Reports of Cases

JUDGMENT OF THE GENERAL COURT (Tenth Chamber)

18 November 2020*

(Community design – Invalidity proceedings – Registered community design representing fluid distribution equipment – Ground for invalidity – Non-compliance with requirements for protection – Article 25(1)(b) of Regulation (EC) No 6/2002 – Features of appearance of a product solely dictated by its technical function – Article 8(1) of Regulation No 6/2002)

In Case T-574/19,

**Tinnus Enterprises LLC**, established in Plano, Texas (United States), represented by A. Odle and R. Palijama, lawyers and J. St Ville, Barrister,

applicant,

v

**European Union Intellectual Property Office (EUIPO)**, represented by J. Ivanauskas and A. Folliard-Monguiral, acting as Agents,

defendant,

the other party to the proceedings before the Board of Appeal of EUIPO, intervener before the General Court, being

**Koopman International BV**, established in Amsterdam (Netherlands), represented by G. van den Bergh and B. Brouwer, lawyers,

the other party to the proceedings before the Board of Appeal of EUIPO having been

**Mystic Products Import & Export, SL**, established in Badalona (Spain),

ACTION brought against the decision of the Third Board of Appeal of EUIPO of 12 June 2019 (Case R 1002/2018-3), relating to invalidity proceedings between, on the one hand, Mystic Products Import & Export and Koopman International and, on the other, Tinnus Enterprises,

THE GENERAL COURT (Tenth Chamber),

composed of A. Kornezov, President, E. Buttigieg (Rapporteur) and K. Kowalik-Bańczyk, Judges,

Registrar: R. Ūkelytė, Administrator,

having regard to the application lodged at the Court Registry on 16 August 2019,

* Language of the case: English.

having regard to the response of EUIPO lodged at the Court Registry on 19 November 2019,

having regard to the response of the intervener lodged at the Court Registry on 11 November 2019,

having regard to the reassignment of the case to a new Judge-Rapporteur sitting in the Tenth Chamber,

having regard to the written questions put by the Court to the parties and their answers to those questions lodged at the Court Registry on 4, 9 and 10 June 2020,

further to the hearing on 10 July 2020,

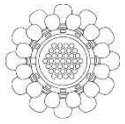
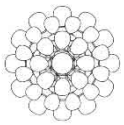
gives the following

## Judgment

### Background to the dispute

1 The applicant, Tinnus Enterprises LLC, is the holder of the Community design filed on 10 March 2015 with the European Union Intellectual Property Office (EUIPO) and registered under number 1 431 829-0001 ('the contested design'), pursuant to Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1).

2 The contested design is represented as follows:

| | | |
|---|---|---|
|  |  |  |
| 1.1 | 1.2 | 1.3 |

3 In accordance with Article 36(2) of Regulation No 6/2002, the applicant indicated in the application for registration that the contested design was intended to be applied to the product 'fluid distribution equipment' in Class 23.01 of the Locarno Agreement Establishing an International Classification for Industrial Designs of 8 October 1968.

4 On 7 June 2016, Mystic Products Import & Export, SL, filed an application for a declaration of invalidity in respect of the contested design based on Article 25(1)(b) of Regulation No 6/2002, read in conjunction with Articles 4(1) and 8(1) of that regulation. Mystic Products Import & Export contended, inter alia, that all the features of the contested design were solely dictated by their technical function. Consequently, in the light of Article 8(1) of Regulation No 6/2002, that design was not eligible for any protection.

5 On 19 April 2017, the intervener, Koopman International BV, also filed an application for a declaration of invalidity in respect of the contested design, based on the same provisions and the same arguments, in essence, as those mentioned in paragraph 4 above. The intervener requested that the design be declared invalid or at least that its protection be limited.

6 On 30 August 2017, EUIPO informed the two applicants for a declaration of invalidity that their applications would be examined in one set of proceedings under Article 54 of Regulation No 6/2002.

7 By decision of 30 April 2018, the Invalidity Division declared that the contested design was invalid.

8 On 31 May 2018, the applicant filed a notice of appeal with EUIPO, pursuant to Articles 55 to 60 of Regulation No 6/2002, seeking the annulment of the Invalidity Division's decision.

9 By decision of 12 June 2019 ('the contested decision'), the Third Board of Appeal of EUIPO upheld the Invalidity Division's finding that the contested design was based on features of a product, fluid distribution equipment, solely dictated by the technical function of that product, with the result that that design had to be declared invalid by virtue of the application of Article 25(1)(b) in conjunction with Article 8(1) of Regulation No 6/2002. Accordingly, the applicant's appeal was dismissed.

## Forms of order sought

10 The applicant claims that the Court should:

– annul the contested decision;

– vary the contested decision to: (i) allow the applicant's appeal; (ii) dismiss the applications for a declaration of invalidity in respect of the contested design; (iii) order the applicants for a declaration of invalidity to pay the costs incurred by the applicant in the proceedings before the Board of Appeal and the Invalidity Division; and (iv) in the alternative, remit the case to the Invalidity Division for consideration under Article 4(1) of Regulation No 6/2002;

– make an order for costs in the applicant's favour.

11 EUIPO and the intervener contend that the Court should:

– dismiss the action;

– order the applicant to pay the costs.

## Law

12 The applicant has advanced four pleas in law in support of its action, which relate to the Board of Appeal's application of Article 8(1) of Regulation No 6/2002 in the contested decision.

13 Article 8(1) of Regulation No 6/2002 provides that a Community design is not to subsist in features of appearance of a product which are solely dictated by its technical function.

