

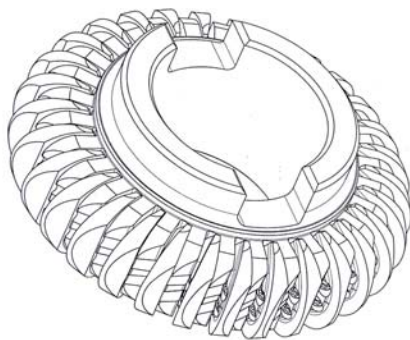
Design Protection for Technical Products

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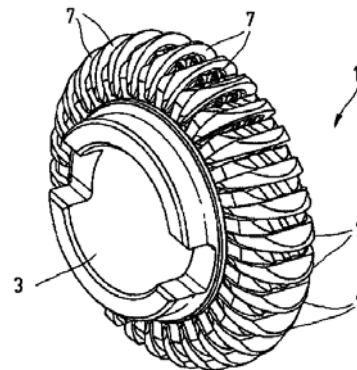
Is somebody doing it?

The harmonized European design law allows protection for the design of a technical product as long as the design does not subsist in features “solely dictated by its technical function.” In fact, the close relation between design and function is common knowledge (“form follows function”) and established practice. A search in the database “RCD Online”² for all registered Community designs which include the terms “tools” or “machines” in the indication of the product reveals thousands of registrations related to patentable matter.

Supplementary protection of an invention by a design in addition to a patent can be done in a fast and cost efficient way by using the figures of the patent application for the design registration. For instance, Community design No. 34269-0001 is registered for a specific embodiment of the milling tool which is claimed in the German patent application DE 103 16 371; obviously, the same drawings served twice:



Community design No. 34269-0001



patent application DE 103 16 371

How come?

When harmonizing the design law in Europe in 1998, the Council clarified that design protection “does not exclude the application to designs of national or Community legislation providing protection other than conferred by registration or publication as design, such as legislation relating to unregistered design rights, trade marks, patents and utility models ...”, and design protection does not require the design to have an “aesthetic quality” (in Recital 10 and 14 Design Directive³). The intention of the legislator to facilitate design protection for technical products found its direct way

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² available on <http://oami.eu.int/RCDOnline/RequestManager?language=en>

³ Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs

into the legal provisions by the addition of the term “complex products” to the fundamental definitions on which the harmonized European design law is based (Article 1(c) Design Directive).

The components of a complex product are themselves eligible for design protection as follows from wording such as “a design applied to or incorporated in a product which constitutes a component part of a complex product” (Article 3 Design Directive) and “design of a component part used for the purpose of the repair of a complex product” (Article 14 Design Directive).

In brief, since the Design Directive has been implemented in all the European Community, there is no doubt that the design of a technical product may be protected in any of the Member States, either by means of a national registration or by a Community design.

When does it apply?

Why should anybody go through the lengthy and costly process of patenting, if protection could be achieved by simple registration of a design? The answer is that design law is only applicable to patentable matter where the invention has materialized in a specific product. The design law does not allow protection of ideas, concepts or methods. A design right can only provide protection for a concrete embodiment of an apparatus claim or a well-defined product achieved with a method claim. However, usually a patent specification contains a description of the best mode for applying the claimed technical solution and figures are attached showing the embodiments. Protecting the best mode by a design registration offers relief for a patent applicant in need of immediate protection.

Even where the invention is incorporated in a device enclosed in some rather unattractive housing, it may still be helpful to register the outer appearance of the device as a design in order to prevent that competitors confuse the market with an identically shaped device. The housing may consist in just some sort of a painted box with an artless arrangement of handles, displays or keys, and nevertheless competitors will have a hard time to find prior art close enough to have the design registration cancelled. Examples can be found by searching in “RCD Online” for registered Community design having the term “housing” in the indication of product, such as the registration No 75007-0001 of a “housing for a laser” shown below:



Community design No. 75001-0001

As regards enforcement, in particular when it comes to preliminary injunctions and custom actions, the certificate of a design registration is quite some weapon, because it is so easy to understand for judges and custom officials.

What are the conditions?

A condition for design protection of technical products is explained in Recital 14 Design Directive: “Technological innovations should not be hampered by granting design protection to features dictated solely by a technical function.” The same language is used in Recital 10 CDR.⁴ The corresponding legal provisions are found in Article 7(1) Design Directive and Article 8(1) CDR.

This condition is in agreement with Article 25(1) TRIPS stipulating that “Members may provide that such protection shall not extend to designs dictated essentially by technical or functional considerations.” Similar restrictions were known in the national design laws before the Design Directive and the TRIPS-Agreement. For instance, the UK Registered Designs Act 1949 excluded “features of shape or configuration of an article which are dictated solely by the function which the article has to perform.”

For understanding this condition, it is helpful to compare the provision of the Design Directive with a similar provision found in Article (3)(1)(e) Trademark Directive:⁵ signs which “consist exclusively of the shape of goods which is necessary to obtain a technical result” shall not be validly registered as a trademark.

