

# TRACK ON DESIGN: 2023 CASE LAW AT A GLANCE (CJEU, GENERAL COURT)

Arnaud FOLLIARD-MONGUIRAL  
10 October 2023

## PROGRAMME

**45'**  
**Presentation**

- Visibility
- Functionality
- Disclosure
  - Effective disclosure
  - Grace period
- Novelty
- Individual character

**15'**  
**Questions and answers**

# 1 Visibility

## Article 4(2) CDR: Visibility

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**:

- if the component part, [...], **remains visible during normal use** of the latter; and
- [...] **those visible features** of the component part fulfil in themselves **the requirements as to novelty and individual character**.



## Are consumables component parts of complex products?

Decision's date

22/03/2023

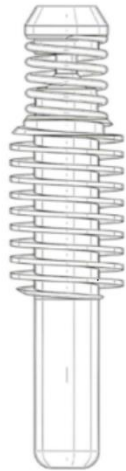
Case number

T-617/21

Title

Welding torches (part of -)

EU:T:2023:152



1.3



1.4

### Powermax30® XP

Duramax® LT hand torch consumables



Minimum order quantity	1	1	5	5	1	
Consumable type	Torch type	Shield/deflector	Retaining cap	Nozzle	Electrode	Swift ring
Standard (15-30 A)	Hand	420116	420114	420118	420120	420211
Quantity in kit		2 (1 each)	1	4	3	7
Essential cutting kit - 851478 (15-30 A)	Hand	420116 (Standard shield) 420115 (FineCut deflector)	420114	420118 (Standard) 420117 (FineCut)	420120	420211
			Combination kit 429243*			
			*Kit contains 2 standard nozzles (420118) and 2 electrodes (420120)			

Minimum order quantity	1	1	5	5	1	
Consumable type	Torch type	Shield/deflector	Retaining cap	Nozzle	Electrode	Swift ring
FineCut (15-30 A)	Hand	420115	420114	420117	420120	420211
Quantity in kit				Combination kit 429244*		
				*Kit contains 2 FineCut nozzles (420117) and 2 electrodes (420120)		

Minimum order quantity	1	1	1	1	
Consumable type	Torch type	Retaining cap	Nozzle	Electrode	Swift ring
HyAccess drag-cutting (15-30 A)			420144		
HyAccess gauging (15-30 A)	Hand	420148	420147	420137	420211
Quantity in kit		1	1	2	1
HyAccess kit - 428337 (15-30 A)	Hand	420148	420144 (cutting)	420147 (gauging)	420137
			HyAccess cutting only starter pack - 428443*		
			HyAccess gauging only starter pack - 428444*		



[Link to the full case](#)

## Are consumables component parts of complex products?

Decision's date	Case number	Title	
22/03/2023	T-617/21	Welding torches (part of -)	EU:T:2023:152

- As **an exception** to the system of protection laid down in **Article 4(1), Art. 4(2) must be interpreted strictly (§ 25)**
- The **concept of ‘component part of a complex product’** covers **multiple components**, [...] which can be replaced permitting disassembly and re-assembly of such an item, **without which the complex product could not be subject to normal use** (§ 26).
- **Relevant criteria:**
  - (i) The consumable nature of the product;
  - (ii) the absence of disassembly and re-assembly of the complex product;
  - (iii) the completeness of the complex product; and
  - (iv) the interchangeability of the product in respect of the complex product (§ 39, 49, 62, 70).

## Are consumables component parts of complex products?

Decision's date	Case number	Title	
22/03/2023	T-617/21	Welding torches (part of -)	EU:T:2023:152

- i. The absence of a **firm and durable connection** with the complex product and the regular purchase and replacement on account of its **short lifespan** are standard characteristics of a **consumable** (§ 35).
- ii. The electrode is intended to be easily attached to the torch, consumed and used relatively quickly, and easily replaced by the end user **without that operation requiring disassembly and re-assembly of that torch** (36).
- iii. **The fact that the torch is regarded as complete without the electrode**: The mere fact that the complex product cannot function without a particular element, does not in itself mean that that element constitutes its component part in the sense of Article 4(2) CDR. When purchasing a torch without an electrode or when the electrode is removed from the torch, the end user will not perceive that torch as being broken or **incomplete** (§ 56, 57).

