Yes

Please Explain

Yes, to apply the Design Constraints, such as the repair clause, the complexity of the product should be taken into consideration (and check whether it is a must match or must fit design).

10.a. whether the Product is normally sold separately?

Yes

Please Explain

In view of the Hungarian group, the circumstances of selling the product that the design is based on might be relevant. Such circumstances may indicate whether or not the design shall be considered as a Partial Design. Nevertheless, the mere fact that the product is sold separately should not, per se, determine the nature of Partial Designs.

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?

Yes

Please Explain

The Hungarian Group is of the opinion that an HIPO Design Guidelines on Hungarian national designs would be more than welcome.

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

13. Is harmonisation of the law of Partial Designs desirable?

Yes

Please Explain
Yes, the assessment whether the unclaimed part should be taken into account when considering the overall impression of a design should clearly be harmonized. Also, the borderline between partial designs and being part of a complex product needs further harmonization.

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.

The Hungarian Group is of the view that the framework laid down by CP6 is efficient and clear in this respect.

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.

15.a SC is the same as UP

No. The overall impression of the accused product and the Partial Design produced on the informed user should be determined by taking into account only the actual registered earlier Partial Design and the relevant part of the accused product. In case we take into account either the UP or the SC, the assessment will provide an unwanted outcome since with different SCs or UPs it is rather easy to establish different overall impression, even if the registered Partial Design and the accused product without the SC is exactly the same. In case this method was to be followed, Partial designs could easily be ‘copied’ and used with different SCs without qualifying as infringement.

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

No. SC an UP should not be relevant when considering the overall impressions of the accused product and the Partial Design. For further reasoning see the answer provided under point a).

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

No. SC an UP should not be relevant when considering the overall impressions of the accused product and the Partial Design. For further reasoning see the answer provided under point a).
SC is not the same as UP, but SC and UP relate to products that categorised in the same way when registering designs.

No, SC an UP should not be relevant when considering the overall impressions of the accused product and the Partial Design. For further reasoning see the answer provided under point a).

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

No, SC an UP should not be relevant when considering the overall impressions of the accused product and the Partial Design. For further reasoning see the answer provided under point a).

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.

The Unclaimed Part should not be taken into account. For further reasoning see the answer provided under div 15 point a).

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 the Hungarian Group is of the view that the Unclaimed Part should not affect the scope of protection of Partial Design, there is no such rule to be proposed in terms of Design Constraints arising from the Unclaimed Part and affecting the Partial Design.

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

N/A.

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

Yes. Partial designs are statutorily permitted as being prescribed in the Patent Act. The laws are not different generally because, by definition, “design” means the creation made in respect of the shape, pattern, color, or any combination thereof, of an article as a whole or in part by visual appeal.

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

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, unclaimed portions are distinguished by using broken lines such as dotted or dashed lines, grayscale area, or semi-transparent coloring. To distinguish the claimed area from the unclaimed, “dot-chain lines” are used to demarcate the boundary. Dot-chain itself is disclaimed.

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

Yes

Please Explain

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.

No

Please Explain

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.

No

Please Explain

No. Not even the same partial design used on different locations of a product constitutes infringement.

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.

No

Please Explain

No. A partial design on product X is novel if it is on product Y, assuming products X and Y are not identical nor similar.

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.

Yes, our laws take the Unclaimed Part into consideration regarding the scope of the Partial Design. Unclaimed area is purposed to explain the product used, the location, size, distribution of the Claimed Part, or the environments of the Claimed Part.

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.

No
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7. **Is the way of specifying, describing or depicting Partial Designs satisfactory?**

Yes

**Please Explain**

Yes. We believe so.

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

Yes

**Please Explain**

Yes, as described above, if a Partial Design forming part of a Product X, the protection of the Partial Design may not be extended to the same design on a Product Y. In such sense the Unclaimed Part does affect the protection of the design. The Unclaimed Part affects the Claimed Part by being served to explain the same.

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

No

**Please Explain**

No. Must-fit/Must match/technical function constraints are not eligible for design protection, which should be "decorative" or "visually appealing."

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:**

   - **the design as shown and any Unclaimed Part; and/or**

Yes

**Please Explain**

Yes. The assessment of whether a design is for a portion of a whole Product should be taken into account. Unclaimed Part should be taken into account so as to better illustrate the Claimed Part’s relative location, distribution, and size on the product that it applies to.
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

13. Is harmonisation of the law of Partial Designs desirable?

No

Please Explain

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.

(a) the Partial Design: use solid lines to depict graphically and describe what product it is a part of,

(b) the Unclaimed Part: use broken lines (such as dotted lines or dashed lines) to depict graphically, use dot-chain lines to demarcate the boundary, and describe that the broken lines and dot-chain lines form no part of the design).

Alternatively, any other means (such as shading or coloring) that can distinguish the claimed part from the unclaimed part may be used to
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.

1. SC is the same as UP

The accused product infringes since the two products are identical objects.

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

The accused product infringes since the two products are of similar usage.

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

The accused product does NOT infringe because SC and UP are neither in the same category of objects or usage.

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

The accused product infringes because the two products are in the same category of object when registering designs.

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

The accused product does NOT infringe.

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.

Identity and similarity of the product usage is material to a partial design. If the Unclaimed Part causes the product to which the subject partial design applies to be used differently in the purpose, usage, or category from the accused product, the accused product is not infringing.
Likewise, where there is such a prior art, the partial design is novel.

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.

Must-fit/Must match/technical function constraints shall be regarded as a consideration affecting eligibility of the design protection and should not be taken into consideration in determining the design scope because they do not relate to visual effect, which is the fundamental requirement of a patentable design.

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

n/a

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

Motorcycle industry.
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

Pursuant to article 31 of Italian Intellectual property code (Legislative Decree No. 131/2010, hereinafter the IIPC) implementing the EC Directive No. 98/71: “the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product itself or its ornamentation” can be registered as design in Italy. This definition is suitable to include also the Partial Designs. Furthermore, pursuant to article 35 of the IIPC “a design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character (a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter, and (b) to the extent that those visible features of the component part fulfill in themselves the requirements as to novelty and individual character”. Therefore, Partial Designs are protected in Italy if they remains visible during normal use of the relevant product and to the extent they fulfill per se the requirements of protection of design set forth in Italy, and notably novelty and individual character.

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

See below.
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

In the practice it is preferred to draw by dotted lines the elements that are not part of protection. According the Italian law, it is required a formal description of the design, so it is possible to disclaim the protection for the elements drawn in dotted lines (or in any other way it is desired by the applicant).

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

Yes

Please Explain

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

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

Pursuant to article 41 of the IIPC "the scope of the protection conferred by a design shall include any design which does not produce on the informed user a different overall impression. In assessing the scope of protection, the degree of freedom of the designer in developing his design shall be taken into consideration". Under this rule, it can be inferred that a Partial Design forming part of a Product X is infringed by the use of the same Partial Design on a Product Y, to the extent that such Partial Design on Product Y does not produce on the informed user of the relevant field a different overall impression. Based on this principle, infringement is less likely to occur between Product X and Product Y should they pertain to different fields. If we considered the specific example given, the use of the Partial Design on the Product Y can infringe the design rights on the Partial Design (to the extent such Partial Design can be deemed new and with an individual character), considering that the fields of Product X and Product Y are the same.

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

Pursuant to article 32 of IIPC: "a design is new if no identical design has been made available to the public before the date of filing of the application [...] Designs shall be deemed to be identical if their features differ only in immaterial details". Under this rule, it can be inferred that if a Partial Design forming part of a Product X is identical to (or its features differ only in immaterial details from) a Partial Design in prior Product Y, such Partial Design is considered not novel (regardless of the relevant field of the products, as the assessment of novelty requirement does not rely on the overall impression of the informed user). Pursuant to article 33 of IIPC "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 date of filing of the application for registration or, if priority is claimed, the
II. Policy considerations and proposals for improvements of your Group’s current law

The IIPC does not expressly take into account elements outside the scope of the Partial Design when considering the application of Design Constraints, which thus are to be assessed based on the same rules applicable to all designs.

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.

The correct application of current rules seems enough to ensure a balance between the interest of the registrant and of the third parties.

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

No

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

Yes

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

Yes

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

Yes
Design Constraints shall restrict the subsistence and scope of protection of Partial Design according to ordinary rules applicable to the protection of design.

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:

- the design as shown and any Unclaimed Part; and/or

Yes

Please Explain

To the extent that the positioning and relation between the Partial Design and the Unclaimed Part is likely to influence the informed user’s overall impression in assessing the infringement of the Partial Design pursuant to article 41 of IIPC (see above answer to question 3).

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

N/A

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

13. Is harmonisation of the law of Partial Designs desirable?

Yes

Please Explain

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

Dashed lines (and/or shaded colours) could be used to identify the Unclaimed Part, while and straight lines and not-shaded colours for the Partial Designs. This solution seems to be applied in many countries.

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.

15.a SC is the same as UP

In this case differences should not be relevant in assessing the overall impression of the relevant designs, as the reproduction of a Partial Design in products of the same kind should per se entail that the informed user cannot have a different overall impression based to differences between UP and SC.

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

In this case differences should be relevant in assessing the overall impression of the relevant designs, although the reproduction of Partial Designs in products used in the same way and covering the same needs is likely to entail the informed user have the same overall impression despite the possible differences between UP and SC.

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

In this case differences should be relevant in assessing the overall impression of the relevant designs, in that the reproduction of Partial Designs in products that look the same but are used/known in different fields, may entail that the informed user has a different overall impression in light of assessing individual character and infringement.

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

In this case differences should be relevant in assessing the overall impression of the relevant designs, as registration categories should not be per se material with respect to individual character and infringement.
SC is not the same as UP, and SC and UP are entirely unconnected.

In this case differences should be relevant in assessing the overall impression of the relevant designs, in that the reproduction of Partial Designs in products entirely different and unconnected, may entail that the informed user has a different overall impression in light of assessing individual character and infringement.

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 a general principle, when assessing novelty/individuality and infringement, the Unclaimed Part should be taken into account in order to define the scope of the right claimed/asserted. Notably, the figure through the eyes of whom the overall impression of relevant designs should be assessed (in Europe the figure is the “informed user”) shall be construed with regard to the market in which the Partial Design seeking protection is used. The Unclaimed Part offers clear indication on this market and shall then be taken into account for this purpose.

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.

The current European legislation on Design Constraints seems adequate to regulate this matter in relation to Partial Designs.

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

N/A

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

N/A
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

Article 2 (1) of the Japanese Design Act

The laws for the protection of Partial Designs and designs in general are Not Different, as provided in 71.4 of the Examination Guidelines for Design (hereinafter called "the Guidelines"):

In order for the subject matter of an application for registration of a partial design (see Note) to be registered, it must comply with all of the following requirements, as in the case of an application for registration of a whole design:

(1) It must be an industrially applicable design,

(2) It must be novel,

(3) It must involve creative difficulty, and

(4) It must not be a design in a later application that is identical or similar to part of a design in a prior application,
(Note): The subject matter of an application for registration of a partial design refers to a subject matter on which the examiner has yet to determine whether or not it is a "design" as defined in Article 2(1) of the Design Act.

Also in 71.4.1.3 of the Guidelines:

The article to the design of a partial design must be industrially applicable. Meanwhile, the industrial applicability of the "part for which the design registration is requested" is not to be determined.

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

71.2.2 of the Guidelines:

(3) Specification of the "part for which design registration is requested"

The "part for which design registration is requested" must be specified by drawing the "part for which the design registration is requested" with solid lines and "any other parts" with broken lines.

Form No.8 Note (3) of the Ordinance:

To apply for design registration of a part of an article, specify the "part for which design registration is requested" by shading the article to the design in black, except that part.

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

Related provisions are found in the Guidelines and the Ordinance for Enforcement of the Design Act (hereinafter called "the Ordinance").

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

Yes

Please Explain

In a design application for Partial Design, it is necessary to state that it is a Partial Design and describe how the "part for Partial Design registration" is identified.

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.
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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

Specifically, the following relationships must exist between X and Y:

(i) Intended purposes and functions of both articles (i.e. Products X and Y) are identical or similar.
(ii) Intended purposes and functions of the "Partial Design for Product Y" are identical or similar to those of the "Partial Design for Product X."
(iii) The shape and/or appearance of the "Partial Design for Product Y" is identical or similar to that of the "Partial Design for Product X."
(iv) The position, size and area of the "Partial Design for Product Y" are substantively identical to those of the "Partial Design for Product X" in the art of the design.

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

This can be explained based on 71.4.2.2.1 of the Guidelines:

(i) Product X and Product Y are identical or similar.
(ii) Intended purposes and functions of the "part of Product X" in a design application for Partial Design are identical or similar to those of the part of a publicly known design which corresponds to the "part of Product Y."
(iii) The shape and/or appearance of the "part of Product X" in a design application for Partial Design is identical or similar to that of the part of a publicly known design which corresponds to the "part of Product Y."
(iv) The position, size and area of the "part of Product X" relative to the form of the whole article in a Partial Design application are identical to those of the part of a publicly known design which corresponds to the "part of Product Y" or within the range of those that are considered commonplace.

The two designs are likely to be considered as identical when all of (i) through (iv) above are met.

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.
When considering the application of Design Constraints (i.e. functionality), the unclaimed part will be taken account. However, there is no rules or regulations for must fit / must match exceptions in Japan.

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

A design application for Partial Design for two or more parts that are physically separated within a whole article will be refused even though each of them is a design for a part of the article, due to lack of unity of one design (Article 7). If these parts are considered as a single design from the view point of unity of the art (i.e, functionally or ornamentally unified as a single design), these parts are registrable (see below).

Example1 (ornamental unity):
“Casing for a wrist watch”

Example2 (functional unity):
“Barber scissors”

(71.7.1.2.1 of the Guidelines)

However, in some cases, such unity requirements likely to limit the degree of freedom of design registration (i.e., the manner to specify the claimed area). Therefore, we hope the practice will be relaxed.

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

Yes

Please Explain
According to the current practice, an applicant should use dotted lines and/or colors in graphical indications to specify the part for which the design registration is requested. They also need to describe how the Partial Design is identified (using dotted lines and/or colors) in the "Description of design" div. This seems to be not confusing to both right holders and third parties.

In the meantime, since such a description is not required in an application for international design registration under the Hague System, such above requirements could be improved in view of international harmonization.

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

Yes

Please Explain

It is desirable that the scope of protection be assessed based on the position, size and area of the Partial Design by taking into account the Unclaimed Part. Since a Partial Design is for a part of a whole article, it is certain that the claimed part was not created independently in the creation process. Therefore, the Unclaimed Part should be taken into account the protection of a Partial Design.

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

Yes

Please Explain

Under Japanese law and practice, a design may be constrained by a functional part. A functional part makes it difficult for a designer to freely create a design, such parts are less evaluated than the other parts in terms of design protection.

**Question 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:

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

Yes

Please Explain

A Partial Design should be assessed by taking into account the position, size and area of the claimed part relative to its whole article including the Unclaimed Part.

10.b whether the Product is normally sold separately?

No

Please Explain
For example, the heel part of a sock is normally not sold independently, however a design for such part of a sock is considered to be a Partial Design.

### III. Proposals for harmonisation

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

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<td>11</td>
<td>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?</td>
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**III. Proposals for harmonisation**

**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.**

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<td>12</td>
<td>Should a Partial Design be registrable as an independent design?</td>
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<tr>
<td>Yes</td>
<td>Please Explain</td>
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<td>13</td>
<td>Is harmonisation of the law of Partial Designs desirable?</td>
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<tr>
<td>Yes</td>
<td>Please Explain</td>
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**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.**

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<td>14</td>
<td>Please propose a suitable framework for specifying, describing and/or graphically depicting (a) the Partial Design and (b) the Unclaimed Part.</td>
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<td>As a general rule, the claimed part (design) and the Unclaimed Part should be represented so that these parts can be clearly identified, and a description should be given of how they are represented. However, if the claimed part (design) and the Unclaimed Part can be clearly identified only by a description, there will be no need to be represented them in visibly.</td>
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<td>15</td>
<td>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:</td>
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<td>· Unclaimed Part (UP) of the Partial Design is the pan without the handle;</td>
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<td>· Surrounding Context (SC) is the part of the accused product without the protected Partial Design, i.e. the sieve without the handle,</td>
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<td>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.</td>
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5. SC is the same as UP

Differences between SC and UP should not be relevant (no influence) at all.

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

Take for example a pan and a pot with the same handle: if these products are used for the same purpose, i.e. cooking, differences between SC and UP should not be relevant. This is because their appearance is assessed by the same consumers and these products are dealt in by the same traders. In addition, the handle does not allow much freedom in creating a design (easily affected by functional constraints).

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

For example, if SC is a "game controller" and UP is a "TV remote control" (they have the same knob), freedom in designing the claimed part varies depending on the intended use and functionality of the article, which may influence the overall impression of the whole product. Therefore, differences between SC and UP may be relevant in some cases.

However, regardless of the possibility that the differences may influence the overall impression, the scope of rights should be assessed by taking into account the identicalness or similarities between the articles (e.g. a game controller and a TV remote control), as a result of which there may be no infringement of the Partial Design.

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

For example, if the same handle is used by a pan and a knife (these two articles belong to the same Class under the Locarno Agreement), differences between SC and UP should not be relevant, basically.

If freedom in designing the claimed part (i.e. the handle) is different between SC (the blade of a third party's knife) and UC (the pan itself) due to their different uses and functions, the location, size and scope of the Partial Design may influence the overall impressions.

However, regardless of the possibility that the differences may influence the overall impression, the scope of rights should be assessed by taking into account the identicalness or similarities between the articles (e.g. a pan and a knife), as a result of which there may be no infringement of the Partial Design.

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

For example, if there is a design for the handle of a knife and it is identical in shape of the handlebar grip of a bicycle, differences between a "knife" and a "bicycle handlebar" should influence the overall impression and the scope of a design right. Therefore, in this case, the overall impressions of the designs would be different.
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.

The Unclaimed Part, and more specifically, the following should be taken into account:

a) Intended purposes and functions of the Unclaimed Part (similarities in intended purposes, industry, consumers etc.)

b) The position, size and area of the Partial Design relative to its whole design; and the position, size and area of the accused design relative to its whole design,

c) The overall impression in view of b) above.

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.

It is likely that the Unclaimed Part may affect freedom in creating a Partial Design for the claimed part. Therefore, it should be allowed to take into account Design Constraints, such as must fit / must match, arising from the Unclaimed Part when assessing the overall impression of the claimed Partial Design.

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

When assessing the scope of a Partial Design right (the object of enforcement), how to consider similarities and differences of articles where partial design applied should be studied.

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

The Design Law of Latvia explicitly provides legal protection also for Partial Designs (Art.1, para 1). There are no differences between the laws protecting designs in general and Partial Designs. Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs is fully implemented into the Design Law which provides the same basic provisions (see Art.1(a)).

The same also applies with Council regulation (EC) No 6/2002 of 12 December 2001 on Community designs in respect to Community designs that are in force in Latvia (hereinafter - "Community Design Regulation") (see Art.3(a)).

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

See below.

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

The law does not provide any guidance in respect to visual indication of the Unclaimed Part. The Patent Office of Latvia follows recommendations "Convergence on graphic representations of designs - Common Communication" adopted by the majority of the European Union patent offices on 15 April 2016 that provide several ways of indicating the Unclaimed Part in the Partial Designs:

1) broken lines, if the image of the design is a drawing in lines;

2) "where broken lines cannot be used due to technical reasons (e.g. when the broken lines are used to indicate stitching for clothes or pattern; or photographs are used), the use of blurring, colour shading, or boundaries is recommended."

The recommendations also state: "The visual disclaimer should be self-explanatory when appreciated in the context of the whole design" (paragraph 3.1.3. "General recommendations", p.20).

The Intellectual Property Office of the European Union follows the same recommendations when applying Community Design Regulation.

2.b

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

No

Please Explain

The Product is named in the design application. A detailed written description is not necessary (15(2) paragraph 4 of the Design Law and Art.36(2) of the Community Design Regulation).

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.

No

Please Explain

The law does not provide for possibility to use verbal disclaimers for design applicants. The verbal indication of what is claimed as a Partial Design and the graphical representation of the Partial Design accompanied with visual disclaimer should be self-explanatory in the design application as described above.

A description of a Partial Design or a Product does not affect the scope of protection (Art.8(4) of the Design Law).

The same principle applies to Community designs (Art.36(6) of the Community Design Regulation).

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

The scope of the protection conferred by a design includes any design which does not produce on the informed user a different overall impression. In assessing the scope of protection, the degree of freedom of the designer in developing his design must be taken into consideration (Art. 8(1) and (3) of the Design Law).
Since the disclaimed parts of the Products are not taken into account in assessment of infringement of the Partial Design, the overall impression on the informed consumer would be deemed identical in case of identical Partial Designs.

The Partial Design protection is not limited to the Product and the Partial Design can be infringed regardless the Product it forms a part. As mentioned above, a description of a Partial Design or a Product does not affect the scope of protection.

The Design Law provides protection for Partial Design without taking into account the Product embodying it. The Design Law only provides an exception when the design application has been accompanied by a two-dimensional Product. In this case the features of the Product and the images of the design are taken into account in infringement proceedings as far as the features of the Product do not contradict the images of the design (Art.8(2) of the Design Law). However, this exception should not have a significant bearing on assessment of infringement of a Partial Design, since its scope of protection is limited to its images. As the images of a Partial Design prevail over the features of the deposited sample Product, the outcome of assessment of infringement should be the same.

The Community Design Regulation provides identical scope of design protection (Art.10 of the Community Design Regulation).

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

A Partial Design forming part of a Product X can be considered as lacking novelty, if the same Partial Design is a part of a prior Product Y that has been disclosed to the public Art.5(1) of the Design Law). Since the design is not claimed in its entirety for the Product, but only for its part, legal protection for the Partial Design is limited to its own visual appearance. The design protection is not limited to a specific category of Products and it applies to other Products as well, accordingly, the same later Partial Design of Product X cannot be considered novel in respect to the earlier Partial Design forming part of a Product Y. The argument to the contrary would provide limitless protection term for the registered design owner in respect to a single Partial Design registration, if any inclusion of the same Partial Design in another type of a Product would be considered as novel.

The Community Design Regulation provides the same (Art.5(1) of the Community Design Regulation).

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.

The Design Constraints of the Unclaimed Part can be taken into account when considering application of the Design Constraints to the Partial Design.

The law precludes a design or a Partial Design from being registered, if it has features - configuration, shape or appearance - necessary to obtain solely technical functions, "must fit" (except for modular systems) and "must match" purpose (Art.9(2) of the Design Law and Art.8(1), 8(2) and Art.110 of the Community Design Regulation).

A Partial Design can potentially include solely technical features, "must fit" and "must match" purpose driven features that form part of or is connected to the Unclaimed Part, accordingly, the Design Constraints are applicable also outside the scope of the Partial Design insofar this assessment is relevant to the assessment of the Partial Design and defines its scope of protection.

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.

No

Please Explain

Latvian law (and also EU law) provides sufficient basis for protection of Partial Designs. However, we note that there is no court practice in Latvia with respect to protection of Partial Designs. Thus, we cannot make any conclusions with respect to any
improvements of such practice.

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

Yes

Please Explain

Yes, Partial Designs can be clearly depicted in the registration application. Also description can be added for more clarity (though description as such does not affect the scope of protection).

**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

No, because the Unclaimed Part is not protected by registered design, and thus only Partial Design shall be considered with respect to the scope of protection.

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

Yes

Please Explain

Yes, Design Constrains should be of the same impact with respect to Partial Designs as for usual Designs.

**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:**

- the design as shown and any Unclaimed Part; and/or

Yes

Please Explain

Yes, the graphical representation should determine the scope of protection.

- whether the Product is normally sold separately?

No

Please Explain
No, the sales specifics, purpose of use, etc. shall not have an impact on the protection scope.

**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

No, issue of partial designs should be elaborated via court practice.

**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

**13. Is harmonisation of the law of Partial Designs desirable?**

Yes

Please Explain

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.**

We consider common guidelines/recommendations (soft law) as the most suitable framework. National patent offices could be free to decide if they adopt such recommendations. The framework could follow the recommendations “Convergence on graphic representations of designs - Common Communication” adopted by the majority of the European Union patent offices on 15 April 2016.
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.

15. SC is the same as UP

No, because products are identical.

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

No, as the purpose of use should not matter.

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

Not clear question.

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

No, as classification has no impact on the scope of protection.

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

No, as overall impression of the Partial Design only should be taken into account.

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.

Unclaimed Part should not be taken into account, as it is not protected by the registered design.
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.

The Design Constraints arising from the Unclaimed Part should affect the Partial Design insofar the Partial Design forms part of Design Constraints, i.e., the Partial Design contains features that taken together with the Unclaimed Part form solely technical features, "must fit" and "must match" purpose features. The "must fit" and "must match" Design Constraints must affect the Partial Designs in respect to assessment of shapes of the Partial Design. The "must fit" Design Constraint must affect the Partial Design if the Partial Design has no alternatives to the shape of the Partial Design or even if there are alternatives in shapes, they must not have technical features that allow the Partial Design to perform its function or help to perform this function together with the Unclaimed Part. The "must match" Design Constraint must affect the Partial Design if the features of the Partial Design are dependent upon appearance of a Product, or Unclaimed Part or any other article of which the Partial Design is intended to be an integral part.

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

No comments.

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

Partial Designs are extremely rarely used in Latvia, thus we could not determine the interested industry.
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.

No

Please Explain

Not specifically for Partial Designs – there are no specific provisions under the Malaysian Industrial Designs Act for the specific protection of Partial Designs. Design registrations are generally sought for the whole article, however protection for part of the article can also be sought via a clear Statement of Novelty, which accompanies the request for registration.

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

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, the Claimed and Unclaimed Parts of the design are graphically/visually distinguished.
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2.b Is there a written description of the Product, of which the Partial Design forms part?

Yes

Please Explain

Yes, the title of the product/article on which the design is applied on must be provided during the application.

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, disclaimers can be used in the written form, and should be indicated where the particular representation contains a disclaimer.

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.

No

Please Explain

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.

No

Please Explain

No, because the articles are different.

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.

