

Switzerland

Dr. Reinhard Oertli
Peter Schramm

I. REQUIREMENTS FOR DESIGN PROTECTION

A. Legal Framework

1. Basics of Design Right

Design law in Switzerland is governed by the Swiss Federal Designs Act (2001),¹ which is commonly referred to as DesA. Promulgated under the DesA is the Designs Ordinance,² which contains provisions of a more procedural nature regarding the registration process at the Swiss Institute of Intellectual Property (IPI). Other legislation relevant for protecting designs in Switzerland are the Federal Unfair Competition Act,³ the Federal Copyright Act,⁴ and the Federal Trademark Act.⁵

Switzerland is a signatory to most international design law treaties, such as the Hague Agreement concerning the International Registration of Industrial Designs and the Geneva Act of the Hague Agreement, the Paris Convention for the Protection of Industrial Property, the Locarno Agreement Establishing an International Classification for Industrial Designs and the Agreement on Trade-Related Aspects of Intellectual Property Rights.

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1. Federal Act on the Protection of Designs (Designs Act, 'DesA'), of 5 October 2001 (last amended as of 1 January 2017), Classified Compilation No. 232.12.
 2. Ordinance on the Protection of Designs (Designs Ordinance, 'DesO'), of 8 March 2002 (last amended as of 1 January 2017), Classified Compilation No. 232.121.
 3. Federal Law of 19 December 1986, on Unfair Competition
 4. Federal Act on Copyright and Related Rights (Copyright Act) of 9 October 1992 (last amended as of 1 January 2017) Classified Compilation No. 231.1.
 5. Federal Act on the Protection of Trade Marks and Indications of Source (Trade Mark Act) of 28 August 1992 (last amended as of 1 January 2017), Classified Compilation No. 232.11.

Since Switzerland it is not a member of the European Union, the EU Design Directive⁶ and Regulation⁷ do not apply in Switzerland. Hence registered and unregistered Community Designs have no effect in Switzerland, and making a design first available to the public in Switzerland cannot create any rights under Community law.⁸

That being said, Swiss design law is broadly in harmony with Community design law. Similar to the Community Design Regulation, the DesA provides protection for designs of products (or parts of products) that are characterised by the arrangement of lines, surfaces, contours, colours and materials used. Two- and three-dimensional product designs of all types and forms are protected, provided they are used in relation to a product (not as independent artwork), and further provided the characteristic elements seeking protection can be rendered by graphical means.

Design protection in Switzerland requires registration, which can be obtained by applying for either a Swiss national registered design before the IPI or an international design under the Hague System (designating Switzerland).

The DesA does not grant protection to unregistered designs, but an unregistered design may be protected under certain circumstances under the Federal Copyright Act (as an artistic creation with individual character), under the Unfair Competition Act,⁹ or under the Trademark Act as a logo or three-dimensional registered mark.

2. Overview of Statutory Requirements

The statutory requirements for design protection are *novelty* and *originality*.

With regard to *novelty*, a design is not new if an identical design, which could be known to the circles specialised in the relevant sector in Switzerland, has been made available to the public¹⁰ prior to the filing date or the priority date.¹¹ The concept of identity is interpreted narrowly, i.e., only a prior design which is *identical* destroys novelty, whereas a prior design that merely has the same general impression does not.¹² Thus novelty will be denied if the design is different from a prior design only in minute details. A comparison of a design with a pre-existing design looks to

6. Directive on the legal protection of designs (CDD), 98/71/EC, 13/10/1998

7. Community Design Regulation (CDR), (EC) No. 6/2002, 18/12/2006; Community Design Implementing Regulation (CDIR), (EC) No. 2245/2002, 24/07/2007; Community Design fees regulation (CDFR), (EC) No. 2246/2002, 24/07/2007

8. Making a design first available to the public in Switzerland does not lead to protection as an unregistered Community Design, irrespective of whether it thereby could reasonably have become known to the circles specialised in the sector concerned operating within the Community.

9. See below item I.C.2.a).

10. Art. 2(2) DesA; irrespective of whether disclosure took place in Switzerland or anywhere abroad.

11. Decision of the Federal Tribunal (the Swiss Supreme Court, 'DFT') 134 III 205, 209 delib. 5.1 'jewellery rings'; Message of the Federal Council of 16 February 2000 on the Geneva File (Hague Convention on Industrial Design Protection including implementation regulations) and the Federal Law on the Protection of Designs, FF 2000, p. 2587 *et seq.*; Juerg Herren, in: Weinmann, Münch, Herren, Swiss IP Handbook, 2013, § 28 Design registration N 4.4.

12. Older decisions relied on the short-term remembrance of the interested persons, but this requirement was not convincing and seems to have been dropped.

the product as a whole. The fineness of the comparison criteria is relative to, and depends, among other criteria, on the size of the object, the attention paid to it,¹³ and the degree of freedom of the designer in developing the design.¹⁴

Novelty may come from a specific combination of features which together determine the appearance of the object, even if each of these features considered separately could not satisfy the novelty test.¹⁵ Novelty can therefore not be denied with the argument that the different separable features have been known before.¹⁶ No effort is made to divorce singular non-novel features from an otherwise novel overall design.

