



## Reports of Cases

OPINION OF ADVOCATE GENERAL  
SAUGMANDSGAARD ØE  
delivered on 19 October 2017<sup>1</sup>

**Case C-395/16**

**DOCERAM GmbH**

**v**

**CeramTec GmbH**

(Request for a preliminary ruling  
from the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany))

(Reference for a preliminary ruling — Intellectual and industrial property — Community designs — Regulation (EC) No 6/2002 — Article 8(1) — Features of appearance of a product solely dictated by its technical function — Definition of that concept — Assessment criteria)

### **I. Introduction**

1. The request for a preliminary ruling from the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany) concerns the interpretation of Article 8(1) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs.<sup>2</sup> That provision, which has never been interpreted by the Court, provides that features of appearance of a product dictated solely by its technical function are excluded from the scope of the protection conferred by that regulation.

2. The order for reference was made in a dispute between two companies, one of which is the proprietor of a number of registered Community designs, while the other manufactures products similar to the products protected by those rights. After the former company had brought an action for an injunction against the latter, the latter company responded by arguing that the rights whose infringement had been claimed by the applicant in the main proceedings were invalid. In support of its counterclaim, it relied on the exclusion laid down in Article 8(1).

3. The questions asked by the referring court call on the Court to define the concept of ‘features of appearance of a product which are solely dictated by its technical function’ within the meaning of that provision and to determine how it should be assessed whether the designs in question have such features.

<sup>1</sup> Original language: French.

<sup>2</sup> OJ 2002 L 3, p. 1. Amendments have subsequently been made to the regulation, but the relevant provisions in the present case have not been affected by them.

## II. Legal context

4. According to recital 10 of Regulation No 6/2002, '[t]echnological 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'.

5. Article 4 of the regulation, 'Requirements for protection', reads as follows:

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

2. A design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character:

- (a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter; and
- (b) to the extent that those visible features of the component part fulfil in themselves the requirements as to novelty and individual character.

...'

6. Article 5 of the regulation, 'Novelty', provides in paragraph 1 that '[a] design shall be considered to be new if no identical design has been made available to the public'.

7. Article 6 of the regulation, '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 ... .

2. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.'

8. Article 8 of the regulation, 'Designs dictated by their technical function and designs of interconnections', provides in paragraph 1 that '[a] Community design shall not subsist in features of appearance of a product which are solely dictated by its technical function'.

## III. The dispute in the main proceedings, the questions referred and the procedure before the Court

9. DOCERAM GmbH is a company incorporated under German law which manufactures technical ceramic components. It supplies customers in the automotive, textile machinery and mechanical engineering 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.

10. CeramTec GmbH is also a company incorporated under German law, which manufactures and markets ceramic centring pins in the same variants as those protected by the designs of which DOCERAM is the proprietor.

11. DOCERAM brought an action against CeramTec at the Landgericht Düsseldorf (Regional Court, Düsseldorf, Germany), requesting in particular that it be ordered to discontinue the infringement of its intellectual property rights. The defendant in the main proceedings brought a counterclaim for a declaration of invalidity of those rights, maintaining that the features of appearance of the products in question were dictated solely by their technical function within the meaning of Article 8(1) of Regulation No 6/2002.

12. 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 offered by the regulation under Article 8(1) because the design decision had been dictated solely by considerations of technical functionality.

13. DOCERAM appealed against that judgment to the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf). That court considered that it is relevant to the decision in the main proceedings whether, for the purposes of the application of the exclusion provided for in Article 8(1) of Regulation No 6/2002, it is necessary — as is maintained by some legal literature and case-law, particularly in Germany — to establish that there are no design alternatives fulfilling the same technical function or — as is postulated in the judgment under appeal — to determine objectively whether the desired functionality was the sole factor which dictated the physiognomy of the product in question.

14. Consequently, by decision of 7 July 2016, received at the Court on 15 July 2016, the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf) decided to stay the proceedings and to refer the following questions to the Court for a preliminary ruling:

- (1) Does a technical function that precludes protection within the meaning of Article 8(1) of [Regulation No 6/2002] also exist 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 design features 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?

15. DOCERAM, CeramTec, the Greek and United Kingdom Governments and the European Commission submitted written observations to the Court. At the hearing on 29 June 2017, they all presented oral arguments.

## IV. Analysis

### ***A. The concept of ‘features of appearance of a product ... solely dictated by its technical function’ within the meaning of Article 8(1) of Regulation No 6/2002 (first question)***

#### *1. The substance of the first question and the opposing arguments*

16. The referring court considers that the designs at issue in the main proceedings are new and possess an individual character in accordance with the requirements of Articles 5 and 6 of Regulation No 6/2002.<sup>3</sup> It is uncertain whether their protection should nevertheless be excluded under Article 8(1) of the regulation, which provides that ‘[a] Community design shall not subsist in features of appearance of a product which are solely dictated by its technical function’, given that in the present case designs exist which it describes as ‘alternatives’ in so far as they are capable of achieving the same technical result as is produced by those designs.

17. In the light of the information provided in the order for reference and the context in which it was made, it seems to me that the *first question* asks the Court, in essence, to determine *if* simply establishing that such *design alternatives* exist implies that the contested designs are not dictated solely by the technical function of the products concerned and are not therefore covered by the exclusion provided for in Article 8(1) *or if* the relevant criterion to that effect is whether ‘*aesthetic considerations*’ or ‘*the design effect*’ of those products<sup>4</sup> led their designer to opt for a specific design.<sup>5</sup> In the event that the latter criterion is accepted by the Court, the referring court then asks it, by its *second question*, how it is to be assessed whether the individual design features of a product have been chosen solely by reason of technical requirements.

18. The referring court states that the question asked raises serious doubts in the light of the divergent positions which have been adopted thus far, both in legal literature and in the decision-making practice of the courts of the Member States and the European Union Intellectual Property Office (EUIPO) (formerly the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)), with regard to the interpretation of Article 8(1) of Regulation No 6/2002. There are two conflicting legal theories, which can produce diametrically opposite practical results.

19. According to a *first theory*, the derogation in that provision should be applied only if it is established that no design alternative allows the same technical function to be fulfilled as the design in question, 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 ‘*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.<sup>6</sup> Thus interpreted, that provision would be applicable in relatively infrequent cases where the design in question is the only one capable of ensuring that the desired technical result is achieved.

<sup>3</sup> Recital 19 of the regulation also states that ‘[a] Community design should not be upheld unless the design is new and unless it also possesses an individual character in comparison with other designs’.

<sup>4</sup> The latter expression is used in the first question, while the former appears in the grounds of the order for reference.