While designs with must-fit / must-match features are non-registrable designs, applications for such designs with the must-fit/must-match portions unclaimed have been successfully registered in Malaysia. However, we must emphasise that our Industrial Designs Act does not have any provision for Substantive Examination, only Formalities Examination. Applications that fulfills the Formalities Examination will proceed to registration. Some Registrar however will exercise their own discretion to raise substantive queries. Whilst designs with must-fit / must-match features are non-registrable designs, applications for such designs with the must-fit/must-match portions unclaimed have been successfully registered in Malaysia. However, we must emphasise that our Industrial Designs Act does not have any provision for Substantive Examination, only Formalities Examination. Applications that fulfills the Formalities Examination will proceed to registration. Some Registrar however will exercise their own discretion to raise substantive queries.

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 – as earlier mentioned, there are no specific provisions relating to the protection of partial designs, hence this could perhaps be addressed. There should be clear guidelines on how to determine the novelty of a partial design. For example, if the Partial Design and the ‘adjoining div’ to which the partial design connects to can be sold independently from each other, then the partial design should be allowed to be registered independently from the adjoining div. A further thought is to perhaps allow Partial Designs to exist in its own category and Locarno classification, assuming again that it can be sold independently.

If the Partial Design cannot be sold independently of each other, then perhaps to allow for a div to allow more articles to be identified as the ‘adjoining div’ to the Partial Design. For example, the handle in this Working Question could be applied to an assortment of ‘adjoining divs’ such as frying pans, pots, hot plates etc.

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

No

Please Explain

See Question 6 above.

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

There is presently no guidance on this issue, though we would lean towards the Unclaimed Part not influencing the protection of the parts of the design that are claimed.


No

Please Explain

It should not, on the assumption that the Design Constraints themselves could be excluded from protection, but the remaining part of the design should still remain protectable. Otherwise there could be any overly wide scope of protection granted for that design.

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:

The design as shown and any Unclaimed Part; and/or
III. Proposals for harmonisation

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

10.b whether the Product is normally sold separately?

Yes

Please Explain

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

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?

13 Is harmonisation of the law of Partial Designs desirable?

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.

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.
| 5.4 | SC is the same as UP |
| 5.5 | SC is not the same as UP, but SC and UP relate to products that are used in the same way |
| 5.6 | SC is not the same as UP, but SC and UP relate to products that look the same |
| 5.7 | SC is not the same as UP, but SC and UP relate to products that are categorised in the same way when registering designs |
| 5.8 | SC is not the same as UP, and SC and UP are entirely unconnected. |

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.

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.

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.
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

There is protection given to Partial Designs, even if the Mexican law does not recognize as such. However, Partial Designs are evaluated and granted in accordance with the general IP law and rules and the current practice.

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

Described and graphically depicted

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, at least one of these visual indications could be used to indicate the Unclaimed Parts.

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

Yes

Please Explain

Yes, it is required a written description of the drawings defining the visual indications. In addition, the title of the application should specify that the protection is pursued for a Partial Design.

2. 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.

No

Please Explain

No. Nevertheless, it is possible to argue certain disclaimers in a writ.

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

Yes, as long as X and Y are products of the same or related genre.

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

Yes, as long as X and Y are products of the same or related genre.

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.

No, the Unclaimed Parts are considered out of the scope of the protection of the Partial Design, but could be considered as illustrative for Design Constraints.

II. Policy considerations and proposals for improvements of your Group’s current law
<table>
<thead>
<tr>
<th><strong>6</strong></th>
<th>Are there aspects of your Group's current law or practice relating to Partial Designs that could be improved? If YES, please explain.</th>
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<tbody>
<tr>
<td><strong>Yes</strong></td>
<td>Yes, depicting in the law and rules the current practice and adding criteria for Partial Designs.</td>
</tr>
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<tr>
<th><strong>7</strong></th>
<th>Is the way of specifying, describing or depicting Partial Designs satisfactory?</th>
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<tbody>
<tr>
<td><strong>Yes</strong></td>
<td>Yes, it is satisfactory for the scope of the description, but it can be improved by including specific provisions in the law to give legal certainty to the owners of rights.</td>
</tr>
</tbody>
</table>

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<tr>
<th><strong>8</strong></th>
<th>Should the Unclaimed Part influence the protection of the parts of the design that are claimed? Please explain why or why not.</th>
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<tbody>
<tr>
<td><strong>Yes</strong></td>
<td>Yes, the Unclaimed Part does influence since it is required to specify the type of whole product in the object of protection.</td>
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<tr>
<th><strong>9</strong></th>
<th>Should Design Constraints restrict the subsistence and scope of protection of Partial Designs? Please explain why or why not.</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>No</strong></td>
<td>No. The Design Constraints should be considered out of the scope of protection not affecting during the substantive examination nor the enforcement of the right.</td>
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<tr>
<th><strong>10</strong></th>
<th>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:</th>
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<tr>
<td><strong>0a</strong></td>
<td>the design as shown and any Unclaimed Part; and/or</td>
</tr>
<tr>
<td><strong>Yes</strong></td>
<td>Yes</td>
</tr>
<tr>
<td><strong>Please Explain</strong></td>
<td>The assessment take into account the design as shown and any Unclaimed Part</td>
</tr>
</tbody>
</table>
III. Proposals for harmonisation

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

10. Whether the Product is normally sold separately?

Yes

Please Explain

The assessment takes into account whether the Product is normally sold separately.

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?

Yes

Please Explain

Yes, clarify unit of the design within different Partial Designs of a whole product; clarify the provision for indicating the genre/product in which the industrial design protection will apply.

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

Yes

Please Explain

A partial design can be registrable as an independent design.

13. Is harmonisation of the law of Partial Designs desirable?

Yes

Please Explain

Yes, it is desirable.

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.
Extending the current practice of describing and representing the partial design in a graphic way as well as representing the unclaimed part.

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.

15.a SC is the same as UP
Very relevant. The accused product has exactly the same purpose of the registered design.

15.b SC is not the same as UP, but SC and UP relate to products that are used in the same way
Relevant. The accused product is using the partial design in the same way but just changing the unclaimed parts.

15.c SC is not the same as UP, but SC and UP relate to products that look the same
Relevant. The accused product is looking alike the partial design in the same way but just changing the unclaimed parts.

15.d SC is not the same as UP, but SC and UP relate to products that categorised in the same way when registering designs
Relevant. As the accused product fall into the same category of the partial design but just changing the unclaimed parts.

15.e SC is not the same as UP, and SC and UP are entirely unconnected.
Not relevant, as the scope of protection of the partial design should apply to the indicated product as such.

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.

The Unclaimed Parts should be considered for analysing the whole impression of a partial design, depending of the relevancy of the relation between the UP and SC for determining the individual character and infringement. If UP and SC show that the products are from the same
genre, then the UP should be taken into consideration. If UP and SC are unrelated, then the UP should not be taken into consideration.

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.

If the UP and SC arise from Design Constraints, then relevancy of the UP should not be taken into consideration.

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

The Locarno Classification should be taken into account from the moment of the filing the design application.

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

Industrial and Intellectual Property practitioners (IP Law firms).
## I. Current law and practice

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

<p>| | |</p>
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<tbody>
<tr>
<td>1</td>
<td>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.</td>
</tr>
<tr>
<td>Yes</td>
<td></td>
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<tr>
<td>Please Explain</td>
<td></td>
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<tr>
<td></td>
<td>Both the Benelux Convention for Intellectual Property (BCIP) and the European Community Design Regulation EC) No 6/2002 (CDR) offer design right protection for the appearance of a part of a product. The laws for the protection of Partial Designs (as defined in the questionnaire not including component parts or spare parts) are not different to the laws for the protection of designs generally.</td>
</tr>
</tbody>
</table>

| 2 | How are Partial Designs specified, described and/or graphically depicted? |
|   | Yes, both the Benelux Office for Intellectual Property (BOIP) and the EUIPO accept that visual disclaimers can indicate that protection is not being sought, and registration has not been granted, for certain features of the design shown in the representation. Thus, they indicate what is not intended to be protected. |

| 3 | 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

This can be achieved:
- by excluding with broken lines, blurring or colour shading the features of the design for which protection is not sought; or
- by including within a boundary the features of the design for which protection is sought, thus making it clear that no protection is sought for what falls outside the boundary.

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

Yes

Please Explain

- In the Benelux Article 2.1 of the Implementing Law of the Benelux Convention for Intellectual Property (BOIP) states that the application may include a description of the characteristic features of the new design of the product.
- Under EU law, Article 36(3)(a) CDR states that the application may contain a description explaining the representation.

**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.*

No

Please Explain

Neither the BCIP, the CDR nor the related Implementing Rules provide specific rules for the possibility of including in the application a statement that the applicant disclaims any exclusive right to one or more features disclosed in the views. Furthermore, in the EUIPO Guidelines for Examination in the Office, version 1.0 dated 1/10/2017 (EUIPO Guidelines) it is explicitly mentioned that the use of a description does not seem appropriate for disclaiming purposes, since a description ‘shall not affect the scope of protection of the design as such’ according to Article 36(6) CDR. Moreover, only an indication that a description has been filed is published, not the description as such (Article 14(2)(d) CDIR). According to the Examination Guidelines, disclaimers must therefore be apparent from the representation of the design itself.

**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

There is no link or nexus required between X and Y.

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

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.

No, the Partial Design should be regarded on its own.

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

We believe the law could be improved by setting clear rules with regard to unclaimed parts. Although the national offices have been working towards a more harmonized approach on this specific subject, as laid down in the common practices of the Conversion Programme (CP6) and in the (EUIPO) Examination Guidelines, there are no laws with regard to the subject of unclaimed parts in the Benelux nor on a European level. To achieve further harmonization (including in case law), we deem recommendable that rules with regard to unclaimed parts are laid down in the implementing laws of both the BCIP and the CDR, rather than only in examination guidelines and or other ‘soft laws’.

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

No

Please Explain

Under Benelux law, there are no specific office guidelines that explain how Partial Design should be specified or depicted. However, under EU law, the framework as included and described in item 5.3 Use of visual disclaimers to exclude features from protection as included in the EUIPO Guidelines, provides clear guidance in this regard. As indicated under Q6, we believe the law could be improved by setting clear rules with regard to specifying or depicting Unclaimed Parts.

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

Because there is no protection claimed for the Unclaimed Part.

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

Yes

Please Explain
In a similar way as any other Design (see answer to Q1).

**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:**

- **the design as shown and any Unclaimed Part; and/or**
  - No
  
  **Please Explain**
  
  No, not necessarily. Partial Designs should also be able to be represented as a stand-alone design.

- **whether the Product is normally sold separately?**
  - No
  
  **Please Explain**
  
  No, this is not relevant. The Product only has to be an industrial or handicraft item like any other Design.

**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**
  
  None other than the improvements outlined in Q6 above.

**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**
  
  Partial Designs should be registrable. A design right should not need to be based on the appearance of the complete product. It may also relate to a part of the product (not separable as an independent product of which it is part).

**13. Is harmonisation of the law of Partial Designs desirable?**
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.

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

We believe the framework as included and described in paragraph 5.3 Use of visual disclaimers to exclude features from protection as included in the EUIPO Guidelines is appropriate for this purpose.

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.

- SC is the same as UP
  
  Not relevant, since these both fall outside the scope of protection sought.

- SC is not the same as UP, but SC and UP relate to products that are used in the same way
  
  Not relevant either, since the way products are used is not relevant for the scope of protection granted.

- SC is not the same as UP, but SC and UP relate to products that look the same
  
  Also not relevant, since SC and UP are excluded from the protection and therefore should not play a role in the assessment of the overall impression.
SC is not the same as UP, but SC and UP relate to products that categorised in the same way when registering designs.

Also not relevant, since SC and UP are excluded from the protection and therefore should not play a role in the assessment of the overall impression.

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

Also in this scenario, these differences are not relevant, since SC and UP should not play a role in the assessment of the overall impression.

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.

Not relevant (because differences between the SC and UP are not relevant).

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.

The same rules should apply as to any other Design (which is already the case under Benelux and EU design law).

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

We have no further comments.

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

There are no sector views included in our Group’s answer to Part III.
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

Background:
NZ does not make extensive use of Registered Design protection because the NZ Copyright Act provides effective protection for the shape of products. It is akin to the UK Unregistered Design Right. NZ allows protect for the shape of products (based on original drawings) for a period of 16 years – one year longer than the rights given by a Registered Design. Both the Copyright in the shape of the product and the protection afforded by a Registered Design for the shape of that product exist concurrently. Consequently NZ does not need separate Design protection for a partial design as it is already protected by way of copyright in the part drawing as well as the entire article via the assembly drawing of that article. Copyright does involve proof of copying but it is in practice easier to enforce than a registered design.

NO - in the strict sense of D1 or D2 directed to the handle design.
YES - if made or sold separately. See below.

In NZ protection is only given to a partial design if the component part is made and sold separately. Provided this criteria is satisfied, then partial designs are otherwise treated the same as a designs for the full article. Designs need to be applied to an article and the definition of an article includes parts thereof if made and sold separately. The article must have some function other than simply being a medium for carrying the registered design. In the example of D2 where the handle is not made and sold separately it could not be a valid Design Registration in NZ. However a Design Registration could be obtained for D1 (the pan but not the “handle for a pan”) where the novelty was claimed in handle rather than the shape of the pan. Infringement is determined by the name of the
article – in this case a pan or a cooking implement. Choice of terminology is important to define the article and hence the scope of protection.

2

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

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

There is no set standard for how components of the unclaimed part are to be represented. The closest the regulations get to specifying depiction of designs in general is regulation 26, subparagraph (2) of which states that “(2) Each representation must clearly and unambiguously show the novel design features of the design as applied to the article.” In practice, the unclaimed part is generally shown by a permanent colour or by shading rather than by dotted or dashed lines. A representation of the article from a viewpoint which does not feature the partial design is not required. Colour or shading of either the novel part “novelty is claimed for the part marked blue” or the “no novelty is claimed for the portion marked blue”

2.b

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

Yes

Please Explain

Yes, regulation 23 requires every application to state the name of the article to which the design is to be applied. But remember this has to be the entire article if the part is not made and sold separately.

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

Apart from a few exceptions, applications are to be accompanied by a statement of the features of the design for which novelty is claimed. While this implies that such statements are stated in the positive sense of what is included, it can also include statements in the negative sense of what is excluded. The standard wording of the statement of novelty is “The design is to be applied to a [name of article] and the novelty resides in the features of shape and configuration as shown in the accompanying representations”. However, such a statement would not be specific enough for use in relation to partial designs, which would generally require a statement to the effect of which items are disclaimed from the novelty claim. Apart from the statement of novelty, only the representations can be used to identify the design applied to the article.

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
A registered design can only be infringed by the use of the same design or a design that is not substantially different on the article or set of articles for which it has been registered. For a partial design when used on Product X to be infringed when forming part of Product Y it would have to be the case that Product Y could also be used for the same purpose as Product X. Hence, with the given examples, the use of the handle on a sieve would not infringe a registered design for a frying pan (with a novel handle) or vice versa. But if the original design was for say a “kitchen article” then both the frying pan and the sieve would be within the scope of that title. See the NZ Designs Act - S.11 set out in the next paragraph.

NZ Designs Act at S.11 states:

11. Right given by registration -

(1) The registration of a design under this Act shall give to the registered proprietor the copyright in the design, that is to say, the exclusive right in New Zealand to make or import for sale or for use for the purposes of any trade or business, or to sell, hire, or offer for sale or hire, any article in respect of which the design is registered, being an article to which the registered design or a design not substantially different from the registered design has been applied, and to make anything for enabling any such article to be made as aforesaid, whether in New Zealand or elsewhere.

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

Yes, a prior registration or disclosure of the partial design in a different product is sufficient to defeat novelty, provided that the different product is an article of manufacture. However, there is an exception where the partial design is applied to the different products by the same owner or where the party that applies the partial design to Product X becomes the owner of the partial design applied to Product Y. Where this exception applies the subsequent design expires with the first design.

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.

New Zealand’s law does not recognise any spare parts must-fit or must-match exceptions. However, the design protection conditions of novelty and non-functionality create design constraints which can influence whether the unclaimed part can be taken into account. Where the partial design is quite different from the prior art, then its scope of protection will be quite wide. However, where the partial design only differs slightly from the prior art, then its scope of protection will be narrower. While the overall assessment is more qualitative than quantitative, the portion of the overall product constituted by the unclaimed part will influence the scope of protection of the partial design. Design protection cannot extend to features of shape or configuration which are dictated solely by the function which the article to be made in that shape or configuration has to perform. Hence, the scope of protection available to a partial design can be influenced by the degree to which the shape or configuration of the unclaimed part places significant functional constraints on it.

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.

No

Please Explain

No. The Designs Act functions alongside the protection afforded by Copyright.
7 Is the way of specifying, describing or depicting Partial Designs satisfactory?

Yes

Please Explain

In practice there does not appear to be any problems caused by the current practice.

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

Yes

Please Explain

Yes. While a partial design can be distinctive enough to be sought in its own right it will also continue to be part of a product and as discussed in response to question 5 the scope of protection that is available to the partial design will depend upon how it interfaces with and its proportion in relation to the unclaimed part.

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

Yes

Please Explain

Yes. Partial designs should be no different to regular designs in this respect.

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:

Yes

Please Explain

As discussed in response to questions 8 and 9 the assessment should take into account both the design as shown and the unclaimed part.

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?
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?

No

Please Explain

NZ Design Law provides monopoly protection for Articles of Manufacture, i.e. the whole article. However, NZ also provides 3D Copyright protection for articles and parts of articles (whether made or sold separately) and enforcement is effective proved the Copyright Owner can establish copying by the Alleged Infringer. See the response to the first question.

13 Is harmonisation of the law of Partial Designs desirable?

No

Please Explain

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.

Not needed - protected by copyright.

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.

15.a SC is the same as UP
Relevant to the definition of the Article and S.11 – hence infringement.

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

Possibly – depends on the title of the Article – see earlier discussion of S.11.

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

NO infringement if they are different articles.

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

Needs care in naming the Registered Design if the registration is to catch the SC.

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

Different articles – so no infringement.

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.

This is not an issue in NZ given the effectiveness of Copyright protection.

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.

Again – not necessary given the NZ Copyright law.

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

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

Industrial designers and manufacturing jewellers.
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

Protection is given to Partial Designs. No, there are no laws for the protection of Partial Designs different to the laws for the protection of designs generally.

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

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
The components which are not included in the Partial Design, i.e. the Unclaimed Part, can be indicated by dotted lines, see, e.g., Case T-68/10, *Sphere Time v. OHIM*, 14 June 2011. However, it is unclear whether the visual indication of the Unclaimed Part is a prerequisite for obtaining Partial Design protection. In this regard, see the answer for question 11.

**2.b Is there a written description of the Product, of which the Partial Design forms part?**

No

Please Explain

One may indicate in the title that the Partial Design is a part of "product X". However, there is no written description of e.g. the geometric characteristics of the shape, to define the scope of the protection.

**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.

No

Please Explain

**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

Yes. The required link is based on the overall impression test. Since a Partial Design in many cases will represent a small part of the product – use of a Partial Design forming a part of Product X will not often constitute an infringement by use of the same Partial design on product Y. Hence, any infringement by the use of the same Partial Design will depend on how similar Product Y is to Product X. However, in cases where the registration does not indicate the Unclaimed Part, The overall impression test will not be extended, and the use of the Partial Design on Product Y may be more likely to be considered an infringement.

**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

The required link for lack of novelty is that X and Y are "identical", which also includes when the features differ only in immaterial details. Hence, also this will depend on how similar Product Y is to product X.

**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.**

Yes, under the application of the "must fit" Constraint, the boundary surface that connects the Unclaimed Part and the Partial Design will be taken into account when considering the Constraint. The Constraint also encompasses features that are necessary for the part to be able to fit
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

There is a certain need for a clarification regarding the applicable requirements as to form, inter alia whether the visual indication of the Unclaimed Part is a prerequisite for obtaining Partial Design protection. The adoption of formal guidelines would therefore amount to an improvement.

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

Yes

Please Explain

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

Yes

Please Explain

The indication of the Unclaimed Part will limit the scope of protection and ensure that the scope of protection is not too broad.


No

Please Explain

No, because the protection would get too broad.

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:

inside, around or against the Unclaimed Part.

For example, if the Partial Design concerns the bed part of a sofa sleeper, not just the mechanical fitting device that connects the sofa to the bed would be taken into account, but also the size and shape of the bed insofar as these features are necessary for the bed to fit inside the sofa.

However, features of a design which are excluded from protection under the application of Design Constraints will not be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection.
### III. Proposals for harmonisation

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

<table>
<thead>
<tr>
<th>Question</th>
<th>Yes/No</th>
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<tbody>
<tr>
<td>Should a Partial Design be registrable as an independent design?</td>
<td>Yes</td>
<td></td>
</tr>
<tr>
<td>Is harmonisation of the law of Partial Designs desirable?</td>
<td>Yes</td>
<td></td>
</tr>
</tbody>
</table>

**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.

Reference is made to answer 2 and 7 above. Current practice is satisfactory.

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.

5a SC is the same as UP

Yes, the SC and the UP would produce the same overall impression on an informed user.

5b SC is not the same as UP, but SC and UP relate to products that are used in the same way

No, solely functional factors should not be relevant if the products produce a different aesthetic overall impression on the user. The nature of the product may nevertheless be relevant in the overall impression test.

5c SC is not the same as UP, but SC and UP relate to products that look the same

Yes, the overall aesthetic impression produced on the user would be similar.

5d SC is not the same as UP, but SC and UP relate to products that categorised in the same way when registering designs

No, the categorisation of products has no legal implications.

5e SC is not the same as UP, and SC and UP are entirely unconnected.

No, if the SC and UP are dominant, it will produce a different overall impression on the informed user.

However, if the Partial Design is dominant in producing a recognisable impression on the informed user, the emphasis placed on the SC and UP should be limited if protection for Partial Designs are to serve its purpose.
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.

The current rule – i.e. the overall impression test – is satisfactory.

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.

Reference is made to answer 5 above. As a consideration of legal policy, the Design Constraints should be applied the same way for Partial Designs as for other Designs.

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

N/A

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

IP advisers
Product distributors
Furniture Design industry
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.

No

Please Explain

Partial Designs are not recognized and protected under the Registered Design Ordinance, 2000. This statute recognizes composite/complete design.

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

Not Applicable.

3. 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?

No

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

2a. Is there a written description of the Product, of which the Partial Design forms part?

No

Please Explain

Not Applicable.

2c. 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.

No

Please Explain

Not Applicable.

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.

No

Please Explain

Not Applicable.

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.

No

Please Explain

Not Applicable.

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.

No
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

Partial Design should be accorded recognition and legal protection.

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

No

Please Explain

At present, Partial Designs are not recognized by law.

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

Unclaimed part should not influence the protection of the parts of the design that are claimed.

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

No

Please Explain

Design constraints should not restrict the subsistence and scope of protection of Partial Designs.

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:

the design as shown and any Unclaimed Part; and/or

Yes

Please Explain

This is a valid factor for consideration.
III. Proposals for harmonisation

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

10. Whether the Product is normally sold separately?

Yes

Please Explain

This is a valid factor for consideration.

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

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

Yes

Please Explain

Pakistan Group favours harmonisation of IP Laws. Partial Design should be registrable as an independent design.

13. Is harmonisation of the law of Partial Designs desirable?

Yes

Please Explain

Pakistan Group favours harmonisation of IP Laws. Partial Design should be registrable as an independent design.

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.

The existing framework is sufficient to cover partial designs as well.
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.

15.a. SC is the same as UP

Yes. However, it will depend on the facts of the case and the conduct of the parties.

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

Yes. However, it will depend on the facts of the case and the conduct of the parties.

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

Yes. However, it will depend on the facts of the case and the conduct of the parties.

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

Yes. However, it will depend on the facts of the case and the conduct of the parties.

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

No

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.

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

Not Applicable.

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

Not Applicable
# I. Current law and practice

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

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<td>Yes</td>
</tr>
<tr>
<td></td>
<td>Please Explain</td>
</tr>
<tr>
<td>1) Yes, even though our local law does not states nor forbid the protection of Partial Designs.</td>
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</tr>
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<td>How are Partial Designs specified, described and/or graphically depicted?</td>
<td>By dotted or dashed lines.</td>
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II. Policy considerations and proposals for improvements of your Group's current law

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

Yes

Please Explain

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

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.

No

Please Explain

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

It will be considered of lack of novelty because the Partial design it will be considered public

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.

No

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.

No

Please Explain

As our local law does not establish Partial designs, just modifying the law it would be possible to improve this topic.
### III. Proposals for harmonisation

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

Yes

Please Explain

#### 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

They do not have an influence because they are not part of the product itself.


No

Please Explain

N/A

#### 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:

- the design as shown and any Unclaimed Part; and/or

Yes

Please Explain

- whether the Product is normally sold separately?

#### 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

As our local law does not establish Partial designs, just modifying the law it would be possible to improve this topic.
Please consult with relevant in-house / industry members of your Group in responding to Part III.

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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.

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A special chapter regarding Partial Design should be into the Industrial Design law.

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

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

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

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.

The UP should be part of a similar registered Partial Design.

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.

The UP should be part of a similar registered Partial Design, according to Locarno’s classification.

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

In our country, a few partial designs cases have been registered, mainly, related to technological products and vehicles. Nowadays, we still do not have any jurisprudence related to partial designs scope.

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

Technological products and vehicles industries.
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

Yes, protection is given to Partial Designs in the Philippines under the same laws protecting designs in general. While there are no specific provisions on Partial Designs, Rule 1514.2 of the Revised Implementing Rules and Regulations for Patents, Utility Models, and Industrial Designs (“Revised Rules”) [1] which implement the Intellectual Property Code of the Philippines (“IP Code”) (Republic Act No. 8293, as amended) allows for “unclaimed environmental structure” to be depicted in broken lines. Hence, it maybe argued that in the Philippines, Partial Designs are protected similarly as designs in general.

Footnotes


How are Partial Designs specified, described and/or graphically depicted?
In the Philippines, when the drawing for a design has solid and broken lines, the broken lines indicate the Unclaimed Parts while the Partial Design is depicted by the solid lines. The Partial Design may also be described through written description.

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, broken lines are used as a visual indication of those components not included in the Partial Design. Rule 1514.2 of the Revised Rules provides that the “unclaimed environmental structure in the drawing disclosure may be shown only in broken lines, where necessary, as where the nature and intended application of the claimed design cannot be indicated adequately by a reasonable concise title or statement in the description.”