14 Concerning Article 8(1) of Regulation No 6/2002, recital 10 of that regulation states as follows:

'Technological innovation should not be hampered by granting design protection to features dictated solely by a technical function. It is understood that this does not entail that a design must have an aesthetic quality. Likewise, the interoperability of products of different makes should not be hindered

by extending protection to the design of mechanical fittings. Consequently, those features of a design which are excluded from protection for those reasons should not be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection'.

15 In its judgment of 8 March 2018, *DOCERAM* (C-395/16, EU:C:2018:172, paragraph 31), the Court of Justice found, inter alia, that Article 8(1) of Regulation No 6/2002 excluded protection under the law on Community designs for features of appearance of a product where considerations other than the need for that product to fulfil its technical function, in particular those related to the visual aspect, have not played any role in the choice of those features, even if other designs fulfilling the same function exist.

16 The Court of Justice stated that, in order to assess whether features of appearance of a product are solely dictated by its technical function, it had to be established that the technical function was the only factor which determined those features, the existence of alternative designs not being decisive in that regard (judgment of 8 March 2018, *DOCERAM*, C-395/16, EU:C:2018:172, paragraph 32).

17 According to the Court of Justice, assessment as to whether the features of appearance of a product are covered by Article 8(1) of Regulation No 6/2002 must be made in the light of all the objective circumstances relevant to each individual case. That assessment must be made, in particular, 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, or information on its use or the existence of alternative designs which fulfil the same technical function, provided that those circumstances, data, or information as to the existence of alternative designs are supported by reliable evidence (judgment of 8 March 2018, *DOCERAM*, C-395/16, EU:C:2018:172, paragraphs 36 and 37).

18 It is in the light of those factors that the General Court must assess the pleas in law on which the applicant relies.

***The first plea in law, alleging that the Board of Appeal failed to adopt a structured and systematic approach in the contested decision.***

19 The applicant submits that, having regard to the judgment of 8 March 2018, *DOCERAM* (C-395/16, EU:C:2018:172), the Board of Appeal, in order to determine whether the contested design had been validly registered, had to adopt a systematic and structured approach; that approach consists in, first, determining the technical function of the product for which registration of the contested design had been granted, secondly, identifying the features of appearance of the product which, allegedly, were solely dictated by its technical function, thirdly, determining whether each of those features is in fact dictated by the technical function of that product and, fourthly, assessing the contested design in the light of the criteria of novelty and individual character required by Articles 4 to 6 of Regulation No 6/2002, excluding the features of appearance solely dictated by the technical function of the product.

20 According to the applicant, the Board of Appeal's analysis in the contested decision had no such structure. The applicant submits that the Board of Appeal did not begin its analysis by determining the technical function of the product concerned. Furthermore, the Board of Appeal identified the four component parts of the product concerned, namely the housing, the hollow tubes, the balloons, and the fasteners fixing the balloons to the tubes, instead of identifying and examining the features of appearance of the product concerned, and also wrongly examined the technical function of the four abovementioned parts of the product, instead of examining the technical function of the product itself. Thus, according to the applicant, in concluding, in essence, at paragraph 37 of the contested decision that none of the features of the contested design had been chosen with the sole aim of enhancing the product's visual appearance, the Board of Appeal applied a different, and therefore erroneous, legal criterion to that required by Article 8(1) of Regulation No 6/2002.

21 Furthermore, the applicant submits that, due to the Board of Appeal's unstructured analysis, it did not address the substance of the evidence of the designer of the contested design. Nor did it correctly apply the second, third and fourth steps of the analysis set out in paragraph 19 above.

22 EUIPO and the intervener dispute the applicant's arguments.

23 It is apparent from the wording of Article 8(1) of Regulation No 6/2002, of recital 10 of that regulation and of the judgment of 8 March 2018, *DOCERAM* (C-395/16, EU:C:2018:172), that the assessment of a Community design in terms of the abovementioned provision comprises the following steps: it is necessary, first, to determine the technical function of the product concerned, secondly, to analyse the features of appearance of that product within the meaning of Article 8(1) of Regulation No 6/2002 and, thirdly, to examine, in the light of all the relevant objective circumstances, whether those features are solely dictated by the technical function of the product concerned. In other words, it must be examined whether the need to fulfil that technical function is the sole factor that determined the choice by the designer of those features, with considerations of another nature, in particular those related to the visual aspect of that product, having played no role in the choice of those features (see, to that effect, judgment of 8 March 2018, *DOCERAM*, C-395/16, EU:C:2018:172, paragraphs 26 and 31). Having regard to recital 10 of Regulation No 6/2002, the solely functional features of the design at issue must not be taken into consideration for assessing whether other features of that design fulfil the requirements for protection, in the light, in particular, of the criteria of 'novelty' and of 'individual character' provided in Article 4(1) of Regulation No 6/2002.

24 It is apparent from Article 8(1) of Regulation No 6/2002 and from recital 10 of that regulation that, if it is found that at least one of the features of appearance of the product concerned is not solely dictated by the technical function of that product, the design at issue remains valid and protects that feature.

