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Lingua del documento : ECLI:EU:T:2021:155

JUDGMENT OF THE GENERAL COURT (Second Chamber)

24 March 2021 (*)

(Community design – Invalidity proceedings – Registered community design representing a building block from a toy building set – 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 – Features of appearance of a product to be necessarily reproduced in their exact form and dimensions in order to permit the interconnection with other products – Designs whose purpose is to allow multiple assembly or connection of mutually interchangeable products within a modular system – Article 8(1) to (3) of Regulation No 6/2002)

In Case T-515/19,

Lego A/S, established in Billund (Denmark), represented by V. von Bomhard and J. Fuhrmann, lawyers, applicant,

v

European Union Intellectual Property Office (EUIPO), represented by S. Hanne, acting as Agent, defendant,

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

Delta Sport Handelskontor GmbH, established in Hamburg (Germany), represented by C. Klawitter and L.-E. Appel, lawyers,

ACTION brought against the decision of the Third Board of Appeal of EUIPO of 10 April 2019 (Case R 31/2018-3) relating to invalidity proceedings between Delta Sport Handelskontor and Lego

THE GENERAL COURT (Second Chamber),

composed of V. Tomljenović, President, F. Schalin and I. Nömm (Rapporteur), Judges,

Registrar: A. Juhász-Tóth, Administrator,

having regard to the application lodged at the Court Registry on 19 July 2019,

having regard to the response of EUIPO lodged at the Court Registry on 10 October 2019,

having regard to the response of the intervener lodged at the Court Registry on 1 October 2019,

having regard to the Court's written questions to the parties of 15 May 2020,

further to the hearing on 23 September 2020,

gives the following

Judgment

I. Background to the dispute

1 On 2 February 2010, the applicant, Lego A/S, filed an application for registration of a Community design with the European Union Intellectual Property Office (EUIPO), pursuant to Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1).

2 The Community design for which registration has been applied and which is contested in this case is represented in the following views:

3 The goods to which the contested design is intended to be applied are in Class 21.01 of the Locarno Agreement of 8 October 1968 establishing an International Classification for Industrial Designs, as amended, and correspond to the following description: 'building blocks from a toy building set'.

4 The contested design was registered on 2 February 2010 as a Community design under No 1664368-0006 and published in *Community Designs Bulletin* No 32/2010 of 11 February 2010.

5 On 8 December 2016, the intervener, Delta Sport Handelskontor GmbH, filed an application for a declaration of invalidity of the contested design pursuant to Article 52 of Regulation No 6/2002.

6 The ground relied on in support of the application was that laid down in Article 25(1)(b) of Regulation No 6/2002, read in conjunction with Articles 4 to 9 of that regulation. In particular, the intervener claimed that all the features of appearance of the product concerned by the contested design were solely dictated by the technical function of the product and, for that reason, were excluded from protection pursuant to Article 8(1) of that regulation.

7 On 30 October 2017, EUIPO's Cancellation Division rejected the application for a declaration of invalidity. In particular, it found that the technical function of the building block was to be interconnected with other building blocks for the purpose of playing, and the intervener had failed to prove that fulfilling that function was the only factor which had determined the features of appearance of the product concerned by the contested design. In order to refute the intervener's argument that the freedom of the designer of building blocks is limited, in the present case, on account of the interoperability of the elements, the Cancellation Division observed, inter alia, that the building set corresponded to the definition of a modular system and that it was not appropriate to exclude the contested design from protection on grounds of interoperability.

8 On 5 January 2018, the intervener filed a notice of appeal with EUIPO, pursuant to Articles 55 to 60 of Regulation No 6/2002, against the decision of the Cancellation Division.

9 By decision of 10 April 2019 ('the contested decision'), the Third Board of Appeal of EUIPO upheld the appeal and annulled the decision of the Cancellation Division and declared the contested design invalid.

10 In essence, it found that all the features of appearance of the product concerned by the contested design were solely dictated by the technical function of the product, namely to allow assembly with, and disassembly from, the rest of the bricks of the set.

11 In the first place, the Board of Appeal observed that the product concerned by the contested design was a building block that is part of a larger set of bricks and was intended to be assembled with other bricks of the set to build objects. The technical function that that brick must fulfil is, therefore, the capability of being assembled, with sufficient stability, with other bricks of the set in order to create a toy building.

12 In the second place, it identified the features of appearance of the product: namely (i) the row of studs on the upper face of the brick; (ii) the row of smaller circles on the lower face of the brick; (iii) the two rows of bigger circles on the lower face of the brick; (iv) the rectangular shape of the brick; (v) the thickness of the walls of the brick; and (vi) the cylindrical shape of the studs.

13 In the third place, the Board of Appeal found that all the features identified by it and approved by the applicant were solely dictated by the technical function of the building brick, namely assembly with, and disassembly from, the rest of the bricks of the set. It also noted that the applicant, whilst disputing that the features of appearance are solely dictated by the technical function, did not cite a single consideration other than the technical consideration that might have determined the visual aspect of those features.

14 In response to the applicant's argument that no objective facts or evidence demonstrating that the features of the product concerned by the contested design are solely technical have been adduced in the present case, the Board of Appeal stated that the intervener had submitted, before both the Cancellation Division and the Board of Appeal, convincing explanations, supported by illustrations, as to how the bricks of the set are assembled together and how each of the features of their appearance make it possible for those bricks to be assembled and disassembled.