<sup>5</sup> In other words, according to CeramTec, it must be ascertained *if* the application of Article 8(1) definitely requires ‘examining exhaustively in the [main] proceedings whether there is any possible design alternative or, more specifically, whether all the conceivable alternative appearances would result in a different or lesser technical functionality *or if* the ground for exclusion [under that provision] is also applicable where the appearance is solely dictated by the need to achieve a specific technical solution and aesthetic considerations are therefore irrelevant’ (emphasis added).

<sup>6</sup> See in particular the sources mentioned in the footnotes to point 20 below.

20. In its order for reference, the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf) states that the application of this first hypothesis, which, as far as I know, is supported by some legal literature, particularly in Germany,<sup>7</sup> Belgium<sup>8</sup> and France,<sup>9</sup> is established not only in national case-law, both in Germany and in other Member States,<sup>10</sup> but also in the practice of EUIPO.<sup>11</sup> It is evident from the observations submitted to the Court, DOCERAM is the only party to take this position in the present case.

21. According to an *opposing theory*, the exclusion laid down in Article 8(1) of Regulation No 6/2002 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. Under this theory, which is linked to the ‘causality’ criterion, it is necessary to identify the reason why the feature in question was chosen by the designer of the product.<sup>12</sup> Thus interpreted, Article 8(1) would be applicable in all cases where the need to fulfil a certain technical function was the sole factor that dictated the design in question, without any effect on its physiognomy or its aesthetic quality, and the possible existence of design alternatives which could fulfil the same function is not crucial.

22. Although the Court is obviously not bound by these previous rulings, I note that, after being inclined towards the multiplicity of forms theory in the past, EUIPO has opted for the causality theory in its more recent decision-making practice,<sup>13</sup> considering that Article 8(1) of Regulation No 6/2002 denies protection to those features of a product’s appearance that were adopted exclusively in order to permit the product to fulfil its technical function, as opposed to features that were selected, at least to some degree, for the purpose of enhancing the product’s visual appearance, which are eligible for

7 See in particular Ruhl, O., *Gemeinschaftsgeschmacksmuster — Kommentar*, Carl Heymanns Verlag, Cologne, 2nd edition, 2010, p. 222, paragraph 22. It seems that this approach was also advocated by the German Government when it transposed a provision of EU law similar to Article 8(1) (see Koschtial, U., ‘Design law: individual character, visibility and functionality’, *International Review of Intellectual Property and Competition Law*, 2005, No 3, p. 308).

8 See Kaesmacher, D., and Duez, L., ‘Le nouveau règlement (CE) No 6/2002 sur les dessins ou modèles communautaires’, *J.T.D.E.*, 2002, No 92, p. 186, paragraph 15; Massa, C.-H., and Strowel, A., ‘Community Design: Cinderella Revamped’, *E.I.P.R.*, 2003, vol. 25(2), p. 72, and De Visscher, F., ‘La protection des dessins et modèles’, *Guide juridique de l’entreprise*, Kluwer, Brussels, 2nd edition, 2005, paragraph 370, where it is stated that the multiplicity of forms criterion has been applied to the similar rule of law which previously existed in the Benelux system (see Article 2(2)(a) of the Loi uniforme Benelux en matière de dessins ou modèles (Uniform Benelux Designs Law), last amended on 20 June 2002).

9 See in particular Passa, J., *Droit de la propriété industrielle — Tome 1: Marques et autres signes distinctifs, dessins et modèles*, L.G.D.J., Paris, 2nd edition, 2009, paragraphs 708 to 712, and Binclin, N., *Droit de la propriété intellectuelle — Droit d’auteur, brevet, droits voisins, marque, dessins et modèles*, L.G.D.J., Paris, 2nd edition, 2012, paragraph 296.

10 Reference is made to two German decisions (‘OLG Düsseldorf, GRUR-RR 2012, 200 (205) — Tablet-PC; LG Düsseldorf, Beck RS 2015, 05506’) and the judgment of the Court of Appeal of England and Wales (Civil Division), *Landor & Hawa International Ltd v Azure Designs Ltd* [2006] EWCA Civ 1285, paragraph 30 et seq. I note that this theory has also been accepted in Spain (see in particular decision of the Juzgado de lo Mercantil No 2 de Alicante (Commercial Court No 2, Corunna, Spain) of 28 November 2012, *Jose Antonioy Hostel Drap SL v Napkings SL*, second legal basis).

11 The referring court cites inter alia the decision of the Invalidity Division of OHIM of 3 April 2007, Case ICD 3150, *Lindner Recyclingtech v Franssons Verkstäder*, paragraph 20. I note that this decision was reversed on appeal by the decision mentioned in footnote 13 to this Opinion.

12 See in particular Stone, D., ‘Le droit européen des dessins et modèles a 10 ans’, *Magazine de l’OMPI*, 2013, No 6, p. 18, and Brancusi, L., ‘Article 8 CDR’, *Community Design Regulation (EC) No 6/2002 — A Commentary*, edited by G.N. Hasselblatt, C.H. Beck, Munich, 2015, p. 137 et seq., paragraphs 34 to 48.

13 Namely since the decision of the Third Board of Appeal of OHIM of 22 October 2009 in Case R 690/2007-3, *Lindner Recyclingtech v Franssons Verkstäder* (‘Chaff cutters’). I would point out that that decision was challenged in an action and an appeal, in which neither the General Court nor the Court of Justice ruled on the substantive application of Article 8 (see orders of 10 May 2010, *Franssons Verkstäder v OHIM — Lindner Recyclingtech (Chaff Cutters)*, T-98/10, not published, EU:T:2010:180, and of 9 September 2010, *Franssons Verkstäder v OHIM and Lindner Recyclingtech*, C-290/10 P, not published, EU:C:2010:511).

protection.<sup>14</sup> It seems that case-law has developed along similar lines, particularly in France<sup>15</sup> and the United Kingdom.<sup>16</sup> In the present case, CeramTec, the Greek Government, the United Kingdom Government and the Commission<sup>17</sup> have all supported this latter theory. That is also my point of view, for the reasons set out below.

## 2. *The bases for the proposed interpretation*

23. It can be stated, first of all, that, contrary to the claim made by DOCERAM, the *wording* of the provisions of Regulation No 6/2002 does not offer any guidance which is immediately helpful in answering the first question, since the concept of ‘features of appearance of a product ... solely dictated by its technical function’ in Article 8(1) is not defined there and no assessment criteria are provided for. In particular, there is absolutely no mention of the criterion of the absence of design alternatives for the product concerned, as advocated by the supporters of the multiplicity of forms theory.

24. According to the Court’s settled case-law, it follows from the need for a uniform application of EU law that, where an EU act makes no reference to the law of the Member States for the definition of a particular concept, as in this case, that concept must be given an autonomous interpretation by the Court, which must take into account the overall scheme, the objectives and the origin of that instrument of EU law.<sup>18</sup>

25. As regards *the overall scheme* of Regulation No 6/2002, I note that recital 10 of the regulation provides interesting but limited illumination as to the meaning of Article 8(1), stating that ‘[t]echnological 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’.

