

CJEU provides guidance on design functionality

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Legal updates: case law analysis and intelligence

- The CJEU has provided guidance on the assessment of whether the features of appearance of a product are dictated solely by its technical function under Article 8(1) of Regulation 6/2002
- The CJEU considered the significance that should be attached to the fact that the proprietor of the design at issue also holds rights for numerous alternative designs
- It also considered whether it was necessary to take into account the fact that the design allows for a multicolour appearance where the colour design was not apparent from the registration

In a judgment of 2 March 2023, [Papierfabrik Doetinchem BV v Sprick GmbH Bielefelder Papier- und Wellpappenwerk & Co](#) (Case C-684/21), the Court of Justice of the European Union (CJEU) (Tenth Chamber) has ruled on the significance that should be attached to the fact that the proprietor of the design at issue owns numerous alternative designs in the assessment of whether the features of appearance of the product are dictated solely by its technical function in the sense of Article 8(1) of [Regulation 6/2002](#).

Background

This referral for a preliminary ruling by the Düsseldorf Higher Regional Court has a long history. Sprick GmbH owns the following registered Community design (RCD) for a packaging-paper dispenser:



The company filed an infringement suit against Papierfabrik Doetinchem, a competitor. Papierfabrik Doetinchem filed a counterclaim for invalidation of the RCD on the ground that all its features were dictated solely by their technical function (Article 8(1) of Regulation 6/2002).

The first-instance court upheld Sprick's claim and dismissed the counterclaim, holding that the existence of numerous design alternatives showed that the features of the design at issue were not dictated solely by its technical function. On appeal, by contrast, the Düsseldorf Higher Regional Court invalidated the design at issue.

Upon further appeal, this time by Sprick, the German Federal Court of Justice sided with the first-instance court and referred the dispute back to the Higher Regional Court for reconsideration, as it had erred in law by:

- attaching too much weight to the importance of the parallel patent invoked by Sprick (which contained drawings identical to the designs at issue); instead, the court should have focused on whether visual considerations had not also played a role in the choice to configure the product concerned as consisting of two components, which make a two-colour appearance possible; and
- disregarding the number of alternative designs to the design at issue held by Sprick - interpreting the CJEU's leading case on design functionality and the role of alternative registered designs, [DOCERAM GmbH v Ceram Tec GmbH](#) (C-396/16).

During its reassessment of the case, the Higher Regional Court, disagreeing with the Federal Court, stuck to its interpretation of the CJEU's decision in *DOCERAM*, decided to stay the proceedings and referred two questions to the CJEU, essentially asking:

- which significance should be attached, in the assessment of the technical functionality of a design, to the fact that the proprietor of the design also holds design rights for numerous alternative designs; and
- whether, to exclude the application of Article 8(1) of Regulation 6/2002, it must be taken into account that the design allows for a multicolour appearance in the case where that colour design is not, as such, apparent from the registration of the design.

Decision

The CJEU underlined that regard must be had to all objective circumstances relevant to each case, *inter alia* those dictating the choice of features of appearance and the fact that the proprietor of the design in question also holds design rights for numerous alternative designs - although the latter is not decisive for the application of Article 8(1).

Moreover, the fact that the design of a product allows for a multicolour appearance cannot be taken into account for the functionality assessment where that multicolour appearance is not apparent from the registration of the design concerned.

Comment

On the rather abstract level of interpretation (here, of the functionality exclusion under Article 8(1) of Regulation 6/2002 and of its own leading case in *DOCERAM*), the CJEU substantively confirmed its tendency to keep the applicability of the technical functionality exception quite broad, in contrast to the interpretation of the German Federal Court of Justice.

Not unexpectedly, in the substance it sided with the Düsseldorf Higher Regional Court (with the first question having already been answered in *DOCERAM*), thus strengthening the appellate court's position in its legal dispute with the German Federal Court of Justice. A continuation of the infringement case within the German hierarchy of courts is to be expected.

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