15 In addition, the Board of Appeal took the view that the findings of the Grand Board of Appeal, upheld by the General Court (judgment of 12 November 2008, *Lego Juris v OHIM – Mega Brands (Red Lego Brick)*, T-270/06, EU:T:2008:483) and the Court of Justice (judgment of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516), in the case relating to trade mark application No 107 029 could be transposed *mutatis mutandis* to the contested design, in view of the fact that the features of appearance of the brick that the applicant attempted to register as a three-dimensional mark were also present in the brick in which the contested design is to be incorporated.

II. Forms of order sought

16 The applicant claims that the Court should:

- annul the contested decision;
- uphold the decision of the Cancellation Division rejecting the application for a declaration of invalidity;
- order EUIPO and the intervener to pay the costs.

17 EUIPO and the intervener contend that the Court should:

- dismiss the action;
- order the applicant to pay the costs.

III. Law

A. Admissibility of Annex A-14 to the application

18 The intervener contends that Annex A-14 to the application is adduced for the first time before the Court. It states that that evidence must be rejected on the ground that it is not the General Court's function to review the facts in light of documents produced for the first time before it.

19 In that regard, it should be borne in mind that the purpose of actions before the General Court is to review the legality of decisions of the Boards of Appeal of EUIPO within the meaning of Article 61 of Regulation No 6/2002, so it is not the Court's function to review the facts in the light of evidence produced for the first time before it (see judgment of 24 October 2019, *Atos Medical v EUIPO – Andreas Fahl Medizintechnik-Vertrieb (medical plasters)*, T-559/18, not published, EU:T:2019:758, paragraph 18 and the case-law cited).

20 In the present case, it should be noted that Annex A-14 to the application contains two decisions of the Third Board of Appeal dated 9 June 2017 and 4 April 2019 concerning invalidity proceedings relating to another design of which the applicant is the proprietor, which corresponds to a brick of the set with a single stud on the upper face.

21 Those documents, although produced for the first time before the Court, are not evidence strictly speaking for the purposes of, inter alia, Article 85 of the Rules of Procedure of the General Court; rather, they relate to the decision-making practice of EUIPO, to which a party may refer for the first time before the Court, even where that practice post-dates the proceedings before EUIPO (see, to that effect and by analogy, judgment of 26 October 2017, *Alpirsbacher Klosterbräu Glauner v EUIPO (Klosterstoff)*, T-844/16, EU:T:2017:759, paragraph 57 and the case-law cited). It follows that the decisions of EUIPO, submitted in Annex A-14 to the application, are admissible in the present case.

B. First head of claim seeking annulment of the contested decision

22 In support of its first head of claim seeking annulment of the contested decision, the applicant raises three pleas in law alleging, first, infringement of Article 8(3) of Regulation No 6/2002, second, infringement of Article 8(1) of the Regulation and, third, infringement of Article 62 of that regulation.

1. Infringement of Article 8(3) of Regulation No 6/2002

23 In its first plea in law, the applicant claims that the contested decision fails to mention Article 8(3) of Regulation No 6/2002, even though the applicant relied on that provision during the proceedings before the Board

of Appeal. Consequently, that plea must be regarded as alleging an error of law relating to the Board of Appeal's refusal to apply Article 8(3) of Regulation No 6/2002.

24 The applicant claims that the contested design falls within the exception referred to in Article 8(3) of Regulation No 6/2002 and it could therefore not be declared invalid in the present case. In its view, that provision should be interpreted as an exception to Article 8(1) of Regulation No 6/2002, either directly or via Article 8(2) of that regulation. If it were held that Article 8(3) of Regulation No 6/2002 constitutes an exception only to Article 8(2) of that regulation and that that provision was not a *lex specialis* in relation to Article 8(1) of that regulation, Article 8(2) and (3) would be rendered ineffective in contradiction with the objective of the legislation, namely the protection of modular systems. By the first part of the second plea, it submits that Article 8(1) of Regulation No 6/2002 was not applicable in the present case.

25 EUIPO rejects the applicant's arguments and contends, primarily, that Article 8(3) of Regulation No 6/2002 was inapplicable to the present case and, in the alternative, that, even if that provision were applicable, reliance on it by the applicant for the first time before the Board of Appeal was, in any event, out of time.

26 In particular, EUIPO submits that the intervener's application for a declaration of invalidity was based solely on Article 8(1) of Regulation No 6/2002, with the result that the Cancellation Division could not examine compliance with Article 8(2) of that regulation without infringing Article 63(1) of that regulation. While accepting that certain features of appearance solely dictated by a technical function within the meaning of Article 8(1) of Regulation No 6/2002 may constitute a mechanical fitting for the purposes of Article 8(2) of that regulation, it submits that the latter provision is nonetheless not automatically applicable in addition to the provision invoked by the intervener. At the hearing, EUIPO added that the exception provided for in Article 8(3) of Regulation No 6/2002 refers to mechanical fittings for which visual considerations have played a role and which, therefore, do not fall within Article 8(1) of that regulation.

27 For its part, the intervener contends, in essence, that Article 8(3) of Regulation No 6/2002 does not apply in the present case, with the result that there is no need to consider whether that provision is *lex specialis* in relation to Article 8(1) of that regulation. In particular, it argues that the exception laid down in Article 8(3) of Regulation No 6/2002 is intended to protect products forming a modular system as a whole, whereas the product into which the contested design is incorporated is not a product as a whole, that is to say the entire toy building set, but only a minor part of it.

