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Protection of Partial Designs

REPORT OF SWISS GROUP*

I. 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.

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: P. HEINRICH, DesG/HMA, 2. Aufl., Zürich 2014, DesG 1 N 26; M. WANG, SIWR IV, Basel 2007, 74; E. MARBACH, in: E. Marbach/P. Ducrey/G. Wild: Immaterialgüter- und Wettbewerbsrecht, 4. Aufl., Bern 2017, N 440; contra: R. M. STUTZ/S. BEUTLER/M. KÜNZI, Designgesetz, Bern 2006, DesG 1 N 40) and/or
- if it is visible in normal use (pro: MARBACH, N 448; contra: HEINRICH, DesG 1 N 27; WANG, 74; STUTZ/BEUTLER/KÜNZI, DesG 1 N 37; CELLI, DesG 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:

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?*

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 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.

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

Swiss law foresees the possibility to add a description in order to explain the representation of the Design (art. 19 al. 4 Design 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.

* Members of the working group: Harry Frischknecht, Myrtha Hurtado Rivas, Dr. Gallus Joller, Marie Kraus, Dr. Markus Wang. 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.

c) *Can verbal disclaimers be used?*¹

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.

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 (Hg.), Designrecht, Zürich 2003, DesG 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, 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 (STUTZ/BEUTLER/KÜNZI, DesG 8 N 72; MARBACH, 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, 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

1. Are there aspects of your Group’s current law or practice relating to Partial Designs that could be improved? If 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.

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

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.

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

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.

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

Design constraints shall not influence the scope of protection, in particular, if several design alternatives are feasible within the boundary of designs 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.

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:

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

b) *whether the Product is normally sold separately?*

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.

No. The validity and/or the scope of protection shall be independent from the sale.

6. 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 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 interest 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

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

Yes, Partial Designs shall also be protected as such, provided that the Partial Design as such is novel and has an individual character.

2. 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.

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.

Even if no, please address the following questions to the extent your Group considers your Group's current law or practice could be improved.

3. 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 ultima 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.

4. 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.

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.

- 5. 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.

- 6. 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.

- 7. 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.

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

- Consumer goods
- Building industry
- Pharmaceutical industry

Summary

AIPPI International has noticed that in different jurisdictions the protection of partial designs is handled in a diverging manner. In some countries designs can only be protected as such while in other countries the protection of partial designs is possible. AIPPI aims for a resolution with the goal of harmonizing design protection. The working group of AIPPI Switzerland has drafted a report about the legal situation in Switzerland and welcomes a liberal approach with regard to the protection of partial designs. The working group is of the opinion that protection for partial designs shall be available. Furthermore the working group believes that a world-wide harmonization with regard to the requirements for the representations showing a partial design shall be achieved. Moreover the scope of protection of a partial design shall extend also to combinations which are not shown in the representations as long as the partial design as such is realized.

Zusammenfassung

AIPPI International hat festgestellt, dass der Schutz von Partial Designs in verschiedenen Jurisdiktionen sehr unterschiedlich gehandhabt wird. In einigen Ländern sind nur gesamte Erzeugnisse dem Schutz zugänglich, während andere Rechtskreise den Schutz von Partial Designs zulassen. Die AIPPI strebt eine Resolution mit dem Ziel der Harmonisierung an. Die Arbeitsgruppe der AIPPI Schweiz hat einen Bericht über die diesbezügliche Rechtslage in der Schweiz abgefasst und begrüsst eine liberale Haltung bezüglich des Schutzes von Partial Designs. Die Arbeitsgruppe ist grundsätzlich der Überzeugung, dass der Schutz von Partial Designs möglich sein soll. Weiter spricht sich die Arbeitsgruppe für eine weltweite Harmonisierung der technischen Anforderungen an die Darstellung von Partial Designs aus. Darüber hinaus soll sich der Schutzbereich eines Partial Designs auch auf Kombinationen erstrecken, welche abbildungsmässig nicht dargestellt sind, solange das Partial Design als solches verwirklicht wird.

Résumé

AIPPI International a constaté que la protection des dessins partiels est très différente selon les juridictions. Dans certains pays, la protection juridique du dessin n'est octroyée que pour des produits dans leur intégralité, tandis que d'autres admettent également la protection de partie de produits. L'AIPPI aspire à une résolution dirigée à l'harmonisation dans ce domaine. Le groupe de travail AIPPI Suisse a rédigé un rapport sur la situation juridique en Suisse et approuve la position libérale qui permet la protection de dessins partiels. En principe, le groupe de travail est convaincu qu'il est possible d'établir une protection pour les parties de produits. En outre, le groupe de travail plaide en faveur d'une harmonisation globale des conditions techniques relatives à la représentation de dessins partiels. Par ailleurs, le champ de protection des dessins partiels devrait aussi s'étendre à des combinaisons, qui ne peuvent pas être toutes représentées, pour autant que le dessin partiel a été clairement défini.