

Case-law Research Report – Identification of the features of a design under Article 8(1) CDR

Consistency Circle Designs

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1. Introduction

- 1 The report on *Identification of the features of a design under Article 8(1) CDR* is a compilation of case-law from the Court of Justice (CJ), the General Court (GC) and the Boards of Appeal (the Boards or the BoA), drawn up with the aim of identifying and analysing the relevant case-law and trends on the topic.
- 2 The purpose is to further support the work of the BoA with a view to maintaining and enhancing the **consistency** of its decision-making practice with the case-law of the EU Courts and among the BoA. As such it contributes to improving the **predictability** of decisions and legal certainty in general. Through divulging relevant legal information, it also serves to increase **knowledge, awareness and transparency** among the various BoA stakeholders.
- 3 It is a working document that reflects existing case-law and the result of discussions within the Consistency Circles and the General Consistency Meeting of the BoA at the given date of the report. **It does not have any binding effect on the BoA.** It has been made available to the staff of the BoA and the public in general for information purposes only.
- 4 This report is complemented by the report on *Proof of technical function of a design under Article 8(1) CDR*.

2. Legal framework

2.1 EU law

- 5 **Recital 10 of the CDR**¹ indicates that '*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. [...] Consequently, those features of a design which are excluded from protection for that reason should not be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection.*'
- 6 **Article 3(a) CDR**² on the definition of a design provides that '*a 'design' means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation*'.
- 7 **Article 25(1)(b) CDR** provides as one of the grounds of invalidity if the design '*does not fulfil the requirements of Articles 4 to 9*'.
- 8 **Article 8(1) CDR** refers to the purely functional features of a product; it provides that '*a Community design shall not subsist in features of appearance of a product which are solely dictated by its technical function*'.

¹ See also Recital 14 of Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs.

² Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ L 3, 5.1.2002, p. 1).

2.2 Other instruments

- 9 The **Office's Guidelines** on *Examination of design invalidity applications* deal with this topic, in particular, in Point 2.3 *Scope of the examination carried out by the Invalidity Division* and Point 5.5 *Technical function*.

3. Case-law analysis³

3.1 Identification of all the features of the design

- 10 The first question that arises is whether 'all the features' or only the 'essential features' of the appearance of the design must be taken into account.
- 11 In **DOCERAM**⁴, the CJ stated that '*in order to determine whether the features of appearance of a product are exclusively dictated by its technical function, it must be established that the technical function is the only factor which determined those features, the existence of alternative designs not being decisive in that regard*'. However, it did not explicitly clarify whether 'all the features' of appearance had to be taken into account.
- 12 Most of the BoA decisions refer to 'all the features' of the design. For example, in **Water purifiers**⁵, the Board referred to all the features of appearance of the design throughout the reasoning on the assessment under Article 8(1) CDR. In **Labels**⁶, the Board identified all the features of appearance and concluded that '*only part of the features of the contested RCD are dictated by the technical function*' and, therefore, found that the design was valid. The Board followed the same reasoning in **Handheld kitchen cutting appliances**⁷.
- 13 However, some decisions refer to 'essential features'. In **Shower drains**⁸, the Board stated that '*Article 8(1) CDR denies protection to those essential features*' found to be only technical. The same wording was used in **Part of heating systems**⁹.
- 14 Finally, other decisions refer to both 'all' and 'essential features'. In **Hinges**¹⁰, the Board referred to both '*all the features of the appearance*' and then took into account '*all the essential features of the contested RCD*' in the assessment of the technical function. In **Fluid distribution equipment**¹¹, the Board stated that '*all the essential features of the contested RCD have been chosen with a view to designing a product that performs its function*' and then that '*all the features of the contested design only serve that function*'

³ The analysis focuses on the BoA decisions and judgments rendered after the Court's preliminary ruling in the DOCERAM case (08/03/2018, C-395/16, DOCERAM, EU:C:2018:172). Considering the great impact of this judgment on the Office's practice, the CC considered that the decisions rendered before would be less relevant.

