

**Case C-684/21**

**Request for a preliminary ruling**

**Date lodged:**

12 November 2021

**Referring court:**

Oberlandesgericht Düsseldorf (Germany)

**Date of the decision to refer:**

4 November 2021

**Defendant, applicant in the counterclaim and appellant:**

Papierfabriek Doetinchem B.V.

**Applicant, defendant in the counterclaim and respondent:**

Sprick GmbH Bielefelder Papier- und Wellpappenwerk & Co.

[...]  
[...]

Order made on 4 November 2021

**OBERLANDESGERICHT DÜSSELDORF (HIGHER REGIONAL COURT,  
DÜSSELDORF, GERMANY)**

**ORDER**

In the case of

Papierfabriek Doetinchem B.V., [...] Doetinchem, Netherlands,

defendant, applicant in the counterclaim and  
appellant,

[...]

v

Sprick GmbH Bielefelder Papier- und Wellpappenwerk & Co., [...] Bielefeld,  
Germany,

applicant, defendant in the counterclaim and  
respondent,

[...]

further to the hearing on 29 June 2021, the 20th Civil Chamber of the Oberlandesgericht Düsseldorf [...] has made the following

o r d e r:

I.

The proceedings are stayed.

II.

The Oberlandesgericht Düsseldorf refers the following questions concerning the interpretation of Articles 8(1) and 10 of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs to the Court of Justice of the European Union ('the Court of Justice') for a preliminary ruling:

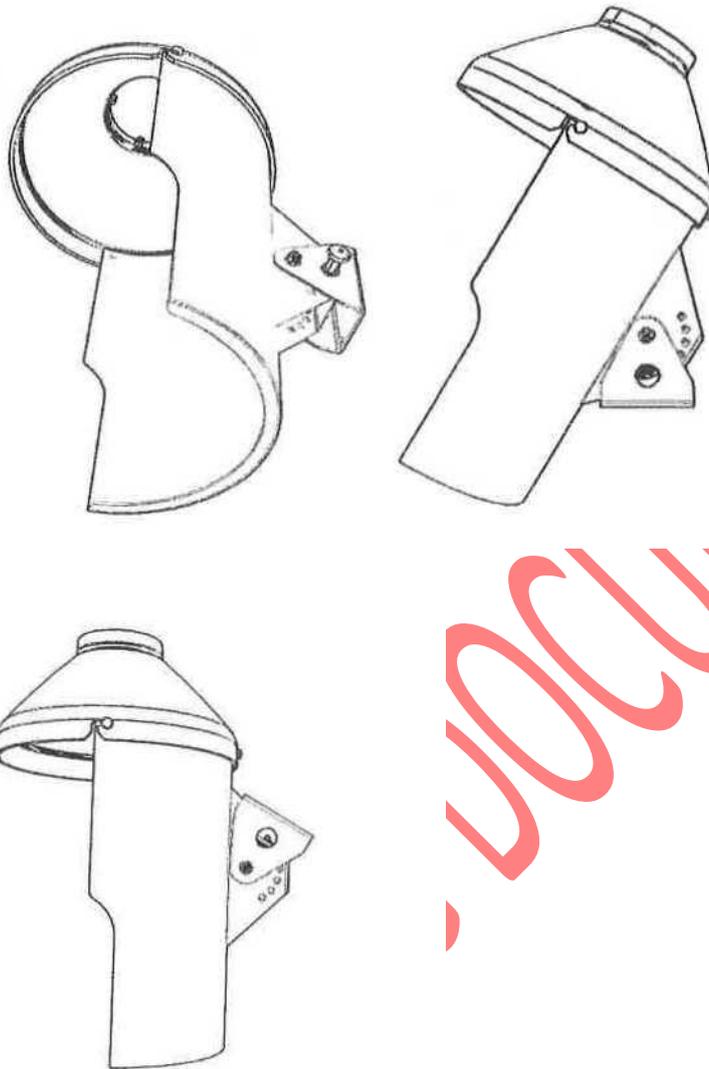
1. According to the case-law of the Court of Justice, the assessment as to whether the features of appearance of a product are dictated exclusively by its technical function must be made having regard to the design at issue, the objective circumstances indicative of the reasons which dictated the choice of features of appearance of the product concerned, information on its use or the existence of alternative designs which fulfil the same technical function (Court of Justice of the European Union, judgment of 8 March 2018 – C-395/16 – *DOCERAM GmbH v CeramTec GmbH* – EU:C:2018:172). With regard to the aspect of the existence of other designs, what significance is attached to the fact that the proprietor of the design also holds design rights for numerous alternative designs?
2. In the assessment as to whether the appearance is dictated exclusively by the technical function, is it necessary to take into account the fact that the design allows for a multicolour appearance in the case where the colour design is not, as such, apparent from the registration?
3. If Question 2 is answered in the affirmative: Does this affect the scope of protection of the design?

