|  |
| --- |
| **AIPPI, 2021, Study Questions Q278****Industrial designs and the role of prior art** |

**Questions 1 – 6.**

**I. Current law and practice**

Please answer the below questions with regard to your Group's current law and practice. References to a "design" below are to be read as referencing the intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture, irrespective of what it is called in your jurisdiction.

Note: If your answer(s) to Q1) to Q3) below is (are) the same as your answer(s) in reply to the 2016 Designs Study Question, you may simply refer to those answer(s).

**Question 1.**

a) Does your Group’s current law provide for an intellectual property right (other than copyright, trademarks or trade dress), that specifically protects the outward appearance or ornamentation of an object or article of manufacture or other? Please answer YES or NO.

 *Please see the reply to the 2016 Designs Study Questions.*

b) If YES to Q1.a), please identify that law and explain what that right is called. (e.g., registered design, industrial design, design patent, etc.).

 *Please see the reply to the 2016 Designs Study Questions.*

**Question 2.**

Please identify what features of the outward appearance or ornamentation are taken into consideration for a design, e.g., shape/contour, surface, texture, color, etc.

 *Please see the reply to the 2016 Designs Study Questions.*

**Question 3.**

a) Is prior art used to assess requirements for protection of a design prior to registration/issuance of a design, i.e., during substantive examination by an Intellectual Property (“IP”) Office? Please answer YES or NO.

*No. There is no substantial examination unless requested and paid for by the applicant.*

*According to section 17 (1) of the Danish Designs Act (hereinafter the "DKDA") the Danish Patent and Trademark Office (hereafter referred to as “DKPTO”) will only examine ex officio whether the formal requirements for registration of a design are fulfilled and whether the design is contrary to public policy or to accepted principles of morality, cf. section 7 (1)(i). Consequently, the requirements for novelty and individual character are not examined ex officio.*

*According to section 17 (2) of the DKDA the applicant may request the DKPTO for a substantive examination of the design including examination of whether the requirements for novelty and individual character are fulfilled. The examination is based on the information of prior rights in the DKPTO’s official database and other circumstances available to the DKPTO, including information on designs published online.*

 *The result of the substantial examination is, however, instructive.*

*The requirements for novelty and individual character are set out in section 3 of the DKDA. Please see the reply to question 3 of the 2016 Designs Study Questions for further presentation of the requirements for novelty and individual character.*

If you have answered YES to Q3.a), please proceed to answer Q3.b). Otherwise, please proceed to Q4).

b) Referring to Q3.a), for which requirements for protection of a design is prior art used? Please tick all boxes that apply.

☐Novelty

☐Originality

☐Individual character

☐Non-obviousness

☐Inventive step

☐Aesthetic

☐Ornamental

☐Other, namely ………………

c) Referring to Q3.a) to Q3.b), please identify your national/regional laws or guidelines that give definitions of prior art or indications of what qualifies as prior art in this context.

**Question 4.**

a) Is prior art used to assess requirements for protection of a design when validity of the design is contested in court or other post-registration/issuance venue? Please answer YES or NO.

*Yes. However, prior art is solely used in the assessment of a design’s validity post registration when plead by either the registrant or a third party in respect of whether the design fulfils the substantive requirements for novelty and individual character.*

If you have answered YES to Q4.a), please proceed to answer Q4.b). Otherwise, please proceed to Q5).

b) Referring to Q4.a), for which requirements for protection of a design is prior art used? Please tick all boxes that apply.

☒Novelty

☐Originality

☒Individual character

☐Non-obviousness

☐Inventive step

☐Aesthetic

☐Ornamental

☐Other, namely ………………

c) Referring to Q4.a) to Q4.b), please identify your national/regional laws or guidelines that give definitions of prior art or indications of what qualifies as prior art in this context.

