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Guidelines on Substantive Examination of Design Applications



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SUMMARY

This document proposes chapters of Russian Guidelines on Examination of Design Applications related to substantive matters (novelty and individual character; informed user; degree of freedom of a designer; disclosure of prior designs, design corpus; exclusion from protection for features solely dictated by technical function; interpretation of graphical representation of designs, essential features) elaborated by Ms Natalie Pasinato, OHIM's expert.

The contents of this document do not necessarily reflect the position or opinion of the European Union.

GUIDELINES ON SUBSTANTIVE EXAMINATION OF DESIGN APPLICATIONS (ARTICLE 1391, CIVIL CODE OF THE RUSSIAN FEDERATION)

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I. NOVELTY AND INDIVIDUAL CHARACTER

1. Disclosure of prior design

Refusing a design applied for on account of its lack of novelty or of individual character requires evidence that an earlier design which is identical or which produces a similar overall impression has been made available to the public before the date of filing the application for registration or, if a priority is claimed, the date of priority (Article 1352, paragraphs 2 and 3, Civil Code of the Russian Federation).

The public in question is made up of the members of the circles specialised in the sector concerned, operating within the territory.

The term *circles specialised in the sector concerned* is not limited to persons that are involved in creating designs and developing or manufacturing products based on those designs within the sector concerned.

There are, generally speaking, no restrictions relating to the nature of the activity of natural or legal persons who may be considered to form part of the *circles specialised in the sector concerned*. Consequently, traders may also form part of the 'specialised circles' (see, by way of analogy, judgment of 13/02/2014, C-479/12, 'gazebo', para. 27).

A 'design' means the essential features of the whole or a part of a product determined by the aesthetic characteristics of the outward appearance, in particular, shape, configuration, ornament, combination of colours, lines, outlines of a product, texture or structure of the material of which a product is made (see Article 1352, paragraph 1, Civil Code of the Russian Federation). Whether or not an earlier 'design' enjoys legal protection (as a design, as a trade mark, as a copyrighted work, as a utility model or otherwise) is immaterial.

There must be evidence of disclosure.

It is assumed that a design which has been made available to the public anywhere in the world and at any point in time, as a result of publication following registration or otherwise, exhibition, use in trade or otherwise, has been disclosed. When determining novelty and individual character of a design applied for, all applications for inventions, utility models, designs and applications for trade marks, service marks filed in the Russian Federation by other persons, provided they have an earlier priority and documents relating to the above-mentioned rights are accessible to the public will also be taken into accounts (see Article 1352, paragraph 4, Civil Code of the Russian Federation).

However, acts of disclosure of an earlier design will not be taken into consideration where the applicant submits convincing facts, evidence and arguments in support of the view that these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the territory (decision of 22/03/2012, R 1482/2009-3 – 'Insulation blocks', para. 38).

2. Official publications

Publication of an earlier design in the bulletin of any industrial property office worldwide constitutes disclosure and it is only ('except') where this publication cannot reasonably become known to the professionals of the sector concerned within the territory that this rule is affected by an exception. Therefore, once there is a proof of publication, disclosure is assumed to have taken place and, considering the globalisation of the markets, it is incumbent on the applicant to provide facts, arguments or evidence to the contrary, namely that publication of the earlier design could not reasonably have become known to the circles specialised in the sector concerned, operating within the territory (decision of 27/10/2009, R 1267/2008-3 – 'Watches', para. 35 et seq; decision of 07/07/2008, R 1516/2007-3 – 'Cans', para. 9).

Publications in trademark and patent bulletins could equally have become known in the normal course of business to the circles in the sector concerned operating within the territory. Therefore, where the appearance of a product has been applied for and published as a trademark, it is to be considered as a disclosure of a 'design' (judgment of 16/12/2010, T-513/09, 'Seated figure', para. 20). The same applies where the representations contained in a patent application show the appearance of an industrial or handicraft item (decision of 22/03/2010, R 417/2009-3 – 'Drinking straws', para. 21). However, the presence of a document kept by a patent and trade mark office, which is available to the public only by means of an application for inspection of files, cannot be considered to have become known in the normal course of business to the specialised circles in the sector concerned and therefore does not prove the disclosure of a prior design (decision of 22/03/2012, R 1482/2009-3 – 'Insulation blocks', paras. 39, 43; decision of 15/04/2013, R 442/2011-3 – 'Skirting Boards', para. 26).

In order to substantiate the disclosure, a registration certificate must specify the date of publication independently of the date of filing or the date of registration. The publication in the Official Bulletin of a national Patent Office must be considered as having been disclosed and made available to the public (judgment of 07/11/2013, T-666/11, 'feline', para. 25). Whether or not the publication takes place before or after registration is irrelevant (decision of 15/04/2013, R 442/2011-3 – 'Skirting Boards', para. 24).

Moreover, it is enough that the date of publication can be identified by the mention of an INID code ('Internationally agreed Numbers for the Identification of (bibliographic) Data' as standardised by WIPO Standard ST.9).