A design lacks *originality*¹⁷ if the overall impression it produces does not differ or differs only in insignificant aspects from a design that is or could be known to the circles specialised in the relevant sector in Switzerland.¹⁸ The standard determining the scope of protection of the design right, which covers designs that have the same essential features and thus produce the same overall impression as a design already registered,¹⁹ is also applicable when it comes to determining originality. Therefore, an earlier design destroys the originality of a new design if they share the same essential features and thus create the same overall impression. A design can create a different overall impression from a prior design, even if it shares certain details with that prior design. When performing the originality test, the similarities rather than the differences have to be examined.²⁰ The creative activity at the origin of the design as such is not relevant. The reference point is the perception of the person potentially interested in the purchase of the product; the overall impression of such a person is decisive.²¹ Originality presupposes that the reference person sees the essential features of the protected design as clearly different from what already exists. However, as it is the case for novelty, an examination of a design as ‘patchwork of separate features’ is not permissible. Therefore, even if a design consists only of a combination of pre-existing features, it can have originality if it distinguishes itself

13. Heinrich, op. cit., Art. 2, note 53.

14. Rollable draining rack delib 7.2.4.2, sic! 2014 S. 545, 552 *et seq.* (with regard to originality).

15. DFT 134 III 205, 209 delib. 5.1 ‘jewellery rings’.

16. R.M. Stutz, S. Beutler, M. Künzi, DesA, Art. 2 N 91, want to rely on the general impression, an opinion that is not shared by the Swiss Supreme Court in DFT 134 III 205, 209 delib. 5.1 ‘jewellery rings’.

17. With respect to the second requirement, Art. 2 DesA uses the terms ‘*Eigenart*’ in German, ‘*original*’ in French and ‘*originale*’ in Italian. These terms are different from the terms used in copyright law, namely (‘*individueller Charakter*’, ‘*caractère individuel*’ and ‘*carattere originale*’). We will use in the following the English terms ‘originality’ and ‘individual character’ interchangeably, describing a standard that is different from the one used in copyright. Originality, which is to be examined in accordance with Art. 2(3) DesA, is an extended, relative novelty test, which makes a separate novelty test obsolete (cf. Stutz, Beutler, Künzi, DesA Art. 2 N 95; Heinrich, DesA Art. 2 N 2.64; sic! 2014 S. 545, 550 – Rollable draining rack, delib. 6.2.1).

18. Art. 2(3) DesA.

19. DesA, Art. 8.

20. DFT 134 III 205, 209 delib. 6.1 ‘jewellery rings’.

21. DFT 134 III 205, 209 delib. 5.1 ‘jewellery rings’.

from pre-existing designs.²² The degree of freedom of the designer in developing his or her design²³ also has to be considered.

3. *Non-Functionality Requirement*

In Switzerland, a design may not be protected if all of its features are dictated solely by the technical function of the product (Article 4(c) DesA). The technical function of the ‘product’ as such is decisive, not the technical function of a single feature of the design.

The IPI only examines a design application for certain formal aspects, which could lead to refusal.²⁴ The IPI will not examine designs for compliance with the novelty and originality requirements,²⁵ nor whether the features of the design are dictated solely by the technical function of the product.²⁶ These issues are tested only when a registered design is challenged in court.

4. *Means for Claiming Design Rights*

The reproductions of the designs for which registration is sought may be in the form of photographs or other graphic representations of the designs, or of the products which embody the designs, which may be in black and white or in colour. The design can be described in terms of type and function. Inclusion of such text may contain a maximum of 100 words. Protection is determined by the images only, regardless of any description. Hence, the pictures or drawings have to be clear and self-explanatory.

Particular features or combinations of features of a product may be protected as a partial design. The protection of a partial design, or rather the design of a part of a product, is critical because the overall appearance of the design is the key factor in determining the scope of protection. It is possible to use broken lines in Swiss design applications to disclaim design elements from protection.²⁷

The portions of the design shown in broken lines do not constitute part of the protected design and thus are not taken into consideration when assessing novelty or infringement. It is therefore possible, using broken lines, to protect various portions of a single product using a variety of claims, each directed at a different part or parts of the product. However, as mentioned, the images depicting the design have to be self-explanatory without the aid of any verbal description. The required degree

22. R.M. Stutz, S. Beutler, M. Künzi, DesA, Art. 2 N 105, 107.

23. Commercial Court Argovie, sic! 2014 p. 545, Rollable draining rack, delib. 7.2.4.2, sic! 2014 S. 545, 552 *et seq.* with regard to originality.

24. Mainly improper documentation or incompatibility with Swiss law or public policy, Art. 24(3) DesA i.c.w. Art. 4(a), (d) and (e) DesA.

