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The notion of functionality in trademark and design matters – introduction

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How to protect IP rights to products as such?

'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

some of features are purely aesthetic, in particular colours and ornamentation

An EU trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

trademark is defined by its essential function

Technical

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

(Art. 8.1. CDR)

Not registered are signs which consist exclusively of the shape, or another characteristic, of goods which is necessary to obtain a technical result.

(Art. 7.1. (e) (ii) EUTMR)

Functional, technical, aesthetic

- CDR delimits technical and aesthetic, but does not refer to functional:

  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 (CDR preamble, tenth motive)

- not solely "technical", not necessary "aesthetic", does "functional" define design?

Technical = purely functional?

It goes without saying that these matters must be assessed objectively: it is not necessary to determine what actually went on in the designer's mind when the design was being developed. The matter must be assessed from the standpoint of a reasonable observer who looks at the design and asks himself or herself whether anything other than purely functional considerations could have been relevant when a specific feature was chosen. The design as a whole will be invalid only if all the essential features of the appearance of the product in question were solely dictated by its technical function.

Further EUIPO decisions: R 690/2007-3, R 211/2008-3

C-395/16 DOCERAM

1. Does a technical function that precludes protection within the meaning of Article 8(1) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1) 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: <u>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</u>? Is an 'objective observer' required and, if so, how is such an observer to be defined?

Functionality and good design

- Functional design means that it serves utilitarian function, is useful, makes us easy to use a product, saves us time and effort

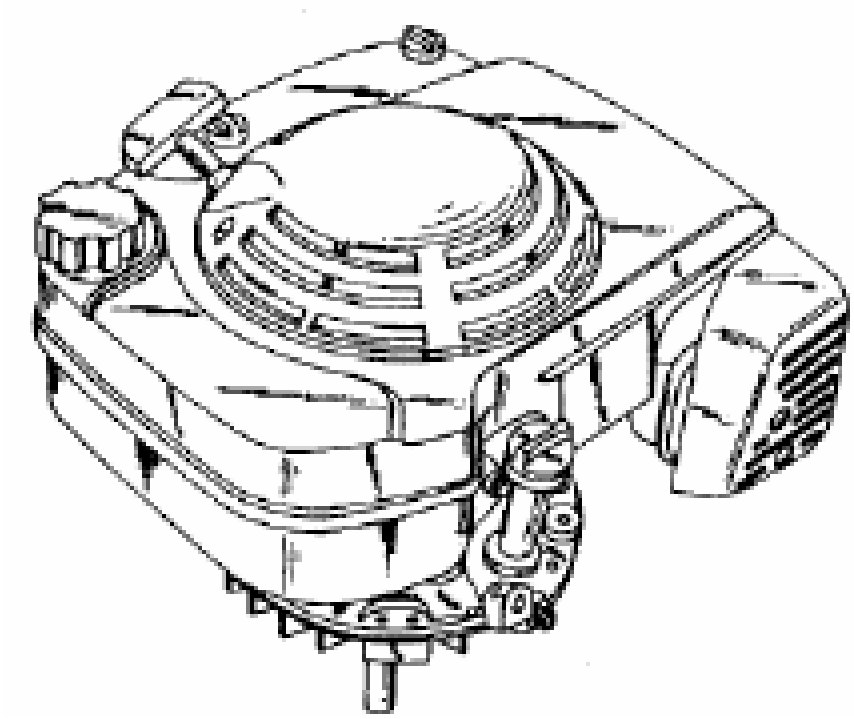
EUIPO decisions: R 690/2007-3, R 211/2008-3:

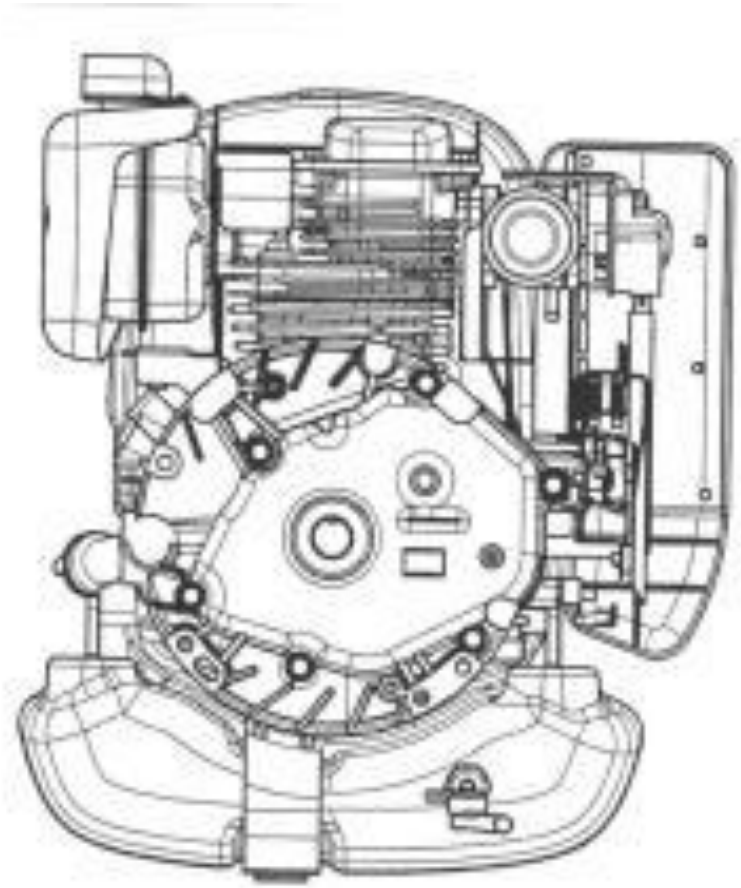
- Good design involves two fundamental elements: the product must perform its function and <u>it should be pleasant to look at</u>.
- In the case of some products, such as pictures and ornaments, their whole purpose is to please the eye.
- In the case of other products, such as the internal working parts of a machine, the visual appearance is irrelevant.

- It there a distinction between design of consumer products and professional ones?

Aesthetics above functionality?

Functionality only?





GC case T-10/08

Functional, technical, aesthetic

- in the CJEU case-law functional is essentially equalled to technical:

The rationale of the grounds for refusal of registration laid down in Article 3(1)(e) of the Directive is to prevent trade mark protection from granting its proprietor a monopoly on technical solutions or functional characteristics of a product which a user is likely to seek in the products of competitors (C-299/99 Philips)

Opinion of AG Colomer in C-299/99 Philips

- The wording used in the Designs Directive for expressing that ground for refusal does not entirely coincide with that used in the Trade Marks Directive. That discrepancy is not capricious. Whereas the former refuses to recognise external features which are solely dictated by its technical function, the latter excludes from its protection signs which consist exclusively of the shape of goods which is necessary to obtain a technical result.
- In other words, the level of **functionality** must be greater in order to be able to assess the ground for refusal in the context of designs; the feature concerned must not only be necessary but essential in order to achieve a particular technical result: form follows function. This means that a functional design may, none the less, be eligible for protection if it can be shown that the same technical function could be achieved by another different form.
- interpreted as *obiter dicta* supporting the multiplicity-of-forms theory in the design law and „causative" approach in the trademark law

The multiplicity-of-forms theory rejected by EUIPO

- **the multiplicity-of-forms theory: If a technical solution can be achieved by two alternative methods, neither solution is solely dictated by the function of the product in question**.
- This would mean that both solutions could be the subject of a design registration, possibly held by the same person, which would have the consequence that no one else would be able to manufacture a competing product capable of performing the same technical function. The multiplicity-of-forms theory would, if accepted, deprive Article 8(1) CDR of any purpose and content.
- That provision might just as well be deleted from the regulation since its field of application, at least as a ground of invalidity in conjunction with Article 25(1)(b), would be reduced to virtually zero.
- There are very few features of a product's appearance that have to be exactly the way they are in order for the product to achieve its technical function. A vehicle wheel must be round, a television screen must be rectangular, and there are doubtless other examples of particular features for which there is no alternative design. But it is hard to think of a product of which it can truly be said that all its essential features can have only one form if the product is to perform its function.
- This leads to the conclusion that the multiplicity-of-forms theory cannot be correct.

