



**DECISION
of the Third Board of Appeal
of 29 April 2010**

In case R 211/2008-3

Nordson Corporation

28601 Clemens Road
Westlake, Ohio 44145-1119
United States of America

Appellant

represented by EISENFÜHR, SPEISER & PARTNER, Martinistr. 24,
D-28195 Bremen, Germany

v

UES AG

Römerstr. 15
D-47809 Krefeld
Germany

Respondent

represented by DTS PATENT- & RECHTSANWÄLTE, St.-Anna-Str. 15,
D-80538 München, Germany

APPEAL relating to Invalidity Proceedings No ICD 2988 (Registered Community
Design No 232996-0008)

THE THIRD BOARD OF APPEAL

composed of Th. Margellos (Chairperson), D.T. Keeling (Rapporteur) and
M. Bra (Member)

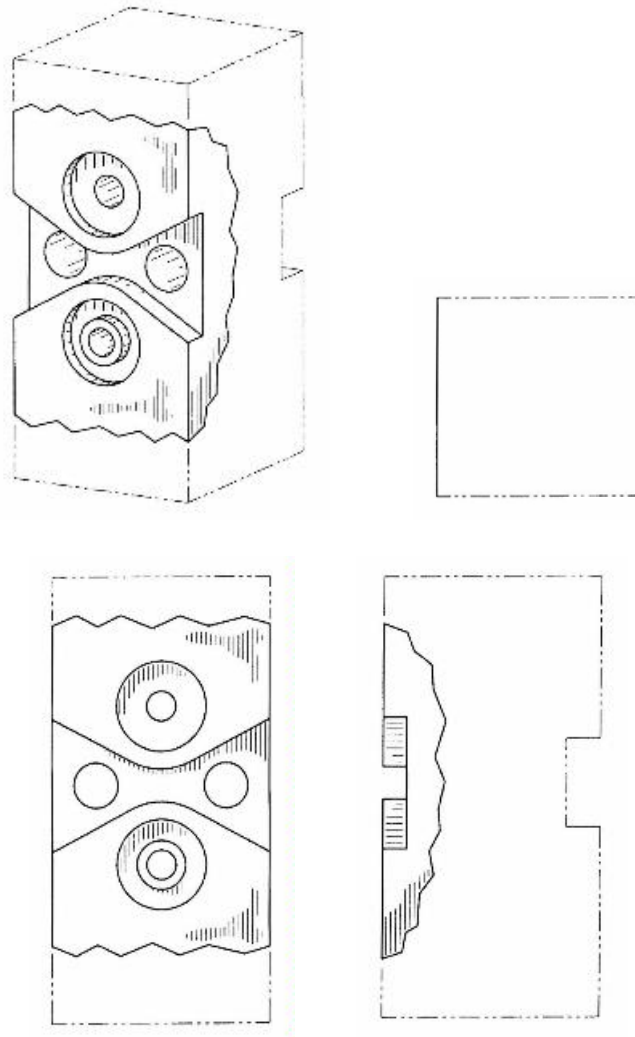
Registrar: J. Pinkowski

gives the following

Decision

Summary of the facts

- 1 On 30 September 2004 Nordson Corporation (hereafter ‘the design holder’) filed an application to register a Community Design (hereafter ‘the contested RCD’) whose four views are represented below:



in respect of the following product:

‘Fluid distribution equipment’.

- 2 The Community Design was registered under No 232 996-0008 and published in Community Designs Bulletin No 2004/102 of 30 November 2004.
- 3 By application received on 18 July 2006 UES AG (hereafter ‘the invalidity applicant’) requested the Office to declare the contested RCD invalid, pursuant to Article 25(1)(b) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Designs (‘CDR’) (OJ EC 2002 No L 3, p 1) on the ground that it did not fulfill the requirements of Articles 4(2) and 8(1) and (2) CDR.