*Neither the DKDA nor the guidelines provided by DKPTO give definition or indications of what qualifies as prior art in this context.*

*According to sections 25 (1) and 27 (1) of the DKDA the validity of a design registration can be contested post registration, if the registration has not been registered in accordance with sections 1 to 8, which includes the requirements for novelty and individual character.*

*When the novelty and individual character of a registered design is contested the request must be accompanied by documentation. The legislative preparatory work to the DKDA exemplifies such documentation as ‘earlier published designs which are detrimental to the novelty value of the contested design’.*

*Consequently, a design registration may be cancelled by the DKPTO, cf. section 25, or revoked by a court’s decision, cf. section 27, if the design does not fulfil the requirements for novelty and individual character set out in section 3.*

**Question 5.**

a) Is prior art used to assess requirements for protection of a design with respect to infringement proceedings or other legal situations not addressed by Q3) and Q4)? Please answer YES or NO.

*Yes. However, the assessment of prior art in relation to infringement proceedings is conditional on the parties pleading that the scope of protection should be limited or enhanced with reference to prior art or the lack of such. The courts do not include prior art in their infringement assessment ex officio.*

*Thus, the courts are receptive to arguments regarding the impact of prior art in relation to the scope of protection.*

*In this regard it should be noted that absence of prior art does not necessarily result in enhanced scope of protection. However, the fact that a variety of prior art exits most often would lead to the scope of protection being limited.*

*As an example, reference is made to judgement from the Maritime and Commercial Court in case V-78-05 regarding inter alia the scope of protection of Ferrari’s EU design registration of their Formula 1 racer. A convenience store chain was selling Formula 1 toy cars, which Ferrari considered an infringement of inter alia their EU design registration. Regarding the scope of protection, the Maritime and Commercial Court said that the toy car was different from Ferrari’s design as it was registered with reference to inter alia the front spoiler, the air admission point, the wing on the air admission point and the wheel suspension. The Maritime and Commercial Court concluded that the toy car was no more similar to the Ferrari Formula 1 car than other Formula 1 cars, and thus the toy car was not an infringement of Ferrari’s EU design registration.*

If you have answered YES to Q5.a), please proceed to answer Q5.b). Otherwise, please proceed to Q6).

b) Referring to Q5.a), for which requirements for protection of a design is prior art used? Please tick all boxes that apply.

☒Novelty

☐Originality

☒Individual character

☐Non-obviousness

☐Inventive step

☐Aesthetic

☐Ornamental

☐Other, namely ………………

c) Referring to Q5.b), please indicate in which context these requirements for protection are taken into consideration, e.g., before a judge in infringement proceedings or other legal situations not addressed by Q3) and Q4).

*The novelty and individual character requirements are taken into consideration when argued by the parties in infringement proceedings before the court.*

d) Referring to Q5.a) to Q5.c), please identify your national/regional laws or guidelines that give definitions of prior art or indications of what qualifies as prior art in this context.

*Neither the DKDA nor the guidelines provided by DKPTO gives definition or indications of what qualifies as prior art in this context.*

*However, according to section 9 (1) and (2) of the DKDA a design right shall imply that nobody may exploit the design, including any design which does not produce on the informed user a different overall impression, without the consent of the holder. Section 9 (2) mirrors section 3 (3). Please see the reply to question 3 of the 2016 Designs Study Questions for further reference of the requirements for novelty and individual character.*

**Question 6.**

a) Do your national/regional laws or guidelines provide different definitions of prior art or indications of what qualifies as prior art for registration/issuance, validity, infringement, or other? Please answer YES or NO.

*No. Neither the DKDA nor the guidelines provided by DKPTO gives definition or indications of what qualifies as prior art in this context.*

b) If YES to Q6.a), please briefly identify the differences, if not readily apparent from your responses to Q3) to Q5).

**QUESTIONS 7a – 11.**

**II Criteria of prior art**

**Question 7.**

a)What are recognized means of disclosure, i.e., which materials/documents, etc., can constitute prior art?

