



Promoting Intellectual  
Property Rights in the  
ASEAN Region



## Session 2: Visibility, Technical and functional features

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Spanish Patent & Trademark Office  
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# Objectives

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- Understand part 3 and 4 of the Common Guidelines
- Be capable of preparing a training session on the subject matter
- Be able to answer questions on the subject matter

# INDEX

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## Part 3: Visibility

1. Principle
2. Complex products and different positions of a product

## Part 4: Technical or Functional features

1. Rationale for refusal
2. Assessment of functionality
3. Functionality ban prevails over aesthetic quality
4. Spare parts and interconnections
5. Combination of functional and aesthetic features

## PART 3. VISIBILITY. PRINCIPLE

- A design should be judged by the eye
- It should:
  - be visible to the consumers
  - remain visible to the user of the product during normal use
- Normal use:
  - use by the end user of the product or article
  - not included maintenance
- Designs involved:
  - complex products with component parts and
  - products with multiple positions.

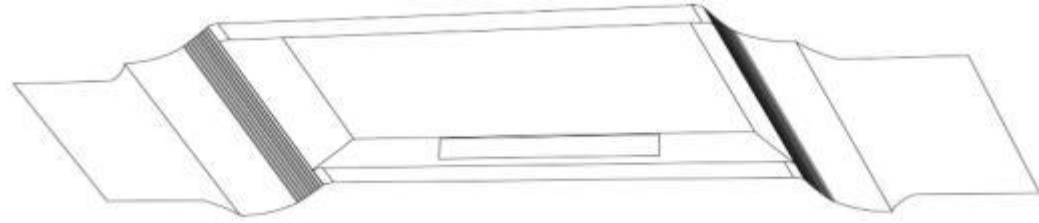
## PART 3. VISIBILITY. COMPLEX PRODUCTS

- Definition:
  - It should comprise or consist of a number of individual parts or pieces.
  - Assembled together to form a device, machine or larger product
  - The pieces may be reassembled, disassembled and replaced
- Are they visible to the consumers during normal use or operation?
  - Yes: **NO OBJECTION**
  - No: **OBJECTION**
  - **“A design right should only cover products and objects that remain *totally or partially* visible during operation and use.”**

## PART 3. VISIBILITY. PRODUCTS WITH MULTIPLE POSITIONS

- If a part
  - is visible during a particular position, phase or step in the normal use or operation of the complex product in such a way that its essential features can be perceived
- should be regarded as a visible feature for purposes of registration and validity of the design. **NO OBJECTION**
- Example: opening and closing of an article, a part or feature of that article that becomes visible during the usual opening step during use

COMPLEX PRODUCTS  
OBJECTED



Interior linings for vehicles

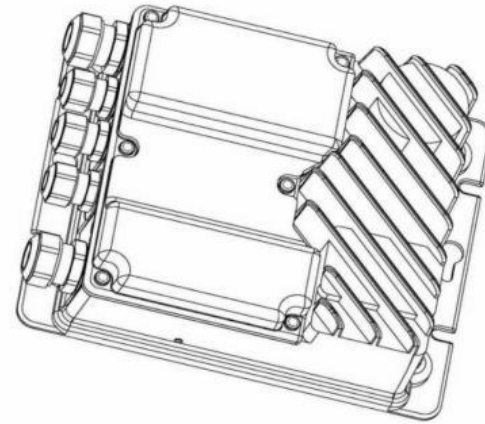
1.4



Joint for sliding roofs for trucks

COMPLEX PRODUCTS  
OBJECTED

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Frequency converters [electricity]



Interior of door for motor vehicles

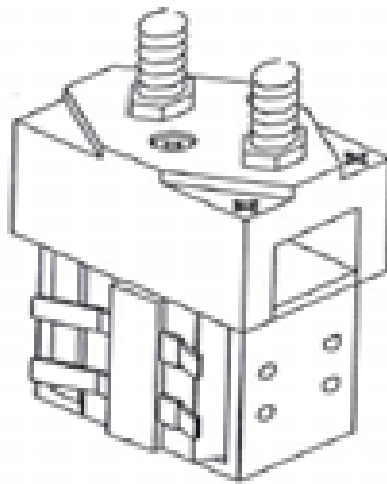


## EXAMPLE



RCD No. 002319814-0001 (06.06) (Leisure furniture) Owner: Przedsiębiorstwo  
Wielobranżowe KAREX Krzysztof Karpiński