25 On the other hand, as is also apparent from Article 8(1) of Regulation No 6/2002 and from recital 10 of that regulation, and as EUIPO rightly notes, if all the features of appearance of the product concerned are solely dictated by its technical function, the design at issue will not be valid, unless it is apparent that the arrangement of those features was dictated by considerations not concerned solely with the need to fulfil the technical function of the product concerned, creating, in particular, an overall visual impression going beyond mere technical function. In that regard, it must be borne in mind that, under the system laid down by Regulation No 6/2002, appearance is the decisive factor for a design (see judgment of 8 March 2018, *DOCERAM*, C-395/16, EU:C:2018:172, paragraph 25 and the case-law cited) and, consequently, a particular arrangement of features could be chosen for purposes other than the need to fulfil a technical function and, in particular for ornamental purposes and, more generally, for purposes seeking to enhance the visual aspect of the design.

26 As EUIPO rightly states, in the situation of the particular arrangement mentioned above, the design at issue remains valid and protects only that particular arrangement and not the solely functional features of appearance of the product that are concerned by that arrangement.

27 It follows from paragraphs 23 to 26 above that the applicant's definition of the steps of analysis required by Article 8(1) of Regulation No 6/2002, set out in paragraph 19 above, is, in essence, correct. It is necessary, therefore, to examine whether the Board of Appeal correctly applied those steps in the contested decision.

28 As regards the first step of the analysis, the Board of Appeal stated, in paragraph 23 of the contested decision, that it was necessary, first of all, to determine the technical function of the product in which the contested design was incorporated. The Board of Appeal took into account the fact that the applicant, the holder of that design, described that product, in the application that led to the registration of the contested design, as 'fluid distribution equipment' (paragraph 23 of the contested decision). The Board of Appeal established that that product was intended to entertain children by facilitating a water balloon fight (paragraph 33 of the contested decision) and specified that the

technical function of the product was to fill a number of inflatable balloons at the same time (paragraph 34 of the contested decision). It is clear from the foregoing that the first step of the analysis, noted in paragraph 23 above, is present in the contested decision.

29 As regards the second step of the analysis, it must be noted that, in paragraph 34 of the contested decision, the Board of Appeal clearly identified and analysed the features of appearance of the product concerned, those being: (i) the housing with an opening and a number of holes; (ii) a number of hollow tubes attached to the housing; (iii) a number of inflatable balloons connected to the ends of the tubes; and (iv) a number of fasteners fixing the balloons to the tubes. It follows that the second step of the analysis noted in paragraph 23 above is also present in the contested decision.

30 In paragraphs 33 to 36 of the contested decision, the Board of Appeal carried out the third step of the analysis in examining whether each of the features of appearance of the product was solely dictated by its technical function. In particular, in paragraph 34 of the contested decision, the Board of Appeal, for the purposes of examining the functions of the four features identified, took into account the following presentation on the internet of the product of the applicant and holder of the contested design, called 'Bunch O Balloons'.

'A hose attachment with 37 pre-connected balloons that automatically tie themselves once filled with water. […] The uninflated balloons have been pulled over 37 straws. Around the neck of each balloon, there is a tiny, tight rubber band securing the balloon onto the straw. The straws feed into a single head that can be attached to a hose for filling. This allows for all of the balloons to simultaneously fill with water. You can then stop the hose and shake the balloons gently to release them into your arsenal'.

31 Furthermore, the Board of Appeal, in paragraphs 35 and 36 of the contested decision and in response to the applicant's arguments drawn from the witness statement of the designer of the contested design, stated that the visual aspect of the device resulted from its technical function and that, while it was true that there existed, in principle, alternative designs in respect of the size, shape and arrangement of the features of appearance of the product concerned, it was, nevertheless, necessary in the case at hand to take into account the fact that the features and the way that they were designed guaranteed the technical effects that let the product function perfectly. Furthermore, in paragraph 28 of the contested decision, the Board of Appeal noted and approved the Invalidity Division's analysis involving examination of the contested design as a whole. It is, therefore, clear from paragraphs 28, 35 and 36 of the contested decision that the Board of Appeal considered the question of whether the arrangement of the individual features of appearance of the product concerned produced an overall visual impression from which it could be inferred that that arrangement was not dictated solely by considerations relating to the need for that product to fulfil its technical function.

32 In paragraphs 37 and 38 of the contested decision, the Board of Appeal thus concluded, in essence, that all the features of appearance of the product concerned were solely dictated by its technical function and, in paragraph 39 of the contested decision that, consequently, the contested design had to be declared invalid.

33 It follows from paragraphs 30 and 32 above that the third step of the analysis, noted at paragraph 23 above, is present in the contested decision.

34 As regards the fourth step of the analysis identified by the applicant and set out in paragraph 19 above, it must be held that since the Board of Appeal found that all the features of appearance of the product concerned were dictated by its technical function and, therefore, found the contested design was invalid on the basis of Article 25(1)(b) of Regulation No 6/2002, in conjunction with Article 8(1) of that regulation, there was no need for it to consider the novelty or the individual character of the abovementioned design.

35 Having regard to the foregoing considerations, it must be concluded that the Board of Appeal carried out all the necessary steps in considering the application of Article 8(1) of Regulation No 6/2002. The question of whether the Board of Appeal's assessments were well founded is a separate issue and will be addressed in the context of examining the other pleas in law raised by the applicant.

36 As regards the applicant's complaint that the Board of Appeal did not address the substance of the evidence of the designer of the contested design, it should be noted that that evidence is presented in paragraph 14 of the contested decision. In paragraph 35 of the contested decision, the Board of Appeal responds in substance to the applicant's arguments based on that evidence. More specifically, in the abovementioned paragraph 35, the Board of Appeal responds to the argument that the contested design relates to a product intended for sale to consumers, to the argument that there are several other ways to obtain the same technical result as that which is represented in the contested design and several possible variations of that design, and to the argument that the contested design has a 'simple, clean and elegant appearance'. The Board of Appeal rejects those arguments in stating that they do not change the fact that the visual aspect of the device is the result of its technical function and that, in accordance with the judgment of 8 March 2018, *DOCERAM* (C-395/16, EU:C:2018:172), the mere fact that an alternative design exists does not mean that the appearance of a product has been dictated by considerations other than technical considerations. The Board of Appeal develops that analysis further in paragraph 36 of the contested decision.

