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CJEU in C-395/16, *Doceram vs. CeramTec*, interprets the concept of technically required features of appearance excluded from protection under Community designs Regulation

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A key-rule of EU design law is enshrined in Article 8(1) of [Regulation \(EC\) No. 6/2002](#), whereby a Community design may not consist of features of appearance of a product that are solely dictated by its technical function.

This provision intends to prevent design protection from hampering technological innovation. The concern addresses cases where the need to fulfil a technical function is the only factor determining the choice by the designer of a feature of appearance of the product, while considerations of different nature, in particular those related to its visual aspect, do not play any role.

However, the EU legislator has not laid down any express criteria for determining whether relevant features of appearance of a product are “solely dictated by its technical function”. In particular, one may wonder whether the mere existence of alternative designs is sufficient to conclude that the features are not solely dictated by a technical function, thus taking one outside the scope of Article 8(1) of the Regulation.

By a recent decision ([CJEU, 08.03.2018, C-395/16, Doceram vs. CeramTec](#)) the Court of Justice gave an answer to the question. The main proceedings, brought before the Düsseldorf Higher Regional Court, revolved around registered Community designs covering pins for welding in different geometrical shapes. In its preliminary ruling, the Court clarified that, where features of appearance are imposed only by technical functions of the product, the exclusion from design protection under Article 8(1) of the Regulation applies despite the existence of alternative designs fulfilling the same technical function.

Otherwise, held the Court, “... 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 ...” (para. 30).

The elaboration of the CJEU may produce a significant impact at the national level. Indeed, certain streams of case-law and legal literature, also in Italy, had taken an opposite approach, considering the existence of alternative designs as a key-element to show that the choice made by the designer, although conditioned by technical considerations, however remained discretionary (rather than “solely dictated”).

Besides, the CJEU decision specifies that, under the system of the Regulation, the decisive factor for a design is appearance and, in order to enjoy protection as a Community design, it is not essential for the appearance of the product to present an aesthetic aspect.

Finally, on a separate but related issue, the Court observes that Article 8(1) of the Regulation does not require the perception of an “objective observer” to be taken into account for the purposes of its application. Instead, it is for the national court, in assessing whether Article 8(1) applies, to take account of all objective circumstances relevant to each individual case. Such an assessment must be made, in particular, having regard to i) the design at issue, ii) the objective circumstances indicating the reasons which dictated the choice of features of appearance of the product, or iii) information on its use, or iv) 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.