EUIPO decisions: R 690/2007-3 Chaff cutters, R 211/2008-3

The feature determined solely by the technical function

Article 8(1) CDR denies protection to those features of a product's appearance that were chosen **exclusively** for the purpose of allowing a product to perform its function, as opposed to features that were chosen, at least to some degree, for the purpose of enhancing the product's visual appearance

R 690/2007-3 Chaff cutters

Where the essential functional characteristics of the shape of a product are attributable **solely** to the technical result, Article 3(1)(e) TMD, second indent, precludes registration of a sign consisting of that shape, even if that technical result can be achieved by other shapes.

CJEU case C-299/99 Philips

Not necessary the only mean to achieve the function

It is not necessary that the feature must be the **only mean** by which the product's technical function can be achieved. Article 8(1) CDR applies where the need to achieve the product's technical function was the only **relevant** factor when the feature was selected.

R 690/2007-3 Chaff cutters

A shape that is **necessary** to achieve a technical result, in the sense that it performs a function in achieving that result but is not necessarily the **only shape** that can achieve that function, must be excluded from registration.

CJEU case C-299/99 Philips

Longchamp Le Pliage bag design

Is folding the essential technical (purely functional) feature or is it functional & aesthetic?

RCD 453956-0015

does not protect the folding design

EUTM application no. 6491906 withdrawn

registered German trademark

Longchamp Le Pliage bag design

- unregistered well-known trademark
- unregistered mark (in Poland protected by unfair competion law)
- unregistered design (in Poland only protection against identical copies, however, not limited in time)
- each of these additional basis requires to prove knowledge of a relevant consumer that the bag originates from one producer (Jean Cassegrain SAS)
- many infringment cases across Europe
- copyright law – outside the scope of this panel

The criteria of functionality with regard to European trademarks ECJ ruling

Cabinet Beau de Loménie

Aurélia MARIE

DIRECTIVE 2008/95 (EC) OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 22 October 2008 /COUNCIL REGULATION (EC) No 207/2009 of 26 February 2009

Directive Article 3 :
Grounds for refusal or invalidity
1. The following shall not be registered or, if registered, shall be liable to be declared invalid:
(e) signs which consist exclusively of:…(ii) the shape of goods which is necessary to obtain a technical result

Regulation Article 7 :
Absolute grounds for refusal
1.The following shall not be registered:
(e) signs which consist exclusively of : …(ii) the shape of goods which is necessary to obtain a technical result

Interpretation given to Articles 4 and 7 of the Directive of 2008 and the Regulation of 2009 by the ECJ

Decisions rendered on request of preliminary ruling

The rationale of this ground for refusal is :

-To prevent trademark protection to be extended beyond its aim (identification of origin) so as to form an obstacle to competitors who want to offer products with the same technical solution or functional characteristics : they would be limited in supplying products incorporating such function or at least in chosing the technical function they wish to adopt (Philips /Remington, EUCJ 18 June 2002, Case C-299/99, parg 78 to 80)

-This ground of refusal must be interpretated in the light of the public interest (parg.77)

Interpretation given to Articles 4 and 7 of the Directive of 2008 and the Regulation of 2009 by the ECJ

Decisions rendered on request of preliminary ruling :

How to assess the character exclusively functional of a shape ?

Does it refer to a shape which is essential to the function of the goods or to a shape which has one or more substantial functional characteristics ?

It applies to a sign which consists **exclusively of the shape** of a product with **one or more essential characteristics which are inherent to the function (s)** of the product and which consumers may be looking for in the products of competitors.

(Hauck/Stokke, EUCJ 18 September 2014, Case-205/13, tripp trapp chair, parg 15)

Interpretation given to Articles 4 and 7 of the Directive of 2008 and the Regulation of 2009 by the ECJ

Decisions rendered on request of preliminary ruling :

How to assess the exclusively functional character of a shape:

Article 3(1)e(ii) of the Directive refers only to the **manner in which the goods at issue fonction** and does not apply to the **manner in which these goods are manufactured.**

(Nestlé/Cadbury, EUCJ, 16 September 2015)

Interpretation given to Articles 4 and 7 of the Directive of 2008 and the Regulation of 2009 by the ECJ

Decisions rendered on request of preliminary ruling :

Technical result achieved by other shapes :

There is nothing in the Directive to allow that the proven existence of other shapes with the same technical result, **can overcome the ground of refusal/invalidity.**

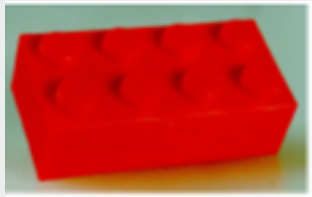
Where the essential functional characteristics of the shape are **attributable solely to the technical result**, the sign **is not valid even if that technical result can be achieved by other shapes.**

(Philips /Remington, EUCJ 18 June 2002, Case C-299/99, parg 81 to 84)

Interpretation given to Articles 4 and 7 of the Directive of 2008 and the Regulation of 2009 by the ECJ

Decisions rendered based on the Regulation :

How to assess the character exclusively functional of a shape ?



All the **essential characteristics of the shape must perform a technical function** (the presence or one or more minor arbitrary elements is irrelevant).

Essential means the **most important elements of the sign** (direct assessement based on the visual analysis of the sign or on a detailed examination in which relevant criteria such as surveys, expert opinions, IP data .. are taken into account).

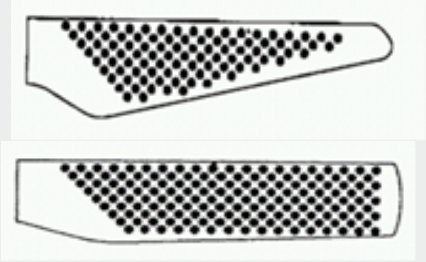
Once the essential characteristics are identified, assessment **whether they perform a technical function** of the product is to be made.

(JUDGMENT OF THE COURT (Grand Chamber) , 14 september 2010, Case C-48/09, Lego)

Interpretation given to Articles 4 and 7 of the Directive of 2008 and the Regulation of 2009 by the ECJ

Decisions rendered based on the Regulation :

What technical function means ?



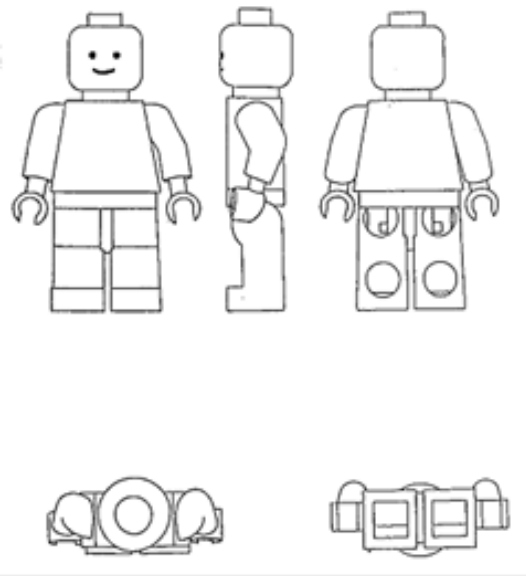
The fact that that non-skid structure is not patentable or that it is a **secondary characteristic of the product patented is of no significance** : it does not mean that the black dots which represent them are not an essential characteristic or that they do not serve a technical objective.

(JUDGMENT OF THE COURT (Seventh Chamber) 21 May 2015)

Interpretation given to Articles 4 and 7 of the Directive of 2008 and the Regulation of 2009 by the ECJ

Decisions rendered based on the Regulation :

What technical function means ?



It is inappropriate to refuse to register a shape of goods solely on the **ground that it has functional characteristics.** The fact that some parts are moveable is not a technical result so long as the movement itself does not enable a result to be achieved.

Functionality means a tecnical result to be achieved.