- 4 The invalidity applicant argued as follows:
- The contested design relates to ‘fluid distribution equipment’. Such a part is called a module which is a spare part of a ‘hotmelt application system’. Modules having a form according to the dashed lines of the contested RCD have been well known for several years.
 - All features which are shown are invisible during normal use.
 - All features of the contested RCD are dictated solely by technical functions. The interoperability of products of different makes is hindered by protection of the design of the mechanical fittings. The provisions of Article 8 (1) CDR are fulfilled.
 - A module for a hotmelt application system must necessarily be reproduced in the exact form and dimensions in order to permit the module to be mechanically connected to the application head to perform its function. Therefore, Article 8 (2) CDR is applicable.
- 5 On 13 March 2007 the design holder submitted written observations. It argued that the contested RCD remains at least partly visible during normal use and that the features of the design are not solely dictated by a technical function. The contested RCD is not necessarily limited to ‘a module’. A module is one form that the design could cover. One option is to use such a module in connection with a manifold, into which one or several modules are mounted. The position of the bores on the product is not solely due technical reasons. The position of the bores could be varied without influencing the mechanical function of the bore in connection with the bolts which extend through the bores. The location of these bores and the position of each individual bore with respect to the other bores have a design quality.
- 6 In a letter dated 16 May 2007 the invalidity applicant continued to argue that the contested RCD is dictated solely by a technical function, is not visible during normal use, is devoid of novelty and individual character and represents a ‘must-fit’ part. In support of its claim it submits a copy of European Patent Application EP 1 568 418 for ‘Method and system for supporting and/or aligning components of a liquid dispensing system’, filed on the 8 February 2005 and published on 31 July 2005, with a priority date of 24 April 2004.
- 7 On 30 July 2007 the design holder reaffirmed the views that it had previously set out.
- 8 On 20 November 2007 the design holder issued a decision (‘the contested decision’) declaring the contested RCD invalid pursuant to Article 25(1)(b) CDR in conjunction with Article 8(2) CDR and ordered the design holder to bear the costs. The reasoning in the contested decision may be summarized as follows:
- The RCD subsist in features of appearance of fluid distribution equipment which must necessarily be reproduced in the exact form and dimensions in

order to permit the fluid distribution equipment in which the RCD is incorporated to be mechanically connected to the head of a hotmelt application system so that either product may perform its function. Therefore, the RCD is to be declared invalid under Article 8(2) CDR.

- 9 The design holder filed an appeal on 21 January 2008 followed by a statement of grounds on 20 March 2008. The invalidity applicant responded on 22 May 2008. The parties exchanged further briefs on 18 August 2008 and 21 October 2008.

Submissions and arguments of the parties

- 10 The design holder requests the Board to annul the contested decision and to order the respondent to bear the costs of the proceedings. It argues as follows:
- The RCD is not a ‘must-fit’ part. The same technical effect and level of ‘fitting’ can be achieved by several design alternatives without any problems.
 - The features of the RCD are not solely dictated by technical function.
 - Whether or not the features of a design are solely dictated by a technical function is to be determined upon the ‘alternative design test’, i.e. whether design alternatives with the same technical function are available (cf. Kur, GRUR International 1993, 71 at 74; Kur, GRUR International 1995, 185 at 190; Riehle, EWS 1996, 1 at 7; Auteri, GRUR International 1998, 360 at 365; Otero Lastres GRUR International 2000, 408 at 416; Kur GRUR 2002, 661 at 664; Koschtial, GRUR International 2003, 973 at 989; Massa/Strowel, [2003] EIPR 68 et 72; Ohly, ZEUP 2004, 296 at 310; Wandtke/Ohst, GRUR International 2005, 91 at 97; Ruhl, Gemeinschaftsgeschmacksmuster, 2007, Art. 8 note 19; see also German Federal Supreme Court, GRUR 2005, 600 at 602 – Handtuchklemmen). This test was considered to be the correct test during the legislative process (see the references at Ruhl, *supra*, Art. 8 notes 19 et seq.).
 - Various alternatives to the design of the RCD are available without any impact on technical functionality.
 - The ‘visibility criterion’ set forth in Article 4(2) CDR is not applicable in the case at hand. Pursuant to the clear wording of Article 4(2) CDR, the ‘visibility criterion’ only applies with respect to component parts of a complex product.
 - ‘Component parts’ are understood to be only items which in the view of the relevant circles are regarded as a constituent part of the product as a whole. Accordingly, ‘component parts’ must be differentiated from accessories and other additions which are applied to or incorporated in a product without being regarded by the relevant circles as a constituent part of a complex product (cf. Ruhl, Gemeinschaftsgeschmacksmuster, *supra*, Art. 3 note 151).
 - Consequently, items which typically have a significantly shorter life-span than the complex product as a whole are not ‘component parts’. In particular,