*As Denmark is a member of the European Union, Danish design law must be construed in the light of the corresponding EU design law. The primary Danish design legislation is found in the DKDA which implements the EU Design Directive.[[1]](#footnote-1)*

*Section 5(1) of the DKDA provides that “a design shall be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed”. The notion of disclosure is broadly defined and not expressly delimited. The travaux préparatoires of the DKDA lists certain examples of actions that inter alia can constitute means of disclosure:*

1. *Publication through the internet,*
2. *a published trademark application,*
3. *a published patent application,*
4. *publication by other authorities, or*
5. *publication in newspaper, magazine, or other literary work.*

 *The list is not exhaustive, and the provision forms a flexible frame for asserting ways of*

 *disclosure that can constitute prior art.*

 *Section 5(2) of the DKDA contains two limitations as to which disclosures that can entail*

 *the disclosed materials to be regarded as prior art. The section provides that a design shall*

 *not be deemed to have been publicly disclosed:*

1. *when the disclosure could not reasonably have become known in the normal course of business to the circles specialized in the relevant sector, operating within the European Union, or*
2. *if the design has been disclosed to a third person under explicit or implicit conditions of confidentiality.*

b)Does the prior art have to be “printed” and if so, what does that mean?

*As stated in the answer to question 7a, disclosure is broadly defined, and several means of disclosure have been acknowledged as novelty-destroying. Hence, prior art does not need to be in print.*

*In addition, two criteria for determining whether a design has been disclosed as prior art are recognized: 1) the representation of the design in a physical form, and 2) the public rendering of the design. [[2]](#footnote-2)*

*The disclosure does not have to be of the actual physical product, but could be a graphic representation, e.g., a drawing, a photograph etc. However, a description in words is not sufficient to constitute disclosure.*

c)Does the prior art have to be “published” and if so, what does that mean?

*The prior art does not have to be published to be regarded as disclosed. This follows directly from section 5 of the DKDA which states that a design is disclosed if a design has been exhibited or used commercially. The decisive criterion is therefore not whether the art was published, but rather whether the design has been exposed in a way in which it has become known in the normal course of business to the circles specialized in the relevant sector within the European Union.*

*In the Danish Supreme Court's judgement, U.2012.3584 H, the design of a furniture handle was considered to have been made publicly available as it was exhibited at various furniture fairs.*

d)Have there been any recent updates or clarifications of prior art in your jurisdiction focused on intangible or other non-“printed” materials? Please provide those updates.

*There have not been any recent updates or clarifications of prior art focused on intangible or other non- “printed” materials.*

**Time of disclosure**

**Question 8.**

a)What is the relevant date of a prior art reference?

*In accordance with section 3(2) of the DKDA, the relevant date of a prior art reference is the filing date of the application for registration, or if priority is claimed, the priority date. Designs made available before the filing date or the priority date are regarded as prior art.*

*The filing date is provided on the application by the DKTPO and is recorded in the Registry. The priority date is recorded in the Registry as well.[[3]](#footnote-3)*

*The relevant date for unregistered Community designs is the date on which the unregistered Community design was first published within the European Union.[[4]](#footnote-4)*

b)Are design applications published, and if so, when?

*Danish design applications are published in the Danish Design Gazette (Dansk Designtidende). Section 21 of the DKDA provides that the files of the application shall be made available to the public from the date of registration of the design or no later than six months after the filing date or the priority date if priority is claimed.*

*However, if the application has been shelved or turned down, the prosecution file shall not be published, unless the applicant requests resumption or appeals the decision.*

*At the request of the applicant, publication may be brought forward.*

c)When and how are issued design patents or registered designs published?

*Following registration, the registered design will be published in the Danish Design Gazette (Dansk Designtidende) by the DKPTO, no later than 6 months after the filing of the application or from the priority date if priority has been claimed.*

*In case the design is registered within 6 months from the application date or the priority date, the applicant may pursuant to section 18 of the DKDA request a deferment of the publication of the design for up to 6 months from the filing date or the priority date if a priority has been claimed. The deferment request must be stated in the application and must specify for how long the applicant requests the deferment.[[5]](#footnote-5)*

d)Does the publication of an issued design patent or registered design effect a publication of the underlying design application if not previously published?