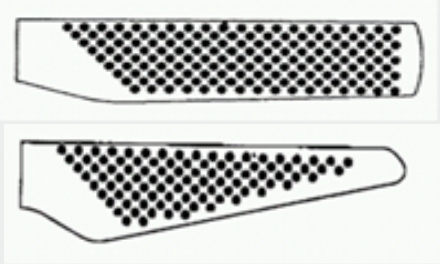
((JUDGMENT OF THE GENERAL COURT (Third Chamber) , 16 June 2015, Case T-396/14,Lego)

Interpretation given to Articles 4 and 7 of the Directive of 2008 and the Regulation of 2009 by the ECJ

Decisions rendered based on the Regulation :

Does Article 7(1)(e)(ii) apply to any sign, whether two- or three-dimensional ?

It applies to any 2 or 3D sign where all the essential characteristics



of the sign perform a technical function.

The Board of Appeal was entitled to take the view that the marks at issue were **2D figurative marks representing 3D shapes**, namely, the handles of knives or utensils marketed by the applicant, and, consequently, to consider, in the light of all the relevant elements, that the black dots affixed to those handles corresponded to dents.

(JUDGMENT OF THE GENERAL COURT (Seventh Chamber) 6 March 2014)

Interpretation given to Articles 4 and 7 of the Directive of 2008 and the Regulation of 2009 by the ECJ

Decisions rendered based on the Regulation :

Is it the sign as filed, or the way it is used, which is to be taken into account ?

The grounds for invalidating the trademark must be

only on the **examination of the representation of the mark as filed** and not on any alleged or supposed invisible features.

The black lines and more generally the grid structure on each surface of the cube in question do not perform or are not even suggestive of any technical function.

(JUDGMENT OF THE GENERAL COURT (Sixth Chamber) , 25 November 2014, Case T-450/09, Simba Toys)

Interpretation given to Articles 4 and 7 of the Directive of 2008 and the Regulation of 2009 by the ECJ

Decisions rendered based on the Regulation :

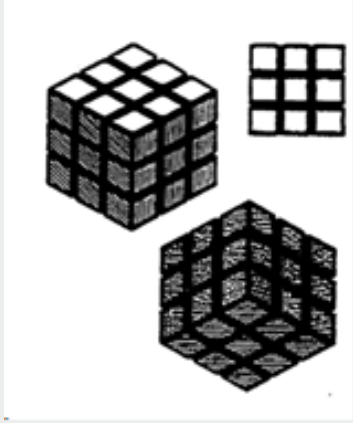
The graphic representations of the contested mark **do not make it possible to determine whether the shape involves any technical function** or if so what that technical function might be. It cannot be inferred with sufficient certainty from those representations that the cube is made up of moveable elements and even less that they are rotatable.

(JUDGMENT OF THE GENERAL COURT (Sixth Chamber) , 25 November 2014, Case T-450/09, Simba Toys)

Interpretation given to Articles 4 and 7 of the Directive of 2008 and the Regulation of 2009 by the ECJ

Decisions rendered based on the Regulation :

In appeal : it is not disputed that the sign at issue **consists of the shape of actual goods and not of an abstract shape.** The technical function of the actual goods at issue namely a 3D puzzle must be taken into account when assessing the functionality of the essential characteristics of that sign.

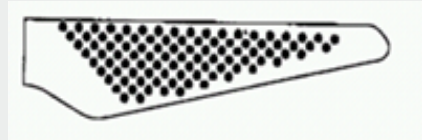


The fact that the trademark was registered for 3D puzzles in general (not limited to rotated ones) without any description in the application of the rotating capability, cannot preclude that the technical function of the actual goods represented by the sign must be taken into account.

(JUDGMENT OF THE GENERAL COURT (First Chamber) ,10 November 2016, Case C 30/15, Simba Toys)

Interpretation given to Articles 4 and 7 of the Directive of 2008 and the Regulation of 2009 by the ECJ

Decisions rendered based on the Regulation :



Criterion of mutiplicity of shape

The existence of other shapes which could achieve the same technical result is not, for the purposes of the application of Article 7(1)(e)(ii) such as to exclude the ground for refusal of registration.

(JUDGMENT OF THE COURT (Seventh Chamber) 21 May 2015)

DIRECTIVE (EU) 2015/2436 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 16 December 2015/REGULATION (EU) 2015/2424 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 16 December 2015 (effective 23 mars 2016)

Directive Article 4 :
Absolute grounds for refusal or invalidity
1. The following shall not be registered or, if registered, shall be liable to be declared invalid:
(e) signs which consist exclusively of:…(ii) the shape, or another characteristic, of goods which is necessary to obtain a technical result

Regulation Article 7:
Absolute grounds for refusal
The following shall not be registered:
(e) signs which consist exclusively of: …(ii) the shape, or another characteristic, of goods which is necessary to obtain a technical result

KRIEGER MES & GRAF v. der GROEBEN DÜSSELDORF · ESTABLISHED 1929

AIPPI Seminar PL-FR-DE
Warsaw, 16 and 17 March 2017

Functionality in Design And Trademark Law

Jens Künzel, LL.M. –

Part 1: EUIPO Case Law On Functional Features In Design Cases

Part 2: German Case Law

What are design features dictated by a function?

- The purpose of an industrial design is, by its very nature, the protection of the overall visual appearance of articles of use:

See, e.g., *Resolution on Designs*, AIPPI Milan Congress 2016:

„Design protection should be available, by way of registration, to protect the overall visual appearance (including ornamentation) (*Appearance*) of an object or article of manufacture as a whole (*Product*).”

- Articles of use, arguably, necessarily incorporate at least some features that (also or solely) perform a technical function corresponding to the normal and intended use of the article by the informed user

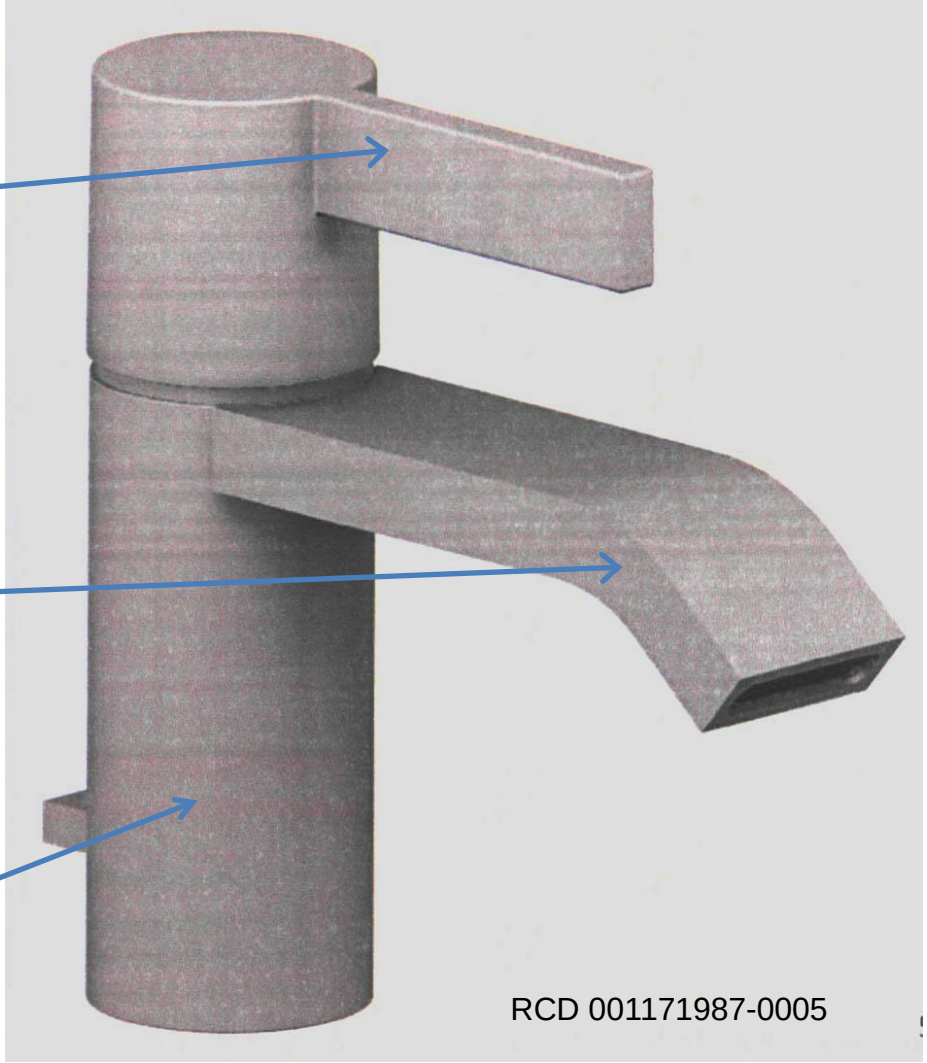
What are design features dictated by a function?

