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### Requirements for protection of designs

#### REPORT OF SWISS GROUP\*

##### I. Current law and practice

##### 1. Does your Group's current law provide for an intellectual property right (registered or patented) that specifically protects the outward appearance or ornamentation of an object or article of manufacture?

Yes. As set out in the Study Guidelines, copyrights and trademarks are not within the scope of this Study Question.

##### 2. If yes, what is this right called? (e.g. registered design, design patent, industrial design, industrial design patent)?

In Swiss law, the right is called "Design" in German, French and Italian, and it is established on entry in the Design Register (Article 5 paragraph 1 of the Federal Act on the Protection of Designs, Designs Act, DesA).

References to design below are to be read as references to this right, irrespective of what it is called in your jurisdiction.

##### 3. What are the statutory requirements for such right?

###### a) Novelty

A design is not new if an identical design, which could be known to the circles specialised in the relevant sector in Switzerland has been made available to the public prior to the filing date or the priority date (Article 2 paragraph 2 DesA). As a consequence, identical prior designs destroy novelty (BGE/ATF 134 III 205, 209, consid. 5.1, sic! 2008, 445, 447, "bagues"; BBl/FF 2000, 2598; J. Herren, in: C. WEINMANN/P. MÜNCH/J. HERREN [eds.], Schweizer IP-Handbuch, Bâle 2013, § 28 Designregistrierung N 4.4). According to the Supreme Court, the concept of identity has to be construed strictly. This means that in particular the features not contributing to the overall appearance of the object in the view of the target public, i.e., the persons interested in the purchase, have to be disregarded. Notably the size of the object and the attention given to it are relevant. Novelty will not be satisfied if the design is different from another one only by barely detectable details. On the contrary, novelty may come from a specific combination of features which together determine the appearance of the object, even if each of these features considered separately could not satisfy the novelty test (BGE/ATF 134 III 205, 209, consid. 5.1, sic! 2008, 445, 447, "bagues"). Novelty can therefore not be destroyed by an examination as a "patchwork of individual features" with the argument that the different separable features have been known before (R. M. STUTZ/S. BEUTLER/M. KÜNZI, Handkommentar zum Designgesetz, Berne 2006, DesG 2 N 91).

###### b) Non-obviousness

###### c) Inventive step

###### d) Individual character

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*(See answer regarding originality.)*

e) *Originality*

In the three official languages of Switzerland Article 2 DesA uses the terms “Eigenart” in German (which corresponds to “individual character” in English), “original” in French and “originale” in Italian. These terms are different from the terms used in copyright law, namely “individuellen Charakter” in German, “caractère individuel” in French and “carattere originale” in Italian. In the context of the Swiss DesA, the English terms “individual character” and “originality” are essentially synonymous and describe a standard that is different from the one used in copyright.

A design does not have individual character/originality if the overall impression it produces does not differ or differs only in insignificant aspects from a design that is or could be known to the circles specialised in the relevant sector in Switzerland (Article 2 paragraph 3 DesA). According to the Supreme Court, the criteria under Article 8 DesA, according to which the scope of protection of the design right includes designs that have the same essential features and thus produce the same overall impression as a design already registered, are also applicable in this regard. Therefore, the overall impression does not come from details of the design to be considered, but from its essential features. If the compared designs produce a general overall impression of similarity, the originality has to be denied, even if a significant number of details are different from the previous design. The Supreme Court furthermore states that the similarities rather than the differences have to be examined. The creative activity at the origin of the design is not relevant per se as a shape giving an overall impression of novelty is necessarily the result of a creative activity. Reference should be the perception of the potential purchasers; the overall impression is the impression remaining on a short term in the memory of said persons. However, in case of a dispute the judge can base its assessment on a direct comparison of the contested design with pre-existing models (BGE/ATF 134 III 205, 209, consid. 5.1, sic! 2008, 445, 447, “bagues”). According to legal scholars, as third parties must be able to continue to use pre-existing shapes, originality presupposes that the essential features of the considered shape are clearly different from what already exists. However, as it is the case for novelty, an examination as a “patchwork of separate features” is not permissible. Therefore, even if a design consists only of a combination of pre-existing features, originality can be admitted if the design distinguishes itself from pre-existing designs (STUTZ/BEUTLER/KÜNZI, DesG 2 N 105, 107).

f) *Aesthetic*

g) *Ornamental*

h) *Other, namely ...*

**4. Does your Group’s current law deny design protection to a design with an appearance that is dictated solely by its function?**

Yes. This is a ground for refusal. In Switzerland, a design may not be protected if the features of the design are dictated solely by the technical function of the product (Article 4 paragraph c DesA).