#### G r o u n d s

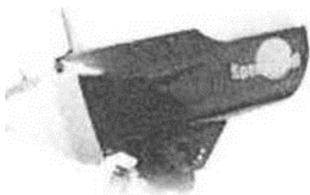
A)

- 1 The applicant is the proprietor of Community Design No 001344022-0006 ('the design at issue'), applied for on 19 September 2012, and registered and published

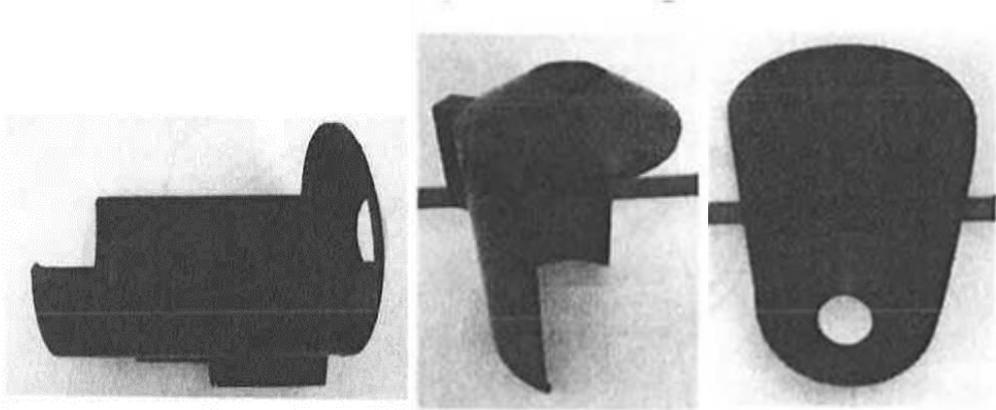
on 17 October 2012, relating to a 'packing device' for which the following images are filed:



- 2 The applicant markets a packing-paper dispenser which is manufactured according to that design and appears as depicted below:



- 3 The defendant marketed a competing product which the applicant regards as constituting an infringement of the design at issue and which appears as depicted below:



- 4 The defendant takes the view that the design at issue is invalid because all of its features are dictated exclusively by the technical function of the product. Against the action, which, after the right to seek a prohibitory injunction had been granted, also sought the disclosure of information and a declaration establishing liability for compensation, the defendant has brought a counterclaim seeking a declaration that the applicant's Community design was invalid.
- 5 The Landgericht (Regional Court) found against the defendant, in accordance with the form of order sought – in so far as is relevant here – and dismissed the counterclaim. The Landgericht proceeded on the assumption that, due to the existence of numerous design alternatives, the features of the design at issue are not dictated exclusively by its technical function. Following an appeal against that decision, the present Chamber declared the design at issue to be invalid on the basis of the counterclaim in its judgment of 27 June 2019 and accordingly dismissed the action – to the extent to which a ruling had not been made against the defendant on the basis of its acknowledgement. The present Chamber proceeded on the assumption that all the features defining the design at issue are dictated by its technical function. It stated that all the features are apparent from the patent application publication invoked by the applicant, EP 2 897 793, and are explained as being technically advantageous in that document. That assessment is also not changed by the depiction of the product in advertising. That depiction also highlights the technical advantages. The existence of viable design alternatives is irrelevant. In so far as they achieve the same technical solution, the applicant has had numerous conceivable designs protected. Such an approach was precisely what prompted the Court of Justice, in its decision in *DOCERAM*, not to allow the existence of design alternatives alone to suffice.
- 6 In response to the applicant's appeal on grounds of lack of jurisdiction brought against that judgment of the present Chamber, the Bundesgerichtshof (Federal Court of Justice) set that judgment aside and referred the dispute back to the present Chamber for reconsideration (BGH, judgment of 7 October 2020, I ZR 137/19 – *Papierspender* – ECLI:DE:BGH:2020:071020UIZR137.19.0). It stated that the present Chamber had attached too much importance to the patent application publication, had erred in law in its assessment of the other circumstances and had failed to take all aspects into account. There is, it ruled, no

