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2016 – Study Question (Designs)

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Requirements for protection of designs

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I. Current law and practice

- 1) Does your Group's current law provide for an intellectual property right (registered or patented) that specifically protects the outward appearance or ornamentation of an object or article of manufacture?

As set out in the Study Guidelines, copyrights and trademarks are not such rights in the context of this Study Question.

yes

Please explain:

The latest amendment of the German Act on the Legal Protection of Designs (German Design Act, in the following GDA) was published on 24 February 2014^[1]. The Act of March 2004 implements Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs (OJ L 289, 28.10.1998, p. 28)^[2]. Sec. 1 (1) GDA defines „design“ as the two-dimensional or three-dimensional appearance of the whole or a part of a product, resulting from the features, in particular, the lines, contours, colors, shape, texture or materials of the product itself or its ornamentation, but excluding computer programs.

Germany has a long tradition of protecting designs. The „Gesetz betreffend das Urheberrecht an Mustern und Modellen“ (Act Concerning Copyrights in Designs and Models) dates back to 1876.

In parallel, the Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Designs (CDR)^[3], protects designs in the European Union and, thus also, in Germany. According to Art. 3 (a) CDR, design "means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colors, shape, texture and/or materials of the product itself and/or its ornamentation". Although two-dimensional appearances are not mentioned explicitly, Art. 3 (b) CDR stipulates that a product can be a graphic symbol. In most cases, this symbol will be two-dimensional. Moreover, Art. 5 of the Community Design Implementing Regulation (EC) No. 2245/2002 (CDIR)^[4] refers

to applications of two-dimensional designs. Thus, two-dimensional designs are protected as Community Designs, as well.

According to the Guidelines for Examination of Registered Community Designs^[5], transformable designs are registrable, too. Alternative positions of the moveable or removable parts of a design can be shown in separate views, for example the design of a flip phone.^[6] Transformable designs do not, however, protect functions. Only the visual appearance is protected.

Footnotes

1. [^ https://www.gesetze-im-internet.de/englisch_geschmmg/index.html](https://www.gesetze-im-internet.de/englisch_geschmmg/index.html).
2. [^ http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:31998L0071&from=EN](http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:31998L0071&from=EN).
3. [^ http://euipo.europa.eu/en/design/pdf/reg2002_6.pdf](http://euipo.europa.eu/en/design/pdf/reg2002_6.pdf)
4. [^ https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/cdr_legal_basis/22452002_cv_en.pdf](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/cdr_legal_basis/22452002_cv_en.pdf)
5. [^ https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/designs_practice_manual/WP_LR_2016/examination_of_applications_for_registered_community_designs_en.pdf](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/designs_practice_manual/WP_LR_2016/examination_of_applications_for_registered_community_designs_en.pdf)
6. [^ Guideline for Examination, see footnote 5, pages 26-27](#)

- 2) If yes, what is this right called? (e.g. registered design, design patent, industrial design, industrial design patent)

References to design below are to be read as references to this right, irrespective of what it is called in your jurisdiction.

The German right is called „design“, the same is true for the European Community. However, whilst the CDR protects registered and unregistered designs, the GDA only protects registered designs.

- 3) What are the statutory requirements for such right? Please tick any relevant boxes and explain the basis and application of these requirements.

- a) novelty

A design is deemed to be new if no identical design has been disclosed prior to the date of filing of the application. Designs shall be deemed to be identical if their features differ only in immaterial details (Sec. 3 (2) GDA). According to Sec. 5 GDA, a design has been disclosed if it has been published, exhibited, used in trade or has been otherwise made available to the public, except where these events could not reasonably have become known in the normal course of business to the circles specialized in the sector concerned, operating within the Community, before the date of filing of the application for the design. A design is not be deemed to have been disclosed for the sole reason that it was made known to a third party under explicit or implicit conditions of confidentiality. Furthermore, there is a twelve-month grace period preceding the date of filing (Sec. 6 GDA). The same requirements apply for Community Designs (see Art. 5, Art. 7 CDR).

- b) non-obviousness

- c) inventive step

d) individual character

A design has individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been disclosed prior to the date of filing of the application. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration (Sec. 3 (3) GDA). The same requirements are valid for Community Designs (see Art. 6 CDR).

e) originality

f) aesthetic

g) ornamental

h) other, namely ...

4) Does your Group's current law deny design protection to a design with an appearance that is dictated solely by its function?

yes

Please explain:

According to Sec. 3 (1) (1) GDA, features of appearance of products which are solely dictated by their technical function, are excluded from design protection. The same applies to Community Designs: According to 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.

The design is excluded from protection only if all features of the design are solely dictated by its function under Sec. 3 (1) (1) GDA and Art. 8 (1) CDR. If only some features of the product are solely dictated by its function, the design is protected, but the scope of protection is limited accordingly.

The interpretation of Sec. 3 (1) (1) GDA on the one hand and Art. 8 (1) CDR on the other hand is highly controversial. Recital 14 of Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs^[1] gives an idea of this provision's purpose, when it states that technological innovation should not be hampered by granting design protection to features dictated solely by a technical function, while, on the other hand, a design needs not have an aesthetic quality in order to be protected as a design. Moreover, features of a design which are consequently excluded from protection are not taken into account for the purpose of assessing whether other features of the design fulfill the requirements for protection.

Accordingly, it is not possible to monopolize solely technical features by registering a design, as a design focuses on the *appearance* of a product and not its technical function, and it must not serve as a loophole to avoid the relatively stringent conditions laid down in patent law^[2].

There are two theories discussed in this context in order to draw the line between design law and patent law: The „multiplicity-of-forms-test“ and the „no-aesthetic-consideration-test“.

- “Multiplicity-of-forms-test“:

According to the multiplicity-of-forms-test, a design is not solely dictated by function, if a technical solution can be achieved by alternative methods: If the designer has a choice between two or more design configurations for the product to fulfill its technical functions, the exception of Art. 8 (1) CDR

and Sec. 3 (1) No. 1 GDA does not apply.

As early as 1991, this was the *Commission of the European Communities'* approach in its Green Paper on the Legal Protection of Industrial Design^[3]: If the designer had a choice among various forms in order to arrive at the technical effect and if the designer therefore had a margin of freedom with respect to aesthetic features independently from the technical function, then the features in question can be protected.

German Courts and German authors defend this approach, too. Amongst others, *Ruh*^[4] agrees that Art. 8 (1) CDR, which corresponds to Sec. 3 (1) (1) GDA is not applicable if a designer has the choice between two or more configurations which all achieve the same technical function, citing, amongst others, the Green Paper. Moreover, the criteria of the multiplicity-of-forms-test have the advantage of being clear and easy to apply. Whether an alternative exists is determined by^[5]

- the exact technical features which are necessary to fulfill the function of the product in question - features which are irrespective of its function are deemed irrelevant,

- alternatives in design, in contrast to alternatives in products - the latter being irrelevant

- reasonability and viability of the alternative - an alternative requires other designs to create a *different* appearance, and this different appearance is not protected as a design, while patent protection is irrelevant.