26. I will discuss further below the implications of the first sentence of that recital in connection with the purposes of Article 8(1).<sup>19</sup> As regards the second sentence,<sup>20</sup> the referring court states that the opponents of the causality theory claim that that theory, which seeks to dissociate the purely technical features of the product from decorative features, runs counter to the statement that it is not necessary for a design to have an aesthetic quality in order to be able to be protected.

14 See decision of OHIM in Case R 690/2007-3, cited above (footnote 13), paragraph 28 et seq., especially paragraphs 35 and 36. The rejection of the ‘alternative shapes’ criterion is expressly confirmed in the EUIPO Guidelines for examination of design invalidity applications for registered Community designs, version of 1 February 2017, p. 30, paragraph 5.3.3, citing in particular the decision of the Third Board of Appeal of OHIM of 27 January 2016 in Joined Cases R 1517/2014-3 and R 2114/2014-3, ‘Hoses’ (see paragraph 65). The developments are traced by Barber Giner, T., ‘Estética y funcionalidad: alcance de la prohibición del diseño funcional en la legislación nacional y comunitaria’, *Diario La Ley*, No 8422, XXXV, 17 November 2014, p. 768 to 770, and Brancusi, L., ‘Design determined by the product’s technical function: arguments for an autonomous test’, *E.I.P.R.*, 2016, vol. 38(1), p. 25 et seq.

15 See in particular Greffe, F., and Greffe, P., *Traité des dessins et des modèles — France, Union européenne, Suisse, continent américain*, LexisNexis, Paris, 9th edition, 2014, paragraphs 155 to 186, and Raynard, J., Py, E., and Tréfigny, P., *Droit de la propriété industrielle*, LexisNexis, Paris, 2016, paragraphs 534 to 536.

16 The United Kingdom Government asserts that the current state of positive law is consistent with the decision of OHIM in Case R 690/2007-3, cited above (footnote 13), referring to the judgment of the High Court of Justice of England and Wales in *Dyson Ltd v Vax* [2010] EWHC 1923 (Pat), paragraphs 23 to 31.

17 The Commission considers that the existence of design alternatives should nevertheless be taken into account among other indicators of the aesthetic value of the form to be assessed by the court hearing the case. See also point 64 of this Opinion.

18 See in particular judgments of 9 March 2017, *Pula Parking* (C-551/15, EU:C:2017:193, paragraph 42), and of 7 September 2017, *Schottelius* (C-247/16, EU:C:2017:638, paragraph 31).

19 See point 38 et seq. of this Opinion.

20 I note that the reference made at the end of the relevant sentence of recital 10 in French, the original language of this Opinion, forms a second sentence in the German version which is cited by the referring court.

27. It is true that such a requirement is not expressly laid down in Articles 4 to 6 of Regulation No 6/2002 either, which set out the requirements for protection of Community designs. Similarly, the second sentence of recital 10 of the regulation states that it cannot be inferred from the ground for refusal under Article 8(1) that only forms having an aesthetic quality can benefit from protection as designs. In my view, the expression ‘this does not entail that a design must have an aesthetic quality’ means only that it is not essential for the appearance of the product in question to have an aesthetic aspect in order to be able to be protected.

28. Like CeramTec and the Greek and United Kingdom Governments, I consider that, even though the aesthetic qualities of the product in question do not constitute a crucial assessment criterion for the grant of such protection, it would be wrong to conclude that it is not the visual appearance of products that the Community design is intended to protect. As OHIM (now EUIPO) has stated,<sup>21</sup> it is clear from the definition of ‘design’ in Article 3(a) of Regulation No 6/2002, which expressly mentions the ‘appearance’ of the product,<sup>22</sup> and from the requirements of visibility, which are set out in both Article 4(2)<sup>23</sup> and recital 12,<sup>24</sup> that the examination of the external appearance, whatever its specific merit,<sup>25</sup> is decisive for protection by the rights conferred by a Community design.<sup>26</sup> I would add that emphasis is also placed on the visual aspect in Article 10(1) of the regulation, under which the product concerned must be distinguishable from previous protected designs.<sup>27</sup>

29. Consequently, in my view it is compatible with the wording of recital 10 of Regulation No 6/2002 to interpret Article 8(1) as not referring to cases where the features in question are the only means of fulfilling the technical function of a product, but to cases where the need to achieve that function is the only factor to explain the adoption of those features. In other words, I think that the features of appearance of the product must be considered to be solely dictated by the objective of achieving a certain technical solution and that those features therefore come under the exclusion in Article 8(1) where it appears that other kinds of considerations, in particular visual ones, played no part in the adoption of the design concerned. The key question is where the formal constraints connected with the product’s technical function stop and where its designer’s freedom of choice starts.<sup>28</sup>

30. Acknowledgment that this provision is an exception, which means that it should be interpreted strictly according to the referring court, does not call my analysis into question. This point cannot in itself lead to the acceptance of a criterion, in this case the multiplicity of forms criterion, which further restricts the cases where the exclusion is applicable<sup>29</sup> but does not have an obvious legal basis either in the text of Regulation No 6/2002 itself or in the light of its origins or objectives as set by the EU legislature.

31. In my view, my proposed interpretation is supported by an analysis of the *origin* of Regulation No 6/2002, and Article 8(1) in particular.

21 See decision of OHIM in Case R 690/2007-3, cited above (footnote 13), paragraph 34.

22 ‘Design’ is defined there 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’.

23 See the citation in point 5 of this Opinion.

24 According to recital 12, ‘[p]rotection should not be extended to those component parts which are not visible during normal use of a product, nor to those features of such part which are not visible when the part is mounted ...’.

25 The United Kingdom Government also used the term ‘merit’, although it does not appear in Regulation No 6/2002, to designate, as here, whether the design actually succeeds in making the product attractive because of its design.

26 See, to that effect, 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 et seq.).

27 According to paragraph 1, ‘[t]he 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’.

28 Specifically, the technical function may, for example, be intended to provide more grip, convenience, comfort, efficiency or safety, as opposed to the development of ornamental, decorative, aesthetic or fanciful forms (see Cohen, D., *Le droit des dessins et modèles — Droit communautaire, droit international, droit français et autres droits étrangers*, Economica, Paris, 2nd edition, 2004, paragraph 65, and Greffe, F., and Greffe, P., op. cit. footnote 15, paragraph 159).

29 See end of point 19 of this Opinion.

32. CeramTec asserts that the multiplicity of forms criterion should not be applied on the ground that the proposal to introduce it into EU legislation was not accepted. The Greek Government also bases a series of arguments on the *travaux préparatoires* for the regulation.