## Are consumables component parts of complex products?

Decision's date	Case number	Title	
22/03/2023	T-617/21	Welding torches (part of -)	EU:T:2023:152

iv. The fact that the product is commonly advertised and **sold separately** from the complex product is a relevant factor to determine whether the product is a component part of a complex product (§ 59).

v. **The interchangeability of the electrode**: A product which cannot be replaced by another non-identical product or be used in different complex products is, in principle, more likely to be linked in a durable and tailored manner to that complex product, and thus to constitute a component part of that complex product' (69)



BoA, 23/08/2021, R 299/2021-3, Vacuum cleaner bag



[Link to the full case](#)

## What constitutes normal use?

Decision's date

16/02/2023

Case number

C-472/21

Title

Monz Handelsgesellschaft International

EU:C:2023:105



[Link to the full case](#)

- An assessment *in abstracto* of the visibility of the component part incorporated into a complex product, **unconnected to any practical situation** of use of the product, is not sufficient to allow a component part to benefit from design protection (§ 45)
- Article 3(3) of Directive 98/71 does not require a component part that is incorporated into a complex product to remain **fully visible the whole time** that the complex product is being used (§ 45)
- The **visibility** of such a component part is to be examined in the perception of the end user, **including external observers** (§ 46).

## What constitutes normal use?

Decision's date

16/02/2023

Case number

C-472/21

Title

Monz Handelsgesellschaft International

EU:C:2023:105



[Link to the full case](#)

- The **concept of ‘normal use’** of a product by the end user **does not correspond to the use intended by the manufacturer or designer** of the component part or of the complex product, but rather to the **normal or customary use of the complex product** by the end user (§ 51-55).
- **Includes all acts of use** surrounding the principal function of a bicycle, such **as storage and transportation** (§ 54).

# 2 **Functionality**

## Article 8(1) CDR: Functionality

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



## Article 8(1) CDR: Functionality

Decision's date

02/03/2023

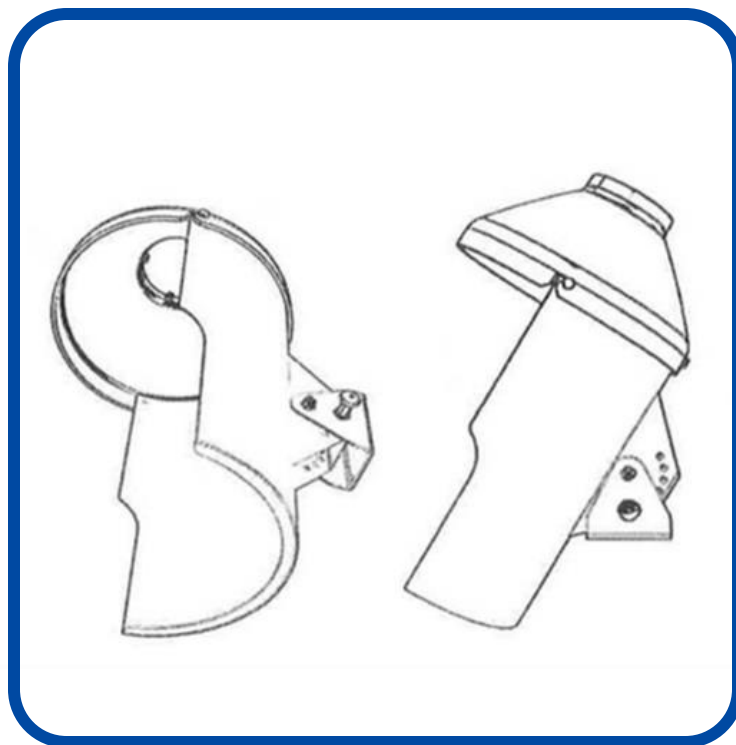
Case number

C-684/21

Title

Papierfabriek Doetinchem (packing-paper dispenser)

EU:C:2023:141



[Link to the full case](#)

- **Article 8(1) CDR** applies where the need to fulfil a technical function is the **only factor** determining the choice of appearance features, protection under the regulation is not applicable (§ 20)
- The existence of **alternative designs** that fulfil the same technical function **is not sufficient** in itself to exclude the application of Article 8(1) (§ 21)

