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Can a product protected by a design be invisible?

Rulings on design matters are rare enough to warrant attention. The Court of Justice of the European Union has recently had two opportunities to address design protection in the European Union: on February 16, 2023 in the [C-472/21](#) ruling, and on March 2, 2023 in the [C-684/21](#) ruling.

I will focus here on the first of these decisions. It highlights the importance of understanding the nuances between Switzerland and our neighbors, particularly in the context of design portfolio management.

In this case, the Court was asked to rule on the design protection of a bicycle saddle represented as follows:



According to Art. 3 of Directive 98/71, *"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 if the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter"*.

"Normal use" is defined in paragraph 4 of this provision as use by the end user, excluding maintenance, servicing or repair work.

In this case, the defendant argued that the saddle in question was not visible during normal use of the bicycle to which the saddle was attached. Therefore, the said saddle was not eligible for design protection, which should be cancelled.

The Court refers to its Ferrari judgment, rendered on October 28, 2021 under Regulation No. 6/2002 ([C-123/20](#)). In this respect, it considers that the protection should not be extended to those component parts which are not visible during normal use of a product, or to those features of such part which are not visible when that part is mounted.

For the Court, the component part in question must not only be visible to the end user, but also to an external observer when the product is used in accordance with its usual purpose. Such use may, however, require the performance of certain acts prior to or subsequent to the performance of that primary function. Such acts are also covered by the so-called "normal" use of the product as long as they do not relate to the maintenance, service or repair of the complex product.

In the end, the Court concluded that Articles 3(3) and 4 of Directive 98/71 *"must be interpreted as meaning that the requirement of 'visibility', laid down in that provision, that is to be met in order for a design applied to or incorporated in a product which constitutes a component part of a complex product to be eligible to benefit from the legal protection of designs, must be assessed in the light of a situation of normal use of that complex product, so that the component part concerned, once it has been incorporated into that product, remains visible during such use. To that end, the visibility of a component part of a complex product during its 'normal use' by the end user must be assessed from the perspective of that user as well as from the perspective of an external observer, and that normal use must cover acts performed during the principal use of a complex product as well as acts which must customarily be carried out by the end user in connection with such use, with the exception of maintenance, servicing and repair work."*

Commentary

It will be up to the German Courts to assess whether the above-mentioned design is eligible for design protection based upon the above criteria.

In my opinion, this should not be the case. In fact, the design features are on the hidden side of the saddle once attached to the bike. "Normal use" of a bicycle does not require the saddle to be systematically removed and put back on. Once attached, the saddle is rarely removed, except for possible acts of maintenance and repair which, according to Art. 3 par. 4 of the Directive, are not considered to be normal use of the product. The design should therefore imho be declared null and void by the German authorities. To be continued.

This decision highlights an essential difference with Swiss law. Indeed, the Swiss doctrine is unanimous in considering that the federal

law on designs does not require that the essential characteristics of a component incorporated in a complex product be visible during the normal use of the product in order to be protected by a design.

This discrepancy should be kept in mind when managing a design portfolio and possible international registrations: designs that are valid in Switzerland will not necessarily be valid within the European Union.

Source : <https://www.wg-avocats.ch/en/news/intellectual-property/can-a-product-protected-by-a-design-be-invisible/>