However, the Swiss Federal Institute of Intellectual Property (IGE/IPI) may only examine certain formal grounds for refusal (Article 24 paragraph 3 DesA in combination with Article 4 paragraph a, d and e DesA). This means that the IGE/IPI may neither examine novelty and originality of a design (Article 4 paragraph b and Article 2 DesA), nor whether the features of the design are dictated solely by the technical function of the product (Article 4 paragraph c DesA). This issue thus can come up only in a litigation between private parties before a court.

**5. If yes, what are the relevant factors to determine whether or not a design is deemed unprotectable as being functional?**

a) *Whether the overall appearance is dictated solely by its technical function*

Article 4 lit. c DesA states that “A design may not be protected if the features of the design are dictated solely by the technical function of the product.” The technical function of the “product” as such is the

decisive element, not the technical function of a single feature of the design. For a design whose overall appearance is dictated solely by its technical function, all features are deemed to be dictated solely by the technical function of the product, and therefore the design is excluded from protection (see also answer to question 5 [b] and [c]).

*b) Whether each portion of the overall appearance is dictated solely by its technical function*

The DesA does not address the question of the effects of certain design features that are functional. Under the act preceding the current DesA, case law had introduced the practice that for designs of which certain features were the result of a technical function, only “partial nullity” applied if the remaining features of the design still justified a legal protection for the design. However, the applicability of this old case law – based on a differently worded article regarding technical effect – to the new law is disputed among legal scholars, and there is no current case law on the subject (see also answer to question 5 [c]).

*c) The availability of alternative appearances that can obtain the same functional result*

According to the case law of the Supreme Court, the exclusion of Article 4 litera c DesA corresponds to the absolute ground of exclusion from protection as shape marks for forms that are technically necessary (Article 2 litera b of the Trade Mark Protection Act, TmPA; BGE/ATF 133 III 189 ff., consid. 6.1.2, sic! 2007, 546, 550, “Schmuckschatulle”). If there is no technical alternative, a design cannot be protected. If there is another technical possibility, which however implies a less convenient execution, is less resistant, or more expensive (for instance even small additional manufacturing costs of 1.3–4.9% for interlocking building blocks have been considered as “more expensive” in this context and therefore the shape trademark as technically necessary, see decision 4A\_20/2012 of the Swiss Supreme Court, dated 3 July 2012, sic! 2012, 811, “Lego IV [3D]”), the design is also excluded from protection. In such a case, a competitor cannot be expected to renounce the technically most obvious and best suited shape (BGE/ATF 133 III 189 ff., consid. 6.1.2, sic! 2007, 546, 550, “Schmuckschatulle”; BGE/ATF 134 III 205 ff., consid. 6.2, sic! 2008, 445, 448, “Bagues”).

*d) The need to achieve the product’s technical function was the only relevant factor when the design in question was selected*

*e) Other, namely ...*

Functional features are part of the overall design. Even a particular combination of only functional features may form a basis for a valid design, as long as the features of the overall design are not dictated solely by the technical function of the product. This means that the combination of features may not be solely dictated by the technical function of the product (see also answer to question 5 [a] and [b]).

**6. Does your Group’s current law deny design protection to any portions (e.g. a “feature”, “element”) of the overall design that are deemed functional?**

The law does not deny protection to single features of an overall design that are deemed functional, but only to designs of which all features are deemed to be functional.

As indicated above, Article 4 litera c DesA states that “A design may not be protected if the features of the design are dictated solely by the technical function of the product”.

Under the law preceding the current DesA, case law had introduced the practice that for designs of which certain features were the result of a technical function, “partial nullity” applied if the remaining features of the design still justified a legal protection for the design. Features of a design that were technical had been singled out, and the assessment of novelty and originality had been based on the remaining features only. In the report of the Federal Council on the draft new design act (BBl/FF 2000, 2729, 2741), it was stated that this practice should apply also to Article 4 litera c of the new DesA (see e.g. J. Herren, in: C. WEINMANN/P. MÜNCH/ J. HERREN (eds.), Schweizer IP-Handbuch, Bâle 2013, § 28 Designregistrierung N 6.2). However, since the concept of partial nullity had been based on an article that has been worded considerably differently in the new DesA, it is the common understanding of the legal scholars that said concept is no longer directly applicable to Article 4 litera c DesA. Also purely

technical features may contribute to the overall impression of a design (see e.g. M. WANG, SIWR VI, Bäle 2007, 130-132; STUTZ/BEUTLER/KÜNZI, DesG 4, N 45).