Amongst others, the *Higher Regional Court of Düsseldorf* takes this approach in its ruling of 2007, when it states that only those technical features are excluded from design protection which are the only technical option.^[6] In 2011 and 2014, the Regional Court of Düsseldorf, confirmed this approach.^[7]

- „No-aesthetic-consideration-test“:

The no-aesthetic-consideration-test, according to which a product's configuration is solely dictated by its function if every feature of the design was determined by technical considerations only, has its origin in English case law.^[8]

In particular, the Third Board of Appeal at EUIPO follows this approach.^[9] They reason that by interpreting Art. 8 (1) CDR the way the multiplicity-of-forms-tests does, the very purpose of Art. 8 (1) CDR, not to hamper technical innovation by granting design protection for purely technical functions, will be in danger of being frustrated. If the multiplicity-of-forms-test was applied, one person could, for example, shut out competitors by registering alternative designs, possibly the only two technical solutions existing: Each of them would then free the other from being "solely dictated by the function" as an alternative solution was at hand.

Furthermore, the teleological interpretation of Art. 8 (1) CDR and of Sec. 3 (1) (1) GDA imply, taking their natural meaning, that the need to achieve the product's technical function was the only relevant factor when the feature in question was selected. Protection shall thus be denied if the feature in question has been dictated by the product's technical function and by no other consideration.^[10]

This is supported by the fact that there is a significant difference in wording in the provisions cited above referring to design, on the one hand, and the corresponding Articles of the Community Trademark Directive (Art. 3(1)(e)(ii)) and the Community Trademark Regulation (Art. 7 (1)(e)(ii)) on the other.

In addition, the supporters of the No-aesthetic-consideration-test argue that design law by its very nature implies the relevance of aesthetic considerations, even if an aesthetic quality is not required. If there had been an intention to protect purely functional design, it would not have been logical to exclude non-visible aspects of design from protection.^[11] Another argument in favor of the No-aesthetic-consideration-test is based on in the general consideration - as mentioned above - that patent law is

the means to provide a monopoly on technical inventions, but there is no justification to obtain such a monopoly by simply filing a design. If technical solutions have become free for all traders, a design right must not prolong this right. As long as an appearance is dictated solely by its technical function, the exemption is justified.^[2]

However, the disadvantage of the No-aesthetic-consideration-test is legal uncertainty. In practice, it is often unclear, whether or not a feature of a design was determined by functional considerations only.

Footnotes

1. <http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:31998L0071&from=EN>.
2. [Third Board of Appeal, decision of April 29, 2010, R 211/2008-3 – Fluid Distribution Equipment, para 26, https://euipo.europa.eu/copla/trademark/data/000232996-0008/download/CLW/APL/2010/EN/0211-2008-3](https://euipo.europa.eu/copla/trademark/data/000232996-0008/download/CLW/APL/2010/EN/0211-2008-3)
3. [At 5.4.6.2 and 11.5.1 of the Green Paper, http://ec.europa.eu/internal_market/indprop/docs/design/green-paper-design_en.pdf](http://ec.europa.eu/internal_market/indprop/docs/design/green-paper-design_en.pdf).
4. [Oliver Ruhl, Gemeinschaftsgeschmacksmuster, 2. Edition 2010, Art. 8 para 17 ff.](#)
5. [Oliver Ruhl, Gemeinschaftsgeschmacksmuster, 2. Edition 2010, Art. 8 para 23 ff.](#)
6. [OLG Düsseldorf, I-20 U 128/06, judgment of April 3, 2007 – Autofelgen, https://www.justiz.nrw.de/nrwe/olgs/duesseldorf/j2007/I_20_U_128_06urteil20070403.html](https://www.justiz.nrw.de/nrwe/olgs/duesseldorf/j2007/I_20_U_128_06urteil20070403.html) [https://www.justiz.nrw.de/nrwe/olgs/duesseldorf/j2007/I_20_U_128_06urteil20070403.html].
7. [LG Düsseldorf, 14c O 64/11, judgment of May 12, 2011 – iPad, https://www.justiz.nrw.de/nrwe/lgs/duesseldorf/lg_duesseldorf/j2011/14c_O_64_11urteil20110512.html](https://www.justiz.nrw.de/nrwe/lgs/duesseldorf/lg_duesseldorf/j2011/14c_O_64_11urteil20110512.html) [https://www.justiz.nrw.de/nrwe/lgs/duesseldorf/lg_duesseldorf/j2011/14c_O_64_11urteil20110512.html]; [LG Düsseldorf, 14 c O 37/13, judgment of June 26, 2014 – Dentalmischer, https://www.justiz.nrw.de/nrwe/lgs/duesseldorf/lg_duesseldorf/j2014/14c_O_37_13_Urteil_20140626.html](https://www.justiz.nrw.de/nrwe/lgs/duesseldorf/lg_duesseldorf/j2014/14c_O_37_13_Urteil_20140626.html) [https://www.justiz.nrw.de/nrwe/lgs/duesseldorf/lg_duesseldorf/j2014/14c_O_37_13_Urteil_20140626.html].
8. [See Third Board of Appeal, decision of April 29, 2010, R 211/2008-3 – Fluid Distribution Equipment, para 29, https://euipo.europa.eu/copla/trademark/data/000232996-0008/download/CLW/APL/2010/EN/0211-2008-3](https://euipo.europa.eu/copla/trademark/data/000232996-0008/download/CLW/APL/2010/EN/0211-2008-3).
9. [See case cited at footnote 14; Third Board of Appeal, decision of April 14, 2014, R 1772/2012-3, Game Cartridges, para 19 ff, https://euipo.europa.eu/eSearchCLW/#basic*////number/1772%2F2012-3](https://euipo.europa.eu/eSearchCLW/#basic*////number/1772%2F2012-3).
10. [See Third Board of Appeal, footnote 14, para 30.](#)
11. [See Third Board of Appeal, footnote 14, para 33.](#)
12. [Eichmann, Designgesetz, 5. Edition 2015, Sec. 3 para 8.](#)

5) If yes, what are the relevant factors to determine whether or not a design is deemed unprotectable as being functional? Please tick any relevant boxes and explain as applicable:

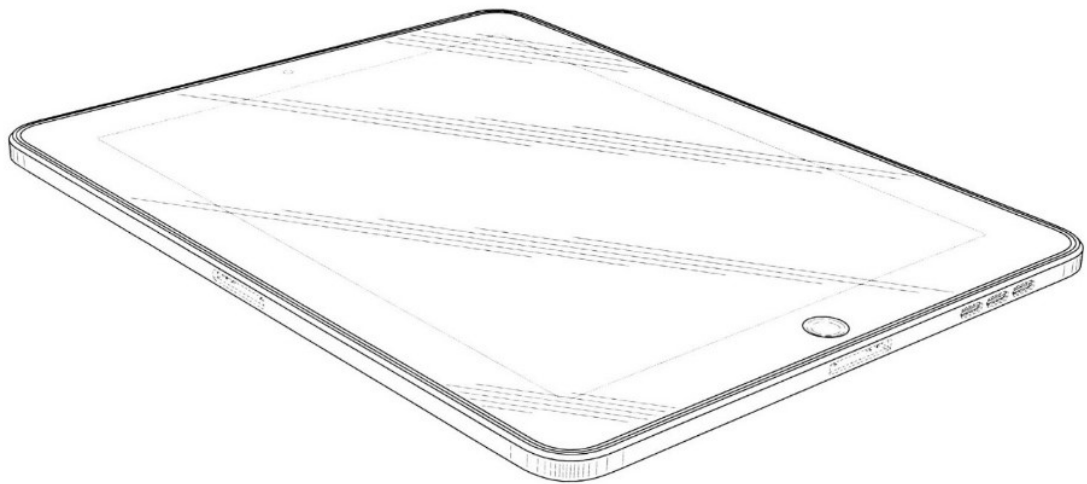
- a) whether the overall appearance is dictated solely by its technical function
- b) whether each portion of the overall appearance is dictated solely by its technical function
- c) the availability of alternative appearances that can obtain the same functional result
- d) the need to achieve the product's technical function was the only relevant factor when the design in question was selected

e) other, namely ...