25. Art. 2 and Art. 4(b) DesA.

26. Art. 4(c) DesA.

27. In the Swiss Supreme Court case 4A_565/2016 of 2 May 2017, Frédéric Jouvenot attacked the front face of Christophe Claret’s wrist watch Marguérit based on his registered design for the wrist watch Surya, but failed for lack of similarity. He could also have attacked the reverse side, probably with more chances of success, in spite of the broken lines that show his registered design as showing the face of the Surya watch.

of clarity is difficult to achieve when several elements of the design are shown in broken lines.²⁸ If a singular feature can be separated from the overall appearance of a larger product, it is advisable to file a separate design application directed at only that feature. For example, if protection is only sought for the armrest of a chair, the applicant should file an application showing only the armrest component, rather than filing a design showing the entire chair in broken lines and only the arm rest in solid lines. This strategy is a best practice to ensure that the particular portion of the product for which protection is sought is made clear from the images of the application alone.

B. Policy Considerations Behind Non-Functionality Requirement

As noted above, a design right will be invalidated if its form is solely dictated by the intended function of the product to which it is applied. According to Swiss doctrine, the policy behind such a non-functionality requirement is to prevent an exclusivity right for technical solutions outside of patent law. Similar, even stricter considerations apply in trademark law.²⁹

Excluded from protection are forms which result from the intended use, application or operation of a product without any freedom of design remaining,³⁰ or if no reasonable design alternatives are available for achieving the same technical function.³¹ If there is a formal alternative, the design is not exclusively technically constrained and can therefore be protected.³² This approach, sometimes referred to as the multiplicity of forms test or the alternative forms test, protects against the unwanted (yet rare) situation where a design right would lead to the monopolisation of a functional concept, i.e., the design is the only way to achieve a particular function. By simply asking whether there are other designs that can achieve the same function to determine whether a design truly is dictated solely by technical function, the multiplicity of forms test side-steps the tricky and unreliable inquiry into the intent of the designer or the aesthetic quality of a design.

C. Compliance with Non-Functionality Requirement

I. Test

Design protection is denied only when the appearance of a product is the only one that can be used to achieve a particular technical function. The Swiss Supreme Court

28. We understand that such graphic renditions are customarily used for US design patents.
 29. Art. 2(b) Trademark Act; DFT 133 III 189 ff., consid. 6.1.2, sic! 2007, 546, 550, 'Jewellery box'; DFT 4A_20/2012 of 3 July 2012, 129 III 514 – Lego IV (3D). See below item II.D.
 30. The term 'exclusive' is not to be referred to 'conditionally', but to 'the technical features of the design'. If the characteristic features of the design are solely the result of the technical function of the product, the design has no other characteristics for which this is not the case, and thus is excluded from protection (Heinrich, DesA 4 N 4.11).
 31. A. Celli, M. Hyzik, R. Staub, A. Celli, ed., DesA 4 N 25 *et seq.*; Stutz, Beutler, Künzi, DesA Art. 4 N 40 f.
 32. Stutz, Beutler, Künzi, DesA Art. 4 N 42, restrictive Heinrich, DesA Art. 4 N 4.15

excludes a design from protection if no other form is available or can be reasonably used for achieving the same technical result, even if there is a different possibility whose realisation would be more difficult or lead to higher production costs. By applying such a modified multiplicity of forms test, the Swiss Supreme Court seeks to prevent an applicant from securing design registrations on all possible variants in order to exclude others from using a technical idea. This situation can arise when there are a limited number of alternative forms available. The technically most obvious and best form remains excluded from protection, while less obvious variants can claim design protection.³³

Article 4(c) DesA only denies protection to designs of which *all* features that determine the overall impression are deemed to be purely functional, but not to designs where only single features of the overall design are deemed purely functional.

2. *Impact of Related IP Rights and Must-Fit Parts*

a. *Related IP Rights*

Concurrent design and copyright protection is possible. Concurrent trademark protection is also possible, whereby the same (if not stiffer) requirements apply for trademark protection as regards functionality.

(Utility) patent protection does not by itself exclude design registration. Rather parallel registration as a design is possible where the technical function protected by the (utility) patent can be realised in different forms of which but one is subject to design registration.

An allegedly infringing design can be found as an expression of unfair competition if additional elements (in addition to the imitation of essential features of the appearance of a product) militate in favour of unfair competition. Swiss unfair competition law (unlike German law) does not provide for general supplementary protection of creations. Protection of an unregistered design under the unfair competition law historically was also rarely successful under Swiss law.³⁴ However, according to recent case law of the Federal Tribunal, the prohibition against unnecessary comparative advertising also applies to the offering of look-alike products. Finally, although the thresholds are high, exploiting the good reputation of a competitor's products can be unlawful under the Unfair Competition Act's general clause if the

33. DFT 133 III 189, 197 delib. 6.1.2, sic! 2007, 546, 550 – Jewellery box; DFT 134 III 205 ff., consid. 6.2, sic! 2008, 445, 448 – Jewellery rings; cf. Heinrich, *supra*, item 4.14 *et seq.* to Art. 4 DesA. The same standard applied in trademark law *de facto* excludes from trademark protection a design if there is another technical possibility, which however implies a less convenient execution, is less resistant, or more expensive (for instance even small additional manufacturing costs of 1.3–4.9% for interlocking building blocks have been considered as 'more expensive' in this context and therefore sufficient to make the first shape a technical necessity excluded from trademark protection). See DFT 4A_20/2012 of 3 July 2012, sic! 2012, 811 – Lego IV [3D]. In light of the difference in potential duration of protection, design law does not warrant the application of the same rigid standard.

