

Court of Justice of the European Union**Cour de Justice de l'Union Européenne****L – 2925 Luxembourg**

Re: Case C-472/21 *Monz Handelsgesellschaft International mbH & Co. KG vs. Büchel GmbH & Co. Fahrzeugtechnik KG*

December 2, 2021

Amicus Submission – International Trademark Association

- 1 The International Trademark Association (INTA) has prepared this Submission in relation to Case C-472/21 *Monz Handelsgesellschaft International mbH & Co. KG vs. Büchel GmbH & Co. Fahrzeugtechnik KG* pending before the Court of Justice of the European Union (CJEU), request for preliminary ruling under Article 267 of the Treaty on the Functioning of the European Union (TFEU) referred by the Federal Supreme Court (Bundesgerichtshof), Germany.
- 2 The case concerns a national intellectual property right, namely a design registered under the German Design Protection Act (*Designgesetz*). The design concerns a component part of a complex product and raises the question of how the requirement of “visibility” for such component parts in Article 3 (3) and 3 (4) of the Directive 98/71/EC on the legal protection of designs is to be interpreted, i.e. by means of (i) a more formal and language-based approach or (ii) by means of a more abstract and systematic approach. In the first case, the registration of designs for component parts may have to undergo a detailed analysis to assess the specifics of visibility with regard to the very product-features and its possible modes of use. In the latter case, it would be sufficient to simply require the opposite of invisibility because of a complete encapsulation of the very product after the final assembly as more or less any other product-feature will already contribute to “visibility”.

A. INTA's interest in the case

- 3 INTA is not a party in the case and acknowledges that the CJEU does not have a procedure for accepting an *amicus curiae* intervention *stricto sensu*. INTA however believes that the case is significant to the development of design law and presents itself as a “friend of the court” in this matter and as done in the past (*cf. Annex A* listing previous amicus interventions by INTA before European courts and bodies).

- 4 This submission was prepared by the INTA's International Amicus Committee – Europe Amicus Subcommittee, under the direct supervision of INTA's Executive Committee of the Board of Directors, following a strictly independent procedure. In particular and in order to maintain INTA's independence, the preparation of the enclosed submission took place confidentially. INTA did not disclose its deliberations to either of the parties and did not consult with the parties on the issues in the cases.
- 5 INTA hopes that its comments may be of assistance to the Court.

B. About INTA

- 6 INTA is a global association of brand owners and professionals dedicated to supporting trademarks and related intellectual property (IP) to foster consumer trust, economic growth, and innovation. Members include nearly 6,500 organizations, representing more than 34,350 individuals (trademark owners, professionals, and academics) from 185 countries, who benefit from the Association's global trademark resources, policy development, education and training, and international network. Founded in 1878, INTA is headquartered in New York City, with offices in Beijing, Brussels, Santiago, Singapore, and Washington, D.C., and a representative in New Delhi. For more information, visit www.inta.org.
- 7 An important objective of INTA is to protect the interests of the public by the proper use of trademarks. In this regard, INTA strives to advance the development of trademark, related IP and unfair competition laws and treaties throughout the world, based on the global public interest in avoiding deception and confusion. INTA has been an official non-governmental observer to the World Intellectual Property Organization ("WIPO") since 1979 and actively participates in all trademark related WIPO proposals. INTA has influenced WIPO trademark initiatives such as the Trademark Law Treaty and is active in other international arenas, including the Asia Pacific Economic Cooperation Forum ("APEC"), the Association of Southeast Asia Nations ("ASEAN"), the European Union (EU) and the World Trade Organization ("WTO").
- 8 INTA provides expertise concerning trademark and other IP-related laws to courts and intellectual property offices around the world through the submission of amicus curiae ("friend of the court") briefs or similar filings, playing a neutral role and addressing only the legal issues. Since 1916, INTA has intervened as *amicus curiae* ("friend of the court") in the US and in other jurisdictions, including before the CJEU and the General Court of the EU.

C. Reasons why INTA is submitting this brief

1. The questions referred to the CJEU in this case are:

- 9 *1. Is a component part incorporating a design a 'visible' component within the meaning of Article 3(3) of Directive 98/71/EC if it is objectively possible to recognise the design when the component is mounted, or should visibility be assessed under certain conditions of use or from a certain observer perspective?*

