

Functionality in EU design law

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Berkeley, 19 February 2021

Quick overview of EU design legislation

- Design Directive 1998 & Design Regulation 2002
- Both 2D and 3D designs
- Protection requirements: new + individual character + not be excluded subject-matter namely: be solely dictated by function, be the design of an interconnecting feature or contrary to public policy or morality
- Dictated by function (art. 8(1) DR): “A design right shall not subsist in features of appearance of a product which are solely dictated by its technical function.”
- First CJEU decision: *Doceram v CeramTec*, 8 March 2018 ended split existing between the Member States applying **multiplicity of shapes theory** and those applying **causality theory**

Doceram v CeramTec

- Choice between (1) result-oriented doctrine AKA multiplicity-of-forms theory and (2) device-oriented doctrine AKA causality theory
 - Under (1), the exclusion does not apply if the same result can also be obtained using another configuration
 - Under (2) the exclusion applies if the product is determined (caused) solely by its technical function, irrespective of the possible existence of design alternatives



Doceram v CeramTec

- Art. 8(1) = autonomous notion of EU law
- If the technical necessity of a design (or one of its features) was not solely the decisive factor in choosing the appearance of it, the exclusion does not apply and the design is protected
- Features must have been chosen also on the basis of non-technical considerations, aesthetic or not
- “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” (para. 32)

Doceram v CeramTec

- Reasoning, competition oriented: “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” (para. 30)

Doceram v CeramTec

- All the **objective** circumstances relevant to the specific case at hand must be taken into account – can include test of ‘objective observer’ (paras 36-38)
- “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.”

Implications of *Doceram*

- More designs are excluded BUT
- Rarely does the exclusion exclude an entire design as only applies to features of a design, if a feature or even several features are excluded, the whole design of the product is still protected. It is only when all the features are excluded that the entire design is invalid.
- The exclusion will bite in the assessment of individual character and infringement
- BUT exclude them totally during assessment or have less importance, and different for assessing individual character and infringement?
Samsung v Apple >< *Cantel v Arc* and divergent opinions in literature

Implications of *Doceram*

- All Member States on same page?
 - AG had mentioned intention of designer but CJEU did not and intention of designer is subjective – problem already one decision of EUIPO post-*Doceram* uses it
 - No hierarchy of criteria + non exhaustive, no outright rejection of objective observer test
 - Rules of evidence not harmonised – e.g. experts (BG, RO v UK, D); forum-shopping/unfairness
- Other question – negative convergence between IPR?
Cofemel/Brompton (copyright)

Further readings

- "Doceram, Cofemel and Brompton: How does the current and future CJEU case law affect digital designs?" in B. Pasa (ed.), *Design, technological and digital innovation. Interdisciplinary proposals for reshaping legal protections*, ESI Press, Naples, forthcoming 2021, https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3507802
- "Member States can no longer require a higher level of originality for works of applied art/designs, says AG Szpunar in *Cofemel*", Kluwer Copyright Law Blog, 3 May 2019, available at <http://copyrightblog.kluweriplaw.com/2019/05/03/member-states-can-no-longer-require-a-higher-level-of-originality-for-works-of-applied-artdesigns-says-ag-szpunar-in-cofemel/>

Further readings

- “The CJEU decision in *Brompton Bicycle* – A welcome double rejection of the multiplicity of shapes and causality theories in copyright law”, Kluwer Copyright Law Blog, 25 June 2020, available at <http://copyrightblog.kluweriplaw.com/2020/06/25/the-cjeu-decision-in-brompton-bicycle-a-welcome-double-rejection-of-the-multiplicity-of-shapes-and-causality-theories-in-copyright-law>
- [*The Copyright/Design Interface: Past, Present and Future*](#), Cambridge University Press. 2018; book reviews by C. Smith in (2018) 13(4) JIPLP 339-340; N. Kapryrina (2018) IIC 756; R. Arnold (2018) EIPR 482.

Thank you for your attention

Questions?



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