consumables such as water filters, printer cartridges, ballpoint pen refills, vacuum cleaner bags and light bulbs are not ‘component parts’ (cf. Ruhl, *supra*, Art. 3 note 151; Musker, [2003] EIPR 450 at 452 et seq.; see also *Canon KK v Green Cartridge Co LTD*, [1995] F.S.R. 877 at 901 and the judgement of Lord Hoffmann in *Canon KK v Green Cartridge Co LTD*, [1997] F.S.R. 817 at 826).

- Article 4(2) CDR must be construed narrowly. This follows from a fundamental general principle for the interpretation of statutes: provisions containing an exception are to be construed narrowly.
 - Further, Article 4(2) CDR is not only fulfilled if the component part is visible in each and any ‘complex product’ in which it is typically used. All ‘complex products’ to which it is typically incorporated must be considered. It suffices for protectability under the ‘visibility criterion’ when during the use of one of these complex products the component part is visible.
- 11 On 22 May 2008, the invalidity applicant submitted observations and attached European Patent Application EP 1 568 418 A2, two photos of the mounted module and two OHIM decisions. The invalidity applicant argues that the contested decision is correct. The design alternatives mentioned in the statement of grounds are not proof of an error in the Invalidity Division’s finding. None of the depicted variations is able to fit onto an application head having a projecting portion that is the counterpart to the recess of the contested RCD. Figure 4 of EP 1 568 418 A2 is either identical to the contested design or at least highly similar and the form of the contested design is a ‘must-fit’ part which exactly fits into the appropriately shaped projecting portion of the application head. The features of the contested design are solely dictated by a technical function and present a parallel between contested design and European Patent Application EP 1 568 418 A2. Regarding visibility, the invalidity applicant mentions that the contested design is not a consumable but a component part and therefore Article 4(2) CDR is applicable. Even if Article 4(2) should be construed narrowly, the features of the contested design are not visible during the normal use of the complex product.
 - 12 The invalidity applicant requests the Board to dismiss the appeal and to order the design holder to bear the costs.
 - 13 On 18 August 2008 the design holder filed a reply.
 - 14 The invalidity applicant filed a rejoinder on 21 October 2008.

Reasons

- 15 The appeal complies with Articles 55 to 57 CDR and Article 34(1)(c) and (2) of Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing

Council Regulation (EC) No 6/2002 on Community designs ('CDIR') (OJ EC 2002 No L 341, p. 28). It is therefore admissible.

The relevant legislation

- 16 Under Article 25(1)(b) CDR a Community design may be declared invalid if it does not fulfil the requirements of Articles 4 to 9CDR.
- 17 Under Article 4(1) CDR a design is to be protected as a Community design to the extent that it is new and has individual character.
- 18 Novelty is defined by Article 5 CDR in the following terms:
1. A design shall be considered to be new if no identical design has been made available to the public:
 - (a) ...
 - (b) in the case of a registered Community design, before the date of filing of the application for registration of the design for which protection is claimed, or, if priority is claimed, the date of priority.
 2. Designs shall be deemed to be identical if their features differ only in immaterial details.'
- 19 Individual character is defined by Article 6CDR:
1. A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public:
 - (a) ...
 - (b) in the case of a registered Community design, before the date of filing of the application for registration or, if a priority is claimed, the date of priority.
 2. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.'
- 20 According to Article 4(2) CDR, a design which is applied to or incorporated in a product which constitutes a component part of a complex product is to be considered to be new and to have individual character:
- (a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter; and