3. Exhibitions and use in trade

Disclosure of a design applied for at an international exhibition anywhere in the world is an event which may become known in the normal course of business to the circles in the sector concerned, operating within the territory, except where evidence to the contrary is provided (decision of 26/03/2010, R 9/2008-3 – 'Footwear', para. 73-82; decision of 01/06/2012, R 1622/2010-3 – 'Lamps', para. 24). The question whether events taking place outside the

territory could reasonably have become known to persons forming part of those circles is a question of fact. The answer to that question has to be assessed by the examiner on the basis of the particular circumstances of each individual case (judgment of 13/02/2014, C-479/12, 'gazebo', para. 34).

Use in trade is another example as a means for disclosure of a design, irrespective of whether this use is made within or outside the territory (decision of 26/03/2010, R 9/2008-3 – 'Footwear', para. 63-71).

Disclosure of a design applied for can be the result of use in trade even where there is no proof on file that the products in which the earlier design is incorporated have actually been put on the market in the territory. It suffices that the goods have been offered for sale in distributed catalogues (decision of 22/10/2007, R 1401/2006-3 – 'Ornamentation', para. 25) or imported from a third country to the territory (judgment of 14/06/2011, T-68/10, 'Watch attached to a lanyard', para. 31-32) or have been the object of an act of purchase between two Russian operators (judgment of 09/03/2012, T-450/08, 'Bottle', para. 30-45).

As regards the submission of catalogues, their evidential value does not depend on their being distributed to the public at large. Catalogues which are made available to professionals can also be a valid means of evidence, bearing in mind that the relevant public for assessing disclosure is the 'circles specialised in the sector concerned'.

The extent of, or the circumstances surrounding the distribution of the catalogues can be relevant factors (judgment of 13/02/2014, C-479/12, 'gazebo', para. 35-36). However, what matters is whether professionals operating on the territory in the sector concerned, taken as a whole, have had a reasonable opportunity to have access to the design irrespective of the actual number of these professionals who seized this opportunity and were eventually confronted with the disclosed design.

It is enough that the disclosure took place at a point in time which can be identified with reasonable certainty prior to the filing date or priority date of the design applied for even if the exact date of disclosure is unknown (judgment of 14/06/2011, T-68/10, 'Watch attached to a lanyard', para. 31-32).

4. Disclosures derived from the internet

As a matter of principle, disclosures derived from the internet form part of the prior art. Information disclosed on the internet or in online databases is considered to be publicly available as of the date the information was posted. Internet websites often contain highly relevant information. Certain information may even be available only on the internet from such websites. This includes, for example, online publications of design registrations by industrial property offices.

The nature of the internet can make it difficult to establish the actual date on which information was in fact made available to the public. For instance, not all web pages mention when they were published. In addition, websites are easily updated, yet most do not provide

any archive of previously displayed material, nor do they display records which enable members of the public to establish precisely what was published and when.

In this context, the date of disclosure on the internet will be considered reliable in particular where:

- the website provides timestamp information relating to the history of modifications applied to a file or web page (for example, as available for Wikipedia or as automatically appended to content, such as forum messages and blogs); or
- indexing dates are given to the web page by search engines (for example from the Google cache); or
- a screenshot of a webpage bears a given date; or
- information relating to the updates of a web page is available from an internet archiving service.

Neither restricting access to a limited circle of people (for example, by password protection) nor requiring payment for access (analogous to purchasing a book or subscribing to a journal) prevent a web page from forming part of the state of the art. It is sufficient if the web page is available without any bar of confidentiality and the accessibility requirements can reasonably be met by professionals of the circles concerned in the territory.

5. Insufficient disclosure

The issue of the disclosure of a prior design is preliminary to that of whether two designs produce the same overall impression on the informed user. If the prior design has not been made available to the public or it has been made so but in an inconsistent manner, then there is sufficient reason for accepting the design application.

The examiner will carry out an overall assessment of such evidence by taking account of all the relevant factors in the particular case. Disclosure cannot be proven by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient disclosure of the earlier design (judgment of 09/03/2012, T-450/08, 'Bottle', para. 21-24).

A global examination of the items of evidence implies that these items must be assessed in the light of each other. Even if some items of evidence are not conclusive of disclosure in themselves, they may contribute to establishing the disclosure when examined in combination with other items (judgment of 09/03/2012, T-450/08, 'Bottle', para. 25 and 30-45).

Where the representation of the prior design fails to adequately represent it, thereby rendering any comparison with the design applied for impossible, this does not amount to disclosure (decision of 10/03/2008, 'Barbecues', R 586/2007-3, para. 22 et seq.).

6. Disclosure within the priority period

An application for a design may claim the priority of one or more previous applications for the same design or utility model in or for any State party to the Paris Convention. The right of priority is six months from the date of filing of the first application.

The effect of the right of priority shall be that the date of priority will count as the date of filing of the application for a design.

A priority claim relating to the 'same design or utility model' requires identity with the corresponding design without addition or suppression of features. A priority claim is however valid if the design and the previous application for a design right or a utility model differ only in immaterial details.