## Article 8(1) CDR: Functionality

Decision's date

02/03/2023

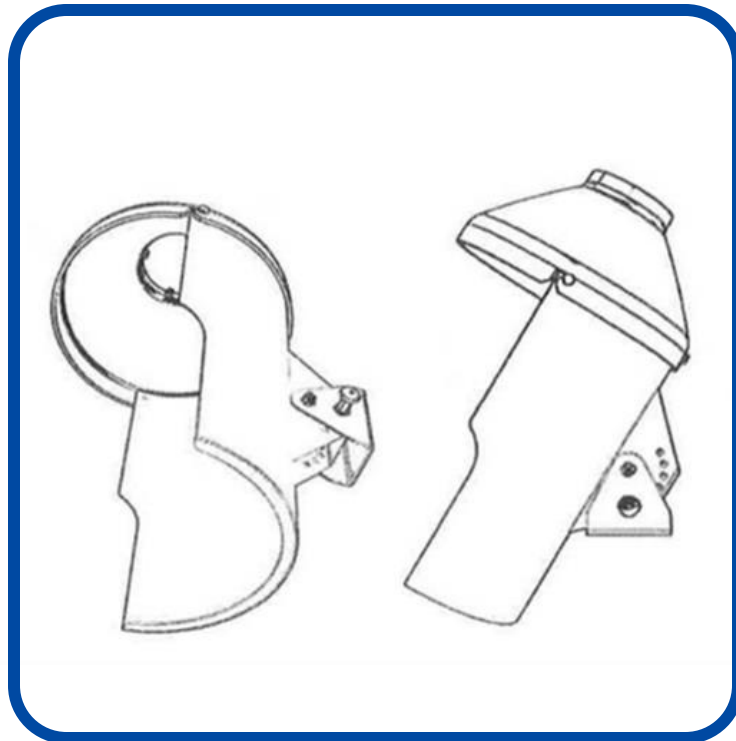
Case number

C-684/21

Title

Papierfabriek Doetinchem (packing-paper dispenser)

EU:C:2023:141



[Link to the full case](#)

- All **objective circumstances** relevant to each case must be considered, including the design at issue, **the reasons dictating the choice of appearance features**, as well as the existence of **alternative designs**, all this supported by reliable evidence (§ 23)
- The design of a product allows for a **multicolour appearance cannot be taken into account** if it is **not apparent** from the registration of the design. **The graphic representation in the registration must clearly identify the design to ensure legal certainty for third parties** (§ 32).

## Identification of the design's features

Decision's date

29/03/2023

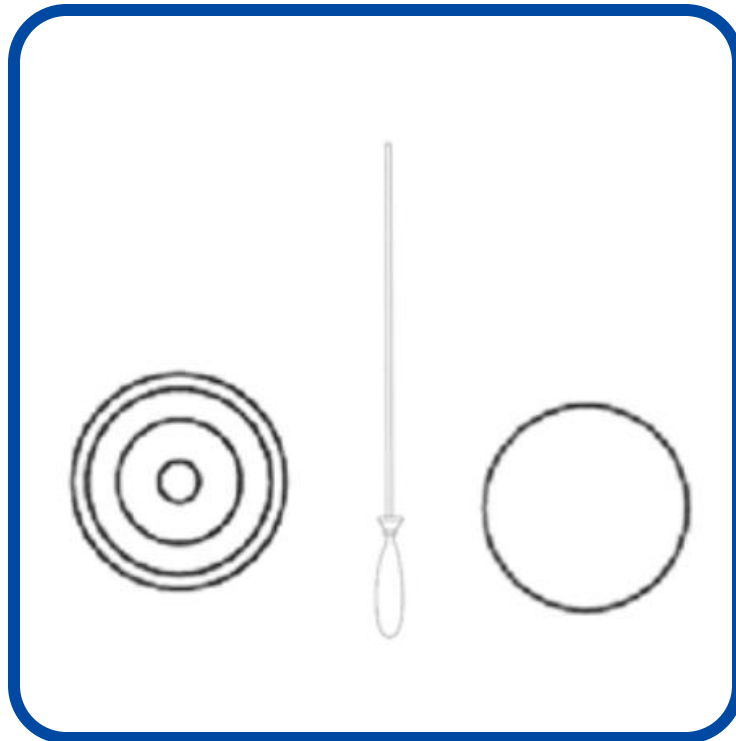
Case number

T-588/21

Title

Fluid distribution equipment

EU:T:2023:182

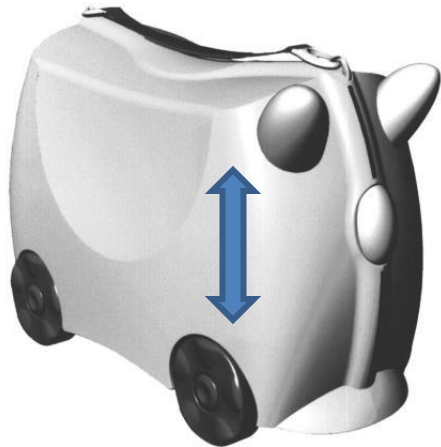


[Link to the full case](#)

- ‘As regards the applicant’s argument that the Board of Appeal failed to take into account the **same contrast** of the balloon, ring and tube, it should be noted that the **contested design was represented in the application for registration in black and white – not in colour** – and that there was nothing in that representation indicating that the applicant was seeking protection of the ‘feature’ referred to above. For that reason, the applicant’s argument must be rejected’ (§ 40).



## UK Supreme court, 9 March 2016 [2016] UKSC 12



- If an applicant for a Community Registered Design elects to submit CADs of an item, whose main body appears as a **uniform grey**, but which has a black strip, a black strap and black wheels, the natural inference is that the components shown in black are intended to be in a **contrasting colour** to that of the main body.
- The Court of Appeal was right to hold that the design claimed in this case was for a wheeled suitcase in the shape of a horned animal, but that it was not a claim for the shape alone, but for one with a strap, strips and wheels and spokes in a colour (or possibly colours) which contrasted with that of the remainder of the product.