- (b) to the extent that those visible features of the component part fulfil in themselves the requirements as to novelty and individual character.’
- 21 ‘Normal use’ is defined by Article 4(3) CDR as ‘use by the end user, excluding maintenance, servicing or repair work’.
- 22 Article 8(1) CDR provides:
- ‘A Community design shall not subsist in features of appearance of a product which are solely dictated by its technical function.’
- 23 Article 8(2) CDR provides:
- ‘A Community design shall not subsist in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either product may perform its function.’
- 24 The respondent has challenged the validity of the contested RCD on the grounds that:
- (i) it is a component part not visible in normal use as required by Article 4(2) CDR;
 - (ii) it lacks novelty under Article 5 CDR;
 - (iii) it lacks individual character under Article 6 CDR;
 - (iv) its appearance is solely dictated by the product’s technical function within the meaning of Article 8(1) CDR;
 - (v) it is contrary to Article 8(2) CDR inasmuch as all the features of the design must necessarily be reproduced in the exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either product may perform its function.
- 25 It is convenient to examine the fourth submission first.
- 26 The interpretation of Article 8(1) CDR (and of the corresponding provision in Article 7(1) of Council Directive 98/71/EC on the legal protection of designs) is highly controversial. Similar provisions existed in the designs legislation of several Member States prior to harmonization of the law by Directive 98/71. The assumption has generally been made that the purpose of such provisions is to prevent design rights from being used to obtain monopolies over technical solutions without meeting the relatively stringent conditions laid down in patent law. Two contrasting views have been canvassed in the legal literature. One view holds that a technical necessity exception, such as that contained in Article 8(1) CDR, applies only if the technical function cannot be achieved by

any other configuration; if the designer has a choice between two or more configurations, the appearance of the product is not solely dictated by its technical function. That theory – known as the multiplicity-of-forms theory – is defended by some German authors (see, for example, P. Schramm, *Der europaweite Schutz des Produktdesigns*, Nomos Verlagsgesellschaft, Baden-Baden 2005, at p. 242 et seq., and U. Ruhl, *Gemeinschaftsgeschmacksmuster: Kommentar*, Carl Heymanns Verlag, Köln-Berlin-München 2007, at p. 169 et seq.) and was formerly followed by the French courts (see D. Cohen, *Le droit des dessins et modèles*, 2nd edition, Economica, Paris 2004, at p. 22). Advocate General Ruiz-Jarabo suggested in *Philips v Remington* (Case C-299/99, [2002] ECR I-5475, at paragraph 34 of the Opinion) that Article 7(1) of the Designs Directive (and therefore obviously Article 8(1) CDR) should be interpreted in that manner. He stated:

‘... a functional design may, none the less, be eligible for protection if it can be shown that the same technical function could be achieved by another different form.’

The Advocate General’s comment is clearly an *obiter dictum* since *Philips v Remington* was a case on the interpretation of Article 3(1)(e)(ii) of Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (‘TMD’). Article 3(1)(e)(ii) TMD excludes from trade mark protection ‘signs which consist exclusively of the shape of goods which is necessary to obtain a technical result’.

- 27 The multiplicity-of-forms theory has been adopted by courts in the United Kingdom (see the judgment of 28 July 2006 of the Court of Appeal in *Landor & Hawa International Ltd v Azure Designs Ltd* [2006] EWCA Civ 1285) and Spain (Juzgado de lo Mercantil PTO Número Uno de Alicante, Auto No 267/07, 20 November 2007, in *Silverlit Toys Manufactory Ltd v Ditro Ocio 2000 SL and others*).
- 28 There is none the less 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. That purpose, as was noted above, is to prevent design law from being used to achieve monopolies over technical solutions, the assumption being that such monopolies are only justified if the more restrictive conditions imposed by patent law (and in some countries by the law of utility models) are complied with. If a technical solution can be achieved by two alternative methods, neither solution is, according to the multiplicity-of-forms theory, solely dictated by the function of the product in question. This would mean that both solutions could be the subject of a design registration, possibly held by the same person, which would have the consequence that no one else would be able to manufacture a competing product capable of performing the same technical function (see W. Cornish and D. Llewelyn, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights*, 5th edition, London, Sweet & Maxwell 2003, at p. 549). The multiplicity-of-forms theory would, if accepted, deprive Article 8(1) CDR of any purpose and

content. That provision might just as well be deleted from the regulation since its field of application, at least as a ground of invalidity in conjunction with Article 25(1)(b), would be reduced to virtually zero. There are very few features of a product's appearance that have to be exactly the way they are in order for the product to achieve its technical function. A vehicle wheel must be round, a television screen must be rectangular, and there are doubtless other examples of particular features for which there is no alternative design. But it is hard to think of a product of which it can truly be said that all its essential features can have only one form if the product is to perform its function. This leads to the conclusion that the multiplicity-of-forms theory cannot be correct.