Thus it is the common understanding of the law that single features dictated by their technical function are excluded from protection (Commercial Court Aarau decision of 15 July 2005, “balancing bike” [Lauftrad], sic! 2006, 187, 189, consid. 3.4.3). Excluded from protection are designs of which all features, that are decisive for its overall impression, are dictated solely by the technical function of the product. This is, however, not examined by the Swiss Federal Institute of Intellectual Property (IGE/PI) during the examination phase of a design application before registration. Therefore, the provision of Article 4 litera c DesA only comes into effect during cancellation proceedings before the courts.

**7. If yes, what are the relevant factors to determine whether or not a portion is deemed functional?**

a) *Whether the overall appearance is dictated solely by its technical function*

*(see answer to question 6)*

b) *The availability of alternative appearances for the portion to obtain the same functional result*

c) *The need to achieve the product’s technical function was the only relevant factor when the portion in question was selected*

d) *Other, namely ...*

**8. What is the effect on the scope of protection of a design with one or more functional portions?**

a) *Any portions deemed functional will not be taken into account when assessing infringement*

b) *Any portions deemed functional will not be taken into account when assessing validity*

c) *Any portions deemed functional will not be taken into account separately when assessing infringement, but can play a role in the overall comparison*

d) *Any portions deemed functional will not be taken into account separately when assessing validity, but may play a role in the overall comparison*

e) *No effect (e.g. so long as the overall appearance is not dictated solely by its technical function, all portions of the design are included in the scope of protection, irrespective as to whether any portions may be functional)*

The Swiss Design act does not explicitly address the effect of design features that are functional on the scope of protection. In line with the overall doctrine (see also answer to question 6) the scope of protection for a registered design does not extend to designs for which the overall impression is determined by the same functional elements.

f) *The Group’s current law is unsettled*

g) *Other, namely*

**II. Policy considerations and possible improvements to your current law**

**9. How can the following aspects of your Group’s current law be improved, if at all?**

a) *The definition or meaning of a “design”*

The Swiss Group has the opinion that no improvement is necessary in regard to the definition of the meaning of the term “design” in the Swiss law.

The current definition of a “design” as provided in Article 1 DesA is generally undisputed. The given definition was inspired by and essentially corresponds to the definition provided by Article 1 litera a of EU Directive 98/71/EC of 13 October 1998 on the legal protection of designs, which is also identical to Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs. Thus it is compatible with the definition of design for the most other European countries. Furthermore, although the definition differs from the definition as provided by the previous law as in force until 1 July 2002, legal scholars are of the opinion that for interpreting the legal definition of a design, the practice under preceding law is still applicable. In contrast to the corresponding EU statutes, no particular definition is provided for the term “product” (Article 1 litera b and c of EU Directive 98/71/EC). The Swiss Group has the opinion that such a definition is actually not necessary for legal security.

*b) The requirements for protection of a design*

The requirements of protection of a design are given by Article 1 DesA (legal definition of a design), Article 2 (novelty and individual character as basic requirements), Article 3 (non-prejudicial disclosures), and Article 4 (reasons for exclusion from protection). Article 4 litera c particularly defines the exclusion of protection in regard to technical functionality, which is the topic of question 9 (c).

A number of significant questions have so far only be answered by decisions of the Swiss Supreme Court and are not stipulated in the law, e.g. the test for infringement/scope of protection of a certain design (BGE/ATF 129 III 545, sic! 2004, 44, “Knoblauchpresse”), the assessment of individual character/originality of a design in regard to existing, older designs (BGE/ATF 134 III 205, sic! 2008, 445, “bagues”); and the handling of two designs with different application date that have an overlapping scope of protection (BGE/ATF 138 III 461, sic! 2012, 644, “boîtier protubérant”).