[Link to the full case](#)

## Identification of the RCD's features

Decision's date

29/03/2023

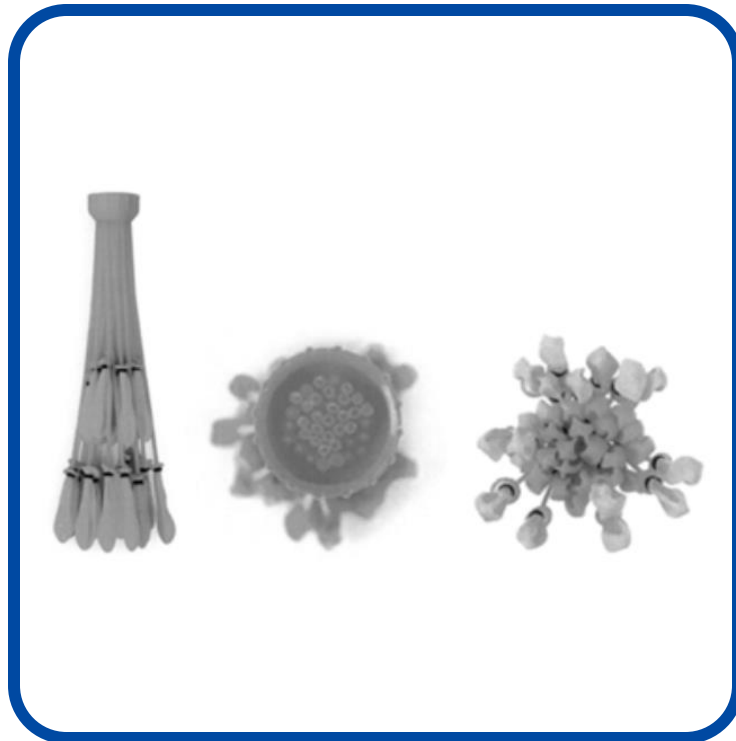
Case number

T-505/21

Title

Fluid distribution equipment

ECLI:EU:T:2023:174



[Link to the full case](#)

- **Features of appearance** that are **usually present** in the product concerned **would not usually be considered to be the result** of a **specific choice** made by the designer. Therefore, they do not have to be referred to explicitly when identifying the features of appearance of the product concerned (§ 33-35, 38).
- Elements that will **not be noticed** by the user when the product concerned is in use do not have a real visual impact capable of classifying them as a 'feature of appearance' (§ 47).

## Identification of the RCD's features

Decision's date

29/03/2023

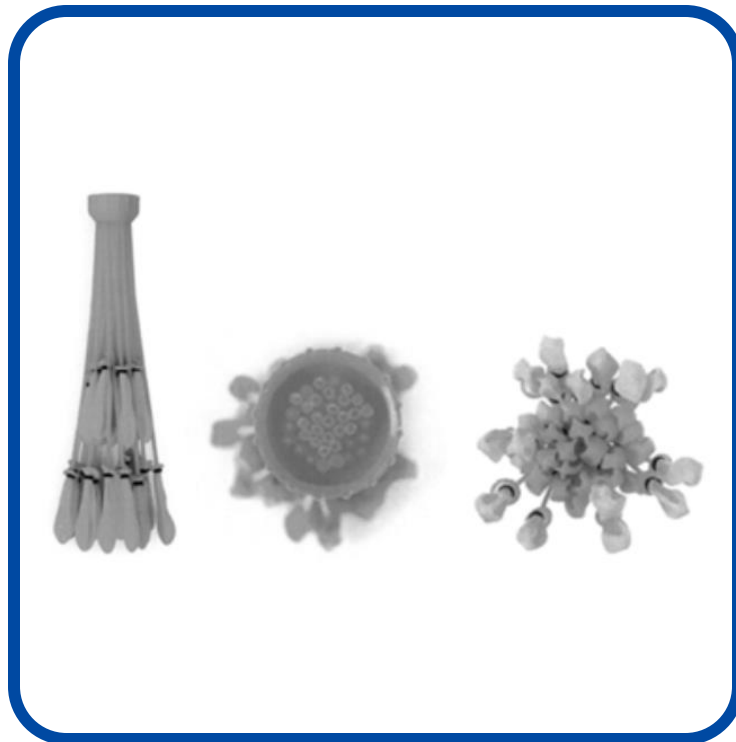
Case number

T-505/21

Title

Fluid distribution equipment

ECLI:EU:T:2023:174



[Link to the full case](#)

- The applicant has **not shown that aesthetic considerations necessarily play a role when designing** products meant for entertainment
- **Various alternative configurations** of the tubes and balloons, which appear on the designs included in the multiple application, are different ways of enabling a large number of balloons to be filled with water at the same time. This is an **indication of the holder's intention to enjoy exclusive protection, equivalent to that conferred by a patent, in respect of the technical solution** that is the basis of the product concerned (§ 91).