- 29 The principal alternative, discussed by academic authors, to the multiplicity-of-forms theory has its origin in English case law. The case of *Amp v Utilux* [1971] FR 572 concerned the interpretation of a provision of the Registered Designs Act 1949 which denied protection to the features of a design that were solely dictated by a product's technical function. The House of Lords held that a product's configuration was solely dictated by its technical function if every feature of the design was determined by technical considerations. The striking similarity between section 1(3) of the 1949 Act and Article 8(1) CDR does not of course mean that the approach of the House of Lords in *Amp v Utilux* must necessarily be adopted in relation to the Community provision. Indeed, as was noted above in paragraph 27, the multiplicity-of-forms theory has now been adopted by the English Court of Appeal in *Landor & Hawa International v Azure Designs*. Thus the Court of Appeal must have thought that the approach taken in *Amp v Utilux* was no longer valid, following harmonization, in spite of the similar wording of the Community provisions and the 1949 Act. The approach taken in *Amp v Utilux* would, however, have the advantage of allowing the purpose of Article 8(1) CDR to be achieved. No one would be able to shut out competitors by registering as Community designs the handful of possible configurations that would allow the technical function to be realised. This may explain why the French courts, which formerly espoused the multiplicity-of-forms theory, began to abandon that theory at the beginning of the 21st century in favour of an interpretation which closely resembles the *Amp v Utilux* approach (see the judgments cited by Cohen, *op. cit.*, at pp. 23-24).
- 30 In addition to being supported by a teleological interpretation, the approach discussed in the previous paragraph is also supported by the wording of Article 8(1) CDR. That provision denies protection to features of a product's appearance that are 'solely dictated by its technical function'. Those words do not, on their natural meaning, imply that the feature in question must be the only means by which the product's technical function can be achieved. On the contrary, they imply that the need to achieve the product's technical function was the only relevant factor when the feature in question was selected. The multiplicity-of-forms theory totally neglects the wording of Article 8(1) CDR. The adverb 'solely' qualifies the phrase 'dictated by its technical function'; thus Article 8(1) applies if the feature in question has been dictated by the product's technical function and by no other consideration, such as the need to design a product that not only works but also looks good. Those authors who base the multiplicity-of-forms theory on a literal reading of Article 8(1) CDR construe that provision as if it read: 'A Community design shall not subsist in features of

appearance of a product which have the sole form capable of performing its technical function.’ In fact, the appellant’s interpretation would be easier to sustain if the word ‘solely’ was not in Article 8(1) at all. Then it might be possible to argue that the word ‘dictated’ implies that the technical function of the product cannot be achieved by an alternative design. The word ‘solely’ is however in the text of the provision and cannot be ignored. This textual argument applies with equal force to the English, French, German, Italian and Spanish language versions.

