

I. INTRODUCTION

The aim of Article 8(1) of Council Regulation (EC) No. 6/2002 on Community designs (hereinafter “CDR”) is to prevent technological innovation from being hampered by the granting of design protection to features dictated solely by a technical function of a product.

Art. 8 (1) CDR reads as follows:

“A Community design right shall not subsist in features of appearance of a product which are solely dictated by its technical function”.

Recital 10 sentences 1 and 2 CDR read as follows:

“Technological innovation should not be hampered by granting design protection to features dictated solely by a technical function. It is understood that this does not entail that a design must have an aesthetic quality.”

Before the recent CJEU decision DOCERAM (Case C-395/16), there were two main legal theories in legal literature and in the decision-making practice of the courts of the Member States and the European Union Intellectual Property Office (EUIPO). These theories appeared to be divergent with regard to the interpretation of Article 8(1) CDR. This led to ambiguity and as such a situation undesirable and even untenable for practitioners and entrepreneurs in the protection and enforcement of design rights.

According to the first theory, this provision does not apply if design alternatives exist allowing the same technical function as the existence of such alternatives would show that the choice of the form in question was not dictated solely by its technical function within the meaning of Article 8(1). This interpretation is based on the criterion usually known as the ‘multiplicity of forms’, according to which, if other forms of a product exist that are capable of fulfilling the same technical function, the product’s design may enjoy protection, since that range of forms shows that in such a case the product’s designer was not constrained by the function, but was free to opt for any one of those forms when developing the design. However, the effectiveness of this theory was low: design alternatives were always possible in practice.

According to the second theory known as the *causality test* (or “*no-aesthetic-consideration-test*”), the exclusion laid down in Article 8(1) CDR should come into play where the features of the design in question are due solely to the need to develop a technical solution, while aesthetic considerations do not have the slightest influence, as in that case there is no creative activity that is worthy of protection under the law relating to designs.

The CJEU has opted for the theory of causality in its DOCERAM decision.

However, this does not mean that a design must have an aesthetic quality. At the first glance, the DOCERAM decision of the CJEU might give a different impression. Against this

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background, ECTA considers it necessary to comment on the interpretation of technical functionality under Article 8(1) CDR.

II. EXECUTIVE SUMMARY

The CJEU decided to take side with the theory of causality in its DOCERAM decision. This position paper welcomes the applicability of the causality theory. Nevertheless, aesthetic considerations should not play a role in future in assessing individual character under Art. 6 CDR. DOCERAM concerns only one special issue, namely under which conditions a Community design is excluded from design protection because it is solely dictated by its technical function. ECTA notes that the DOCERAM decision does not mean that considerations concerning the aesthetic quality of the design become more important and does not at all affect the interpretation of technical features of designs with regard to the overall impression under Art. 6 and 10 CDR. ECTA considers it necessary for the interpretation of the functionality requirement as per Article 8.1. CDR to make the most of the adverb “exclusively” and, as a consequence, too broad interpretation of this provision by the EUIPO, national IP offices and national courts should be avoided. Thus, ECTA proposes a clarification to the Recitals of the future European Design package (Regulation and the Directive) to express that technical designs are still protected by design law, as opposed to designs solely dictated by function.

III. COMMENTS

a) Findings of the CJEU

Article 8(1) CDR excludes protection for features of appearance of a product where considerations other than the need for that product to fulfil its technical function, in particular those related to the visual aspect, have not played any role in the choice of those features, even if other designs fulfilling the same function exist.

The CJEU dismissed the position that technical functionality must be denied if design alternatives exist, which fulfil the same technical function. In the future, technical functionality must be affirmed even if design alternatives fulfilling the same function exist. The CJEU followed the approach that features of appearance of a product are purely functional if aesthetical considerations did not play a role at all.

Further, the CJEU made it clear that for establishing technical functionality, the national courts must take into account all objective circumstances of each individual case.

b) ECTA’s remarks – no broad interpretation of technical functionality

ECTA is in favour of the causality theory. The focus on the existence of design alternatives has not been able to secure the effectiveness of Art. 8 (1) CDR. However, the disadvantage of the now applicable “no-aesthetical-consideration-test” is that it leads to a greater legal uncertainty as to when features of appearance of a product are solely dictated by function.

ECTA has realised that some national courts interpret the technical function exception under Art. 8 (1) CDR too broadly, thereby excluding from protection designs that should be protected (see e.g. the judgement of the district court of Frankfurt am Main case no. 2-06 O 79/18 “red frying pan”). The case concerned a Community design for a frying pan. In the case, there existed a parallel utility model registration, given that the colour of the pan was changing after heating. Speckles were only visible when it was cold. The Frankfurt district court considered the whole design registration as solely dictated by technical function within the inter. The decision was criticised because the chamber has not considered the shape of the pan as an element which contributes to individual character under Art. 6 CDR. Obviously, the shape was not solely dictated by technical function.