*c) The treatment of functionality in the sense described in paragraph 14 of the Study Guidelines or aspects of such functionality*

The treatment of technical functionality of single features of an overall design, as well as technical functionality of the combined features of an overall design, is well established. The majority of the Swiss Group is of the opinion that the current approach is logic and practical, and that another approach is neither necessary nor desirable. A minority expresses the view that the relevance of technically functional features should be treated differently in trademark law and in design law, and that design protection should be awarded more liberally than trademark protection for designs where the overall impression is determined by technically functional features. E.g., design protection should be available if an alternative version exists, although this alternative would cause additional costs, which, however, are not substantial for the end-user price of the object.

**10. Are there any other policy considerations and/or proposals for improvement to your current law falling within the scope of this Study Question?**

The Swiss law does not address the relevance of the design title of and/or of the Locarno classification on the scope of protection conferred by a design registration. Various opinions on the subject were expressed, some authors considering that these elements have no effect on the scope of protection and that a design is protected independently of the nature of the object reproducing it, while others argue that the title and the Locarno class limit the scope of protection to similar objects and/or objects belonging to the same class. The current situation creates legal uncertainty, especially in terms of infringement assessment. The Swiss Group is of the opinion that the law should clearly specify whether the title and/or the Locarno class of a design registration is a limiting factor of its protection scope or not.

**III. Proposals for harmonization**

**11. Does your Group consider that harmonization in the three areas in question 9 above is desirable?**

Yes. It is desirable that the definition of a design as well as the requirements for protection of a design is harmonized (see response under 12). Also the treatment of functionality should be harmonized (see response under 15–17).

**If yes to some but not all of those three areas, please state in relation to which of the areas your Group considers harmonization is desirable.**

**If yes in relation to any of those areas, please respond to the following questions without regard to your Group's current law.**

**Even if no in relation to any of those areas, please address the following questions to the extent your Group considers your Group's current law could be improved.**

**12. Should there be harmonization of the definition of an intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture?**

Yes, the Swiss Group sees a need for harmonization of the definition. With regard to the progressing globalization, designers and/or commercial companies have an extensive interest in a harmonization of the definition of an intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture.

A company intending to launch its goods, consisting of an industrial product which is dictated not only by its technical function, but also supplemented by one or more individual and new elements, will wish to protect the design with protection as broad as possible, particularly for international markets it has not yet entered into. Otherwise, the risk of exploitation by business competitors would be great.

Definitions of a design and varying requirements for its protection (in particular with regard to formal requirements such as shaded lines, meaning of figures and the like) which differ from country to country, requires the company to review and consider the valid requisites for design protection in every single country in which protection is desired, which leads to excessive costs.

A certain design may be protected in, for example, two different countries, but the conformance of the requirements for its registration may have to be argued differently for the two. These situations should be prevented as far as possible since they do not satisfy the demands of a free, globalized market. Therefore, harmonization of formal requirements would be much welcomed.

The Hague Agreement Concerning the International Registration of Industrial Designs allows simultaneous protection of a design in many countries by means of a single registration. Attention should be paid to article 8 of the Hague Agreement and the possibility to refuse protection. By harmonizing the definition and the requirements for the registration of a design, the countries party to the Agreement have limited means of refusing registration and thus creating a different scope of protection.

Harmonization should simplify and standardize the process for protecting the creation of creative designs and therefore enhance their value. A desirable effect of a harmonization would also be a reduction of administrative costs for the applicants as well as the authorities responsible for the registration of the design. Part of the harmonization should also include a clarification of the priority principle, as it is the case for other intellectual property rights.

**13. If so, what should that right be called?**

We suggest the term "registered design". The Swiss Group is of the opinion that a product or rather a design whose features are all dictated solely by their technical function should not be protected. The Swiss Group would not recommend the term "design patent", as it could be misunderstood. Protection of solely functional inventions should only be allowed under patents acts, not design acts. The term "registered design" also emphasizes the effect of absolute protection of a design vis-à-vis third parties as a result of its registration and avoids possible confusion between the object of protection (the design) and the intellectual property right actually providing protection.

**14. What should the requirements for such right be?**

a) *Novelty*

Yes. This requirement prevents a design from being protected, which is already publicly known (by the relevant public). Diversity or distinct differences should be criteria which are required for novelty. Just an identical or almost identical design would destroy novelty and the design in question would not be considered novel (E. MARBACH, in: R. von Büren/E. Marbach/P. Ducrey [eds.], Immaterialgüter- und Wettbewerbsrecht, Bern 2008, N 446 f.).