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

Yes

Please Explain

Yes, design applications must provide an indication of the kind of article of manufacture or handicraft to which the design shall be applied. [1] In particular, design applications must include a title and a statement of the characteristic features of the design. [2] The title of the design must technically designate the particular article embodying the design while the statement of the characteristic features must describe the particular novel and ornamental features of the claimed design. [3] Hence, under Rule 1514.2 of the Revised Rules, broken lines are used only “where the nature and intended application of the claimed design cannot be indicated adequately by a reasonable concise title or statement in the description.”

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, verbal disclaimers can be used. As stated above, design applications must include a title and a statement of the characteristic features of the design. [1] Further, drawings in broken lines are only necessary if the nature and intended application of the claimed design cannot be indicated adequately by reasonable concise title or statement in the title or description. [2] An adequate indication of the nature and intended application of the claimed design necessarily includes disclaimers as to the extent of the unclaimed parts of the design.

Footnotes


2. ^ Rule 1513, Revised Rules.

3. ^ Rule 1513.1 & 1513.3, Revised Rules.

Footnotes

1. ^ Rule 1513, Revised Rules.
2. ^ Rule 1514.2, Revised Rules.

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

Yes, Partial Designs are protected, and may be infringed, in the same manner as designs in general.

While the IP Code does not expressly define infringement of designs, Section 60 of Republic Act No. 165 [1] provides that “identity or substantial identity with the registered design shall constitute evidence of copying.” [2] Likewise, under the doctrine of equivalents embodied under Section 75.2 of the IP Code which also applies to designs, [3] due account shall be taken of elements which are equivalent to the elements of the design. Thus, a Partial Design may be infringed if a substantial part thereof or an equivalent is used on a junior product.

Footnotes
1. ^ While Republic Act No. 165 has been superseded by the IP Code, provisions of the former that are not inconsistent with the IP Code have not been repealed.
2. ^ Section 60 of Republic Act No. 165. (Available at: https://www.lawphil.net/statutes/repacts/ra1947/ra_165_1947.html)

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

Technically yes. Under Rule 1503 of the Revised Rules, a design shall not be considered new if it differs from prior designs only in minor respects that can be mistaken as such prior designs by an ordinary observer. The Revised Rules, however, do not provide that similarities between the unclaimed parts should be taken into account.

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.

Under Philippine design laws, technical and functional considerations, as well as those contrary to public order, health and morals, are excluded from protection. [1] Thus, if not under the aforementioned considerations, other elements including that of the Unclaimed Part may or may not be taken into account in determining the application of Design Constraints.

Footnotes
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. As discussed above, Partial Designs and related concepts are not specifically defined under Philippine design laws. Likewise, provisions on infringement specifically tailored for designs, in general, and Partial Designs, in particular, are also wanting. Thus, making the enforcement of design rights in the Philippines ambiguous.

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

No

Please Explain

Although under Philippine design laws, Partial Designs may be depicted using broken lines in the drawings as well as through written description, the Revised Rules are unclear as to how Partial Designs can be enforced and what is exactly needed for infringement to occur.

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

Yes

Please Explain

Yes, the Unclaimed Part should be taken into consideration in assessing the protection afforded to a Partial Design because the Unclaimed Part provides the nature and the intended application of the design which are relevant in determining its registrability in connection with the Design Constraints. However, the protection of a Partial Design should not be limited to the exact object to which it is attached. The Unclaimed Part should be considered to show the similarity of the technical application of the Partial Design.

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

Yes

Please Explain

Yes, the validity and scope of protection of Partial Designs should be subjected to the Design Constraints since the essence of design protection is to reward the creativity contributed by the designer. Granting protection to elements that are dictated by the technical or functional considerations for which no artistic input have been provided is contrary to the notion of design protection.

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:**

Yes

the design as shown and any Unclaimed Part; and/or
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

Yes, but the Unclaimed Part must be taken into consideration in determining the scope of protection of the Partial Design.

13. Is harmonisation of the law of Partial Designs desirable?

Yes

Please Explain

Yes. Harmonisation will prevent varying degrees of protection granted in different jurisdictions and avoid uncertainty in the rights enjoyed by the designer.

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

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Please Explain

Yes, the determination should be dependent on the drawings and the written description since these reflect the intention of the designer who created the design as well as the nature and intended application of the product.

01. whether the Product is normally sold separately?

No

Please Explain

No. The fact that the product is being sold separately or not should not influence the determination of whether the design is a Partial Design since this may be inconsistent with the intention of the designer which amounts to an unnecessary Design Constraint.

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?

Yes

Please Explain

While Philippine design laws allow the use of broken lines in the drawings in depicting the Unclaimed Part, allowing other visual indications or representations such as shading and colouring will provide flexibility and enhance clarity of the design being claimed. Also, a clear definition of design infringement and its elements are necessary to enhance the enforcement of this right.

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

a. Partial Designs should be depicted and described similarly as designs in general. There should be a visual and verbal description.

b. The Unclaimed Part should be depicted using broken lines, shading and colouring, and should also be described in the written description.

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.

- SC is the same as UP

If the SC is the same as UP, the accused product and the product with the Partial Design will likely have similar overall impressions. Hence, any minor differences between SC and UP are irrelevant. Infringement is apparent without even delving into the nature or the intended application of the products.

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

If the SC and UP are not the same, but relate to products that are used in the same way, the accused product and the product with the Partial Design may have similar overall impressions. Hence, the differences between the SC and UP will be relevant in determining infringement especially in determining whether the Partial Design has the same technical application.

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

If the SC and UP relate to products that look the same, the accused product and the product with the Partial Design will likely have similar overall impressions. More than function or use, similarity in appearance is a strong indicator of infringement. Hence, the differences between SC and UP may not at all be relevant. Still the similarity in the technical application of the Partial Design should be considered.

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

Similarity of the class to which the products belong means that the products are related and indicate a resemblance in function, use or purpose. Hence, the differences between SC and UP will be relevant in determining whether the accused product and the product with the
Partial Design have similar overall impressions.

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

If the SC and UP are not the same and are entirely unconnected, the accused product and the product with the Partial Design will have different overall impressions and infringement is highly unlikely. Hence, the differences between SC and UP will no longer be relevant in determining the overall impressions.

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.

In determining the overall impression of a Partial Design, the appearance, purpose, function and use of the Partial Design as well as the Unclaimed Part must be considered.

If SC is the same as UP, or if SC and UP relate to products that look the same, the accused product and the product with the Partial Design will likely have similar overall impressions. As such, any minor differences between SC and UP is irrelevant so long as technical application of the Partial Design is the same.

Similarly, if the SC and UP are not the same and are entirely unconnected, the products will likely have different overall impressions. Hence, differences between SC and UP will not be relevant. In these cases, the Unclaimed Part will be irrelevant in the determination of the overall impression as well as the nature and purpose of the product.

If SC is not the same as UP, but relate to products that are used or categorized in the same way, these products may or may not have similar overall impressions. Thus, the Unclaimed Part will be relevant in the determination of the overall impression of the products as well as the nature and purpose of the Partial Design. Hence, the differences between the SC and UP will play a significant role in determining infringement.

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.

Must fit and must match Design Constraints arising from the Unclaimed Part should be taken into consideration in determining the extent of protection afforded to Partial Designs in so far as the Unclaimed Part provides the nature and the intended application of the design which are relevant in determining the design’s registrability as well as whether infringement was committed. However, these should only aid the determination of protection and not the primary consideration.

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

Considering that designs are also protected under copyright laws, the following issues should also be addressed: a) how will copyright protection apply to Partial Designs and the Unclaimed Part? b) How should these concepts be taken into account in determining the extent of copyright protection as well as copyright infringement.

Please indicate which industry sector views are included in your Group’s answers to Part III.
Furniture and jewelry design, spare parts and other hand held tools and implements.
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

According to Polish Law there are two types of Partial Designs: (1) part of a product inseparably connected to the product (as in the example of the handle of the pan) and (2) part of a product which is independent from the product, could be replaced and/or sold separately.

Under Polish Law, protection of Partial Designs does not differ from protection given to general designs. Thus, the provisions of Act of 30 June 2000 Industrial Property Law (hereinafter as Industrial Property Law or IPL) apply.

Moreover, in relation to filing procedure, the provisions of Regulation of 30 January 2002 on filing and examining the design applications (hereinafter as Regulation) apply as well. In this regard, also art.108 par. 2 1 IPL applies, according to which, when novelty and individual character applies only to a part of a product, the illustration of the design applied for must depict the whole product, i.e. including the part which lacks novelty and individual character.

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

Partial Design shall be graphically depicted in association with the Unclaimed Part (according to Article 108 (2 1) IPL whole product must be visible in the industrial design application).
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

The practice of the Polish Patent Office is that the Unclaimed Part can be indicated in dotted or dashed line. However, this visual indication is not specified in written regulation.

In these cases, where broken lines cannot be used due to technical reasons (e.g. when the broken lines are used to indicate stitching for clothes), the use of blurring, colour shading, or boundaries is possible.

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

According to art. 108 par. 3 of the Industrial Property Law, the applicant is allowed to include a written description explaining the visual indication/illustration of the design applied for.

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

Yes

Please Explain

According to art. 108 par. 3 of the Industrial Property Law, the applicant is allowed to include a written description explaining the visual indication/illustration of the design applied for.

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.

No

Please Explain

Under art.108 par. 3 of the Industrial Property Law, a verbal disclaimer is not allowed.

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

According to Polish law, the same provisions regarding infringement apply to designs for a whole product as well as to Partial Designs. Therefore, in the light of art. 105 par. 4 of the Industrial Property Law, scope of protection conferred by a design shall include any design which does not produce a different overall impression on the informed user.

Considering the above, possible infringement must be examined case by case. One can easily imagine situation when a registered Partial Design used in another product still produces the same overall impression, while in other situation this does not have to be the case.

However, according to art.105 par. 5 of the Industrial Property Law, the right conferred by a registered design is limited to products specified in the application. Accordingly, the applicant must indicate type of a product/products, which incorporate the design. Clearly, this is in contradiction with Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of design (article 9) and limits the scope of protection.
II. Policy considerations and proposals for improvements of your Group's current law

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

This should be examined case by case. If protection of a Partial Design depends on the whole product, it is possible that the prior use of an identical Partial Design, even in different product, could influence its novelty. Moreover, when assessing novelty, art. 105 par. 5 of the Industrial Property Law does not apply.

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.

According to art. 107 IPL, scope of protection of a design does not cover features of the product: 1) arising solely from its technical function; 2) that must be reproduced in their exact form and dimensions in order to enable the product to be mechanically connected to another product or to work with another product).

This regulation provides limitations in the scope of protection of a design and should be seen as applying also to Partial Design. In the same time, it does not specify the source of the Design Constraints and, thus, these may also arise from the Unclaimed Part.

Moreover, according to art. 108 par. 2, if novelty and individual character applies only to a part of a product, the illustration of the design applied for must still show the entire product. This requirement should be seen as a confirmation of the possible influence of the Unclaimed Part on the scope of protection of the Partial Design.

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

The scope of a design’s protection, according to article 105 par. 5, is currently limited to products specified in the application. Therefore, it is desirable to review, if this limitation is useful or necessary, especially considering the market needs.

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

Yes

Please Explain

According to the IPL, a whole product must be depicted in the industrial design application. However, this regulation does not specify the possible representation of a Partial Design. The practice adopted by the Polish Patent Office regarding the use of dotted or dashed line to depict the Unclaimed Part makes the application for Partial Design transparent.

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

No

Yes

Please Explain

Design constraints should be applicable to a Partial Design, the same way these are applicable to each other type of design. Design constraints determine these features, which may not be a subject of any “artistic input” (meaning a creative input), or may be subject of a limited “artistic input”, and, therefore, may not be altered by the designer.

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:

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

Yes

Please Explain

The scope of protection of a design, being a whole Product or its portion, depends on and is limited to the these features, which are visible in the application. It follows, that the representation of a design and any Unclaimed Part should be taken into account in assessment whether a design is for portion of a whole Product.

10.b. whether the Product is normally sold separately?

Yes

Please Explain

In general, in relation to registered designs, the scope of protection depends on the representation of a design in the application from, and, after obtaining registration certificate, on the representation of a design in this certificate. The scope of protection should be determined accordingly. Therefore, the market use of a product plays secondary role in assessing the scope of protection and in assessing the fact if the design is for a portion or for a whole product.

However, a Partial Design may be incorporated in a part of a product which is independent from the whole product and could be sold separately (art. 102 par. 3 point 2 of the Industrial Property Law).

Also, the requirement of a possible separate sales of a part of a whole product was included in the former wording of art. 102 par. 3 point 3, which is not present in the current version of this Act.

It follows, that the fact, whether a Product incorporating a design may be sold separately, may be taken into account while assessment whether a design is a Partial Design.

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
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

Partial Design should be registrable as an independent design. It is crucial to protect these elements of a Product, which are the effect of an artistic input and may influence the informed user.

13 Is harmonisation of the law of Partial Designs desirable?

Yes

Please Explain

Harmonisation of law on Partial Designs is desirable. The EU provisions on designs is obvious example for Poland to follow. Therefore, the harmonisation process itself will result in creation of a certain acquis communautaire that will most likely have a normative effect not only within the EU Member States (that will be obliged to transpose the directives) but also at the international level. Also, the harmonization process will lead to unified legal rules throughout the EU. Thus, it will empower legal certainty, transparency and predictability of norms.

Obviously, harmonisation comes at a price – it may be a time consuming, expensive and complex process. Law-making procedure in the EU and other countries or regions may take up to several years to complete. From the very first proposal to its final adoption, including translation into the many official languages.

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.

A suitable framework should be based on the already gathered experiences and the common national practices. A design is the appearance of a product: its shape, patterns and colours. Thus, in general, when considering designs the most preferred method for description is the visual indication. Thus, any form of visual representation that serves the purpose of precise indication should be recommended for consideration (dotting, dashed lines, shading, coloring etc.). Two different forms of visual identification may be recommended for the Partial Design and the Unclaimed Part. For instance, dotting (or dashed lines) for the Partial Design while shading for the Unclaimed Part. Brand-new forms of visual representation should also be investigated, such as 3D models, including representation of partial designs in VR and AR.
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.

15.a SC is the same as UP

Assessment of an overall impression should be conducted disregarding differences between the SC and the UP since the essential appearance of a product (or part thereof) is stored within the claimed part only. Therefore, the SC and the UP, as such, are irrelevant.

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

Consequently, relation to products or their method of use should be also disregarded. As above, the essential appearance of a product (or part thereof) is stored within the claimed part only. Therefore assessment of an overall impression should be conducted disregarding either differences between the SC and the UP, its relation to products or method of use.

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

As above, the SC and the UP are irrelevant. Thus, the fact that the SC and UP look the same should be disregarded.

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

Consequently, relation to products and whether they are categorised in the same way when registering designs is not relevant.

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

As above, assessment of an overall impression should be conducted disregarding differences between the SC and the UP. The essential appearance of a product (or part thereof) is stored within the claimed part only. Therefore, the SC and the UP, as such, are irrelevant.

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 above, the Unclaimed Part should be disregarded when assessing an overall impression both for establishing individual character, as well
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as, infringement since the essential appearance of a product (or part thereof) is present within the claimed part only.

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.

In view of the nature of the Design Constraints, being mostly technical restraints which determine the functioning or integrity of the product itself, the source of these factors i.e. if these arise from the Unclaimed Part or from the design itself, should not influence their applicability.

Therefore, Design Constraints arising from the Unclaimed Part should affect a Partial Design.

This influence of the Design Constraints determined by the Unclaimed Part should cover:

- the key features of a Partial Design as such [such as the shape of the handle D2, which must have a certain shape and thickness in order to be easily gripped, but also to balance the weight of a pan being the Unclaimed Part; this includes also the technical features of a Partial Design itself];
- the features necessary in order to connect the Partial Design or and place the Partial Design in, around or against the Unclaimed Part in order to perform its function or features of the Partial Design which must match the appearance of the Unclaimed Part or in any other way are technically constraint by the possible connection with the Unclaimed Part [i.e. the features of the proximal end of the handle D2, which shape is determined by the shape of the rim of the pan in order to be connected].

As these features may not be subject of any “artistic input” or this “artistic input” may be only to a limited extent, the designer of the Partial Design may not choose from a multiplicity of shapes, but must always consider the technical constraints dictated by the Unclaimed Part.

Referring the above to the example given in the Study Guidelines, the proximal edge of the handle D2 should be considered as constraint by the shape of the rim of the pan, and, therefore, the design protection should not be expanded on this part.

It follows, that must fit / must match constraints determined by the Unclaimed Part should also fall within this rule and be taken into account as affecting the Partial Design.

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

We do not have additional comments in this regard.

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

At the moment there aren’t any representatives of relevant industry within the Polish Group. Therefore the authors of the Report based their conclusions on their legal experience while working with clients from the following sectors:

Building and construction industry sector (elements of interior design)
Fashion industry (footwear)
Food industry (beverages)
Study Question

Submission date: May 2, 2018

Sarah MATHESON, Reporter General
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Partial designs

Responsible Reporter(s): Yusuke INUI and Ari LAAKKONEN

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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
   
   Yes, protection is given to Partial Design. And, the same laws for protection are applied to both Partial Designs and General (Whole) Designs.

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

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. Drawings should contain solid lines to indicate the Claimed Part and dashed lines to indicate the Unclaimed Part.
The Claimed Part can be depicted using colored or boundary lines like in the below examples.

In the above tractor design, the Unclaimed Part is painted in black ink. If necessary, the applicant should depict the portion claimed for the partial design registration in the “Explanation of the Design”.

If the border separating the Claimed Part and Unclaimed Part is not clearly shown by the use of solid and dashed lines, the applicant should use dot-dashed lines to indicate the border, and explain it in the “Explanation of the Design” when necessary.

2.b Is there a written description of the Product, of which the Partial Design forms part?
Yes

Please Explain

Yes. Whether it is a Partial Design or General (Whole) Design, the applicant should pick the name of the article from the Korean Goods Classification, which was created based on the Locarno Classification. The article name should be the name of the complete article that includes portions depicted in both solid and dashed lines.

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.

No

Please Explain

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.

No

Please Explain

No. In principle, design infringement can be established when the kinds of products are identical or similar. However, design infringement can be established between dissimilar products if the products can be interchangeable in terms of usage, such as a pencil case and chopstick case.

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.

No
II. Policy considerations and proposals for improvements of your Group's current law

Please Explain

No. Again, a novelty issue can occur when the two compared products are identical or similar kinds of products.

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.

Elements outside the scope of the Partial Design can be taken into account when reviewing the registrability of a Partial Design application, however, the Unclaimed Part is not taken into account when considering functionality-driven design.

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. Under current Korean design practices, when a foreign applicant files a design application claiming priority, a General (Whole) Design cannot be filed if the prior design was a Partial Design. Instead, a Partial Design should be filed if the prior design was a Partial Design.

Like US design practices, we may improve current practices in Korea by allowing a foreign applicant to file a General (Whole) Design claiming priority based on an application for a Partial Design, since it is not an expansion of protection.

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

Yes.

Please Explain

Yes. Under the current practices, an applicant can use solid lines and dashed lines, colored or boundary lines, and can also submit photos instead of drawings.

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

Yes.

Please Explain

Under current design practices, the Unclaimed Part influences the protection of the parts of the designs that are claimed. The current Design Examination Guidelines specify that the Unclaimed Parts as well as the Claimed Parts of a Partial Design should be taken into account when determining if a design is registrable or not.

However, we think the Unclaimed Part should be considered limitedly and subsidiarily since it is not a part that the applicant is requesting for protection.

Yes

Please Explain

Under current design practices, Design Constraints restrict the subsistence and scope of protection of Partial Designs. The parts related to Design Constraints are completely or mostly excluded when the scope of protection is judged or determined by Intellectual Property Trial and Appeal Board or Court. However, we think that complete exclusion of the parts related to Design Constraints could result in an excessively limited protection of design rights.

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:

- the design as shown and any Unclaimed Part; and/or

Yes

Please Explain

- whether the Product is normally sold separately?

No

Please Explain

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

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

13. Is harmonisation of the law of Partial Designs desirable?

Yes

Please Explain
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.

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

- Both drawings and photos should be acceptable.

  (a) Partial Design: Use solid lines to graphically indicate the design. The Claimed Part can be depicted using colored or boundary lines. If necessary, the applicant should depict the portion claimed for the partial design registration in the “Explanation of the Design”. If the border separating the Claimed Part and Unclaimed Part is not clearly shown by the use of solid and dashed lines, dot-dashed lines can be used to indicate the border. The applicant can also explain how the Claimed Part is depicted in the “Explanation of the Design” when necessary.

  (b) Unclaimed Part: Use dashed lines to graphically indicate the design.

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.

SC is the same as UP

We think whether or not the products of the Partial Designs are the same/similar should be relevant, not whether the SC and UP are the same. Therefore, among (a) to (e), only in the case of (b) do we think a design right infringement could be established.

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

We think whether or not the products of the Partial Designs are the same/similar should be relevant, not whether the SC and UP are the same. Therefore, among (a) to (e), only in the case of (b) do we think a design right infringement could be established.

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

We think whether or not the products of the Partial Designs are the same/similar should be relevant, not whether the SC and UP are the same. Therefore, among (a) to (e), only in the case of (b) do we think a design right infringement could be
SC is not the same as UP, but SC and UP relate to products that categorised in the same way when registering designs.

We think whether or not the products of the Partial Designs are the same/similar should be relevant, not whether the SC and UP are the same. Therefore, among (a) to (e), only in the case of (b) do we think a design right infringement could be established.

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

We think whether or not the products of the Partial Designs are the same/similar should be relevant, not whether the SC and UP are the same. Therefore, among (a) to (e), only in the case of (b) do we think a design right infringement could be established.

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.

We think the Unclaimed Part also needs to be taken into account when we analyse the overall impression of a Partial Design for individual character and infringement since we need to consider the position and portion of the Claimed Part from the whole product and how the Claimed Part is connected with the Unclaimed Part when we judge the individual character and infringement. However, consideration of the Unclaimed Part should play a subsidiary role since the Claimed Part is part of the protection.

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.

The influence of Design Constraints arising from the Unclaimed Part on a Partial Design should exist but be minimal and limited. However, when judging infringement and registrability of a Partial Design, we think must fit / must match Design Constraints need to be considered together with limitations because the complete exclusion of an Unclaimed Part may result in the unrealistic judgement of infringement and registrability of a Partial Design.

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

N/A

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

Machinery and household items.
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

According to the Civil Code of the Russian Federation a design is a pattern of the appearance of a product of industrial or handicraft production. A design application can be filed to a whole article as well as to its part.

A partial design can be declared as a design if it is intended for unified use, i.e. if it can be used with various articles and can have an independent function and a single composition.

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

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

A dotted line may be used to display on the article image those parts (elements) of its external appearance, for which the applicant does not claim legal protection. At the same time the part of the appearance of the article, to which the claimed design belongs, will
be represented by a solid line.

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

No

Please Explain

The description of a Product, of which the Partial Design forms part, is not necessary; moreover, is not recommended to avoid misunderstanding in scope of protection. But there are requirements of the Rules, where the name of A Product, to which a Partial Design forms part, should be indicated:

- if the Partial design refers to the appearance of the it part of the product, the name of the application should indicate the name of the part of the product and the name of the whole product, indicating that the solution of the appearance of the part of the product is claimed;
- if the Partial design relates to a component for assembling a composite product, an indication in the name of the application of the name of the composite product is not mandatory.

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.

No

Please Explain

Since the scope of protection is defined by images only, and description serves only for clarity, verbal disclaimer won't have legal consequences - it may only be of help in case of doubts.

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

In case the Partial design refers to the appearance of the non-demountable part of the product, and therefore the name of the whole product should be indicated in the name of the design, in such a case, if Product Y differs from what is indicated in the name of the design, there is no infringement. But in all other cases, and also if Product Y can also be considered a type of product indicated in the name of the design, the infringement will be detected.

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

Again, this is true in case Partial design relates to a component for assembling a composite product (it's demountable). If it's non-demountable part of Product X, non-demountable part of Product Y won't be a bar to novelty, but will be a bar to originality.
The Designs Constraints are described in the laws as following: “When comparing the general impressions produced by the tested industrial design and the closest analogue, one should take into account the degree of freedom of the designer, i.e. the limitations of the designer’s capabilities that took place in the development of the tested industrial design. The need for such accounting is due, at least to three circumstances: the functional features of the product to which the industrial design belongs, the saturation of the analog series (a variety of known forms of products of the same purpose) and standardized requirements for the product, if any (Rule 75, 1), part 2 of the Rules on Preparing, Filing and Consideration of Designs applications and Rule 277 of the Guidelines on Industrial Designs). Therefore, hypothetically, elements outside the scope of Partial Design can be taken into part by an expert when considering Designs Constraints.

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

Yes

Due to today law and practice a Whole Design and a Partical Design cannot be included into one application - each application for each of them should be filed separately. Previous laws allowed including a whole product and its part into one application. The Group considers, also basing on previous experience, that both whole and the part should be allowed to form one application, since they are unified by the same creative input.

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

Yes

At the same time, necessity to include the name of the whole product into the name of design application in case the Partial Design is non-mountable, may create problems in proving infringement. This may create concerns of the Group.

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

Yes

It should influence the protection in the least possible way, but some influence is still unavoidable, to understand the aim of the Partial Design and also to reveal Design Constraints.

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

No

Please Explain
Vice versa, Design Constraints are not considered in detecting originality of a design claimed.

### III. Proposals for harmonisation

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

#### 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:

- the design as shown and any Unclaimed Part; and/or
- whether the Product is normally sold separately?

**Yes**

Please Explain

#### 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

### 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

#### 13. Is harmonisation of the law of Partial Designs desirable?

**Yes**

Please Explain

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

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.

SC is the same as UP

For sure, in such a case the overall impression should be the same: consumers for sure will perceive both products as originating from the same source, so confusion is highly likely.

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

Still, overall impression may be the same, since both products may still be considered by consumers as originating from one source.

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

Still, overall impression may be the same, since both products may still be considered by consumers as originating from one source.

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

Still, overall impression may be the same, since both products may still be considered by consumers as originating from one source.

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

Here may be doubts whether overall impression is the same. Most likely, it will be different.

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.
In the Russian IP law the very important role is given to so called "destination of the product". The same category may be suggested to be used for specifying whether and how the Unclaimed Part should be taken into account. As an example: "The Partial Design is considered infringed, in case UP and SC are of similar nature and designation and an informed consumer may suppose, that both products originate from the same source".