37 It follows that the applicant's complaint that the Board of Appeal did not address the substance of the evidence of the designer of the contested design must be rejected.

38 Having regard to the foregoing considerations, the first plea in law must be rejected.

***Second plea in law, alleging that the Board of Appeal did not analyse the features of appearance of the product concerned and its technical function and that it had used an incorrect threshold for the application of Article 8(1) of Regulation No 6/2002***

39 The applicant complains that the Board of Appeal, first, analysed the technical features of the product at issue or the component parts, instead of analysing the features of its appearance (first complaint) and, secondly, analysed the functions of those technical features or component parts, instead of analysing the technical function of the product (second complaint). According to the applicant, the result of those errors is that the Board or Appeal adopted a different and less stringent preliminary criterion than that required by Article 8(1) of Regulation No 6/2002, as interpreted by the judgment of 8 March 2018, *DOCERAM* (C-395/16, EU:C:2018:172), which involves checking whether each of the features of appearance of the product was solely dictated by its technical function (third complaint).

40 EUIPO and the intervener dispute the applicant's arguments.

*The first complaint, relating to a failure by the Board of Appeal to analyse the features of appearance of the product concerned.*

41 As a preliminary point, it should be noted that Regulation No 6/2002 does not provide a precise definition of the 'features of appearance of a product' In the definition of a design in Article 3(a) of that regulation, the term 'features' is used in a broad sense, covering all possible aspects of the appearance of a product, in particular the features of the lines, contours, colours, shape, texture and/or materials of the product. As EUIPO correctly notes, the identification of those features must be carried out on a case-by-case basis and depends on the product concerned (see, by analogy, judgment of 24 September 2019, *Roxtec* v *EUIPO – Wallmax (Depiction of a black square containing seven concentric blue circles*), T-261/18, EU:T:2019:674, paragraphs 51 and 55).

42 Accordingly, identification of the features of appearance of a product may, depending on the case, and in particular having regard to its degree of complexity, be carried out by means of a simple visual analysis of the design or, on the contrary, be based on a detailed examination in which relevant criteria of assessment are taken into account, such as surveys or expert opinions, or data relating to intellectual property rights conferred previously in respect of the product concerned (see, by analogy, judgment of 19 September 2012, *Reddig* v *OHIM – Morleys (Knife handle)*, T-164/11, not published, EU:T:2012:443, paragraph 38 and the case-law cited).

43 In the contested decision, the Board of Appeal began its analysis by noting that the applicant, in the application which led to registration of the contested design, described the product to which that design applied as 'fluid distribution equipment' (paragraph 23 of the contested decision).

44 Next, the Board of Appeal noted, in essence, that it would consider the European patent application EP 3 005 948 A 2, filed in the applicant's name on 3 October 2015, in order to obtain more precise information and evidence about the nature of the abovementioned product and the functional features of the contested design (paragraph 25 of the contested decision).

45 The Board of Appeal thus identified, in paragraph 34 of the contested decision, the features of appearance of the product as being: (i) the housing with an opening and a number of holes; (ii) a number of hollow tubes attached to the housing; (iii) a number of inflatable balloons connected to the ends of the tubes; and (iv) a number of fasteners fixing the balloons to the tubes. The Board of Appeal found that all those features were necessary for the technical solution enabling a number of inflatable balloons to be filled at the same time.

46 It is true that, according to the Board of Appeal's analysis, the four abovementioned features of appearance of the product correspond with the individual component parts of that product. In paragraph 33 of the contested decision, the Board of Appeal noted that the product 'fluid distribution equipment' consisted of a housing that could be attached to a water distribution facility such as a tap or a hosepipe, that the water was distributed via multiple straws (tubes) attached to the housing via holes and that it filled the inflatable balloons attached to the far ends of the straws (tubes) by elastic bands. According to the Board of Appeal, once sufficient water is in the balloons, the weight of the liquid allows the balloons to be detached from the straws and the elastic bands close them, keeping the water inside, so that those balloons can be used in water fights.

47 However, the fact that the features of appearance of the product concerned coincide with its individual component parts does not mean that the Board of Appeal erred in the identification of those features. In accordance with the considerations in paragraphs 41 and 42 above, it should be noted, first, that the identification of those features depends on the product concerned. In the present case, given the complex nature of that product, which is composed of several individual parts, it is logical that the features of its appearance correspond with those individual parts. Secondly, as regards the method, the Board of Appeal was entitled, having regard to the complexity of the product concerned, not to limit itself to a mere visual analysis but to proceed to a detailed examination and to identify as features of the product's appearance the visible parts comprising the product and which form that appearance.

48 Based on those considerations, the applicant's complaint that the Board of Appeal did not analyse the features of appearance of the product concerned must be rejected. That conclusion is borne out by the fact that, during the proceedings before EUIPO, the applicant itself had agreed that the four individual parts of the product concerned did constitute the features of its appearance.