28 It must be noted that, according to Recital 10 of Regulation No 6/2002, technological innovation should not be hampered by granting design protection to features solely dictated 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, the 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.

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

30 For its part, Article 8(2) of Regulation No 6/2002 provides that a Community design will 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 ('features of interconnection').

31 As for Article 8(3) of Regulation No 6/2002, it is the expression of Recital 11 of that regulation according to which the mechanical fittings of modular products may nevertheless constitute an important element of the innovative characteristics of modular products and present a major marketing asset, and therefore should be eligible for protection.

32 Thus, according to that provision, notwithstanding paragraph 2, a Community design must, under the conditions set out in Articles 5 and 6, subsist in a design serving the purpose of allowing the multiple assembly or connection of mutually interchangeable products within a modular system.

33 In that regard, it should be noted that Article 8(3) of Regulation No 6/2002 is an exception to Article 8(2) of that regulation which makes it possible to protect designs covering products which form part of a modular system despite their possible features of interconnection.

34 It must be noted that, in support of its application for a declaration of invalidity, based on Article 25(1)(b) of Regulation No 6/2002, the intervener relied on Article 8(1) of that regulation. The Board of Appeal, unlike the Cancellation Division, found that all the features of appearance of the product concerned by the contested design were solely dictated by the technical function of that product. That technical function is to allow assembly with, and disassembly from, other bricks of the set.

35 In that regard, it should be noted that the Cancellation Division, without having assessed the conditions for the application of Article 8(2) and Article 8(3) of Regulation No 6/2002, found that the product covered by the contested design constituted an element of a modular system. In doing so, the Cancellation Division suggested that the contested design could fulfil the requirements for protection of Article 8(3) of Regulation No 6/2002.

36 Similarly, the applicant, in its observations on the intervener's statement of grounds of the appeal, lodged before the Board of Appeal, citing the findings of the Cancellation Division's decision, relied on the benefit of Article 8(3) of Regulation No 6/2002.

37 The fact remains that the Board of Appeal did not examine the relevance of Article 8(3) of Regulation No 6/2002, which was, however, relied on by the applicant before it.

38 Thus, in the present case, it is necessary to examine whether the Board of Appeal should have assessed the conditions for the application of Article 8(3) of Regulation No 6/2002. In order to do so, before considering whether the features of appearance of the product concerned by the contested design may fall within the exception laid

down in Article 8(3) of Regulation No 6/2002, it is necessary to examine whether the benefit of Article 8(3) of Regulation No 6/2002 could be relied on for the first time before the Board of Appeal.

(a) Lateness of the applicant's reliance on Article 8(3) of Regulation No 6/2002

39 As a preliminary point, it must be found, as observed by EUIPO, that it is for the proprietor of the contested design to rely on the benefit of Article 8(3) of Regulation No 6/2002. It should be borne in mind that that provision lays down an exception to Article 8(2) of that regulation, excluding from the scope of that provision the features of interconnection of designs, which, while satisfying the conditions set out in Articles 5 and 6 of that regulation, allow the multiple assembly or connection of mutually interchangeable products within a modular system.

40 However, the question of at what stage of the administrative procedure the proprietor of a contested design may rely on the benefit Article 8(3) of Regulation No 6/2002 arises and, in particular, whether he can do so for the first time before the Board of Appeal.

41 In that regard, EUIPO submits that Article 8(3) of Regulation No 6/2002 must necessarily be relied on by the proprietor of the contested design, since it constitutes a 'defence', and that provision cannot be relied on, for the first time, before the Board of Appeal. It refers to Article 108 of Regulation No 6/2002, according to which the rules of procedure of the Boards of Appeal are to apply to appeals heard by those Boards under that regulation. Thus, the rules of procedure of the Boards of Appeal are Commission Delegated Regulation (EU) 2018/625 of 5 March 2018 supplementing Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark, and repealing Delegated Regulation (EU) 2017/1430 (OJ 2018 L 104, p. 1). EUIPO refers, in particular, to Article 27(3) of that regulation, which states that the examination of the appeal is to relate to the claims or requests raised in due time before the first instance in order for the Board of Appeal to be able to consider them.

42 In response to the written question put by the Court, the applicant argued, at the hearing, that reliance on Article 8(3) of Regulation No 6/2002 before the Board of Appeal was not out of time, since there is no time limit for invoking that provision. It argued, *inter alia*, that the scope of Article 27(3) of Regulation 2018/625 is very limited in that it applies only to the specific cases referred to in that provision, which do not include Article 8(3) of Regulation No 6/2002. Consequently, an interpretation by analogy is not possible in the present case. Finally, the applicant took the view that Article 27(4) of Regulation 2018/625 also did not apply in the present case.

43 The intervener, for its part, submits that Article 8(3) of Regulation No 6/2002 must be relied on in good time before the first instance and its reliance by the applicant, in the present case, was out of time both pursuant to Article 27(3) of Regulation 2018/625 and to a broad application of Article 27(4) of that regulation, which are applicable in the present case under Article 108 of Regulation No 6/2002. It adds that, in order to benefit from Article 8(3) of Regulation No 6/2002, the proprietor of the contested design must demonstrate the novelty and individual character of that design. In its view, the production of evidence to that effect for the first time before the Board of Appeal would delay, disproportionately, the proceedings before that board.

44 In that regard, it should be noted that, admittedly, under Article 108 of Regulation No 6/2002, the provisions of Regulation 2018/625 relating to proceedings before the Boards of Appeal are also applicable to appeals against the decisions referred to in Article 55 of Regulation No 6/2002.

