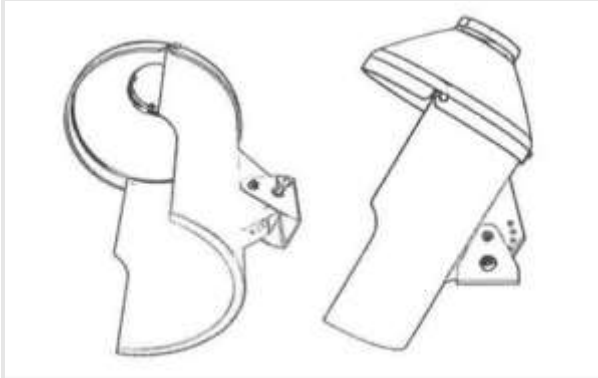


Court of Justice EU, 2 February 2023, Papierfabriek Doetinchem v Sprick



DESIGN LAW

Dictated by technical function ([article 8\(1\) CDR](#))

The assessment as to whether the features of appearance of a product are dictated solely by its technical function, within the meaning of that provision, must be made having regard to all of the objective circumstances relevant to each case, inter alia

- [those dictating the choice of features of appearance,](#)
- [the existence of alternative designs which fulfil the same technical function, and](#)
- [the fact that the proprietor of the design in question also holds design rights for numerous alternative designs, although that latter fact is not decisive for the application of that provision.](#)

20 Article 8(1) of Regulation No 6/2002, which, as is apparent from recital 10 of that regulation, is intended to prevent technological innovation from being hampered, provides that a Community design is not to subsist in features of the appearance of a product which are dictated solely by its technical function. That provision therefore excludes from the protection conferred by that regulation a case in which the need to fulfil a technical function of the product concerned is the only factor determining the choice by the designer of a feature of appearance of that product, while considerations of another nature, in particular those related to its visual aspect, have not played a role in the choice of that feature (see, to that effect, [judgment of 8 March 2018, DOCERAM, C-395/16, EU:C:2018:172](#), paragraphs 26, 29 and 31).

21 As regards, in particular, the existence of alternative designs fulfilling the same function as that of the product concerned, the Court has held that, if that circumstance was sufficient in itself to exclude the application of Article 8(1) of Regulation No 6/2002, a single economic operator would be able to obtain several registrations as a Community design of different possible forms of a product incorporating features of appearance of that product which are dictated solely by its technical function. That would enable such an operator to benefit, with regard to such a product, from exclusive protection

which is, in practice, equivalent to that offered by a patent, but without being subject to the conditions applicable for obtaining the latter, which would prevent competitors from offering a product incorporating certain functional features or limit the possible technical solutions, thereby depriving Article 8(1) of its full effectiveness. The existence of alternative designs is therefore not decisive for the application of that provision (see, to that effect, [judgment of 8 March 2018, DOCERAM, C-395/16, EU:C:2018:172](#), paragraphs 30 and 32). That also applies where there are multiple alternative designs registered by the proprietor of the design at issue.

22 Furthermore, it should be noted that, in order to determine whether the relevant features of appearance of a product are covered by Article 8(1) of Regulation No 6/2002, it is for the national court to take account of all the objective circumstances relevant to each individual case. Such an assessment must be made, in particular, having regard to the design at issue, the objective circumstances indicative of the reasons which dictated the choice of features of appearance of the product concerned, or information on its use or the existence of alternative designs which fulfil the same technical function, provided that those circumstances, data, or information as to the existence of alternative designs are supported by reliable evidence (see, to that effect, [judgment of 8 March 2018, DOCERAM, C-395/16, EU:C:2018:172](#), paragraphs 36 and 37).

Technical function – allowing a multicolour appearance – can only be taken into account if it is apparent from the registration of the design

- [in the assessment as to whether the appearance of a product is dictated solely by its technical function, the fact that the design of that product allows for a multicolour appearance cannot be taken into account in the case where that multicolour appearance is not apparent from the registration of the design concerned.](#)

28 On the one hand, the competent authorities must know with clarity and precision the nature of the constituent elements of a design in order to be able to fulfil their obligations in relation to the prior examination of applications for registration and to the publication and maintenance of an appropriate and precise register of designs. On the other hand, economic operators must be able to acquaint themselves, with clarity and precision, with registrations or applications for registration made by their current or potential competitors and thus to obtain relevant information about the rights of third parties. Such a requirement is thus intended to ensure legal certainty for third parties ([judgment of 5 July 2018, Mast-Jägermeister v EUIPO, C-217/17 P, EU:C:2018:534](#), paragraphs 53 and 54 and the case-law cited).