If each and every portion of the overall appearance of the product is dictated solely by its technical function, the product will be excluded from design protection.

So far, the German courts follow the multiplicity-of-forms-test, as described above under 4. For instance, the Higher Regional Court of Düsseldorf (OLG Düsseldorf) took this approach in a ruling of 2007, when it stated that only those technical features are excluded from design protection, which are the only technical option^[1]. In 2011 and 2014, the Regional Court of Düsseldorf (LG Düsseldorf), confirmed this approach^{[2] [3]}.

In 2011 the LG Düsseldorf decided that the appearance of the Registered Community Design No. 001 222 905-0002:

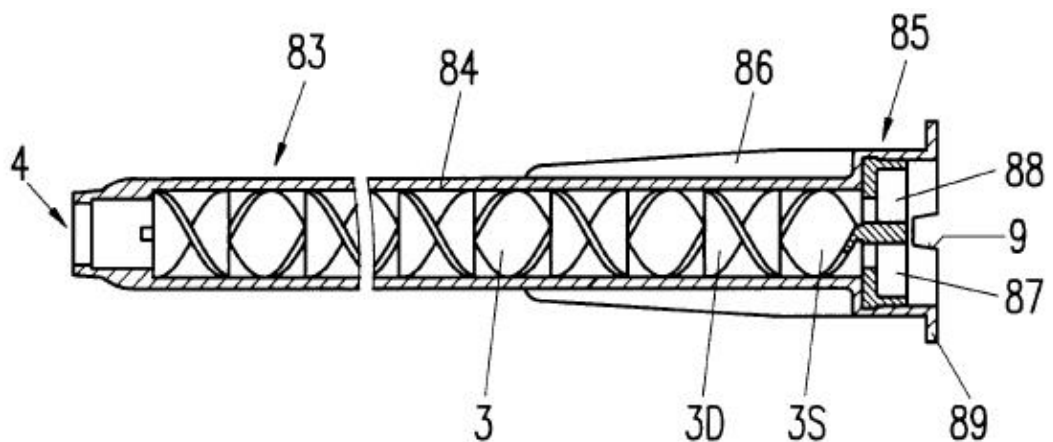


was not solely dictated by its technical function. The court held that Art. 8 (1) CDR is not applicable, if there are viable alternative shapes, which fulfill its technical function at least in the same manner. In the case at hand, alternative designs for every feature of the registered design under dispute could be taken from samples filed by the defendant, which all exhibit differing shapes of the casing, the arrangement of the edges and the display.

Similarly, in 2014 the LG Düsseldorf held that the essential features of the Registered Community Design No. 872007-0005,



were not solely dictated by their technical functions pursuant to Art. 8 (1) CDR, since there were viable alternative designs on the market or described in the patent literature, e.g. by EP 0723 807:



As opposed to the German civil courts, the Board of Appeal of EUIPO consistently follows the no-aesthetic-consideration test:

- Third Board of Appeal decision R 690/2007 “Chaff cutters” ^[4] (para 37):

“The fact that a particular feature of a product’s appearance is denied protection by Article 8(1) CDR does not mean that the whole design must be declared invalid, pursuant to Article 25(1)(b) CDR, on the ground that it does not ‘fulfil [one of] the requirements of Articles 4 to 9’. The last sentence of the 10th recital in the preamble to the Regulation makes it clear that the design as a whole may be valid even though certain features of the design are denied protection. 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.”

The contested RCD had five essential features (para 22):



1. The rotor is in the form of a cylinder having grooves in planes perpendicular to the rotation axis of

- the cylinder, the grooves having essentially the same width as the elevations between the grooves;
2. Knives are arranged along two parallel lines;
 3. The two parallel lines are V-shaped;
 4. The knives along one of the parallel lines are arranged within the grooves;
 5. The knives along the other parallel line are arranged on the elevations.

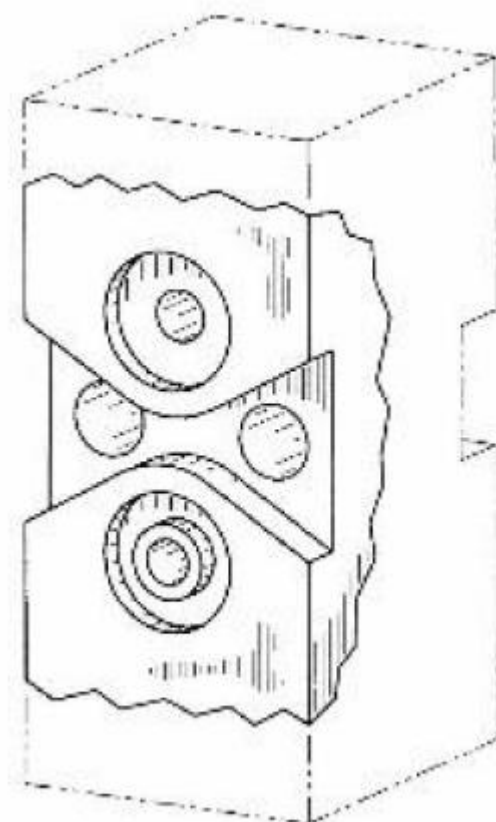
All five of these ‘characteristic features’ have a purely technical function. The V-shaped knives (feature 3) ensure that the material introduced into the shredder is guided into the middle of the rotor. They also ensure that the material is shredded successively, and not at the same time. This means that the shredder operates more quietly and thus complies more easily with government regulations, which protect workers against excessive noise. Based on detailed, coherent and convincing explanations of the technical function of each of the five features, each feature had been selected in such a way as to improve the shredding process. Even the respondent’s own statements show that the design was chosen purely for technical reasons.

In para 30 the Board of Appeal held:

“There is nonetheless a major flaw in the multiplicity-of-forms theory. If it is accepted that a feature of a product’s appearance is not ‘solely dictated by its function’ simply because an alternative product configuration could achieve the same function, Article 8(1) CDR will apply only in highly exceptional circumstances and its very purpose will be in danger of being frustrated.”