34. District Court VII Bern-Laupen, sic! 2009, 356 ff. – Plastic Clogs.

alleged infringer's approach is systematic or parasitic, or copies a multitude of the competitor's designs.³⁵

b. Must-Fit Parts

The Swiss DesA does not contain a part-specific 'must-match' clause, such as contained in Article 110 CDR³⁶ and Article 14 CDD.³⁷ So the normal rules of design law apply also to spare parts and connecting parts. Their purpose to fit a mating part, which they can only fulfil if their shape and dimension exactly match the mating part is decisive. If the characteristic elements of the design are determined by that purpose, it is excluded from design protection, otherwise the scope of protection does not extend to the technically determined features.

The aesthetic fit ('must match'), the compatibility of the spare part or connecting part with the aesthetic qualities of the original or the parts with which it is intended to mate aesthetically, do not prevent protection and fall under the scope of protection under Swiss law, provided only the design of the spare part is new and original.^{38 39}

3. Designs Not Viewable in Normal Use

The Swiss DesA does not require visibility for products that are intended as parts of an encompassing product such as required in the CDR.⁴⁰ The Swiss designs can protect,

35. DTF 135 III 446 – MALTESERS, E. 7; DTF, sic! 2008, 454 ff., 458 f. – IWC.

36. Council Regulation (EC) No. 6/2002 of 12 December 2001 on Community designs, Art. 110 (Transitional provision) para. 1 'protection as a Community design shall not exist for a design which constitutes a component part of a complex product used ... for the purpose of the repair of that complex product so as to restore its original appearance.'

37. Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs, Art. 14 (Transitional provision) 'Member States shall maintain in force their existing legal provisions relating to the use of the design of a component part used for the purpose of the repair of a complex product so as to restore its original appearance and shall introduce changes to those provisions only if the purpose is to liberalize the market for such parts' (so-called 'freeze plus').

38. The Swiss Supreme Court denied design protection under the precursor of the DesA to a Volvo fender (DFT 4C.110/1990 of 15 October 1990, delib. 2a/aa and 2b/bb, in SMI 1991/1, 155, not published in DTF 116 II 471) for lack of novelty and originality and because it was determined by technical considerations and the purpose to fit with the overall design of the car, and to all but one part of a pickup needle casing of a record player, because its features were determined by technical rather than aesthetic considerations, irrespective of the fact that alternative technical solutions would have been available, and also because they were not visible after installation (DFT 113 II 77. 80 ff., SMI 1987/1, 67, delib. 3c).

39. As in the EU, the distribution of spare parts for automobiles separate from the distribution of the cars is the subject of competition law. See the publication of the Swiss Competition Commission concerning the treatment of vertical agreements in the automobile sector under competition law of 29 June 2015.

40. CDR Art. 4 (Requirements for protection) para. 2 'A design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character: (a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter;

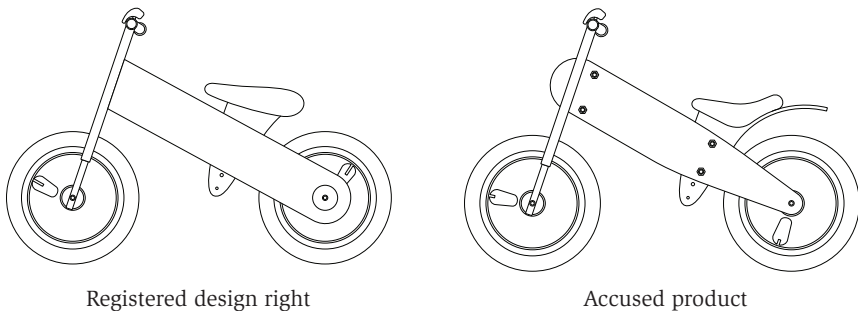
in principle, parts ‘under the hood’ provided that these parts are independently tradable as well as new and original.

D. Case Law Examples Dealing with Non-Functionality Requirement

1. *Walking Bike Case*

The Commercial Court confirmed design protection according to Article 4(c) DesA in the *Walking Bike* case⁴¹ because all of the features of the design were not dictated solely by the technical function. Though some necessary elements such as handlebars, the saddle and the wheels are determined by their technical function, they may be interpreted in several different ways. While the design right was sustained, the Court held that because the shape and structure of a walking bike was heavily determined by functional considerations, the freedom of the designer was limited, and consequently also the design’s scope of protection. Due to the differences in appearance between the registered design (Figure 1, left) and the allegedly infringing design (Figure 1, right), and in view of this limited scope of protection, the Commercial Court concluded that there was no infringement.