29 Furthermore, Article 36(1)(c) of Regulation No 6/2002 provides that the application for registration of a Community design must contain a ‘representation of the design suitable for reproduction’.

30 In this connection, the Court has held that the representation of a design for which registration is sought must enable that design to be identified clearly ([judgment of 28 October 2021, Ferrari, C-123/20, EU:C:2021:889](#), paragraph 39 and the case-law cited).

The function of the graphic representation requirement is, in particular, to define the design itself in order to determine the precise subject of the protection afforded by the registered design to its proprietor ([judgment of 5 July 2018, Mast-Jägermeister v EUIPO, C-217/17 P, EU:C:2018:534](#), paragraphs 51 and 52) and to comply with the objectives specified in paragraphs 27 and 28 of the present judgment.

31 It must accordingly be held that the mere possibility of a multicolour appearance allowed by the two-part configuration of the product concerned is subjective in nature if that multicolour appearance does not appear in the representation of the design at issue in the main proceedings and cannot be sufficient, as such, to exclude the application of the exclusion provided for in Article 8(1) of Regulation No 6/2002. The opposite interpretation could lead to a lack of precision or certainty regarding the precise matter to be protected by the design and could undermine legal certainty.

Source: [ECLU:EU:C:2023:141](#)

Court of Justice EU, 2 March 2023

(M. Ilešič, I. Jarukaitis (rapporteur) en Z. Csehi)

JUDGMENT OF THE COURT (Tenth Chamber)

2 March 2023 (*1)

(Reference for a preliminary ruling – Intellectual property – Community designs – Regulation (EC) No 6/2002 – Article 8(1) – Features of appearance of a product dictated solely by its technical function – Criteria for assessment – Existence of alternative designs – Proprietor also holding a multitude of alternative protected designs – Multicolour appearance of a product not reflected in the registration of the design concerned)

In Case C-684/21,

REQUEST for a preliminary ruling under Article 267 TFEU from the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany), made by decision of 4 November 2021, received at the Court on 12 November 2021, in the proceedings

Papierfabriek Doetinchem BV

v

Sprick GmbH Bielefelder Papier- und Wellpappenwerk & Co.,

THE COURT (Tenth Chamber),

composed of M. Ilešič, acting as President of the Tenth Chamber, I. Jarukaitis (Rapporteur) and Z. Csehi, Judges,

Advocate General: M. Campos Sánchez-Bordona,

Registrar: A. Calot Escobar,

having regard to the written procedure,

after considering the observations submitted on behalf of:

- Papierfabriek Doetinchem BV, by C. Böhmer and C. Menebröcker, Rechtsanwälte,

- Sprick GmbH Bielefelder Papier- und Wellpappenwerk & Co., by S. Rojahn, Rechtsanwältin,

- the European Commission, by P. Němečková, J. Samnadda and T. Scharf, acting as Agents,

having decided, after hearing the Advocate General, to proceed to judgment without an Opinion,

gives the following

Judgment

1 This request for a preliminary ruling concerns the interpretation of Article 8(1) and Article 10 of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1).

2 The request has been made in proceedings between Papierfabriek Doetinchem BV and Sprick GmbH Bielefelder Papier- und Wellpappenwerk & Co. ('Sprick') concerning an action for infringement, on the ground of an alleged infringement of the rights conferred by a Community design of which Sprick is the proprietor.

Legal context

3 Under recital 10 of Regulation No 6/2002:

'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. Likewise, the interoperability of products of different makes should not be hindered by extending protection to the design of mechanical fittings. Consequently, those features of a design which are excluded from protection for those reasons should not be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection.'

4 Article 3 of that regulation, entitled 'Definitions', provides:

'For the purposes of this Regulation:

(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;

(b) "product" means any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs;

...'

5 Under Article 6 of that regulation, entitled 'Individual character':

'1. A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public ...'

6 Article 8 of that regulation, entitled 'Designs dictated by their technical function and designs of interconnections', provides in paragraph 1:

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

7 Article 10 of Regulation No 6/2002, entitled 'Scope of protection', provides in paragraph 1:

'The scope of the protection conferred by a Community design shall include any design which does not produce on the informed user a different overall impression.'

