Reports of Cases

JUDGMENT OF THE COURT (Second Chamber)

8 March 2018 *

(Reference for a preliminary ruling — Intellectual and industrial property — Regulation (EC) No 6/2002 — Community design — Article 8(1) — Features of appearance of a product solely dictated by its technical function — Criteria for assessment — Existence of alternative designs — Consideration of the point of view of an 'objective observer')

In Case C-395/16,

REQUEST for a preliminary ruling under Article 267 TFEU from the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany), made by decision of 7 July 2016, received at the Court on 15 July 2016, in the proceedings

DOCERAM GmbH

v

CeramTec GmbH,

THE COURT (Second Chamber),

composed of M. Ilešič, President of the Chamber, K. Lenaerts, President of the Court, acting as Judge of the Second Chamber, A. Rosas, C. Toader and E. Jarašiūnas (Rapporteur), Judges,

Advocate General: H. Saugmandsgaard Øe,

Registrar: M. Aleksejev, Administrator,

having regard to the written procedure and further to the hearing on 29 June 2017,

after considering the observations submitted on behalf of:

– DOCERAM GmbH, by M. Bergermann, Rechtsanwalt, and P. Rätsch, Patentanwalt,

– CeramTec GmbH, by M.A. Mittelstein and A. Bothe, Rechtsanwälte,

– the Greek Government, by G. Alexaki, acting as Agent,

– the United Kingdom Government, by J. Kraehling and G. Brown acting as Agents, and by B. Nicholson, Barrister,

– the European Commission, by J. Samnadda and T. Scharf, acting as Agents,

* Language of the case: German.

after hearing the Opinion of the Advocate General at the sitting on 19 October 2017,

gives the following

Judgment

1 This request for a preliminary ruling concerns the interpretation of Article 8(1) 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 DOCERAM GmbH and CeramTec GmbH concerning an infringement of Community designs.

Legal context

3 According to recitals 5, 7 and 10 of Regulation 6/2002:

‘(5) This calls for the creation of a Community design which is directly applicable in each Member State, because only in this way will it be possible to obtain, through one application made to the Office for Harmonisation in the Internal Market (Trade Marks and Design) in accordance with a single procedure under one law, one design right for one area encompassing all Member States.

…

(7) Enhanced protection for industrial design not only promotes the contribution of individual designers to the sum of Community excellence in the field, but also encourages innovation and development of new products and investment in their production.

…

(10) 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 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 Article 4 of Regulation No 6/2002, entitled ‘Requirements for protection’, provides in paragraph 1 as follows:

‘A design shall be protected by a Community design to the extent that it is new and has individual character.’

6 Article 5 of that regulation, headed ‘Novelty’, states:

‘1. A design shall be considered to be new if no identical design has been made available to the public …

…

2. Designs shall be deemed to be identical if their features differ only in immaterial details.

7 Article 6 of Regulation No 6/2002, entitled ‘Individual character’, provides:

‘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:

…’

8 Article 8(1) of that regulation provides:

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

9 Article 10(1) of that regulation states:

‘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.’

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

10 DOCERAM is a company manufacturing technical ceramic components. In particular, it supplies weld centring pins to customers in the automotive, textile machinery and machinery industries. It is the proprietor of a number of registered Community designs which protect centring pins for welding in three different geometrical shapes, each of which is produced in six different types.

11 CeramTec also manufactures and sells centring pins in the same variants as those protected by the designs of which DOCERAM is the proprietor.

12 Relying on an infringement of its Community designs, DOCERAM brought an action against CeramTec before the Landgericht Düsseldorf (Regional Court, Düsseldorf, Germany), seeking an order for CeramTec to discontinue the infringement of its intellectual property rights. The latter brought a counterclaim for a declaration of invalidity of the contested designs, maintaining that the features of appearance of the products in question were dictated solely by their technical function.