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.

Design Constraints arising from the Unclaimed Part may explain the limitations a designer had, therefore, set up less strict requirements to originality, but they should not exhaustively limit protection of a Partial Design.

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

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

Automobile, household appliances.
Partial designs

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

The laws governing the protection of registered designs are contained in the Registered Designs Act (Chapter 266) (“Act”).

A “design” is defined by s2(1) of the Act to mean, “features of shape, configuration, colours, pattern or ornament applied to any article or non-physical product that give that article or non-physical product its appearance .......” An "Article" is defined by s2(1) of the Act to mean anything that is manufactured (whether by industrial process, by hand or otherwise) and includes, (a) any part of an article if that part is made and sold separately; and (b) any set of articles. Partial Designs therefore satisfies the definition under s.2 of the Act being “features of shape, configuration, pattern or ornament applied to an ‘article’. There is no requirement under the Act that the design has to be an article in its entirety. The expression "made and sold separately" is not inconsistent with the position that protection is allowed for Partial Designs.

Practice Direction No. 1 of 2017 of the Intellectual Property Office of Singapore clarifies that a Partial Design may be claimed and protected. The Practice Direction states, “To protect a design which only applies to a part or parts of an article, clearly identify the part or parts of the article by means of broken or stippled lines, or shaded portions. Broken or stippled lines and/or shaded portions are for illustrative purposes only.”

The laws applicable to Partial Designs do not differ from Designs generally. S5(1) of the Act provides that a design which is new may upon application by the person claiming to be the owner, be registered in respect of an article, a non-physical product or a set of articles and non-physical products specified in the application. Based on the wording of Act, the registration of a Partial Design would still be required to satisfy the same criteria of novelty as would be the case of a Design registration.

The bars to registration in respect of a Design may be claimed and protected. The “must match” and “must fit” exclusions apply under Singapore law under s.2(1)(b) of the Act. Protection is not granted to (a) a method or principle of construction; (b) features of shape, configuration or colours of an article or a non-physical product that - (i) are dictated solely by the function that the article or non-physical
product has to perform; (ii) are dependent upon the appearance of another article or non-physical product of which the article or non-physical product to be connected to, or placed in, or around or against another article or non-physical product, so that either article or non-physical product may perform its function.

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

Partial Designs are to be represented graphically in the form of photographs or drawings under Part 12 of Form D3.

3. 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

1. The representations of the submitted design shall be either in the form of photographs or drawings which should be visually clear, of good quality and be suitable for reproduction.

2. To protect a Partial Design, the applicant has to clearly identify the part or parts of the article in solid lines. The parts for which protection is not claimed may be indicated by means of broken or stippled lines, or shaded portions. Broken or stippled lines and/or shaded portions are for illustrative purposes only.

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

No

Please Explain

Only the name of the Article and/or Non-physical product is requested for and there is no option to describe the product of which the Partial Design forms part.

5. 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

There is an option for the applicant to specify that no claim is to be made to any right to the exclusive use of (i) letters, (ii) words, (iii) numerals, (iv) symbols/units of measure, (v) trade mark elements. Applicant may also include a statement disclaiming generic elements which should not be claimed in the design application. The applicant may also indicate the following:

(i) The broken/stippled lines are for illustrative purposes only and form no part of the claimed design.

(ii) The shaded portions are for illustrative purposes only and form no part of the claimed design.

(iii) Others (specify)
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

The Partial Design forming part of a Product X can be infringed by the use of the same Partial Design on a Product Y.

In a Singapore Court of Appeal case of Hunter Manufacturing Pte Ltd v Soundtext Switchgear & Engineering Pte Ltd [1999] 3 SLR(R) 1108, the Court of Appeal applied a two step approach. The first step is to assess what are the essential or significant features of the registered design. The second step is to compare the registered design with the alleged infringement to assess whether visually the alleged infringement has incorporated all the design features which are considered to be the essential parts of the registration. If an alleged infringing article is the same or not substantially different from a part of the design for which protection is not claimed, there would not be a finding of infringement. It follows that as long as the two step approach is applied, there is no required link or nexus between X and Y. The Partial Design forming part of Product X can be said to be infringed by the use of the same Partial Design on Product Y.

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

It would appear that there is no required link or nexus between X and Y.

s.5(2) of the Act provides as follows:

“A design for which an application for registration is made shall not be regarded as new if it is the same as a design - (a) registered in respect of the same or any other article, non-physical product or set of articles and non-physical products in pursuance of a prior application; or (b) published in Singapore or elsewhere in respect of the same or any other article, non-physical product or set of articles and non-physical products before the date of the first-mentioned application or it differs from such a design only in immaterial details or in features which are variants commonly used in the trade.”

As long as the conditions in s.5(2) are satisfied, the Partial Design forming part of a Product X will not be considered novel in view that the same Partial Design is in prior Product Y.

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.

The position is unclear. It would appear that the elements outside the scope of the Partial Design when considering the application of Design Constraints such as must fit/must match exceptions may be taken into account.

A major review of Singapore’ design regime was conducted in 2014. Views of the public were sought. The concluding view is contained in Annex A of the Ministry of Law’s Final Report published on 16 March 2016. At 2.3.14 of the Final Report it was stated that there was little feedback from the public consultation relating to the “must fit” or “must match” exclusions in the context of Partial Designs save that it would be useful if the Intellectual Property Office of Singapore to issue Practice Directions to provide for guidance as to the practical effects of these exclusions.

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

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

The bars to registration in respect of a design should not equally apply to Partial Designs. S2(1) of the Act states that design features which enable an article to be connected to another article in order to perform a function are excluded from design registration under the “must fit” exclusion. The “must fit” exception can be seen as a specific situation under the general scope of registered design protection which excludes solely functional design features.

Practically, the application of the “must fit” exclusion under S2(1) of the Act to Partial Designs is unfeasible as partial designs often enable the product to be connected to, or placed in, around or against, another article so that either article may perform its function. A simple example would be the Partial Design of a handle for a pan (used AIPPI Study Guidelines p.5), where the handle for a pan enables the product to be connected to another article, so that the product may perform its function.

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

No

Please Explain

Written descriptions of the product, of which the Partial Design forms a part of, and of the Partial Design itself, should be allowed. Descriptions in writing, regarding what the Product is a part of, should be allowed as they can aid the applicant in explaining how Unclaimed Parts should be considered in the context of assessing the overall impression of the product. Furthermore, written descriptions may aid in explaining whether or not portions which are not visible in normal use (and not depicted graphically in the Partial Design) are included in the application for a Partial Design.

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

Yes

Please Explain

In applying for protection of a Partial Design, the Unclaimed Part should influence the protection of the parts of the design that are claims, but only insofar as it is consistent with the legitimate policy concern of preventing the use of design patents to protect functional ideas, and to prevent impermissible monopolies.

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

Yes

Please Explain

Design Constraints, defined as the constraints on design freedom arising from must fit / must match / technical functions, should restrict the subsistence and scope of protection of Partial Designs. This principle is in line with the general principle that design patents should not be used to protect functional ideas. Consequently, the scope of protection is broader when the designs are not constrained, but narrower when the designs are constrained.

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:

the design as shown and any Unclaimed Part; and/or
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

A Partial Design should be registrable as an independent design.

In a report released jointly by the Singapore Ministry of Law and the Intellectual Property Office of Singapore (“IPOS”) (see Annex A, Ministry of Law’s Final Report dated 16 March 2016) it was stated that Partial Designs are becoming more important to businesses due to the increasing use of design on specific parts of a product, product line, or even across different product lines so that they can distinguish their products from those offered by their competitors. Thus, Partial Designs should be registrable and protected in order to support such current and future business trends and needs.

13. Is harmonisation of the law of Partial Designs desirable?

Yes

Please Explain

Harmonisation of the law of Partial Designs is desirable for global business development.

As mentioned previously, business trend is moving towards the creation and designing of specific parts of products, instead of entire/whole products, by businesses to differentiate themselves from their competitors. Harmonisation of the law will ensure uniformity and wider protection around the world for business owners and their Partial Designs. Currently, the law on Partial Designs differs from country to
country. In some countries, protection is not offered for Partial Designs.

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.

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

We find that the current practice in Singapore is sufficient. The current practice here is to identify the part or parts of the Product intended for registration in solid lines. For the parts for which protection is not claimed, they can be indicated in either broken or stippled lines, or shaded portions.

One possible area of improvement is to include short mandatory descriptions in all applications to indicate which parts of the Products are claimed and which parts of the Products are unclaimed for protection.

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.

SC is the same as UP

In general, the UP and SC should not be relevant when considering the overall impressions of the accused product and the Partial Design. As opined by the Chairman of IPOS, Dr Stanley Lai, in his recent Journal of Intellectual Property Law & Practice article titled “The Protection of Partial Designs”, protection is only limited to the part(s) of the design that is claimed. Similarities in SC and UP should not matter in all 5 categories mentioned (i.e (a) to (e)). However, if the accused product is a Product that falls in the Locarno classification that the Partial Design is registered in, then the accused product can and should be found to infringe if the criteria for infringement are met.

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

See response to 15.a

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

See response to 15.a
15.d SC is not the same as UP, but SC and UP relate to products that categorised in the same way when registering designs

See response to 15.a

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

See response to 15.a

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.

In light of our answer to question 15, the Unclaimed Part should not be taken into account when analysing the overall impression of a Partial Design for individual character and infringement. Instead it should be the Locarno classification that should be taken into account. A Partial Design in a particular class should be able to enforce its rights against an accused product (in the same Locarno classification) which uses the Partial Design.

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.

The same rules governing the must fit/must match exceptions for registered designs should also be applied to Partial Designs. We do not think Design Constraints arising from the Unclaimed Part should affect a Partial Design because the protection sought is for the Partial Design, and not for the Unclaimed Part. As mentioned above, must fit/must match rules should continue to apply as there is little commercial value in must fit and must match parts. Such parts are not designed for aesthetic value on its own but rather in combination with another design.

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

No additional comments.

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

Legal practitioners.
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

YES, according to article 1.2 of current Spanish Industrial Design Law 20/2003, 7th July, partial designs are also protected under the same law that designs. The above mentioned article states as follows:

1.2 For the purposes of this Regulation:

   (a) ‘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 or materials of the product itself or its ornamentation.

   (b) ‘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.

   (c) ‘Complex product’ means a product which is composed of multiple components which can be replaced permitting disassembly and re-assembly of the product.

The wording of this provision follows the harmonization framework set forth by the EU Directive 98/71/CE on Legal Protection of Designs.

2. How are Partial Designs specified, described and/or graphically depicted?
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, according to the Spanish Patent and Trade Mark Office (SPTO) guidelines (item 2.1.19 ‘Disclaimers’), visual indications can be used to delimit the components not included in the partial design. However, by common practice CP6 published by the European Trademark and Design Network (EUTDM) \[1\], graphic representations that only show the design object of the claim are preferred.

Visual indications used to delimit the disclaimed part of the design must be unequivocal and obvious, so that the disclaimed part is clearly distinguishable, and must be consistent in all the views of the design. Disclaiming visual indications could be:

- Broken lines: dots, dashes or a combination of both. **Preferred way for disclaiming**. Broken lines are used to show the **Unclaimed Parts**.
- Shading: shading parts show the **Unclaimed Parts**
- Colouring: by colouring the Unclaimed Parts.
- Boundaries: **Claimed Parts** included within the boundary.
- Blurring: obscuring the **Unclaimed Parts** in drawings or photographs.

Footnotes

1. ^[1] The hub that connects EU National and Regional Intellectual Property Offices, User Associations and other IP Organizations

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

Yes

Please Explain

YES. According to the Spanish Industrial Design Law 20/2003 the legal treatment concerning descriptions is the same being it for the design applied to a portion of a product or for the design of the whole product: a written description can optionally be used to clarify what is claimed.

**Article 21. Application requirements**

2. In addition, the application may contain:
   
a) a description explaining the representation of the design

The Implementing Regulation Spanish Industrial Design of Law 20/2003 (Royal Decree 1937/2004) further specifies in article 1.2.a that:

**Article 1. Content of the application**

2. The application may contain, besides the above, the following elements:

   a) an explicative description of the representation of each design **referred only to the features appearing in the graphic representation** to which article 21.1.c) of Law 20/2003 from July the 7th is referred. It shall not contain statements as to the purported novelty or individual character of the design or the functionality of the design.

Finally, in accordance with the above-stated, the Design Guidelines of the Spanish Patent and Trade Mark Office (SPTO) \[1\] indicate that the description shall be optional and will not affect without affecting the scope of protection of the design as
Examiners must verify that what appears described is exactly what is seen.

Footnotes
1. ^Part A. Section 2.2.1. (Pg. 30) SPTO Design Guidelines. Version 1.0 January 2018

**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.*

No
Please Explain

There is no explicit mention in the Spanish Law about the possibility of using verbal disclaimers.

However, the Design Guidelines of the SPTO, following the Common Practice CP6 of the EUTMDN, stipulate that if disclaimers are made they must be apparent from the reproduction (drawings) of the design or model itself.[1]

As mentioned in the previous question, according to the Spanish Industrial Design Law 20/2003, a written description can optionally be used to clarify what is claimed but without altering the scope of protection of the object as reproduced.

Footnotes
1. ^Part A. Section 2.2.19 (Pg. 23). SPTO Design Guidelines. Version 1.0 January 2018

**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

The Spanish Industrial Design Law 20/2003 on its article 45 states as follows:

*Article 45. Content of the right of the registered design.*

The registered design shall confer on its holder the exclusive right to use it and to prevent any third party not having his consent from using it. To these effects, using means making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated, as well as the stocking of such a product for any of the aforementioned purposes.

Thus, according to the wording of the above mentioned article, a Partial Design forming part of a Product X would be infringed by a Product Y incorporating the same Partial Design.

**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

According to the novelty requirement established in article 6, a design shall be considered to be new if no identical design has been
made available to the public.

Spanish Law is identical concerning novelty requirements to the EU Regulation, so the practice is also similar.

The reply to this question would depend on the nature of Product X and Y.

If product X and Y are of the same nature, a Partial Design in Product X would not be considered novel in view of the same Partial Design in prior Product Y.

However, if Products X and Y are of different nature, Partial Design X would be novel, in view of the same Partial Design in different Product Y.

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.

Design constraints are set forth in article 11 of the Spanish Industrial Design Law 20/2003. The same Law regards these constraints as exceptions[^1] to the claimed design registration.

According to the Design Guidelines of the SPTO[^2] and EUIPO[^3] disclaimed features of an earlier registered design can be taken into account when assessing the novelty and individual character of a contested Design.

Design Constraints, such as must fit/must match affect to the validity of a registered design, as novelty and individual character do, and as such could be taken into consideration when considering the subsistence of a registered design consisting in a Partial Design, even if those Design Constraints elements are outside the scope of the Partial Design, even though, the general principle, according to what it is indicated under Paragraph 20 of the Preamble of Regulation 6/2002 on Community Designs:

> those features of a design which are excluded from protection for those reasons should not be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection.

Footnotes

2. [^2] Part B. Section 4.1.2.1.4. (Pg. 19). SPTO Design Guidelines, Version 1.0 January 2018
3. [^3] Section 5.5.2.1 (Pgs. 34-35) EUIPO Guidelines for Invalidity Design Applications

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

No

Please Explain

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

Yes

Please Explain

Should the Unclaimed Part influence the protection of the parts of the design that are claimed? Please explain why or why not.
Should Design Constraints restrict the subsistence and scope of protection of Partial Designs? Please explain why or why not.

Yes

Please Explain

The legal conceptualization of the design is unique, regardless of whether it is applied to a product as a whole or only to a part of it and, therefore, the legal limitations imposed by its functionality or other aspects are also unique.

However, this will always be determined by the final product, upon which the subsistence and degree of incidence of these limitations will have to be considered.

See reply to Question I.5.

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:

- the design as shown and any Unclaimed Part; and/or

Yes

Please Explain

YES, following the same argument of the previous point.

whether the Product is normally sold separately?

No

Please Explain

No, the fact of whether or not the product is sold separately should not be a limitation. Both national and community regulations are clear in this regard when separating design and product concepts.

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?

Yes

Please Explain
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

There are many situations when only a part of a product fulfils the validity requirements so there is a need to recognise worldwide the possibility to protect a part of a product.

13 Is harmonisation of the law of Partial Designs desirable?

Yes

Please Explain

In spite of the harmonising efforts at the EU level, first with the Directive and then with the Regulation, there are still interpretative discrepancies, especially at the judicial level, regarding the scope and effectiveness of Partial Designs of a product.

This lack of harmonisation in the European Union shows the need for more worldwide confluence in the field of designs. The incorporation of new countries to the Hague Agreement on International Designs requires at least harmonisation in those countries so that users can make a reliable use of that system.

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.

We understand that, at the registry level, a certain degree of formal harmonisation has been achieved in terms of the requirements for delimiting these designs in the application.

The ETMDN Convergence Program (CP6 graphic representations of designs), promoted by EUIPO and by the national offices, as well as the examination guidelines of the different offices, which reflect the aforementioned case law of the (ECJ) establish a set of technical and formal provisions to claim Partial Designs and exclude ( waive) parts of the product that are not claimed as belonging to the design.
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. SC is the same as UP

Yes. The overall impression for the purposes of assessing the individual character of designs is determined by the product as a whole. However, as the Supreme Court establishes in its judgment of June 26, 2014 (Case S. TOUS, SL vs. NEW AURIJOYA, SL):

(...) that assessment must be made with criteria more synthetic than analytical, of putting back together the parts into the whole, rather than breaking down the whole into parts, as results from the need to capture the global vision that the whole set produces in said character (...)

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

Yes. On assessing the overall impression, the nature or sector of the product that incorporates the design is one of the key factors for the informed user, who as such is precisely considered to be familiar with a certain sector or design area.

The judgment of the Supreme Court of April 30, 2014 (Case FIESTA vs. PERFETTI VAN MELLE, SpA.) states that:

(...) the informed user, in order to assess the concurrence of the individual character requirement of the design, is linked to the industrial sector in question, since the personal experience or extensive knowledge about the existing designs in the category of products in question that characterize an "informed" user necessarily refer to a specific industrial sector (...)

This aspect is also part of the four-step analysis that the CJEU has defined in Case T-525/13 H&M vs. Yves Saint Laurent of 10.09.2015.

From this it is inferred that the assessment of the nature of the product and of the industrial sector carried out by the informed user (who is precisely defined as such), includes the applicative element as one of its analysis criteria.

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

Yes. Following the criteria of the above mentioned judgment, the appearance of the product is an intrinsic part of the comparative examination. Moreover, depending on the circumstances of the case, it may have a greater weight than the applicative aspect when configuring the overall impression.

In this sense, and according to the same judgment:

(...) in order to assess the individual character in the comparative judgment, there is normally an inverse relationship between the general similarity of the design with respect to another and the similarity of the nature of the product to which it is applied, so that designs that show certain differences among themselves, when applied to products of the same industrial sector, can cause the same overall impression on the informed users, while designs with slight differences can cause a different overall impression on informed users if they are applied to products of very different industrial sectors (...)

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It may be an evidentiary criterion. The Locarno Classification has only administrative effects and it does not determine the scope of the protection of designs, but an identical categorisation of both products provides input to the informed user.

Yes. In the same way that the degree of proximity of UP and SC is one of the determining elements in the assessment of the individual character, *a contrario* (a) the separation or disconnection between these elements must also be determining.

When analysing the similarity between two designs consisting of the whole shape of a product, the aforementioned judgment of the Supreme Court states:

(...) *In addition, it is not a design that applies to part of a product, in the sense of a product that is completely different from the one for which it was subsequently registered and that causes a different overall impression in the informed user between the previous design and the registered one* (…)

Establishing a priori criteria for such a complex variety of cases where designs are involved is a difficult task. In all cases, the Unclaimed Part of the design should indeed be taken into account when determining the overall impression, since it is still one of the visually perceptible elements of the finished product and it contributes to the final configuration, which is ultimately what the informed user will contrast.

The criterion of assessment of the Unclaimed Part with respect to the individual character of the design should be the same for both the validity test and the infringement test.

The fact that these limitations are excluded from protection does not preclude them from contributing to the final appearance of the product in the eyes of the informed user, whereby the same assessment criterion is applied to them as with the Unclaimed Parts or the Surrounding Context in determining the overall impression.

The priority right is an aspect that should be considered when addressing the complexity of this issue. The unequal treatment applied to the articulation of disclaimers and formal requirements certainly causes distortions for the users of the system.

Thus, Art-4 (A) (2) of the Paris Convention and Art. 41 (2) of the Community Design Regulation 6/2002 clearly establish that the right of priority concurs only to the extent where there is an equivalence with a regular national deposit of the country or territory in which enforcement is sought.
In this sense, the law of the country or territory receiving the priority claim may qualify or set additional requirements to render it effective. As the Advocate General concludes in Case C-217/17P Mast Jägermeister SE vs. EUIPO: (...) any Law, in particular that of the EU, is free to define the requirements of a regular deposit (...) [1]

All this may lead to the loss of priority rights in the cases where priority is to be based on a previous application for a Partial Design of a product, in a jurisdiction that formally recognises representations or descriptions of this specific type.

Footnotes


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

In our answers we have considered views from a wide range of industries, since this is a rather transversal topic that affects any right-holder either seeking protection, enforcing design rights or intending to avoid infringement thereof.
Study Question

Submission date: May 3, 2018

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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

Yes, protection is given to Partial Designs. The protection for Partial Designs do not differ from the laws for the protection of designs in general. The applicable legislation is for Swedish national registered designs, the Swedish Design Protection Act (1970:485) which is based on the Directive 98/71/EC, and for Community Designs, the Community Design Regulation EC No 6/2002 (“CDR”).

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

Please refer to p. 2 a-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
When filing an application for registration of a Partial Design, the image material should primarily show only the part to be covered by the protection.

There are also other acceptable ways to display a Partial Design. Dotted or dashed lines are recommended to indicate the Unclaimed Part, please refer to the D1 example.

Only when dotted or dashed lines cannot be used, due to technical reasons, following disclaimers may be used to indicate the Unclaimed Part.

The IP Offices of the European Trade Mark and Design Network continue to collaborate in the context of the Convergence Program. They have now agreed on the first Common Practice of Designs with the aim of giving guidance for the examination procedures on how to use the appropriate disclaimers, types of views and how to represent designs in a neutral background. Convergence on graphic representations of designs - Common Communication 15 April 2016 ("CP6"). Sweden took part in the working group but has not yet adopted the proposed unified practice. We do not have any information on when or whether Sweden will adopt it.
**2.b** Is there a written description of the Product, of which the Partial Design forms part?

Yes

Please Explain

Yes, when filing an application for a design registration in Sweden you must provide a product specification that specifies *the type of product you seek to protect* by a design registration. The product specification shall not include any reference to technical features but shall for Partial Designs describe in words the desired scope of protection (e.g. as regards D1 “handle of a pan”). The product specification does not however impact the scope of protection, as it is provided solely for classification purposes (within the so-called Locarno classification system.)

**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.

No

Please Explain

**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

Yes, a partial design forming a part of Product X can be infringed on by the use of the same partial design on a Product Y.

For Partial Designs making up a part of a complex product, the decisive factor is if the appearance during normal use produces the same overall impression on the informed user, according to product 2 a § The Swedish Design Protection Act. For example, in relation to a comparison of two different internal combustion engines, to be incorporated in a lawn mower, the court held that only the parts of the internal combustion engine that were visible during normal use were to be taken into consideration, not the appearance of the of the products overall (Judgment of the EU General Court, T-10/08 - Kwang Yang Motor).

For Partial Designs forming a part of non-complex products, a comparison to see if the Partial Designs forming the parts of the products will produce the same overall impression on an informed user, taking into account the degree of freedom of the designer in developing the design, is the decisive factor. If the Partial Design in Product Y produces the same overall impression on the informed user as Product X, then Product X can be infringed on. One example from case law is that the inside of a door was not considered to produce a new overall impression, and in this instance only the indicated Partial Design was examined, not the overall impression of the products (see judgment of EU General Court T-251/14 - DEP Natorski and Pokrywa v EUIPO).

The scope of protection for a Partial Design when incorporated in a different type of product has not been completely clarified by the Swedish nor the EU courts. The court has stated that the product the Partial Design is to be inserted into, or at least the relevant sector, is to be taken into account (see judgment by the EU General Court, T7666/11 Bounding feline para. 31). Furthermore, the court has stated that in the assessment of individual character of a product, a four-stage examination is to be made, taking into account i) the sector to which the products in which the design is intended to be incorporated or to which it is intended to be applied belong, ii) the informed user of those products and their awareness, iii) the designers freedom in developing the design and, iv) the outcome of the comparison of the designs at issue, taking into account the sector in question, the designer’s degree of freedom and the overall impressions produced on the informed user by the contested design and by any earlier design which has been made available to the public (see judgment of EU General Court in T757/16 Chanel para. 27). The outcome of this assessment will be decisive in determining if there is an infringement.

**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
A design is considered new if it is not predated by an identical design disclosed pursuant to Article 7 CDR or 2 § The Swedish Design Protection Act, or if it only differs in immaterial details. Thus, a Partial Design can be considered not novel in view of the same design in another Product, if the latter constitutes of each and every element of the former.

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.

The basis for the examination of an application to a partial design is that elements outside the scope of the design are not considered by the registration authority. Moreover, there is no examination of whether the partial design comprises a must fit part, which in are excepted from protection under the Swedish Design Protection Act. Such considerations could instead arise if the application becomes subject to opposition from third parties or within an infringement matter where a must fit exception is invoked.

Must match parts are not excepted from protection under the Swedish Design Protection Act but have a shorter period of protection of 15 years (5x3), as compared to 25 years. As with must fit solutions, the registration authority does not make any assessment of whether the sought design is actually a must match part. This could lead to the fact that such designs are granted a fourth and fifth extension of their protection periods (year 16-25), even though they only should be given a 15 year protection. As with the must fit exception, a consideration of the outside elements in order to determine if a must match situation is at hand, should instead be made in possible opposition, infringement or validity proceedings.

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

As Sweden has not adopted the convergence program (CP6), there is a risk that the evaluation at the Swedish Patent- and registration Office may differ from other states within the European Union.

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

Yes

Please Explain

Yes. However, please see p. 6.