General Court, T-231/21, 19/10/2022, « post » (Art. 8 CDR)

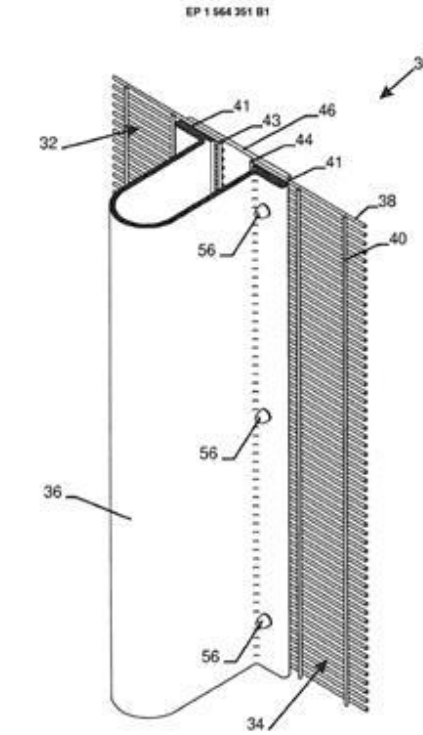
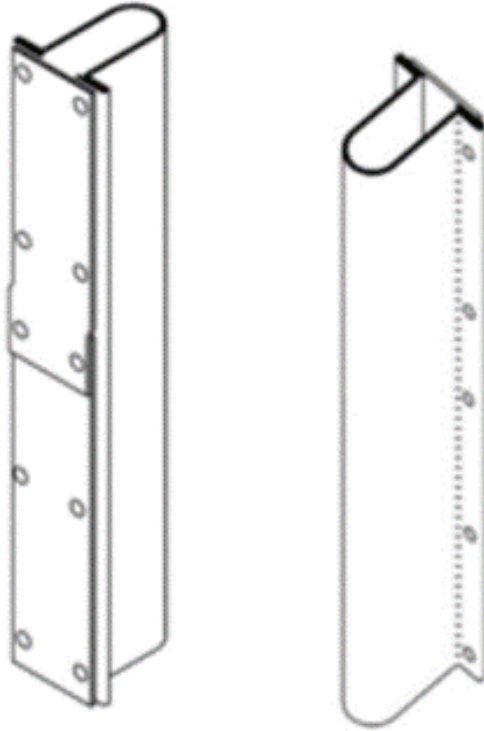


Fig. 2

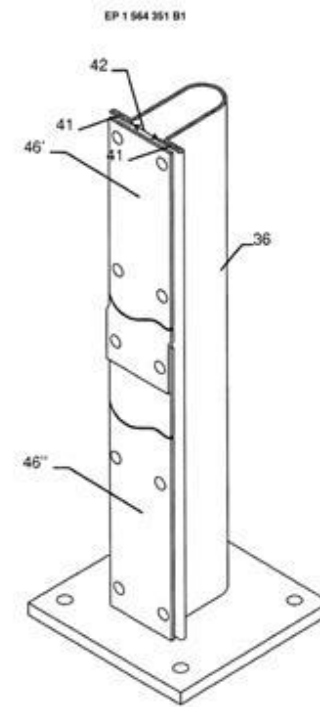


Fig. 3

[Link to the full case](#)

# 3 Disclosure

## Article 7 CDR: disclosure & self-disclosure

### 1. A design shall be deemed to have been made available to the public if it has been :

- **published** following registration;
- **exhibited;**
- **used in trade**
- or **otherwise disclosed** [...]

**except where** these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community

**The design shall not, however, be deemed** to have been made available to the public for the sole reason that it has been disclosed **to a third person** under **explicit or implicit** conditions of **confidentiality**.



## Article 7 CDR: disclosure & self-disclosure

### 2. A disclosure shall not be taken into consideration [...]

and if a design for which protection is claimed under a registered Community design **has been made available to the public:**

- **by the designer, his successor in title**, or a third person as a result of information provided or action taken by the designer or his successor in title; **and**
- during **the 12-month period** preceding the date of filing of the application or, if a priority is claimed, the date of priority.
- if the design has been made available to the public as a consequence of an **abuse in relation to the designer or his successor in title.**







## Article 7 CDR: disclosure & self-disclosure

Decision's date	Case number	Title	
21/06/2023	T-347/22	Schmelzriegel II	EU:T:2023:344