An example:

Lever element: By lifting and turning it, water may be dispensed and its temperature chosen

Water spout: Spills out water and, by having a certain length, transports it ahead to a certain point (ideally above a water basin)

Upright basic element transports water to a certain height



What are design features dictated by a function?

Another example:

Steel bars at the front: Holding the fabric for the seat and footrest; constituting the engagement end for the handles; stabilising the whole children's buggy

Stretching of the fabric between bars serves as a footrest for the child

Connection of steel bars serves as contact point for front wheels, and as stabiliser for entire construction

RCD 000049655-0003

What are design features dictated by a function?

- Features performing, or dictated by, a technical function are obviously inherent in the concept of „industrial designs“ and do not of themselves exclude protection or limit their scope
- The term „technical“ should be understood broadly, i.e. not by referring to the understanding of the term in patent and utility model law (where „technicity“ is a requirement for granting)

  ≫ „features dictated by technical function“ therefore are features which in any way serve a practical purpose (i.e. have a „function“).

How does the CDR address functional features?

- Art. 8 (1) CDR:

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

- Art. 8 (2) CDR:

„A Community design shall not subsist in ***features of appearance of a product which must necessarily be reproduced in their exact form and dimensions*** *in order to permit the product in which the design is incorporated or to which it is applied* ***to be mechanically connected to or placed in, around or against another product*** *so that either product may* ***perform its function****."*

„Features dictated solely by a technical function“

- CDR, Recital No. 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. […] 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****.”*

„Features dictated solely by a technical function“

- General effect of provision:
  - Directly applies only to certain features of the design, not per se to the entire design
  - Features within scope of Art. 8 (1) CDR are excluded:
    - from scope of protection of design (Art. 19 CDR). ≫ Effect:
    - from being considered for examination of validity requirements (Art. 4 No. 1 CDR). ≫ Effect:

„Features dictated solely by a technical function“

- Alternatives with respect to validity:

- Entire product consists ***exclusively*** of features (of appearance) that are solely dictated by its function

≫≫ Design as a whole will be invalid, Art. 25 (1) (b) in conjunction with Art. 8 (1) CDR (rare cases)

- Product consists, partly, of features (of appearance) that are solely dictated by technical function and, partly, of features that are not

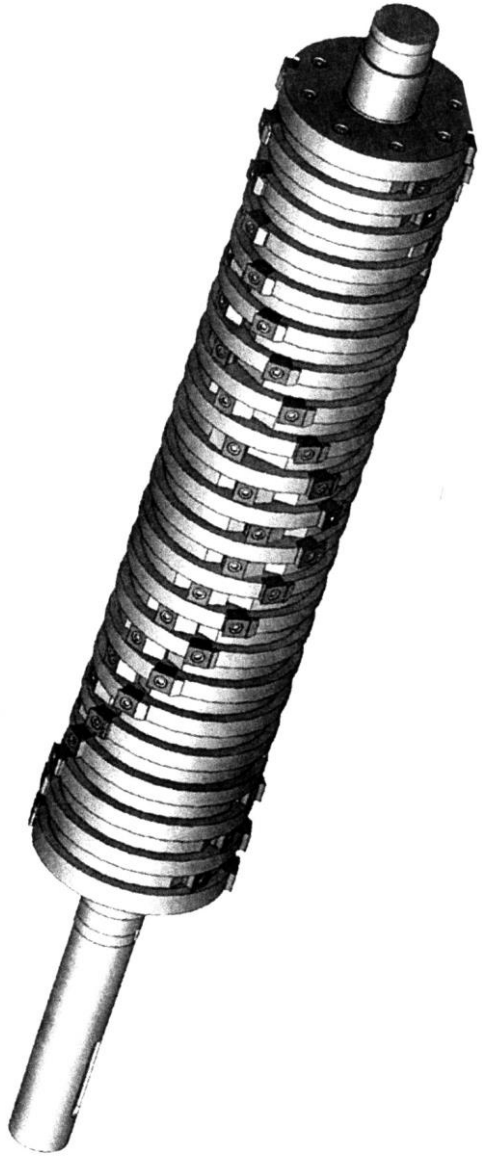
≫≫ Design as a whole may be valid, provided other requirements of protection in Articles 4-7 and 9 CDR are met

„Features dictated solely by technical function“

- Alternatives with respect to scope of protection (where design as a whole is valid): see Part 2

Lindner Recyclingtech/Franssons Verkstädter [Chaff Cutters Case] (EUIPO R 690/2007-3)

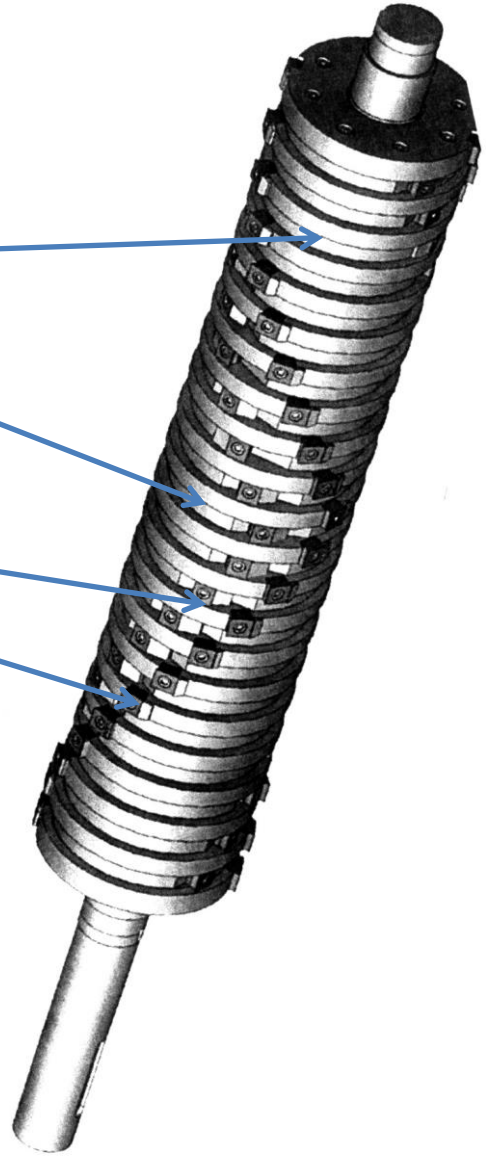
- First EUIPO case to embrace so-called „causative“ (or: „aesthetic considerations“) test for Art. 8 (1) CDR
- Rejected „multiplicity of forms“ test previously applied by EUIPO and national courts
- Represents current legal opinion of design boards at EUIPO



Chaff Cutters Case (EUIPO R 690/2007-3)

Cylinder having grooves in planes perpendicular to the rotation axis of cylinder, the grooves having same width as elevations (A)

Knives arranged along two parallel lines (B) which are C-shaped (C), one of which is arranged within the grooves (D), whereas the other line is arranged on the elevations (E)



Chaff Cutters Case (EUIPO R 690/2007-3)

- „Multiplicity of forms“ test: as applied by EUIPO prior to „Chaff Cutters“, this test asked whether there were „alternative designs“ performing the same technical function
  - Example: „*Lindner Recyclingtech GmbH*“ – ICD 03150 (later overruled by BoA in „Chaff Cutters“)

    „The feature of the V-shape arrangement of the cutting knives of RCD is not solely dictated by the technical function of the cutter. The technical function of the cutter is to cut material fed into it. <u>This function may be achieved by alternative designs with a different arrangement of the knives</u>, for instance along a straight line across the cutter or W-shape alignment. Therefore, Article 8(1) CDR does not apply to the specific feature of the V-shape arrangement of the RCD.”