When examining an application for a design, the examiner verifies whether this application concerns the 'same design or utility model' whose priority is claimed.

7. Disclosure within the twelve-month period

Article 1352, paragraph 4, Civil Code of the Russian Federation, provides for a 'grace period' of 12 months preceding the date of filing or the priority date of the design applied for. Disclosure of information relating to a design applied for by its author, applicant or other person having received this information directly or indirectly from them (in particular in consequence of exhibiting a design) and the information of which relates to the essence of the design applied for, shall not be a circumstance that prevents the possibility of seeking registration of a design, if an application is filed within the twelve-month period from the date of the first disclosure to the public. The burden of proof relating to the circumstances of the disclosure is on the applicant.

As a matter of principle, the applicant must establish that it is either the creator of the design upon which the application is based or the successor in title to that creator (judgment of 14/06/2011, T 68/10, 'Watch attached to a lanyard', para. 26 29).

8. Assessment of novelty and individual character

A design applied for will be protected as a design to the extent that it is new and has individual character. The novelty and individual character of a design must be examined on its date of filing or, as the case may be, on its date of priority, in the light of the relevant prior art. The relevant prior art is made up of the earlier designs and their relevant disclosure.

a. Common principles

The design applied for must be compared with each and every earlier design relied on individually. Novelty and individual character of a design applied for can be defeated by combining features taken in isolation and drawn from a number of earlier designs.

As a matter of principle, all the features of a design applied for must be taken into consideration when examining its novelty and individual character. There are, however, a number of exceptions to this general principle.

b. Features dictated by a function and features of interconnection

Features which are solely dictated by a technical function cannot contribute to the novelty and individual character of a design applied for. Such features must therefore be disregarded when comparing the design with the relevant prior art (see Article 1352, paragraph 1, Civil Code of the Russian Federation).

c. The visibility requirement

Features of a design applied to, or incorporated in a 'component part of a complex product', will be disregarded if they are invisible during normal use of the complex product in question.

'Complex product' means a product which is composed of multiple components which can be replaced, permitting disassembly and re-assembly of the product. For instance, the visibility requirement does not apply to a design representing the appearance of a garbage container as a whole since garbage containers may be complex products as such, but not component parts of complex products (decision of 23/06/2008 (ICD 4919)).

'Normal use' means use by the end user, excluding maintenance, servicing or repair work. 'Normal use' is the use made in accordance with the purpose for which the complex product is intended.

For instance, for safety reasons, an electrical connector is a component part which is normally incorporated in a casing in order to be shielded from any contact with potential users when a complex product, such as a train or electric vehicle, is in operation. The fact that such a component part of a complex product can theoretically be made visible when inserted in a transparent casing or cover constitutes a purely hypothetical and random criterion which must be disregarded (decision of 03/08/2009, R 1052/2008-3 – 'Electrical contactors', paras 42-53).

Where none of the features of a design applied to a component part (for example, a sealing ring) is visible during normal use of the complex product (for example, a heat pump system), this design applied for will be refused as a whole (decisions of 10/09/2013, R 293/2012-3 and R 688/2012-3 – 'Heat exchanger inserts')

However, there is no requirement that a component part has to be clearly visible in its entirety at every moment of the use of the complex product. It is sufficient if the whole of the component can be seen some of the time in such a way that all its essential features can be apprehended (decision of 22/10/2009, R 0690/2007-3 – 'Chaff cutters', para. 21).

Where the features of a design applied to a component part (for example, an internal combustion engine) are only partially visible during normal use of the complex product (for

example, a lawnmower), the comparison with the relevant prior art must be limited to the visible parts. 'During the normal use of a lawnmower, it is placed on the ground and the user stands behind the lawnmower. Thus, the user, standing behind the lawnmower sees the engine from the top and therefore sees principally the upper side of the engine. It follows that the upper side of the engine determines the overall impression produced by the engine' (judgment of 09/09/2011, T-10/08, 'Engine', para. 20-22).

d. Clearly discernible features

Features of the design applied for, which are not clearly discernible in its graphical representation cannot contribute to its novelty or its individual character (Directive 98/71/EC of the European Parliament and the Council of 13 October 1998 on the legal protection of designs, Recital 11). Likewise, features of the prior design which are not of a sufficient quality allowing all the details to be discerned in the representation of the prior design cannot be taken in consideration (decision of 10/03/2008, R 586/2007-3, 'Barbecues', para. 23-26).

Features of a prior design can be supplemented by additional features which were made available to the public in different ways, for instance, first, by the publication of a registration and, second, by the presentation to the public of a product incorporating the registered design in catalogues. These representations must however relate to one and the same earlier design (judgment of 22/06/2010, T-153/08, 'Communication equipment', para. 25-30).

e. Disclaimed features

Features of a design which are disclaimed are disregarded for the purposes of comparing the designs. This applies to the features of a design represented with dotted lines, boundaries or colouring or in any other manner making clear that protection is not sought in respect of such features (judgment of 14/06/2011, T-68/10, 'Watch attached to a lanyard', para. 59-64).