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

The Unclaimed part shouldn’t be allowed to directly influence the protection of the claimed part in a way that the Unclaimed part might be used to extend the protection of the claimed part beyond what would otherwise be possible. The applicant may therefore not be able to use an Unclaimed part for the unwarranted beneficial purpose of receiving a larger scope of protection.

The Unclaimed part should not however be completely disregarded, as it may still serve as relevant evidence when assessing whether or not
the claimed part produces an overall impression on the informed user that differs from earlier public designs. The Unclaimed part may, during this test, indicate i.e. the normal use of the product, and the freedom of the designer.

If the Unclaimed part is limited to having such an evidentiary use, the Unclaimed part would in practice consist only of information that wouldn't have been precluded in an opposition or infringement proceeding either way, even if left out of the application.


Yes

Please Explain

We find the current exception regarding “must fit” as a reasonable solution in order to safeguard the availability for other creators to contribute to the field and provide differently designed parts that fit the rest of a product.

As for the must match exception, it is a hot topic of balancing the interests of the automobile industry in particular, and on the other side the interest of fairly priced spare parts. Even though a harmonization would as always be welcomed, we support to solution adapted in the Swedish Act with a shorter protection time for such parts.

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:

- the design as shown and any Unclaimed Part; and/or

Yes

Please Explain

Yes, as it clearly indicates which parts of the product that is intended to be included/excluded from protection.

- whether the Product is normally sold separately?

Yes

Please Explain

Yes, to make sure that if another design producing the same overall impression is also considered to lack individual character/infringe on the earlier design, whether sold together with another product or separately.

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?

Yes

Please Explain

A clarification as regards to the scope of protection when the Partial Design makes up part of a different product.
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

13 Is harmonisation of the law of Partial Designs desirable?
Yes
Please Explain

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.

We do believe that the current framework set forth by the Swedish Patent- and registrations Office is sufficient, and cannot really see the need for additional ways for specifying, describing and/or graphically depicting the Partial Design and the Unclaimed part, please refer to the answer under p. 2a.

However, in order to seek for a smooth harmonization process, the group has closely reviewed the results of CP6 program. The differences from the results of the CP6 program compared to the Swedish system are small.

Therefore, we do consider that the framework set forth in CP6 for visual disclaimers should be used, namely that:

1. Graphic or photographic representations showing only the claimed Partial Design are preferred;

2. However, visual disclaimers may alternatively be used to indicate an Unclaimed Part of the graphic or photographic representations. The visual disclaimer must then be clear and obvious, and the Partial Design and the Unclaimed Part must be clearly differentiated;

3. The graphic or photographic representation of the design shall clearly indicate that protection is only sought for the Partial Design and not the Unclaimed Part;

4. The graphic or photographic representation of the design shall show consistently the Unclaimed Part in all the views where the Unclaimed Part appears; and

5. Where a visual disclaimer is used, broken lines are recommended for indicating the Unclaimed Part (and the Partial Design be indicated with continuous lines). Only when broken lines cannot be used due to technical reasons (for example, when they are used to indicate stitching on clothing or patterns; or photographs are used), other visual disclaimers can be used: colour shading, boundaries and blurring.
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.

**SC is the same as UP**

No matter if the SC and the UP are the same, similar or entirely unconnected, this could be taken into the assessment of the overall impression of the Partial Designs in question, as it may indicate the freedom of the designer and possible design constraints. But the UP and the SC should only be limited to evidentiary use. This should not directly influence scope of protection of the protected part. A partial design that is highly similar to an earlier partial design, where there exists a high degree of freedom can still be able to produce the same overall impression as the earlier design, no matter if the UP and the SC are entirely unconnected. Similarly, two partial designs with a low degree of similarity and where the designer due to constraints have a low degree of freedom can be considered to produce different overall impressions, even if the UP and the SC are highly similar.

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

See p.15 a.

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

See p.15 a.

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

As is the visual appearance of the design rather than the classification of the design that is the decisive factor in determining the overall impression and the scope of protection for designs in general, it is our opinion that this should apply to partial designs as well. Thus, it should not be relevant for the assessment.

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

See p.15 a.

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.
In light of the above, the Unclaimed Part should be able to act as evidence in assessing the overall impression for both individual character and infringement. The Unclaimed Part should however never directly influence similarity assessment in relation to the Partial Design.

**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.**

The Unclaimed Part should not directly influence the assessment of Design Constraints, but it may still have an evidentiary effect when assessing the freedom of the designer and Design Constraints. The Unclaimed Part may help to better establish what type of product the Partial Design is as it depicts its appearance in normal use. It may also serve as a basis of the circumstances under which the Partial Design was created, and may consequently be helpful when identifying possible constraints in the designer’s freedom such as technical function i.e.

It is however questionable to what extent the Unclaimed Part will be of any relevant evidentiary use when assessing must fit/must match, as those defences are to a greater extent dependent on objectively assessing the details on the actual physical products which has been put on the market. Although the Unclaimed Part may at least clearly indicate the designer’s awareness of the Partial Design possibly being subject to must fit/must match.

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

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

None.
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

The Federal Act on the Protection of Designs protects the design “of products or parts of products” that is characterised, in particular, by the arrangement of lines, surfaces, contours or colours or by the materials used (Art. 1 Design Act). In general view, protection is given to Partial Designs.

The Design Act does not state any additional or different requirements for the protection of Partial Designs. In legal literature, however, it is disputed whether a Partial Design is capable of being protected only

- if it could be sold on its own (pro: OFK-, 2. Aufl., Art. 1 DesG N 26; SIWR-Wang, 74; Marbach, in: Marbach/Ducrey/Wild: Immaterialgüter- und Wettbewerbsrecht, 4. Aufl., N 440; contra: SHK-Stutz/Beutler/Künzi, DesG 1 N 40) and/or

- if it is visible in normal use (pro: , N 448; contra: OFK-, Art. 1 DesG N 27; SIWR-, 74; SHK-, DesG 1 N 37; , Art. 1 N 52).

These issues have not been clarified by Swiss case law yet. Denying individual character of the design in question, the Swiss Federal Supreme Court notably left undecided any requirement of “autonomy” (“Eigenständigkeit”; BGer 4A_44/2016, E. 2.3.5 – Saunapritschen).

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

There is no legal requirement to show the Partial Design in connection with the unclaimed part. It is possible to represent the Partial Design (i.e. a part of a product such as the handle as mentioned herein) as such.

The Swiss Federal Institute of Intellectual Property accepts dotted or dashed lines as indications of the unclaimed Part of the Partial Design. By way of exceptions it does accept shading when it is not possible to define the unclaimed part otherwise. In the Swiss Group's view, colouring should be allowed as an ultima ratio as well.

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

Yes

Please Explain

Swiss law foresees the possibility to add a description in order to explain the representation of the Design (Art. 19 al. 4 Designs Act, DesA). However, this is optional. The Partial Design has to be clearly depicted in the submitted representation. Furthermore, it must be clear to the examiner which part is protected and which is excluded from protection while examining the representation. A description only explains the representation and does not add any new features.

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.

No

Please Explain

The Swiss practice does not allow a verbal disclaimer. The representation must contain the part of the design that has to be protected, either alone or in its context using dotted or dashed lines for the Unclaimed Part. The representation has to reveal the protected Design.

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

Art. 8 of the Design Act stipulates that the protection of the design right includes designs that have the same essential features and thus produce the same overall impression as the registered design. There is no provision in the Design Act which would limit the scope of protection in any way. Furthermore, there is no high court decision in Switzerland concerning that question.

From legal literature the main opinion appears to be that the only criteria regarding the question of infringement is the same overall impression [Staub in Staub, Designrecht, Zürich 2003, Art. 8 N 26]. Therefore, the scope of protection of a Partial Design (that is registered in combination with a disclaimed product) should extend also on Partial Designs which are used with products that are different from the disclaimed product. Hence, the registered design of the handle as discussed within the scope of this questionnaire would cover the handle on the pan as well as on the sieve.

Whether and to which extent a link or nexus between X and Y is required, is not entirely clear. In BGE 134 III 205, 213 the Swiss Federal
Supreme Court only held that the scope of different products to consider in this context does not only extend to substitutable products, but did not provide any further guidance. In literature, the question has been heavily discussed. While some authors take the position that the products should at least be “akin” (see Heinrich, OFK-DesG/HMA, DesG 2 N 161 et seq.; SWIR-Wang, 67 et seq.; Eschmann, 150 et seq.) others appear to decline the requirement of a link or nexus (SHK-Stutz/Beutler/Künzi, Art. 8 N 72; Marbach, in: Marbach/Ducrey/Wild: Immaterialgüter- und Wettbewerbsrecht, 4. Aufl., N 457).

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

Yes, a Partial Design forming part of a Product X can be considered not novel in view of the same Partial Design in prior Product Y. With respect to the nexus required, the situation is the same as mentioned with regard to question 3. It is generally acknowledged the same principle should apply when assessing novelty and infringement.

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.

Elements outside of the scope of Partial Design are not to be taken into account. The Swiss Design Act foresees with Art. 4c that a design shall not be protected in case the features of the design are dictated solely by the technical function of the product. Alternative forms – even if the part only embodies a technical function – must be taken into consideration for the Partial Design itself. However, the overall impression is decisive.

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

As outlined above the design system in Switzerland follows a liberal approach with regard to Partial Designs. The group is of the opinion that such a liberal approach is in favour of the stakeholders and therefore no further clarification on a statutory basis is necessary in Switzerland.

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

Yes

Please Explain

Under current Swiss practice Partial Designs are usually defined by representing the non-claimed subject matter with broken lines. In some types of representations, such as renderings or photographs, this is not always feasible. The group is of the opinion that with this regard the Swiss practice could be enhanced. In particular by admitting other ways of depicting or describing the parts for which no protection is claimed.

Furthermore, the way of specifying, describing or depicting Partial Designs shall be harmonized internationally.
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

On principle, the Swiss group is of the opinion that the filed representations shall determine the scope of protection and that there shall be no limitation of the scope of protection by other factors such as the title or the Locarno classification.

In view of this general principle, the Swiss group believes that the unclaimed part shall not influence the scope of protection. The main reason is to avoid that the rights of the design proprietor are limited unnecessarily.

For example: When considering the example with the handle as indicated in the introduction of this study question, the scope of a handle-design shall not be limited to a sieve or a pan, in case the handle is registered as a Partial Design and the sieve or the pan, respectively, are disclaimed. Limiting the scope of the handle to either the sieve or the pan, would constitute an unjustified limitation in case the core of the design lies in the design of the handle.


No

Please Explain

Design constraints shall not influence the scope of protection, in particular, if several design alternatives are feasible within the boundary of design constraints.

According to the opinion of the Swiss Group the overall impression together with its distinctive features of the protected design shall be decisive for the scope of protection.

The Swiss Group is of the opinion that the only exception when it comes to design constraints concerns those features of the designs which are dictated solely by the technical function of the product. In case the distinctive features are dictated solely by the technical function of the product, no protection shall result for said technical features.

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:

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

Yes

Please Explain

Yes, the assessment should take into account the design as shown. The unclaimed part shall play, as indicated above no or only a minor role.

10.b whether the Product is normally sold separately?

No

Please Explain
No. The validity and/or the scope of protection shall be independent from the sale.

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?

Yes

Please Explain

The Swiss Group is of the opinion that the AIPPI should focus on a liberal approach. In particular, the Swiss Group believes that it is in the interested of the property rights owner that design protection is available for Partial Designs in a broad manner. However, as the only exception there shall be no design protection available for those features which are dictated solely by their technical function. Other exceptions such as a must-fit/must-match exception or a replacement part exception shall not be provided.

III. Proposals for harmonisation

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

Should a Partial Design be registrable as an independent design?

Yes

Please Explain

Yes, Partial Designs shall also be protected as such, provided that the Partial Design as such is novel and has an individual character.

Is harmonisation of the law of Partial Designs desirable?

Yes

Please Explain

Yes. The Swiss Group considers harmonisation important to provide an international framework for design protection providing easy access to the users of the design systems. Harmonization would also enhance legal certainty for property rights owner as well as for third parties.

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.

Please propose a suitable framework for specifying, describing and/or graphically depicting (a) the Partial Design and (b) the Unclaimed Part.
A suitable framework of specifying, describing and/or graphically depicting the Partial Design and the Unclaimed Part would be the use of the following elements

- Broken lines for the unclaimed part and normal lines for the claimed parts.
- If broken lines are not suitable, any other means such as shading/encompassing lines or as an ultimo ratio a coloured layer shall be used to define the Unclaimed Parts in the representations, whereby additionally a description clarifying which parts are to be considered as unclaimed shall be added.

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.

15.a SC is the same as UP

The Swiss Group comes to the conclusion that no separation is necessary as the handle which is to be considered as the Partial Design shall be protected as such irrespective of its use with the unclaimed part shown in the representation or with any other element that is not shown in the representation.

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

The Swiss Group comes to the conclusion that no separation is necessary as the handle which is to be considered as the Partial Design shall be protected as such irrespective of its use with the unclaimed part shown in the representation or with any other element that is not shown in the representation.

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

The Swiss Group comes to the conclusion that no separation is necessary as the handle which is to be considered as the Partial Design shall be protected as such irrespective of its use with the unclaimed part shown in the representation or with any other element that is not shown in the representation.

15.d SC is not the same as UP, but SC and UP relate to products that categorized in the same way when registering designs

The Swiss Group comes to the conclusion that no separation is necessary as the handle which is to be considered as the Partial Design shall be protected as such irrespective of its use with the unclaimed part shown in the representation or with any other element that is not shown in the representation.

15.e SC is not the same as UP, and SC and UP are entirely unconnected.
The Swiss Group comes to the conclusion that no separation is necessary as the handle which is to be considered as the Partial Design shall be protected as such irrespective of its use with the unclaimed part shown in the representation or with any other element that is not shown in the representation.

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 mentioned above the unclaimed part shall not be taken into account. The scope of protection of a Partial Design shall include all combinations with other elements as long as the protected Partial Design is used.

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.

The Swiss Group is of the opinion that there shall be no limitation in the scope of protection based on design constraints apart from the only exception when the design constraints are purely technical. However, it appears to be important that the Partial Design as such is novel and has an individual character.

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

The Swiss Group has no further comments.

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

- Consumer goods
- Building industry
- Pharmaceutical industry
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

Laws for the protection of Partial Design is not different.

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

if protection of a partial design is requested, the unclaimed parts in a visual indication that is submitted as drawing are shown by dotted or dashed lines. If a visual indication is submitted as a photograph, the claimed parts are then limited by clearly marking. If the visual indication that is submitted as a photograph cannot be marked as a line (by outlining) due to technical reasons, the unclaimed parts can be shown by shadowing, coloring or blurring.

3. 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

If protection of a partial design is requested, the unclaimed parts in a visual indication that is submitted as drawing are shown by dotted or dashed lines. If a visual indication is submitted as a photograph, the claimed parts are then limited by clearly marking. If the visual indication that is submitted as a photograph cannot be marked as a line (by outlining) due to technical reasons, the unclaimed parts can be shown by shadowing, coloring or blurring.

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

Yes

Please Explain

Optionally, while filing an application, it is possible to submit a written description of the Product, of which the Partial Design forms part.

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

Verbal disclaimers cannot be used alone. However, they can be used to support visual representations.

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

In case the product X is registered as a Partial Design, then no link or nexus is required.

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

In case of the Product X is claimed as a Partial Design, then no link or nexus is required.

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.
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

There should be a Guideline prepared by the registration authority Turkish Patent and Trademark Office (Turk Patent) which includes visual examples of ways of showing the partial designs and explaining the scope of protection of the partial designs.

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

Yes

Please Explain

Our legislation covers three ways of showing the partial designs; namely coloring, outlining and use of dotted or dashed lines. Additionally, apart from the listed techniques, Turk Patent examiners indicated that any clear visual showing way of Partial Disclaimer can be accepted.

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

The partial design protection will take into account irrespective of the entire product. But it is recommended adding the partial design as an additional view for a better understanding of the design.


Yes

Please Explain

Design Constraints should restrict the subsistence and scope of protection of Partial Designs, as the general provisions should be applied to Partial Designs as well. The constraints for Partial Designs should be in parallel with Design Constraints in accordance with the general provisions. There should be no exceptional rules.

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:

Unclaimed parts are not taken into account when considering the application of Design Constraints.
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

Yes, as long as the Partial Design is visible at the normal use, it should be registered as an independent design. When the Partial Design cannot be visualized separately/solely or it is inseparable from the article which the design is applied to, it can be visualized by the methods of partial disclaimer techniques such as dotted or dashed lines, coloring or outlining for a better understanding of the design.

13 Is harmonisation of the law of Partial Designs desirable?

Yes

Please Explain

Yes
Harmonization is desirable especially for independent Partial Designs. In some jurisdictions, there is a requirement of the link between the article in which the design is applied to and the design for obtaining design protection which limits scope of protection for Partial Designs.

*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.*

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

The parts for which protection is sought should be indicated clearly on the visual representations either by outlining or coloring at the visual representations which are submitted at the CAD drawing or photograph format, and use of dotted or dashed lines for the unclaimed parts specifically at the visual representations which are submitted at the line drawing format.

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,

- 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**

**SC is the same as UP**

Not relevant because partial design should be protected whether they are same or not.

**5**

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

Not relevant because partial design should be protected whether they are used in the same way or not.

**5**

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

Not relevant because partial design should be protected whether they look the same way or not.

**5**

**SC is not the same as UP, but SC and UP relate to products that categorised in the same way when registering designs**
5. SC is not the same as UP, and SC and UP are entirely unconnected.

Not relevant because partial design is protected whether they are categorized in the same way.

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

Not relevant because partial design should be protected whether entirely connected or not.

10. 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.

Unclaimed Part may help to reach a better understanding of the design applied to an article but it should not be taken into account when analyzing the overall impression of the Partial Design since the Unclaimed Part is not part of the protected portion of the design.

11. 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.

General rules for Design Constraints applied to designs should likewise affect Partial Design.

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

Some countries have the rule of requirement of a link between the article and the design for obtaining design protection, which prevents providing an efficient scope of protection for Partial Designs. This rule should be revised in order not to limit the scope of protection for the Partial Designs.

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

Household appliances, white household appliances, electric electronic, stage decor design, packaging, lightning, furniture.
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

Yes, provided that it otherwise meets the requirements for registrability.

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).

The laws for the protection of Partial Designs are not different to the laws for the protection of designs generally. Partial designs must meet all of the same requirements for registrability.
AIPPI 2018 - Study Question - Partial designs

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

See answers below for (a), (b) and (c)

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

Both the UKIPO and the EUIPO provide guidelines which contain general instructions for visual indications.

For UK registered designs, the UKIPO suggests "greying-out" the irrelevant parts of the design to disclaim the Unclaimed Part.

It also suggests “highlighting” the specific parts of the design you do wish to protect (a "limitation"). For example, to register a Partial Design for the legs of a table, the applicant could outline, by using a distinct visual border, the table legs to make clear that it is only the legs being registered.

For Community registered designs, the EUIPO suggests the following visual indications to disclaim an Unclaimed Part:

1. Broken/dashed lines – a line made up of dots or dashes (or a combination of both) to indicate what features protection is not sought for, contrasted against continuous lines to indicate the Partial Design.

2. Blurring – obscuring the features for which protection is not sought.

3. Colour shading - using contrasting tones to sufficiently obscure the features for which protection is not sought.

4. Boundaries – (akin to ‘highlighting’ above) to outline an area to indication that no protection is sought for features not contained within the boundary.

There has recently been an effort to harmonise the guidance for graphic representation of designs across the EU by the European Trade Mark and Design Network. Common Practice 6 (“CP6”) provides guidance on graphic representation of designs. It aims to give common guidance for the examination procedures on, for example, how to use appropriate disclaimers. CP6 largely follows the EUIPO’s guidance summarised above. Showing only the claimed design is preferred although it is acknowledged that sometimes it is helpful to show the design in context to understand the features of the Partial Design. Where a disclaimer is used, the use of broken lines is “recommended”. Only when broken lines cannot be used due to technical reasons (for example, where they are used to indicate stitching on a design), other disclaimers such as colour shading, boundaries and blurring can be used. CP6 also provides examples of how not to claim partial designs, for example, by not using a clear boundary line which results in the risk of including more than just the Partial Design within the boundary.

CP6 was implemented by the UK as of 15 April 2016, although it has not yet updated its guidance to reflect the principles of CP6. It has, however, updated its Examination Practice Guide to reflect CP6. There is therefore some residual conflict as to its implementation.

However, given that these are only guidelines, they are not binding and there is no uniform approach as to how to depict Partial Designs. Consequently there is no uniform approach to the interpretation of the visual disclaimer techniques. There is considerable uncertainty concerning the correct interpretation, particularly of broken lines. Whilst the EUIPO guidance above 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 in Samsung Electronics (UK) Limited v Apple Inc. [2012] EWHC 1882 (Pat). In that case it was determined that the dashed lines showed an edge visible under a glass screen, rather than the usual practice of dashed lines being used to disclaim a part of the design. Various practices concerning use of dashed lines are arising in other countries. CP6 touches on this problem, stating that where broken lines are used to indicate a feature of the design (and not to disclaim a part of the design), this “must be clear from the representation”. It suggests that in such cases, it may be helpful to file a “magnified view” (although it fails to produce an adequate example of this). Where broken lines are used to indicate a feature, it requests that only then the other techniques be used. Whilst this is a helpful development, the applicant remains unable (for a Community registered design) to state whether its broken lines indicate a feature or a disclaimed part of its design. It therefore does not definitively resolve the above
ambiguity. In any event, CP6 remains guidance only. It does not provide a common, binding, harmonised approach.

However, the UK Supreme Court has suggested that, whilst not binding, EUIPO (and presumably by implication, UKIPO) guidance is persuasive when interpreting the representations. In *PMS International Group Plc v Magmatic Limited* [2016] UKSC 12, the Supreme Court considered that it is not for the court or for law to advise an applicant how to make clear what is included and excluded in a registered design: it is a matter of practice and guidance. The images – which the applicant is afforded a wide freedom in selecting – should be interpreted by reference to how it would appear to the reader in the light of the terms of the Principal Regulation, the Implementation Regulation and the EUIPO’s guidance manual.

A further, related, point to make as to the visual indications available to applicants is that, for both UK registered designs and Community registered designs, the applicant can submit up to seven representations to depict its design. When registering a Partial Design, the applicant may choose only to submit representations of the views in which the Partial Design is visible. There is no rule requiring the applicant to show views of solely the Unclaimed Part.

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

**Yes**

**Please Explain**

For both UK registered designs and Community registered designs, an application must state what the Product is, of which the Partial Design forms part. For example, a saucepan, chair or knife. This is known as the "product indication" or the "indication of product".

The EUIPO’s guidance for the examination of Community registered designs provides specific guidance for the product identification of Partial Designs. Where a design represents the appearance of one part of a product, for example an application for the design of a knife handle, it should not simply provide "knives" as the indication. If the applicant did so, the examiner is to replace that product indication by the indication "Product(s) X (Part of-)" (providing both the part in question and the product as a whole belong to the same class of the Locarno Classification). It also provides that it is not possible to register a design which represents the appearance of a product as a whole, for example a knife, and provide the product indication of a "knife handle". The examiner will raise an objection and suggest that either the applicant disclaim the part not indicated, in this example the blade (presumably using the techniques provided above in our response to question 2(a)) or amend the product indication to the product term for the whole product, which for our example is "knives". It is therefore not possible to disclaim a part by way of product indication.

The Community Design Regulation provides that the product indication is "not to affect the scope of protection of the design as such". The meaning of "as such" is unclear and case law presents differing opinions. The EUIPO Board of Appeal in *Casio’s Appn* [2007] R-1421/2006-3 considered that a broader or narrower formulation of the product might affect the design’s scope of protection and the extent of the registrant’s exclusive rights. Further, that it may have implications for the determination of prior art and the identification of the ‘informed user’. However, a UK judge in the Court of Appeal decision *Green Lane v PMS* [2008] EWCA Civ 358 disagreed with this, stating that the legislation makes it clear that it should not affect the design’s scope of protection. As to validity, the judge was less certain: he accepted that there might be implications for the determination of prior art.

In addition to the product indication, it is also possible to provide a written description.

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 is possible for UK registered designs. Alongside the product indication, an applicant also has the option to enter a short description or note to help explain the design.

For Community registered designs, an application can also contain a 100 word description to assist the EUIPO in checking only the formalities of registrability. This is not reproduced on the registered design certificate, nor is it ‘searchable’ on the EUIPO database.

**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.*
For UK registered designs, in addition to the description discussed at 2(b) above, it is also possible to verbally disclaim (or limit) the design. The applicant can include a disclaimer or limitation to indicate what features are (or are not) claimed as comprising the design. Examples of such a disclaimer include: “No claim is made to the pattern shown on the surface of the teapot”.

In the case of Community registered designs no explanatory text, wording or symbols other that the indication “top” can be displayed in the views of the registration. The 100 word description referred to in b) above will have no effect on the scope of protection and cannot be used to indicate a disclaimer of any Unclaimed Part. Disclaimers therefore must only be apparent from the representation of the design itself.

CP6 expressly does not provide any guidance on verbal disclaimers.

Yes

Please Explain

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

Yes. If validly registered, a monopoly is granted across all sectors and products and there is no required link or nexus between X and Y as such.

Whilst an indication of the product in which the design is intended to be incorporated must be included in the application, the Regulation specifically states that this “shall not affect the scope of protection of the design as such”. The scope being defined as: “any design which does not produce on the informed user a different overall impression” (our emphasis). An infringement arises when the registered design is incorporated into a product, there being no restriction as to the infringing product’s sector or class.

The UK Court of Appeal in Green Lane v PMS [2008] EWCA Civ 358 consequently decided that registered designs protect against any use of the Design or Partial Design for a product, whatever its intended purpose. The CJEU came to the same decision in Easy Sanitary Solutions (C-361/15 and C-405/15), thereby harmonising the position across the Community. However, the nature and nexus of the differing products X and Y is still taken into account and may affect the overall impression on the informed user for the purposes of determining infringement.

The informed user is a fictitious legal character who, among various characteristics defined in the case law, is deemed to be a knowledgeable user of the design product who is aware of the existing design corpus and alert to design issues. The difference in the nature of the products and the way they might be used may be more significant than if they were from the same sector and might therefore affect the overall impression on the informed user. An example is provided in our response to question 4 immediately below.