Attention should be paid to disclosure by the right holder himself. Only in some countries does the right holder enjoy a grace period in which to register the new design even after he/she has disclosed or published it. This method should be supported because of the right holder's legitimate interest in conducting a market test before attempting registration (E. MARBACH, in: R. von Büren/E. Marbach/P. Ducrey [eds.], Immaterialgüter- und Wettbewerbsrecht, Bern 2008, N 452 ff.). To the extent possible, a uniform grace period should be part of a harmonization.

*b) Non-obviousness*

No. The Swiss Group is of the view that "Non-obviousness" is an aspect of the requirement "originality". There is no need to define it as a stand-alone requirement.

*c) Inventive step*

No.

*d) Individual character or originality*

The decision whether an additional requirement should have an "individual character" or "originality" in the Swiss Group's view is a question of semantics, because in practice these two terms are difficult to distinguish. The three official languages of Switzerland (German, French, and Italian) in which the Swiss Design Act is enacted use different terms (see question 3 above). However, no language has precedence over the other, which creates some uncertainty. The Swiss Group prefers the term "originality" to distinguish this requirement from the term "individual character" which is used in Swiss copyright law, but also has a different meaning in Swiss copyright law than in Swiss design law. In general, "originality" is not understood as a qualifying criterion. Even a trivial design requires originality as long as the design is not a result of its technical function and differs from known designs (see BGE/ATF 133 III 189 ff., consid. 3.1, sic! 2007, 546, "Schmuckschatulle", BGE/ATF 133 III 189, 191 with further references).

*e) Aesthetic*

*f) Ornamental*

*g) Other, namely ...*

**15. Should design protection be denied to a design with an appearance that is dictated solely by its function?**

Yes, design protection should be denied to a design with an appearance that is dictated solely by its function.

Patent protection is available for technical solutions.

**16. If yes, what should the relevant factors be to determine whether or not a design is deemed unprotectable as being functional?**

*a) Whether the overall appearance is dictated solely by its technical function*

The decisive point is the interpretation of the expression "dictated solely by its technical function".

In the opinion of the Swiss Group, a design should be deemed unprotectable only if no alternative fulfilling the same technical function but having a different overall appearance exists. In other words, design protection should be denied if the overall appearance represents the only reasonable embodiment.

If several alternatives exist, but each of them is the only one to provide a specific improvement of the overall technical function (e.g., simple producibility vs. long lifetime) each alternative would be deemed "dictated solely by its technical function" and thus unprotectable. If, however, an alternative version would cause additional costs, would be less convenient, or less resistant, but where such disadvantages are not substantial for the end-user of the object, design protection should be available nonetheless.

Since objects typically combine aesthetic and technical aspects, a broader interpretation of the expression "dictated solely by its technical function" would unduly exclude many objects from design protection. Thus, the Swiss Group considers a broad interpretation as inadequate.

*b) Whether each portion of the overall appearance is dictated solely by its technical function*

A design is more than a sum of its portions. The overall appearance of a design can be influenced by any of its portions, including technically dictated portions.

In the opinion of the Swiss Group, it would be a wrong approach to examine the design by first rejecting the technically dictated portions and then examining the remaining portions with regard to novelty and originality. In such an approach, a design of which each portion was dictated solely by its technical function would be unprotectable, of course.

At least theoretically, it seems to be possible that a plurality of technically dictated portions can be arranged in several different ways, the arrangements having different overall appearances. If these arrangements fulfilled the same technical or functional result, they should not a priori be deemed unprotectable (cf. the response to question 16 [a]).

*c) The availability of alternative appearances that can obtain the same functional result*

The availability of alternative appearances should be the only criterion for deciding whether or not a design is deemed unprotectable as being functional. If an alternative appearance that can obtain the same functional result does not exist, the design should be deemed unprotectable; if such an alternative appearance does exist, the design should be protectable (see also the response to question 16 [a]).

*d) The need to achieve the product's technical function was the only relevant factor when the design in question was selected*

Factors considered by the designer when selecting the design can be subjective. In order to guarantee an objective assessment of the design, the Swiss Group does not recommend taking such factors into account.

