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Lego building blocks design – valid or invalid?

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Introduction

The General Court (GC) recently lifted a Board of Appeal (BoA) decision that had declared a Community design for Lego building blocks invalid (24 March 2021, T-515/19). The GC found that:

- the BoA had failed to identify all of the appearance features of the Lego building block without which a decision on invalidity could not be passed; and
- the exception for products within a modular system may have applied (article 8(3) of the EC Community Designs Regulation (6/2002)).

The GC further noted that the burden of proof as to the purely technical function of a design lies with the applicant for a declaration of invalidity.

Facts

Lego is the owner of a Community design for "building blocks from a toy building set".



Figure 1: Lego Community design

Delta Sport Handelskontor filed an application for a declaration of invalidity, arguing that the design was exclusively dictated by the product's technical function – namely, the assembly with (and disassembly from) other building blocks from a given set.

EUIPO decision

The EU Intellectual Property Office (EUIPO) Cancellation Division rejected the application, arguing that the applicant had failed to prove that functionality was the only factor determining the appearance of the building blocks. It held that the building set corresponded to the definition of a modular system and that it was inappropriate to exclude the contested design from protection on grounds of interoperability.

BoA decision

Upon the applicant's appeal, the BoA annulled the Cancellation Division's decision and declared the contested design invalid, following the applicant's line of reasoning. It had identified the following appearance features of the product:

- the row of studs on the upper face of the brick;
- the row of smaller circles on the lower face of the brick;
- the two rows of bigger circles on the lower face of the brick;
- the rectangular shape of the brick;
- the thickness of the walls of the brick; and
- the cylindrical shape of the studs.

Lego filed an action against this decision with the GC.

GC decision

The GC annulled the BoA's decision. The GC started by referring to the European Court of Justice's decision in *DOCERAM* (C-395/16), which held that the assessment of a Community design for the purposes of article 8(1) of the EC Community Designs Regulation comprises the following three steps:

- determination of the technical function of the product concerned;
- analysis of the appearance features of that product within the meaning of article 8(1) of EC Regulation 6/2002; and
- examination in light of all of the relevant objective circumstances of whether those features are solely dictated by the technical

function of the product concerned.

A design falls under article 8(1) of the EC Community Designs Regulation if the need to fulfil a technical function is the only factor that determined the choice by the designer and considerations of another nature – in particular, those relating to the visual aspect of the product concerned – do not play a role.

The GC pointed out that if at least one of the features of the contested design's appearance was not solely dictated by the technical function of that product, the design could not be declared invalid under article 8(1) of the EC Community Designs Regulation. Since the BoA had not included the smooth surface of the upper face of the building block among the features, it identified that a declaration of invalidity was not (yet) possible as this unidentified feature could be one that did not have a technical function. The GC rejected the EUIPO's argument put forward in the oral hearings that the absence of studs, necessarily resulting in a smooth surface, was in fact of a technical character. It referred to the BoA's decision, which had not contained any such considerations. The GC stressed that a decision had to be self-sufficient and the reasons on which it was based could not be stated in subsequent written or oral explanations.

The GC also rejected the BoA's opinion that Lego could not rely on the exemption provision of article 8(3) of the EC Community Designs Regulation because the invalidity applicant had relied only on article 8(1) thereof and Lego had referred to the applicability of the exemption provision of article 8(3) for the first time before the BoA. The GC noted that some of the features of a contested design may fall within the scope of both articles 8(1) and 8(2) of the EC Community Designs Regulation. Where some features fall under article 8(2), the design owner must be able to rely on article 8(3) even if the invalidity applicant has based its application only on article 8(1).

According to the GC, Lego's reliance on article 8(3) before the BoA for the first time was admissible because article 8(3) is not expressly covered by article 27(3) of EU Regulation 2018/625/EU (this provision refers to three specific types of claims which must be raised in the first-instance proceedings).

Comment

The GC's decision clarifies that articles 8(1) and 8(2) of the EU Community Designs Regulation are to be interpreted narrowly. Since the GC also stressed that it is up to the invalidity applicant to prove that a design subsists purely of appearance features that are dictated by its technical function, invalidity applicants will have to ensure that their application covers all features of the product's appearance, including those whose technical function result from their absence. However, proving that something does not exist is notoriously difficult.

Further, the Court (rightly) barred invalidity applicants from the possibility of relying only on article 8(1) of the EU Community Designs Regulation in an attempt to circumvent the applicability of the exception under article 8(3) thereof.

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