8 Under Article 36 of that regulation, entitled 'Conditions with which applications must comply':

'1. An application for a registered Community design shall contain:

(a) a request for registration;

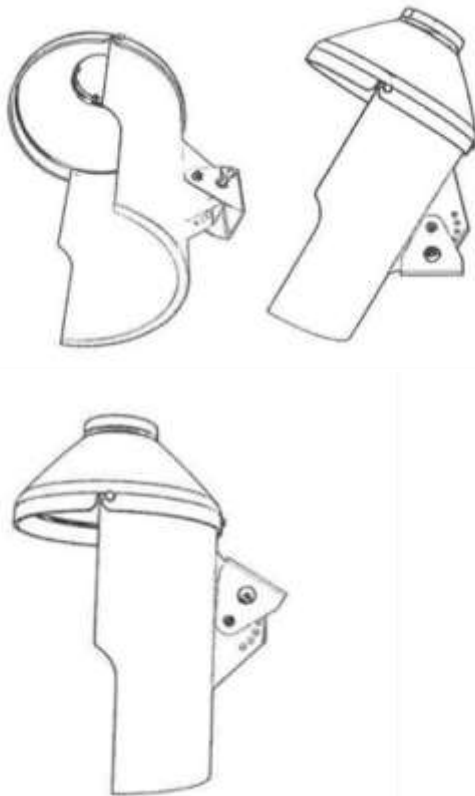
(b) information identifying the applicant;

(c) a representation of the design suitable for reproduction. ...

...'

The dispute in the main proceedings and the questions referred for a preliminary ruling

9 Sprick is a company manufacturing a packing-paper dispenser. It is the proprietor of Community design No 001344022-0006 concerning a packing device, applied for on 19 September 2012 and registered and published on 17 October 2012, and which is shown below:



10 Papierfabriek Doetinchem manufactures and markets a product competing with that manufactured by Sprick.

11 Relying on an infringement of the rights conferred by the design at issue in the main proceedings, Sprick brought an action against Papierfabriek Doetinchem before the Landgericht Düsseldorf (Regional Court, Düsseldorf, Germany) seeking, inter alia, the discontinuation of that infringement. Papierfabriek

Doetinchem brought a counterclaim for cancellation of the design on the ground that all its features were dictated solely by their technical function.

12 By judgment of 18 May 2017, the Landgericht Düsseldorf (Regional Court, Düsseldorf) upheld Sprick's application and dismissed Papierfabriek Doetinchem's counterclaim on the ground that, in view of the existence of 'numerous design alternatives' for that product, the features of the design at issue in the main proceedings were not dictated solely by its technical function.

13 Papierfabriek Doetinchem appealed against that judgment to the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany). The latter, by judgment of 27 June 2019, declared the design at issue in the main proceedings to be invalid, on the ground that all of its features were dictated by the technical function of that product. In that connection, the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf) took into account the patent application publication invoked by Sprick, EP 2897793, according to which all the features of that product were explained as being technically advantageous, and found, on the basis of the [judgment of 8 March 2018, DOCERAM \(C-395/16, EU:C:2018:172\)](#), that the existence of 'viable design alternatives' was irrelevant.

14 Following an appeal by Sprick, the Bundesgerichtshof (Federal Court of Justice, Germany) set the judgment of the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf) aside and referred the dispute back to that court for reconsideration. The Bundesgerichtshof (Federal Court of Justice) took the view that the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf) had attached too much importance to the patent application publication invoked by Sprick, EP 2897793, had erred in law in its assessment of the other circumstances and had failed to take all relevant aspects of the case into account. According to the Bundesgerichtshof (Federal Court of Justice), the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf) should have examined whether visual considerations had not also played a role in the choice to configure the product concerned as consisting of two components, because it makes possible the two-colour appearance, as the product actually marketed demonstrates. Furthermore, the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf) should not have disregarded the fact that Sprick held a number of designs for alternative forms of design which pursue the same technical function as that pursued by the product created according to the design at issue in the main proceedings.

15 Following the referral of the case in the main proceedings back to the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf), which is the referring court, the latter takes the view that paragraph 30 of the [judgment of 8 March 2018, DOCERAM \(C-395/16, EU:C:2018:172\)](#), supports an interpretation according to which the existence of other designs is of minor importance in the overall assessment of the objective circumstances of the case under Article 8(1) of

Regulation No 6/2002, where the proprietor of the design at issue also claims design protection for those other designs.

16 With regard to the assessment of the Bundesgerichtshof (Federal Court of Justice) that the referring court should have examined whether the two-part configuration of the product at issue apparent from the design at issue in the main proceedings was not based on visual considerations, since that design allowed for a two-colour appearance which is not dictated by the technical function of that product, that court points out that the two-colour appearance is not apparent from the registration of the design.

