

## **CJEU Provides Some Clarity On When A Design Is ‘Solely Dictated By Its Technical Function’**

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The Court of Justice of the European Union (CJEU) recently confirmed that the “no-aesthetic-consideration” test is the preferable approach when deciding whether a design is “solely dictated by its technical function”. As a result, if aesthetic considerations are completely irrelevant the design should not be registered. However, this does not mean that the legislation requires a design to have an aesthetical merit in order to be registered as a Community Design.

Last month, the CJEU published their long-awaited decision on the request for a preliminary ruling raised by the Oberlandesgericht Düsseldorf (the “German Court”) back in 2016.

The CJEU has provided some clarity on the interpretation of Article 8(1) of the Community Design Regulation (CDR) and how to determine if a product’s features are “solely dictated by its technical function”. The CJEU took the chance to stress, once again, that the determination “must be interpreted in a uniform manner in all Member States”, which strongly reiterates the EU’s objective for cohesive legal application.

Historically, Member States have interpreted Article 8(1) CDR in different ways. In fact, the UK and French courts tend to prefer the ‘no-aesthetic-consideration’ test, whereas the German and Spanish courts opted for the ‘multiplicity of forms’ test. The first test asks whether the design was created based on some aesthetic-considerations, although it also presents some functional elements; if so, then it is capable of being protected. By contrast, the ‘multiplicity of forms’ test asks whether there is an alternative form of the same product which could fulfil the same function; if there is, then the design cannot be ‘solely dictated by its technical function’ and is registrable.

In the UK this test was first adopted in *Landor & Hawa v Azure Designs* and it has been criticised by several commentators as it would not be difficult to obtain a monopoly on a certain function by registering more than one design. As a result, the ratio of the exclusion dictated by Article 8(1) CDR would be frustrated.

### **The Facts**

DOCERAM and CeramTec manufacture ceramic weld centring pins (alongside other items). DOCERAM brought an action to stop CeramTec using their registered design and, as often happens, CeramTec filed an invalidity counterclaim based on the “technical functions” exclusion. CeramTec’s counterclaim was successful at first instance and DOCERAM appealed the decision to the German Court.

The German Court stayed the proceeding and referred the following questions to the CJEU:

1. Shall Article 8(1) CDR be interpreted as meaning that the existence of alternative designs is decisive?
2. Shall the features of appearance of a product be determined based on the perception of the ‘objective observer’? If so, how is such an observer to be defined?

In answering the first question the CJEU confirmed that the ‘no-aesthetic-consideration’ test should be applied (as previously stated in the UK in *Amp v Utilux* and, more recently, in *Lindner v Franssons* and *Dyson v Vax*). In fact, by adopting this test, a single economic operator cannot obtain several Community Design registrations for alternative forms of a product incorporating features that are exclusively dictated by its technical function. This prevents operators benefiting from exclusive protection equivalent to that offered by a patent without being subject to the requirements for obtaining a Community design.

In answer the second question, the CJEU stated that there is no mention of an ‘objective observer’ in the law and thus the national courts must take into account all objective and relevant circumstances of the case.

The CJEU decision was largely anticipated by the Advocate General’s opinion. He also opines that the existence of a design alternative can be taken into account when determining a product’s features but it should not be the decisive test. On a side note, the Advocate General also suggested that using expert opinions for particular questions may be helpful.

In conclusion, this decision will find large application in future disputes regarding Community design rights as the national courts are now provided with a clear reference to the no-aesthetic consideration test. On the other hand, right holders will be able to receive clearer answers when it comes to considering potential invalidity claims, which are likely to increase in light of this landmark decision.

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