Figure 1



2. *Rollable Draining Rack Case*

In the *Rollable Draining Rack* case,⁴² the design (shown in Figure 2) was found valid because of its novelty and individual character and characteristic features not solely dictated by technical function, but the allegedly imitating rack was considered sufficiently different in appearance as not to violate the registered design. The Court, using the multiplicity of forms test, said that the accused product was sufficient evidence that there were different options for the assembly of the rods such as the

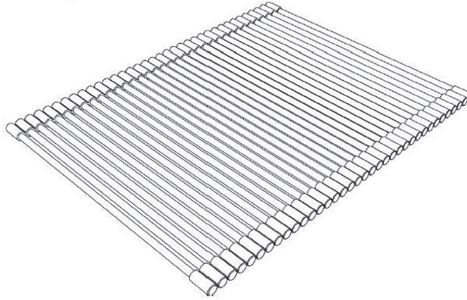
and (b) to the extent that those visible features of the component part fulfil in themselves the requirements as to novelty and individual character’.

41. HGer AG in sic! 2006, S. 189.

42. Commercial Court Argovie, sic! 2014 p. 545, rollable draining rack.

‘ribbon look’ of the allegedly infringing design or the ‘bicycle chain look’ of the prior art design.

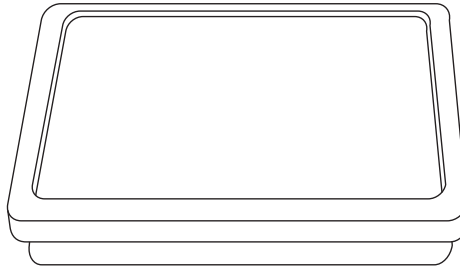
Figure 2



3. *Jewellery Box Case*

In the *Jewellery Box* case,⁴³ the registered design (a representation of which is shown in Figure 3) was for the design of a jewellery box.

Figure 3



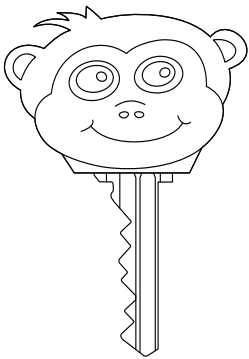
The registration was challenged on the ground that its appearance was solely dictated by technical function. The Court rejected the argument and sustained the validity of the design. Applying the multiplicity of forms test, the Court found that there were alternative designs that could serve the function of a jewellery box. The appearance set forth in the design registration was not the only form a jewellery box can take.

E. *Hypothetical Fact Patterns (‘Monkey Key’ Hypothetical)*

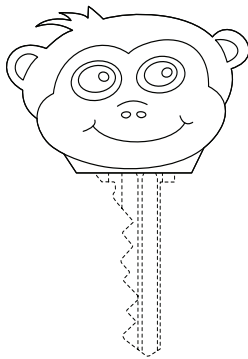
In Example 1.1, no portions of the key are depicted in broken lines. Accordingly, the ‘claimed’ design includes both the key head (which is in the form of a monkey’s

43. DFT 133 III 189 – jewellery box.

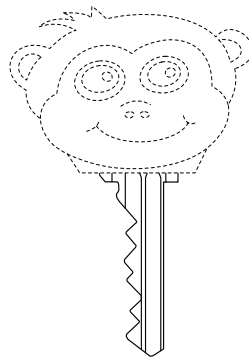
head) and a key blade. The key head is clearly not dictated solely by the technical function of the key. The key head need not take the form of a monkey's head for the key to function as a key. Indeed, the key head could be unadorned, or take the form of any other animal (or even a different depiction of a monkey's head). All elements of the design are not dictated by the key's intended function. Accordingly, the design of the key in Example 1.1 would not run afoul of the non-functionality requirement. Notably, the key is eligible for protection despite the fact that (1) a key itself is a functional product, and (2) the claimed key includes the key blade which will likely be considered a feature whose appearance is dictated purely by functional considerations.



Example 1.1



Example 1.2



Example 1.3

In Example 1.2, the key blade portion is depicted in broken lines and thus it is understood not to be part of the 'claimed' design. The only portion claimed is the key head. As noted above, the key head could take several forms and still achieve its intended function and thus is not dictated solely by the technical function. Accordingly, the design of the key in Example 1.1 would not run afoul of the non-functionality requirement.

In Example 1.3, the registered design consists only in the key blade; it is the only portion shown in solid lines. If, in an invalidity proceeding, the challenger established that the key blade could only take this appearance, the design right would be invalidated. Indeed, there may only be one appearance for the key blade if it was intended for a particular keyhole, so that this design should be qualified as dictated solely by its technical function.

F. Tactical Considerations

1. Prosecution

The invalidity of a design can only be argued in court proceedings since designs are basically unexamined rights in Switzerland. There is no risk of the Swiss Patent Office denying protection because of functionality in the application process.

In case there is doubt as to whether some features are functional or must-fit features, protection can be claimed for the entire product with all features. When the design includes at least some features that are not functional or must-fit features, the design as a whole is eligible for protection in case the other conditions are met.

If a singular non-technical feature can be separated from the overall appearance of a larger mere technical product, it is advisable to file several separate design applications, each only showing a single design directed at only that feature, instead of using broken lines. This strategy is a best practice to ensure that the particular portion of the product for which protection is sought is made clear from the images of the application alone.