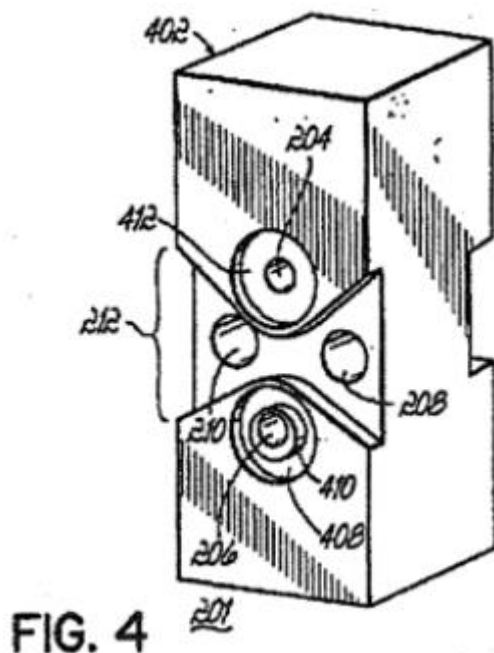
- Third Board of Appeal decision, R 211/2008 “Fluid Distribution Equipment”^[5]:

The Board held that the contested Registered Community Design No 232 996-0008 was invalid under Art. 8 (1) CDR. The contested design covered the following fluid distribution equipment:



In order to determine whether all the essential features of the appearance of the product into which the contested RCD will be incorporated were solely dictated by the technical function of the product, it is first necessary to determine what the technical function of that product is.

The design owner had also filed a European patent application (EP 1 568 418 A2) relating to liquid dispensing systems. Based on several figures, including the following Fig. 4, the patent applicant explained in the description the technical functions of the different elements of such a liquid dispensing system.

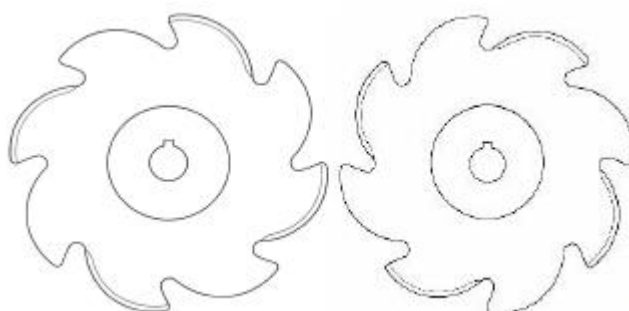


Based on the explanations in the description of the patent application, the Board (para 41) came to the following conclusion:

“It is abundantly clear from the above extracts that the only consideration that can possibly have gone through the mind of the designer of the module shown in paragraph 1 was the need to design a product that would perform a technical function. Every detail of the design has been chosen with a view to enhancing the technical performance of the ‘intake portion of a liquid dispensing valve’. All the essential features of the design have been chosen solely with technical considerations in mind. For proof of that, it is only necessary to read the above extracts from the patent application concerning screw holes 208 and 210, port 204 to an air passageway and port 206 to a liquid passageway, the surrounding indentations 214 and 216, and the curved portions 240 and 242.”

- Third Board of Appeal decision of 10.06.2013, R 2466/2011-3 “Chaff Cutting Blade” ^[6]:

The Board declared the Registered Community Design No. 820618-0002 invalid under Art. 8 (1) CDR. The RCD covered chaff cutting blades:



Upon comparing the essential features of the RCD with the description of the RCD owner’s European patent application EP 2 186 589 A2^[7] including Fig. 2,

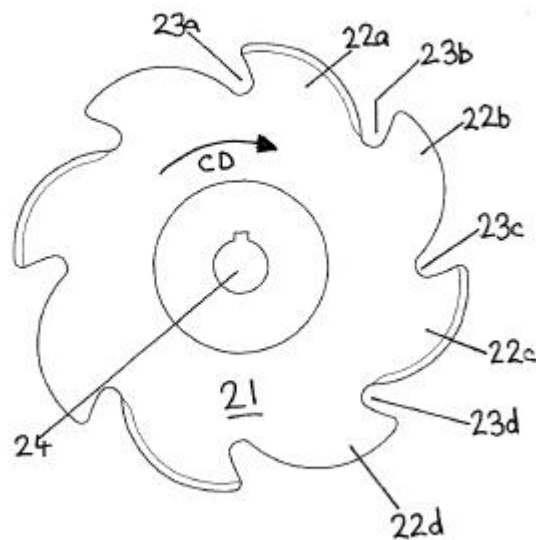


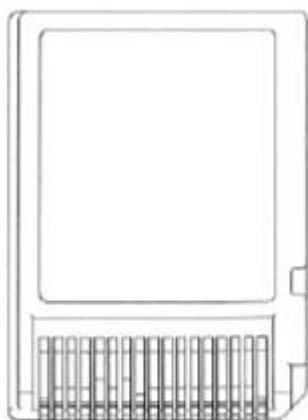
FIGURE 2

the Board concluded (para 24):

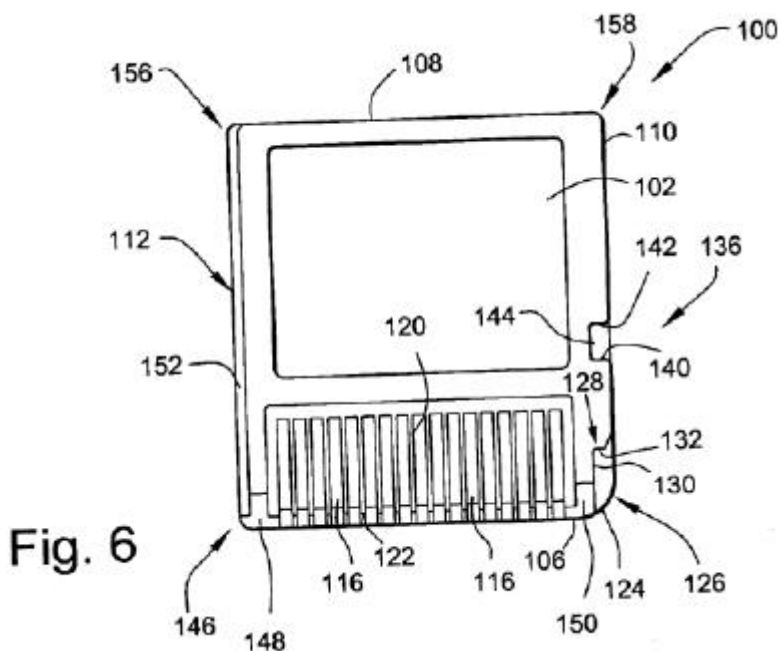
“The Board also notes that in the RCD proprietor’s European Patent Application No EP 2 186 589 A2, the contested design is shown and it is stated that ‘The blade comprises 8 elliptically shaped teeth ... each having an associated undercut ... It will be noted the curve of the each tooth turns smoothly to provide the undercut for the adjacent tooth. Alternate teeth ... are ground on a first face of the blade ... and intermediate blades... are ground on the opposing face.’ The fact that all of these features are specifically mentioned in a patent application is evidence that even the RCD proprietor itself considers these features to be of a technical character. Also in US Patent 3,730,038 which consists of a somewhat similarly shaped blade, all the essential features of the blade are considered to be features of a technical character.”