ECTA is against any such broad interpretation of the technical functionality exception under Art. 8 (1) CDR.

ECTA remarks that according to Recital 10 sentence 2 CDR considerations concerning the aesthetic quality of a design shall play no role in the assessment of its validity as a Community design.

ECTA also notes that the DOCERAM decision does not affect technical features of appearance, but only those rare designs solely dictated by its technical function. Of course, the fact that a design contains technical features of appearance does not exclude it from protection. In practice, good design always is a mixture of form and function (“form follows function”).

ECTA proposes a clarification to the Recitals of the future European Design package (Regulation and Directive) to express that technical designs are still protected by design law, as opposed to designs solely dictated by function.

ECTA supports the view that even a minor “creative input” rules out the applicability of Art. 8(1) of the CDR. Only in case where it is established that aesthetic considerations did not play any part at all, Art. 8 (1) of the CDR does apply [see e. g. High Court, 23.02.2018, EWCA 354 (Pat)].

c) Determining features solely dictated by technical function

As to determining features solely dictated by technical function all objective circumstances of an individual case must be taken into account. ECTA observes the following:

- As the CJEU made clear, the existence of alternative designs, being the only factor, can no longer be the sole argument to deny technical functionality.
- Nevertheless, the existence of alternative designs can be taken into account as an additional argument to deny technical functionality. The more design alternatives

exist for a product fulfilling a technical function, the stronger is the indication that features of a product are not solely dictated by its function.

- The statement of the designer or the owner of the design should at best be of minor importance and should never be decisive for the assessment.
- Under no circumstances, the taking of evidence (including expert hearings) should be excluded by Community Design courts from the beginning. For instance, it is not justified to assume that taking of evidence in an industry sector for certain products (such as wear parts) is not necessary because aesthetic considerations do not play any role in this business, but only reliability and in-time-delivery.
- If features of appearance of a product are promoted, this should be a strong argument against technical functionality.
- In the opposite situation, if the features of appearance are not promoted, this does not necessarily indicate technical functionality because design features speak for themselves and tend to be not expressly promoted at all.
- Non-visibility of the product features due to packaging etc, neither at the point of sale nor during normal use, might be indicative for technical functionality (cf. R 1772/2012-3 Nintendo Co., Ltd. v Compatinet S.L.U, 14.04.2014 – Game cartridges).
- In principle, the existence of patent and/or utility model documentation concerning the same product should be irrelevant, because these documents must not contain information on the design of the product or of parts thereof (Federal German Supreme Court, decision of October 7,2020 – case no. I ZR 137/19).

As for the burden of proof, ECTA believes that the burden of proof is with the party relying on the exception under Art. 8 (1) CDR. This is the applicant in invalidity proceedings and the defendant in infringement proceedings.

IV. FINAL REMARKS

ECTA notes again that the DOCERAM decision does not mean that aesthetic considerations become more important. In particular, the DOCERAM decision does not at all affect the interpretation of technical features of designs with regard to the overall impression under Art. 6 and 10 CDR.

ECTA, which was formed in 1980, is an organisation concerned primarily with trade marks and designs. ECTA has approximately 1,500 members, coming from all the Member States of the EU, with associate Members from more than 50 other countries throughout the world.

ECTA brings together those practicing in the field of IP, in particular, trade marks, designs, geographical indications, copyright and related matters. These professionals are lawyers, trade mark and patent attorneys, in-house lawyers concerned with IP matters, and other specialists in these fields. ECTA does not have any direct or indirect links to, and is not funded by, any section of the tobacco industry or any other industry sector.

The extensive work carried out by the Association, following the above guidelines, combined with the high degree of professionalism and recognised technical capabilities of its members, has established ECTA at the highest level and has allowed the Association to achieve the status of a recognised expert spokesman on all questions related to the protection and use of trade marks, designs and domain names in and throughout the European Union, and for example, in the following areas:

- Harmonization of the national laws of the EU member countries;
- European Union Trade Mark Regulation and Directive;
- Community Design Regulation and Directive;
- Organisation and practice of the EUIPO.

In addition to having close links with the European Commission and the European Union Intellectual Property Office (EUIPO), ECTA is recognised by WIPO as a non-Government Organisation (NGO).

ECTA does also take into consideration all questions arising from the new framework affecting trade marks, including the globalization of markets, the explosion of the Internet and the changes in the world economy.

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