- 31 There is, moreover, a significant difference between the wording of Article 8(1) CDR and Article 7(1) of the Designs Directive, on the one hand, and Article 7(1)(e)(ii) CTMR and Article 3(1)(e)(ii) TMD, on the other. Notwithstanding the view expressed by the Advocate General in *Philips v Remington*, the wording of the trade mark provisions is easier to accommodate with the multiplicity-of-forms theory. It is possible to argue that a shape is not necessary in order to obtain a technical result when the same result can be obtained by an alternative shape. However, the mere fact that a design alternative exists does not mean that a product’s appearance has been dictated by anything other technical considerations.
- 32 Good design involves two fundamental elements: the product must perform its function and it should be pleasant to look at. In the case of some products, such as pictures and ornaments, their whole purpose is to please the eye. In the case of other products, such as the internal working parts of a machine, the visual appearance is irrelevant. That is why the Community design legislation denies protection to component parts that are not visible in normal use. In the case of most products the designer will be concerned with both the functional and the aesthetic elements. That applies also to items of industrial equipment, such as fluid distribution equipment. A machine must, in the first place, perform its function effectively and safely and without creating excessive noise, but it is also desirable that the machine should be pleasing to the eye and thus enhance the working environment of the people who operate it and see it in use. For that reason there is no objection in principle to granting design protection to industrial products whose overall appearance is determined largely, but not exclusively, by functional considerations.
- 33 It is often pointed out that the Community design legislation, unlike the old laws of some Member States, does not lay down any requirement of aesthetic merit, artistic creativity or eye appeal. The absence of such a requirement is expressly mentioned in the 10th recital in the preamble of Regulation No 6/2002 and in the 14th recital in the preamble to Directive No 98/71. Some authors infer from this that purely functional designs are protectable. That is a false analysis. Community design law is concerned with the visual appearance of products. That is clear from the definition of ‘design’ in Article 3(a) CDR and from the requirement of visibility in normal use for component parts in Article 4(2)(b) CDR. Those parts of a product that cannot be seen are of no concern to the Community law of designs because no one cares what they look like. All that matters is that such parts perform their function. If the law were intended to protect purely functional designs it would not be logical to exclude the non-visible aspects of design from protection.

- 34 The significance of limiting protection to the visual appearance of products is that aesthetic considerations are in principle capable of being relevant only when the designer is developing a product's visual appearance. Most of the time the designer will be concerned with both elements of good design: functionality and eye appeal. In some cases functionality will be the dominant preoccupation of the designer. The need to make a product that works will be uppermost in the designer's mind and will largely determine the appearance of the product. As long as functionality is not the only relevant factor, the design is in principle eligible for protection. It is only when aesthetic considerations are completely irrelevant that the features of the design are solely dictated by the need to achieve a technical solution. This is not, it must be stressed, tantamount to introducing a requirement of aesthetic merit into the legislation. It is simply recognition of the obvious fact that when aesthetics are totally irrelevant, in the sense that no one cares whether the product looks good, bad, ugly or pretty, and all that matters is that the product functions well, there is nothing to protect under the law of designs.
- 35 It follows from the above that Article 8(1) CDR denies protection to those features of a product's appearance that were chosen exclusively for the purpose of designing a product that performs its function, as opposed to features that were chosen, at least to some degree, for the purpose of enhancing the product's visual appearance. It goes without saying that these matters must be assessed objectively: it is not necessary to determine what actually went on in the designer's mind when the design was being developed. The matter must be assessed from the standpoint of a reasonable observer who looks at the design and asks himself whether anything other than purely functional considerations could have been relevant when a specific feature was chosen.
- 36 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.
- 37 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. In the application that led to the registration of the contested RCD the design holder described the product as 'an intake portion of a liquid dispensing valve'. The Office objected to that term on the ground that it did not figure in the Locarno Classification. The design was therefore registered in respect of 'fluid distribution equipment' but the original description was also mentioned when the contested RCD was published in the Community Designs Bulletin.

- 38 More precise information about the nature of the product into which the design is to be incorporated can be found in the documents supplied by the design holder along with its observations of 13 March 2007. The product (described as a 'module') is part of a 'hot-melt gun'. The module is connected to a manifold and the purpose of the whole system is to apply glue evenly over the surface of some article that has to be stuck to another object. The glue is either solid or highly viscous and has to be heated before it can be used: hence the name 'hot-melt gun'.
- 39 On 8 February 2005 the design holder filed a European patent application (EP 1 568 418 A2) in respect of a 'method and system for supporting and/or aligning components of a liquid dispensing system'. A number of drawings were attached to the application, including the following:

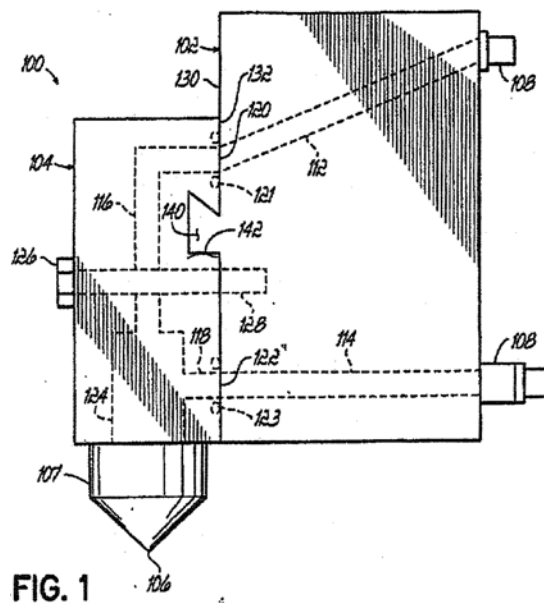


FIG. 1

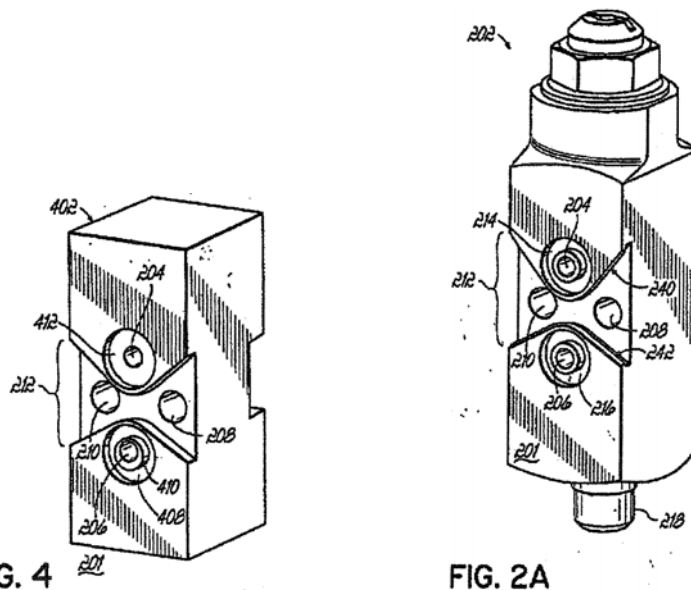


FIG. 4

FIG. 2A

- 40 The patent application contained a typically detailed description of the claimed invention. The following extracts are of interest for the present proceedings:

‘The present invention generally relates to liquid dispensing systems having separate components that are coupled together and, more particularly, to the manners in which such components are fastened together.’

‘A dispensing module that includes the dispensing orifice is usually connected to the manifold block, sometimes referred to as a gun body or gun manifold, by way of screws or bolts that extend through the module and into threaded holes in the face of the gun manifold. In order for the liquid dispensing system to operate properly, this connection of the manifold with the module must be accomplished so that fluid or liquid ports on each of the manifold and module are properly aligned so as to provide leak-proof fluid communication between the two subassemblies or components. In the case of a pneumatically operated module and/or one which provides air-assisted liquid dispensing, cross-connection of an air port with an adhesive port must be avoided. Connecting the two subassemblies entails placing the module steady, threading the connecting bolts through the module into the manifold. Misalignment may cause the adhesive to leak from the gun onto a conveying system and/or substrate as well as to leak into the air section of the module.’

‘The invention is generally directed to an apparatus for dispensing liquid thermoplastic material, such as hot melt adhesive, including at least a first component which is configured for easier attachment and removal with respect to a second component of a dispensing system. More particularly, the first component includes a first side and at least one passageway for receiving the liquid thermoplastic material. The passageway includes an opening on the first side and the first component further includes a first interactive surface on the first side and configured as one of a recessed portion extending only partially into the first component or a projecting portion configured to extend only partially into the second component. The first interactive surface is adapted to cooperate with the second interactive surface on the second component and thereby either at least partially supports the first component on the second component or at least partially supports the second component on the first component, depending on which component receives the other component.’

‘Screw holes 208, 210 are included to permit the module 202 to be attached to the gun manifold. The rear face 201 of the exemplary module 202 of FIG. 2A includes a port 204 to an air passageway and a port 206 to a liquid passageway. In this particular example, each port 204, 206 has a surrounding indentation 214, 216, respectively, that accommodates an O-ring (not shown) between the module 202 and the manifold.’