⁴ 08/03/2018, C-395/16, DOCERAM, EU:C:2018:172, § 32

⁵ 26/02/2020, R 740/2018-3, Water purifiers, § 32; decision confirmed 26/01/2022, T-325/20, Water purifiers, EU:T:2022:23

⁶ 15/05/2020, R 2413/2018-3, Labels, § 26 and 35; decision confirmed 10/11/2021, T-443/20, Labels, EU:T:2021:767, § 91-96

⁷ 10/05/2021, R 440/2020-3, Handheld kitchen cutting appliances, § 21, 32

⁸ 17/03/2020, R 2664/2017-3, Shower drains, § 72 - pending before the GC under T-327/20

⁹ 02/04/2020, R 510/2019-3, Part of heating systems, § 40

¹⁰ 04/04/2019, R 1270/2018-3, Hinges, § 19-20

¹¹ 12/06/2019, R 1002/2018-3, Fluid distribution equipment, § 37-38

to conclude that the design was invalid pursuant to Article 8(1) CDR. In **Seats**¹², the Board first mentioned *'the essential features of the appearance of the product'* and then stated that *'the invalidity applicant has not produced any convincing evidence or argumentation to demonstrate that all the features of the design had been chosen solely to secure or enhance the product's technical function'*.

- 15 The analysis has shown that despite the difference in wording, all recent BoA decisions consistently took all the features of appearance into account in order to determine whether the contested design was solely dictated by the technical function of the product.
- 16 This position is consistent with recent judgments. In **Fluid distribution equipment**¹³, the GC conceded that the BoA had used inconsistent terminology in its decision but held that Article 8(1) CDR was nevertheless correctly applied because the BoA had unequivocally concluded that *'all the features of appearance of the product concerned fulfil only its technical function'*.
- 17 In **Building blocks from a toy building set** (or 'Lego' case)¹⁴, the GC, interpreting **DOCERAM**, stated that *'It follows that a design must be declared invalid if all the features of its appearance are solely dictated by the technical function of the product concerned by that design (see, to that effect, judgment of 8 March 2018, DOCERAM, C-395/16, EU:C:2018:172, paragraph 32)'* and *'all the features of appearance of the product concerned by the contested design must be solely technical in order for that design to be declared invalid pursuant to Article 8(1) CDR'*. Consequently, it annulled the BoA decision because it considered that one feature of the appearance of the design was absent from the features identified by the Board, namely the *'smooth surface of the upper face of the product'*. The GC considered that this element constituted a feature of appearance of the product and, therefore, should have been taken into account in the analysis done by the Board.
- 18 Furthermore, it is important to recall that design law aims to protect the product's appearance, that is, the features composing the design. Therefore, design protection should only be denied if the entire appearance of the product covered by the design results from nothing but the technical function of the product. On the contrary, if one of the features of the design was not proven to be exclusively dictated by the technical function of the product of concern, the design should not be declared invalid under Article 8(1) CDR.
- 19 It follows from the above that the case-law is consistent in finding that **all features** (and not only the essential features) of appearance of the design should be identified in the context of Article 8(1) CDR.

3.2 The features to be taken into account

- 20 Next, the question arises to which level of detail the features should be identified.

¹² 02/06/2020, R 896/2019-3, Seats, § 26-27

¹³ 18/11/2020, T-574/19, Fluid distribution equipment, EU:T:2020:543, § 60

¹⁴ 24/03/2021, T-515/19, Building blocks from a toy building set, EU:T:2021:155, § 96, 113

- 21 In principle, the Office will proceed on the basis of the features identified by the parties. However, in the examination of the invalidity application, it is the **obligation of the Office** to correctly identify all the features of appearance of the contested design. In **Lego**¹⁵, the GC confirmed that the Office must identify all features irrespective of the parties' submissions.
- 22 Article 3(a) CDR gives a non-exhaustive list of what can be considered as 'features of appearance' of the product (lines, contours, colours, shape, texture, materials). In **Fluid distribution equipment**, the GC emphasises the importance of identifying the features of the design on a case-by-case basis, in consideration of the product in question. In that exercise, the Board, while proceeding **primarily from a visual analysis of the representation** of the contested design as registered, may take into account additional evidence that explains the function of the feature and/or the product and the relationship between its appearance and the function of the product, such as, for instance, promotional material issued by the design holder¹⁶.
- 23 As regards **colour or material of a feature**, although there is no clear guidance yet from the courts, the question may arise as to what extent they may have an impact on the assessment, i.e. whether they are to be considered features in themselves for which technical functionality must be established¹⁷.
- 24 In case of a **composite product**, the GC confirms in **Fluid distribution equipment**¹⁸, that in the specific case where a product is composed of individual parts, the BoA is not obliged to identify the features within the parts of the composite product. The features to be identified are the parts of the product themselves¹⁹.