*As stated in the answer to question 8b, the application shall be made available to the public from the date of registration or not later than six months after the date of filing or the priority date. As a design will be published upon registration, the date of publication of the design is determined by the date of registration of the application, unless deferment has been requested. In any event, after six months from the filing date or the priority date if a priority has been claimed, the application will be published.*

**Circumstances of disclosure**

**Question 9.**

Are the circumstances of disclosure relevant, e.g.:

* Geographical location
* Type of location (e.g., during an exhibition)
* Sector / Type of products
* The person disclosing the prior art (e.g., the applicant of a design, a person bound by a confidential agreement, etc.)
* The recipient of the disclosed prior art
* Other, namely …

*The decisive criterion is whether the design has been exposed in such a manner that it may become known in the normal course of business to the circles specialized in the relevant sector in the European Union. When making this assessment, all the listed circumstances are taken into consideration.*

*The geographical location and the type of location is relevant as some means of disclosure can be perceived as “obscure disclosure”, if the disclosure was limited to a geographical area in which disclosure cannot reasonably have become known in the normal course of business to the circles in the relevant sector in the European Union.*

*The type of product disclosed is relevant for determining the relevant circles in the sector.*

*The identity of the person disclosing the prior art may be relevant as a design shall not be deemed to have been made available to the public, if it results from misuse in relation to the designer (or his successor in title), cf. section 6(ii) of the DKDA.*

*The identity of the recipient of a prior disclosure is also relevant, as the limitation in section 5(2)(ii) of the DKDA sets out that a design shall not be deemed to have been made available to the public if disclosed to a third person under explicit or implicit confidentiality.*

**Grace period**

**Question 10.**

Does your jurisdiction provide a grace period after a first public disclosure of a design for later filing for protection of such design? Please answer YES or NO. If answering YES, please explain the conditions (e.g., formal request, same applicant) and identify the length of time for the grace period (e.g., 6 or 12 months).

*Yes. With respect to prior art Section 6 of the DKDA provides a 12-month grace period from the first disclosure of the design. The grace period does not offer protection in relation to other designs disclosed during the 12-month period.*

*To fulfil the novelty requirement, the designer, his successor in title or a third party acting on behalf of the designer or his successor, must apply for design protection within the 12-month period.*

**Question 11.**

Please indicate any other relevant criteria of prior art.

*There are no other relevant criteria relating to prior art than the criteria set out above.*

**QUESTIONS 14 – 19.**

**II. Policy considerations and proposals for improvements of your Group’s current law**

**Question 14.**Could any of the following aspects of your Group’s current law relating to prior art be improved? If YES, please explain.

a)defining criteria of prior art

*YES. A specific definition of prior art is neither given in the DKDA, nor in the guidelines of the DKPTO. Defining what is to be considered prior art in an infringement case is therefore somewhat incidental. For the courts it can therefore be difficult to determine what is considered relevant prior art in a case. Defining prior art is of importance in the determination of whether the registered design fulfils the requirements of novelty and individual character given in section 3 of the DKDA.*

*Determining the defining criteria for relevant prior art in a case could advantageously be done on an EU-level, i.e., through precedent set by the European Court of Justice. See the answer to question 16.*

b) the use of prior art when assessing the requirements for protection of a design

*YES. The courts do not ex officio take prior art into account. It must first be put forward by one of the parties before the court. This can potentially be perceived as problematic as the court may reach a materially incorrect verdict if the parties fail to address relevant prior art in their proceedings.*

*Regarding the DKPTO’s administrative examination there is a possibility for the applicant to request the DKPTO for a substantive examination in accordance with section 17(2) of the DKDA. This examination by the DKPTO includes an assessment of whether the requirements for novelty and individual character are fulfilled in accordance with section 3 of the DKDA. This examination costs an additional 1,500 DKK (DKDA section 59 a (2)), which could discourage applicants. Furthermore, this examination is merely instructional, and it cannot lead to rejection of the application. It could be beneficial if this examination were an opt-out feature instead of an opt-in feature, which would mean that more applicants became aware of possible infringements.*

*The price of the examination could also be lowered as a registration with the DKPTO costs DKK 1,200, which combined with the price of DKK 1,500 for the substantive examination means a total of DKK 2,700 (or € 360). In comparison, the price of an EU registration, which applies in all EU-member states including Denmark, is € 230.*