45 However, the fact remains that Article 8(3) of Regulation No 6/2002 is not expressly covered by the provisions of Regulation 2018/625 and in particular by Article 27(3) thereof. That latter provision refers to three specific types of claims or requests which must be raised in due time in proceedings before the instance of EUIPO which adopted the decision subject to appeal. Requests relating to the application of Article 8(3) of Regulation No 6/2002 are not covered by that provision, with the result that it cannot be applicable to the circumstances of the present case.

46 The same is true of Article 27(4) of Regulation 2018/625, relating to the admission of facts or evidence submitted for the first time before the Board of Appeal. In that regard, it is sufficient to consider that reliance on the exception referred to in Article 8(3) of Regulation No 6/2002 cannot under any circumstances be regarded as a fact or evidence for the purposes of Article 27(4) of Regulation 2018/625, with the result that the latter regulation is manifestly inapplicable in the present case.

47 Accordingly, it must be held that no provision of Regulation No 6/2002 precludes the benefit of the exception laid down in Article 8(3) of that regulation from being relied on, for the first time, before the Board of Appeal, in response to the decision of the Cancellation Division or to the statement of grounds of the appeal before that board of the other party to the proceedings.

48 It must be observed, in that regard, that, according to Article 60(1) of Regulation No 6/2002, following the examination as to the merits of the appeal, the Board of Appeal is to decide that appeal and, in doing so, it may exercise any power within the competence of the department which was responsible for the contested decision, that is to say, in the present case, itself give a decision on the application for a declaration of invalidity by rejecting it or declaring it to be founded, thereby upholding or reversing the decision contested before it. It follows from that provision that, through the effect of the appeal against a decision of the Cancellation Division, the Board of Appeal may carry out a new, full examination of the merits of the application for a declaration of invalidity of the contested design, in terms of both law and fact (see, to that effect, judgment of 27 June 2013, *Beifa Group v OHIM – Schwan-Stabilo Schwanhäuser (Instruments for writing)*, T-608/11, not published, EU:T:2013:334, paragraph 37 and the case-law cited). Consequently, the Board of Appeal has jurisdiction, *inter alia*, to rule on the claims of the proprietor of the contested design relating to the benefit of Article 8(3) of Regulation No 6/2002.

49 The Board of Appeal cannot be deprived of that jurisdiction merely because the proprietor of the contested design has chosen to claim the benefit of Article 8(3) of Regulation No 6/2002, for the first time, at the stage of appeal proceedings (see, to that effect and by analogy, judgment of 18 October 2016, *Raimund Schmitt Verpachtungsgesellschaft v EUIPO (Brauwelt)*, T-56/15, EU:T:2016:618, paragraph 120).

50 In the light of all those factors, and since neither Regulation No 6/2002 nor the rules of procedure of the Boards of Appeal specify the conditions for the application of Article 8(3) of that regulation, it is not possible to

consider that the applicant's reliance on that provision, for the first time before the Board of Appeal, was out of time.

51 The intervenor's argument that permitting reliance on the benefit of Article 8(3) of Regulation No 6/2002 for the first time before the Board of Appeal prolongs the administrative procedure cannot be accepted, since the refusal by the Boards of Appeal to examine the applicability of that provision may have the effect of depriving the proprietor of the contested design of a right which has been conferred on him.

52 It must be added that, in accordance with Article 59(2) of Regulation No 6/2002, in the examination of the appeal, the Board of Appeal invites the parties, as often as necessary, to file observations, within a period to be fixed by the Board of Appeal, on communications from the other parties or issued by itself. That provision is intended, *inter alia*, to apply where the proprietor of a contested design relies, for the first time before the Board of Appeal, on the benefit of Article 8(3) of Regulation No 6/2002.

(b) *Applicability of Article 8(3) of Regulation No 6/2002 to the contested design*

53 As a preliminary point, it should be noted that, unlike Article 8(3), Article 8(1) and Article (2) of Regulation No 6/2002 do not confer any right in respect of a design. Therefore, in order to determine whether Article 8(3) of Regulation No 6/2002 was applicable to the contested design, it is necessary to assess whether that design, in the light of its features, is covered by other provisions of that article, in order, if necessary, to examine whether those other provisions preclude the application of Article 8(3).

(1) *The link between the features referred to in Article 8(1) of Regulation No 6/2002 and those referred to in Article 8(2) of that regulation*

54 It should be noted that, by claiming that the contested design falls within Article 8(3) of Regulation No 6/2002, the applicant accepts, at least implicitly, that the features of appearance of the product concerned by that design allowing the interconnection of that product fall within Article 8(2) of that regulation. In addition, by the first part of the second plea in law, it submits, in particular, that the contested design could not be declared invalid under Article 8(1) of Regulation No 6/2002.

55 In the present case, in paragraph 32 of the contested decision, the Board of Appeal identified the following features of appearance of the product: (i) the row of studs on the upper face of the brick; (ii) the row of smaller circles on the lower face of the brick; (iii) the two rows of bigger circles on the lower face of the brick; (iv) the rectangular shape of the brick; (v) the thickness of the walls of the brick and, (vi) the cylindrical shape of the studs. According to the Board of Appeal, as is apparent from paragraph 47 of the contested decision, all those features were solely dictated by the technical function of the building brick, namely to allow assembly with, and disassembly from, the rest of the bricks of the set.