9. Novelty

A design application will be considered to be new if it is not predated by an identical design disclosed at a prior date. Designs shall be deemed to be new if the sum of its essential features representing the outward appearance of the product is not known from information generally available in the world before the priority date or the filing date of the design applied for (see Article 1352, paragraph 2, Civil Code of the Russian Federation). Consequently, designs shall be deemed to be identical if their features differ only in immaterial details.

There is identity between the design applied for and an earlier design where the latter discloses each and every element constituting the former. The framework of the comparison is limited to the features making up the design applied for. It is therefore irrelevant whether the earlier design discloses additional features. A design applied for cannot be new if it is included in a more complex earlier design (decision of 25/10/11, R 978/2010-3 – 'Part of a sanitary napkin', para. 20-21).

However, the additional or differentiating features of the design applied for may be relevant to decide whether this design is new, unless such elements are so insignificant that they may pass unnoticed.

An example of an immaterial detail is a slight variation in the shade of the colour pattern of the compared designs (decision of 28/07/09, R 0921/2008-3 – ‘Nail files’, para. 25). Another example is the display, in one of the two compared designs, of a label which is so small in size that it is not perceived as a relevant feature (decision of 08/11/2006, R 0216/2005-3 – ‘Cafetera’, para. 23-26).

10. Individual character

A design application will be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the date of filing the application for registration or, if a priority is claimed, the date of priority. A design applied for shall be deemed to be original if its essential features are determined by the creative nature of the special aspects of the product and its outward appearance (see Article 1352, paragraph 3, Civil Code of the Russian Federation).

The dissimilar or similar impression produced in the informed user can be defined as the absence or presence of a ‘déjà vu’ (see, by analogy, judgment of 7/11/2013, T-666/11, ‘Gatto domestico’, para. 29).

In assessing individual character, the degree of freedom of the designer in developing the design will be taken into consideration.

a. The informed user

The status of ‘user’ implies that the person concerned uses the product in which the design is incorporated, in accordance with the purpose for which that product is intended (judgment of 22/06/2010, T-153/08, ‘Communications equipment’, para. 46; judgment of 09/09/2011, T-10/08, ‘Internal combustion engine’, para. 24; judgment of 06/06/2013, T-68/11, ‘Watch dials’, para. 58).

The concept of ‘informed user’ lies somewhere between that of the average consumer, applicable in trade mark matters, who need not have any specific knowledge, and the sectorial expert, who is an expert with detailed technical expertise. Without being a designer or a technical expert (and therefore without necessarily knowing which aspects of the product concerned are dictated by technical function, (as found in judgment of 22/06/2010, T-153/08, ‘Communication equipment’, para. 48) informed users are aware of the various designs which exist in the sector concerned, they possess a certain degree of knowledge with regard to the features which those designs normally include, and, as a result of their interest in the products concerned, they show a relatively high degree of attention when they use them (judgment of 20/10/2011, C-281/10 P, ‘Representation of a circular promotional item’, para. 53 and 59; judgment of 22/06/2010, T-153/08, ‘Communications equipment’,

para. 47; judgment of 20/10/2011, C-281/10 P, 'Metal rappers', para. 59; judgment of 06/06/2013, T-68/11, 'Watch dials', para. 59).

In other words, the informed user is neither a designer nor a technical expert. Therefore, an informed user is a person having some awareness of the existing designs in the sector concerned, without necessarily knowing which aspects of that product are dictated by technical function.

The informed user is neither a manufacturer nor a seller of the products in which the designs at issue are intended to be incorporated (judgment of 09/09/2011, T-10/08, 'Engine', para. 25-27).

However, depending on the nature of the product in which the design applied for is incorporated, the concept of informed user may include, firstly, a professional who acquires such products in order to distribute them to the final users and, secondly, those final users themselves (judgment of 20/10/2011, C-281/10 P, 'Representation of a circular promotional item', para. 54). The fact that one of the two groups of informed users perceives the designs at issue as producing the same overall impression is sufficient for a finding that the design applied for lacks individual character (judgment of 14/06/2011, T-68/10, 'Watch attached to a lanyard', para. 56).

When the nature of the product in which the compared designs are incorporated makes it possible, the overall impression left by these designs will be assessed on the assumption that the informed user can make a direct comparison between them (judgment of 18/10/2012, joint cases C-101/11P and C-102/11P, 'Lutins', paras. 54 and 55).

b. The overall impression

Unless the compared designs include functional or invisible or disclaimed features, the two designs must be compared globally. That does not mean, however, that the same weight should be given to all the features of the compared designs.

First, the informed user uses the product in which the design is incorporated, in accordance with the purpose for which that product is intended. The relative weight to give to the features of the compared designs may therefore depend on how that product is used. In particular, the role played by some features may be less important depending on their reduced visibility when the product is in use (judgment of 22/06/2010, T-153/08, 'Communication equipment', para. 64-66 and 72; judgment of 21/11/2013, T-337/12, 'corkscrew', Paras 45-46; judgment of 04/02/2014, T-339/12, 'Armchairs', para. 30; judgment of 04/02/2014, T-357/12, 'Armchairs', para. 57).