*This could be combined with the possibility of administrative refusal from the DKPTO of the application, with an access to appeal the refusal, if there exist identical prior art. This would rebalance the entire design system to be more administratively focused with more emphasis on the registration itself, rather than on the later contesting by other rights holders.*

c) the influence of prior art on the infringement/scope of protection of a design

*NO.*

**Question 15.**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.*

**III. Proposals for harmonisation**

***Please consult with relevant in-house / industry members of your Group in responding to Part III.***

**Question 16.**Do you believe that there should be harmonization in relation to the definition of prior art and/or the use of prior art when assessing the requirements for protection?

If YES, please respond to the following questions to the extent your Group considers your Group’s current law or practice could be improved**.**

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

*YES, on an EU-level. Danish companies use the EU design system more than the national system. In 2018 the number of design applications to the DKPTO was 228 while EUIPO received 1572 applications from Denmark in that same year (Schovsbo, NIR 2020/323-343). It is therefore important to ensure, through harmonisation, that the definition of prior art and the use of prior art in both administrative examination and in court cases is similar throughout the EU. There is already a high level of harmonisation in the EU with regards to the protection of industrial designs, and it is therefore obvious that the regulation and definition of prior art in this field should be the same in all member states.*

*This could be done by the European Court of Justice determining, on an even larger scale, what factors and criteria are to be included in the definition of what is relevant prior art.*

**Question 17.**a) Should prior art be used to assess requirements for protection of a design prior to registration/issuance, i.e., during substantive examination by an IP Office? Please answer YES or NO.

*YES. See the answer to question 14b) on the possibility of a more substantial administrative examination.*

If you have answered YES to Q17a), please proceed to answer Q17.b). Otherwise, please proceed to Q18).

b) Referring to Q17.a), for which requirements for protection of a design should prior art be used? Please tick all boxes that apply.

☒Novelty

☐Originality

☒Individual character

☐Non-obviousness

☐Inventive step

☐Aesthetic

☐Ornamental

☐Other, namely ………………

**Question 18.**a) Should prior art be used to assess requirements for protection of a design during determination of validity when validity of the design is contested in court or other post-registration/issuance venue? Please answer YES or NO.

*YES.*

If you have answered Yes to Q18.a), please proceed to answer Q18.b). Otherwise, please proceed to Q19).

b) Referring to Q18.a), for which requirements for protection of a design should prior art be used? Please tick all boxes that apply.

☒Novelty

☐Originality

☒Individual character

☐Non-obviousness

☐Inventive step

☐Aesthetic

☐Ornamental

☐Other, namely ………………

**Question 19.**
a) Should prior art be used to assess requirements for protection of a design with respect to infringement proceedings or other legal situations not addressed by Q17) or Q18)? Please answer YES or NO.

*NO.*

If you have answered YES to Q19.a), please proceed to answer Q19.b). Otherwise, please proceed to Q20).

b) Referring to Q19.a), for which requirements for protection of a design should prior art be used? Please tick all boxes that apply.

☐Novelty

☐Originality

☐Individual character

☐Non-obviousness

☐Inventive step

☐Aesthetic

☐Ornamental

☐Other, namely ………………

c) Referring to Q19.b), please indicate in which context these requirements for protection should be taken into consideration, e.g., before a judge in infringement proceedings or other legal situations not addressed by Q17) and Q1.

**QUESTIONS 20 – 25.**

**III Proposals for harmonisation**

Criteria of prior art

**Question 20.**

a) What should recognized means of disclosure be, i.e., which materials/documents, etc., can constitute prior art?

*Recognized means of disclosure of prior art should not be limited to specific forms, ways or methods of disclosure save for description in words.*

b) Should the prior art have to be “printed” and if so, what should that mean?

*No. A “printed” criterion would not be adequate as the majority of all new designs are disclosed digitally through e.g., online blogs, online advertising and social media. Additionally, the national Danish Design Gazette is no longer published in print.*

c) Should the prior art have to be “published” and if so, what should that mean?