- Third Board of Appeal decision R 1772/2012-3 “Game Cartridges” [\[8\]](#):

The Board declared the Registered Community Design No. 235247-0006 invalid under Art. 8 (1) CDR. The RCD covered game cartridges for electronic games stations:



The Board confirmed that the multiplicity-of-forms-test is not the correct interpretation of Art. 8 (1) CDR. Upon comparing the essential features of the RCD with the description of the RCD owner's (appellant) US patent application US 2005/0245313^[9] including Fig. 6,



the Board concluded (paras 35/36):

“Taking all of the above into account, in the opinion of the Board it is difficult to see anything in the contested RCD that could have been influenced by anything other than designing a product that performs its function in the best possible manner. All the essential features of the RCD have been chosen with a view to designing a product that performs its function. None of those features has been chosen for the purpose of enhancing the product’s visual appearance.”

- Guidelines for the Examination of Design Invalidation Applications^[10]:

The recently published Guidelines summarize in Chapter 5.3 the above case law of the Third Board of Appeal regarding the invalidation based on Art. 8 (1) CDR. The following outlines the way to examine the question whether a RCD is invalid under Art. 8 (1) CDR:

"In order to determine whether the essential features of the appearance of the product into which the contested CD will be incorporated are solely dictated by the technical function of the product, it is first necessary to determine what the technical function of that product is. The relevant indication in the application for registration of the design (Article 36(2) CDR) should be taken into account, but also the design itself, insofar as it makes clear the nature of the product, its intended purpose or its function.

Whether Article 8(1) CDR applies must be assessed objectively, not in the perception of the informed user who may have limited knowledge of technical matters.

The technical functionality of the features of a design may be assessed, inter alia, by taking account of the documents relating to patents describing the functional elements of the shape concerned.

Depending on the case, and in particular in view of its degree of difficulty, the Invalidity Division may appoint an expert (Article 65(3) CDR and Article 44 CDIR)."

Footnotes

1. [OLG Düsseldorf, I-20 U 128/06, judgment of April 3, 2007 - Autofelgen](https://www.justiz.nrw.de/nrwe/olgs/duesseldorf/j2007/I_20_U_128_06urteil20070403.html), https://www.justiz.nrw.de/nrwe/olgs/duesseldorf/j2007/I_20_U_128_06urteil20070403.html [https://www.justiz.nrw.de/nrwe/olgs/duesseldorf/j2007/I_20_U_128_06urteil20070403.html].
2. [LG Düsseldorf, 14c O 64/11, judgment of May 12, 2011 - iPad](https://www.justiz.nrw.de/nrwe/lgs/duesseldorf/lg_duesseldorf/j2011/14c_O_64_11urteil20110512.html), https://www.justiz.nrw.de/nrwe/lgs/duesseldorf/lg_duesseldorf/j2011/14c_O_64_11urteil20110512.html [https://www.justiz.nrw.de/nrwe/lgs/duesseldorf/lg_duesseldorf/j2011/14c_O_64_11urteil20110512.html].
3. [LG Düsseldorf, 14 c O 37/13, judgment of June 26, 2014 -Dentalmischer](https://www.justiz.nrw.de/nrwe/lgs/duesseldorf/lg_duesseldorf/j2014/14c_O_37_13_Urteil_20140626.html), https://www.justiz.nrw.de/nrwe/lgs/duesseldorf/lg_duesseldorf/j2014/14c_O_37_13_Urteil_20140626.html [https://www.justiz.nrw.de/nrwe/lgs/duesseldorf/lg_duesseldorf/j2014/14c_O_37_13_Urteil_20140626.html].
4. [Third Board of Appeal of 22.10.2009, R 690/2007 - Chaff cutters](https://euipo.europa.eu/eSearchCLW/#basic*////number/690%2F2007) https://euipo.europa.eu/eSearchCLW/#basic*////number/690%2F2007
5. [Third Board of Appeal of 29.04.2010, R 211/2008 - Fluid Distribution Equipment](https://euipo.europa.eu/copla/trademark/data/000232996-0008/download/CLW/APL/2010/EN/0211-2008-3), <https://euipo.europa.eu/copla/trademark/data/000232996-0008/download/CLW/APL/2010/EN/0211-2008-3>.
6. [Third Board of Appeal decision of 10.06.2013, R 2466/2011-3 - Chaff Cutting Blade](https://euipo.europa.eu/copla/trademark/data/000820618-0002/download/CLW/APL/2013/EN/2466-2011-3), <https://euipo.europa.eu/copla/trademark/data/000820618-0002/download/CLW/APL/2013/EN/2466-2011-3>
7. [EP 2 186 589 A2](http://worldwide.espacenet.com/publicationDetails/biblio?DB=worldwide.espacenet.com&II=0&ND=3&adjacent=true&locale=de_EP&FT=D&date=20100519&CC=EP&NR=2186589A2&KC=A2), http://worldwide.espacenet.com/publicationDetails/biblio?DB=worldwide.espacenet.com&II=0&ND=3&adjacent=true&locale=de_EP&FT=D&date=20100519&CC=EP&NR=2186589A2&KC=A2.
8. [Third Board of Appeal of 14.04.2014, R 1772/2012-3 - Game Cartridges](https://euipo.europa.eu/copla/trademark/data/000235247-0006/download/CLW/APL/2014/EN/1772-2012-3), <https://euipo.europa.eu/copla/trademark/data/000235247-0006/download/CLW/APL/2014/EN/1772-2012-3>
9. [US 2005/0245313](http://worldwide.espacenet.com/publicationDetails/biblio?CC=US&NR=2005245313A1&KC=A1&FT=D&ND=3&date=20051103&DB=worldwide.espacenet.com&locale=de_EP), http://worldwide.espacenet.com/publicationDetails/biblio?CC=US&NR=2005245313A1&KC=A1&FT=D&ND=3&date=20051103&DB=worldwide.espacenet.com&locale=de_EP.
10. https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/designs_practice_manual/WP_LR_2016/examination_of_design_invalidity_applications_en.pdf

6) Does your Group's current law deny design protection to any portions (e.g. a "feature", "element") of

the overall design that are deemed functional?

yes

Please explain:

Yes, a feature or a portion of an overall design which is dictated solely by its technical function will be excluded from design protection. This is clearly emphasized in the last sentence of Recital 10 of the CDR and the last sentence of Recital 14 of Directive 98/71/EC: ¹

“(14) ... whereas features of a design which are excluded from protection for these reasons should not be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection;”

Footnotes

1. [^] Directive 98/71/EC, see footnote 2.

7) If yes, what are the relevant factors to determine whether or not a portion is deemed functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

b) the availability of alternative appearances for the portion to obtain the same functional result

c) the need to achieve the product's technical function was the only relevant factor when the portion in question was selected

d) other, namely ...

As stated above in Answer 6, features or portions of a design which are solely dictated by a technical function should not be taken into consideration when assessing the scope of protection of the overall design which means that they shall be ignored. In order to assess whether or not a portion is deemed to be solely functional, the two factors mentioned above in Answer 7 b and 7 c are discussed controversially. Whilst German courts consistently apply the “multiplicity-of-forms-test” (Answer 7 b), EUIPO’s Third Board of Appeal uses the “no-aesthetic-consideration-test” (Answer 7 c) since 2009. For details please refer to Answers 4 and 5 above.