56 Without prejudice to the question whether all the features of the product concerned by the contested design are solely dictated by the technical function of that product within the meaning of Article 8(1) of Regulation No 6/2002, it is necessary to assess whether the features, as identified by the Board of Appeal, are covered by that provision or, as the applicant submits, by Article 8(2) of that regulation.

57 In that regard, it must be borne in mind that, the function which exclusively determined the appearance of all the features of the product concerned by the contested design, identified by the Board of Appeal, is, according to that board, to allow assembly with, and disassembly from, the other bricks.

58 As is apparent, in essence, from the Board of Appeal's findings, set out in paragraphs 34 to 46 of the contested decision, that function is the only factor which determined the features of appearance of the product concerned by the contested design.

59 The Court of Justice held that Article 8(1) of Regulation No 6/2002 excludes 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 (judgment of 8 March 2018, *DOCERAM*, C-395/16, EU:C:2018:172, paragraph 31). Consequently, such features of appearance of the product concerned by a design, such as those identified by the Board of Appeal in the present case, which are determined exclusively by the function allowing assembly with, and disassembly from, the other bricks, fall within Article 8(1) of Regulation No 6/2002. In other words, where the possibility of assembling the product concerned by the contested design with other building blocks and dismantling them is the only factor which determined those features, the latter necessarily fall within Article 8(1) of Regulation No 6/2002.

60 Furthermore, since, in order to fulfil the function of assembly and disassembly of the product concerned by the contested design, the features of appearance of that design, as identified by the Board of Appeal, must be reproduced in the exact dimensions in order to permit their connection, they also fall within Article 8(2) of that regulation.

61 It follows that features of appearance of the product concerned by a design may fall within both Article 8(1) of Regulation No 6/2002 and Article 8(2) of that regulation since they may both be solely dictated by the technical function of that product, namely to allow the connection and disconnection of that product, and constitute features of interconnection.

62 However, it must be stated that all features of interconnection for the purposes of Article 8(2) of Regulation No 6/2002 are not necessarily solely dictated by the technical function of the product concerned by a design for the purposes of Article 8(1) of that regulation, since the interconnection of that product may not be the only factor which determined the appearance of those features.

63 As EUIPO submitted at the hearing, features of interconnection for the purposes of Article 8(2) of Regulation No 6/2002 may be designed in such a way that visual considerations have played a role and, for that reason, those features do not fall within Article 8(1) of that regulation.

64 That interpretation is also confirmed by the *travaux préparatoires* for Regulation No 6/2002. As is apparent from the explanatory memorandum relating to Article 9(2) of the Commission's proposal of 3 December 1993 for a Regulation on the Community design COM(93) 342 final (OJ 1994 C 29, p. 21), which corresponds, in part, to

Article 8(2) of Regulation No 6/2002, the design applied to interconnections which must necessarily be reproduced in their exact forms and dimensions is not eligible for protection even where it is arbitrary in the sense that shapes and dimensions are not solely dictated by their technical function.

65 According to the Commission, it follows that features of interconnection are not necessarily solely dictated by the technical function of the product to which the design is applied and, consequently, Article 8(2) of Regulation No 6/2002 covers a broader category of features of interconnection than Article 8(1) of that regulation.

66 Furthermore, it must be observed, as did EUIPO, that if all features of interconnection were solely dictated by a technical function, there would have been no need for the legislature to provide for the application of Article 8(2) of Regulation No 6/2002.

67 It follows that Article 8(2) of Regulation No 6/2002 covers all features of interconnection, some of which do not fall within the scope of Article 8(1) of that regulation, namely those for the appearance of which considerations other than technical considerations existed.

68 In the light of the foregoing considerations, there is a certain overlap between the features referred to in Article 8(1) and Article 8(2) of Regulation No 6/2002, with the result that the same feature of appearance of the product concerned by a design may be covered by the description of the features referred to in both Article 8(1) and in Article 8(2) of Regulation No 6/2002. They are features of appearance of the product concerned by a design permitting the connection of that product to another product for which that function is the only factor which determined their appearance.

(2) Applicability of Article 8(3) of Regulation No 6/2002 to the features referred to in both Article 8(1) and in Article 8(2) of that regulation

69 From the outset, it should be noted that, under Article 8(3) of Regulation No 6/2002, that regulation may be relied on for the benefit of features referred to in Article 8(2) of that regulation.

70 However, as stated in paragraph 68 above, certain features of interconnection may fall within both Article 8(1) and Article 8(2) of Regulation No 6/2002.

71 Should it be considered that EUIPO may merely apply Article 8(1) of Regulation No 6/2002 to the features which fall within both that provision and Article 8(2) of that regulation, Article 8(2) and Article 8(3) of Regulation No 6/2002 would be at least partially deprived of their effectiveness, as the applicant submits, since applicants for a declaration of invalidity could be encouraged to base their applications for a declaration of invalidity solely on Article 8(1) of that regulation, so that the proprietor of the contested design cannot rely on the benefit of the exception protecting modular systems.

72 In those circumstances, all the provisions of Article 8 of Regulation No 6/2002 must be interpreted in such a way as to preserve their effectiveness.

73 Thus, on the one hand, to consider that only Article 8(2) of Regulation No 6/2002 applies to the features of appearance falling within both Article 8(1) and Article 8(2) of that regulation, as the applicant submitted at the hearing, may result in overprotection of the features of interconnection, thus running counter to Recital 10 of that regulation. Adopting the interpretation advocated by the applicant, where an earlier design consists exclusively of features of appearance falling within both Article 8(1) and Article 8(2) of Regulation No 6/2002, but only Article 8(1) of that regulation is relied on in support of the application for a declaration of invalidity, that application would be rejected.