Second, when appraising the overall impression caused by two designs, the informed user will only give minor importance to features that are totally banal and common to the type of product in issue and will concentrate on features that are arbitrary or different from the norm (judgment of 18/03/2010, T-9/07, 'Representation of a circular promotional item', para. 77; decision of 28/11/06, R 1310/2005-3 – 'Galletas', para. 13; decision of 30/07/2009, R 1734/2008-3 – 'Forks', para. 26 et seq.).

Third, similarities affecting features in respect of which the designer enjoyed a limited degree of freedom will have only minor importance in the overall impression produced by those

designs on the informed user (judgment of 18/03/2010, T-9/07, 'Representation of a circular promotional item', para. 72).

Fourth, when familiar with a saturation of the state of the art due to the density of the existing design corpus, the informed user may be more sensitive to even minor differences between the designs, which thus may produce a different overall impression (judgement of 13/11/2012, T-83/11 and T-84/11, 'Radiator I', para. 81; judgement of 12/03/2014, T-315/12, 'Radiator II', para. 87). In order to prove an actual impact of such saturation on the informed user's perception, there must be sufficient evidence of the existing design corpus and its density at the date of filing of the design applied for or its priority date (decision of 10/10/2014, R1272/2013-3 – 'Radiator II', para. 36, 47; decision of 09/12/2014, R1643/2014-3, para. 51).

c. The degree of freedom of the designer

The designer's degree of freedom depends on the nature and intended purpose of the product in which the design will be incorporated, as well as on the industrial sector to which this product belongs. The examiner will take into account the indication of the products in which the design is intended to be incorporated or to which it is intended to be applied, but also, where necessary, the design itself, in so far as it makes clear the nature of the product, its intended purpose or its function (judgment of 18/03/2010, T-9/07, 'Representation of a circular promotional item', para. 56).

The designer's degree of freedom in developing its design is established, inter alia, by the constraints of the features imposed by the technical function of the product or an element thereof, or by statutory requirements applicable to the product. Those constraints result in a standardisation of certain features, which will thus be common to the designs applied to the product concerned (judgement of 13/11/2012, T-83/11 and T-84/11, 'Radiator I', para. 44).

The greater the designer's freedom in developing the design applied for, the less likely it is that minor differences between the designs at issue will be sufficient to produce a different overall impression on an informed user. Conversely, the more the designer's freedom in developing the design applied for is restricted, the more likely minor differences between the designs at issue will be sufficient to produce a different overall impression on the informed user (judgment of 18/03/2010, T-9/07, 'Representation of a circular promotional item', para. 67 and 72). Therefore, if the designer enjoys a high degree of freedom in developing a design, that reinforces the conclusion that the designs which do not have significant differences produce the same overall impression on an informed user (judgment of 09/09/2011, T-10/08, 'Engine', para. 33).

The fact that the intended purpose of a given product requires the presence of certain features may not imply a restricted degree of freedom of the designer where there is evidence that there are possibilities of variations in the positioning of such features and in the general appearance of the product itself (judgment of 14/06/2011, T-68/10, 'Watch attached to a lanyard', para. 69; judgment of 06/10/2011, T-246/10, 'Brake', para. 21-22; judgment of 09/09/2011, T-10/08, 'Engine', para. 37).

The degree of freedom of the design is not affected by the fact that similar designs co-exist on the market and form a 'general trend' or co-exist on the registers of Industrial Property

Offices (judgment of 22/06/2010, T-153/08, 'Communications Equipment', para. 58; decision of 01/06/2012, R 0089/2011-3 – 'Corkscrews', para. 27).

II. TECHNICAL FUNCTION

1. Rationale

Article 1352, paragraph 5, point 1, Civil Code of the Russian Federation denies protection to those features of a product's appearance that were chosen exclusively for the purpose of allowing a product to perform its function, as opposed to features that were chosen, at least to some degree, for the purpose of enhancing the product's visual appearance' (decision of 22/10/2009, R 690/2007-3 – 'Chaff cutters', para. 35 et seq.).

The fact that a particular feature of a product's appearance is denied protection by law does not mean that the whole design applied for must be refused registration. The design applied for as a whole will be refused only if *all the essential features* of the appearance of the product in question were solely dictated by its technical function (decision of 29/04/2010, R 211/2008-3 – 'Fluid distribution equipment', para. 36).

2. Examination

In order to determine whether the essential features of the appearance of the product into which the design applied for will be incorporated are solely dictated by the technical function of the product, it is first necessary to determine what the technical function of that product is. The relevant indication in the application for registration of the design should be taken into account, but also, where necessary, the design itself, in so far as it makes clear the nature of the product, its intended purpose or its function (judgment of 18/03/2010, T-9/07, 'Representation of a circular promotional item', para. 56).