33. I note in this regard that in its 1991 Green Paper on the Legal Protection of Industrial Design the Commission explained that protection was excluded for features dictated exclusively by the technical function of the product in question, a rule which already existed in the vast majority of Member States,<sup>30</sup> by comments that seem to fluctuate, in substance, between the multiplicity of forms theory and the causality theory, which, in my view, are linked respectively to the absence of design alternatives in the light of the final form of the product and to the failure by the designer to make a creative contribution in developing the product.<sup>31</sup>

34. In the Commission's original proposal from 1993, which led to the adoption of Regulation No 6/2002, Article 9(1) (now Article 8(1) of the regulation) was entitled 'Non-arbitrary technical designs ...' and worded as follows: 'A Community Design right shall not subsist in a design to the extent that the realisation of a technical function leaves no freedom as regards arbitrary features of appearance'.<sup>32</sup>

35. The explanatory memorandum for that proposal for a regulation<sup>33</sup> and the commentary on Article 9(1) thereof<sup>34</sup> state, first of all, that the aesthetic aspect of the product is not crucial in itself, as both designs that tend towards a certain aesthetic and designs that fulfil a certain practical use are equally protectable. Above all, these extracts emphasise that Community design protection is refused in rare cases where 'the form follows the function without any possibility of variation', as the designer has 'no freedom' in the design of the product and 'cannot [therefore] claim that the result is due to personal creativity' and that the design has 'individual character'.<sup>35</sup>

30 With regard to certain earlier national systems, see in particular Mounçif-Moungache, M., *Les dessins et modèles en droit de l'Union européenne*, Thèse, Bruylant, Brussels, 2012, p. 121 et seq.

31 Working document published in June 1991 (III/F/5131/91-EN), p. 65, paragraph 5.4.6: 'If a technical effect can be achieved *only by a given form*, the design cannot be protected. On the other hand, *if the designer has a choice among various forms* in order to arrive at the technical effect, the features in question can be protected. Understood in this way the exclusion ... corresponds exactly to the idea/expression dichotomy of copyright law. What is meant is *in reality* that *if there is no choice* when designing a product with a given effect, *there is no personal creativity displayed* and consequently nothing to protect' (emphasis added).

32 See Proposal for a European Parliament and Council Regulation on the Community Design of 3 December 1993 (COM(93) 342 final, p. 57). The use of the word 'arbitrary' was questioned by the Economic and Social Committee (see Opinion of 22 February 1995, OJ 1995 C 110, p. 14, paragraph 5.7).

33 According to paragraph 8.2 of the explanatory memorandum (COM(93) 342 final, p. 7), '[d]esigns are features of appearance which can be perceived by the human senses. No aesthetic criteria are applied. Aesthetic and functional designs are equally protectable. However, features necessary to achieve a technical function and which leave no freedom as regards arbitrary elements are unprotectable ...'.

34 According to the commentary on that provision, '[n]o distinction is made in the Regulation between aesthetic and functional designs; they are equally able to attract protection. In extremely rare cases, the form follows the function without any possibility of variation. In such cases, the designer cannot claim that the result is due to personal creativity. The design has, in fact, no individual character and cannot attract protection. ... Therefore, the provision provides for unprotectability to the extent only that there is no freedom as regards arbitrary elements of design' (COM(93) 342 final, p. 15).

35 Similarly, recital 9 of that proposal refers to 'designs produced to meet a functional requirement and providing no opportunity for inclusion of further and arbitrary design features' (p. 51) and the commentary on Article 27(1) mentions 'the case where the specific features of the design are not eligible for protection because they are entirely dictated by a technical function leaving no freedom for arbitrary design' (p. 22).



36. Furthermore, according to the amended proposal from 1999,<sup>36</sup> the present wording of Article 8(1) of Regulation No 6/2002 was aligned with that of Article 7(1) of Directive 98/71/EC on the legal protection of designs,<sup>37</sup> which seeks to harmonise the applicable laws of the Member States.<sup>38</sup> The *travaux préparatoires* for Directive 98/71 confirm that the absence of freedom of choice for the designer in designing the product and the fact that the chosen form is dictated solely by the technical function were seen, from the very start, as crucial factors in refusing protection, both in the initial proposal for that directive from 1993<sup>39</sup> and in the amended proposal from 1996.<sup>40</sup>

37. It would seem that no criterion equivalent to the existence of design alternatives or the multiplicity of forms was adopted in the abovementioned draft legislation, but that the causality criterion was favoured instead. There is no requirement that the feature in question is the *only means* by which the desired technical function can be achieved. The exclusion laid down in Article 8(1) of Regulation No 6/2002 is motivated mainly by the absence of creative influence on the part of the designer over the appearance of the product, since only added value stemming from intellectual effort independent of that function justifies design protection. It seems that in its decision-making practice EUIPO has recently tended to give greater prominence to whether or not the designer had a degree of freedom in developing the product in question.<sup>41</sup>

38. As regards the *objectives* pursued by the regulation, and Article 8(1) in particular, it is not disputed by the parties — and it is, moreover, undeniable in my view — that that provision is intended mainly to prevent features of a product which are solely technical in origin being ‘monopolis[ed]’<sup>42</sup> through their protection as Community designs<sup>43</sup> and to ensure that ‘[t]echnological innovation should not be hampered’<sup>44</sup> because such protection reduces the availability of technical solutions for other economic operators.<sup>45</sup> Finding a balance between protecting innovation and creativity and safeguarding fair and profitable competition for all Community undertakings was one of the concerns of the legislature.<sup>46</sup>

36 See Amended Proposal for a Council Regulation (EC) on Community Design of 21 June 1999 (COM(1999) 310 final), explanation as to Article 9.

37 Directive of the European Parliament and of the Council of 13 October 1998 (OJ 1998 L 289, p. 28).

38 Laws whose effects are limited to the territory of the Member State concerned, contrary to the system established by Regulation No 6/2002 (see recitals 1 to 6 of that regulation).

39 Article 7(1) of that initial proposal for a directive of 3 December 1993 (COM(93) 344 final) was worded as follows: ‘A design right shall not subsist in a design to the extent that the realisation of a technical function leaves no freedom as regards arbitrary features of appearance’ and, according to the explanatory memorandum, ‘competition will be encouraged in areas where designs will be made ineligible for protection — for example because fulfilment of a technical function leaves no design freedom’(see p. 11 and p. 17).

40 See, in the amended proposal for a directive of 21 February 1996 (COM(96) 66 final), the commentary on Article 7(1), which states that ‘[a]lthough the question whether a design does or does not contain any aesthetic elements is irrelevant in the context of the requirements for protection, as set out in the Proposal, the need was felt for a provision indicating that protection should not be available in those extremely rare cases where form necessarily follows function. ... [T]he Commission felt that clearer wording was needed, especially after the amendment proposed as regards paragraph (2)’ (p. 7). Article 7(1) now referred to ‘features of appearance of a product which are solely dictated by its technical function’, the wording adopted in Article 8(1) of Regulation No 6/2002.