8) What is the effect on the scope of protection of a design with one or more functional portions? Please tick any relevant boxes and explain as applicable:

a) any portions deemed functional will not be taken into account when assessing infringement

b) any portions deemed functional will not be taken into account when assessing validity

c) any portions deemed functional will not be taken into account separately when assessing infringement, but can play a role in the overall comparison

d) any portions deemed functional will not be taken into account separately when assessing validity, but

	may play a role in the overall comparison
e)	no effect (e.g. so long as the overall appearance is not dictated solely by its technical function, all portions of the design are included in the scope of protection, irrespective as to whether any portions may be functional)
f)	the Group's current law is unsettled
g)	other, namely ...

The effect on the scope of protection of a design with one or more functional portions has not been clarified yet in German and European case law.

In this regard, a distinction can be made between (i) features that are solely dictated by its technical function and (ii) features only having a certain technical effect.

• **Features being solely dictated by function**

As stated above, a *solely* functional portion of a design shall not be taken into consideration when assessing the scope of protection.^[1] Thus, as a matter of law, these features must be disregarded when assessing *validity* and *infringement* of a design.

When it comes to *validity*, it must therefore be assumed that those technical features do not exist when assessing the novelty and the individual character of a design.^[2] The same applies with regard to *infringement*: When assessing whether one design produces on the informed user the same overall appearance as another design, features which are solely functional must be disregarded as a matter of law.^[3]

• **Features having a certain technical effect**

Features that are not solely dictated by functions but still have a certain technical effect are not excluded by law from protection but may nevertheless influence the scope of protection of a design. Thus, they may have an impact on the relevant criteria when assessing the validity and/or infringement of a design, e.g. on the designer's degree of freedom in developing its design, on the informed user as well as on the overall impression.

The designer's degree of freedom in developing its design is established, inter alia, by the constraints of the features imposed by the technical function of the product.^[4] The more the designer's freedom in developing designs is restricted, the more likely minor differences between the designs at issue will be sufficient to produce a different overall impression on the informed user.^[5]

Further, technical features might play a role when assessing the attention of the informed user. For example, it is acknowledged that the informed user focuses his attention on the features not necessarily implied by the function of the design.^[6] On the other hand and according to European case law, the informed user is neither a designer nor a technical expert and therefore does not necessarily know which aspects of that product are dictated by technical function.^[7]

Finally, the technical effect of a feature might have an impact when assessing the overall impression and when balancing the role of every single feature against each other. Features having a technical effect have a less important role than others.^[8]

For example, the European General Court stated in its "PepsiCo/Grupo Promer"-decision that *similarities* between the designs at issue related to common technical features have only minor importance on the overall impression produced by those designs on the informed user.^[9] The German

Federal Supreme Court acknowledged this European case law in its “Kinderwagen II”-decision¹⁰¹, but found that this principle shall not mean that *differences* in features having a certain technical function likewise have only minor importance on the overall impression. The German Federal Supreme Court has so far not substantiated this view. The group is not in favor of this view (please refer to question III 19).

Footnotes

1. ¹⁰¹ [Recital 10 CDR and Recital 14 of the Directive 98/71/EC.](#)
2. ¹⁰² [Oliver Ruhl, Gemeinschaftsgeschmacksmuster, 2. Edition 2010, Art. 8 para 72; Eichmann Designgesetz, 5. Edition 2015, Sec. 3, para 2; OLG Düsseldorf, I-20 U 128/06, judgment of April 3, 2007 – Autofelgen, \[https://www.justiz.nrw.de/nrwe/olgs/duesseldorf/j2007/I_20_U_128_06urteil20070403.html\]\(https://www.justiz.nrw.de/nrwe/olgs/duesseldorf/j2007/I_20_U_128_06urteil20070403.html\) \[\[https://www.justiz.nrw.de/nrwe/olgs/duesseldorf/j2007/I_20_U_128_06urteil20070403.html\]\(https://www.justiz.nrw.de/nrwe/olgs/duesseldorf/j2007/I_20_U_128_06urteil20070403.html\)\]; LG München I, judgment of June 21, 2006, 21 O 14565/05 – BMW- Welt; EUIPO’s Invalidation Guidelines Sec. 5.5.2.1, page 35, \[https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/designs_practice_manual/WP_LR_2016/examination_of_applications_for_registered_community_designs_en.pdf\]\(https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/designs_practice_manual/WP_LR_2016/examination_of_applications_for_registered_community_designs_en.pdf\) \[\[https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/designs_practice_manual/WP_LR_2016/examination_of_applications_for_registered_community_designs_en.pdf\]\(https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/designs_practice_manual/WP_LR_2016/examination_of_applications_for_registered_community_designs_en.pdf\)\]](#)
3. ¹⁰³ [Oliver Ruhl, Gemeinschaftsgeschmacksmuster, 2. Edition 2010, Art. 8 para 74; Eichmann Designgesetz, 5. Edition 2015, Sec. 3 para 2.](#)
4. ¹⁰⁴ [EUIPO’s Invalidation Guidelines Sec. 5.5.2.3, page 44, \[https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/designs_practice_manual/WP_LR_2016/examination_of_applications_for_registered_community_designs_en.pdf\]\(https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/designs_practice_manual/WP_LR_2016/examination_of_applications_for_registered_community_designs_en.pdf\) \[\[https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/designs_practice_manual/WP_LR_2016/examination_of_applications_for_registered_community_designs_en.pdf\]\(https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/designs_practice_manual/WP_LR_2016/examination_of_applications_for_registered_community_designs_en.pdf\)\]; judgment of General Court of 28 January 2015, T-41/14 – Argo Development and Manufacturing Ltd / HABM \(Clapbanner Ltd\), <http://curia.europa.eu/juris/document/document.jsf?text=&docid=161844&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=113085> \[<http://curia.europa.eu/juris/document/document.jsf?text=&docid=161844&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=113085>\].](#)
5. ¹⁰⁵ [Judgment of General Court of 28 January 2015, T-41/14 – Argo Development and Manufacturing Ltd / HABM \(Clapbanner Ltd\), <http://curia.europa.eu/juris/document/document.jsf?text=&docid=161844&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=113085> \[<http://curia.europa.eu/juris/document/document.jsf?text=&docid=161844&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=113085>\]; judgment of General Court of 9 September 2011, T-11/08 – Kwang Yang Motor co. Ltd / Honda Giken Kogyo Kabushiki Kaisha, para. 33, <http://curia.europa.eu/juris/document/document.jsf;jsessionid=9ea7d2dc30d5ca40d8ac9e6a4fd084fbd52da32a12f2.e34KaxiLc3qMb40Rch0SaxuSc3b0?text=&docid=109294&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=242099> \[<http://curia.europa.eu/juris/document/document.jsf;jsessionid=9ea7d2dc30d5ca40d8ac9e6a4fd084fbd52da32a12f2.e34KaxiLc3qMb40Rch0SaxuSc3b0?text=&docid=109294&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=242099>\]](#)
6. ¹⁰⁶ [Oliver Ruhl, Gemeinschaftsgeschmacksmuster, 2. Edition 2010, Art. 6 para 106; EUIPO’s Invalidity Division, decision of 14 June 2004, ICD 000000057, RCD 000022454-0002, \[https://euipo.europa.eu/eSearchCLW/#basic*/14%2F06%2F2004/14%2F06%2F2004/number/\]\(https://euipo.europa.eu/eSearchCLW/#basic*/14%2F06%2F2004/14%2F06%2F2004/number/\) \[\[https://euipo.europa.eu/eSearchCLW/#basic*/14%2F06%2F2004/14%2F06%2F2004/number/\]\(https://euipo.europa.eu/eSearchCLW/#basic*/14%2F06%2F2004/14%2F06%2F2004/number/\)\]](#)
7. ¹⁰⁷ [EUIPO’s Invalidation Guidelines Sec. 5.5.2.3, page 39, \[https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/designs_practice_manual\]\(https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/designs_practice_manual\)](#)