## EXAMPLE

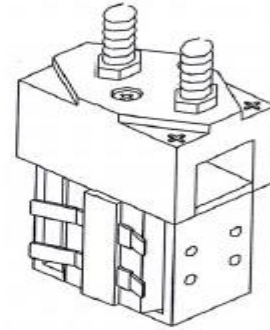


RCD 22603-0001

## EXAMPLE



normal use

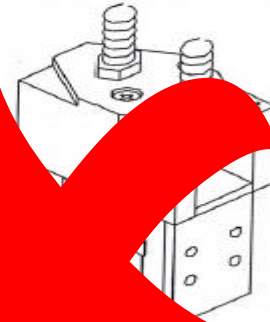


RCD 22603-0001

## EXAMPLE

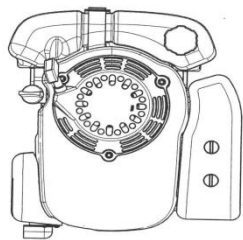
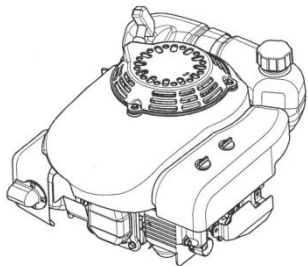


normal use



CD 22 0001

## EXAMPLE

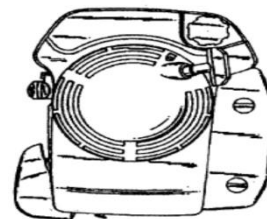


**Contested Desing**

**FIG. 2**



**FIG. 7**



**Previous Design**

## PART 4. TECHNICAL OR FUNCTIONAL FEATURES. RATIONALE OF REFUSAL

- A design protects only the aesthetic appearance
- **NOT** functional or technical characteristics of the features of appearance
- Features not covered by protection:
  - Those with technical effect
  - Those which give the product a functional or economic advantage relevant to:
    - Manufacturing, transportation or handling
    - Ergonomic performance
- Features which respond to functional considerations or give a technical effect or advantage amount to **‘technical solutions’ or inventions**.
- Rule of alternative solutions not applicable.

## PART 4. TECHNICAL OR FUNCTIONAL FEATURES. RATIONALE OF REFUSAL

Condition:

- the *entire* appearance or shape of a product, or all its essential features of appearance are *dictated solely by technical or functional considerations*.
- examiners should raise an objection to the registration of a design *where the appearance of the product responds only to function*.

## PART 4. TECHNICAL OR FUNCTIONAL FEATURES. RATIONALE OF REFUSAL



2.1





## PART 4. TECHNICAL OR FUNCTIONAL FEATURES. ASSESSMENT OF FUNCTIONALITY

1. Determine what the function or utilitarian purpose is:
  - Assessed objectively
  - Perception from a consumer or user not applicable.
2. Locarno Class and product indication will be taken into account.
3. Other documents in connection with the product –patents, utility models, ads- should be taken into account.
4. Any of the features of the product were freely created by a designer with the purpose of adding aesthetic value or were all dictated by the functional purpose of the product, and this was the only factor taken into consideration.

## PART 4. TECHNICAL OR FUNCTIONAL FEATURES. ASSESSMENT OF FUNCTIONALITY

A shape is functional in the following cases (1/3):

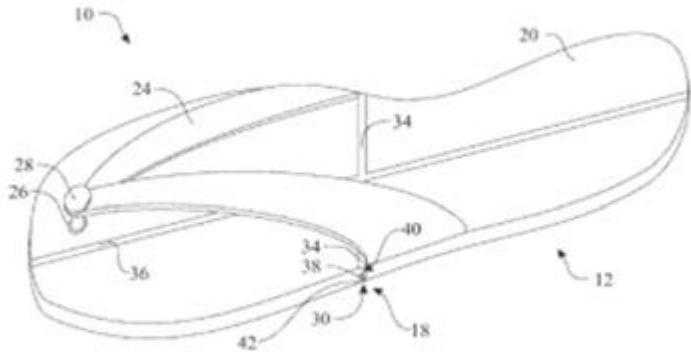
- Shape necessary to allow the product to be used for its intended purpose, or is an ergonomic shape for the product,
- Shape allows for a more efficient or more economical manufacture or assembly of the goods (e.g. by saving material or energy),
- Shape facilitates the transportation or storage of the goods,
- Shape gives the product more strength or better performance or durability,
- Shape allows the product to fit or be connected with another product.