Chaff Cutters Case (EUIPO R 690/2007-3)

- Main criticism of„multiplicity of forms“ test:
  - Renders Art. 8 (1) CDR and corresponding national provisions based on EU Design Directive largely insignificant as in almost all cases alternative designs performing the same function may exist (see margin No. 30)

- Arguments in favour:
  - „Multiplicity of forms“ is a purely objective test. No evaluations as to whether „aesthetic considerations“ have been a reason for including a certain feature in the design must be made, whereas the test employed by „Chaff Cutters“ may not be used without at least some such considerations
  - Practicability
  - Clarity

Chaff Cutters Case (EUIPO R 690/2007-3)

- „causative approach“ or „aesthetic considerations“ test, as employed by EUIPO in „Chaff Cutters“:

  “It follows from the above that Article 8(1) CDR denies protection to those features of a product’s appearance that were chosen exclusively for the purpose of designing a product that performs its function, as opposed to features that were chosen, at least to some degree, for the purpose of enhancing the product’s visual appearance.“ (see margin No. 36)

Chaff Cutters Case (EUIPO R 690/2007-3)

- Criticism of „causative approach“ or „aesthetic considerations“ test, as employed in „Chaff Cutters“:
  - Requires aesthetic considerations „through the backdoor“, in spite of Recital No. 10 (see margin No. 42):

    „Article 7(1) of the Directive and Article 8(1) CDR deny protection to certain designs, not because they lack aesthetic merit but because aesthetic considerations play no part in the development of the designs, the sole imperative being the need to design a product that performs its function in the best possible manner. That may fairly be said of the contested RCD. **No one cares whether such a product looks good, bad or indifferent because no one spends much time looking at it**.”

Chaff Cutters Case (EUIPO R 690/2007-3)

- Criticism of „causative approach“ or „aesthetic considerations“ test (cont‘d):
  - Introduction of „reasonable observer“ as objective standpoint (No. 36) unclear and arguably (in practice) not objective at all:

    “It goes without saying that these matters must be assessed **objectively**: it is not necessary to determine what actually went on in the designer’s mind when the design was being developed. The matter must be assessed from the **standpoint of a reasonable observer who looks at the design and asks himself whether anything other than purely functional considerations could have been relevant when a specific feature was chosen**.”

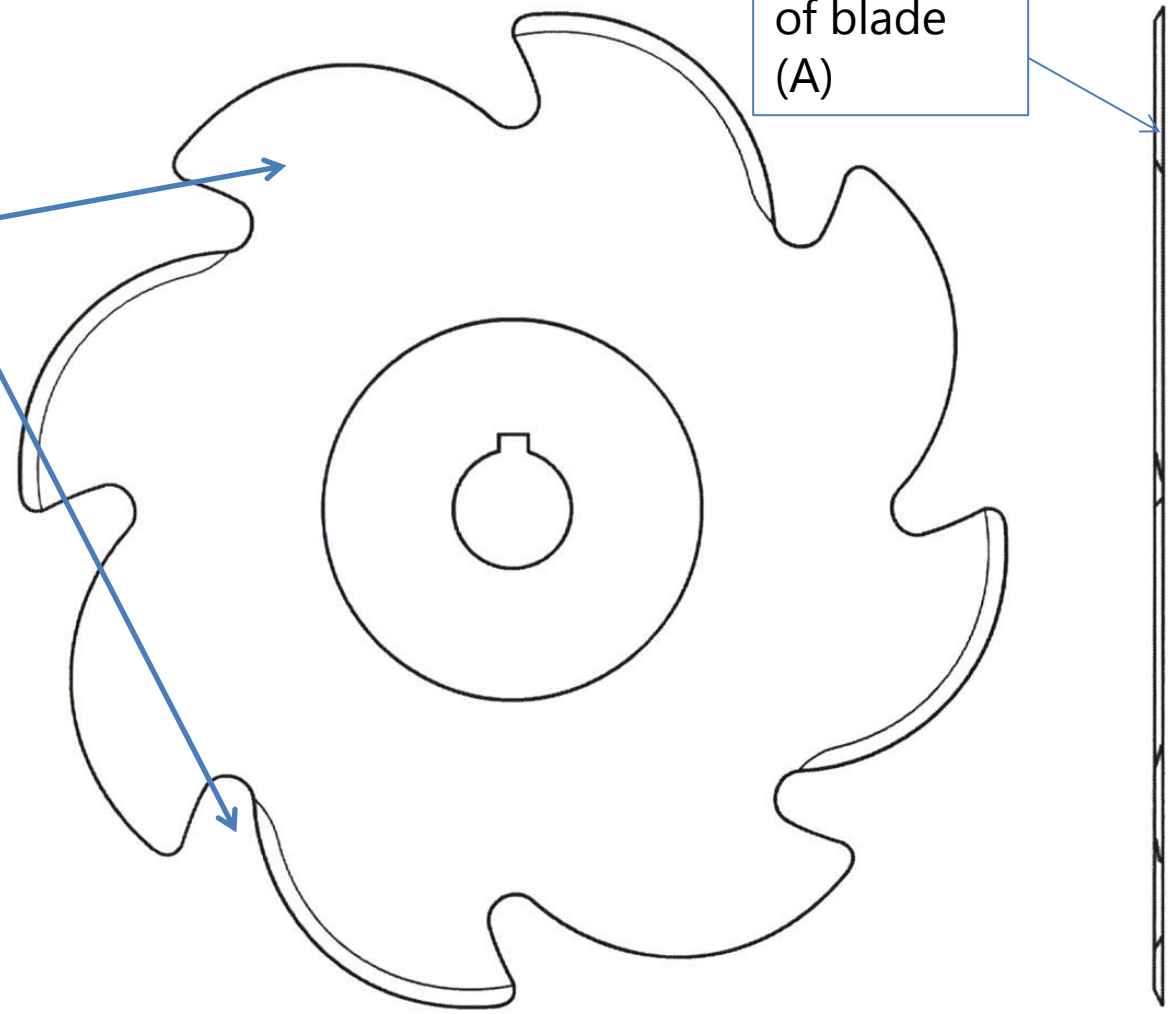
Application of Chaff Cutters Rule in practice

- EUIPO ICD 8290 [Wallop Defense Systems], 16.09.2011
- EUIPO ICD 8721 [Samsung v Apple], 14.05.2013

EUIPO ICD 8290 [Wallop Defense Systems], 16.09.2011

Thickness of blade (A)

Number and size of teeth (B) and depth and curvature of hollow of each tooth (C)



Result: Invalid by virtue of Art. 8 (1) CDR

RCD 000820618-0002

EUIPO ICD 8290 [Wallop Defense Systems], 16.09.2011

See margin Nos. 13 and 14:

> "The thickness of the blade, the number and the size of the teeth **not only affect the** size, the rotation and the number of the filaments cut but **they also define the quality of the final chaff**. Moreover, the given depth of the hollow of each tooth and the curvature of said hollow of the blade are designed in a way that assures the most beneficial chaff-cutting effect. **Every aspect** of the technical characteristics of the diameter, bevelling or size of the saw blade **is carefully examined and designed in order to assure the production of the maximum number of filaments in the minimum number of cuts.** The contested RCD as filed contributes to the creation of a saw blade **that solves any possible technical problem** of amelioration of quality, safety and effectiveness.
>
> In no event the features mentioned above **derive from the designer's liberty**. On the contrary, **they serve the proper function of the product** and they are meant to achieve the best technical performance during the chaff-cutting process."