- **The evidence in invalidity proceedings before the EUIPO** must, in principle, **be presented in the language of the proceedings**. However, if this is not the case, the EUIPO **may** require a **translation** (Art. 81(2) CDIR). The mere fact that certain evidence was produced in a language other than the language of the proceedings is, therefore, not sufficient reason for rejecting the application for a declaration of invalidity (§ 34).
- **Posting on the internet** is, **in principle**, a circumstance that **may constitute a disclosure** within the meaning of Article 7 CDR (§ 62).
- Moreover, the production of a **technical drawing** **does not in itself generally prove that the drawing has actually been brought to the attention of the public**, but it may be capable of **corroborating other evidence** showing that products conforming to the specifications of that drawing and bearing the same references have been placed on the market (§ 62)

## Article 7 CDR: disclosure & self-disclosure

Decision's date

26/04/2023

Case number

T-757/21

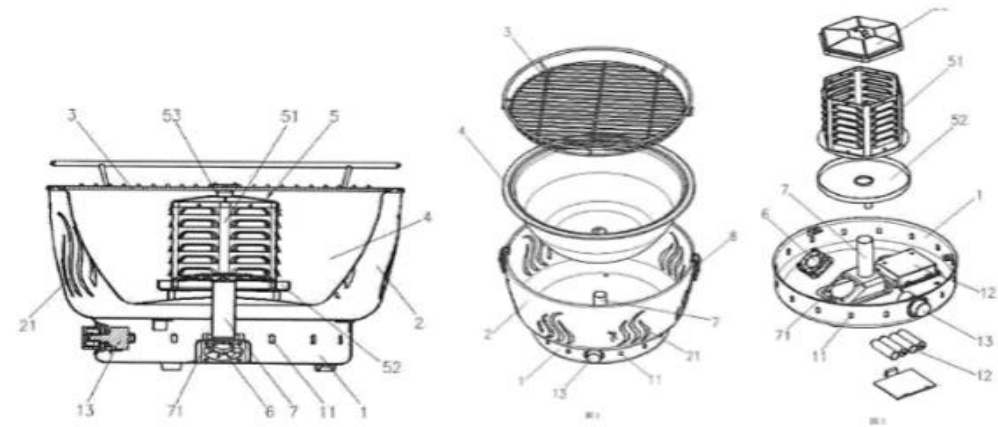
Title

Grilling apparatus

EU:T:2023:216



Contested RCD filed in the name of company Y  
(successor-in-title to Mr X)



Chinese Utility Model published within grace period  
(filed in the name of Mr X)

[Link to the full case](#)

## Article 7 CDR: disclosure & self-disclosure

Decision's date	Case number	Title	
26/04/2023	T-757/21	Grilling apparatus	EU:T:2023:216

- The **benefit of the grace period** supposes that the RCD proprietor was **on the filing date** (or the priority date) the holder of the design previously disclosed within the 12-month period.
- In this case, **the transfer was signed after** the RCD's filing date but with retroactive effect.
- There is nothing in Article 7(2) CDR which prohibits a registered design that is subject to the 'grace period' from being acquired and that exception from being benefited from (§ 36).

# 4 Novelty

## Article 5 CDR: Novelty

### 1. A design shall be considered to be new if no **identical design** has been made available to the public:

- **For unregistered Community design** : before the date on which the design for which protection is claimed has first been made available to the public;
- **For registered Community design**: before the date of filing of the application for registration of the design for which protection is claimed, or, if priority is claimed, the date of priority.



### 2. **Designs** shall be deemed to be identical if their features differ only in **immaterial details**.

## Article 5 CDR: Novelty

Decision's date

15/03/2023

Case number

T-89/22

Title

Chairs

EU:T:2023:132

Right



Contested RCD



Earlier design (Art. 5 CDR)

[Link to the full case](#)

## Article 5 CDR: Novelty

<b>Decision's date</b>	<b>Case number</b>	<b>Title</b>	
15/03/2023	T-89/22	Chairs	EU:T:2023:132

- The invalidity request was based on **Art. 5 (novelty)** and **6 CDR** with **different earlier designs being relied on for each ground**.
- **CD dismissed action** based on an **earlier design** which was relied on in support of the lack of novelty (**Art. 5 CDR**).  
**BoA annulled and invalidated the design** based on the **same earlier design** but under **Art. 6 CDR** (individual character).  
**GC annuls for lack of competence.**

## Article 5 CDR: Novelty

<b>Decision's date</b>	<b>Case number</b>	<b>Title</b>	
15/03/2023	T-89/22	Chairs	EU:T:2023:132

- **Disclosure (internet):** A screenshot of a sale offer on Amazon, supported by an ASIN identification number (which identifies the date of publication of the offer for sale), **establishes proof of disclosure** (§ 38-39).
- **Scope of examination:** Where a prior design has only been clearly invoked in support of the ground of lack of novelty (Article 5), examining that earlier design ex officio also under Article 6 (lack of individual character) exceeds the competencies of the BoA and thus infringes Article 63(1) CDR.
- This is because the **examination of Article 6 CDR required the application of different criteria** (§ 69, 71). (comp. with [01/02/2023, T-349/22, Hacker space / Hacker-pschorr et al., EU:T:2023:31](#))



## Article 5 CDR: Novelty

Decision's date

06/09/2023

Case number

T-492/22

Title

Socks box

EU:T:2023:516



Contested RCD



Earlier design

[Link to the full case](#)

# 5 Individual character

## Article 6 CDR: Individual character

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 [...] by any design which has been made available to the public:

- **For unregistered Community design** : before the date [...] the design [...] has first been made available to the public;
- **For registered Community design:** before the **date of filing** of the application for registration [...] or, [...], the **date of priority**.