- 10 2. If the answer to Question 1 is that visibility under certain conditions of use or from a certain observer perspective is the decisive factor:
(a) When assessing the ‘normal use’ of a complex product by the end user within the meaning of Article 3(3) and (4) of Directive 98/71/EC, is it the use intended by the manufacturer of the component part or complex product that is relevant, or the customary use of the complex product by the end user?
(b) What are the criteria for assessing whether the use of a complex product by the end user constitutes a ‘normal use’ within the meaning of Article 3(3) and (4) of Directive 98/71/EC?
- 11 INTA considers Question 1 to be of general importance. Articles 3 (3) and 3 (4) of the Directive 98/71/EC on the protection of Designs (Design Directive) establish access to the design protection of components of complex products which deviates from the access to protection of other designs. While in general there is recourse to the content of the application - “what you see is what you get” -, components may achieve protection based on a recourse to the conditions of use; i.e. on facts lying outside the application. Protection is only granted under the condition of visibility of the respective component whereby such visibility must occur during normal use. “Normal use” is then further specified as “*use by the end user, excluding maintenance, servicing or repair work*”.
- 12 These issues are of general importance for applicants seeking to register the design of components of complex products. They need guidance of how to practically deal with the three extra criteria of (1) “visibility”, (2) “normal use” and (3) “maintenance, servicing and repair” whereby the third functions partly as a specification and partly as a negative to the second criterium. Further, it is already clear from the outset that the answers to these criteria may well differ from product to product. In that regard the referring court has already noted correctly that visibility may become difficult to determine for moveable or very small components.
- 13 INTA has already taken position in a joint paper together with MARQUES and ECTA of July 2018 (<https://www.inta.org/wp-content/uploads/public-files/advocacy/testimony-submissions/ECTA-INTA-MARQUES-Joint-Paper-on-Legal-Review-of-EU-Designs-System-July2018.pdf>). This paper suggests abandoning the current linking of the visibility-requirement to the use of a product because “use” is not otherwise a requirement for the granting of design protection (see page 18 f). Further it notes that Article 3 (3) of the Design Directive historically targeted only spare parts of motor vehicles and needs to be revised and restricted. Both suggestions give some indication, however direct in the future making of new design laws which is not at stake here.
- 14 In light of the above, the very reason for INTA to intervene is the distinction outlined by the Bundesgerichtshof between (i) an abstract concept of visibility which more or less ignores the reference to the term “during normal use”, and (ii) a concept which sticks to the very language of Article 3 (3) (a) Design Directive and seeks to gain more guidance on how to apply this wording in practice. As a starting point it is obvious that the latter concept is much more burdensome for practitioners to align with whatever outcome the interpretation will provide.

- 15 There is no CJEU case law on these issues which specifically deals with the interpretation of Article 3 (4) of the Design Directive:
- 16 In its judgment of September 21, 2017 (Cases C-361/15 P and C-405/15 P, EU:C:2017:720) – *Easy Sanitary Solutions* the CJEU has held that the protection of a design incorporated into a product is not limited to the product in which the design is incorporated or to which it is applied (para 95).
- 17 CJEU judgment of December 20, 2017 (C-397/16 and C-435/16, EU:C:2017:992) - *Acacia/Pneusgarda* provides a clarification for the repair clause in Article 110 CDR in that the scope of this provision is limited to spare parts which are visually identical with the original (para 75).
- 18 CJEU judgment of October 28, 2021 (C-123/20, EU:C:2021:889) – *Ferrari/Mansory Design* specifies the features of a component part of a complex product capable to benefit from design protection in that the product or component part of the complex product at issue must be visible and defined by features which constitute its particular appearance, namely by particular lines, contours, colours, shapes and texture. That presupposes that the appearance of that part of the product or that component part of a complex product is capable, in itself, of producing an overall impression and cannot be completely lost in the product as a whole (para 50).
- 19 GC judgment of October 9, 2014 (Case T-494/12, EU:T:2014:757) *Biscuit Poultis* differentiates a foodstuff product from a complex product in the sense of Article 3 (3) Design Directive and concludes that the visibility criterium during normal use therefore does not apply (para 28) for the protectability of inner layers.
- 20 GC judgment of October 3, 2014 (Case T-39/13, EU:T:2014:852) - *Cezar Przedsiębiorstwo* deals with the special issue of possibly multiple functions of a component part and concentrates on the most likely form of use (para 27) to conclude that a product intended to cover a recess in a skirting board and, incidentally, a recess in a wall or floor qualifies for a component of a complex product.

D. Background

- 21 In the case at hand, the claimant had initially failed with a nullity claim against German National Design No. 40 2011 004 383-0001 for saddles for bicycles and motorcycles with the German Patent Office.