RCD 000820618-0002

EUIPO ICD 8721 [Samsung v Apple], 14.05.2013

Slim profile

Rounded corners

Flat display

Functional elements [home button] and camera

Result: Not invalid by virtue of Art. 8 (1) CDR

EUIPO ICD 8721 [Samsung v Apple], 14.05.2013

See argument in margin No. 51:

•„Technical function of the **product** […] is to allow the user to be mobile, independent of the place of use.“„[…] cannot be excessively large or rubust; however, it does not necessarily be **as thin** as possible, as suggested by Applicants“

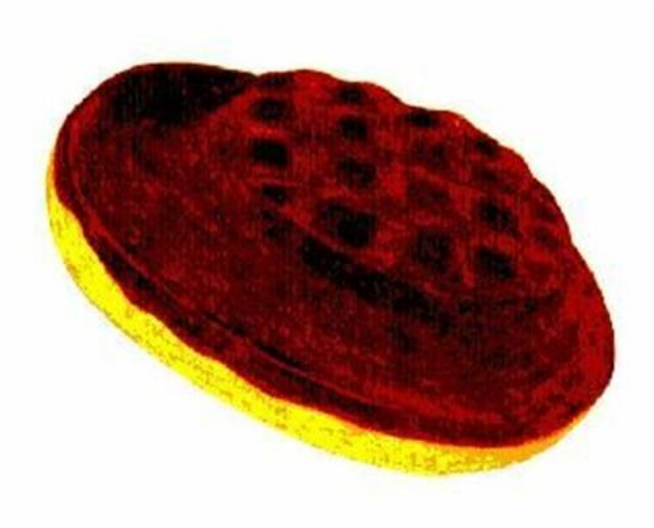
•„It is supposed to display information or internet contents; therefore it requires a **screen** and **elements** to trigger and operate the functions of the device. […] The configuration of the device, the choice, making and placement of the elements, however, is a matter of the designer’s will.“

The notion of functionality in trademark and design matters – Polish case-law

Polish trademark case-law

- heavily based on CJEU case-law
- tends to deny registration / protection of shape trademarks
- emphasizes access for competitors to technical solutions

Shape of a jaffa cake



Invalidation action

Ref.: II GSK 92/05

Shape of a jaffa cake

- the shape of cake round and flat (two-layered) results from its character as a cake, which does not mean that cakes may also be other various shapes;
- is to prevent trade mark protection from granting its proprietor a monopoly on **technical** solutions or **functional** characteristics of a product which a user is likely to seek in the products of competitors (based on C-299/99 Philips)
- a sign consisting exclusively of the form of a product can not be registered, if it is shown that the essential **functional** features of this form are determined exclusively by the **technical** features (is there any distinction?)
- the problem in the trademark law is not consistent wording
- however, based on the subject matter of the regulation, technical and functional can be equalled
- not wholly determined by technical function, however, cannot constitute the trademark (a legal basis similar to Art. 7 (1) (a) EUTMR)

Shape of a yoghurt container

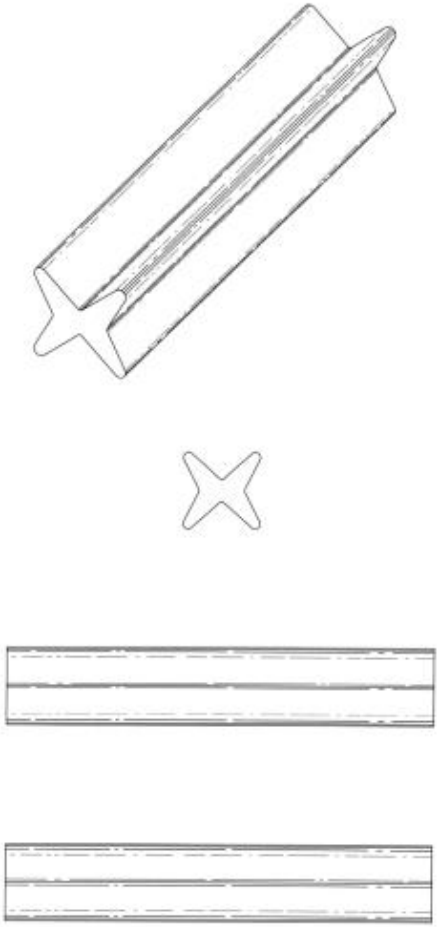
Invalidation action

Infringment action

Shape of a yoghurt container

- the essential feature: two-chamber container
- technical function: separation of two substances of different consistence, flection enables to transfer dry substance (musli etc) to yoghurt
- there are many shapes of such container
- still the essential feature is determined by the function

Shape of a teether



Ref.: XXII GWzt 1/13

Polish design case-law

- in Polish case law it is not clear whether multiplicity-of-forms theory or „causative” approach is applied
- doctrine rather tends to accept the multiplicity-of-forms theory
- rarely designs are found strictly technical
- there are cases in which a design is compared with prior design disclosed in a patent and found to have no individual character
- non-essential technical features restrict freedom of designer, thus, it is easier to prove individual character and defend design from invalidity

Design of a phone case

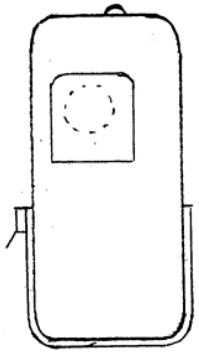


FIG.1

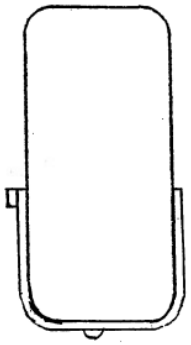


FIG.2

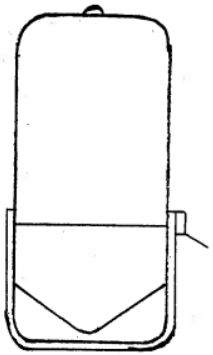


FIG.3

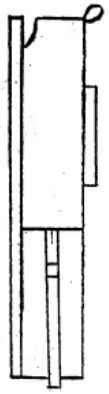


FIG.4

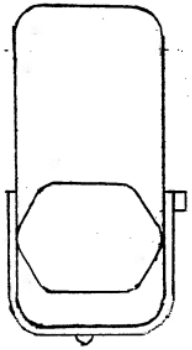


FIG.5

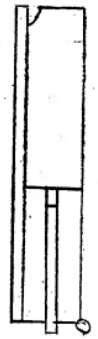


FIG.6

Ref.: VI SA/Wa 2420/13

Design of a stair strip

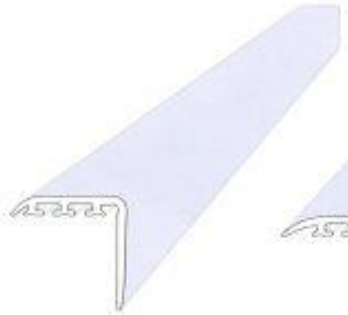


Fig. 1

Fig. 2

Fig. 3

Ref.: VI SA/Wa 498/09

Design a pneumatic advertising carrier

FIGURA NR 3

Ref.: II GSK 1196/11

Thank you for your attention!

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Trademarks and designs functionality issues in France

Cabinet Beau de Loménie

Aurélia MARIE

ASSESSMENT OF FUNCTIONALITY IN TRADEMARKS

Article L.711-2 of the French IP Code :

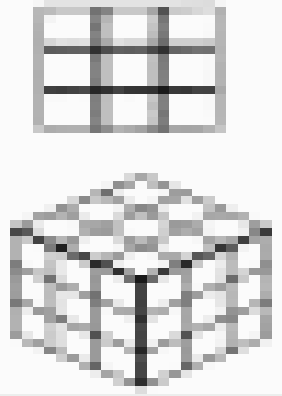
Are devoided of distinctive character….c) the signs exclusively made of the shape determined by the function of a product.

ASSESSMENT OF FUNCTIONALITY IN TRADEMARKS

Appeal Court of Anger (penal chamber) 9 October 2014 (Rubik's cube)

Shape determined by the function

The charateristics of the 3D sign made up of 27 small cubes forming a cube with 6 faces of different colours, each of them made up of 9 small cubes, are imposed by the nature and the function of a 3D puzzle.



Overturned by the Supreme Court (23 March 2016)

The judges did not precise in what the characteristics of the 3D sign are imposed by the nature and the function of the 3D puzzle.

ASSESSMENT OF FUNCTIONALITY IN TRADEMARKS

Supreme Court 30 May 2007 (Philips Remington)

Combination of functional and arbitrary elements :

When a trademark is made up of a shape imposed by the nature of the product **and other** arbitrary elements, these **arbitrary elements must have a distinctive character allowing the identification of the product**.

All the characteristics of the shapes filed as trademarks produce **a technical result or participate to such result**. The fact that other reasons may have existed in the choice made among other possible technical solutions, is irrelevant.