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

## Article 6 CDR: Individual character

Decision's date

06/09/2023

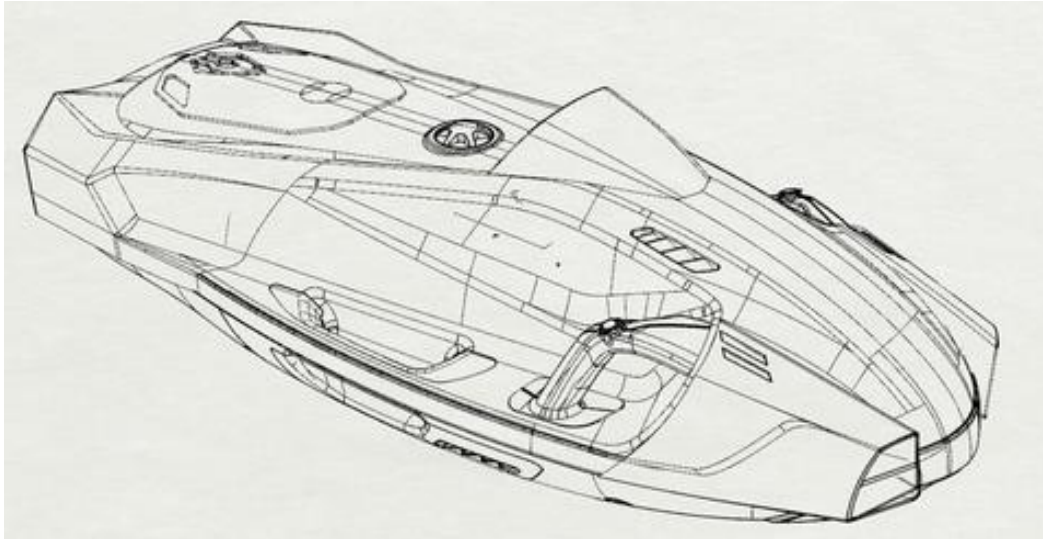
Case number

T-377/22

Title

Sea scooter

EU:T:2023:504



Contested RCD



Earlier design

[Link to the full case](#)

## Article 6 CDR: Individual character

<b>Decision's date</b>	<b>Case number</b>	<b>Title</b>	
06/09/2023	T-377/22	Sea scooter	EU:T:2023:504

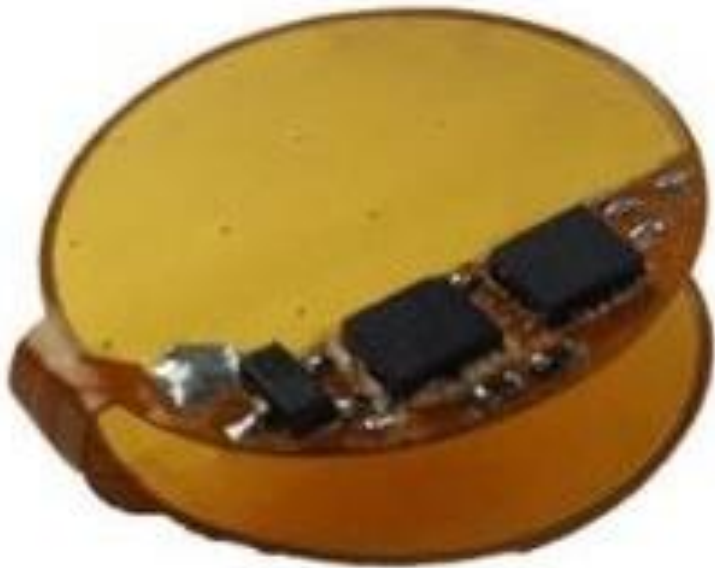
- The fact that a **preliminary injunction was ordered** against the marketing of the contested RCD in 3 MS **is not directly relevant** (§ 36).
- **The designer's degree of freedom may reinforce or nuance similarities.** In this case, notwithstanding a wide degree of freedom, the differences are too striking to be ignored by the informed user (§ 54-55).
- **An expert report stressing the similarities of the compared design is not binding on EUIPO** (§ 66 and 69).