Technical functionality must be assessed objectively, not in the perception of the informed user who may have limited knowledge of technical matters.

The technical functionality of the features of a design applied for may be assessed, inter alia, by taking account of the documents relating to patents describing the functional elements of the shape concerned.

Depending on the case, and in particular in view of its degree of difficulty, the examiner may make recourse of an expert.

3. Alternative shapes

The law does not require that a given feature must be the only means by which the product's technical function can be achieved. The law applies where the need to achieve the product's technical function was the only relevant factor when the feature in question was selected (decision of 22/10/2009, R 690/2007-3 – 'Chaff cutters', para. 31-32; decision of 10/06/2013, R 2466/2011-3 – 'Blades', para. 15-16).

The examination of the law must be carried out by analysing the design applied for, and not designs consisting of other shapes.

III. DESIGNS OF INTERCONNECTIONS

Features of a design applied for are excluded from protection if they must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to, or placed in, around or against another product so that either product may perform its function. If the law applies to all the essential features of the design applied for, the latter must be refused registration.

IV. EARLIER TRADE MARK OR SERVICE MARK

A design application will be refused if a trade mark or a service mark is used in a subsequent design, and the law set out in the Civil Code of the Russian Federation confers such a right to a distinctive sign (see Article 1483, Civil Code of the Russian Federation).

1. Distinctive sign

The notion of 'distinctive sign' encompasses registered trade marks as well as non-registered trade marks and other signs used in the course of trade (see in particular Article 1483, paragraphs 4, 5, 7, 8 and 9, Civil Code of the Russian Federation)

a. Introduction

When assessing which kind of intellectual property rights can be invoked under the Civil Code of the Russian Federation and which cannot, a standard must apply. The distinction follows from the Civil Code of the Russian Federation and, in particular, from the differentiation made between the kinds of earlier signs upon which a refusal may be based and the types of further rights that may constitute a basis for refusal.

Therefore, although the signs covered by Article 1483, Civil Code of the Russian Federation, fall within the broad category of 'industrial property rights', not all industrial property rights may be 'signs' for the purposes of Article 1483, Civil Code of the Russian Federation.

The types of rights falling under Article 1483, Civil Code of the Russian Federation are:

- trade marks
- service marks
- non-registered trade marks; and
- other signs used in the course of trade which may cover:

business identifiers such as:

- trade names;
- corporate names;
- establishment names;
- titles of publications or similar works;
- geographical indications.

Most business identifiers falling within the category of earlier rights will be non-registered signs. However, the fact that a sign is also registered does not bar it from being used as a ground for refusal.

In relation to trade marks and service marks reference is made to the Guidelines on trade marks, and in particular to the sections referring to likelihood of confusion and likelihood of association and reputation. As concerns non-registered signs reference is made to Article 1483, paragraph 6, letter 2, Civil Code of the Russian Federation.

b. Non-registered trade marks

Non-registered use-based trade marks are signs that indicate the commercial origin of a product or service. Therefore, they are signs which function as a trade mark.

c. Other business identifiers

Other signs used in the course of trade are a broad category that are enumerated in Article 1483, paragraphs 4, 5, 7, 8 and 9, Civil Code of the Russian Federation. In order for such signs to be used as a ground for refusal, they must have an identifying function, that is, they must primarily serve to identify in trade a business (business identifiers) or a geographical origin (geographical indications).

d. Trade names

Trade names are the names used to identify businesses, as distinguished from trade marks which identify goods or services as produced or marketed by a particular undertaking.

A trade name is not necessarily identical with the corporate name or commercial name entered in a commercial or similar register as trade names can cover other non-registered names such as a sign which identifies and distinguishes a certain establishment.

Pursuant to Article 8 of the Paris Convention, trade names enjoy protection without any registration requirement.

e. Corporate names

A corporate name or company name is the official designation of an undertaking, in most cases registered.

f. Titles

Titles of magazines and other publications, or titles of similar categories of works such as films, television series, etc. fall under the Civil Code of the Russian Federation only if, under the applicable law, they are protected as business identifiers.

The title must have been used in the course of trade. This will normally require that the work to which the title relates must have been placed on the market. Where the title relates to a service (such as a television programme), that service must have been made available. However, there will be circumstances where pre-use advertising may be sufficient to create rights, and where such advertising will constitute 'use'. In all cases, the title must have been used as an indicator of the commercial origin of the goods and services in question.

g. Geographical indications

Geographical indications are used to designate the origin of goods as being from a particular region or locality (Article 1483, paragraph 5, Civil Code of the Russian Federation).

Depending on the context, as described below, the term 'protected geographical indication' (PGI) may cover terms such as 'designations of origin', 'appellations of origin' and equivalent terms, and is used in this context to refer to PGIs in general.

PGIs are protected in various ways, such as national law, EU law, international agreements, and cover various product areas (such as foodstuffs or handicrafts).

h. Use in the course of trade

A first requirement is that the sign must be used in the course of trade.