ASSESSMENT OF FUNCTIONALITY IN TRADEMARKS

Paris Court of Appeal, 19 June 2009, Unilever

Technical result to be achieved

Registered in class 30 for ice cream

What must be taken into consideration is the **shape as filed, as well as the function it serves** i.e. the **technical result they give.**

A sign exclusively constituted by the shape of a good cannot be registered if it is evidenced that the essential characteristics of the shape are solely due to its technical result.

The **impression given by a shape on the sense of sight or on the sense of taste** is not a technical result.

ASSESSMENT OF FUNCTIONALITY IN TRADEMARKS

Paris court of Appeal, 27 January 2015, Bottega Veneta

Criterion of multiplicity of shapes

It exists a **multiplicity of shapes of bags and buckles**; the trademarks **do not intend to protect a locking technology**, the decorative shape being arbitrary.

ASSESSMENT OF FUNCTIONALITY IN TRADEMARKS

Paris Court of Appeal,13 December2013,Nestlé

Criterion of multiplicity of shapes

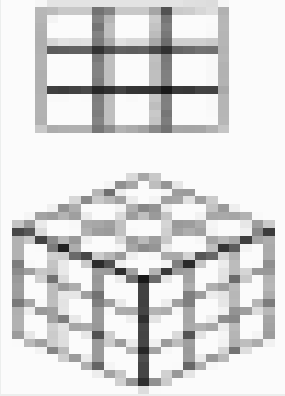
Trademark refused by the French PTO : the shape as filed was considered functional, the technical result being that the product could easily be cut.

For the Court of Appeal, it derives from the other chocolate bars existing on the market that the shape is not imposed by its nature or function but arbitrary choices were made. The two bars are linked with a thin base in order to cut them more easily but this **does not make the shape exclusively functional when there are other means to cut the bars.**

ASSESSMENT OF FUNCTIONALITY IN TRADEMARKS

First Instance Court of Paris 6 July 2012
(Rubik's cube)
Assessment of the trademark as filed

The trademarks shall be considered as they are shown in the registration, **without taking into account the characteristics that are not visible**.



The **grid structure has no technical function as represented in the registration**, nothing can make think that the elements of the cube are mobile or can rotate.

ASSESSMENT OF FUNCTIONALITY IN DESIGNS

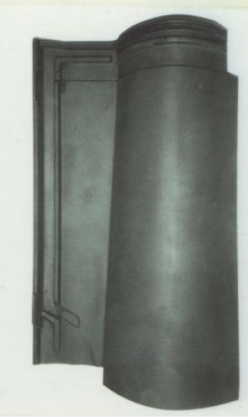
Article L. 511-8 of the French IP Code :

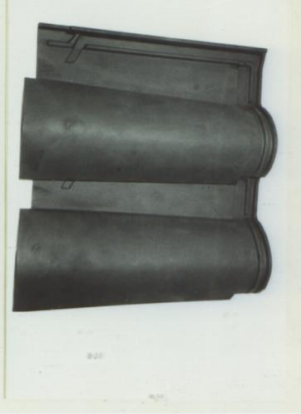
Cannot be subject to protection :

1) The apparence, whose characteristics exclusively result from the technical function of the product.

ASSESSMENT OF FUNCTIONALITY IN DESIGNS

The characteristics of the shape exclusively resulting from the technical function





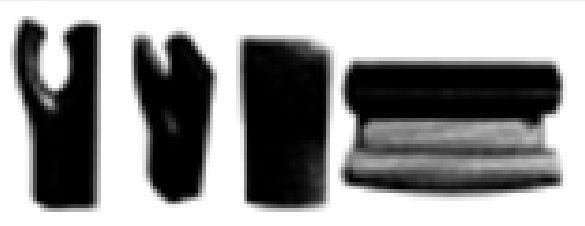
Supreme Court 29 June 2010 (roof tiles)

The shape which cannot be separated from the technical function the shape produced when used, even if aesthetic, cannot be protected as design.

ASSESSMENT OF FUNCTIONALITY IN DESIGNS

The characteristics of the shape exclusively resulting from the technical function

What means "exclusively" ?



Hand Dryers (european design)

Paris 1st Instance 15 September 2016

Exclusively means that the design is only null if its shape is controlled by its sole function.

The fact that the shape obeys to technical constraints linked to its use and functionality or the fact that there is a patent filed, does not means per se that these technical constraints exclusively dictate the choice of the shape.

ASSESSMENT OF FUNCTIONALITY IN DESIGNS

Criterion of multiplicity of shapes

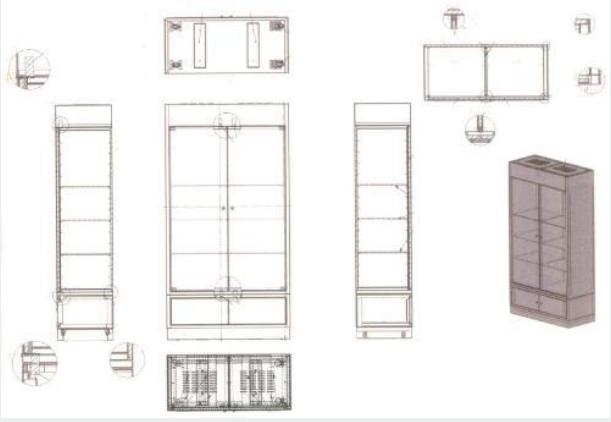
(French design)

Displays rack (Paris Court of Appeal 10 April 2009)

The shape filed is exclusively dictated by the technical function of the display. Therefore the fact that there are other possibilities for presenting the pastries in a display rack is irrelevant

ASSESSMENT OF FUNCTIONALITY IN DESIGNS

Aesthetic research : a French criterion ?



(French designs)

Showcases (Paris 1st Instance 6 December 2012)

The showcases do not reflect any aesthetic research; their shapes are common

The defendant does not explain what is not exclusively functional in the appearance of the products

ASSESSMENT OF FUNCTIONALITY IN DESIGNS

Aesthetic research : a French criterion ?

Digital pen (European designs)

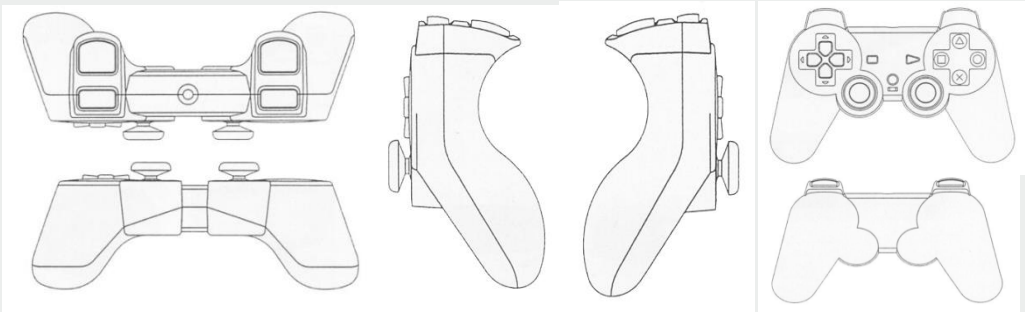
(Paris 1st Instance 6 October 2016)

The pursued design is the one of a fountain pen and the adjunction of buttons is only aesthetic.

Other digital pen with the same technical function were put on the market with different shapes.

ASSESSMENT OF FUNCTIONALITY IN DESIGNS

Aesthetic research : a French criterion ?



Video game joystick

(International design)

(Paris Court of Appeal 17 January 2017)

The choice of the shape, even if dictated by the search of a more comfortable handling, also meets an aesthetic research. Other joysticks put on the market by competitors have a different shape and a different aesthetic.

ASSESSMENT OF FUNCTIONALITY IN DESIGNS

Aesthetic research : a French criterion ?

Duvet cover zipped on a fitted sheet
(International design)

(Douai Court of Appeal 28 May 2014)

The shape and the appearance of the design and of its constitutive elements are exclusively dictated by the utilitarian goal which is pursued and from which they cannot be dissociated. The aesthetic of the design is only the result of this utilitarian goal.