17 In those circumstances the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf) decided to stay the proceedings and to refer the following questions to the Court of Justice for a preliminary ruling:

'(1) According to the case-law of the Court of Justice, the assessment as to whether the features of appearance of a product are dictated solely by its technical function must be made having regard to the design at issue, the objective circumstances indicative of the reasons which dictated the choice of features of appearance of the product concerned, information on its use or the existence of alternative designs which fulfil the same technical function (judgment of 8 March 2018, DOCERAM, C-395/16, EU:C:2018:172). With regard to the aspect of the existence of other designs, what significance is attached to the fact that the proprietor of the design also holds design rights for numerous alternative designs?

(2) In the assessment as to whether the appearance is dictated solely by the technical function, is it necessary to take into account the fact that the design allows for a multicolour appearance in the case where the colour design is not, as such, apparent from the registration?

(3) If Question 2 is answered in the affirmative: Does this affect the scope of protection of the design?'

Consideration of the questions referred

The first question

18 By its first question, the referring court asks, in essence, whether Article 8(1) of Regulation No 6/2002 must be interpreted as meaning that the assessment as to whether the features of appearance of a product are dictated solely by its technical function, within the meaning of that provision, must be made having regard to the objective circumstances dictating the choice of features of appearance, the existence of alternative designs which fulfil the same technical function, or the fact that the proprietor of the design at issue also holds design rights for numerous alternative designs.

19 In that connection, it should be noted that Article 3(a) of Regulation No 6/2002 defines 'design' as 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. Consequently, under the system laid down by that regulation, appearance is the decisive factor for a design (**judgments of 8 March 2018, DOCERAM, C-395/16, EU:C:2018:172,**

paragraph 25 and the case-law cited, and of **28 October 2021, Ferrari, C-123/20, EU:C:2021:889,** paragraph 30).

20 Article 8(1) of Regulation No 6/2002, which, as is apparent from recital 10 of that regulation, is intended to prevent technological innovation from being hampered, provides that a Community design is not to subsist in features of the appearance of a product which are dictated solely by its technical function. That provision therefore excludes from the protection conferred by that regulation a case in which the need to fulfil a technical function of the product concerned is the only factor determining the choice by the designer of a feature of appearance of that product, while considerations of another nature, in particular those related to its visual aspect, have not played a role in the choice of that feature (see, to that effect, **judgment of 8 March 2018, DOCERAM, C-395/16, EU:C:2018:172,** paragraphs 26, 29 and 31).

21 As regards, in particular, the existence of alternative designs fulfilling the same function as that of the product concerned, the Court has held that, if that circumstance was sufficient in itself to exclude the application of Article 8(1) of Regulation No 6/2002, a single economic operator would be able to obtain several registrations as a Community design of different possible forms of a product incorporating features of appearance of that product which are dictated solely by its technical function. That would enable such an operator to benefit, with regard to such a product, from exclusive protection which is, in practice, equivalent to that offered by a patent, but without being subject to the conditions applicable for obtaining the latter, which would prevent competitors from offering a product incorporating certain functional features or limit the possible technical solutions, thereby depriving Article 8(1) of its full effectiveness. The existence of alternative designs is therefore not decisive for the application of that provision (see, to that effect, **judgment of 8 March 2018, DOCERAM, C-395/16, EU:C:2018:172,** paragraphs 30 and 32). That also applies where there are multiple alternative designs registered by the proprietor of the design at issue.

22 Furthermore, it should be noted that, in order to determine whether the relevant features of appearance of a product are covered by Article 8(1) of Regulation No 6/2002, it is for the national court to take account of all the objective circumstances relevant to each individual case. Such an assessment must be made, in particular, having regard to the design at issue, the objective circumstances indicative of the reasons which dictated the choice of features of appearance of the product concerned, or information on its use or the existence of alternative designs which fulfil the same technical function, provided that those circumstances, data, or information as to the existence of alternative designs are supported by reliable evidence (see, to that effect, **judgment of 8 March 2018, DOCERAM, C-395/16, EU:C:2018:172,** paragraphs 36 and 37).

23 Having regard to the foregoing considerations, the answer to the first question is that Article 8(1) of

Regulation No 6/2002 must be interpreted as meaning that the assessment as to whether the features of appearance of a product are dictated solely by its technical function, within the meaning of that provision, must be made having regard to all of the objective circumstances relevant to each case, inter alia those dictating the choice of features of appearance, the existence of alternative designs which fulfil the same technical function, and the fact that the proprietor of the design in question also holds design rights for numerous alternative designs, although that latter fact is not decisive for the application of that provision.

The second question

24 By its second question, the referring court asks, in essence, whether Article 8(1) of Regulation No 6/2002 must be interpreted as meaning that, in the assessment as to whether the appearance of a product is dictated solely by its technical function, it is necessary to take into account the fact 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 in question.