41 See Brancusi, L., ‘Article 8 CDR’, op. cit. footnote 12, p. 140, paragraph 47, and the latter approach, described as ‘more flexible’, mentioned in the report on the study carried out for the Commission, 3 June 2016, *Legal review on industrial design protection in Europe*, pp. 89, 91 and 92.

42 According to paragraph 8.2 of the explanatory memorandum for the initial proposal (COM(93) 342 final, p. 7), ‘... features necessary to achieve a technical function ... are unprotectable in order not to monopolise technical functions by way of design protection’.

43 I note that a similar objective was pursued by the repair clause in Article 110(1) of Regulation No 6/2002, the original wording of which contained a reference to products ‘upon whose appearance the protected design is dependent’, which was, however, removed in the course of the legislative work. In this regard, see my Opinion in *Acacia and D’Amato* (C-397/16 and C-435/16, EU:C:2017:730, point 38 et seq.).

44 See the beginning of the first sentence of recital 10 of Regulation No 6/2002.

45 In its observations the Commission rightly states that excluding from design protection features of appearance which serve solely to implement a technical solution ensures free competition between the suppliers of products using that technical solution.

46 See section 9 of the explanatory memorandum for the initial proposal (COM(93) 342 final, p. 8) and recital 7 of Regulation No 6/2002.

39. Furthermore, it is clear from the *travaux préparatoires* for Regulation No 6/2002 that a further purpose of Article 8(1) is to draw the separation line between the rules on patents and the rules on designs.<sup>47</sup> Any protection of technical innovations must come under the former rules<sup>48</sup> provided the conditions for patentability are met. As CeramTec states, it may prove more difficult to obtain a patent in some cases, as that property right requires that it be demonstrated that there exists an invention meeting strict requirements,<sup>49</sup> and less attractive, as the term of protection offered may be less than is guaranteed by designs.<sup>50</sup> It was therefore necessary to avoid the risk of the provisions applicable to patents being circumvented by preventing the possibility of technical solutions being protected as designs.

40. In my view, opting for a criterion which, like multiplicity of forms, seriously limits the scope of the exclusion under Article 8(1)<sup>51</sup> could deprive that provision of its full effectiveness and thus prevent the above objectives being achieved, by permitting the appropriation of purely technical forms for which variants exist.<sup>52</sup>

41. Like CeramTec and the United Kingdom Government, I take the view that it is nearly always possible to modify the appearance of features of a product slightly, but sufficiently,<sup>53</sup> without affecting the desired technical function. It is therefore possible that several conceivable forms of a technical solution, or indeed all of them, could be monopolised through design protection, which would hamper the technological innovation that Regulation No 6/2002 seeks to promote. If the criterion advocated by DOCERAM were adopted, a single economic operator would be able to obtain several registrations, as a Community design, of different forms of a product, thereby benefiting from exclusive protection which is, in practice, equivalent to that offered by a patent, but without being subject to the related restrictions, which could thus be circumvented.

42. CeramTec asserts in this regard that in the dispute in the main proceedings, by seeking protection for 17 form variants of a centring pin in three different basic models, DOCERAM has not left other market operators any opportunity to use alternative forms of those products, as there are no other technically relevant forms in the field of projection welding that are capable of producing a different overall impression of the product in accordance with Article 6(1) of the regulation.

43. Lastly, my recommended interpretation has the advantage that it is consistent with the *case-law* which has been developed by the Court *in the field of trade marks*.<sup>54</sup> Contrary to what CeramTec seems to claim, that case-law cannot, in my view, be applied as such to the present case, given the differences that exist between the system of EU law for trade mark protection and the system for design protection.<sup>55</sup> However, since provisions similar to those in Article 8(1) of Regulation

47 The coexistence of those rules is confirmed in recital 31 and Article 96 of Regulation No 6/2002. See also the Green Paper on the Legal Protection of Industrial Design, *op. cit.* footnote 31, p. 65, paragraph 5.4.6.1.

48 According to paragraph 8.2 of the explanatory memorandum for the initial proposal (COM(93) 342 final, p. 9), ‘... features necessary to achieve a technical function ... may be protectable under patent law or utility model law provided the requirements for such protection are fulfilled’.

49 In particular, the invention must be new, involve an inventive step and be susceptible of industrial application under Articles 52 to 57 of the Convention on the Grant of European Patents, signed at Munich on 5 October 1973 (‘the Munich Convention’), the text of which is available at: <http://www.epo.org/law-practice/legal-texts/html/epc/2016/e/ma1.html>

50 Namely 20 years in principle for the European patent (see Article 63 of the Munich Convention) and up to 25 years for registered Community designs (see Article 12 of Regulation No 6/2002), as is the case in the main proceedings.

51 See the end of point 19 of this Opinion.

52 See also decision of OHIM in Case R 690/2007-3, cited above (footnote 13), paragraphs 28 and 30, and Brancusi, L., ‘Article 8 CDR’, *op. cit.* footnote 12, pp. 136 and 137, paragraph 33.

53 Under Article 5(2) of Regulation No 6/2002, which provides that a design is deemed to be identical to an existing design, and not therefore protectable, if their features differ only in immaterial details.

54 See footnotes 59 and 61 to this Opinion.

55 With regard to the differences between the protection offered by trade marks and the protection offered by designs, in terms of their respective natures, scopes and terms, see Opinion of Advocate General Ruiz-Jarabo Colomer in *Philips* (C-299/99, EU:C:2001:52, points 36 to 38).

No 6/2002 can be found in the former system,<sup>56</sup> even though their wording is not completely the same,<sup>57</sup> and in view of the relationship between these two categories of provisions,<sup>58</sup> I consider that it is possible, and indeed appropriate, to take a view in the light of that case-law and, if necessary, to reason by analogy in the present case.

44. I note in this connection that, with regard to the protection granted by trade marks, the Court has ruled that the objective of the abovementioned provisions of EU law, which correspond in essence to Article 8(1) of Regulation No 6/2002, is to prevent trade mark protection from granting its proprietor a monopoly on technical solutions or functional characteristics of goods which a user is likely to seek in the goods of competitors.<sup>59</sup> As I explained above,<sup>60</sup> this would also appear to be why protection under Community design law is excluded in the circumstances provided for in Article 8(1).