- al/WP_LR_2016/examination_of_applications_for_registered_community_designs_en.pdf[\[https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/designs_practice_manual/WP_LR_2016/examination_of_applications_for_registered_community_designs_en.pdf\]](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/designs_practice_manual/WP_LR_2016/examination_of_applications_for_registered_community_designs_en.pdf) ; judgment of General Court of 22 June 2010, T-153/08 - Communication equipment. para. 48, <http://curia.europa.eu/juris/document/document.jsf?text=&docid=81091&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=242099>[\[http://curia.europa.eu/juris/document/document.jsf?text=&docid=81091&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=242099\]](http://curia.europa.eu/juris/document/document.jsf?text=&docid=81091&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=242099) ; Judgment of General Court of 9 September 2011, T-11/08 - Kwang Yang Motor co. Ltd / Honda Giken Kogyo Kabushiki Kaisha, para. 26, <http://curia.europa.eu/juris/document/document.jsf;jsessionid=9ea7d2dc30d5ca40d8ac9e6a4fd084fbd52da32a12f2.e34KaxiLc3qMb40Rch0SaxuSc3b0?text=&docid=109294&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=242099>[\[http://curia.europa.eu/juris/document/document.jsf;jsessionid=9ea7d2dc30d5ca40d8ac9e6a4fd084fbd52da32a12f2.e34KaxiLc3qMb40Rch0SaxuSc3b0?text=&docid=109294&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=242099\]](http://curia.europa.eu/juris/document/document.jsf;jsessionid=9ea7d2dc30d5ca40d8ac9e6a4fd084fbd52da32a12f2.e34KaxiLc3qMb40Rch0SaxuSc3b0?text=&docid=109294&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=242099)
8. [^](#) Oliver Ruhl, *Gemeinschaftsgeschmacksmuster*, 2. Edition 2010, Art. 6 para 106;
9. [^](#) Judgment of General Court of 18 March 2010, T-9/07, Grupo Promer/PepsiCo, para 72, <http://curia.europa.eu/juris/document/document.jsf;jsessionid=9ea7d2dc30d5a37b0ba7c68a41df84b3df4dc4bb8355.e34KaxiLc3qMb40Rch0SaxuSc3b0?text=&docid=82997&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=245075>[\[http://curia.europa.eu/juris/document/document.jsf;jsessionid=9ea7d2dc30d5a37b0ba7c68a41df84b3df4dc4bb8355.e34KaxiLc3qMb40Rch0SaxuSc3b0?text=&docid=82997&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=245075\]](http://curia.europa.eu/juris/document/document.jsf;jsessionid=9ea7d2dc30d5a37b0ba7c68a41df84b3df4dc4bb8355.e34KaxiLc3qMb40Rch0SaxuSc3b0?text=&docid=82997&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=245075)
10. [^](#) Federal Supreme Court, Judgment of 12 July 2012, I ZR 102/11 – Kinderwagen II, <http://juris.bundesgerichtshof.de/cgi-bin/rechtsprechung/document.py?Gericht=bgh&Art=en&nr=63006&pos=0&anz=1>[\[http://juris.bundesgerichtshof.de/cgi-bin/rechtsprechung/document.py?Gericht=bgh&Art=en&nr=63006&pos=0&anz=1\]](http://juris.bundesgerichtshof.de/cgi-bin/rechtsprechung/document.py?Gericht=bgh&Art=en&nr=63006&pos=0&anz=1)

II. Policy considerations and possible improvements to your current law

9) How can the following aspects of your Group's current law be improved, if at all?

a) the definition or meaning of a "design"

The GDA as well as the CDR both have legal definitions of a design. These definitions differ slightly from each other. For the sake of clarification and unity, two-dimensional designs should be explicitly mentioned in Art. 3 CDR.

b) the requirements for protection of a design

The requirements for protection of a design under German and European law could be improved regarding the unity of designs and in particular the unity of representations. A clear definition that a design registration can protect only one design and of how the question of unity of a design shall be evaluated would be an improvement. At the moment, design application before the GPTO and the EUIPO can be filed using a mixture of photographs in color and line drawings in black and white. While one would protect only the appearance of a product in a specific color the other would protect the shape as such. Thus, these applications lack unity but would not be rejected by any of the Offices as both recommend in their publications that it may be useful to combine photographs and line drawings^[1].

Footnotes

1. [GPTO Information Sheet: „Information for Design Applicants“ R 5704.1, 7/15, P. 6, 3. \(2\)](#)

- c) the treatment of functionality in the sense described in paragraph 14) of the Study Guidelines or aspects of such functionality

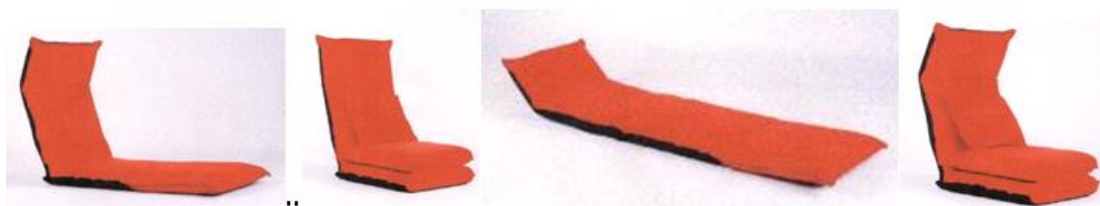
Improvement is necessary regarding the parameters for the exclusion of functional features both under German and under European law. A definition how functional features should be treated when determining validity and scope of protection would improve the current law. The current legal definition leaves a wide scope as to how functional features should be treated, resulting in the risk of differing case law of the German civil courts and the European courts.

- 10) Are there any other policy considerations and/or proposals for improvement to your current law falling within the scope of this Study Question?

yes

Please explain:

As laid down above in Answer 1, transformable designs are registrable. They must not, however, protect technical functions. The technical function of a transformable design must be *ignored* when assessing validity and scope of protection. The focus is on the protection of the visual appearance. In practice, this is often not observed. For instance, the *technical features* of Community design EU 000809470-0001, showing a piece of furniture which can be transformed into a mat or a lounge chair



shall not be considered when assessing whether another transformable piece of furniture infringes the RCD.

III. Proposals for harmonisation

- 11) Does your Group consider that harmonisation in the three areas in question 9) above is desirable?

If yes to some but not all of those three areas, please state in relation to which of the areas your Group considers harmonisation is desirable.

If yes in relation to any of those areas, please respond to the following questions without regard to your Group's current law.