74 Thus, in order to achieve the objectives of those provisions set out in Recital 10 of Regulation No 6/2002, where a feature of appearance falls within both Article 8(1) and Article 8(2) of that regulation, it must be possible to apply both those provisions.

75 It follows, moreover, that the applicant's complaint relating to the inapplicability of Article 8(1) of Regulation No 6/2002 to the features of appearance of the product concerned by the contested design must be rejected.

76 On the other hand, as regards the application of Article 8(3) of Regulation No 6/2002, EUIPO maintained, during the hearing (see paragraph 63 above), that, in order to benefit from the exception laid down in that provision, the features of interconnection referred to Article 8(2) of that regulation do not need to be solely dictated by the technical function of the product concerned by the design at issue for the purposes of Article 8(1) of that regulation. Thus, adopting EUIPO's argument, the benefit of Article 8(3) of Regulation No 6/2002 could be relied on only in respect of some of the features referred to in Article 8(2) of that regulation, namely those which do not fall within Article 8(1) of that regulation.

77 However, it must be held that, in the absence of any indication to the contrary, it must be possible to rely on Article 8(3) of Regulation No 6/2002 for the benefit of all the features referred to in Article 8(2).

78 Consequently, the interpretation given by EUIPO at the hearing cannot be adopted, since it is too restrictive and would not ultimately enable the objective set out in Recital 11 of Regulation No 6/2002, namely the protection of mechanical fittings of modular products, to be achieved, since only some of the features referred to in Article 8(2) of that regulation could potentially benefit from the exception provided for in Article 8(3) of that regulation.

79 Furthermore, the interpretation given by EUIPO, finally, would mean that the Cancellation Division or the Board of Appeal, where only Article 8(2) of Regulation No 6/2002 is relied on by the applicant for a declaration of invalidity, determines, before applying Article 8(3) of that regulation, whether the features of appearance of the product concerned by a design falling within Article 8(2) of that regulation fulfil the conditions of Article 8(1) of that regulation, failing which an asymmetric application of Article 8(3) of that regulation would be promoted.

80 It follows that, in order to preserve the effectiveness of Article 8(3) of Regulation No 6/2002, where EUIPO, when examining an application for a declaration of invalidity based on Article 25(1)(b) of that regulation, read in conjunction with Article 8(1) of that regulation, finds that the features of appearance of the product concerned by the contested design fall within both Article 8(1) and Article 8(2) of that regulation, and where the proprietor of the contested design relies on the benefit of Article 8(3) of that regulation, it must examine whether those features are

capable of benefiting from the protection of modular systems for the purposes of that latter provision, including when the applicant for a declaration of invalidity did not rely on Article 8(2) of that regulation.

81 In that regard, it should be noted that the application of Article 8(3) of Regulation No 6/2002, where the features of appearance of the product concerned by a design fall within both Article 8(1) and Article 8(2) of that regulation, cannot depend on the intention of the applicant for a declaration of invalidity to rely on one or other of those provisions.

82 That would be the case, *inter alia*, if, in the presence of the features of appearance of the product concerned by a design falling within both Article 8(1) and Article 8(2) of Regulation No 6/2002, the proprietor of the contested design is denied the possibility of relying on the benefit of Article 8(3) of that regulation on the sole ground that the applicant for a declaration of invalidity, in support of his application, had merely relied on Article 8(1) of that regulation.

83 Furthermore, in accordance with the considerations set out in paragraph 50 above, the obligation incumbent on EUIPO, established in paragraph 80 above, exists even if the benefit of Article 8(3) of Regulation No 6/2002 is relied on, by the proprietor of the contested design, for the first time before the Board of Appeal.

84 Thus, in the light of all the foregoing considerations, the Board of Appeal had to assess whether the contested design met the requirements of Article 8(3) of Regulation No 6/2002. Since it failed to do so, as has been found in paragraph 37 above, it erred in law. Therefore, the first plea in law must be upheld and the contested decision must be annulled.

85 Under those circumstances, there is no need to examine the third plea in law, alleging infringement of Article 62 of Regulation No 6/2002 in that regard.

86 By contrast, since it is not possible to prejudge the outcome of the examination of the conditions for the application of Article 8(3) of Regulation No 6/2002, it is appropriate to continue the examination of the applicant's arguments alleging infringement of Article 8(1) of that regulation.

2. *Infringement of Article 8(1) of Regulation No 6/2002*

87 In the context of the second plea in law, the applicant relies on several complaints, alleging infringement of Article 8(1) of Regulation No 6/2002 by the Board of Appeal.

88 Thus, first, it complains that the Board of Appeal misinterpreted the features of the product concerned by the contested design and considered that the applicant had approved the list of those features. Second, it maintains that the Board of Appeal disregarded the creative aspects of the contested design, in particular the smooth surface on either side of the row of four studs on the upper side. Third, the applicant claims that the Board of Appeal's findings regarding the functional nature of the 'two rows of bigger circles on the lower face of the brick', are contradictory and insufficient. Fourth, the applicant finally criticises the Board of Appeal for having imposed on it the burden of proving the absence of a purely technical function of the contested design, even though the intervener had failed to prove the existence of such a function.