25 In that connection, account must be taken of the case-law cited in paragraphs 19 and 22 of the present judgment concerning appearance as the essential element of the protection conferred by a design and the circumstances that must be taken into account in order to assess whether the features of appearance of a product are dictated solely by its technical function, within the meaning of Article 8(1) of Regulation No 6/2002.

26 It should also be noted that visual considerations, such as a design consisting of two components allowing for the multicolour appearance of a product, may, in principle, form part of the circumstances to be taken into account in the context of this assessment, without, however, being in themselves decisive.

27 With more specific regard to the question of whether the fact that the design of a product allows for its multicolour appearance to be taken into account in the case of a registered design, when this multicolour appearance does not appear in the registration concerned, it should be recalled that the entry of a design in a public register has the aim of making it accessible to the competent authorities and the public, in particular to economic operators ([judgment of 5 July 2018, Mast-Jägermeister v EUIPO, C-217/17 P, EU:C:2018:534](#), paragraph 53).

28 On the one hand, the competent authorities must know with clarity and precision the nature of the constituent elements of a design in order to be able to fulfil their obligations in relation to the prior examination of applications for registration and to the publication and maintenance of an appropriate and precise register of designs. On the other hand, economic operators must be able to acquaint themselves, with clarity and precision, with registrations or applications for registration made by their current or potential competitors and thus to obtain relevant information about the rights of third parties. Such a requirement is thus intended to ensure legal certainty for third parties ([judgment of 5 July 2018, Mast-Jägermeister v](#)

[EUIPO, C-217/17 P, EU:C:2018:534](#), paragraphs 53 and 54 and the case-law cited).

29 Furthermore, Article 36(1)(c) of Regulation No 6/2002 provides that the application for registration of a Community design must contain a ‘representation of the design suitable for reproduction’.

30 In this connection, the Court has held that the representation of a design for which registration is sought must enable that design to be identified clearly ([judgment of 28 October 2021, Ferrari, C-123/20, EU:C:2021:889](#), paragraph 39 and the case-law cited). The function of the graphic representation requirement is, in particular, to define the design itself in order to determine the precise subject of the protection afforded by the registered design to its proprietor ([judgment of 5 July 2018, Mast-Jägermeister v EUIPO, C-217/17 P, EU:C:2018:534](#), paragraphs 51 and 52) and to comply with the objectives specified in paragraphs 27 and 28 of the present judgment.

31 It must accordingly be held that the mere possibility of a multicolour appearance allowed by the two-part configuration of the product concerned is subjective in nature if that multicolour appearance does not appear in the representation of the design at issue in the main proceedings and cannot be sufficient, as such, to exclude the application of the exclusion provided for in Article 8(1) of Regulation No 6/2002. The opposite interpretation could lead to a lack of precision or certainty regarding the precise matter to be protected by the design and could undermine legal certainty.

32 In the light of the foregoing considerations, the answer to the second question is that Article 8(1) of Regulation No 6/2002 must be interpreted as meaning that, in the assessment as to whether the appearance of a product is dictated solely by its technical function, the fact that the design of that product allows for a multicolour appearance cannot be taken into account in the case where that multicolour appearance is not apparent from the registration of the design concerned.

The third question

33 By its third question, the referring court asks, in essence, whether, if the second question is answered in the affirmative, Regulation No 6/2002 must be interpreted as meaning that the fact that the design of the product concerned allows a multicolour appearance, although this is not apparent, as such, from the registration of the design concerned, has an effect on the scope of the protection conferred by that design.

34 In view of the answer given to the second question, there is no need to answer that third question.

Costs

35 Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national court, the decision on costs is a matter for that court. Costs incurred in submitting observations to the Court, other than the costs of those parties, are not recoverable.

On those grounds, the Court (Tenth Chamber) hereby rules:

1. Article 8(1) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs must be

interpreted as meaning that the assessment as to whether the features of appearance of a product are dictated solely by its technical function, within the meaning of that provision, must be made having regard to all of the objective circumstances relevant to each case, inter alia those dictating the choice of features of appearance, the existence of alternative designs which fulfil the same technical function, and the fact that the proprietor of the design in question also holds design rights for numerous alternative designs, although that latter fact is not decisive for the application of that provision.

2. Article 8(1) of Regulation No 6/2002 must be interpreted as meaning that, in the assessment as to whether the appearance of a product is dictated solely by its technical function, the fact that the design of that product allows for a multicolour appearance cannot be taken into account in the case where that multicolour appearance is not apparent from the registration of the design concerned.