Even if no in relation to any of those areas, please address the following questions to the extent your Group considers your Group's current law could be improved.

yes

Please explain:

a) and b) Harmonisation would be helpful for applicants wishing to protect their design in different jurisdictions. The definition and meaning of design differs in many countries making it difficult to achieve protection for the same subject matter in different countries. Some countries accept the

protection of two dimensional design while in other countries only copyright protection is available for such designs. In some countries two dimensional designs such as labels can be protected if they are filed showing the exact position on the product they are placed on.

c) To the same extent that the definition of design differs, the parameters for the exclusion of parts of a product or the whole product with technical features differ from country to country. Precise parameters that are harmonized in as many countries as possible would be an improvement for both design owners and the general public.

12) Should there be harmonisation of the definition of an intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture?

yes

Please explain:

Yes, a harmonization regarding the definition if a design includes two dimensional appearances, alternate positions, graphical user interfaces (with motion elements) and transformable design is desirable.

13) If so, what should that right be called?

registered design

14) What should the requirements for such right be? Please tick any relevant boxes and explain the basis and application of these requirements:

a) novelty

A registered design must be new on the date of filing the application, i.e. no identical design or near identical design must have been published before the date of filing (Sec. 2 (1) and (2) GDA; Art. 5 CDR). For the determination of novelty all designs having been disclosed and having potentially been known to the designer (relative novelty) should be considered. A grace period for disclosures by the designer or his successor should apply.

b) non-obviousness

c) inventive step

d) individual character

A registered design must have individual character (Sec. 2 (3) GDA; Art. 6 CDR). The question of individual character should be determined by assessing the overall impression of the design in contrast to prior art. Constraints on the creative freedom of the designer should be taken into consideration if they are dictated by the need to fulfill a certain function.

e) originality

f) aesthetic

g) ornamental

h) other, namely ...

15) Should design protection be denied to a design with an appearance that is dictated solely by its function?

yes

Please explain:

16) If yes, what should the relevant factors be to determine whether or not a design is deemed unprotectable as being functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

b) whether each portion of the overall appearance is dictated solely by its technical function

c) the availability of alternative appearances that can obtain the same functional result

d) the need to achieve the product's technical function was the only relevant factor when the design in question was selected

e) other, namely ...

The multiplicity-of-forms-test is clear and objective. However, the German Group sees a disadvantage of the multiplicity-of-forms-test in the fact that it applies in too few cases, given that there might always be an alternative product configuration. The no-aesthetic-consideration-test broadens the scope of application but leads to legal uncertainty as to the issue whether or not a feature is solely dictated by its technical function. Further, it is not convincing that representations of the product in patent documentations serve as a major argument for the affirmation of features being solely dictated by function under Art. 8 (1) CDR and Sec. 3 (1) (1) GDA. The criteria to be developed for assessing whether or not a feature is solely dictated by function have to be objective and must be based on verifiable facts. Intentions or considerations of the designer regarding the function of a feature are not to be considered in this context. According to the German group, would be desirable to get an answer from the ECJ on the open question what constitutes solely technical function under Art. 8 (1) CDR, as soon as possible.

17) Should design protection be denied to any portions (e.g. a "feature", "element") of the overall design that are deemed functional?

yes

Please explain:

Yes, if the portions are solely dictated by their technical function.

18) If yes, what should the relevant factors be to determine whether a portion of a design is functional? Please tick any relevant boxes and explain as applicable:

- a) whether the overall appearance is dictated solely by its technical function
- b) the availability of alternative appearances for the portion to obtain the same functional result
- c) the need to achieve the product's technical function was the only relevant factor when the portion in question was selected
- d) other, namely ...

Reference is made to Answer 16 above and to Answer 7 above.

- 19) What should the effect be on the scope of protection of a design with one or more functional portions? Please tick any relevant boxes and explain as applicable:

- a) any portions deemed functional will not be taken into account when assessing infringement
- b) any portions deemed functional will not be taken into account when assessing validity
- c) any portions deemed functional will not be taken into account separately when assessing infringement, but can play a role in the overall comparison
- d) any portions deemed functional will not be taken into account separately when assessing validity, but may play a role in the overall comparison
- e) no effect (e.g. so long as the overall appearance is not dictated solely by its technical function, all portions of the design are included in the scope of protection, irrespective as to whether any portions may be functional)
- f) the Group's current law is unsettled
- g) other, namely ...

Features solely dictated by technical function on the one hand and other technical features on the other hand should be distinguished. As a matter of law, the courts must ignore features solely dictated by technical function. However, features having a certain technical effect, which are not solely dictated by the technical function, must be taken into account in assessing overall impression of a design. Thus, in principle, the informed user will give technical elements less weight. Similarities between the designs at issue related to common technical features have only minor importance on the overall impression produced on the informed user. Likewise, differences in technical features should have less weight on the overall impression. It is not convincing to assume that the informed user changes its opinion depending on whether a feature is a common or different technical feature of the design. Moreover, the infringer who simply copies the technical feature of the design would be privileged (given that similarities weigh less in assessing the overall impression).

- 20) If your answer to question 11) is no, is it your Group's view that a (registered or patented) intellectual property right that specifically protects the outward appearance or ornamentation of an object or

article of manufacture should not be available at all?

no

21) If yes, why?

22) If your answer to question 11) is no in relation to some but not all of the three areas set out in question 9) above, please state why your Group does not consider that harmonisation in that area(s) is desirable.

23) Please comment on any additional issues concerning any aspect of the definition and requirements for protection of designs, or the role of functionality, you consider relevant to this Study Question.

The harmonization of the definition of a design would also be desirable with respect to the question of priority. Filing a priority application and using the priority for foreign filing is often not possible as not only the requirements regarding representations but also the subject matter that can be protected differ.

Also the question of unity could be an interesting topic for another study question. A design application should protect only one appearance of a product. By using different types of representations, it might be possible to get protection for more than one appearance of a product by one design registration.

Please indicate which industry sector views are included in part “**III. Proposals for harmonization**” of this form:

Automotive

Summary

Summary Study Questions (Design), Requirements for protection of designs

The purpose of Art. 8 (1) CDR and Sec. 3 (1) (1) GDA is to avoid obtaining monopolies over technical solutions without meeting the strict conditions laid down in patent law. Art. 8 (1) CDR and Sec. 3 (1) (1) GDA should be narrowly construed.

It is controversial whether to follow the multiplicity-of-forms-test (German Courts) or the no-aestheti-consideration-test (Board of Appeal of EUIPO). In principle, the multiplicity-of-forms-test is clear and objective. However, a disadvantage of the multiplicity-of-forms-test is that it applies in too few cases, given that there might be nearly always an alternative product configuration. The no-aestheti-consideration-test leads to legal uncertainty as to the issue whether or not a feature is solely dictated by its technical function. Further, it is not convincing that representations of the product in patent documentations serve as a major argument for the affirmation of solely technical function under Art. 8 (1) CDR and Sec. 3 (1) (1) GDA. Whether Article 8(1) CDR and Sec. 3 (1) (1) GDA apply should be assessed objectively.

As a matter of law, features solely dictated by technical function must be ignored in assessing the overall impression. For instance, it must be assumed that those technical features do not exist when assessing novelty and individual character of a design. As opposed to features solely dictated by the technical function, features being technical must be taken into account in assessing the overall impression. However, the informed user will give these technical features less weight. Both, similar technical features as well as different technical features should have only minor importance on the overall impression produced on the informed user.