



## Study Question

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### Partial designs

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National/Regional Group	Sweden
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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?

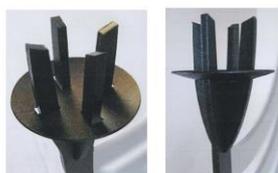
Please refer to p. 2 a-c.

**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

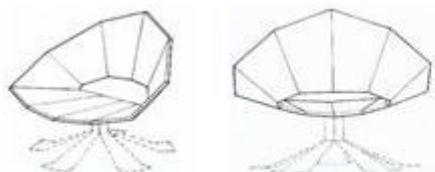
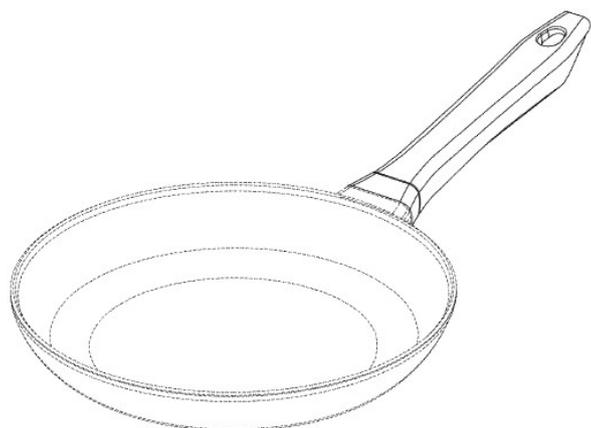
Please Explain

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.



Registrering 82824, mönster nr 4 (Del av ljusstake/ljushållare, 26-01). Innehavare: Ekenäs Kommunikation AB, Huskvarna.  
Formgivare: Ulla-Britt Viking, Huskvarna.

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.



Registrering 80479, mönster nr 1 (Del av fåtölj, 06-01) Innehavare/formgivare: Jon Malmsten med firma JKM Consulting, Stockholm.

Only when dotted or dashed lines cannot be used, due to technical reasons, following disclaimers may be used to indicate the Unclaimed Part.



Registrering 82278, mönster nr 1 (Del av handske, 02-06). Innehavare: ELEMENTA SAFETY Handelsbolag, Bergvik.  
Formgivare: Maryna Grip, Bollnäs.

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, T?666/11 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 T?57/16 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 is exempted 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 exempted 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.

## 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 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.

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

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:**

**0.a** **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.

**0.b** **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.

### 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 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.

**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

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.

**5.b** 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.

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

See p.15 a.

**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

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.

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

See p.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 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.

**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 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.

**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.

None.