Conclusion (at least a try)

The French assessment of functionality does not strictly follow the EU rulings.

As far as trademarks are concerned :

- Still , the sign as filed is to be considered (but may change with the Simba Toy EU decision of November 2016),
- The criterion of multiplicity of shapes remains even if it is not the only one taken into account.

As far as designs are concerned :

- The aesthetic search in relation with the creation of the design is a criterion often considered to assess if the design is only dictated by its technical function,
- The criterion of multiplicity of shapes remains also examined.

Cabinet Beau de Loménie

Thank you for your attention

KRIEGER MES & GRAF v. der GROEBEN DÜSSELDORF · ESTABLISHED 1929

AIPPI Seminar PL-FR-DE
Warsaw, 16 and 17 March 2017

Functionality in Design And Trademark Law

Jens Künzel, LL.M. –

Part 2: German Case Law on Functional Features

German case law on functional features

- German Designs Act, Sec. 3 (1) No. 1 (wording identical with Art. 8 (1) CDR)
- Until 2015, German courts regularly applied the „multiplicity of forms“ test
- Example: Apple/Samsung, Düsseldorf Court of Appeal GRUR-RR 2012, 200 – „Tablet-PC“

Apple/Samsung, Düsseldorf Court of Appeal GRUR-RR 2012, 200 – „Tablet-PC“

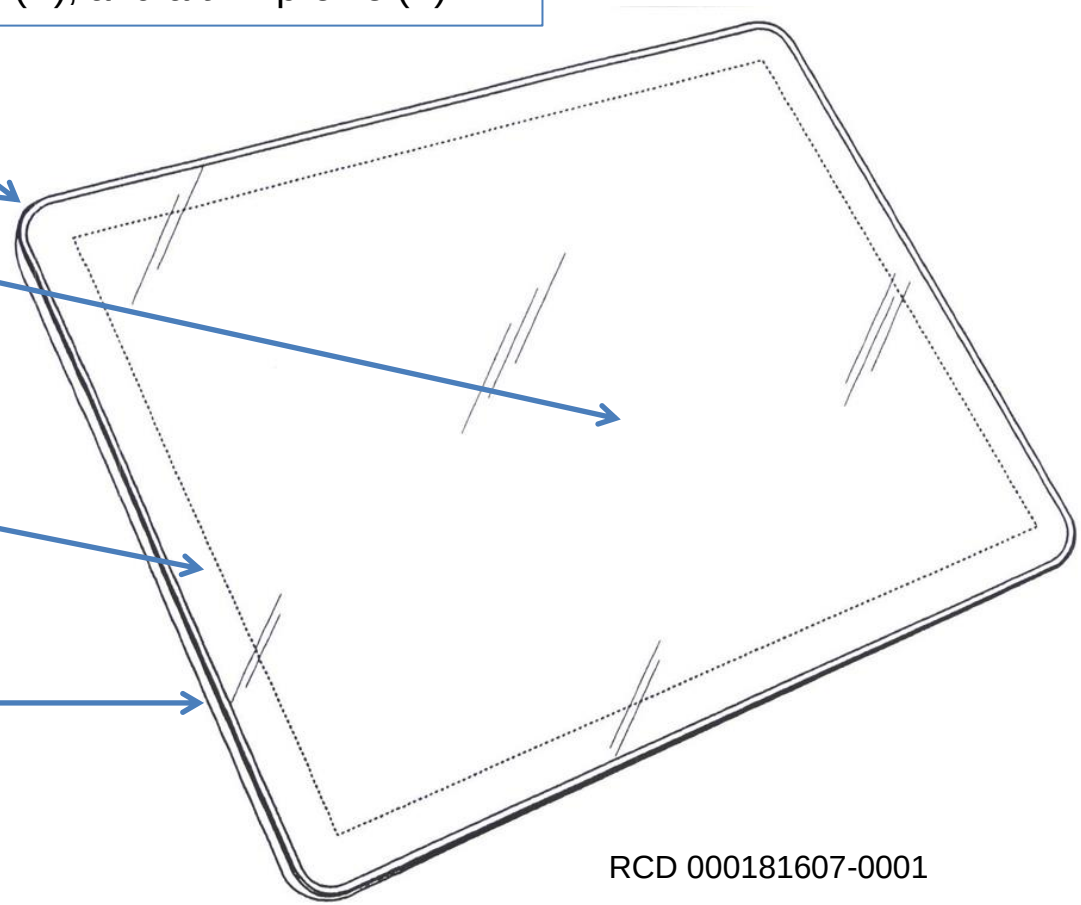
An overall rectangular form with four evenly rounded corners(A),

A flat, clear surface covering the front, without any patterning, (B),

Under the clear surface, there is a rectangular, centred margin with even distances at each of the opposite sides (C),

A thin enclosure surrounding the front (D),

A back side rounded at the corners and at the edges, (E), and a thin profile (F).



RCD 000181607-0001

Apple/Samsung, Düsseldorf Court of Appeal GRUR-RR 2012, 200 – „Tablet-PC“ – margin Nos. 67 and 68

- „None of these features is solely dictated by a technical function“
- Features are not solely dictated by a technical function „if there is **a viable design alternative** to those features with which the product may perform its technical function in at least the same way“
- “Exactly arranging the margin under the transparent front screen that extends over margin and screen is **a creative achievement**.”
- “Rounded corners […] have advantages, but their use is **not technically compulsory**”
- “The alternative products submitted by defendant differ substantially from litigious RCD, but perform their function in the same way”

Doceram/CeramTec, Düsseldorf District Court 14c O 98/13, of 13.08.2015

- Invalidated 17 RCDs covering different centring pins for welding processes by virtue of Art. 8 (1) CDR

- Applied, as the first court in Germany, the “causative approach” or “aesthetic considerations test” as proposed by EUIPO in “Chaff Cutters”

- Court of Appeal referred case to ECJ (still pending)

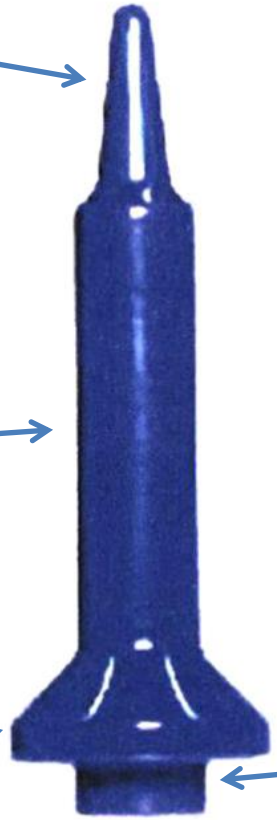
RCD 000242730-0001

Doceram/CeramTec, Düsseldorf District Court 14c O 98/13, of 13.08.2015

Rounded pylons at top – „essentially pre-determined by dimension of electrode and used screw nut“

Cylindrical basic form – „is obvious because it corresponds to hole through which pin is led

Apron – „necessary to avoid slipping out of the hole“; cylindrical part – “less prone to crack due to angle“



Cylindrical end – „is being encased by spring at lower end of electrode, has advantage to better fix pin on spring“

Doceram/CeramTec, Düsseldorf District Court 14c O 98/13, of 13.08.2015

- “With respect to each feature, the chosen design has technical advantages for the intended use, while it is not relevant that there are design alternatives”
- Plaintiff (design holder) had “exclusively advertised the technical advantages”
- Witness confirmed that only functional aspects had been relevant for the design of the pins

RCD 000242730-0001 RCD 000242730-0011

More often: Scope of protection and technical features in infringement proceedings

- Features solely dictated by technical function must not be considered for determination of overall impression (Art. 8 (1) CDR)
  ≫ **limits** scope as identically "copied" functional features do not lead to infringement, and differences in other features lead to different overall impression (no infringement)

- However, **differences** in technical features may be considered against **infringement** (see Federal Court of Justice, "Kinderwagen II [*children's buggy II*]")

- If RCD does not include solely technical features, adding such features to the attacked product does not make any difference for determination of infringement (no limitation of scope)

Thank you.

Jens Künzel, LL.M.
Rechtsanwalt | Partner

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