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

In Green Lane v PMS (referenced above in our response to question 3), the UK Court of Appeal unanimously decided that for the purposes of novelty, the sector of the prior art is irrelevant. The CJEU came to the same decision in Easy Sanitary Solutions (referenced above in our response to question 3), thereby harmonising the position across the Community.

This is a logical result given that the registrant of a Design or Partial Design is granted a monopoly across all products (see our response to question 3 above). If it were otherwise, the earlier Product Y would become an unlawful infringement upon the registration of Product X. Registrants could then circumvent the novelty requirements by simply registering the design for a product class other than that of Product Y. Further, the registrant could indefinitely extend its term of protection by re-registering the design for an alternative product upon its expiry.
Prior art may be excluded if it would not reasonably have become known in the normal course of business to the circles specialised in the sector concerned: the sector being that of the prior art, i.e. Product Y. This eliminates obscure disclosures from consideration.

For the purposes of novelty, there is therefore no required link or nexus between X and Y. To invalidate Product X, the design of Product Y must simply be identical, with any differing design features doing so only in immaterial details.

However, for UK registered and Community registered designs to be valid, the design must be novel and have ‘individual character’. The overall impression produced on the informed user of a design must differ from that of any earlier design.

The informed user is that of the registered design, not that of the prior art i.e. Product X and not Product Y. However, prior art, such as that of Product Y, may form part of the design corpus which is known to the informed user when making the comparison.

While there is again no required link or nexus, that the design is being used on different products, X and Y, may affect the overall impression on the informed user. This was the case in Gimex v The Chill Bag Co ([2012] EWPCC 31), where the design was for a ‘bottle chill bag’, and the prior art for a ‘bottle bag’: the visual differences were much more significant than if they had both been for bottle bags (and therefore were less likely to produce the same overall impression). Further, as recently confirmed by the CJEU in Easy Sanitary Solutions, and in the UK decision of L’Oreal v RN Ventures Ltd [2018] EWHC 173 (Pat), any prior art may form part of the design corpus of which the informed user is aware.

Yes, elements shown in a design registration and surrounding subject matter can be taken into account when considering the application of Design Constraints. However, different views have been expressed on the weight which should be given to additional subject matter in assessing Design Constraints and the scope of a design more generally, and their relevance is assessed on a case by case basis. See our responses to questions 2(a) and 8 and the cases referred to in those responses generally.

Recital 14 of the Community Design Regulation refers to two factors which are taken into consideration when interpreting a design: (i) the nature of the product to which the design is applied or in which it is incorporated; and (ii) the particular industrial sector to which the design belongs. Whilst these factors are not set out in the substantive provisions of the Regulation, the case law confirms that they are relevant to the assessment of both the overall impression and Design Constraints, as they are part of the knowledge and experience of the informed user.

The role of these factors was acknowledged in Gimex v The Chill Bag Co (referenced above in our response to question 4), where the court held that: “in assessing overall impression the question of the intended purpose or function of the product in question is a relevant factor, after all Recital 14 says as much…”

The EUIPO Guidelines also explicitly refer to the issue of additional subject matter and Unclaimed Parts of Community registered designs, noting firstly that a design must be presented with a “neutral background” (i.e. without any unnecessary colouring, shading or subject matter that would interfere with proper interpretation of the design). The Guidelines then go on to state that additional subject matter can be included where it serves an “illustrative purpose”. An example is given where a human hand is shown in one representation of a design “to illustrate how the product in which the design is incorporated will be used, or the context in which it will be used” (see RCD 00210166-0003 for the images used by way of illustration). A good example which is similar to the subject matter of this question is a registered community design for a pan handle (RCD 002322644-0001) in the name of Actervis, GmBH.

CP6 (referenced above in our response to question 2(a)), also acknowledges the use of “visual disclaimers” which include additional subject matter that is outside the scope of the design but is relevant to its interpretation. The Guidelines go on to state that it is recommended that visual disclaimers be used in those cases where the graphic or photographic representation of the design contains parts of the product for which no protection is sought”.

It follows then that additional subject matter, which has been purposely selected by an applicant and included in a design filing, must have some relevance to the assessment of the context in which that design exists, including Design Constraints. It is clear that the additional subject matter will not be included as a feature of the protected design, however the informed user will consider the additional subject matter as part of his or her assessment of the nature, purpose and function of the Product, and consequently the Design Constraints and other exceptions that may apply to the legal assessment of the Partial Design.
In *Imperial International Limited v Handl Cookware Limited* [2007] R-1456/2006-3, the Community registered design at issue showed both a Partial Design (the handle) and an Unclaimed Part (the saucepan). The EUIPO Invalidity Division considered that given the saucepan had been disclaimed, it could not be considered when comparing the design for the handle to prior art. For example, features such as the "higher position" of the handle and the "balance with the saucepan" should not be considered. The proprietor argued on appeal that the saucepan should not be ignored because "the relationship between a handle and a pan body plays a material role in the design". In addition, the informed user would consider the positioning of the handle on the pan which would become an important consideration. Unfortunately the appeal was dismissed on procedural grounds so a definitive decision on the question was not provided.

The issue was specifically addressed and decided upon in the well-publicised case of *Samsung v Apple* (referenced above in our response to question 2(a)). The majority of this case turned on whether the asserted Apple design registrations disclosed certain unclaimed features such as a border and surface beneath a transparent surface. These features were relevant to the assessment of the design corpus, technical function and overall scope of protection. On validity, Samsung relied extensively on prior art which included registrations for larger monitors and devices which served different purposes and functions to those of a tablet computer. Justice Birrs noted explicitly that: "design constraints applicable to a computer monitor may or may not be the same as those applicable to a tablet computer". His Honour called out one prior design in his judgment, shown below, which was for a Bloomberg electronic display unit:

![Bloomberg Electronic Display Unit](image)

The conclusion reached was that "the unit is drawn in dotted lines and I am sure that in this context it is intended to indicate that as a matter of design right, that aspect of the design is not claimed. However as an item in the design corpus I reject the idea that this means one can regard Bloomberg 1 as a disclosure of a different design with a pure flat blank back wall. It is not. The article shown has a rear mounted rectangular unit. Whatever legal rights may or may not be claimed, in my judgment what is disclosed by Bloomberg 1 is a device with a rear broadly rectangular unit. Even if the informed user is taken to pay attention to the legal significance of the dotted lines, the most that can be said is that they are an indication of design freedom in this area. So any other shape could be placed there. That does not mean the document discloses an article with a completely flat back." This strongly suggests, therefore, that the Unclaimed Part (or unclaimed features) will be taken into account when considering Design Constraints, albeit to an unknown extent which is seemingly determined by the courts on a case by case basis.

### 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**

1. A standardised set of expressions contained in the registration form by way of a tick-box system could be generated. The applicant could select those applicable to its design to help reduce uncertainty over its interpretation. We propose that simple, straightforward expressions be used, for example:
   1. "Shape only."
   2. "2D design only."
   3. "Logo/2D ornamentation only."
4. “Unbroken lines used to indicate a feature of the design.”

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. The harmonisation of the rules and guidelines regarding visual disclaimers, such as the use of dashed lines.

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

No

Please Explain

The tools available for specifying, describing or depicting Partial Designs are inadequate.

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

Yes

Please Explain

Designers and legal practitioners ought to understand what is being protected from looking at the representations of the UK registered design or the Community registered design. However, designs do not (and should not) exist in a vacuum: for example, whilst the legislation is clear that the indication of the product should not affect the scope of protection, it indirectly does so. As above, an important part of the debate when considering two designs is identifying the correct definition of the product and the connected argument about design corpus (as in the case of Gimex, referenced above in our response to question 4). This may affect the overall impression of the Design or Partial Design. Of course, this carries much less weight than the representations of the design which remain of central importance.

In the same way, we consider that the Unclaimed Part ought to influence the protection of the parts of the design that are claimed.

By not showing the Unclaimed Part in the representations the scope of protection is necessarily broader, for example a handle as compared to a saucepan handle. Whilst it is the Partial Design that ought to be compared to the infringing design (by way of a ‘like-for-like’ comparison), a handle might have a broader design corpus making visual differences, say between the handle of a sieve, less significant and consequently more likely to produce a similar overall impression and therefore infringe. However, the Partial Design’s individual character might be more open to attack.

Conversely, showing the whole saucepan in the representations makes it more likely that the product is identified as a “saucepan handle”. This affects the design corpus making visual features more significant and less likely to infringe, albeit perhaps easier to prove individual character. Furthermore, the Unclaimed Part might help determine relative size, proportions or shape.

It is for the registration holder to choose the level of generality at which its design is to be considered ( Proctor & Gamble v Reckitt Benckiser [2007] FSR 13). It must perform a balancing exercise between identifying the nature and extent of the monopoly which it is claiming and trying to protect its design’s validity. Therefore, its decisions as to including or excluding the Unclaimed Part on its application, ought to affect the scope of protection claimed. However, the impact of the Unclaimed Part ought to be given less weight than that of the Partial Design.
<table>
<thead>
<tr>
<th>Question</th>
<th>YES</th>
<th>Please Explain</th>
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<tbody>
<tr>
<td>Should Design Constraints restrict the subsistence and scope of protection of Partial Designs? Please explain why or why not.</td>
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<tr>
<td>Yes</td>
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<tr>
<td>Generally, design rights are intended to protect the appearance of a product. If Design Constraints did not affect the subsistence and scope of protection of a Design, a monopoly would be granted for a function or a method: this would hamper technological innovation. This ought instead to be subject to the laws of patents. If the rules were different for Partial Designs, it would enable an applicant to register the part which might be excluded due to Design Constraints and to circumvent these restrictions.</td>
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<tr>
<td>This is the case in UK registered designs and Community registered designs: Design Constraints currently restrict the subsistence and scope of Designs (and, the applicable law being the same, Partial Designs). The legislation provides that UK registered and Community registered design rights will not subsist in features which are solely dictated by its technical function and must-fit features (i.e. Design Constraints).</td>
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<tr>
<td>In practice, however, Design Constraints do not (and we consider this to be the correct approach, as explained below) affect the validity of a design.</td>
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<td>Recital 14 to the Directive states:</td>
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<td>“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.”</td>
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<td>Recital 10 to the Regulation makes an almost identical statement in relation to Community designs.</td>
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<td>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.</td>
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<td>This is practical: to achieve the speed, ease and low cost of design applications, it is appropriate that the designer register its Design or Partial Design as including those features in which design right might not subsist. Further, given the uncertainties as to 1) how to appropriately and clearly depict disclaiming those features, and 2) the appropriate legal approach to determine whether design right ought to subsist in those features, a designer ought to be able to validly register their design as including the features that may be restricted by Design Constraints.</td>
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<tr>
<td>However, this leaves the question as to how to deal with the features restricted by Design Constraints.</td>
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<td>The England &amp; 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] EWPCC 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. 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.</td>
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<td>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:</td>
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<td>the design as shown and any Unclaimed Part; and/or</td>
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The design as shown ought to identify the design for which protection is being sought.

The Unclaimed Part ought to be taken into consideration: see our response to question 8.

0.1 whether the Product is normally sold separately?

No

Please Explain

Provided that the Partial Design is identifiable, and meets the requirements for registration (e.g. novelty), whether it is or is not sold separately ought to be irrelevant.

This is beneficial for the following reasons:

1. It allows a designer to protect significant alterations or adaptations to a prior design by registering only those altered parts. This is particularly helpful where the altered part only forms a small part of the whole product, and that change alone is insufficient to attract a new, independent design right for the product as a whole. The Partial Design for the adapted part must still fulfill the requirements for registrability.

2. If it were otherwise, a designer would be denied adequate protection for the effort expended in creating his/her design, particularly in industries where Partial Designs are applied to range of products. For example, take a distinctive heel to a shoe. Being that heels are not sold separately, it would have to be registered along with the shoe as a ‘whole’ design even where the designer made no contribution to the shoe (e.g. a standard boot). A competitor could then take the distinctive heel and apply it to its own, different, shoe type (e.g. sandal) without necessarily infringing.

3. It avoids the inherent difficulties in construing what is meant by “normally sold separately”. Under the old UK design legislation, a Partial Design would not be registrable unless that part was “made and sold separately” (i.e. whether the product was sold separately was taken into account when assessing a Partial Design). This was problematic, as contemporaneous case law showed. Taken literally, if a part was made and sold separately it might invalidate the design for novelty. Therefore, did it either mean that it be intended that the parts be manufactured and sold separately, or must it be susceptible to being sold separately? Neither are adequate. The latter was rejected in *Sifam Electrical Instruments v Sangamo Weston* [1971] FSR 337, for being meaningless: all parts of a product are susceptible to being sold separately, even if they have to be forcibly removed from the whole. It was decided that it is the intention that mattered and that Partial Design must have a separate economic existence, being a distinct manufacture and sale from that of the whole of the article. However, at what point must that intention arise? Further, given that there need be no intention to sell a whole product when applying for a registered design right, why ought to be different in the case of Partial Designs?

We therefore consider that when assessing a Partial Design, whether or not the product is sold separately should not be taken into account.

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?

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
Is harmonisation of the law of Partial Designs desirable?

Yes

Please Explain

It is desirable to have a uniform approach to reduce uncertainty for both designers and legal practitioners.

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.

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

A suitable framework might include, in terms of graphical representation:

1. Colour shading and blurring to obscure features for which protection is not sought.

2. Broken or dashed lines of a specific sort to delineate between parts of a design for which protection is sought and those which are not.

3. Boundaries to clearly outline an area for which protection is sought.

4. Words – the use of verbal disclaimers ought to be allowed as is the case with UK registered designs. That way, it provides the opportunity (whether or not the applicant avails itself of it) to clarify the design. It should also be able to confirm whether the dashed lines are a feature of the design itself, or are being used in the context of the guidelines for depicting the extent of the Partial Design.

5. Tick boxes providing the applicant with an opportunity to select predetermined short phrases to reduce uncertainty over its interpretation, for example: “shape only”; “broken lines to indicate feature of a design”; “broken lines to indicate disclaimed part”. See our response to question 6 above.

6. Images chosen for representations – if claiming a Partial Design, the applicant should not have to show every side/feature of the Product as a whole within the views used for registration of a Partial Design. For example, the applicant should not have to include views which only show the Unclaimed Part. The applicant should be given a wide freedom to select only the images that best portray the individual character of the design for the design registration. Any potential uncertainty over the use of broken lines, etc. could be reduced by careful view selection to ensure the disclaimed features are not visible in the representations used.

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.

SC is the same as UP
Yes.

If the product is the same, the differences will be less significant and should lead to an increased likelihood of the design being found to infringe. This is appropriate given that both the SC and the UP will be subject to similar design challenges and requirements.

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

Yes.

If the products are used in the same way, it is still likely that the SC and UP will be subject to similar design challenges and requirements.

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

Yes.

Where a valid Partial Design provides a monopoly across all products, it should not matter whether the SC and UP are or are not the same. If they look the same, the accused product may not produce a different overall impression than that of the design.

However, it could potentially be desirable to allow an applicant to limit the scope of protection of its design (e.g. by including a product indication for this specific purpose in the application form). This would have implications for the registration requirements, e.g. novelty and individual character. In that instance, it would be relevant that the SC is not the same as the UP.

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

Not necessarily.

If the products are used in the same way, it is likely that the SC and UP will be subject to similar design challenges and requirements. If so, then this might be relevant.

However, the key question is whether the design and the accused product form the same overall impression. To some extent, whether or not they are categorised in the same way when registering designs, may or may not be relevant.

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

Yes.

If the applicant has chosen to show the Unclaimed Part in its application, it ought to be taken into account when comparing the design and an accused product, albeit it ought not to weigh in considerably on the issue.

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.
The definition of these study questions for “Unclaimed Part” requires that that it be indicated as such on the design registration. This question therefore necessarily excludes any consideration of where the graphical representation consists solely of the Partial Design.

An Unclaimed Part ought to be taken into account when analysing the overall impression to the extent that it helps inform the design corpus of the Partial Design and the design freedom in arriving at the Partial Design. This will determine the perspective and background of the informed user when making the comparison (whether for the purposes of individual character or infringement).

It might also inform the user of the relative size and proportions of the Partial Design to be compared against that of the prior art or accused design.

However, for both individual character and infringement, it ought to still be a like-for-like comparison of the Partial Design as against the prior art or accused design. Therefore, the differences between the Unclaimed Part and the Surrounding Context (in either the prior art or an accused product) ought not to form a part of the direct comparison once the informed user, design corpus or design freedom has been determined.

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.

In relation to the first sentence of this question see our responses to questions 8 and 14 above. The rules for Partial Designs ought not to differ from that of designs for a whole of a product. There should not be special rules for Partial Designs. In response to the second sentence of this question, see our responses to questions 5 and 9 above.

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

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

Yes, protection is available for Partial Designs in the US. Section 171 of the Patent Act provides that “Whoever invents any new, original and ornamental design for an article of manufacture may obtain a [design] patent therefor . . . .” 35 U.S.C. § 171. Thus, the statute grants protection “not to the design of an article, but to the design for an article . . . .” In re Zahn, 617 F.2d 261, 268 (C.C.P.A. 1980) (emphasis added) (seminal U.S. case on partial designs whereby the court permitted applicant’s design patent claiming just the shank of a drill bit, rather than requiring the claim to be directed at an entire drill bit.) A Partial Design is a design “for an article of manufacture” and thus qualifies as eligible subject matter for design patent protection. The laws for protecting Partial Designs are not different than those for “complete” designs.

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

See responses to Qs 2a, 2b and 2c below.
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?

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?

2. b

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

No

Please Explain

Other than identifying, in the title and the claim, the article of manufacture to which the design is applied to, there is no requirement that an Applicant provide a written description of the Product

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

In theory, yes, verbal disclaimers may be used, provided that what is claimed in the Partial Design satisfies the requirements of Section 112, including that the invention must be described in such full, clear, concise, and exact terms to enable one skilled in the art to make and use the same. See 35 U.S.C. § 112(a). However, in practice, it is rare that the requirements of Section 112 are successfully met by a verbal disclaimer only (i.e., in practice, the disclaimer often needs to be both visual and verbal).

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

In general, if the overall visual appearance of the claimed Partial Design used in accused Product Y is substantially the same as the claimed overall visual appearance of the Partial Design shown albeit on (unclaimed) Product X, the Partial Design used in Product Y will still infringe, regardless of whether the Products X and Y are the same or different.

See Contessa Food Prods., Inc. v. Conagra, Inc., 282 F.3d 1370, 137762 USPQ2d 1065, 1067 (Fed. Cir. 2002):

Determining whether a design patent is infringed requires (1) construction of the patent claim, and (2) comparison of the construed claim to the accused product. Elmer & HTH v. ICC Fabricating, Inc., 67 F.3d 1571, 1577, 36 USPQ2d 1417, 1420 (Fed. Cir. 1995). In construing a design patent claim, the scope of the claimed design encompasses "its visual appearance as a whole," and in particular "the visual impression it creates." See Durling v. Spectrum Furniture Co., 101 F.3d 100, 104-05, 40 USPQ2d 1788, 1791 (Fed. Cir. 1996).

See also MPEP § 1504.I.C quoting from Contessa:

The scope of a design claim is defined by what is shown in full lines in the application drawings. Contessa, Food Prods., Inc. v. Conagra, Inc., 282 F.3d at 1370, 1378, 62 USPQ2d 1065, 1069 (Fed. Cir. 2002) ("If features appearing in the figures are not desired to be claimed, the patentee is permitted to show the features in broken lines to exclude those features from the claimed design, and the failure to do so signals inclusion of the features in the claimed design." (citing Door-Master Corp. v. Yorktowne, Inc., 256 F.3d 1308, 1313, 59 USPQ2d 1472, 1475 (Fed. Cir. 2001))).
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

If the overall visual appearance of the Partial Design in prior Product Y is substantially the same as the overall visual appearance of the Partial Design forming part of Product X, the Partial Design in Product X is likely to be found not novel, regardless of whether the products are the same or different.

See MPEP 1504.02 (Novelty):

Anticipation does not require that the claimed design and the prior art be from analogous arts. In re Glavas, 230 F.2d 447, 450, 109 USPQ 50, 52 (C.C.P.A. 1956). “It is true that the use to which an article is to be put has no bearing on its patentability as a design and that if the prior art discloses any article of substantially the same appearance as that of an applicant, it is immaterial what the use of such article is. Accordingly, so far as anticipation by a single prior art disclosure is concerned, there can be no question as to nonanalogous art in design cases.” Id. (internal quotation marks omitted).

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.

The “Unclaimed Part” shown in the drawings does not affect the Design Constraints.

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

No

Please Explain

No. At this time, we have no recommendations for proposed changes to law or practice related to the protection of Partial Designs in the United States.

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

Yes

Please Explain

Yes, the ways that are commonly used to describe and depict Partial Designs in the United States are satisfactory for that purpose.

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
No, unclaimed Parts shown in design drawings should have no *per se* effect in determining claim scope but should be considered in conjunction with the full specification of the application.

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

**Yes**

**Please Explain**

If the overall appearance of a Partial Design is solely dictated by functional considerations, it is ineligible for design patent protection in the U.S.

It is also worth noting that the U.S. has no “must fit” doctrine that excepts from design patent eligibility those Partial Designs that must be shaped a certain way to fit some mechanical connection, and also has no “must match” doctrine that excepts from design patent eligibility those Partial Designs that must match the appearance of other parts of a product of which the Partial Design forms a part.

Under U.S. law, every visual portion of a claimed design should be given weight when considering the claimed design’s overall scope of protection, even if some visual portions of said design have an appearance that is solely dictated by function, since there is often design freedom with respect to the relative aspect ratio and positioning of purely functional visual design elements vis-à-vis those visual design elements that are not solely dictated by function. Consistent with paragraph 7 of the Milan Resolution, it may be reasonable to minimize the weight given to such visual elements in claim construction, however it is never appropriate to “factor out” these visual elements completely. *(See Sport Dimension, Inc. v. Coleman Co., Inc., 820 F.23d 1316 (Fed. Cir. 2016).*

### 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:

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

**Yes**

**Please Explain**

As defined in this document, a Partial Design exists when an Unclaimed Part is present.

**10.b** whether the Product is normally sold separately?

**No**

**Please Explain**

No.

### 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**
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

Yes. Note: in the US, design rights are patented and not registered.

13 Is harmonisation of the law of Partial Designs desirable?
Yes

Please Explain

Yes. Partial design protection should be supported and harmonized for the reasons described herein.

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.

See the above answer to Part I. Current law and practice, Question 2), subpart a) including requiring a visual indication to denote disclaimed subject matter not included in the claim of the partial design, as well as a verbal explanation of the visual indication employed to denote disclaimed subject matter is required. Broken lines in lines drawings and shading in photographs should be used to show unclaimed subject matter, and a statement should be used as follows: “The structural features depicted by broken lines in the drawings have been shown for the purpose of illustrating portions of the [title] that form no part of the claimed design” or “The claimed design is indicated by the relatively dark portions in the figures. The relatively light portions form no part of the claimed design”, respectively.
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.

### SC is the same as UP

Generally speaking, the differences between the SC and UP should not be relevant when considering the overall impression of the accused product and the Partial Design.

See Part I, Question 3) In general, if the overall visual appearance of the claimed Partial Design used in accused Product Y is substantially the same as the claimed overall visual appearance of the Partial Design, the Partial Design used in Product Y will still infringe, regardless of whether the Products X and Y are the same or different.

As noted above, it should not matter whether the SC is the same as the UP. The analysis focuses on whether the overall appearance of the Partial Design is substantially the same as overall appearance of the accused product.

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

As noted above, it should not matter whether the SC is the same as the UP. The focus is on the overall appearance of the Partial Design and accused product, rather than their use.

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

As noted above, it should not matter whether the SC is the same as the UP. The focus is on the overall appearance of the Partial Design and accused product, rather than their use.

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

As noted above, it should not matter whether the SC relates to the same products as the UP when registering designs. The focus is on the overall appearance of the Partial Design and accused product, rather than their design classification.

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

As noted above, it should not matter whether the SC is the same as the UP. The focus is on the overall appearance of the Partial Design and accused product, rather than their use.
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 noted in the answer to Question 15, the analysis focuses on whether the overall appearance of the Partial Design is substantially the same as the overall appearance of the accused product.

Unclaimed Parts should be “taken into account” only to the extent that they are clearly understood as forming no part of the claim, and thus may be taken into account in constructing the claim by helping to clearly define what the claim does include.

MPEP Sec. 1503.02(3) states in part that “The two most common uses of broken lines are to disclose the environment related to the claimed design and to define the bounds of the claim. Structure that is not part of the claimed design, but is considered necessary to show the environment in which the design is associated, may be represented in the drawing by broken lines. This includes any portion of an article in which the design is embodied or applied to that is not considered part of the claimed design. In re Zahn, 617 F.2d 261, 204 USPQ 988 (C.C.P.A. 1980).”

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.

We propose that Design Constraints arising from the Unclaimed Part should not affect the Partial Design, consistent with the absence of must fit/must match doctrines in the U.S.

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

An overall design issue that can apply to partial designs is that presently, the law in the United States is unsettled with respect to design patent damages, in particular how to define an article of manufacture and whether an infringer’s total profits for sale of an entire product may be recovered under Title 35, U.S. Code, Section 289, if a design patent covering only a portion of the entire product as sold is infringed. Cf. Samsung Elecs. Co. v. Apple Inc., 137 S. Ct. 429 (2016). This issue is being monitored closely by AIPPI/AIPLA.

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

AIPLA, which includes as a Division AIPPI-US, is a national bar association with approximately 13,500 members who are primarily lawyers in private and corporate practice, government service, and the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law. Our members represent both owners and users of intellectual property.
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

The Venezuelan Industrial Property Law allows the partial patentability of Industrial Models and Drawings (Industrial Designs). There is no special Law for the Partial Protection of Industrial Models and Drawings (Industrial Designs).

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

Partial Designs are specified, described and/or graphically depicted using the same methodology as any Industrial Model or design; there are no special requirements.

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
The claimed parts of the Model or Industrial Drawing (Industrial Designs), is described by figures characterized by including continuous lines. The non-claimed parts of the design are highlighted using dashed lines.