2. *Litigation*

If a design is challenged on functionality grounds, it has to be shown by a concrete analysis of the individual elements of the design that every feature of the design determining its overall appearance is dictated by its technical function only. If there are some features determined also by aesthetic considerations, the design will remain registered.

Since the courts in Switzerland follow the ‘multiplicity of forms’ test, the design owner should further try to counter such a challenge by arguing that alternative appearances are available to achieve the same technical result. To do so, the registrant has to show examples of other available product shapes performing the same function.

II. SCOPE OF PROTECTION

A. Legal Framework

1. *Articulation of Scope of Protection*

A design is infringed by another design which has the same overall impression as the registered design as viewed by an informed user. Mere variation in details will not create sufficient distinction from the protected design. An infringing imitation is deemed to exist if the dominant characteristics of the design recur in the imitation, and if the imitation may only be distinguished from the protected design upon a thorough examination. A mere different choice of colour, for example, does not avoid infringement.

In infringement proceedings, the overall impression produced by a registered design is assessed on the basis of the images in the design registration only. Similar to the EU, the product designation and the classes in which the design is registered serve administrative and registration purposes only. However, in the assessment of novelty and originality the type of product for which the design has been registered is considered.

2. *Effect of Prior Art Corpus on Scope of Protection*

The test for infringement is whether the alleged infringing product produces a different overall impression or not. Hence, in assessing the scope of protection, the degree of freedom of the designer in developing his or her design should be considered. This is because highly functional designs are likely to be more similar than designs in respect of which the designer enjoys total freedom. In fact, the freedom of the designer cannot be assessed without considering the prior art.

In order for a design to be considered to have individual character, the overall impression produced by a design must be different from that produced by one or more earlier designs taken individually. This means that the relevant prior art is not a tessellated combination of singular features from earlier designs taken in isolation.

3. *Effect of Functional Features on Scope of Protection*

a. *Features Dictated Solely by Technical Function*

The non-functionality requirement (Article 4(c) DesA) does not lead to a denial of protection if only individual features of a design are deemed purely functional; as noted above, denial of a right only occurs when all features are determined to be the result of only functional requirements.

Under the Swiss statute in force before the current DesA, designs could be partially nullified on ground of functionality. In the course of determining partial nullity on such a basis, features of a design whose appearance was driven solely by a technical solution were eliminated; the assessment of novelty and originality was based only on the remaining features. Since the concept of partial nullity was based on a legal provision considerably different from Article 4(c) of the current DesA, it is the common understanding of legal scholars that said concept is no longer directly applicable. As a result, features driven purely by technical requirements may now contribute to the overall impression of a design.⁴⁴

This does not change the fact that individual features which are solely dictated by their technical function as such are given little weight when assessing the scope of protection.⁴⁵

b. *Features Not Dictated Solely by Technical Function, but Nevertheless Serving a Function*

Features of appearance, whether partially or even solely, influenced by technical function remain part of the overall appearance of a design. No features are stripped out due to functionality. Of course, the scope of protection does not extend to any

44. See Juerg Herren, in: C. Weinmann, P. Münch, J. Herren (eds.), *Schweizer IP-Handbuch* (Bale 2013), § 28 Designregistrierung N 6.2; M. Wang, *SIWR VI* (Bale 2007), 130-132; Stutz, Beutler, Künzi, DesA Art. 4 N 45; contrary opinion in Message of the Federal Council, FF 2000, 2729, 2741.

45. See Commercial Court Aarau decision of 15 July 2005 – walking bike, sic! 2006, 187, 189, delib. 3.4.3. They may still be relevant regarding their positioning, combination, etc.

of the underlying qualities or characteristics of the product (e.g. how fast it flies, how well it cuts, how strong the material is). This approach recognises that most designers follow, at least to some degree, the ‘form follows function’ philosophy. Indeed, even a combination of purely functional features may be combined to form a non-purely functional overall design, so long as the *combination* of features of the design is not dictated solely by the technical function of the product.

c. Impact of Related IP Rights, Industry Standards, Must-Fit Components

As already mentioned, the Swiss DesA does not contain a part-specific ‘must-match’ clause, such as contained in Article of 110 CDR and Article 14 CDD. The normal rules of Swiss design law apply to things like spare parts and connectors. If all characteristic elements of a ‘must-fit’ part are completely determined by the need to mate with a separate part, the design is excluded from protection. If a design has a combination of must-fit features, on the one hand, and features for which alternatives are available, on the other hand, the design is still eligible for protection. Of course, the features dictated by the must-fit purpose are deemed to play a less important role when determining the scope of protection.

While ‘must-fit’ parts mate together for technical reasons, there are also ‘must-match’ parts which mate together for aesthetic reasons. For example, a head lamp may be designed to appear with a particular car grille. ‘Must-match’ parts are not denied protection on functionality grounds.⁴⁶

B. Test(s) for Determining Whether a Feature is ‘Dictated Solely by Technical Function’

As discussed in more detail under section I.C.1. *supra*, the so-called multiplicity-of-forms test (*i.e.* alternative designs test) has been adopted by the Swiss courts. A feature is solely dictated by its technical function when the technical function restricts the design to one possible appearance only and no alternative appearances are available for the design.