45. It is clear from various judgments of the Court regarding trade marks that ‘a sign consisting exclusively of the shape of a product is unregistrable by virtue [of the provisions that were interpreted] if it is established that the essential functional features of that shape are attributable only to the technical result’. The Court has held that ‘the ground for refusal ... of registration’ as a trade mark of ‘the shape of goods which is necessary to obtain a technical result’ ‘cannot be overcome by establishing that there are other shapes which allow the same technical result to be obtained’, in accordance with those provisions. It based this rejection, which is implicit but clear in my view, of the multiplicity of forms theory in particular on the finding that the refusal of registration is not subject to the condition that the shape at issue is the only one which could achieve the intended technical result and on the observation that a significant number of alternative shapes might become unusable for the trade mark proprietor’s competitors if such a criterion were considered to be decisive.<sup>61</sup>

46. In my view, these considerations are also relevant in the present case, given that, in this field too, it is not acceptable that Community designs are diverted from their purpose to offer protection to purely technical features of a product.<sup>62</sup>

47. Accordingly, in my view, the first question should be answered in the affirmative and the argument in support of acceptance of the ‘multiplicity of forms’ criterion must therefore be rejected. More specifically, I take the view that Article 8(1) of Regulation No 6/2002 must be interpreted to the effect that, in order to determine whether features of appearance of a product are solely dictated by its

56 See the second indent of Article 3(1)(e) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), now Article 3(1)(e)(ii) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25), and Article 7(1)(e)(ii) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), now Article 7(1)(e)(ii) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1).

57 The abovementioned provisions relating to trade mark law (see footnote 56) do not refer to ‘features ... solely dictated by [the] technical function [of the product]’, but to ‘the shape of goods which is necessary to obtain a technical result’. According to Advocate General Ruiz-Jarabo Colomer, that discrepancy was not capricious and it meant that the level of functionality had to be greater in order to be able to assess the ground for refusal in the context of designs, the feature concerned having to be not only necessary but essential in order to achieve a particular technical result, such that form follows function. In his view, this meant that a functional design could nonetheless be eligible for protection if it could be shown that the same technical function could be achieved by another different form (see his Opinion in *Philips*, C-299/99, EU:C:2001:52, point 34). I do not concur with this view, given that it was expressed in an *obiter dictum* (see decision of OHIM in Case R 690/2007-3, cited above in footnote 13, paragraph 28) and that the Court did not rule on designs in the judgment of 18 June 2002, *Philips* (C-299/99, EU:C:2002:377).

58 Regulation No 40/94 on the Community trade mark was a ‘legacy’ which the authors of Regulation No 6/2002 took as the basis for drafting (see Hiance, M., ‘Le projet de règlement communautaire sur les dessins et modèles: les enjeux’, *Revue internationale de la propriété industrielle et artistique*, 2000, No 201, p. 100).

59 See in particular, with regard to Article 3(1)(e) of Directive 2008/95, judgment of 16 September 2015, *Société des Produits Nestlé* (C-215/14, EU:C:2015:604, paragraphs 44, 45 and 55) and, with regard to Article 7(1)(e)(ii) of Regulation No 40/94, judgment of 10 November 2016, *Simba Toys v EUIPO* (C-30/15 P, EU:C:2016:849, paragraphs 39 and 53).

60 See point 38 et seq. of this Opinion.

61 See, with regard to the second indent of Article 3(1)(e) of Directive 89/104, judgment of 18 June 2002, *Philips* (C-299/99, EU:C:2002:377, paragraphs 81 to 84); with regard to Article 3(1)(e) of Directive 2008/95, judgment of 16 September 2015, *Société des Produits Nestlé* (C-215/14, EU:C:2015:604, paragraph 56), and, with regard to Article 7(1)(e)(ii) of Regulation No 40/94, judgment of 14 September 2010, *Lego Juris v OHIM* (C-48/09 P, EU:C:2010:516, paragraphs 53 to 58).

62 In support of an analogy with the position taken by the Court on trade marks, see in particular Greffe, F., and Greffe, P., op. cit. footnote 15, paragraphs 182 and 183, and Raynard, J., Py, E., and Tréfigny, P., op. cit. footnote 15, paragraph 536.

technical function, regard should not be had simply to the non-existence of alternative forms which could fulfil the same function, but it should be established that obtaining a certain technical function is the sole factor that dictated the choice of the design concerned and that no creative role was therefore played by its designer in this regard.

48. In connection with this proposed interpretation, the referring court put forwards other queries concerning the specific application of the rule in Article 8(1), which are the subject of the second question referred for a preliminary ruling.

***B. The relevant assessment criteria for the purposes of the application of Article 8(1) of Regulation No 6/2002 (second question)***

49. The second question is asked in the alternative, in case, as I suggest, the Court answers the first question to the effect that the relevant method for the purposes of the application of the exclusion laid down in Article 8(1) of Regulation No 6/2002 is to determine whether the features of appearance of the product in question are attributable solely to the desired technical function and not to establish the absence of design alternatives which could also fulfil that function.

50. By this question, the referring court asks, first, from which point of view it is to be assessed whether the various design features of a product have been chosen solely for reasons of technical functionality and, second, if an 'objective observer' is required, how that concept is to be defined.

51. The referring court explains that in the judgment under appeal before it, the Landgericht Düsseldorf (Regional Court, Düsseldorf) held that the assessment must be objective and does not depend on the personal will of the designer of the design concerned, except possibly as an indication as to whether an objective, reasonable observer would conclude that imperatives of technical functionality dictated the design decision.<sup>63</sup> However, according to the opponents of this approach, it is difficult to assess the view of the 'objective observer', that is to say, a further person existing only in theory, on a case-by-case basis.

52. *As regards the objective or subjective character of the assessment to be carried out* with a view to the application of Article 8(1) of Regulation No 6/2002, the parties in the main proceedings and the interested parties which submitted observations to the Court agree that the designer's subjective intention when he conceived the design at issue cannot constitute the key factor in determining whether that design was chosen on the basis of purely technical considerations. I also take this view.

53. An objective approach to the assessment in question promotes a uniform application of that provision in all Member States and in each of their legal systems and it offers greater predictability, which increases legal certainty for economic operators. As DOCERAM and CeramTec note, in essence, if the presumed intention of the designer were the only relevant criterion, statements made by him would in themselves be crucial in determining whether or not the design concerned can be protected and, in the event of a dispute, he could be tempted to claim that he was guided by aesthetic concerns in choosing that design, in order to ensure that the exclusion laid down in Article 8(1) of Regulation No 6/2002 is not applied against his creation. It is essential, in my view, that the competent authorities are able to decide on the basis of assessment criteria which are not subjective, but are neutral and without any risk of partiality.

54. *As regards the procedure to follow in carrying out an objective assessment* whether the appearance of a product is dictated solely by its technical function within the meaning of Article 8(1) of Regulation No 6/2002, on the other hand, the positions taken before the Court are not consistent.

<sup>63</sup> The referring court notes that the decision of OHIM in Case R 690/2007-3, cited above (footnote 13), adopted this approach.

55. I consider that the *first problem* raised by the question asked by the referring court, which mentions the possibility of considering the point of view of an ‘objective observer’, is whether or not *reasoning should be based on a hypothetical person* whose presumed assessment would serve as an archetype.