*Yes, but depending on the definition of “publication”.*

*There is no uniform definition of “publication” in IP law.*

*Publication as defined in copyright, inter alia the Berne Convention, does not seem fit for design law.*

*Publication should reflect the terminology “disclosure” as used for example in the Common Practice Criteria for assessing Disclosure of Designs on the Internet (used in conjunction with “publication” in said Common Practice) and Section 5 of the DKDA. “Disclosure” seems, however, to be used as a broader term than “publication”.*

*Since for design law there are inter-alia no country-of-origin considerations similar to in copyright and under the Berne Convention, there might not be need for an independent “publication” criterion in design law, as “disclosure” as defined above, could suffice. Designs which have never made it beyond the drawing board should not be considered published or disclosed.*

Time of disclosure

**Question 21.**

What should the relevant date of a prior art reference be?

*The date of disclosure.*

Circumstances of disclosure

**Question 22.**

What, if any, circumstances of disclosure should be relevant? Please tick all boxes that apply.

☒ geographic location

☒ type of location (e.g., during an exhibition)

☒ sector/type of products

☒ the person disclosing the prior art (e.g., the applicant of a design, a person

bound by a confidential agreement, etc.)

☒ the recipient of the disclosed prior art

☒ other, namely: Consider if the number of persons exposed to disclosure is relevant, e.g. on Facebook

Grace period

**Question 23.**

a) Should there be a grace period after a public disclosure of a design for later filing for protection of such design?

Please answer YES or NO.

 *Yes.*

b) If the answer to Q23.a) is YES, please identify what the length of time for the grace period should be. Also, please explain what the conditions allowing for the benefit of the grace period should be (e.g., formal request, same applicant).

*12 months which is identical to the length of the grace period under the current state of law regarding the registrability of new designs, cf. Section 6 of the DKDA and the answer to question 10 above.*

*The conditions for allowing such a grace period are set out in Section 6 of the DKDA.*

Other

**Question 24.**

Should there be any other relevant criteria of prior art?

*Prior art should always be required to meet the requirements for novelty and individual character.*

*We see no need for introducing any additional criteria.*

**Question 25.**

Should the assessment of prior art differ for the different requirements for protection mentioned in Q17) b), Q18) b) and Q19) b)?

*No. It would not be advisable to differ the assessment of prior art in relation to the different requirements for protection.*

**QUESTIONS 26 – 29.**

**The use of prior art when assessing the requirements for protection of a design**

**Question 26.**

a) Should one single prior art reference have to disclose all features of a design in order to prevent its validity?

*Novelty*

*The requirement of novelty should be fairly easy for a design to fulfill given that a design must pass a two-step test where the second limb, i.e., individual character, is stricter than the novelty requirement. Hence, the novelty requirement should be used to disqualify only the designs where one or more prior art individually discloses all features of a design, unless that design differs in details which are so minor that it would take a thorough comparison to notice those differences. However, when assessing novelty, the unprotectable parts of the design should be disregarded, e.g., designs solely dictated by function.*

*Individual Character*

*Individual character of a design in effect sets the threshold for protection. A ‘different overall impression’ should be given a broad interpretation so that differences that are easily perceptible for the eye are enough to establish individual character.*

*In conclusion, one single prior art reference should disclose all protectable features that are easily perceptible for the informed user.*

b) Should a prior art reference that differs only in minor details from a design prevent finding validity? If YES, please indicate what should only in minor details mean (is it, e.g., in a non-substantive way)?

*Please refer to answer 26(a).*

c) Should a prior art reference that discloses the entire design with additional features prevent finding validity?

*Yes. If not, there is a risk of free-riding, given that it would be possible to take any given design and merely add enough features to establish validity.*

d) Should it be possible to contest the validity of a design on the ground of a combination of prior art references disclosing the features of a design? If YES, should there be a limit to the number of prior art references that can be combined?