*The second complaint, relating to a failure by the Board of Appeal to analyse the technical function of the product concerned.*

49 As a preliminary point, it should be observed that the Board of Appeal did take into account the technical function of the product concerned, having stated that the purpose of the product was to entertain children by facilitating a water fight (paragraph 33 of the contested decision) and that the technical function of the product was to fill a number of inflatable balloons at the same time (paragraph 34 of the contested decision).

50 Next, the Board of Appeal, after identifying the features of appearance of the product concerned, concluded that all those features were solely dictated by the technical function of that product, thus falling within the scope of Article 8(1) of Regulation No 6/2002 (paragraphs 38 and 39 of the contested decision).

51 Accordingly, the applicant's complaint that the Board of Appeal did not analyse the technical function of the product concerned must be rejected.

52 It is true that, in order to reach the conclusion referred to in paragraph 50 above, the Board of Appeal also analysed, in paragraphs 33 and 34 of the contested decision, the technical function of each of the four features of appearance of the product concerned, namely the housing, the tubes, the balloons and the fasteners, and the contribution of each of them in obtaining the technical function of that product, namely the simultaneous filling of a number of inflatable balloons that could be used in a water fight. For example, as is mentioned in paragraph 30 above, the Board of Appeal describes, in paragraph 34 of the contested decision, the functions of those features as they are portrayed on the internet by the applicant.

53 That approach by the Board of Appeal is not incorrect.

54 When the design at issue is applied to a complex product, like the product concerned in the present case, in which the features of appearance correspond with the product's individual component parts, the answer to the question of whether those features are 'solely dictated by the technical function of the product', within the meaning of Article 8(1) of Regulation No 6/2002, requires, at the outset, examination of the technical function of each of those features and examination of the causal link between the technical function of each of those features and the technical function of the product concerned. When there is no causal link between the technical function of the feature and the technical function of the product, that is to say where that feature does not contribute to the technical function of the product, it cannot be maintained that that feature is 'solely dictated' by the technical function of the product. By contrast, if such a causal link exists, it allows a finding that the feature of appearance of the product is 'solely dictated' by the technical function of that product, provided that considerations other than the need for that product to fulfil its technical function, in particular those related to the visual aspect, have not played any role in the choice of that feature, as provided for in the judgment of 8 March 2018, *DOCERAM* (C-395/16, EU:C:2018:172, paragraph 31).

55 In order to illustrate the abovementioned considerations, it is appropriate to refer to the example of the housing visible on the contested design. The housing, according to the foregoing analysis, constitutes one feature of appearance of the complex product concerned in the present case, but also an individual part, in other words, a component, of that product. That housing has the function of connecting the product concerned to the water supply, the tap, for example. Thus, it is clear that, even if the housing, taken in isolation, has a different function from the product concerned, which serves to fill several balloons with water at the same time, it nevertheless contributes to the product's technical function. That causal link may lead to the conclusion that that housing is 'solely dictated' by the technical function of the product concerned, provided that considerations other than the need for that product to fulfil its technical function, in particular those related to the visual aspect, have not played any role in the choice of the housing.

56 It follows that, as EUIPO correctly notes, the fact that the product concerned contains several features, each of which fulfils a different function, does not exclude the application of Article 8(1) of Regulation No 6/2002. That provision does not require the features of appearance to refer to one single technical result. The features may produce several technical results, as long as they contribute to achieving the technical result intended by the product.

57 As EUIPO points out, not to allow such an interpretation of Article 8(1) of Regulation No 6/2002 would result in that provision not being applied to a number of purely functional features merely because they do not directly fulfil the function of the product concerned. Similarly, the application of that provision would be excluded for designs comprising only part of a product or a component thereof, since the latter would only rarely fulfil the function of the product as such. Such a situation is not consistent with the objective pursued by the abovementioned provision.

58 Having regard to the foregoing considerations, the applicant's complaint relating to the method of analysis followed by the Board of Appeal in order to conclude that all the features of appearance of the product concerned are solely dictated by its technical function must be rejected.

*The third complaint, relating to the criterion for the application of Article 8(1) of Regulation No 6/2002, used by the Board of Appeal in the contested decision*

59 The applicant submits that the Board of Appeal adopted a criterion for the application of Article 8(1) of Regulation No 6/2002 that is less stringent than that provided by that provision, according to which the features of appearance of a product must be 'solely dictated by its technical function'. In support of its complaint, the applicant relies on the following assertions made by the Board of Appeal: the assertion in paragraph 34 of the contested decision that 'all those features are necessary for the technical solution'; the assertion in paragraph 35 of the contested decision that 'the visual aspect of the device is still the result of its technical function'; the assertion in paragraph 36 of the contested decision that 'however, in the case at hand it must also be taken into account that the features and the way that they are designed also secure technical effects for the product's faultless performance'; and the assertion in paragraph 37 of the contested decision that 'all the essential features of the contested [design] have been chosen with a view to designing a product that performs its function' and that 'none of those features has been chosen simply for the purpose of enhancing the product's visual appearance'.

60 It must be found that the abovementioned terms used by the Board of Appeal in the contested decision do not indeed always correspond with those in Article 8(1) of Regulation No 6/2002. However, in the context of that decision and read in the light of its broad logic, the terminology criticised by the applicant does not demonstrate, as such, that the Board of Appeal applied that article erroneously. Indeed, the Board of Appeal, in referring to the abovementioned provision, concludes unequivocally in paragraph 38 of the contested decision that all the features of appearance of the product concerned fulfil only its technical function.

61 It follows that the applicant's complaint must be rejected and, consequently, the second plea in law rejected in its entirety.