The notion of 'use in the course of trade' is not the same as 'genuine use' (judgment of 30/09/2010, T-534/08, 'Granuflex', paras 24-27). The aims and conditions connected with proof of genuine use of registered trade marks are different from those relating to proof of use in the course of trade. Therefore, use must be interpreted according to the particular type of right at issue.

The 'use of the sign in the course of trade' refers to the use of the sign 'in the course of a commercial activity with a view to economic advantage and not as a private matter' (judgments of 12/11/2002, C-206/01, 'Arsenal Football Club', para. 40; of 25/01/2007, C-48/05, 'Adam Opel', para. 18; of 11/09/2007, C-17/06, 'Céline', para. 17).

This would include deliveries made without charge may be taken into account in order to ascertain whether the requirement for use of the earlier right in the course of trade has been met, since those deliveries could have been made in the context of a commercial activity with a view to economic advantage, namely to acquire new outlets (judgment of 29/03/2011, C-96/09 P 'BUD', para. 152).

As far as the time of use of the sign is concerned it must be proven that use took place before the filing of the design application or the priority date if relevant (see judgment of 29/03/2011, C 96/09 P 'BUD', para. 166-168).

In the case of unregistered signs, the use must be continuous and uninterrupted until the filing of the design application, since otherwise there is no certainty that the rights in the unregistered sign have not lapsed.

A sign is used in the course of trade where that use occurs in the context of commercial activity with a view to economic advantage and not as a private matter.

Therefore, the examiner will carry out a search on the actual use of the sign.

2. Use in a subsequent design

The notion of 'use in a subsequent design' does not necessarily presuppose a full and detailed reproduction of the earlier distinctive sign in a subsequent design application. Even though the design applied for may lack certain features of the earlier distinctive sign or may have different additional features, this may constitute 'use' of that sign, particularly where the omitted or added features are of secondary importance and are unlikely to be noticed by the relevant public. It is enough that the design applied for and the earlier distinctive sign be similar (judgment of 12/05/2010, T 148/08, 'Instrument for writing', para. 50 52; judgment of 25/04/2013, T 55/12, 'Cleaning device', para. 23; decision of 09/08/11, R 1838/2010 3 – 'Instrument for writing', para. 43).

Where a design application includes a distinctive sign without any disclaimer making clear that protection is not sought in respect of such feature, it will be considered that the design applied for makes use of the earlier distinctive sign even if the latter is represented in only one of the views (decision of 18/09/07, R 137/2007 3 – 'Containers', para. 20).

3. Examination

The examiner will apply the principles established in the Civil Code of the Russian Federation and the Guidelines established by the Federal Executive Authority for Intellectual Property as concerns identity and likelihood of confusion applicable to the examination of trade mark applications (Article 1483, Civil Code of the Russian Federation).

For the purpose of applying these provisions, it will be assumed that the design applied for will be perceived by the relevant public as a sign capable of being used 'for' or 'in relation to' goods or services (judgment of 12/05/2010, T 148/08, 'Instrument for writing', para. 107; judgment of 25/04/2013, T 55/12, 'Cleaning device', para. 39 and 42).

As distinctive signs are protected in respect of certain goods or services, the examiner will examine in respect of which goods the design applied for is intended to be used (judgment of 12/05/2010, T 148/08, 'Instrument for writing', para. 108). For the purpose of determining

whether these goods and services are identical or similar, the examiner will take into account the indication of the products in which the design is intended to be incorporated or to which it is intended to be applied and also, where necessary, the design itself, in so far as it makes clear the nature of the product, its intended purpose or its function (judgment of 18/03/2010, T 9/07, 'Representation of a circular promotional item', para. 56; decision of 07/11/11, R 1148/2010 3 – 'Packaging', para. 34 37). The assessment of the similarity of the goods will be made on the basis of the principles of the established practice in relation to the examination of trade mark applications.

Where the design is intended to be incorporated in two-dimensional 'logos', the examiner will consider that such logos may be applied to an infinite range of products and services, including the products and services in respect of which the earlier distinctive sign is protected (decision of 03/05/07, R 609/2006 3 – 'logo MIDAS', para. 27).

V. REPRESENTATION OF THE DESIGN SUITABLE FOR REPRODUCTION

1. General requirements

The representation of the design shall consist of a graphic and/or photographic reproduction of the design, either in black and white or in colour.

Irrespective of the form used for filing the application (paper, e-filing, or fax), the design must be reproduced on a **neutral background** and **must not be retouched** with ink or correcting fluid.

It must be of a quality permitting all the details of the matter for which protection is sought to be clear.

The purpose of that requirement is to allow third parties to determine with accuracy all the details of the design for which protection is sought.

Drawings, photographs, computer-made representations or any other graphical representation are accepted provided they are suitable for reproduction, including on a registration certificate in paper format. 3D computer-animated design generating motion simulation is not accepted for that very reason. CD-ROMs and other data carriers are accepted.