89 EUIPO contests the applicant's arguments. As regards, in particular, the claim that the list of features of the product concerned by the contested design, drawn up in the contested decision, was incomplete, it contends that in its observations before the Board of Appeal, the applicant had reiterated the Cancellation Division's list of features without endorsing it. As for the account taken of the smooth surface on the upper side of the brick, EUIPO argues that the absence of studs is also a technical feature. In particular, it states that the lack of additional studs on the upper side of the brick allows two bricks to be twisted when connected by a single stud at the end of the row, thereby allowing a bend to be built. Since there are no side studs, steps can also be built which are not obstructed by the studs.

90 The intervener, for its part, takes the view that the Board of Appeal did not infringe Article 8(1) of Regulation No 6/2002 in the present case. It adds that the applicant was not able to rely on a single consideration which is of a nature other than the need for the features of the product concerned by the contested design to fulfil their technical function, namely to allow assembly with, and disassembly from, the rest of the bricks of the set.

91 It also considers that it met the burden of proof incumbent upon it and that the Board of Appeal could rely on the illustrations provided in the course of the administrative procedure to draw the conclusions relating to the solely technical nature of the features of the product concerned by the contested design.

92 As noted in paragraph 29 above, under Article 8(1) of Regulation No 6/2002, a Community design does not subsist in features of appearance of a product which are solely dictated by its technical function.

93 In that regard, it follows from the case-law cited in paragraph 59 above that Article 8(1) of Regulation No 6/2002 excludes 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.

94 The Court of Justice stated that, in order to determine whether the features of appearance of a product are solely dictated by its technical function, it must be established that that technical function is 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).

95 According to the Court of Justice, assessment as to whether the features of appearance of a product fall within 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).

96 It follows that a design must be declared invalid if all the features of its appearance are solely dictated by the technical function of the product concerned by that design (see, to that effect, judgment of 8 March 2018, *DOCERAM*, C-395/16, EU:C:2018:172, paragraph 32). It follows that if at least one of the features of appearance of the product concerned by a contested design is not solely dictated by the technical function of that product, the design at issue cannot be declared invalid under Article 8(1) of Regulation No 6/2002.

97 That latter interpretation is also supported by the explanatory memorandum relating to Article 9(1) of the Commission's proposal of 3 December 1993 for a Regulation on Community designs, corresponding, in essence, to Article 8(1) of Regulation No 6/2002, according to which: 'it is unlikely, however, that the whole design will be unprotectable. In most cases, only specific features will, without possibilities of variations, be dictated by function. Therefore, the provision provides for unprotectability to the extent only that there is no freedom as regards arbitrary elements of design'.

98 Furthermore, it is apparent from Article 8(1) of Regulation No 6/2002, Recital 10 of that regulation and the judgment of 8 March 2018, *DOCERAM* (C-395/16, EU:C:2018:172), that the assessment of a Community design in the light of the abovementioned provision comprises the following steps: it is necessary, in the first place, to determine the technical function of the product concerned, in the second place, to analyse the features of appearance of that product within the meaning of Article 8(1) of Regulation No 6/2002 and, in the third place, 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 only 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).

99 Moreover, it must be noted that, when an applicant for a declaration of invalidity refers to the ground of invalidity set out in Article 25(1)(b) of Regulation No 6/2002, it is for him to provide evidence to demonstrate that the contested design does not fulfil the requirements of Articles 4 to 9 of that regulation (judgment of 21 September 2017, *Easy Sanitary Solutions and EUIPO v Group Nivelles*, C-361/15 P and C-405/15 P, EU:C:2017:720, paragraph 60).

100 The applicant's complaints, alleging infringement of Article 8(1) of Regulation No 6/2002, must be examined in the light of those principles.

101 In the present case, as is apparent from paragraphs 30 and 31 of the contested decision, the Board of Appeal found that the product concerned by the contested design, namely a toy brick, must have features that make it possible to assemble it to other toy bricks and the technical function that that product must fulfil is therefore the capability of being assembled with sufficient stability to other bricks of the set so that it can form part of a toy building.

102 Subsequently, as noted in paragraphs 12 and 13 above, the Board of Appeal identified the features of appearance of the contested design (six) and found that all of those features were solely dictated by the technical function of the product concerned by the contested design, namely to allow assembly with, and disassembly from, the rest of the bricks of the set.

103 In that regard, the applicant complains, inter alia, that the Board of Appeal, first, misinterpreted the features of the contested design and, secondly, disregarded the creative aspects of that design by referring in particular the smooth surface on either side of the row of four studs on the upper side.

104 As is apparent from paragraph 55 above, the Board of Appeal identified, in paragraph 32 of the contested decision, the features of appearance of the product concerned by the contested design.

105 It must be stated that the smooth surface of the upper face of the product concerned by the contested design is not included among the features identified by the Board of Appeal. It is a feature of appearance of that product.

106 In that regard, EUIPO argued, at the hearing, that the surface of the product is an element of it, characterised, in the present case, by the absence of studs and which is not to be assessed in the light of Article 8(1) of Regulation No 6/2002. For that reason, it was not for the applicant for a declaration of invalidity to rely on the absence of a feature, but for the proprietor of the contested design to invoke the proportions which show that that design had a particular visual effect because of its surface. It added that it is always possible to find elements of a design by maintaining that it is a technical feature and by criticising the Board of Appeal for not having taken it into account.

107 Contrary to what EUIPO suggested at the hearing, it must be held that the smooth surface of the upper face of the toy brick is a feature of the specific appearance of the product concerned by the contested design and is not limited to a mere 'absence of studs on the upper surface of the brick'. It follows that the Board of Appeal had to take it into account.

