The weight of technical-functional features on the examination of industrial designs

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Authors

Ana Cristina Müller, D.Sc.

André de Moura Reis

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In Brazil, industrial designs have certain limitations to their protection, as defined by the IP Law. For instance, objects or patterns that are contrary to morals and good customs or that are contrary to the liberty of conscience or belief are not registrable as industrial designs. These are all fairly straightforward and not often applicable when examining industrial designs. However another exclusion from protection raises considerable concerns when users seek design protection – essentially technical or functional aspects contained on the design.

In this regard, the Brazilian IP Law defines on article 100 that:

"An industrial design is not registrable for:
I - that which is contrary to morals and good customs or which offends the honour or image of people or is contrary to the liberty of conscience, belief, religious cults or ideas and feelings worthy of respect and veneration.

II - the necessary common or ordinary shape of an object or, further, that which is determined essentially by technical or functional considerations."

Thus, there would be four types of exclusion as registered industrial designs defined on article 100 (II) of the IP Law – 1) necessary common shape; 2) ordinary shape; 3) essentially technical considerations; and 4) essentially functional considerations. Apart from these specific protection exclusions, all forms should be entitled to industrial design protection, provided the registrability requirements are duly met.

The necessary common shape could be understood as related to forms with appearance dictated by market norms, including those determined by standard institutes, such as ABNT, ASTM and ISO. Further, the ordinary shape represents the opposite of what a design must possess – novelty and originality[1]

As for the exclusion from registrability of designs based on essentially technical or functional features, the limitation would have taken place to differentiate the ornamental protection of the industrial design from entirely technical or functional sets of features protectable in the form of other industrial property assets. Particularly, only the subject matter essentially determined by technical or functional features should be excluded from design protection as this, in turn, would be protected as a patent (invention or utility model).

Most notably, the establishment of an essentiality regarding technical or functional aspects on a design implies that said registrability exclusions do not derive from their mere presence on the design. Instead, article 100 (II) of

the IP Law indicates a requirement to consider such technical or functional aspects in view of the configuration as a whole. Ultimately, if the ornamental features grant the design a distinctive overall aspect, even if it possesses technical/functional features, said design should not fall within the provisions of article 100 (II) of the IP Law.

This is of major importance as various objects share a technical functionality without necessarily departing from the protection of an industrial design, wherein a form containing technical or functional features could be registrable as an industrial design whenever it presents a distinctive ornamentability. In fact, many industrial designs correspond to commercial products that commonly require ergonomics, grip, comfort, among other features that have substantial effect on a product's market success or failure. Further, depending on the type of design for which protection is sought, the ornamental features may be limited to only certain parts of the object, wherein a design should be registrable whenever said ornamental features grant the object a distinctive overall aspect regardless of its volumetric proportion thereon. Surely, this distinctive aspect varies depending on the market segment to which the design is intended.

Exclusion to design protection based mainly/exclusively on technical/functional features is present in several jurisdictions, including Canada, Europe, Japan, United States and, as previously mentioned, Brazil. While some require sets of rules to assess the functionality of a design, or alternatively if it is primarily ornamental (which is the case in the United States[2]), others have more generic guidelines. The issue in Brazil deals with an improper applicability of article 100 (II) by Brazilian Examiners, which inadvertently limits the protection of a product/object as an industrial design.

Therefore, the Brazilian PTO generally applies a limited understanding on the applicability of technical/functional limitations regarding industrial designs. Particularly, the Brazilian Guidelines for industrial designs require that:

"5.4.2 Essentially technical or functional form
Many objects have, to a greater or lesser degree, both technical and ornamental characteristics. However, sometimes the plastic shape results more from the need for the product to function than from concerns related to appearance or visual aspect.
In these situations, even though there is a certain ornamental aspect in the shapes of the object, if these characteristics do not prevail over what is observed as technical or functional, the object cannot be registered as an industrial design.

The registration application that contains an object whose plastic form is essentially determined by technical or functional considerations will be rejected based on § 4 of art. 106 of the LPI, although the assessed configuration is new and original."

In these Guidelines, the Brazilian PTO further indicates the prevalence of technical or functional features as basis for rejecting an industrial design, although no specific procedure is established for such assessment. Accordingly, decisions based on impermissible functionality of industrial designs may vary depending on the Examiner responsible for the case. On some rejection decisions, Examiners may perform a patent search to indicate features that would be considered essentially technical/functional, in line

with examination procedures abroad, but that is not always the case for Brazilian design applications facing a functionality-based rejection.

Unfortunately, the proportion of rejected industrial design applications based on article 100 (II) is not published by the Brazilian PTO nor is its corresponding number of appeals. In any case, the percentage of reformed rejection decisions based on all appealed design applications varied from 25,5% (2018), 45,2% (2019), 39,3% (2020), 8,5% (2021) and 40,4% (2022), i.e., less than half of the rejection decisions issued by the Brazilian PTO were overruled at the appeal stage in the period of 2018-2022.

A new version of the Examination Guidelines for Industrial Designs is open for public consultation until December 07, 2022. Hopefully, aspects such as the presence of technical features and its weight on the registrability of designs will be addressed on its final text, so that the Brazilian PTO properly applies the wording of article 100 (II) in line with the users' needs and the best practices adopted abroad such as in Europe and the US, further stimulating a harmonization of the Examiners' interpretation of the Law and fostering creation and its protection.

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NOTES:

[1] Brazilian IP Law, Art. 97 "An industrial design is considered original when it results in a distinctive visual configuration in relation to other prior objects."

[2] "The proper evidentiary basis for a rejection under 35 U.S.C. 171 that a claim is lacking in ornamentality is an evaluation of the appearance of the design itself. The examiner's knowledge of the art, a reply to a letter of inquiry, a brochure emphasizing the functional/mechanical features of the design, the specification of an analogous utility patent (the applicant's or another inventor), or information provided in the specification may be used to supplement the analysis of the design. If a design is embodied in a specific mechanical article, the analysis that the design lacks ornamentality because its appearance is dictated by functional requirements should be supported by reference to utility patents or some other source of information about the function of the design." (Emphasis added) USPTO, Manual of Patent Examining Procedure, Chapter 1500 – Design Patents, 1504.01(c) – Lack of Ornamentality.

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Ana Cristina Müller, D.Sc.

André de Moura Reis