## PART 4. TECHNICAL OR FUNCTIONAL FEATURES. ASSESSMENT OF FUNCTIONALITY

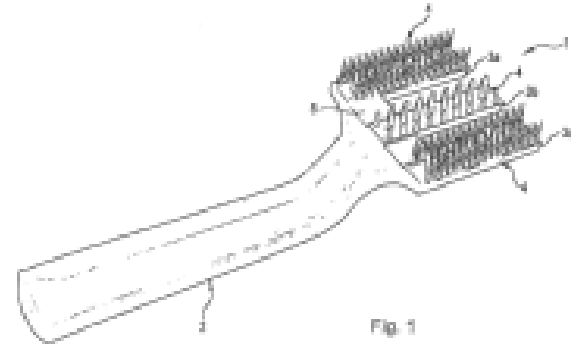
A shape is functional in the following cases (2/3):

- Shape disclosed and claimed in a patent of invention document or in technical literature in connection with the type of product for which the design is to be registered.

## PART 4. TECHNICAL OR FUNCTIONAL FEATURES. ASSESSMENT OF FUNCTIONALITY



“Sandal with formed hinge and  
method of use”



“Hair applicator brush for generating streaks  
and method of using the same”

## PART 4. TECHNICAL OR FUNCTIONAL FEATURES. ASSESSMENT OF FUNCTIONALITY

Can the screwdriver be protected?  
Is it protected in full?



## PART 4. TECHNICAL OR FUNCTIONAL FEATURES. ASSESSMENT OF FUNCTIONALITY

A shape is functional in the following cases (3/3):

- Surface designs that have the function of providing grip, traction or other physical or technical effect.

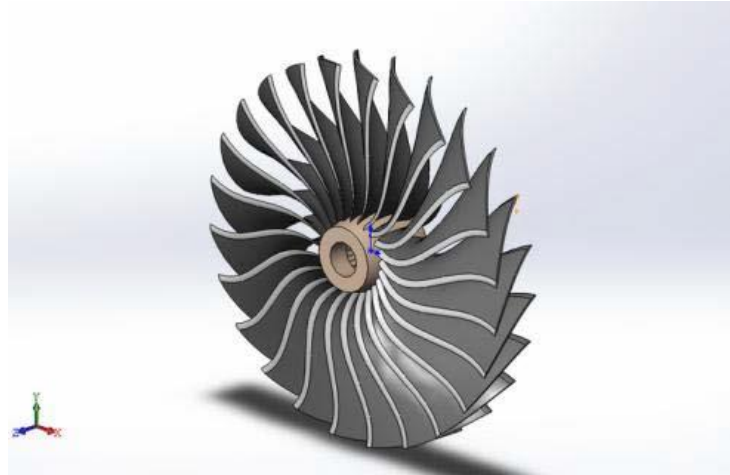
## PART 4. TECHNICAL OR FUNCTIONAL FEATURES. ASSESSMENT OF FUNCTIONALITY



## PART 4. TECHNICAL OR FUNCTIONAL FEATURES

### *Functionality ban prevails over aesthetic quality*

- Functional feature of shape dictated **solely** by technical requirements + aesthetically **attractive** = **objection** regardless of any aesthetic value of the product's appearance.





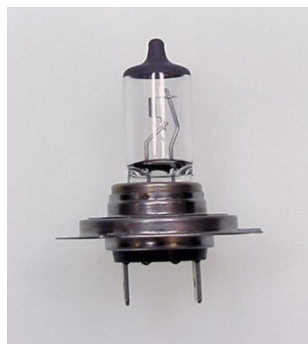
## PART 4. TECHNICAL OR FUNCTIONAL FEATURES

### *Spare parts and interconnections*

- Functional feature: a feature of a design that must **necessarily** be replicated in order that the product that embodies that design may be mounted on, connected with or assembled in another product of which it is a part, in order that they may both perform their intended function. **Not protectable. Must fit clause.**