C. Policy Considerations Underlying Treatment of Functional Features

As noted above, there is no effort made to eliminate visual features from the overall appearance of a design. Swiss law recognises that visual features do not reside in isolation; rather all features have a visual relationship with all other features of the design.⁴⁷

46. DFT 4C.110/1990 of 15 October 1990, delib. 2a/aa and 2b/bb, in SMI 1991/1, 155 – Volvo.

47. See Christopher V. Carani, *Design Patent Functionality: A Sensible Solution*, 7 LANDSLIDE 19 (2014) (discussing flaws with approach where attempts are made to excise visual elements of an overall design based on functionality concern); see also Christopher V. Carani, *Apple v. Samsung: Intelligence on Apple’s U.S. Design Patent Offensive*, 81 PTCJ 687 (October 2011) (cautioning against exclusion of visual features, whether non-novel or purely functional); see also Christopher V. Carani, *Design Patents Take Center Stage*, 5 LANDSLIDE 3 (2013).

To understand the Swiss approach it is helpful to touch on the evolution of DesA. In short, the Swiss statute in force before the DesA followed a copyright approach, whereby design objects were considered art so long as they had an appreciably amount of aesthetic quality. Like the EU regime, the current Swiss DesA diverged from this approach and instead followed a more expansive approach sometimes called the ‘design approach’ or ‘marketing approach’. Under this approach, designs are protected as elements of products so long as they enhance their visual appearance in some way. The Swiss legislature wanted to encourage innovation and investment into new products when putting in place the DesA. Thus, the design law was moved away from copyright and more towards a protection of any marketing relevant feature of a product design, be it aesthetic, ergonomic or more functional. Some decisions such as the *Rollable Draining Rack*⁴⁸ case show that it is original functionality, or functional originality, rather than beauty of the shape, which design law primarily protects and therefore encourages.

D. Case Law Examples of Treatment of Functional Features in Infringement and Validity Analyses

1. Jewellery Ring Case

The *Jewellery Ring* case⁴⁹ concerned an invalidity challenge for a design right regarding a jewellery ring based on lack of originality. In assessing the scope of protection, the Court noted that the broad, smooth and flat aspect of the edges surrounding the cavity of the jewellery, as well as the square section of these edges are features that were driven exclusively by the technical function of the ring. The Court noted that these features could not take any other appearance. The features accorded little weight when comparing the design right to the prior art. The remaining visual features were given primacy in the analysis. The design, as construed, shared the same general impression with jewellery ring published earlier in a catalogue of the applicant. Accordingly, the design was invalidated.

2. Garlic Press Case

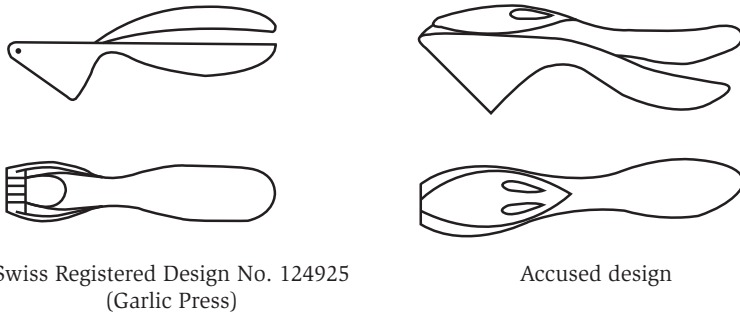
In the *Garlic Press* case, the plaintiff asserted that the defendant’s ‘Pelican’ garlic press (Figure 4, right) infringed Swiss Registered Design no. 124925 (Figure 4, left). As both products were garlic presses, there were several similarities in overall configuration. For example, they both have two handles, a fulcrum and a cavity in which to place the cloves of garlic. While each of these elements serve a particular function in the operation of the garlic press, none of these features were excluded from the scope of the overall appearance of the garlic press. Nevertheless, due to the highly functional nature of each of these elements, when turning to the infringement comparison, each would be assigned a narrow scope of protection; the designer of garlic presses has a restricted freedom of design due to functional considerations of

48. Commercial Court Argovie, sic! 2014 p. 545.

49. DTF 134 III 205 – jewellery ring.

the tool. In view of these constraints, relatively small differences in the particular curves and angles were given heightened significance. As a result, and in view of this scope of protection, the Court found there was no infringement as the accused design produced a different overall visual impression on the informed user.