*e) Other, namely ...*

**17. Should design protection be denied to any portions (e.g. a "feature", "element") of the overall design that are deemed functional?**

No, portions of the overall design that are deemed functional should not be discarded when assessing the scope of the design protection. Even though a particular portion that is deemed functional should not benefit from design protection for itself, it may contribute to the general impression produced by the overall design and thus contribute to defining its protection scope, for example through a particular position, size, etc. relative to the overall design.

**18. If yes, what should the relevant factors be to determine whether a portion of a design is functional?**

Not applicable.

- a) *Whether the overall appearance is dictated solely by its technical function*
- b) *The availability of alternative appearances for the portion to obtain the same functional result*
- c) *The need to achieve the product's technical function was the only relevant factor when the portion in question was selected*
- d) *Other, namely*

**19. What should the effect be on the scope of protection of a design with one or more functional portions?**

- a) *Any portions deemed functional will not be taken into account when assessing infringement*

False. The Swiss Group is of the opinion that functional design portions may add to the overall impression of the design and therefore require proper consideration in design infringement assessments.

- b) *Any portions deemed functional will not be taken into account when assessing validity*

False. The Swiss Group is of the opinion that functional design portions may add to the overall impression of the design and therefore require proper consideration in design validity assessments.

- c) *Any portions deemed functional will not be taken into account separately when assessing infringement, but can play a role in the overall comparison*

True. A functional portion may alter or shift the overall impression of a design. Generally, it may, however, be expected that the informed user recognizes the functional character of a functional portion of the design. Moreover, it may be expected that the informed user attaches only reduced weight to functional portions in the context of the overall impression of the design. As a consequence, when assessing infringement, functional portions may play a less important role than purely aesthetic portions. Excluding functional design portions from infringement assessments a priori and as a matter of principle would unduly narrow the act of creation of the designer. An assessment on a case-by-case basis seems appropriate.

- d) *Any portions deemed functional will not be taken into account separately when assessing validity, but may play a role in the overall comparison*

True. Response under 19 (c) applies mutatis mutandis to validity assessments.

- e) *No effect (e.g. so long as the overall appearance is not dictated solely by its technical function, all portions of the design are included in the scope of protection, irrespective as to whether any portions may be functional)*

False. See response under 19 c).

- e) *The Group's current law is unsettled*

- f) *Other, namely*

**20. If your answer to question 11 is no, is it your Group's view that a (registered or patented) intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture should not be available at all?**

Not applicable.

**21. If yes, why?**

Not applicable.

**22. If your answer to question 11 is no in relation to some but not all of the three areas set out in question 9 above, please state why your Group does not consider that harmonization in that area(s) is desirable.**

Not applicable.

**23. Please comment on any additional issues concerning any aspect of the definition and requirements for protection of designs, or the role of functionality, you consider relevant to this Study Question.**

Not applicable.

### Summary

*Under Swiss law, a design may not be protected if the features of the design are dictated solely by the technical function of the product (Article 4 paragraph c DesA). In the opinion of the Swiss Group, the availability of alternative appearances as applied by the case law of the Supreme court (BGE/ATF 133 III 189 ff. consid. 6.1.2, sic! 2007, 546, 550, "Schmuckschatulle"; BGE/ATF 134 III 205 ff., consid. 6.2 sic! 2008, 445, 448, "Bagues"; Supreme Court decision 4A\_20/2012 dated 3 July 2012, sic! 2012, 811, "Lego IV [3D]") should be the only criterion for deciding whether or not a design is deemed unprotectable as being functional. A design should be deemed unprotectable if there is no alternative fulfilling the same technical function, but having a different overall appearance. However, even in case of possible alternatives, if all these alternatives provide a specific improvement of the overall technical function (e.g., simple producibility vs. long lifetime), the protection would be denied, because all alternatives are deemed "dictated solely by its technical function". This last expression should therefore not be interpreted in a broader way according to the Swiss Group. Otherwise many designs would be unduly excluded from the design protection.*

*This notwithstanding, functional features are part of the overall design. If the possible alternatives do not provide a specific improvement of the overall technical function, the design may be protected, but still contain functional features. For instance, a particular combination of only functional features may form a basis for a valid design, as long as the features of the overall design are not dictated solely by the technical function of the product. The Swiss Group is of the opinion that functional design portions may add to the overall impression of the design and therefore require proper consideration in design infringement assessments. Therefore, functional design portions should not be excluded a priori from infringement assessments, which have to be examined on a case-by-case basis. On the other hand, the Swiss Group is of the opinion that the Swiss law should rule some specific issues. In particular, it should clearly specify whether the title and/or the Locarno class of a design registration is a limiting factor of its protection scope or not.*