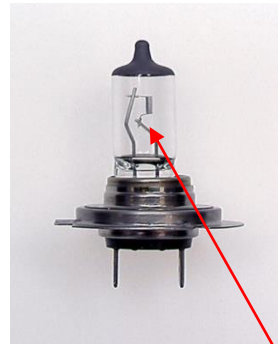


# Examples



DE 40403737-0001

# Examples



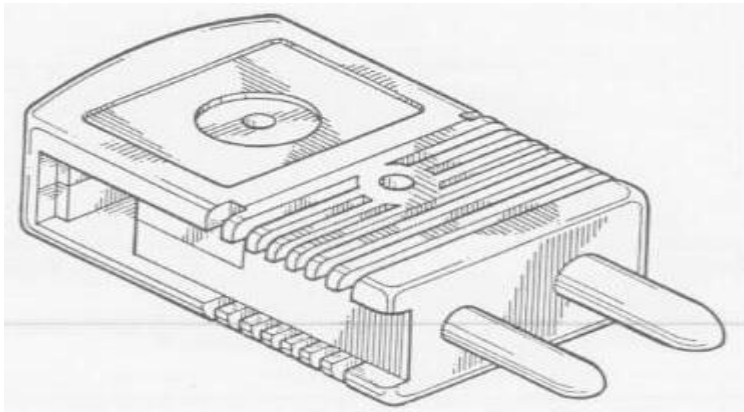
must fit



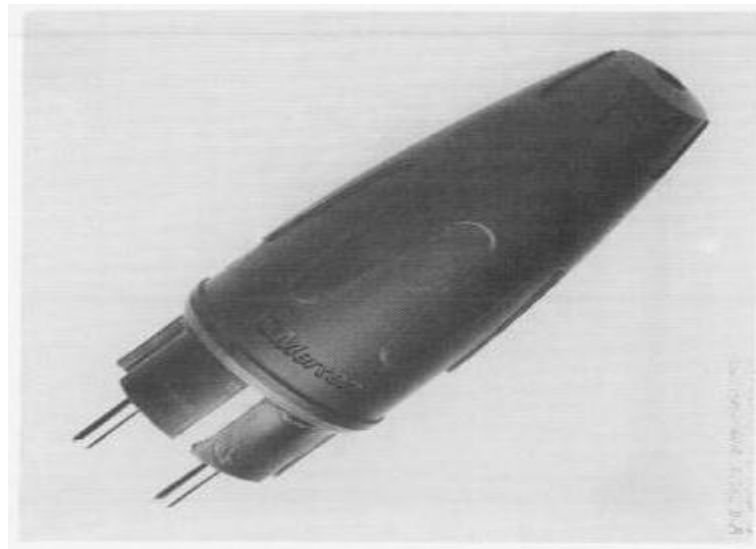
Solely dictated  
by its technical  
function

DE 40403737-0001

# Examples



DE M9108524-0001



DE M9400304-0001

## PART 4. TECHNICAL OR FUNCTIONAL FEATURES

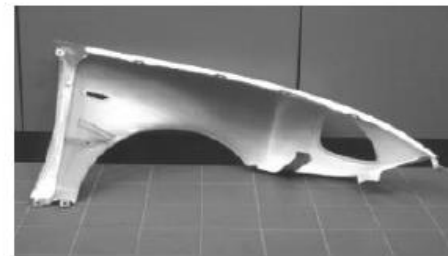
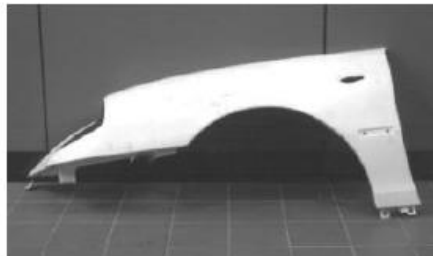
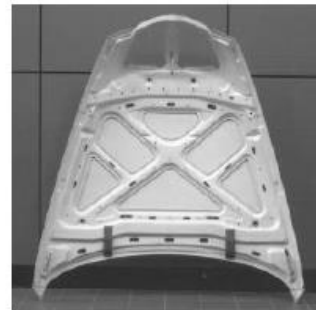
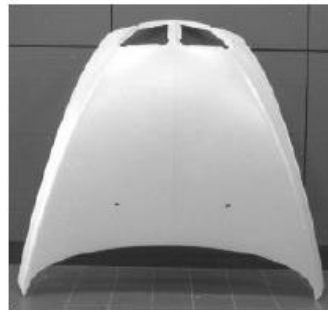
### *Spare parts and interconnections*

- **Spare part**: part which must necessarily be reproduced in its entirety in *identical* shape and appearance in order that such part may fit or match a complex product to which it belongs: **entirely functional and excluded** from protection as an industrial design. **Not protectable. Must Match clause**

