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5th Session: Industrial designs and trade marks

The Assessment on functionality in trade marks and designs

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Abstract

Functionality has been a very much debated topic, which started in the field of trademarks and over the past years moved on to designs.

In regard to Designs different approaches have been applied along the past years by the various national Courts and the EUIPO, being the most common the multiplicity-of-forms theory on the one hand and the causality, or no-aesthetic consideration test on the other.

On 08 March 2018, the Court of Justice of the European Union (CJEU) issued a landmark decision on the assessment functionality in Designs in the case Doceram GmbH vs. Ceramtec GmbH, answering questions referred to in a preliminary ruling. This decision could be seen as a starting point after a long period of unclarity and uncertainty, people actually awaiting for either new legislation or a clear judgement of the Court of Justice.

The Higher Regional Court of Düsseldorf submitted a request for preliminary ruling on the interpretation of Article 8.1. Here the Court raised the following questions:

First, 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?

Secondly, 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?

In particular the first question is a core issue. The Court of Justice answered in favor of the no-aesthetic-consideration test, herewith following the Advocate-General’s earlier opinion. This decision will be perceived differently by the various courts, depending on their current approach in daily practice. The decision, at the positive side, serves the harmonization process in regard to Designs. At least the question whether or not alternatives exist is no longer decisive, but rather a relevant circumstance. At the same time, many uncertainties still remain, as the assessment whether or not a design is solely dictated by the technical function would still be based in circumstances and therefore, subjective criteria.

As regard to Trademarks there has been quite constant case law in which each time the Court of Justice seems to prevent trademarks/shape marks from being used to extend other IP-rights indefinitely. Since the exclusions on the basis of a technical function cannot be overcome by acquired distinctiveness one might raise the question if the exclusions applied are not too narrow. While this discussion will continue on, if not because of the new wording in the new Regulation, it would be interesting to have a helicopter overview on the assessment of functionality in both types of IP-rights.