## Poll

### In your view, which statement is correct:

- a) A design consisting of a **functional** shape **in colours** will not be caught by Art. 8(1) CDR (prohibition of functional shapes) unless it is established that the colours themselves are functional.
- b) The invalidity of a design consisting of a functional shape in colours requires that the request for invalidity be based both on Art. 8(1) CDR for the shape, **and** on Art. 5 or 6 CDR for the colours

**BoA, 05/07/2021, R 1070/2020-3, Accessory for remote controls (annulled by GC, 30/11/2022, T-611/21, on a procedural point)**

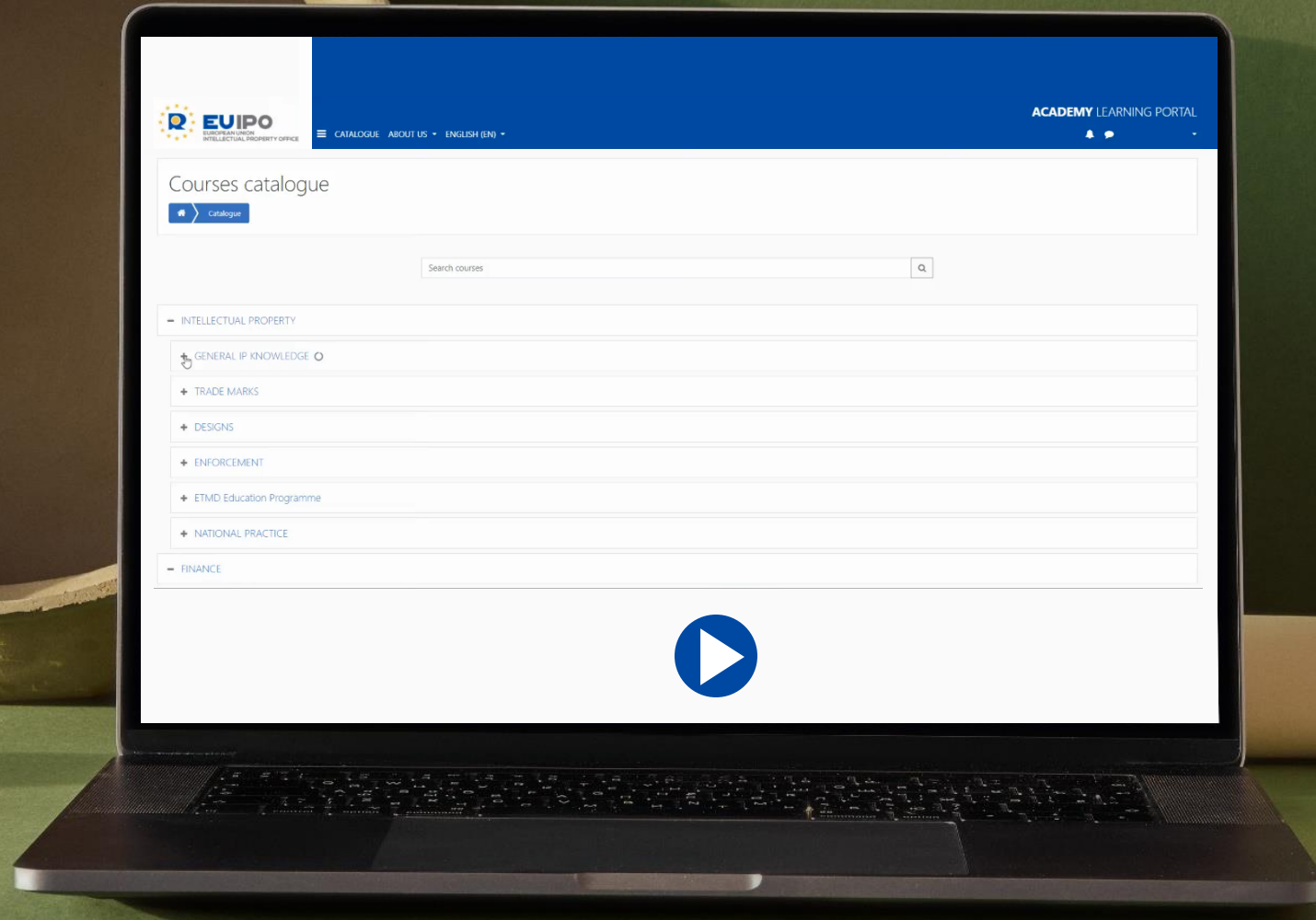


[Link to the full case](#)





## Keep in touch with the EUIPO Academy





**Arnaud Folliard-Monguiral,**  
Legal Department - EUIPO



**EUIPO**

EUROPEAN UNION  
INTELLECTUAL PROPERTY OFFICE

[www.euipo.europa.eu](http://www.euipo.europa.eu)



[@EU\\_IPO](https://twitter.com/EU_IPO)



[EU IPO](https://www.linkedin.com/company/euipo)



[EUIPO.EU](https://www.facebook.com/EUIPO.EU)

**THANK YOU**