## PART 4. TECHNICAL OR FUNCTIONAL FEATURES

### *Spare parts and interconnections*

Designs of spare parts that **could be acceptable** for registration but could be subject to the 'must fit' or 'must match' limitation



## PART 4. TECHNICAL OR FUNCTIONAL FEATURES

### *Combination of functional and aesthetic features*

- Normally, the appearance of a useful product, will **combine both functional and aesthetic features**: the same feature may be functional and aesthetic simultaneously.
- Features of appearance and shape that respond **at least in part** to the designer's intention to make the product's aspect more pleasing to the eye should not be objectionable under the functionality standard.
- The fact that one or several features of a product's design would not be claimable under design law **would not invalidate** the entire design for purposes of registration or continued validity.

## PART 4. TECHNICAL OR FUNCTIONAL FEATURES

*Combination of functional and aesthetic features*





## PART 4. TECHNICAL OR FUNCTIONAL FEATURES

### *Combination of functional and aesthetic features*

- The registration of the industrial design embodying such combination will only cover the aesthetic features in the design, not the functional features.
- Features of a design that are functionally necessary or dictated by technical considerations should not be taken into account when comparing the design with other (earlier or later) designs.

## PART 4. TECHNICAL OR FUNCTIONAL FEATURES

*Combination of functional and aesthetic features*

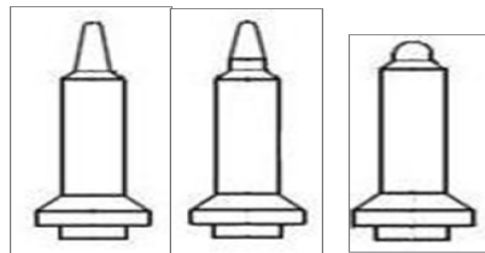


# Case DOCERAM

Request for a preliminary ruling from the OLG Düsseldorf

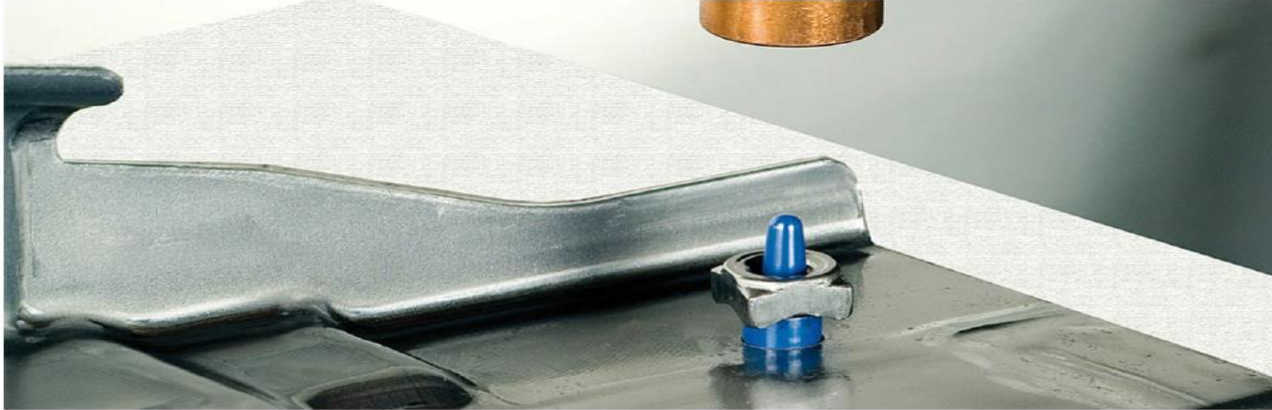


RCD 242730-0001 to 242730-0017  
declared invalid on counterclaim



Accused designs

# Caso DOCERAM



<http://doceram.com/en/application-examples/welding-technology/>

- Controversial elements:
  - Every single feature of the product or just some of them?
  - What does technical function mean?
  - How to assess exclusively dictated?

## Technical and functional features

1. Design to be declared invalid only if **all features of appearance** result from technical considerations only. Any **arbitrary feature sufficient** to deny invalidity.
2. To be established and proven by **invalidity applicant**. To be based on **evidences**.
  1. **Invalidity applicant must** prove circumstances that **dictated choice of features** (technical product information, absence of alternative designs etc).
  2. **Design holder** to prove considerations **other than technical** (designer's intention, design awards, alternative designs etc.)



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# Q & A



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## Promoting Intellectual Property Rights in the ASEAN Region

# THANK YOU



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