*On the international level, definitions of a design and varying requirements for its protection differ. Companies have therefore to review and consider the valid requisites for design protection in every single country in which protection is desired. With progressing globalization this situation does not satisfy the demands of the designers. In this context, the Swiss Group considers that the definition has to be harmonized and suggests the term "registered design" which avoids possible confusion between the object of protection (the design) and the intellectual property right actually providing protection. The term "originality" should also be preferred instead of other expressions such as "individual character" also used for copyright with another meaning. Furthermore, there is also a need for harmonization of formal requirements (for instance shaded lines, meaning of figures and the like) and issues such as, to the extent possible, worldwide uniform grace period (non-prejudicial disclosure).*

## Zusammenfassung

Nach schweizerischem Recht kann ein Design nicht geschützt werden, wenn dessen Merkmale ausschliesslich durch die technische Funktion des Erzeugnisses bedingt sind (Art. 4 lit. c DesG). Nach Auffassung der Schweizer Gruppe soll die vom Bundesgericht angewendete Rechtsprechung der Verfügbarkeit von Varianten (BGE 133 III 189 ff., E. 6.1.2, sic! 2007, 546, 550, «Schmuckschatulle»; BGE 134 III 205 ff., E. 6.2, sic! 2008, 445, 448, «Bagues»; Entscheid des BGer vom 3. Juli 2012, 4A\_20/2012, sic! 2012, 811, «Lego IV [3D]») als einziges Kriterium für die Entscheidung verwendet werden, ob ein Design aufgrund technischer Bedingtheit schützbar ist oder nicht. Steht keine gleichwertige Variante für dieselbe technische Funktion aber mit einem unterschiedlichen Gesamteindruck zur Verfügung, dann sollte ein Design nicht schützbar sein. Selbst wenn mögliche Varianten bestehen, würde, wenn sie eine spezifische Verbesserung der gesamten technischen Funktion darstellen (z.B. einfach produzierbar gegen lange Lebensdauer), der Schutz dennoch verweigert, weil alle diese Varianten als «ausschliesslich durch die technische Funktion bedingt» zu betrachten sind. Dieser Ausdruck sollte deshalb gemäss Schweizer Gruppe nicht zu breit ausgelegt werden, da ansonsten viele Designs ungerechtfertigt vom Designschutz ausgeschlossen würden.

Dennoch gehören technisch bedingte Merkmale zum Gesamteindruck des Designs. Wenn die möglichen Varianten keine spezifische Verbesserung der gesamten technischen Funktion darstellen, kann das Design geschützt werden und trotzdem technisch bedingte Merkmale enthalten. Eine bestimmte Kombination von ausschliesslich technisch bedingten Merkmalen kann zum Beispiel eine Basis für ein gültiges Design darstellen, insofern die Merkmale des Gesamteindrucks des Designs nicht ausschliesslich durch die technische Funktion des Erzeugnisses bedingt sind. Die Schweizer Gruppe ist der Auffassung, dass technisch bedingte Teile eines Designs zum Gesamteindruck beitragen können und deshalb in Verletzungsbeurteilungen berücksichtigt werden können. Demzufolge sollten technisch bedingte Teile nicht a priori von Verletzungsbeurteilungen, welche von Fall zu Fall zu beurteilen sind, ausgeschlossen werden. Auf der anderen Seite ist die Schweizer Gruppe der Auffassung, dass das schweizerische Recht spezifische Fragen regeln sollte. Insbesondere sollte das Gesetz klar festlegen, ob der Titel und/oder die Locarno-Klasse einer Designregistrierung den Schutzbereich eines Designs begrenzt oder nicht.