13 The Landgericht Düsseldorf (Regional Court, Düsseldorf) dismissed the action brought by DOCERAM and declared the designs at issue to be invalid on the ground that they were excluded from the protection afforded by Article 8(1) of Regulation No 6/2002.

14 DOCERAM appealed against that judgment to the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany). In particular, that court observes, first, that the designs at issue are new and have an individual character and, second, alternative designs of the centring pins concerned exist which are not protected by the Community law on designs. Therefore, that court considers that for the purposes of the application of the exclusion laid down in Article 8(1) of Regulation No 6/2002, it is necessary to establish whether the existence of those alternative designs leads to the conclusion that the features of appearance of those products are not covered by Article 8(1) of Regulation No 6/2002, or whether it is also necessary to ascertain whether the technical function was the only factor which dictated those features.

15 That court points out that there are differing approaches in the case-law and in legal literature on that question. One approach is that the sole criterion for the application of Article 8(1) of Regulation No 6/2002 is the existence of alternative designs which fulfil the same technical function, which demonstrates that the design at issue is not dictated solely by reason of its technical function within the meaning of that provision. The opposing view is that that provision is applicable where the various features of appearance of the product are dictated solely by the need to achieve a technical solution and that the aesthetic considerations are entirely irrelevant. In that case there is no creative effort worthy of protection as a design.

16 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) Are the features of appearance of a product solely dictated by its technical function, within the meaning of Article 8(1) of [Regulation No 6/2002] which excludes protection, also if the design effect is of no significance for the product design, but the (technical) functionality is the sole factor that dictates the design?

(2) If the Court answers Question 1 in the affirmative: From which point of view is it to be assessed whether the individual features of appearance of a product have been chosen solely on the basis of considerations of functionality? Is an “objective observer” required and, if so, how is such an observer to be defined?’

Consideration of the questions referred

The first question

17 By its first question, the referring court asks essentially if Article 8(1) of Regulation No 6/2002 must be interpreted as meaning that, in order to ascertain whether the features of appearance of a product are solely dictated by its function, the existence of alternative designs is decisive, or whether it must be established that function is the only factor which dictated those characteristics.

18 According to Article 8(1) of Regulation No 6/2002, a Community design does not subsist in features of appearance of a product which are solely dictated by its technical function.

19 As regards the expression ‘features of appearance of a product which are solely dictated by its technical function’, neither Article 8(1) of Regulation No 6/2002 nor any other provisions of that regulation nor even Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs (OJ 1998 L 289, p. 28) which, as the Advocate General observed in point 36 of his Opinion, serves as the basis for the content of Article 8(1), sets out what is meant by that expression. Furthermore, the regulation and the directive make no reference to national laws as regards the meaning to be given to those terms.

20 According to the Court's settled case-law, it follows from the need for a uniform application of EU law that, where a provision thereof makes no reference to the law of the Member States with regard to a particular concept, that concept must be given an autonomous and uniform interpretation throughout the European Union which must take into account the context of the provision and the objective pursued by the legislation in question (judgments of 19 July 2012, *A*, C-33/11, EU:C:2012:482, paragraph 27, and of 7 September 2017, *Schottelius*, C-247/16, EU:C:2017:638, paragraph 31 and the case-law cited).

21 Therefore, the expression 'features of the appearance of a product which are solely dictated by its technical function' designates an autonomous concept of EU law which must be interpreted in a uniform manner in all the Member States.

22 First of all, as regards the wording of Article 8(1) of Regulation No 6/2002, it must be held that in the absence of any definition of that expression that regulation does not lay down any criteria for determining whether the relevant features of appearance of a product are solely dictated by its technical function. Therefore, it does not follow from that article or any other provisions of that regulation that the existence of alternative designs which fulfil the same technical function as that of the product concerned is the only criterion for determining the application of that article.