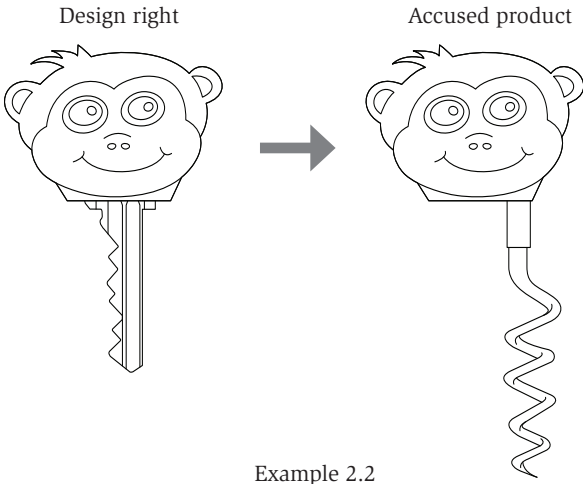
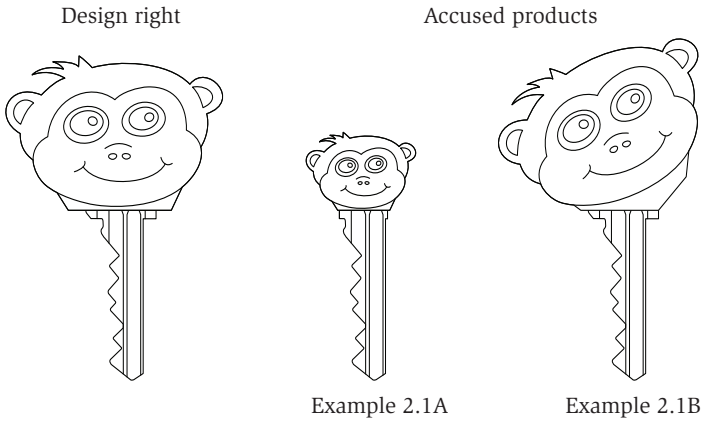
Figure 4



E. Hypothetical Fact Patterns ('Monkey Key' Hypothetical)

1. Infringement Examples

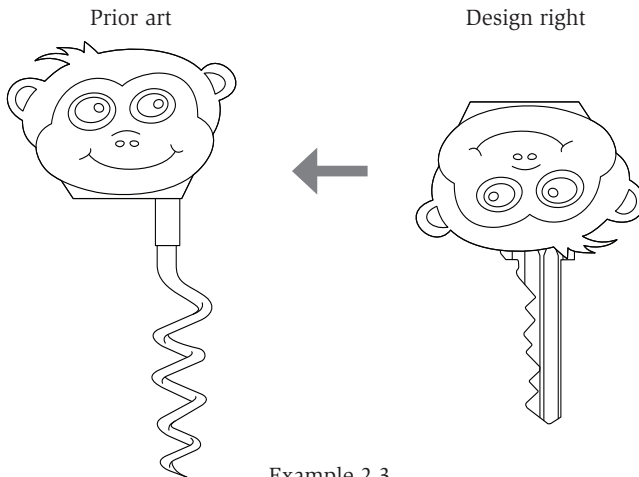
The infringement analysis for Examples 2.1A, 2.1B, and 2.2, under Swiss law has to begin with an assessment of the scope of protection of the registered design. The registered design shows the entire key in solid lines, including the key head and key blade. A threshold question is whether the key blade is excluded from the registered design's scope of protection under a functionality analysis. While the shape of the key blade might be dictated solely by its function, its relationship to the key head, including the relative size and positioning, is not. Thus, while at first sight one might be tempted to exclude the key blade from the scope of protection of the registered design, this would be in error. There are aspects of the key blade's relationship to the key head that are not dictated solely by technical functions, and thus the key blade should not be excluded from the scope of protection.



If the key blade were completely excluded from the scope of protection of the registered design, in each of the Examples 2.1A, 2.1B and 2.2, a finding of infringement would be mandated. The key head in each example is identical to that of the registered design. Excluding features of a registered design under the title of eliminating functional features can have the unintended effect of broadening its scope of protection beyond what the applicant is entitled to. Excluding any features from the overall appearance for determining the scope of protection must therefore be done with care.

Comparing the key as a whole to the accused designs of Examples 2.1A, 2.1B and 2.2, the exactitude of imitation in the shape of the key head, which has a wide freedom of design, will militate strongly in favour of a finding of infringement. Although there are noticeable differences in the positioning and orientation of the key blade of Example 2.1A and 2.1B, and the corkscrew of Example 2.2, this similarity in the key head will lead likely to a finding of infringement in all three examples.

2. *Validity Example*



Example 2.3

As regards the validity of Example 2.3, the analysis again has to begin with an assessment of the scope of protection of the registered design. That scope of protection will then be compared to the prior design to determine if the design is novel and original.

The design shows the entire key in solid lines, including the key head and key blade. A threshold question is whether the key blade is excluded from the design's scope of protection under a functionality analysis. If the key blade feature is eliminated entirely from the scope of protection, the design right would lack novelty as the shape of the key head is found in the prior art. If the key blade is included in the scope of protection, the analysis on novelty and originality is less certain.

Here again, the key blade feature is not just the shape of the teeth of the blade. Instead, the key blade feature includes the blade relationship to the remainder of the design, including the relative orientation, positioning and size. Accordingly, the

scope of protection should include the key blade. The scope of protection, however, will be reduced in view of the low degree of freedom the designer has in designing the key blade portion of the key.