empirical principle according to which considerations relating to visual appearance do not play a role in the decision to opt for a feature of appearance which, according to a patent application publication, is necessary for its technical function. The present Chamber should have considered whether visual considerations do not also play a role in the configuration consisting of two components connected by means of bayonet connectors because it makes possible the two-colour appearance achieved in the product actually marketed. Lastly, the present Chamber ought not to have disregarded the fact that the applicant has a number of designs for alternative forms of design which pursue the same technical function as that pursued by the product created according to the design at issue.

## B)

- 7 The outcome of the reopened appeal proceedings hinges on the answers to the questions referred.
- 8 In that respect, with regard to the significance of the existence of design alternatives, the decision of the Bundesgerichtshof is based on the assumption that it is irrelevant that the applicant also claims design protection for those alternative designs. The present Chamber takes the view that that assumption is gainsaid by the findings of the Court of Justice in paragraph 30 of the judgment in *DOCERAM*. In that paragraph, the Court of Justice stated that there is a risk that a single economic operator would be able to obtain several registrations as a Community design of different possible forms of a product incorporating features of appearance of that product which are exclusively dictated by its technical function, thereby obtaining exclusive protection, something which is, in practice, equivalent to that offered by a patent, but without meeting the conditions applicable for obtaining a patent. In that sense, in a case that was similar in many respects, the General Court of the European Union also took the view that account should be taken of the fact that the alternative forms presented were protected by means of their registration as Community designs, as was the case for the contested design, and could not, therefore, be considered as alternatives available to competitors (General Court, judgment of 18 November 2020 – T-574/19 – *Tinnus Enterprises LLC* – EU:T:2020:543 – appeal pending before the Court of Justice as Case C-29/21 P – paragraph 70 et seq.).
- 9 The present Chamber takes the view that this militates in favour of the existence of other designs being ascribed only minor importance in the requisite overall assessment in the case where the design proprietor also claims design protection for those other designs.
- 10 Questions 2 and 3 are posed irrespective of this. The Bundesgerichtshof criticised the present Chamber on the ground that it did not examine whether the two-part configuration apparent from the design at issue was not based on the visual consideration that it made possible the two-colour appearance of the product manufactured according to the design. The fact that the two-colour appearance is not dictated by the technical function, as evidenced solely by the fact that the

contested product is monochrome, militates in favour of that view taken by the Bundesgerichtshof. However, the present Chamber has reservations in that respect because the two-colour appearance is not apparent from the registration of the design. Accordingly, a feature of appearance which is not apparent from the registration, which clearly claims protection irrespective of the colour design, would establish protection.

- 11 If Question 2 is answered in the affirmative, the question arises as to the significance of the two-colour appearance in relation to the scope of protection of the design at issue. This is because, if the essential reason, which is not dictated solely by the technical function of the product, for the choice of the features of appearance is to make a two-colour design possible, it appears questionable whether designs which do not achieve that two-colour appearance then come within the scope of protection.

[...]

[Signatures]