4. Conclusions

- 25 The case-law analysis shows that despite the reference to 'essential features' in some decisions, there is consistency within the BoA and with the case-law of the EU courts in that a design be declared invalid pursuant to Article 8(1) CDR only when all the features of appearance of the product are found to be solely dictated by its technical function.
- 26 The following conclusions can be drawn to maintain consistency:
- (i) The features of appearance of the contested design should be identified *ex officio*, taking into account the parties' submissions in that respect.
 - (ii) **All features** (and not only the essential features) of appearance of the contested design should be identified in the context of Article 8(1) CDR.

¹⁵ 24/03/2021, T-515/19, Building blocks from a toy building set, EU:T:2021:155, § 105-108

¹⁶ 18/11/2020, T-574/19, Fluid distribution equipment, EU:T:2020:543, § 42

¹⁷ For a case where the colour of the product was assessed as an element of one feature of a design: see 05/07/2021, Remote controls [wireless](Accessories for -), R 1070/2020-3, § 29 – pending before the GC under T-611/21.

¹⁸ 18/11/2020, T-574/19, Fluid distribution equipment, EU:T:2020:543, § 47

¹⁹ Although the judgment refers to '*the complex nature of the products*' or '*the complexity of the product*' it would appear more fortunate to use instead the terms '*composite product*' or a '*product composed of several individual parts*' in order to avoid any confusion with the concept of '*complex product*' within the meaning of Article 3(c) CDR.

- (iii) It is only where **all the features** of the design identified are found to be **solely** dictated by the technical function of the product that the design is to be declared invalid pursuant to Article 8(1) CDR.

Annex I
List of cases reviewed

Court of Justice and General Court

08/03/2018, C-395/16, DOCERAM, EU:C:2018:172

04/07/2017, T-90/16, Measuring instruments, apparatus and devices, EU:T:2017:464

18/11/2020, T-574/19, Fluid distribution equipment, EU:T:2020:543

24/03/2021, T-515/19, Building blocks from a toy building set, EU:T:2021:155

10/11/2021, T-443/20, Labels, EU:T:2021:767

26/01/2022, T-325/20, Water purifiers, EU:T:2022:23

Boards of Appeal

04/04/2019, R 1270/2018-3, Hinges

10/04/2019, R 31/2018-3, Building blocks from a toy building set (24/03/2021, T-515/19, Building blocks from a toy building set, EU:T:2021:155 – decision annulled)

12/06/2019, R 1002/2018-3, Fluid distribution equipment (18/11/2020, T-574/19, Fluid distribution equipment, EU:T:2020:543 – decision confirmed)

20/01/2020, R 865/2017-3, Spray guns (part of -)

26/02/2020, R 740/2018-3, Water purifiers (26/01/2022, T-325/20, Water purifiers, EU:T:2022:23 – decision confirmed)

12/03/2020, R 1484/2018-3, Battens

12/03/2020, R 1485/2018-3, Battens

17/03/2020, R 2664/2017-3, Shower drains (pending before the GC under T-327/20)

02/04/2020, R 510/2019-3, Part of heating systems

15/05/2020, R 2413/2018-3, Labels (10/11/2021, T-443/20, Labels, EU:T:2021:767 – decision confirmed)

02/06/2020, R 896/2019-3, Seats

07/12/2020, R 69/2019-3, Elektrische Steckverbinder

10/05/2021, R 440/2020-3, Handheld kitchen cutting appliances

15/02/2021, R 2068/2019-3, Posts (pending before the GC under T-231/21)

09/06/2021, R 1003/2018-3, Fluid distribution equipment (pending before the GC under T-505/21)

16/06/2021, R 1004/2018-3, Fluid distribution equipment (pending before the GC under T-535/21)

16/06/2021, R 1011/2018-3, Fluid distribution equipment (pending before the GC under T-545/21)