***The third plea in law, alleging that the Board of Appeal erred in the analysis of the other Community designs held by the applicant and of its application for a European patent***

62 The applicant complains that the Board of Appeal failed to call into question the Invalidity Division's analysis that the mere fact that the applicant holds several visually different Community designs applicable to the product 'fluid distribution equipment' implies that all the features of appearance of the product concerned are solely dictated by its technical function.

63 The applicant also complains that the Board of Appeal considered that, since it had filed a patent application for the same product as that to which the contested design applies, containing a detailed description of the features of appearance of that product, those features are solely dictated by the product's technical function. According to the applicant, that patent application can only be one source of information concerning the reasons which dictated the choice of the features of appearance of the product concerned and cannot be a shortcut to avoid the structured analysis required by the judgment of 8 March 2018, *DOCERAM* (C-395/16, EU:C:2018:172), set out under the first plea in law.

64 EUIPO and the intervener dispute the merits of the applicant's complaints.

65 It should be noted that, in the judgment of 8 March 2018, *DOCERAM* (C-395/16, EU:C:2018:172, paragraph 32), the Court of Justice specified that the existence of alternative designs was not decisive as to whether the technical function of the product concerned was the only factor which determined the features of its appearance.

66 Similarly, it should be borne in mind that the Court of Justice, in the judgment of 8 March 2018, *DOCERAM* (C-395/16, EU:C:2018:172, paragraphs 36 and 37), found that the existence of alternative designs which fulfilled the same technical function constituted a relevant objective circumstance that had to be taken into consideration in the assessment as to whether the features of appearance of the product concerned were solely dictated by its technical function (see paragraph 17 above).

67 It is in the light of those clarifications that the applicant's two complaints must be examined.

*The complaint relating to the existence of the other Community designs held by the applicant.*

68 In order to assess the applicant's complaint relating to the fact that it is the holder of other designs applicable to the product 'fluid distribution equipment', it is appropriate to refer, first of all, to the Invalidity Division's decision.

69 The Invalidity Division noted that, although the procedure at issue concerned the validity of the contested design, it was relevant, having regard to the judgment of 8 March 2018, *DOCERAM* (C-395/16, EU:C:2018:172), to take account of the other Community designs held by the applicant and which had been subject, along with the contested design, to a multiple application for registration (page 8 of the Invalidity Division's decision).

70 The Invalidity Division noted that at least four designs among those mentioned in the applicant's multiple application showed possible alternatives to achieve a single technical solution, leaving little room for other alternatives. According to the Invalidity Division, the different configurations of the tubes and the balloons illustrated are only different ways of enabling a large number of balloons to be filled with water at the same time and in obtaining registration of those forms, the applicant leaves its competitors with few options for achieving the same result (page 9 of the Invalidity Division's decision).

71 Thus, the Invalidity Division, in referring to the need to take into account the relevant objective circumstances for the purpose of the application of Article 8(1) of Regulation No 6/2002, considered that such an objective circumstance in the present case might be the fact that all the alternative forms presented in the present case 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 (page 9 of the Invalidity Division's decision). It is also important to note that, as is apparent from its decision, the Invalidity Division did not confine itself to that consideration in order to conclude that Article 8(1) of Regulation No 6/2002 applied, but also took other factors into account and, in particular, the applicant's patent application and the nature of the product concerned, which was intended for a single, disposable use (pages 9 and 10 of the Invalidity Division's decision).

72 It follows that the existence of the other Community designs held by the applicant was taken into account by the Invalidity Division, as one factor among others, in order to assess whether the features of appearance of the product concerned in the present case were solely dictated by its technical function, within the meaning of Article 8(1) of Regulation No 6/2002.

73 That approach by the Invalidity Division was endorsed by the Board of Appeal. The Board of Appeal stated, in paragraph 29 of the contested decision, that the Invalidity Division was fully entitled to take account of the applicant's other Community designs, since, in accordance with the judgment of 8 March 2018, *DOCERAM* (C-395/16, EU:C:2018:172), all the objective circumstances of the case at hand had to be taken into account and one of those circumstances was constituted by the information that could be elicited from the applicant's other registrations relating to the same product.

74 As is stated in paragraph 81 below, the Board of Appeal also took into account other 'relevant objective circumstances', in terms of the judgment of 8 March 2018, *DOCERAM* (C-395/16, EU:C:2018:172), in order to conclude that all the features of appearance of the product concerned were solely dictated by its technical function.

75 It follows from the foregoing that the applicant's first complaint is based on a misunderstanding of the contested decision, since the Board of Appeal did not rely solely on the existence of the applicant's other Community designs in order to conclude that Article 8 (1) of Regulation No 6/2002 applied. On that basis, the first complaint must be rejected.

*The complaint relating to the applicant's European patent application*

76 It is apparent from the contested decision that the Board of Appeal used the applicant's European patent application as an important source of information for assessing the contested design in terms of Article 8(1) of Regulation No 6/2002.

77 Thus, the Board of Appeal found, essentially, that the patent application concerned exactly the same product as that to which the contested design applied (see paragraphs 30 to 32 of the contested decision).

78 The Board of Appeal used the information in the patent application to determine the component parts of the product to which the contested design applied, as well as its purpose, namely the entertainment of children by facilitating the organisation of a water fight (paragraph 33 of the contested decision).

79 The Board of Appeal also used the information in the patent application to establish the technical function of the four features of appearance of the product concerned, namely the housing, the tubes, the balloons and the fasteners, as well as the causal link between the technical function of those four features and the technical function of the product concerned. The Board of Appeal found that the abovementioned features were described in more detail in the patent application and that those two instruments (the contested design and the patent applied for) related to the same product (paragraph 34 of the contested decision).