23 Next, as regards the context of Article 8(1) of Regulation No 6/2002, it must be observed that that provision appears in Section 1 of Title II thereof, entitled 'Requirements for protection', and refers to cases in which protection is not conferred by a Community design on the features of appearance of a product where they are dictated solely by its technical function. According to recital 10 of that regulation, it does not follow from the exclusion of protection in that case that a design must have an aesthetic quality. Thus, as the Advocate General observed, in point 27 of his Opinion, it is not essential for the appearance of the product in question to have an aesthetic aspect to be protected under that regulation.

24 However, 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. Furthermore, Article 6(1) thereof, concerning the individual character of the design, which is one of the requirements for protection, and Article 10(1) thereof concerning the extent of that protection, both refer to the 'overall impression' that that design makes on an informed user.

25 It follows that, under the system laid down by Regulation No 6/2002, appearance is the decisive factor for a design (judgment of 21 September 2017, *Easy Sanitary Solutions and EUIPO* v *Group Nivelles*, C-361/15 P and C-405/15 P, EU:C:2017:720, paragraph 62).

26 Such a finding supports an interpretation of Article 8(1) of Regulation No 6/2002 according to which that provision 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.

27 Finally, such an interpretation of that provision is supported by the objective pursued by Regulation No 6/2002.

28 It is clear from recitals 5 and 7 that that regulation aims to create a Community design which is directly applicable in each Member State which is protected in one area encompassing all Member States, encouraging the innovation and development of new products as well as investment in their production by offering enhanced protection for industrial design.

29 As regards, in particular, Article 8(1) of Regulation No 6/2002, read in the light of recital 10 thereof, that provisions intends to prevent technological innovation from being hampered by granting design protection to features dictated solely by a technical function of a product.

30 As the Advocate General stated in points 40 and 41 of his Opinion, if the existence of alternative designs fulfilling the same function as that of the product concerned 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 exclusively dictated 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 offering a product incorporating certain functional features or limit the possible technical solutions, thereby depriving Article 8(1) of its full effectiveness.

31 In light of the foregoing, it must be held that Article 8(1) of Regulation No 6/2002 excludes protection under the law on Community designs 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.

32 Therefore, the answer to the first question is that Article 8(1) of Regulation No 6/2002 must be interpreted as meaning 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.

The second question

33 By its second question, the referring court asks essentially whether Article 8(1) of Regulation No 6/2002 must be interpreted as meaning that in order to determine whether the relevant features of appearance of a product are exclusively dictated by its technical function, that finding must be based on the perception of the 'objective observer'.

34 In that connection, it must be observed that Regulation No 6/2002 does not provide any clarifications as to whether the relevant features of appearance of a product have been dictated by its technical function.

35 Furthermore, unlike Article 6(1) and Article 10(1) of Regulation No 6/2002, which expressly provide that, for the purpose of their application, the assessment must be based on the overall impression produced by a design on an 'informed user', Article 8(1) thereof does not require the perception of an 'objective observer' to be taken into account for the purposes of its application.

36 In that connection, having regard to the objective pursued by Regulation No 6/2002, which, as is clear from paragraph 28 of the present judgment, consists, in particular, in creating a Community design directly applicable and protected in all the Member States, it is for the national court, in order to determine whether the relevant features of appearance of a product are covered by Article 8(1) thereof, to take account of all the objective circumstances relevant to each individual case.

37 As the Advocate General stated in essence, in points 66 and 67 of his Opinion, 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.

38 Having regard to 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 order to determine whether the relevant features of appearance of a product are solely dictated by its technical function, within the meaning of that provision, the national court must take account of all the objective circumstances relevant to each individual case. In that regard, there is no need to base those findings on the perception of an 'objective observer'.

Costs

39 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 (Second 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 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.**

2. **Article 8(1) of Regulation No 6/2002 must be interpreted as meaning that, in order to determine whether the relevant features of appearance of a product are solely dictated by its technical function, within the meaning of that provision, the national court must take account of all the objective circumstances relevant to each individual case. In that regard, there is no need to base those findings on the perception of an 'objective observer'.**

[Signatures]