These provisions became an issue in the case Philips vs. Remington⁶ which led Advocate General Ruiz-Jarabo Colomer to the following explanation: “The wording used in the Designs Directive for expressing that ground for refusal does not entirely coincide with that used in the Trade Marks Directive. That discrepancy is not capricious. Whereas the former refuses to recognise external features 'which are solely *dictated* by its technical function, the latter excludes from its protection 'signs which consist exclusively of the shape of goods which is *necessary* to obtain a technical result. In other words, the level of 'functionality must be greater in order to be able to assess the ground for refusal in the context of designs; the feature concerned must not only be *necessary* but *essential* in order to achieve a particular technical result: form follows function.⁷ This means that a functional design may, none the less, be eligible for protection if it can be shown that the same technical function could be achieved by another different form.” [...] “First, a trade mark seeks to protect the identity of the origin of the goods and, therefore, indirectly, the *goodwill* which the goods attract, whereas designs - like patents - seek to protect the goods, in their own right, as an economic factor: their substantial value (in the case of designs) or the value which derives from their technical performance (in the case of patents). In that sense, it is entirely logical that the legislature is less concerned by the strict

⁴ Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs

⁵ First Directive 89/104/EEC of the Council, of 21 December 1988, to Approximate the Laws of the Member States Relating to Trade Marks

⁶ ECJ Case C-299/99, *Philips Electronics NV v Remington Consumer Products Limited*, 23 January 2001

⁷ “The semantic contrast which exists in the German version between the adjectives 'erforderlich and 'beding is particularly telling.”

delimitation between designs and patents than by that which ought to exist between the latter and trade marks. Moreover, this makes it easier to give protection to designs that combine functional and aesthetic features.”

The UK Patent Office came to a similar conclusion in its practice of design examination: “It may not be fatal therefore that all of the features of the design are dictated by function. The test would appear to be whether or not the technical function dictates the appearance of the product to the extent that there is no (or negligible) design freedom.”⁸

The current understanding matches the original intention of the European Commission when preparing the Design Directive. In Section 5.4.6.2 of the Green Paper⁹ it reads: „If a technical effect can be achieved only by a given form, the design cannot be protected. On the other hand, if the designer has a choice among various forms in order to arrive at the technical effect, the features in question can be protected.” Accordingly, the draft of the Design Directive of 1993 included an Article 7(1) “A design right shall not subsist in a design to the extent that the realisation of a technical function leaves no freedom as regards arbitrary features of appearances.”

In brief, whether the appearance of a technical product may be protected by a valid design right can be probed as follows: “Is there an alternative design that can achieve the same technical function and does not fall under this design right?” If the answer is affirmative, the design is not solely dictated by the technical function of the product.

This test has been applied by the Invalidity Division of OHIM in its decision regarding the registered Community design No. 225073-0001 for an underwater motive device.¹⁰ The validity of the registration has been contested *inter alia* with the argument that “most features are necessary for technical function”. The Invalidity Division found that the Community design “does not subsist in features of appearance solely dictated by the technical function of the underwater motive device. The device would still fulfil its function with a body of different shape.”

That’s all?

In most cases, the requirement “not solely dictated by its technical function” is the only special provision in the design law which needs to be taken into consideration when it comes to technical products. However, where a technical product is used in connection with another product, there are some more conditions to be fulfilled for the design right to be valid.

First, in case the product will be connected mechanically with (or placed in, around or against) the other product, design protection is only available if the features of the design do need “necessarily be reproduced in their exact form and dimensions” in order to permit the mechanical connection. This condition is called the “must fit” clause (Article 7(2) Design Directive). It applies for instance to the parts of an electrical plug which are inserted into a socket. The plug may still be validly

⁸ Design Practice Notice (DPN) 5/03, 18 August 2003

<http://www.patent.gov.uk/design/reference/dpn/dpn0503.htm>

⁹ Green Paper on the Legal Protection of Industrial Design. Working document of the services of the Commission. III/F/5131/91-EN, June 1991

¹⁰ ICD 867 of 1 December 2005 on <http://oami.eu.int/pdf/design/invaldec/000225073-0001.pdf>

registered as a design, provided there are other features of the plug which do not fall under the “must fit” clause.

Second, if the technical product is used as a component part of a complex product, its design is excluded from protection to the extent it is not visible during the normal use of the complex product (Article 3(3) Design Directive). This condition does not have any logical explanation and had better remained invisible itself. It is a remnant of the traditional thinking that a design has to appeal to the eye. However, until corrected by smarter case law, the condition is to be observed.

Finally, there is this infamous “must match” or “spare part” clause (Article 14 Design Directive). Same as for the color sign in trademark law: it is more a topic in conferences than a problem in real life.¹¹

So what?

A patent covering an invention in its general form, and a registered design protecting a specific embodiment of the invention may coexist with no mutual negative effect to their respective validity. In particular, the existence of the patent does not mean that the design is solely dictated by its technical function. If there is at least one alternative design that can achieve the same technical function and does not fall under the design registration, the registration cannot be invalidated on the ground of Article 7(1) Design Directive. The fact, that all possible design alternatives may be covered by the patent, has no implication to the validity of the design registration.

Having an enforceable protection right for an embodiment of an invention at hand a long time before the corresponding patent is granted, is a valuable asset in an IP portfolio. The additional costs incurred by a design registration are insignificant in comparison to the costs for the patent.

¹¹ recommended reading: *Straus*, GRUR Int. 12/2005, p. 965 - 1054