‘The top curved portion 240 and the bottom curved portion 242 may have the same or may have different radii of curvature. As illustrated in FIGS. 2A-2C, the curved portions 240, 242 have different radii of curvature. Accordingly, the complementary projecting portion of the manifold (not shown) will have appropriately shaped complimentary curved portions. As a result of this asymmetry, the module 202 will properly mate with the manifold in only one orientation. Thus, the recessed portion 212 of the module 202 can be considered ‘keyed’ such that it operates to correctly orient the module 202 and, thereby,

prevent an operator from inadvertently flipping the module 202 when attaching it to a manifold. The curved portions 240, 242 also act to properly align the module 202 with the gun manifold. Because of the curved shape, the module is urged towards proper side-to-side alignment. Thus, the openings 204 and 206 will be aligned with their corresponding openings on the gun manifold. Similarly, the bolt holes 208, 210 will be properly aligned as well.'

- 41 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.
- 42 Throughout the proceedings the design holder has argued that none of the essential features of the design needs to be exactly as it is in order for the product to perform its technical function. For example, in its observations of 13 March 2007 the design holder argued that the assumption that screw holes 208 and 210 (referred to as 'bores') had a technical function did not mean that they had a solely technical function. The appellant went on to state:

'The position of the bores on the product, in particular the position with respect to the other openings is not solely due to technical reasons. Rather, the position of the bores could be varied and changed without influencing the mechanical function of the bore in connection with the bolts which extend through the bores. The location of these bores and the position of each individual bore with respect to the other bores has a design quality. In other words, the location of these holes have been determined by design considerations to be in this particular location [sic].

Others are free to locate mounting holes in other locations. The fact that these bores may also have a functional characteristic does not necessarily mean that they cannot be protected as a design. The location and arrangement of these holes is part of the overall design appearance of the registered design.'

- 43 The design holder argues, in the same vein, that each feature of the contested RCD's appearance could be altered in some way or other without preventing the product from performing its function properly. For each feature the design holder proposes a 'design alternative'. On that basis it contends that none of the features of the product's appearance is solely dictated by its technical function. This theory of the design alternative is of course simply another name for the multiplicity-of-forms theory discussed above. As was pointed out earlier, there are two major weaknesses in the theory. First, it is not supported by the wording of Article 8(1) CDR (see paragraphs 30 and 31 above); secondly, it would undermine the purpose of that provision (see paragraph 28 above).

- 44 It is true that there is no ban on the protection of designs that lack any aesthetic quality. Such a requirement is not imposed because it is notoriously difficult to make an objective evaluation of aesthetic merit. Article 7(1) of the Directive and Article 8(1) CDR deny protection to certain designs, not because they lack aesthetic merit but because aesthetic considerations play no part in the development of the designs, the sole imperative being the need to design a product that performs its function in the best possible manner. That may fairly be said of the contested RCD. No one cares whether such a product looks good, bad or indifferent because no one spends much time looking at it. All that matters is that the product performs its function properly. Every essential feature of the design has been chosen with a view to achieving the best possible technical performance. Those features were therefore solely dictated by the product's technical function. It follows that the contested RCD must be declared invalid under Article 25(1)(b) in conjunction with Article 8(1) CDR.
- 45 In view of the finding reached above it is not necessary to examine the other grounds of invalidity invoked by the respondent.
- 46 It follows that the appeal must be dismissed since the Invalidity Division rightly declared the contested RCD invalid. The fact that the contested decision was based on Article 25(1)(b) CDR in conjunction with Article 8(2) CDR, whereas the Board has founded its decision on Article 25(1)(b) CDR in conjunction with Article 8(1) CDR has no bearing on the outcome.

Costs

- 47 Since the appeal has been unsuccessful, the design holder must be ordered to bear the costs of the appeal proceedings, in accordance with Article 70 CDR.

Order

On those grounds,

THE BOARD

hereby:

- 1 Dismisses the appeal;**
- 2 Orders the appellant to bear the costs.**

Th. Margellos

D.T. Keeling

M. Bra

Registrar:

J. Pinkowski