56. In this regard, CeramTec asserts, first, that the expression ‘objective observer’, which appears both in the judgment under appeal before the referring court and in the second question referred for a preliminary ruling, is inspired by similar phrases which have been used, with variants, in the decision-making practice of EUIPO<sup>64</sup> and in legal literature.<sup>65</sup>

57. Second, CeramTec submits that in order to ascertain whether Article 8(1) of Regulation No 6/2002 is applicable, regard should be had by analogy to the concept of ‘informed user’ which is used in Article 6(1), Article 10(1) and recital 14 of the regulation<sup>66</sup> and is defined in the case-law of the Court of Justice and of the General Court.<sup>67</sup> According to CeramTec, in so far as the review must be conducted, as in this case, in the particular situation where all users of the products concerned are professionals, the ‘informed user’ would then in practice correspond to the ‘specialist’, who has technical expertise, a concept used to assess the innovative character of the patent.

58. I do not consider it appropriate to adopt this proposal. Contrary to the claim made by CeramTec, the relevant criterion in assessing the existence of points of fact, in the context of Regulation No 6/2002, is not ‘always the “informed user”’. In particular, it has been ruled that the informed user is not necessarily able to distinguish, beyond the experience gained by using the product concerned, the aspects of the appearance of the product which are dictated by the product’s technical function from those which are arbitrary.<sup>68</sup> The application of Article 8(1) of Regulation No 6/2002 actually necessitates a technical assessment, which requires specific skills that even an ‘informed’ user does not always have. Consequently, the perspective of the ‘informed user’ cannot, in my view, constitute the objective assessment criterion required here.

59. Like the United Kingdom Government and the Commission, I consider that if the authors of Regulation No 6/2002 had wished to adopt a legal construct like ‘objective observer’, as the second question suggests, they would have mentioned it in Article 8(1), as they did expressly, with ‘informed user’, in Articles 6(1) and 10(1).<sup>69</sup> I further note that Article 8 also makes no reference to the

<sup>64</sup> In particular, paragraph 36 of the decision of OHIM in Case R 690/2007-3, cited above (footnote 13), makes reference to the standpoint of a ‘reasonable observer’.

<sup>65</sup> CeramTec mentions the expressions ‘relevant observer’ and ‘reasonable observer persona’, which are used, respectively, by Brancusi, L., ‘Article 8 CDR’, op. cit. footnote 12, p. 139, paragraph 41, and in the report on the study carried out for the Commission, op. cit. footnote 41, p. 90.

<sup>66</sup> Articles 6 and 10 concerning, respectively, the ‘individual character’ which the design concerned must possess (like recital 14) and the ‘scope of protection’ conferred by Regulation No 6/2002.

<sup>67</sup> The concept of ‘informed user’ must be understood as ‘*lying somewhere between that of the average consumer*, applicable in trade mark matters, who need not have any specific knowledge and who, as a rule, makes no direct comparison between the trade marks in conflict, and the sectoral expert, [applicable in patent matters,] who is an expert with detailed technical expertise. [It] may be understood as referring ... to a *particularly observant one*, either because of his personal experience or his extensive knowledge of the sector in question’ (emphasis added) (see in particular judgments of 20 October 2011, *PepsiCo v Grupo Promer Mon Graphic*, C-281/10 P, EU:C:2011:679, paragraphs 53 and 59, and 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, paragraphs 124 and 125).

<sup>68</sup> See in particular judgments of the General Court of 22 June 2010, *Shenzhen Taiden v OHIM — Bosch Security Systems* (Communications equipment) (T-153/08, EU:T:2010:248, paragraphs 47 and 48); of 21 November 2013, *El Hogar Perfecto del Siglo XXI v OHIM — Wenf International Advisers* (Corkscrew) (T-337/12, EU:T:2013:601, paragraph 25); and of 12 March 2014,  *Tubes Radiatori v OHIM — Antrax It* (Radiator) (T-315/12, not published, EU:T:2014:115, paragraph 61). In my view, this recurrent analysis by the General Court is well founded.

<sup>69</sup> In this regard, see in particular the commentary on Article 6(1) in the initial proposal for a regulation (COM(93) 342 final, p. 12).

perception of other categories of hypothetical person, such as ‘average potential buyer’, a criterion which DOCERAM suggests before dismissing,<sup>70</sup> or ‘average consumer’, an element which the Commission notes was considered not to be decisive in itself in assessing the purely technical character of a shape in relation to trade marks.<sup>71</sup>

60. The United Kingdom Government asserts, rightly in my view, that Articles 6(2) and 10(2) of Regulation No 6/2002 do not refer to the theoretical concept of ‘informed user’ in assessing the ‘degree of freedom of the designer in developing the design’<sup>72</sup> and that the same — non-hypothetical — approach should be adopted in connection with Article 8(1), as here too the court hearing the dispute must evaluate objectively what comes under the technical function of the product, an aspect that is not eligible for protection, and where a role has been played by the freedom of the designer, whose creative work may be protected.<sup>73</sup> Such an evaluation on a case-by-case basis is already conducted, without major difficulty it would seem, by national courts<sup>74</sup> and by the members of OHIM (now EUIPO).<sup>75</sup>

61. Moreover, if the ‘objective observer’ criterion were to be accepted, this would raise a whole series of additional difficulties in defining this artificially created category and how it should be used, if only as regards the type and level of knowledge that such a person should possess.

62. The *second problem* raised before the Court is *identifying the elements which must be included in the examination* to be conducted, in my view both objectively and on a case-by-case basis, by the court hearing a dispute based on Article 8(1) of Regulation No 6/2002.

63. I concur with the majority view expressed in the observations submitted to the Court, according to which it is for the national court hearing the dispute to assess objectively and in the light of all the specific circumstances of each case whether different features of appearance of a product are based solely on considerations related to functionality.

70 According to DOCERAM, such a buyer will often possess less extensive professional knowledge of the technical field to which the product belongs than, for example, the designer or the manufacturer, the consequence of which could be that the technical functions of certain features of appearance are perceived wrongly as aesthetic features.

71 It cites, to that effect, paragraphs 33 to 35 of the judgment of 18 September 2014, *Hauck* (C-205/13, EU:C:2014:2233), which concern Article 3(1)(e) of Directive 89/104. According to the Commission, because the objective of that provision is comparable to the objective pursued by Article 8(1) of Regulation No 6/2002, it is logical also to apply similar criteria in connection with Article 8(1) in order to assess the design of a product’s appearance beyond technical constraints. In this regard, see also point 43 et seq. of this Opinion.

