



Study Question

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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

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.

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.

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

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.

2.b 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.

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

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.

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

There is no link or nexus required 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.

Yes

Please Explain

There is no link or nexus required between X and Y (see Court of Justice judgment C-361/15 (*Easy Sanitary Solutions v Group Nivelles and EUIPO*)).

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

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

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:

0.a 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.

0.b 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?

Yes

Please Explain

It is desirable to harmonize the law of Partial Designs, see the answer to Q6

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 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.

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.a SC is the same as UP

Not relevant, since these both fall outside the scope of protection sought.

5.b 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.

5.c 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

5.d 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 in the assessment of the overall impression.

5.e 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.

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.

Not relevant (because differences between the SC and UP are not relevant).

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 should apply as to any other Design (which is already the case under Benelux and EU design law).

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

We have no further comments.

19 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.