2. Neutral background

The background in a view is considered neutral as long as the design shown in this view is clearly distinguishable from its environment without interference from any other object, accessory or decoration, whose inclusion in the representation could cast doubt on the protection sought (decision of 25/04/2012, R 2230/2011-3 – 'Webcams', paras 11-12).

In other words, the requirement of a neutral background neither demands a 'neutral' colour nor an 'empty' background. It is instead decisive that the design stands out so clearly from the background that it remains identifiable (decision of 25/01/2012, R 284/2011-3 – 'Tool chest', para. 13).

The views, among the seven allowed for representing a design, which do not have a neutral background will be objected to.

The examiner will issue a deficiency letter. The examiner will give the applicant the possibility to remedy the deficiencies within a three-month period by:

- withdrawing those views (which will not form part of the design); or
- by submitting new views on a neutral background; or
- by amending the objected views in such a way that the design will be isolated from its background. This latter option will make use of identifiers such as boundaries or colour shading clarifying the features of the design for which protection is sought.

3. Designs retouched with ink or correcting fluid

The design shall not be retouched with ink or correcting fluid. Therefore, where the use of ink or correcting fluid leaves doubt as to whether the visible correction is or not an ornamental feature forming part of the design, that corrected representations will be objected to and refused for the purpose of allocating a filing date. The applicant may remedy the deficiency.

4. Quality

The requirement that the design must be of a quality permitting all the details of the matter for which protection is sought to be clearly distinguished, for publication purposes, applies equally to all applications, irrespective of the means of filing.

Transmission by telecopy (fax) may not be appropriate for filing design applications, because the representation of the design may be distorted or blurred or otherwise damaged. Where an application is transmitted by fax, it is highly recommended that a paper confirmation copy be filed without delay, by ordinary mail, private delivery services or personal delivery.

Where an application is transmitted by fax, the examiner will in any event await a confirmation copy for a period of up to one month from the date of receipt of the fax transmission before further processing the application. Once this period has lapsed, the examiner will continue the examination on the basis of the documents on file.

5. Number of views

The purpose of the graphic representation is to disclose the features of the design for which protection is sought. The graphic representation must be self-contained, in order to determine with clarity and precision the subject-matter of the protection afforded by the design to its proprietor. This rule is dictated by the requirement of legal certainty.

It is the responsibility of the applicant to disclose as thoroughly as possible the features of its design. The examiner will not check whether additional views would be required to fully disclose the appearance of the design.

A maximum of seven different views can be filed in order to represent the design. The views may be plain or in perspective. Two copies of each view should be filed.

The alternative positions of the moveable or removable parts of a design can be shown in separate views.

6. Consistency of the views

The examiner will check whether the views relate to the same design, that is, to the appearance of one and the same product or of its parts.

Where the views are inconsistent and relate to more than one design, the applicant will be invited either to withdraw some views or to convert the application into a multiple application for different designs.

The consistency of the views may be particularly difficult to assess when examining applications for designs relating to complex products, to details of products and to sets of articles.

a. Complex products

A complex product is a product which is composed of multiple components which can be replaced permitting disassembly and re-assembly of the product.

Applicants must submit, among the seven views allowed, at least one view showing the complex product in its assembled form.

b. Details

The same reasoning applies to a design which is not intended to be incorporated in a complex product where the views only show individual details which cannot be related to the appearance of the product as a whole.

Each of the individual details of the product could in themselves be a 'design'. Therefore, where all the views disclose different detailed features, **without showing these features connected to each other**, the examiner will issue a deficiency letter.

c. Sets of articles

A set of articles is a group of products of the same kind which are generally regarded as belonging together and are so used.

The difference between a complex product and a set of articles is that, in contrast to a complex product, the articles of a 'set of articles' are not mechanically connected.

A set of articles can be a 'product' in itself. It can be represented in a single design application if the articles making up this set are linked by **aesthetic and functional complementarity** and are, in normal circumstances, sold altogether as one single product, like a chess board and its pieces or sets of knives, forks and spoons.

It must, however, be clear from the representation that protection is sought for a design resulting from the combination of the articles making up the set.

Applicants must submit, among the seven views allowed, at least one view showing the set of articles in its entirety.

d. Variations of a design

Sets of products should not be confused with variations of a design. The different embodiments of a same concept cannot be grouped in a single application because each embodiment is a design on its own.

e. Colours

The representation of the design may be submitted **either** in black and white (monochrome) **or** in colour.

Representations combining black and white views with colour views will be objected to due to their inconsistency and the resulting legal uncertainty as to the protection sought.

The same reasoning applies where the same features of a design are represented in different colours in the various views. Such an inconsistency illustrates the fact that the application relates to more than one design (decisions of 31/03/2005, R 965/2004-3 – 'Tape measure', paras 18-20; of 12/11/2009, R 1583/2007-3 – 'Bekleidung', paras 9-10).

However, as an exception to the above principle, the same features of a design can be represented in different colours in the various views if the applicant submits evidence that the change of colours at different points in time, while the product is in use, is one of the relevant features of the design.