<table>
<thead>
<tr>
<th>2.a</th>
<th>Is there a written description of the Product, of which the Partial Design forms part?</th>
</tr>
</thead>
<tbody>
<tr>
<td>Yes</td>
<td>Please Explain</td>
</tr>
<tr>
<td></td>
<td>As indicated in the previous response to the product description, a selection of the claimed parts was made according to the type of lines used.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>2.b</th>
<th>Can verbal disclaimers be used?*</th>
</tr>
</thead>
<tbody>
<tr>
<td>Yes</td>
<td>Please Explain</td>
</tr>
<tr>
<td></td>
<td>Yes; complete writing description of the design, containing full details for which part of the design the protection is sought and which part is unclaimed.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>3</th>
<th>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.</th>
</tr>
</thead>
<tbody>
<tr>
<td>Yes</td>
<td>Please Explain</td>
</tr>
<tr>
<td></td>
<td>If the Partial Part of product X is protected, then use in a product Y is considered an infringement, unless the owner of the Product Y is the owner of the partial design patent X.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>4</th>
<th>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.</th>
</tr>
</thead>
<tbody>
<tr>
<td>Yes</td>
<td>Please Explain</td>
</tr>
<tr>
<td></td>
<td>Yes, as long as the Partial Design in the product Y has been disclosed.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>5</th>
<th>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.</th>
</tr>
</thead>
<tbody>
<tr>
<td>N/A</td>
<td></td>
</tr>
</tbody>
</table>

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

It would be advisable to include provisions for Partial designs.

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

Yes

Please Explain

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

No, because the description of the design should clearly indicate, in the representation of the design, the difference between the claimed part and the non-claimed part.


Yes

Please Explain

Yes, to clearly define the scope of the protection granted to the partial part of the design, allowing the applicant to differentiate the protection of the partial part from the total protection of the design.

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:

Yes

Please Explain

In order to have a better understanding of the design.

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

Yes

10.b. whether the Product is normally sold separately?

Yes
### III. Proposals for harmonisation

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

<table>
<thead>
<tr>
<th>11</th>
<th>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?</th>
</tr>
</thead>
<tbody>
<tr>
<td>No</td>
<td></td>
</tr>
</tbody>
</table>

Please Explain

### III. Proposals for harmonisation

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

<table>
<thead>
<tr>
<th>12</th>
<th>Should a Partial Design be registrable as an independent design?</th>
</tr>
</thead>
<tbody>
<tr>
<td>Yes</td>
<td></td>
</tr>
</tbody>
</table>

Please Explain

<table>
<thead>
<tr>
<th>13</th>
<th>Is harmonisation of the law of Partial Designs desirable?</th>
</tr>
</thead>
<tbody>
<tr>
<td>Yes</td>
<td></td>
</tr>
</tbody>
</table>

Please Explain

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.

<table>
<thead>
<tr>
<th>14</th>
<th>Please propose a suitable framework for specifying, describing and/or graphically depicting (a) the Partial Design and (b) the Unclaimed Part.</th>
</tr>
</thead>
<tbody>
<tr>
<td>As describe in 2.a</td>
<td></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>15</th>
<th>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:</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>· Unclaimed Part (UP) of the Partial Design is the pan without the handle;</td>
</tr>
<tr>
<td></td>
<td>· Surrounding Context (SC) is the part of the accused product without the protected Partial Design, i.e. the sieve without the handle,</td>
</tr>
<tr>
<td></td>
<td>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.</td>
</tr>
</tbody>
</table>
5. SC is the same as UP

The differences between the SC and UP should not be relevant when considering the overall impression of the accused product and the Partial Design.

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

The differences between the SC and UP should not be relevant when considering the overall impression of the accused product and the Partial Design.

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

The differences between the SC and UP should not be relevant when considering the overall impression of the accused product and the Partial Design.

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

The differences between the SC and UP should not be relevant when considering the overall impression of the accused product and the Partial Design.

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

The differences between the SC and UP should not be relevant when considering the overall impression of the accused product and the Partial Design.

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.

Protection of the partial design does not fall on Unclaimed Part. No influence on the overall impression should be taken into account.

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.

Design Constraints arising from the Unclaimed Part 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.
No additional comments to add.

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

All sectors and industries.
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.

No

Please Explain

According to the Vietnam IP law and regulations, to be registered as an industrial design (ID), the ID must be an appearance of a whole product. “A whole product” here is interpreted by the laws as a final product for end-user or a component of a final product which is capable of circulation in trade channel independently (sold separately).

Therefore, in principle, partial design is not registrable in Vietnam. However, kindly note that, a design for a component which can be sold separately will still be considered/classified as a design for a whole product and accordingly, be registrable in Vietnam (i.e. wing mirrors, car wheels, …).

Claiming priority rights for a design application in Vietnam based on a partial design application in Japan or other countries is acceptable provided that the design sought for protection in Vietnam design application is a whole design.

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

In principle, because partial design is not registrable in Vietnam, all designs to be filed in Vietnam must be presented in solid lines (the broken-
line/dotted line drawings are not acceptable by the NOIP). 

For a design for a component (which is sold separately), besides the figures showing the requirement views (front, rear, top, bottom, right, left and perspective views) which must be presented in solid lines, the applicant may submit reference views to clarify the position of this design/component in the Product of which it is a part of. In this case, dotted lines or dashed lines may be used for the Unclaimed Part.

<table>
<thead>
<tr>
<th>Question</th>
<th>Answer</th>
<th>Explanation</th>
</tr>
</thead>
<tbody>
<tr>
<td>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?</td>
<td>No</td>
<td>As said above, because partial design is not registrable in Vietnam, all designs to be filed in Vietnam must be presented in solid lines (the broken-line/dotted line drawings are not acceptable by the NOIP).</td>
</tr>
<tr>
<td>Is there a written description of the Product, of which the Partial Design forms part?</td>
<td>No</td>
<td>It is not necessary to describe of the Product, of which the design for a component (which can be sold separately) forms part.</td>
</tr>
<tr>
<td>Can verbal disclaimers be used?*</td>
<td>No</td>
<td>* 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.</td>
</tr>
<tr>
<td>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.</td>
<td>No</td>
<td>As partial design is not protected in Vietnam, we have no answer to this question.</td>
</tr>
<tr>
<td>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.</td>
<td>Yes</td>
<td></td>
</tr>
</tbody>
</table>

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According to the Article 65, the IP Law of Vietnam, “An industrial design shall be considered new if it significantly differs from other industrial designs that are already publicly disclosed through use or by means of written descriptions or in any other form, inside or outside the country, prior to the filing date or the priority date, as applicable, of the industrial design registration application”.

Therefore, if a design for a component (which can be sold separately) was used/publicly disclosed on a Product Y in advance, this design which forms part of a Product X will still be considered as having no novelty.

Under Vietnamese law, because a design for a component which can be sold separately is considered/classified as a design for a whole product, elements outside the scope of this design and must fit/must match exceptions will not be taken into account.

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.

No

Please Explain

As partial design is not protected in Vietnam, we have no answer to this question.

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

No

Please Explain

As mentioned above, partial design is not registrable in Vietnam and there are no provisions regarding protection for partial designs in the IP regulations of Vietnam.

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

Yes

Please Explain

YES, because the overall impression of one product will be created not only by the Partial Designs but also the Unclaimed Part. In addition, one must refer to the Unclaimed Part to determine the purpose of use and function of the claimed Partial Designs.


Yes

Please Explain
YES, because Partial Design is a Design of a portion or portions of a whole Product, this Partial Design need to be “must fit” and “must match” to other parts of the whole Product to create a complete Product.

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:

09 the design as shown and any Unclaimed Part; and/or

Yes

Please Explain

In our opinion, to assess of whether a design is a Partial Design or not, only the Design as shown and the Unclaimed Part are need to take into account.

Portions which are sold separately or together with the Unclaimed Part/the whole Product should all be considered as Partial Designs.

08 whether the Product is normally sold separately?

Yes

Please Explain

In our opinion, to assess of whether a design is a Partial Design or not, only the Design as shown and the Unclaimed Part are need to take into account.

Portions which are sold separately or together with the Unclaimed Part/the whole Product should all be considered as Partial Designs.

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?

Yes

Please Explain

The IP law should be revised to include subject “partial design” therein.

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
13. Is harmonisation of the law of Partial Designs desirable?

Yes

Please Explain

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.

For (a) the Partial Design, using solid lines.

For (b) the Unclaimed Part, using dotted lines.

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.

15. a. SC is the same as UP

NO.

Because in case SC is the same as UP, the overall impressions of the accused product and the Partial design will be the same.

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

YES.

Because if SC and UP relate to products that categorized in the same way when registering designs, it is necessary to consider the differences between SC and UP when considering the overall impression of the accused product and the Partial Design.

15. c. SC is not the same as UP, but SC and UP relate to products that look the same
Because SC and UP relate to products that look the same, the overall impression of the accused product and the Partial design may be similar.

**YES.**

Because if SC and UP relate to products that categorized in the same way when registering designs, it is necessary to consider the differences between SC and UP when considering the overall impression of the accused product and the Partial Design.

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

**NO.**

In case SC and UP are entirely unconnected, it can be assumed that the Product of which the Partial Design is a part of and the accused product also have no connection. Thus, the overall impression of the accused product and the Partial design will be quite different.

When analyzing the overall impression of a Partial Design for both individual character and infringement, it is necessary to assessment the differences between the Unclaimed Part and Surrounding Context of the accused products if the Unclaimed Part and Surrounding Context of the accused products relate to products that have a close relation on functions or being categorized in the same way when registering designs.

We have no answer to this question.

We have no answer to this question.

Our answers to Part III are stated without referring to any specific industry sector.
Summary Report

by 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

2018 – Study Question – Designs

Partial designs

Introduction

Designs protecting the appearance of a whole product were discussed in AIPPI's Resolution on "Requirements for protection of designs" (Milan, 2016), hereafter referred to as the Milan Resolution. Partial designs, being a portion or portions of a whole product, were excluded from the Milan Resolution. The objective of this Study Question is to address such partial designs.

Reference is made to the Milan Resolution for the regime of protection for designs generally, and terms used in this Summary Report are the same as those in the Milan Resolution. At a minimum, novelty should be a requirement for protection of a registered design. In addition, in some jurisdictions there is a requirement that a design has individual character. 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. The relevant set of prior designs which has been made available to the public, for the purposes of assessing individual character of a specific design, is referred to as the design corpus for that design.

The following additional defined terms are used in this Summary Report:

a) a Product is an object or article of manufacture;

b) a 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;
c) a *Partial Design* is a Design for a portion or portions of a whole Product\(^1\);

d) the *Unclaimed Part* of a Product is the part of a whole Product indicated not to be within the Partial Design;

e) the *Surrounding Context* of an accused product is the part or parts of the accused product that do not correspond to the Partial Design, i.e. they are outside the Partial Design; and

f) *Design Constraints* are constraints on design freedom arising from must fit / must match requirements, or the technical function of the object to which the design is applied. The term terms *functional* and *function* refer to technical functionality, not "aesthetic functionality", which has its origins in trade mark law in certain jurisdictions.

The copying of a part or even a substantial part of a design of a whole article might not infringe a registered design right. For example, in the EU, the test of infringement is whether the overall impression created by the accused product is not different to the overall impression of the design. If the accused product only has one feature (of several) taken from the registered design, the overall impressions may well be different. This makes it difficult to protect a part of a whole product as a Design, without a system of protection for Partial Designs.

There can be commercial value in the protection of parts of a Product (e.g. Partial Designs in wing mirrors, wheels, and other car parts; aesthetic additions to kitchen cabinets; the ornamental ends of an otherwise common bed; the clasp of a watch; the heel of a shoe; the base and stem of a wine glass), and it would clearly be advantageous for Partial Designs to be protected by the same legal rules across many jurisdictions. This would increase legal certainty while lowering costs.

Some of the key issues arising in relation to Partial Designs are:

- should Partial Designs be registrable?

- how should a Partial Design be indicated? For example, should there be a written indication, or graphical indication and if so what common standard would work best?

- what is the scope of a Partial Design? Should a Partial Design forming part of a larger product X, be registrable when the prior art contains the same Partial Design but forming part of a larger product Y?

The Reporter General has received Reports from the following Groups and Independent Members in alphabetical order: Argentina, Australia, Belarus, Belgium,

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\(^1\) i.e. a Partial Design is a Design where less than the whole Produce *depicted* is claimed. Where the claimed design is depicted an described as being an entire Product, that design is not regarded as a Partial Design for the purposes of this Study Question.
Brazil, Bulgaria, Canada, China, Czech Republic, Denmark, Ecuador, Estonia, Finland, France, Germany, Hungary, Italy, Japan, Latvia, Malaysia, Mexico, the Netherlands, New Zealand, Norway, Pakistan, Paraguay, Poland, the Philippines, the Republic of Korea, the Russian Federation, Singapore, Spain, Sweden, Switzerland, Taiwan (Independent Member), Turkey, the United Kingdom (UK), the United States of America (U.S.), Venezuela and Vietnam.

40 Reports were received in total. The Reporter General thanks the Groups and Independent Members for their helpful and informative Reports. All Reports may be accessed here:

http://aippi.org/committee-publications/?committee-id=54307

The Reports provide a comprehensive overview of national and regional laws and policies relating to Partial Designs set out in three parts:

- Part I – Current law and practice
- Part II – Policy considerations and proposals for improvement of the current state of the law
- Part III – Proposals for harmonisation.

This Summary Report does not summarise Part I of the Reports received. Part I of any Report is the definitive source for an accurate description of the current state of the law in the jurisdiction in question.

This Summary Report has been prepared on the basis of a detailed review of all Reports (including Part I) but focuses on Parts II and III, given AIPPI’s objective of proposing improvements to, and promoting the harmonisation of, existing laws. As it is a summary, if any question arises as to the exact position of a particular Group in relation to Parts II or III, please refer to the relevant Report directly.

In this Summary Report:

- references to Reports of or responses by one or more "Groups" may include references to Independent Members;
- where percentages of responses are given, they are to the nearest 5%; and
- in Part IV below, some conclusions have been drawn in order to provide guidance to the Study Committee for this Question.
I. Current law and practice

For the replies to Questions 1) - 5) set out in the Summary Guidelines for this Study Question, reference is made to the full Reports. The Study Guidelines may be accessed here:


II. Policy considerations and proposals for improvement of your 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.

20 Groups responded in the affirmative, with a great deal of variation between the Groups as to their reasons. These Groups were of the opinion that their laws could be improved, at least in some respects or to some extent. These are listed below, noting that some are contradictory.

- by adding rules on how to take the Unclaimed Part into consideration for infringement, the preference being to take it into consideration but give it less weight;
- by adding rules for the Unclaimed Part;
- by adding the possibility to use a verbal disclaimer;
- by removing the possibility to use verbal disclaimers;
- by allowing the possibility to protect Partial Designs;
- by adding improved rules in relation to infringement and validity;
- by better harmonisation internationally as to methods of depicting Partial Designs;
- by allowing unconnected Partial Designs with parts either “floating in space” or connected via a substrate formed from the Unclaimed Part;
- by reducing the impact of Design Constraints on Partial Designs; and
- by allowing non-Partial Designs and Partial Designs to be included in one application.

12 Groups were of the view that their respective laws do not need to be improved.

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

23 Groups (just over 50% of all responding Groups) believe that the way of specifying Partial Designs under their laws are satisfactory. The Australian
Group is of the view that the ability to specify a Partial Design using the product name, statements of newness and distinctiveness, and the use of dotted or dashed lines is sufficient.

15 Groups were of the view that the way of specifying Partial Designs under their laws are not satisfactory. The reasons cited include:

- there are very few or no rules in relation to Partial Designs;
- there is a need to indicate the Unclaimed Part if photographs are used;
- there is a need for further methods of designating Partial Designs, over and above dotted lines;
- the rules on the infringement of Partial Designs are unclear;
- a requirement to specify the product name for Partial Designs creates difficulties with alleging infringement;
- international harmonisation is needed to ensure that methods of designating Partial Designs are consistent across jurisdictions;
- adding verbal disclaimers would be helpful; and
- boundary indications can be problematic;

8) Should the Unclaimed Part influence the protection of the parts of the design that are claimed?

Three Groups consider that the Unclaimed Part should not, in principle, influence the protection of the parts of the design that are claimed. In the view of 15 Groups, since no protection is claimed for the Unclaimed Part, the Unclaimed Part should not influence the protection of the parts of the design that are claimed.

21 Groups (just over 50% of all Groups) consider that the Unclaimed Part should influence the protection of the parts of the design that are claimed at least to some extent. This could be by using the Unclaimed Part to generally understand the claimed design, or more specifically by allowing the Unclaimed Part to be used to allow an appreciation of the design or overall impression of the claimed design. In the view of these Groups, the Unclaimed Part should be given less weight, and should have minimal influence in most cases unless it can be shown to affect the appreciation of the design or the overall impression of the design.

The point is made by the UK Group that designers, legal practitioners and courts ought to understand what is being protected from looking at the representations of the design. Designs do not (and should not) exist in a vacuum: for example, whilst the indication of the product should not affect the scope of protection, it indirectly does so. An important part of the debate is identifying the correct definition of the product and the relevant design corpus. This may affect the overall impression of the design being considered. In the view of the UK Group,
this still carries much less weight than the representations of the design which remain of central importance.

It follows that, by not showing the Unclaimed Part in the representations, the scope of protection is necessarily broader, for example a handle as compared to a saucepan handle. Whilst it is the Partial Design that ought to be compared to the infringing design (by way of a "like-for-like" comparison), a handle might have a broader design corpus making visual differences, say between the handle of a sieve, less significant and consequently more likely to produce a similar overall impression and therefore infringe. However, the Partial Design’s individual character might be more open to attack.

Conversely, showing the whole saucepan in the representations makes it more likely that the product is identified as a “saucepan handle”. This affects the design corpus making visual features more significant and less likely to infringe, albeit perhaps easier to prove individual character. Furthermore, the Unclaimed Part might help determine relative size, proportions or shape.

Fundamentally, the point made by the UK Group is that it is for the registration holder/designer to choose the level of generality at which its design is to be considered. The designer must perform a balancing exercise between identifying the nature and extent of the monopoly which they are claiming and trying to protect the design’s validity. Therefore, its decisions as to including or excluding the Unclaimed Part on its application, ought to affect the resulting scope of protection. Even then, in the view of the UK Group, the impact of the Unclaimed Part ought to be given less weight than that of the Partial Design.

9) Should Design Constraints restrict the subsistence and scope of protection of Partial Designs?

14 Groups (around 30% of all Groups) consider that Design Constraints should not restrict the subsistence and scope of protection of Partial Designs, either because Design Constraints should not in principle limit a design, or because Design Constraints apart from functionality should not limit a design, or because functional designs should be allowed.

27 Groups (around 70% of all Groups) take the view that Design Constraints should restrict the subsistence and scope of protection of Partial Designs. This was either simply because such restrictions should be the same for Partial Designs as for Designs, with some Groups noting in this context that Design Constraints should not cause features to be eliminated altogether but may result in those features being given very little weight.

Since Partial Designs are a part of a larger product, they must necessarily and always integrate into the larger product and they must always “fit” into the larger whole. They may sometimes also “match” the larger whole. If these Design
Constraints should always limit the valid scope of a Partial Design, it is inevitable that some parts of the Partial Design will be nearly always given little weight. This could be an undesirable result if a different way of sub-dividing the design of the larger whole product would give more protection, e.g. if the larger product can be divided into different Partial Designs with relatively small interfaces into the larger whole product. It could be considered unfair for the protection to be narrower simply because the borders between parts of a single design are drawn in different places.

Just over half of Groups stated that Design Constraints should be applied in the same way that they are applied for non-Partial Designs, and this approach logically results in some degree of limitation especially under a “must fit” analysis, if the Partial Design is applied in the same way in which it is linked to the Unclaimed Part. The unsurprising result, in the case of a design of a pan handle attached to a pan would be that the interface between the handle and the pan would appear to be subject to a “must fit” limitation.

However, if the Partial Design for a pan handle is applied to something else, e.g. a handle connected to a blade to form a knife, or a handle connected to an oval net with a wooden outer edge to form a tennis racket, using the same logic different limitations would be relevant, because the handle would fit differently. Of course, these types of limitations would only be discovered when the handle is used and the context in which it is used becomes known, which decreases legal certainty for the right holder in the sense that limitations due to Design Constraints can only be determined later, when the design is said to be infringed.

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:

the design as shown and any Unclaimed Part; and/or

32 Groups (80% of all Groups) agree that the assessment should take the Unclaimed Part into account, and six Groups disagree.

The French Group takes the position that when assessing novelty, only the design as shown should be taken into consideration, but when assessing overall impression/individual character/scope of protection, both the design as shown and the Unclaimed Part should be taken into consideration. This is because, in the view of the French Group, novelty is assessed objectively without taking the informed user into account, whereas the overall impression is a partly subjective construct because it refers to that same user which is determined by the function of the product in which the design is incorporated.
whether the Product is normally sold separately?

15 Groups agree that the question of whether the Product is sold separately should be taken into account, and 24 Groups (just over 50% of all Groups) disagree.

This question goes to the issue of whether a design without any express indication or suggestion that it is a Partial Design, should nonetheless be considered a Partial Design if the design is for an object that is not normally sold separately, with consequential limitations such as those imposed by Design Constraints. The question also touches on issues that are or have been relevant in many legal systems in which design protection has been limited to whole products/articles that are independently sold only, and parts or components not sold independently have not been protected by designs.

In the view of the French Group, whether the object is normally sold separately should be irrelevant. The validity of the design cannot be based on factors which depend on how the design is commercially used, and in particular commercial considerations do not have to be taken into account when assessing the freedom given to the creator.

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?

The Canadian Group states that clarification of possible exemptions from infringement for articles which “must fit” or “must match” would be helpful.

The Swiss Group believes that it is in the interests of the rights owner that design protection is available for Partial Designs in a broad manner, but there should be no design protection available for those features which are dictated solely by their technical function. In the view of the Swiss Group, other exceptions such as a must-fit/must-match exception or a replacement part exception should not be provided.

The Swedish Group explains that clarification is needed as regards to the scope of protection when the Partial Design for a part intended to be incorporated in a Product is used for a different Product.

III. Proposals for harmonisation

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

All but two Groups say that a Partial Design should be registrable as an independent design.
13) **Is harmonisation of the law of Partial Designs desirable?**

All but two Groups say that harmonisation of the law of Partial Designs is desirable.

The New Zealand Group considers that New Zealand copyright law is sufficient for protecting Partial Designs, explaining that the NZ Copyright Act protects the shape of products (based on original drawings) for a period of 16 years – one year longer than the rights given by a registered design in New Zealand. Both the copyright in the shape of the product and the protection afforded by a registered design for the shape of that product exist concurrently. Consequently protection for a Partial Design is afforded by way of copyright in the part drawing as well as the entire article via the assembly drawing of that article.

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

23 Groups stated that this should be flexible and include current practice of stippled or dotted lines for the Unclaimed Part and solid line for the claimed part. However circling or colours showing the Unclaimed Part should also be acceptable, as should boundaries (the features for which protection is sought are clearly indicated/represented within the boundary, whereas all the features outside the boundary are considered to be disclaimed and therefore not protected) and blurring (obscuring the features for which protection is not being sought).

Two Groups stated that the same rules should be used for Partial Designs, as are used for non-Partial Designs.

Three Groups suggested that the Partial Design can be identified in words and by graphical depictions in the drawings.

The UK Group states that if claiming a Partial Design, the applicant should not have to show every side/feature of the Product as a whole within the views used for registration of a Partial Design. For example, the applicant should not have to include views which only show the Unclaimed Part. The applicant should be given a wide freedom to select only the images that best portray the individual character of the design for the design registration, and also clearly delineate the Partial Design.

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.

a. SC is same as UP
b. SC is not the same as UP, but SC and UP relate to products that are used in the same way
c. SC is not the same as UP, but SC and UP relate to products that look the same
d. SC is not the same as UP, but SC and UP relate to products that categorised in the same way when registering designs
e. SC is not the same as UP, and SC and UP are entirely unconnected.

10 Groups say that all of the factors a. – e. are relevant when considering overall impression. Two Groups say that all factors a. – e. are relevant when considering overall impression, but the Unclaimed Part should be considered less important. A further six Groups identify factors a. – d. (but not e.) as relevant when considering overall impression. The Korean Group states that the proximity of the products in which the Partial Design is incorporated is a key issue, which indirectly involves the UP as well as the SC. Thus, a total of 19 Groups indicate that the UP and/or SC are relevant, at least to some extent.

The Spanish Group explains that the UP and/or SC are relevant because the assessment of the nature of the product and of the industrial sector carried out by the informed user (who is precisely defined as such), includes the applicative element as one of its analysis criteria.

A total of 14 Groups indicated that the UP and/or SC are not relevant.

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.

A total of 16 Groups take the view that the Unclaimed Part should, in some way and to some extent, be taken into account when considering the overall impression:

− Only to the extent that infringement of the registered design only occurs in relation to products in respect of which the design is registered;
- The Unclaimed Part should be given less weight than the Partial Design;
- The Unclaimed Part is one of the relevant factors;
- The Unclaimed Part should be relevant to validity but not infringement.

A total of 11 Groups take the view that the Unclaimed Part should not be taken into account when considering the overall impression.

The Singaporean Group states that the Unclaimed Part should not be taken into account, but the Locarno classification (which to some extent reflects the Unclaimed Part) should.

Two Groups say that the Unclaimed Part can be used to understand the Partial Design.

The UK Group explains that an Unclaimed Part ought to be taken into account when analysing the overall impression to the extent that it helps inform the design corpus of the Partial Design and the design freedom in arriving at the Partial Design. This will determine the perspective and background of the informed user when making the comparison (whether for the purposes of individual character or infringement). It might also inform the user of the relative size and proportions of the Partial Design to be compared against that of the prior art or accused design.

The Italian Group takes the view that, as a general principle, when assessing novelty/individuality and infringement, the Unclaimed Part should be taken into account in order to define the scope of the right claimed/asserted. This is because, in the view of the Italian Group, the informed user should be linked to the market to which the Partial Design is relevant. The Unclaimed Part offers a clear indication of this market and should be taken into account for that purpose. This view is consistent with EU case law on the characteristics of the informed user.

The Japanese Group proposes that the Unclaimed Part, and more specifically, the following should be taken into account:

- Intended purposes and functions of the Unclaimed Part (similarities in intended purposes, industry, consumers etc.)
- The position, size and area of the Partial Design relative to the Product; and the position, size and area of the accused design relative to the Product,
- The overall impression in view of b) above.

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.