80 In addition, in paragraph 35 of the contested decision, the Board of Appeal stated that it agreed with the Invalidity Division's analysis, which was based on the applicant's patent application. In particular, the Invalidity Division had observed that the appearance of the product to which the contested design applied was not enhanced in comparison with the austere embodiment presented in the patent application and that that example was almost identical to the contested design (page 11 of the Invalidity Division's decision).

81 Furthermore, it must be noted that the Board of Appeal did not rely on the applicant's patent application alone in order to conclude that the features of appearance of the product concerned were solely dictated by its technical function. It also took into account other 'relevant objective circumstances' in terms of the judgment of 8 March 2018, *DOCERAM* (C-395/16, EU:C:2018:172), namely the contested design (paragraph 35 of the contested decision), the nature and use of the product concerned (paragraph 33 of the contested decision), objective data indicating the reasons that dictated the choice of the features of appearance of the product concerned, namely the function of those features (paragraph 34 of the contested decision), and the applicant's other designs (paragraph 29 of the contested decision).

82 It follows from the foregoing considerations that the Board of Appeal did not rely solely on the applicant's patent application as the applicant claims (paragraph 63 above). It also follows that the Board of Appeal's analysis did not constitute a 'shortcut' in respect of the analysis required by the judgment of 8 March 2018, *DOCERAM* (C-395/16, EU:C:2018:172).

83 Accordingly, the applicant's second complaint must be rejected and, consequently, the third plea in law in its entirety.

***The fourth plea in law, alleging errors of assessment by the Board of Appeal***

84 The applicant submits, first, that the four features of appearance of the product concerned, identified by the Board of Appeal, are not solely dictated by the technical function of that product and, secondly, that those four features are not all of the features of appearance of the product concerned. It follows that the contested design should not have been declared invalid on the basis of Article 8(1) of Regulation No 6/2002, without an analysis under Articles 4 to 6 of that regulation being carried out.

85 The applicant, referring to paragraph 35 of the contested decision, identifies the following features as features of appearance of the product concerned not solely dictated by its technical function: the 'simple and clear appearance' of the contested design, which was identical or similar to a 'flower and stem' due to the choice as to the length of the straws in relation to the length of the balloons and the 'proportions of the design as a whole namely the length being about 18 times the width giving the design a sleek and elegant appearance appealing to the user'. According to the applicant, none of those features is solely dictated by the technical function of the product.

86 In support of its arguments, the applicant cites the witness statement of the designer of the contested design, submitted during the proceedings before the Board of Appeal.

87 In the abovementioned witness statement, that designer explained that there were ways other than that demonstrated by the contested design to achieve the same technical function. For example, 'the straws could be attached in a straight line along a length of hose, or they could be arranged in a spiral twisting around a length of hose, or the straws could be spokes protruding in a radial arrangement from a central hub' (paragraph 6 of the witness statement).

88 Similarly, according to the designer, various aspects of the contested design could be varied, such as the shape of the housing, the number, spacing and length of the straws and the combination of several straws of different lengths (paragraph 7 of the witness statement).

89 The designer stated that the contested design was more aesthetic than any which satisfied the technical function in one of the alternative ways listed in paragraph 6 of his witness statement, since it has an elongated shape, with a length that is approximately four times its width. The contested design therefore has a simple, clean and elegant appearance (paragraph 8 of the witness statement). The designer asserted that the choice of the arrangement of the aspects mentioned in paragraph 7 of his

witness statement had been dictated by the fact that that arrangement was one of the possible arrangements which enabled the contested design to have an elongated shape, which gave it a simple, clean and elegant appearance (paragraph 9 of the witness statement).

90 The designer also cited the commercial success of the product concerned (under the brand name 'Bunch O Balloons') and the awards he had received, which were based on criteria including the degree of consumer appeal of the design of the product (paragraphs 10 and 11 of the witness statement).

91 The applicant also relies on arguments in support of the individual character of the contested design and challenges the application, in the present case, of Article 8(2) of Regulation No 6/2002.

92 EUIPO and the intervener dispute the applicant's arguments.

93 First, it should be noted that the applicant does not put forward any arguments to support its assertion that the four features of appearance of the product concerned, identified by the Board of Appeal in paragraph 34 of the contested decision – namely (i) the housing with an opening and a number of holes, (ii) a number of hollow tubes attached to the housing, (iii) a number of inflatable balloons connected to the ends of the tubes and (iv) a number of fasteners fixing the balloons to the tubes – are not solely dictated by the technical function of that product. That assertion must, therefore, be rejected.

94 Secondly, it must be noted that in its arguments the applicant relies, in essence, on the arrangement of the features of appearance of the product concerned and the overall impression of the contested design, which, it is argued, is 'simple and clear', similar to a 'flower and stem'. The designer of the contested design, in his witness statement, also refers to the specific arrangement of the features of appearance, which, it is argued, is dictated by aesthetic considerations, and to the overall impression of that design.

95 In that regard, it is important to bear in mind that, in order to determine whether the features concerned of the appearance of a product are covered by Article 8(1) of Regulation No 6/2002, account should be taken of all the objective circumstances relevant to each case and that such an assessment must be made, in particular, 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, or information on its use or the existence of alternative designs which fulfil the same technical function, provided that those circumstances, data, or information as to the existence of alternative designs are supported by reliable evidence (judgment of 8 March 2018, *DOCERAM*, C-395/16, EU:C:2018:172, paragraphs 36 and 37).