108 In that regard, it is irrelevant that the applicant did not expressly rely on that feature before the Board of Appeal. Furthermore, as is apparent from EUIPO's case file, it had invoked it before the Cancellation Division.

109 As noted in paragraph 99 above, it is for the applicant for a declaration of invalidity to demonstrate and for EUIPO to find that all the features of appearance of the product concerned by the contested design are solely dictated by the technical function of that product. The interpretation suggested by EUIPO at the hearing, according to which it was for the applicant to claim that the smooth surface of the upper face of the toy brick is not solely dictated by the technical function of that brick consequently cannot be adopted.

110 EUIPO's argument set out in paragraph 26 of its response that the absence of studs necessarily resulting in a smooth surface is in fact technical in character also cannot be adopted. That conclusion is based on the considerations, set out in paragraphs 24 and 25 of its response, that the smooth sides have a solely technical function in that it allows several figures (such as bends or steps) to be built which would not be possible if additional studs were present.

111 The contested decision clearly does not contain any such considerations.

112 In that regard, it is sufficient to note that, as the applicant raised in an objection at the hearing, EUIPO's argument in paragraphs 24 to 26 of its response, cannot remedy the inadequacy of the statement of reasons for the contested decision since a decision must be self-sufficient and the reasons on which it is based cannot be stated in written or oral explanations given subsequently (see, to that effect, judgment of 18 December 2019, *Gres de Aragón v EUIPO (GRES ARAGÓN)*, T-624/18, not published, EU:T:2019:868, paragraph 39).

113 As for EUIPO's argument that it is always possible to rely on a feature of the product which the Board of Appeal did not examine, it must also be rejected. As is apparent from paragraph 96 above, all the features of appearance of the product concerned by the contested design must be solely technical in order for that design to be declared invalid pursuant to Article 8(1) of Regulation No 6/2002.

114 In the light of all the foregoing, the Board of Appeal infringed Article 8(1) of Regulation No 6/2002 in the present case, in that it did not identify all the features of appearance of the product concerned by the contested design and, a fortiori, did not establish that all of those features were solely dictated by the technical function of that product.

115 In those circumstances, the present plea in law must be upheld, without there being any need to examine the applicant's other complaints.

116 In the light of all the foregoing, the applicant's first and second pleas in law must be upheld and the contested decision must be annulled in its entirety.

C. **Second head of claim seeking alteration of the contested decision**

117 By its second head of claim, the applicant requests that the decision of the Cancellation Division rejecting the application for a declaration of invalidity be upheld.

118 It must be considered that the applicant's second head of claim requests that the Court itself take the decision which the Board of Appeal ought to have or could have taken, that is to say, the decision to dismiss the appeal before it and therefore uphold the decision of the Cancellation Division of 30 October 2017. In other words, it requests the Court to exercise its jurisdiction to alter the decision of the Board of Appeal, which is granted it under Article 61(3) of Regulation No 6/2002 (see judgment of 13 May 2015, *Group Nivelles v OHIM Easy Sanitary Solutions (Shower drainage channel)*, T-15/13, EU:T:2015:281, paragraph 20 and the case-law cited).

119 In that regard, it must be borne in mind that the power of the General Court to alter decisions pursuant to Article 61(3) of Regulation No 6/2002 does not have the effect of conferring on that Court the power to carry out an assessment on which the Board of Appeal has not yet adopted a position. Exercise of the power to alter decisions must therefore, in principle, be limited to situations in which the General Court, after reviewing the assessment made by the Board of Appeal, is in a position to determine, on the basis of the matters of fact and of law as established, what decision the Board of Appeal was required to take (see, to that effect, judgment of 27 February 2020, *Bog-Fran v EUIPO – Fabryki Mebli "Forte" (Furniture)*, T-159/19, not published, EU:T:2018:123, paragraph 45 and the case-law cited).

120 However, in the present case, the conditions for alteration are not satisfied given that the Board of Appeal has not established all the elements of fact and of law to enable the Court to determine the decision which it was required to take both as regards the application of Article 8(1) of Regulation No 6/2002 and of Article 8(3) of that regulation.

121 First, as is apparent from paragraph 114 above, the Board of Appeal did not identify all the features of appearance of the product concerned by the contested design and, consequently, did not establish the solely technical nature of all those features.

122 Second, as is apparent from paragraph 37 above, the Board of Appeal did not examine the conditions of application of Article 8(3) of Regulation No 6/2002.

123 It follows that the application for alteration, contained, in essence, in the applicant's second head of claim, must be dismissed.

IV. **Costs**

124 Under Article 134(1) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings.

125 In the present case, since EUIPO and the intervener have been unsuccessful, they must be ordered to bear their own costs and each to pay half of the costs incurred by the applicant, in accordance with the forms of order sought by the applicant.

On those grounds,

THE GENERAL COURT (Second Chamber)

hereby:

1. **Annuls the decision of the Third Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 10 April 2019 (Case R 31/2018-3);**
2. **Dismisses the action as to the remainder;**
3. **Orders EUIPO and Delta Sport Handelskontor GmbH to bear their own costs and each to pay half of the costs incurred by Lego A/S.**

Tomljenović

Schalin

Nömm

Delivered in open court in Luxembourg on 24 March 2021.

E. Coulon

S. Papasavvas

Registrar

President

*
— Language of the case: English.