Auf internationaler Ebene bestehen Unterschiede bei der Definition des Designs und den verschiedenen Voraussetzungen für den Schutz des Designs. Unternehmen müssen deshalb in jedem einzelnen Land, in welchem sie Schutz wünschen, die Voraussetzungen überprüfen und berücksichtigen. Aufgrund der fortschreitenden Globalisierung ist diese Lage für Designer unbefriedigend. In diesem Zusammenhang ist die Schweizer Gruppe der Auffassung, dass die Definition des Designs harmonisiert werden sollte und schlägt den Begriff «Registriertes Design» vor, der mögliche Verwechslungen zwischen dem Schutzgegenstand (das Design) und dem schützenden Immaterialgüterrecht vermeidet. Der Begriff «Eigenart/Originalität» sollte gegenüber anderen Begriffen wie «individueller Charakter», der auch im Urheberrecht mit einem anderem Sinn verwendet wird, bevorzugt werden. Zudem besteht auch ein Bedürfnis für die Harmonisierung von formalen Voraussetzungen (zum Beispiel schattierte Linien, die Bedeutung von Figuren und ähnliches) und Fragen wie eine weltweit einheitliche Schonfrist (Unschädliche Offenbarungen).

## Résumé

Selon le droit suisse, un design ne peut pas être protégé si les caractéristiques du design découlent exclusivement de la fonction technique du produit (art.4 let. c LDes). De l'avis du groupe suisse, l'existence d'apparences alternatives telle qu'appliquées par le Tribunal fédéral (ATF 133 III 189 ss, consid. 6.1.2, sic! 2007, 546, 550, «Schmuckschatulle»; ATF 134 III 205 ss, consid. 6.2, sic! 2008, 445, 448, «Bagues»; décision du TF du 3 Juillet 2012, 4A\_20/2012, sic! 2012, 811, «Lego IV [3D]») devrait être le seul critère pour décider si un design est réputé non protégeable au motif qu'il découle de la technique. Un design ne devrait pas être considéré comme protégeable en l'absence d'alternatives satisfaisant à la même fonction technique, mais ayant une impression d'ensemble différente.

Toutefois, même en présence d'alternatives possibles, si toutes ces alternatives confèrent une amélioration spécifique à la fonction technique d'ensemble (p.ex. productibilité simple v. longue durée de vie), la protection serait refusée, car toutes les alternatives seraient considérées comme «découlant exclusivement de la fonction technique». Cette dernière expression ne devrait par conséquent pas être interprétée plus largement selon le groupe suisse. Dans le cas contraire, des designs seraient indûment exclus de la protection du design.

Ce nonobstant, des caractéristiques qui découlent de la technique font partie de l'impression d'ensemble du design. Si les alternatives possibles ne confèrent pas d'amélioration à la fonction technique d'ensemble, le design peut être protégé, mais quand même contenir des caractéristiques qui découlent de la technique. Par exemple, une combinaison particulière de caractéristiques qui découlent exclusivement de la technique peut constituer la base d'un design valable, tant que les caractéristiques de l'impression d'ensemble du design ne découlent pas exclusivement de la fonction technique du produit. De l'avis du groupe suisse, des parties d'un design découlant de la technique peuvent contribuer à l'impression d'ensemble du design et, partant, doivent être pris en considération dans le cadre d'évaluations de violation de designs. Par conséquent, des parties d'un design découlant de la technique ne doivent pas être exclus a priori d'évaluations concernant la violation qui sont à examiner au cas par cas. D'un autre côté, le groupe suisse est d'avis que le droit suisse devrait régler certaines questions spécifiques. En particulier, il devrait clairement spécifier si le titre et/ou la classe de Locarno de l'enregistrement d'un design constituent un facteur limitant exclus son champ de protection ou non.

Sur le plan international, les définitions d'un design et de nombreuses exigences pour sa protection diffèrent. Les entreprises doivent dès lors examiner et prendre en considération les exigences pour la protection d'un design dans chaque pays particulier dans lequel la protection est souhaitée. Avec la mondialisation qui se développe, cette situation n'est pas satisfaisante pour les designers. Dans ce contexte, le groupe suisse considère que la définition doit être harmonisée et suggère le terme «design enregistré» qui permet d'éviter de possibles confusions entre l'objet de protection (le design) et le droit de propriété intellectuelle qui confère la protection. Le terme «originalité» devrait être préféré à d'autres expressions telles que «caractère individuel» également utilisé pour le droit d'auteur avec une signification différente. De plus, il y existe un besoin d'harmonisation d'exigences formelles (par exemple lignes ombragées, signification des dessins et sujets similaires) et de questions telles qu'une période de grâce uniforme (divulgations non dommageables) dans la mesure du possible au plan mondial.