96 In the present case, it must be found that the Board of Appeal, in endorsing the Invalidity Division's decision, took into account objective circumstances, supported by reliable evidence, relied on by the two applicants for a declaration of invalidity, in order to assess the contested design in the light of Article 8(1) of Regulation No 6/2002. The Board of Appeal took into account, inter alia, the applicant's patent application and found that that application concerned exactly the same product as the contested design (paragraph 32 of the contested decision). Indeed, that patent application helped the Board of Appeal to analyse the product to which the contested design applied and to find that the four single elements making up the product and contributing to its technical function corresponded to the features of its appearance (paragraphs 33 and 34 of the contested decision). Thus, the Board of Appeal was right to conclude that the contested design did not deviate from the previously submitted patent (paragraph 34 of the contested decision) and that all the single elements that are part of the visual appearance of the product concerned performed a technical function (paragraph 35 of the contested decision).

97 The Board of Appeal also endorsed the Invalidity Division's conclusion, based on the examination of the contested design as a whole, that it had not been established that considerations related to the visual aspect had played a role in the design process of the contested design (paragraph 28 of the contested design). The Board of Appeal thus endorsed the Invalidity Division's assessment that it could not see any enhancement of the appearance of the product, protected by the contested design, compared with the austere embodiment presented in the patent application.

98 The applicant's arguments do not call into question the abovementioned assessments of the Board of Appeal. Indeed, the applicant's assertion in relation to the 'simple and clear' appearance of the contested design and its resemblance to a 'flower and stem' (see paragraph 85 above) is contradicted, by way of example, as is apparent from the administrative file before EUIPO, by the author of the article 'Bunch O Balloons will revolutionise water fights', who described the appearance of the product concerned as 'deflated grapes'. The visual impression of the product put forward by the applicant thus seems arbitrary or, at the very least, too uncertain, and is not supported by objective data.

99 The Board of Appeal's conclusion, in paragraph 35 of the contested decision, that the applicant's claim, set out in paragraph 85 above, does not change the fact that the visual aspect of the device is dictated solely by its technical function, must therefore be approved.

100 Thirdly, as regards the witness statement by the designer of the contested design, cited by the applicant, it must be noted, as a preliminary point, that that witness statement has limited evidential value in so far as it presents the personal and subjective opinion of that designer and in so far as that designer, as President and proprietor of the applicant, has a personal interest in the validity of the contested design. It follows that that witness statement, in so far as it describes the 'simple, clean and elegant' appearance of the contested design and is not borne out by any other evidence from reliable and impartial sources, is unconvincing to the General Court as regards the contention that aesthetic considerations were taken into account during the design of the contested design.

101 Next, it should be noted that the designer attests, in essence, that it is possible to devise alternative designs by size, shape and the proportions of their features, which perform the same technical function as that of the product concerned. In that regard, as the Board of Appeal noted (see paragraphs 35 and 36 of the contested decision), it must be borne in mind that, for the Court of Justice, the existence of alternative designs is not decisive as regards the question of whether the technical function of the product concerned is the only factor which determined the features of its appearance (judgment of 8 March 2018, *DOCERAM*, C-395/16, EU:C:2018:172, paragraph 32). In the present case, in view of the objective elements taken into account by the Board of Appeal in order to conclude that Article 8(1) of Regulation No 6/2002 applied, the General Court considers that the assertions made by the designer of the contested design are not sufficient to call into question the Board of Appeal's conclusion.

102 Furthermore, the assertions made by the designer of the contested design in relation to the commercial success of the product to which that design applies and the awards he had received must also be rejected. The commercial success of the abovementioned product does not mean that considerations that are not related purely to the need to fulfil its technical function were taken into account in the creation of the contested design. As regards the argument relating to the awards received, it is apparent from the documents before the Court that the criteria on the basis of which those awards were given did not relate solely to the design of the products at issue and it is not apparent that the product concerned was award-winning by reason of its design. It follows that the abovementioned argument does not bear out the applicant's contention.

103 Fourthly, the applicant's arguments relating to the individual character of the contested design and to the application, in the present case, of Article 8(2) of Regulation No 6/2002 (see paragraph 91 above) must be rejected, since the Board of Appeal did not rule on those aspects of the dispute and gave a ruling only on the basis of Article 8(1) of Regulation No 6/2002. Consequently, the Court does not

have the power to adjudicate on those aspects either in the context of the action for annulment or the application for variation (see, to that effect and by analogy, judgment of 5 July 2011, *Edwin* v *OHIM*, C-263/09 P, EU:C:2011:452, paragraphs 71 and 72).

104 Having regard to the foregoing considerations, the fourth plea in law must be rejected and, consequently, the action dismissed in its entirety.

## Costs

105 Under Article 134(1) of the Rules of Procedure of the General Court, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since the applicant has been unsuccessful, it must be ordered to pay the costs incurred by EUIPO and by the intervener, as applied for in their respective pleadings.

On those grounds,

THE GENERAL COURT (Tenth Chamber)

hereby:

1. **Dismisses the action;**

2. **Orders Tinnus Enterprises LLC to bear its own costs and to pay the costs incurred by the European Union Intellectual Property Office (EUIPO) and by Koopman International BV.**

Kornezov Buttigieg Kowalik-Bańczyk

Delivered in open court in Luxembourg on 18 November 2020.

E. Coulon
Registrar

M. van der Woude
President