72 Even though the conditions laid down in paragraphs 1 and paragraphs 2 of Articles 6 and 10 respectively are complementary, as is clear from recital 14 of that regulation. In the specific assessment of the overall impression of the designs at issue on the informed user, the designer’s degree of freedom in developing the contested design must be taken into account, knowing that the more that freedom is restricted, the more likely minor differences between those designs will be sufficient to produce a different overall impression on the user (see in particular judgments of 18 March 2010, *Grupo Promer Mon Graphic v OHIM — PepsiCo* (Representation of a circular promotional item), T-9/07, EU:T:2010:96, paragraph 72 et seq., and of 5 July 2017, *Gamet v EUIPO — ‘Metal-Bud II’ Robert Gubala* (Door handle), T-306/16, not published, EU:T:2017:466, paragraph 43 et seq.).

73 I note that in its initial proposal for a regulation (COM(93) 342 final, p. 16), the Commission stated that paragraph 2 of what became Article 10 of Regulation No 6/2002 was ‘intended to give guidance to the courts in infringement cases’ (emphasis added). It added that ‘[h]ighly functional designs where the designer must respect given parameters are likely to be more similar than designs in respect of which the designer enjoys total freedom. Therefore, paragraph 2 also establishes the principle that the freedom of the designer must be taken into consideration when the similarity between an earlier and a later design is being assessed’ (emphasis added).

74 The United Kingdom Government cites to that effect the judgment of the Court of Appeal of England and Wales (Civil Division), *Dyson Ltd v Vax* [2011] EWCA Civ 1206, paragraph 36.

75 By way of example, see the analysis conducted by the Invalidity Division of OHIM in its decision of 17 March 2014 in Case ICD 8674, *Extruplast v PVG Energy BV*. In paragraph 17 it states that the designer knows that the degree of freedom in developing the design of the cans is limited by a number of constraints connected with its intended use, namely, in the case under examination, to contain, transport and store liquids. In that case, the choice of a cross in a rounded propeller shape on top, the width of its blades, its arrangement both on top and underneath, the wide grooves for its stacking, the arrangement of the cartridges, their shape and thickness or thinness, the grooves and their number give the Community design in question a certain aesthetic but also a more sophisticated appearance not dictated solely by their technical function.

64. In this regard, according to the Commission, the national court should take account of assessment criteria accepted by the Court in the field of trade marks on the basis of which it can be presumed that the shape is not of purely technical value, such as ‘the perception ... by the average consumer[, <sup>76</sup>] ... the nature of the category of goods concerned, the artistic value of the shape in question, its dissimilarity from other shapes in common use on the market concerned, a substantial price difference in relation to similar products, and the development of a promotion strategy which focuses on accentuating the aesthetic characteristics of the product in question’.<sup>77</sup> The Commission maintains that the court hearing the case should also take into consideration the existence of alternative forms which also fulfil the technical function concerned, as such existence would, as a rule, show that the designer had freedom in developing the features of appearance of the product and that the appearance was not dictated solely by functional contingencies.

65. Similarly, DOCERAM also produces a non-exhaustive list of criteria which could be relevant, namely ‘circumstances connected with the design process, advertising, use, etc.’ CeramTec asserts that the point of view of the ‘informed user’, which it proposes — wrongly in my view<sup>78</sup> — be used as the objective assessment criterion, should be determined ‘on the basis of an in-depth examination of all the circumstances of each case’,<sup>79</sup> in particular ‘the specific objective of the manufacturer at the time of design, advertising of the product which focuses on accentuating the design, any distinction or particular reputation of the design among the relevant public and the designer’s intention on the creation of the product’.<sup>80</sup>

66. I would point out in this respect that the assessment in question must be conducted by the court hearing the case, in my view, not only having regard to the design concerned itself, but also in the light of all the circumstances surrounding the choice of its features of appearance, bearing in mind the evidence provided by the parties, regardless of the subject or the nature of that evidence,<sup>81</sup> and bearing in mind any measures of inquiry ordered by that court.

67. It is not impossible that criteria which, in my view, cannot in themselves show that features of appearance of a product have been dictated solely by its technical function within the meaning of Article 8(1) of Regulation No 6/2002, such as the subjective intention of the designer or the existence of alternative forms,<sup>82</sup> may nevertheless be included in the body of specific evidence which courts must take into consideration in order to form their own opinion regarding the application of that provision.

68. There is no need, in my view, to make a list of the relevant criteria, even a non-exhaustive one, given that the EU legislature did not envisage recourse to this method and that it would seem that the Court did not consider this appropriate in respect of the assessment, including of the facts, which must, moreover, be conducted pursuant to Articles 4 to 6 of the regulation.

69. However, like the Greek Government, I think that it should be stressed that the court hearing the case will, if necessary, be able to conduct the required evaluation by seeking clarification from an independent expert appointed by it. I note in this regard that the national courts do not possess the sometimes highly technical competences necessary for that purpose and that they commonly order an expert report when faced with complex questions of this kind.

76 Even though this criterion would not be crucial in itself (see point 59 of this Opinion).

77 In this regard, the Commission refers to paragraphs 34 and 35 of the judgment of 18 September 2014, *Hauck* (C-205/13, EU:C:2014:2233). See also footnote 71 to this Opinion.

78 See point 57 et seq. of this Opinion.

79 To that effect, CeramTec cites, inter alia, Ruhl, O., *Gemeinschaftsgeschmacksmuster — Kommentar*, op. cit. footnote 7, paragraph 10.

80 The Greek and United Kingdom Governments did not make such lists of assessment criteria.

81 Given that the burden of proving that the conditions inherent in Article 8(1) of Regulation No 6/2002 are met in a certain case logically rests on the party which is seeking to rely on the exception laid down in that provision.

82 None of these criteria being decisive in itself, for the reasons set out in point 53 and point 23 et seq. of this Opinion respectively.

70. Consequently, I consider that the second question should be answered to the effect that, in order to assess whether different features of appearance of a product are based solely on considerations of technical functionality for the purposes of the application of Article 8(1) of Regulation No 6/2002, it is for the court hearing the case to carry out an objective assessment, not from the — theoretical — point of view of an ‘objective observer’, but bearing in mind — in specific terms — all the relevant circumstances of each case.

## V. Conclusion

71. In the light of the foregoing considerations, I propose that the Court answer the questions referred for a preliminary ruling by the Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany) as follows:

- (1) Article 8(1) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs must be interpreted to the effect that the protection offered by the regulation is excluded where the features of appearance of the product in question were adopted exclusively in order to permit the product to fulfil a certain technical function, and thus without any creative contribution on the part of its designer, and the fact that there may exist other shapes which allow the same technical result to be obtained is not in itself crucial in this regard.
- (2) In order to determine whether the features of appearance of a product have been adopted on the basis of considerations related solely to the technical function of a product within the meaning of Article 8(1), the court hearing the case must give an objective ruling, exercising its own discretionary power and taking account of all the relevant circumstances of each case.