*No. Most, if not all, designers stand on the shoulders of giants. Almost all design progress builds on a foundation provided by earlier designers. Hence, the vast majority of designs could be invalidated under a principle allowing the combination of prior art.*

*However, there should be a safety valve regarding iconic designs. Hence, it should not be possible to combine a few iconic designs by cherry picking and combine the most dominant and distinguished features of those designs. Such a rule should, however, be applied as a narrow exception and must therefore not lead to a general mosaic approach*.

e) Should the assessment of validity differ where there is numerous prior art or very few prior art available?

*No. Given that the relevant features must be disclosed in one or more prior art individually, such a rule does not seem appropriate. In other words, there is a risk that such a rule could let a principle of combining prior art in the validity assessment through the backdoor. However, this should not be mistaken for the possibility that the designer’s creative freedom can be de facto limited due to a dense design corpus.*

f) Should the assessment of validity differ with respect to designs for different industry sectors (e.g., textile design vs. GUI design)?

*No. If a design’s protection depends on which specific sector it belongs to, it is the same as limiting the scope of the design right according to the product in which the design is incorporated. This would push the door wide open to free-riding, e.g., a car design incorporated in a toy car or a bed frame.*

**The influence of prior art on the infringement/scope of protection of a design**

**Question 27.**

Should the assessment of infringement/scope of protection of a design differ where there is numerous prior art or very few prior art? Please refer to earlier response(s) where applicable.

*Please refer to answer 26(e).*

**Question 28.**

Please comment on any additional issues concerning any aspect of industrial designs and the role of prior art you consider relevant to this Study Question**.**

*The CJEU has persistently through its line of case-law established and harmonized the originality criterion under Article 2 of the Infosoc Directive[[6]](#footnote-6) (ISD) i.e., Infopag[[7]](#footnote-7), Painer[[8]](#footnote-8), and Cofemel[[9]](#footnote-9). Following those cases, the threshold for works of applied art and industrial designs to qualify for copyright protection is low. As long as the author has a minimal scope for creativity, then copyright protection can be established. Apparently, there is close to full overlap in the protection requirements given that distinguishing the concepts of the author’s free and creative choices under Article 2 ISD, and the designer’s creative freedom under Article 5(2) EUDD seems as a matter of terminology rather than reality. The reality is that applied art and industrial designs are protectable by copyright if there is scope for a few free and creative choices.[[10]](#footnote-10) Member States can no longer apply stricter protection requirements in order to protect works of applied art. Notwithstanding that a registered design offers the advantage of legal monopoly and proof of ownership through registration, it is our opinion that there is a real risk that the EU design scheme will be diluted, and in the light thereof, the protection requirements for a design should therefore be lower than that of copyright protection*.

**Question 29.**

Please indicate which industry sector views provided by in-house counsel are included in your Group's answers to Part III.

1. Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs [1998] OJ L 289 [↑](#footnote-ref-1)
2. ” European Union Design Law – A Practitioners’ Guide, second edition” af David Stone, side 164. [↑](#footnote-ref-2)
3. http://iprights.dkpto.org/design/the-design-database-desdoc/publication.aspx [↑](#footnote-ref-3)
4. http://iprights.dkpto.org/design/the-unregistered-and-registered-community-design-(rcd).aspx [↑](#footnote-ref-4)
5. http://iprights.dkpto.org/design/how-to-protect-exploit-and-register-a-design.aspx#Publication%20and%20deferment%20of%20publication [↑](#footnote-ref-5)
6. Directive 2001/29 (EC) of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society [2001] OJ L 167/10. [↑](#footnote-ref-6)
7. Case C-5/08 Infopaq International A/S v Danske Dagblades Forening [2009] ECR I-6569. [↑](#footnote-ref-7)
8. Case C-145/10 Eva-Maria Painer v Standard Verlags GmbH [2011] ECR I-12533. [↑](#footnote-ref-8)
9. Case C-683/17 Cofemel — Sociedade de Vestuário SA v G-Star Raw CV ECLI:EU:C:2019:721. [↑](#footnote-ref-9)
10. See e.g., Annette Kur, ‘Unite´ de l’art is here to stay—Cofemel and its consequences’ [2020] JIPLP 290, 292f. [↑](#footnote-ref-10)