Seven Groups are of the view that the Unclaimed Part should affect the analysis of Design Constraints.

A total of 18 Groups take the view that the Unclaimed Part should not affect the analysis of Design Constraints:

− Because there should be no design constraint limitations at all;
− Design constraints should apply as for any Design by reference to the Partial Design and not the Unclaimed Part;
− Design constraints except must match should apply, as normal, by reference to the Partial Design and not the Unclaimed Part;
− Functionality based design constraints only should apply, as normal, by reference to the Partial Design and not the Unclaimed Part.

The Japanese Group explains that it is likely that the Unclaimed Part may affect freedom in creating a Partial Design for the claimed part. Therefore, it should be allowed to take into account Design Constraints, such as must fit / must match, arising from the Unclaimed Part when assessing the overall impression of the claimed Partial Design. In the view of the Korean Group, the effect of the Unclaimed Part should be minimal and limited when assessing Design Constraints.

The Swedish Group is of the view that:

− the Unclaimed Part should not directly influence the assessment of Design Constraints, but it may still have an evidentiary effect when assessing the freedom of the designer and Design Constraints.
− The Unclaimed Part may help to better establish what type of product the Partial Design is as it depicts its appearance in normal use. It may also serve as a basis of the circumstances under which the Partial Design was created, and may consequently be helpful when identifying possible constraints in the designer's freedom such as technical function.
− It is questionable to what extent the Unclaimed Part will be of any relevant evidentiary use when assessing must fit/must match, as those defences are to a greater extent dependent on objectively assessing the details on the actual physical products which has been put on the market. Although the Unclaimed Part may at least clearly indicate the designer's awareness of the Partial Design possibly being subject to must fit/must match.
18) Please comment on any additional issues concerning any aspect of Partial Designs you consider relevant to this Study Question.

No further issues were identified that relate directly to the focus area of this Study Question.

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

The responses also evidenced experience and expertise in advising particular industry sectors, including for example:

Packaging, Machines (valves), Cleaning products, Oil, Automotive, Aviation, Toy industry, Consumer goods, Building industry, Pharmaceutical industry, Software, Plastic manufacturers, Furniture designers, Electrical goods, Motorization for doors, gates, Home automation, Sports equipment, Motorcycle industry, Manufacturing jewellers, Household appliances, Stage decor design, Lighting, Fashion industry (footwear), Food industry (beverages), steel.

IV. Conclusions

From the Reports the conclusion can be drawn that a large majority of the Groups agree that harmonisation is desirable regarding at least some of the issues described above.

The main issue of principle that the Groups addressed was the scope of protection of a Partial Design. Some Groups considered that use of a partial design in a different context should infringe regardless of the context in which the design is used. However, the inevitable result of this approach is that more prior art will also be relevant to the design because the context of the prior art ought not to matter, making it more difficult to obtain a design registration that will prove to be valid. Other Groups took the view that the designer had the option, when seeking to register its design, of registering a non-Partial Design or a Partial Design. If they register a Partial Design together with its context (e.g., the handle of a pan depicted in solid lines, the Unclaimed Part – being the rest of the pan – depicted in dotted lines), then the context of the pan should have some effect both in terms of infringement and validity. If, however, they choose to register a handle of a pan as a Design in its own right, there will be no context to be taken into account, and indeed that Design should not be considered a Partial Design for the purposes of this Study Question if it is not depicted or described as being a Partial Design.

**Should protection be independently available for Partial Designs?**

All but two Groups agree that it should.

**Should laws on the Partial Designs be harmonised?**
All but two Groups agree that they should.

**Should the Unclaimed Part be relevant when assessing the overall impression?**

19 Groups support the proposition that the Unclaimed Part should be factored in, at least to some extent, when considering the overall impression of the Partial Design. 13 Groups are against. There is therefore support for this proposition from approximately 60% of Groups responding to the question.

Each viewpoint has a distinct set of advantages and disadvantages. Whatever matter is relevant to overall impression will also drive the breadth of the design corpus that is relevant to assessing whether the Partial Design has distinctive character, since a Partial Design will not have distinctive character if the overall impression it produces is not different to that of any design in the design corpus. Thus:

- If the Unclaimed Part is not relevant to overall impression, the design corpus for the Partial Design may be broader and include all kinds of components with the same characteristics regardless of how they are used. For example, in the case of design for the a heel for a shoe, the same heel in any other shoe (or even the same heel without a connected shoe, a square block alone, or a design for a cube or brick) could be part of the design corpus. Generally speaking, this makes it more difficult for the partial design to be distinctive over the design corpus, but if the partial design satisfies that condition then it is more easily infringed by anything else that contains the partial design regardless of context;

- If the Unclaimed Part is relevant to overall impression, the design corpus for the Partial Design may be narrower and include only the same or similar components in the same or similar types of product lines. This then generally speaking makes it more easy for the partial design to be distinctive, but more difficult to establish infringement.

The majority of Groups were in favour of the latter approach: making it easier for a design to be distinctive, but making it more difficult to establish infringement and monopolise many areas of design with a single registration for the design of a fundamental component.

A number of Groups sought to temper the disadvantages of this approach by proposing that the Unclaimed Part should be given less weight.

**Should Design Constraints evident from the Unclaimed Part be relevant?**
It almost goes without saying that if a Partial Design is a design for a part of a Product, then that part could well connect to the rest of the Product (unless the Partial Design is for an element that is “floating in space”, but even then, the distance, orientation and placement of the part is defined by the rest of the Product). If that part were to be protected as a standalone design (but without the context of the rest of the Product), then in all likelihood some part of the part could fall within must fit/must match exclusions (in jurisdictions having such exclusions), because when in use the element will connect to and must fit with the rest of the product. The Unclaimed Part could be a useful guide to relevant must fit/must match exclusions, when the part forms a part of a Product in the way envisaged by the designer. An additional benefit of using the Unclaimed Part to deduce whether there are Design Constraints that apply to the Partial Design is that legal certainty is increased since the evaluation is not product-specific and can be carried out based on information available in the design registration alone.

However, the majority of Groups (some 70%) take the view that the correct approach is to not take the Unclaimed Part into account when judging Design Constraints. Thus, the majority view is that Design Constraints will need to be judged from the way that the Partial Design is applied in each situation: e.g., whether it must fit with the particular product in which a part made to the Partial Design is used.

For example, if the Partial Design is for the base and stem of a wine glass, the must fit/must match analysis would be different if the base and stem are used by (a) connecting to a glass, (b) connecting to a candle holder to make a candle stick with a stem and base, and (c) using the stem as a miniature flagpole and attaching a flag to it. In each of these cases, the scope of the Partial Design would need to be adjusted according to the circumstances, the disadvantage being that the right holder would not know in advance what Design Constraints apply. The advantage would of course be that, in some situations such as the use of a wine glass base and stem as a flagpole, very few constraints would limit the Partial Design and unnecessary constraints would not be applied.

**Representation of Partial Designs**

There was substantial support for a clear and consistent system for identifying Partial Designs. This could include stippled or dotted lines for the unclaimed part and sold line for the claimed part. However circling or colours showing the unclaimed part should also be acceptable, and boundaries and blurring. The main point is that the same standard method should be used everywhere to avoid confusion and to reduce errors. If dashed lines indicate the Unclaimed Part in one jurisdiction, dashed lines should have the same function in other jurisdictions.
The Swedish Group proposed the framework set forth in EU guideline CP6 for visual disclaimers should be used, namely that:

− Graphic or photographic representations showing only the claimed Partial Design are preferred;

− However, visual disclaimers may alternatively be used to indicate an Unclaimed Part of the graphic or photographic representations. The visual disclaimer must then be clear and obvious, and the Partial Design and the Unclaimed Part must be clearly differentiated;

− The graphic or photographic representation of the design shall clearly indicate that protection is only sought for the Partial Design and not the Unclaimed Part;

− The graphic or photographic representation of the design shall show consistently the Unclaimed Part in all the views where the Unclaimed Part appears; and

− Where a visual disclaimer is used, broken lines are recommended for indicating the Unclaimed Part (and the Partial Design be indicated with continuous lines). Only when broken lines cannot be used due to technical reasons (for example, when they are used to indicate stitching on clothing or patterns; or photographs are used), other visual disclaimers can be used: colour shading, boundaries and blurring.

On a general level, the proposal of the Swedish Group encompasses the views of the Groups as a whole. There is some debate as to the utility of individual types of disclaimers (such as written disclaimers), and some doubts are expressed in a few Groups on the utility of boundaries and blurring. The individual elements finding the greatest support across most Groups are the use of visual disclaimers using broken lines and/or colour shading. The most important point, identified by all Groups, is a consistent system across jurisdictions in which a visual disclaimer has the same meaning in all jurisdictions.

Date: 10 August 2018
Background:

1) Designs protecting the appearance of a whole product were discussed in AIPPI's Resolution on "Requirements for protection of designs" (Milan, 2016), hereafter referred to as the Milan Resolution. Partial designs, being a portion or portions of a whole product, were excluded from the Milan Resolution. The objective of this Resolution is to address such partial designs.

2) For the purpose of this Resolution:

- **Product** is an object or article of manufacture;
- **Design** means the overall visual appearance of a Product including any ornamentation;
- **Partial Design** is a design for a portion or portions of a whole Product. In particular, a Partial Design is a design where less than the whole Product depicted is claimed. Where the claimed design is depicted and described as being a whole Product, that design is not regarded as a Partial Design for the purpose of this Resolution;
- the **Claimed Part** of a Product is the part or parts of the Product which is claimed as a Partial Design;
- the **Unclaimed Part** of a Product is the part or parts of the Product which is not claimed as a Partial Design;
- the **Surrounding Context** of a prior design or an accused product is the part or parts of the prior design or accused product that do not correspond to the Claimed Part, i.e. they are outside the Partial Design; and
• **Design Corpus** refers to the relevant set of prior art which has been made available to the public.

3) This Resolution:

• provides for uniform methods of defining the Claimed Part of Partial Designs graphically, by disclaimer or otherwise; and

• addresses the role and relevance of the Unclaimed Part and the Surrounding Context.

4) 40 Reports were received from AIPPI's National and Regional Groups and Independent Members providing detailed information and analysis regarding national and regional laws relating to this Resolution. These Reports were reviewed by the Reporter General Team of AIPPI and distilled into a Summary Report (see links below).

5) At the AIPPI World Congress in Cancun in September 2018, the subject matter of this Resolution was further discussed within a dedicated Study Committee, and again in a full Plenary Session, following which the present Resolution was adopted by the Executive Committee of AIPPI.

**AIPPI resolves that:**

1) Design protection should be available, by way of registration, for Partial Designs. Such registered designs protect only the overall visual appearance (including ornamentation) of the Claimed Part.

2) The Claimed Part and Unclaimed Part of Partial Designs should be explicitly indicated, including using the following methods:

   a) Graphic or photographic representations are preferred.

   b) Visual disclaimers must be used to indicate the Unclaimed Part. The visual disclaimers must clearly indicate that protection is not being sought for the Unclaimed Part. A written description may optionally be used to clarify a visual disclaimer.

   c) Visual disclaimers of the Unclaimed Part shall be shown consistently in all the views in which the Unclaimed Part appears.

   d) Broken lines are the preferred form of visual disclaimer, and may be used to indicate the Unclaimed Part, with the Claimed Part indicated with continuous lines.
e) Alternatively, when broken lines are not used, for example due to technical reasons (such as, when they are used to indicate stitching on clothing or patterns, or where photographs are used), other visual disclaimers can be used, including:

(i) colour shading, whereby contrasting colour tones can be used to obscure the Unclaimed Part;

(ii) boundaries (e.g.: a distinct visual border such as a red outline) to indicate that only the portion inside that boundary forms the Claimed Part; and

(iii) blurring, whereby the Unclaimed Part is obscured.

3) In determining the nature and use, the Design Corpus, and the relevant observer of the Product to which the Partial Design is directed, consideration should be given to the Claimed Part and the Unclaimed Part. The validity and scope of protection of the Partial Design is assessed through the eyes of that relevant observer of that Product, considering exclusively the Claimed Part.

4) In the assessment of the overall impression created by a prior design (validity) and an accused product (infringement), the Surrounding Context need not be excluded.

5) The Milan Resolution shall apply to registered Partial Designs mutatis mutandis.

Links:

- Study Guidelines
- Summary Report
- Reports of National and Regional Groups and Independent Members
Resolution

2018 – Arbeitsfrage (Muster)

Designschutz für Teile eines Erzeugnisses

Hintergrund:


2) Für die Zwecke dieser Resolution gilt:

- Erzeugnis ist ein Gegenstand oder Erzeugnis.

- Design bedeutet die gesamte sichtbare Erscheinungsform eines Erzeugnisses einschließlich jeglicher Verzierungen.


- der beanspruchte Teil eines Erzeugnisses ist der Teil oder Teile des Erzeugnisses, der als Design für Teile eines Erzeugnisses beansprucht wird;

- der nicht beanspruchte Teil eines Erzeugnisses ist der Teil oder Teile eines Erzeugnisses, der nicht als Design für Teile eines Erzeugnisses beansprucht wird;
• der **umgebende Kontext** eines vorbekannten Designs oder eines angegriffenen Erzeugnisses ist der Teil oder Teile eines früheren Designs oder angegriffenen Erzeugnisses, die nicht dem beanspruchten Teil entsprechen, d.h. sie befinden sich außerhalb des Designs für Teile eines Erzeugnisses; und

• **Design Corpus** bezieht sich auf die relevante Gesamtheit an Formenschatz, der der Öffentlichkeit offenbart wurde.

3) Diese Resolution

• regelt einheitliche Methoden, um den beanspruchten Teil eines Designs für Teile eines Erzeugnisses grafisch, durch Disclaimer oder auf andere Weise festzulegen;

• befasst sich mit der Funktion und Relevanz des nicht beanspruchten Teils und des umgebenden Kontexts.


5) Auf dem Weltkongress der AIPPI in Cancún im September 2018 wurde der Gegenstand dieser Resolution weiter innerhalb eines zugewiesenen Study Committee und noch einmal in der Vollversammlung diskutiert. Dies führte zur Annahme der gegenwärtigen Resolution durch das Executive Committee der AIPPI.

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**AIPPI beschliesst:**


2) Der beanspruchte Teil und der nicht beanspruchte Teil sollen ausdrücklich angegeben werden, einschließlich durch Benutzung der folgenden Methoden:

   a) Grafische oder fotografische Darstellungen sind bevorzugt.

   b) Visuelle Disclaimer müssen benutzt werden, um den nicht beanspruchten Teil anzugeben. Die visuellen Disclaimer müssen klar angeben, dass ein Schutz nicht für den nicht beanspruchten Teil begehrt wird. Eine schriftliche Beschreibung kann optional benutzt werden, um den visuellen Disclaimer zu erläutern.
c) Visuelle Disclaimer des nicht beanspruchten Teils müssen in allen Ansichten, in denen der nicht beanspruchte Teil erscheint, übereinstimmend gezeigt werden.

d) Unterbrochene Linien sind die bevorzugte Form eines visuellen Disclaimers, und können benutzt werden, um den nicht beanspruchten Teil anzugeben, während der beanspruchte Teil mit durchgängigen Linien anzugeben ist.

e) Wenn unterbrochene Linien nicht benutzt werden, zum Beispiel aus technischen Gründen (zum Beispiel, wenn sie benutzt werden, um Nähte auf Bekleidung oder Mustern anzugeben, oder wenn Fotografien benutzt werden), können alternativ andere visuelle Disclaimer benutzt werden, einschließlich:

   (i) Farbschattierungen, wobei kontrastierende Farbtöne benutzt werden können, um den nicht beanspruchten Teil zu verschleiern;

   (ii) Begrenzungen (Beispiel: eine deutliche visuelle Grenze, wie eine rote Umrisslinie), um anzugeben, dass nur der Teilbereich innerhalb dieser Begrenzung das Design für Teile eines Erzeugnisses bildet; und

   (iii) Unschärfe, durch die der nicht beanspruchte Teil verschleiert wird.


4) Bei der Prüfung des Gesamteindrucks, der durch ein vorbekanntes Design (Schutzhäftigkeit) und ein angegriffenes Erzeugnis (Verletzung) erzeugt wird, muss der umgebende Kontext nicht ausgenommen werden.

5) Die Mailand-Resolution findet auf Designs für Teile eines Erzeugnisses entsprechende Anwendung.
Links:

- [Richtlinien für Berichte](#) (englisch)
- [Zusammenfassender Bericht](#) (englisch)
- [Berichte von Landes- und Regionalgruppen sowie von unabhängigen Mitgliedern](#) (englisch)
Résolution

2018 – Question d’étude (Modèles)

Dessins et Modèles partiels

Contexte :


2) Aux fins de la présente Résolution :

- **Produit** est un objet ou un article manufacturé ;
- **Dessin ou Modèle** signifie l'apparence visuelle d'ensemble d'un produit, y compris son ornementation ;
- **Dessin ou Modèle Partiel** est un dessin ou modèle pour une portion ou des portions d'un produit entier. En particulier, un Dessin ou Modèle Partiel est un dessin ou modèle revendiquant une protection sur une partie seulement du Produit entier. Un dessin ou modèle revendiquant une protection sur un produit entier tel que représenté et décrit, ne sera pas considéré comme un Dessin ou Modèle Partiel aux fins de la présente Résolution ;
- **la Partie Revendiquée** du produit consiste en la ou les parties du produit qui sont revendiquées en tant que Dessin ou Modèle Partiel ;
- **la Partie Non Revendiquée** du produit consiste en la ou les parties du produit qui ne sont pas revendiquées en tant que Dessin ou Modèle Partiel ;
• le **Contexte Périphérique** d’un dessin ou modèle antérieur ou d’un produit argué de contrefaçon consiste en la ou les parties d’un dessin ou modèle antérieur ou d’un produit argué de contrefaçon qui ne correspondent pas à la Partie Revendiquée, ou autrement dit, qui se trouvent en dehors du Dessin ou Modèle Partiel ;

• **Corpus Antérieur** fait référence à l’ensemble de l’état de la technique pertinent qui a été mis à la disposition du public.

3) La présente Résolution :

• définit des méthodes uniformes pour déterminer l’étendue de protection des Dessins et Modèles Partiels, grâce à des exclusions graphiques, textuelles ou autres ; et

• examine le rôle et la pertinence de la Partie non revendiquée et du Contexte Périphérique.


5) Lors du Congrès Mondial de l’AIPPI à Cancun en septembre 2018, l’objet de la présente Résolution a également été discuté au sein d’un comité d’étude et de nouveau en Session Plénière, ce qui a abouti à l’adoption de la présente Résolution par le Comité Exécutif de l’AIPPI.

**L’AIPPI adopte la Résolution suivante :**

1) La protection d’un dessin ou modèle devrait être possible, par le biais d’un enregistrement, pour les Dessins ou Modèles Partiels. De tels dessins ou modèles enregistrés protègent uniquement l’apparence visuelle d’ensemble (incluant les éléments ornementaux) de la Partie Revendiquée.

2) La Partie Revendiquée et la Partie Non Revendiquée des Dessins ou Modèles Partiels devrait être explicitement indiquée, notamment en utilisant les méthodes suivantes :

   a) Les représentations graphiques ou photographiques sont à privilégier.
b) Des exclusions visuelles doivent être utilisées pour indiquer la Partie Non Revendiquée. Les Exclusions visuelles doivent clairement indiquer qu'aucune protection n'est revendiquée sur la Partie Non Revendiquée. Une description écrite peut éventuellement être utilisée pour clarifier la portée d'une exclusion visuelle.

c) Les Exclusions visuelles sont représentées de façon homogène dans toutes les vues dans lesquelles la Partie Non Revendiquée apparaît.

d) Les traits pointillés sont l'exclusion visuelle à privilégier, et peuvent être utilisées pour indiquer la Partie Non Revendiquée, la Partie Revendiquée étant représentée en traits pleins.

e) Alternativement, quand les traits pointillés ne sont pas utilisés, par exemple pour des raisons techniques (comme quand elles sont utilisées pour représenter des coutures sur des habits ou des motifs, ou quand des photographies sont utilisées), d'autres Exclusions visuelles seront utilisées, notamment :

(i) L'ombrage colorée (ou nuances de couleurs), par lequel des couleurs contrastées peuvent être utilisées pour obscurcir la Partie Non Revendiquée ;

(ii) L'entourage (par exemple une délimitation visuelle nette telle qu'un contour rouge), pour indiquer que seuls les éléments à l'intérieur de la zone délimitée constituent la Partie Revendiquée.

(iii) Le floutage, par lequel la Partie Non Revendiquée est obscurcie.

3) Il convient de considérer la Partie Non Revendiquée et la Partie Revendiquée afin de déterminer la nature, l'usage, le Corpus Antérieur et l'utilisateur pertinent du Produit auquel le Dessin et Modèle Partiel est appliqué. L’appréciation de la validité et de la portée du Dessin et Modèle est effectuée au travers du regard de cet utilisateur pertinent du Produit en tenant compte exclusivement de la Partie Revendiquée.

4) Lors de l’appréciation de l’impression d’ensemble produite par un dessin ou modèle antérieur (validité) ou par un produit argué de contrefaçon (contrefaçon), le Contexte Périphérique n’a pas à être exclu.

5) La Résolution de Milan s’appliquera *mutatis mutandis* aux Dessins et Modèles Partiels.
Liens:

- **Orientations de travail** (anglais)
- **Rapport de synthèse** (anglais)
- **Rapport des groupes nationaux, régionaux et des membres indépendants** (anglais)
Resolución

2018 – Cuestión de Estudio

Diseños Parciales:

Antecedentes:

1) Los Diseños que protegen la apariencia de la totalidad de un producto fueron abordados en la Resolución de la AIPPI “Requisitos para la protección de los diseños” (Milán, 2016), en adelante referida como Resolución de Milán. Los Diseños parciales, en cuanto que parte o partes de la totalidad de un producto, fueron excluidos de la Resolución de Milán. El objetivo de esta Resolución es el de tratar dichos diseños parciales.

2) Para el propósito de esta Resolución:

- **Producto** es un objeto o artículo de fabricación.

- **Diseño** se refiere a la apariencia visual general de un Producto incluyendo cualquier ornamentación.

- **Diseño Parcial** es un diseño para una parte o partes de la totalidad de un producto. En particular, un Diseño Parcial es un Diseño en el que se reivindica solo una parte de todo el Producto representado. Cuando el diseño reivindicado se representa y describe como un Producto completo, ese diseño no se considera un Diseño Parcial a los efectos de esta Resolución.

- La **Parte Reivindicada** de un Producto es la parte o partes del Producto que se reivindican como un Diseño Parcial;

- La **Parte no Reivindicada** de un Producto es la parte o partes del Producto que no se reivindican como un Diseño Parcial;

- El **Contexto Circundante** de un diseño anterior o de un producto infractor es la parte o partes del diseño anterior o del producto infractor que no se corresponden con la Parte Reivindicada, i.e. las que quedan fuera del Diseño Parcial; y
- **Acervo de Diseños** se refiere al conjunto relevante de anterioridades que se ha hecho accesible al público.

3) Esta Resolución:

- Proporciona métodos uniformes para definir gráficamente la Parte Reivindicada de los Diseños Parciales, por medio de renuncias o de otro modo; y
- Aborda el papel y relevancia de la Parte no Reivindicada y del Contexto Circundante.

4) Se han recibido 40 Informes de los Grupos Nacionales y Regionales de la AIPPI y de Miembros Independientes, proporcionando información detallada y análisis sobre las leyes nacionales y regionales relacionadas con la Resolución. Estos informes fueron revisados por el Equipo del Relator General de la AIPPI y sintetizados en el Informe Sumario (ver enlaces abajo)

5) En el Congreso Mundial de la AIPPI de Cancún de septiembre de 2018, el objeto de esta Resolución fue discutido en el seno de un Comité de Estudio específico, y de nuevo en una Sesión Plenaria, siguiendo la cual la presente Resolución fue adoptada por el Comité Ejecutivo de la AIPPI.

**AIPPI resuelve que:**

1) La protección del Diseño debería estar disponible, por medio del registro, para los Diseños Parciales. Tales diseños registrados protegen solo la apariencia visual general (incluyendo la ornamentación) de la Parte Reivindicada.

2) El ámbito de protección de los Diseños Parciales debería estar explícitamente indicado, incluyendo el uso de los siguientes métodos:

   a) Se prefieren las representaciones Gráficas o fotográficas
   
   b) Las renuncias visuales deben usarse para indicar la Parte no Reivindicada. Las renuncias visuales deben indicar claramente que no se pretende la protección de la Parte no Reivindicada. Se puede utilizar de manera opcional una descripción escrita para aclarar una renuncia visual.
   
   c) Las renuncias visuales de la Parte no Reivindicada se mostrarán consistente,mente en todas las vistas en las que aparezca la Parte no Reivindicada.
   
   d) Las líneas discontinuas son la forma preferida de la renuncia visual, y pueden usarse para indicar la Parte no Reivindicada, mientras que con las líneas continuas se identifica la Parte Reivindicada.
   
   e) Alternativamente, cuando no se usen líneas discontinuas, por ejemplo, debido a razones técnicas (como cuando se usan para indicar costuras sobre ropa o patrones, o cuando se usen fotografías), se pueden usar otras renuncias visuales, incluyendo:
(i) Sombreado de color, en el que el contraste de los tonos de color se puede usar para oscurecer la Parte no Reivindicada;

(ii) Contornos (p. ej: un borde visual distinto, como un círculo rojo) para indicar que solo la porción dentro de ese borde forma la Parte Reivindicada; y

(iii) Difuminados, en los que la Parte no Reivindicada queda oscurecida.

3) En la determinación de la naturaleza y uso, el Acervo de Diseños, y el observador relevante del Producto al que se dirige el Diseño Parcial, se debe considerar la Parte Reivindicada y la Parte No Reivindicada. La validez y alcance de protección del Diseño Parcial se valora a través de los ojos del observador relevante de dicho Producto, considerando exclusivamente la Parte Reivindicada.

4) En la valoración de la impresión general creada por un diseño anterior (validez) y un producto infractor (infracción), no es necesario excluir el Contexto Circundante.

5) La Resolución de Milán se aplicará a los Diseños Parciales registrados mutatis mutandis.

Enlaces:

- Directrices de estudio (inglés)
- Informe de síntesis (inglés)
- Informes de grupos nacionales / regionales y miembros independientes (inglés)