- 22 Upon appeal the Federal Patent Court declared the design invalid. The owner then filed a complaint with the Federal Supreme Court, which stayed the proceedings to refer the matter to the CJEU to seek guidance on the interpretation of Article 3 (3) and 3(4) Design Directive in order to properly apply the respective provisions in the German Design Protection Act.
- 23 The referring court has already indicated (in para 20 ctd. of the reasoning) that the language of Article 3 (3) and 3 (4) of the Design Directive may probably cause unnecessary restraints for protection in that the history of the provision only targeted inner parts of motor vehicles.
- 24 A recent review of the overall functioning of design protection in the EU has disclosed some areas of uncertainty. The question of visibility as an additional requirement for components ranks amongst the top topics in that regard:
- 25 ➤ The “Legal Review on Design Protection in Europe” issued by the EU-Commission on April 15, 2016 (MARKT2014/083/D), notes a conflicting case law and suggests to clarify Articles 3 (3) and 3 (4) of the Design Directive in that it should be made clear that the addendum of “during normal use” should only apply to component parts and not on designs in general (see pages 13, 55, 56, 71-78).
- 26 ➤ A staff working paper of the EU-Commission on the results of an enquiry concerning the legislation on design protection in the EU published on November 6, 2020 (SWD(2020) 265 final) notes a controversial interpretation of Article 3 (3) and 3 (4) of the Design Directive, however avoids to give further guidance (see pages 29, 80 and 120).

E. INTA’s analysis

- 27 In accordance with the position of INTA on trademarks and designs as an object of property, we highlight the importance of a practical and coherent approach to distinct protectable from non-protectable objects to outline the limits of intellectual property against other purposes (namely public welfare) and to avoid unnecessary procedural constraints for the acquisition of intellectual property rights. Even in the negative, a clear demarcation lies in the interest of potential right owners. In that regard, the case

at issue namely calls for a better understanding of the foreclosure of design protection for components of complex products.

1. As regards the character of Article 3 (3) and (4) Design Directive

- 28 The case at issue concerns the interpretation of a provision which appears in the format of a specified rule for protection and thus as an extension of design protection to components of complex products. A closer look into the legislative framework of the Design Directive however reveals that in absence of Article 3 (3) and (4), Article 3 (2) would apply which grants protection without a reference to “visibility” or “normal use”:

2. A design shall be protected by a design right to the extent that it is new and has individual character.

- 29 Therefore Article 3 (3) and (4) Design Directive have to be seen and treated as a restriction of the general concept of design protection which otherwise would take place.

2. As regards the purpose of Article 3 (3) and (4) Design Directive

- 30 Recital 12 of the Design Directive (and also of the Community Design Regulation) states that “*Protection should not be extended to those component parts which are not visible during normal use of a product, nor to those features of such part which are not visible when the part is mounted, or which would not, in themselves, fulfil the requirements as to novelty and individual character*”. As regards component parts, these are excluded from protection when they are not visible during “normal use” and as regards features of the component parts, these are excluded from protection when they are not visible when the component part is mounted.

- 31 The recitals of both the Directive and the Regulation on design protection give little guidance on the rationale behind the particular restriction of protection for components of complex products. Scholars and also the joint paper of INTA, MARQUES and ECTA of 2018 point out and criticize a potential overruling against the historical background of the purpose to exclude the inner parts of motor vehicles. Such a target however would have already been achieved to a large extent by reference to the definition of a design in Article 1 according to which a design is a “*appearance of the whole or a part of a product*”. The word “*appearance*” already transports the concept of “*visibility*” as it is addressed in Article 3 (3) Design Protection Directive. A further need to expressly address the inner components of motor vehicles is not perceivable. Thus, one can well question the existence of a particular rationale in support of the restricted protection for components of complex products.

3. As regards the concept of Article 3 (3) and (4) Design Directive

- 32 From the wording of Articles 3(3) and 3(4) of the Directive (and the analogous 4(2) and 4(3) of the Designs Regulation) it follows that a design on or in a component part of a complex product shall be excluded from protection if, when incorporated in such product, it is not visible any longer. Such visibility is to be assessed in the context of use made by the end user and is to exclude maintenance, servicing or repair. Visibility therefore must exist without taking into account the fact that the component may be visible during maintenance, servicing or repair.

4. As regards the language of Article 3 (3) and (4) Design Directive

- 33 The referring court further rightfully points out that there is also a structural tension between the provisions of Article 3 (3) and 3 (4) in a double sense. First of all, the word “Visibility” can well be translated into the ability to be seen. This would suggest an objective concept of “*visibility*” against which the addendum “*during normal use*” may be taken as a mere extra description of little or no relevance. The further definition of what constitutes a normal use in Article 3 (4) sheds a particular light on this extra and thus questions the simple translation of “*visibility*” as “*able to be seen*”. Apparently, the user and his perception come into play and apparently the further element “*during normal use*” must bear a legal concept which calls for observance and which prohibits to simply adopt an objective approach of “*visibility*”. In a second step Article 3 (4) excludes “*repair, servicing and maintenance*” which are activities otherwise to be counted under “*normal use*” – albeit often not performed by the product’s own user but by professionals. The message from this second element conveys a very restrictive approach to really ask by means of a case by case-analysis what kind of images a given product produces and what counts for the “normal use”. In the absence of further clear guidance such a concept necessarily results in an only narrow path for component parts to benefit from the regime of design protection in the EU.
- 34 As a result, there is already an implied contradiction between the requirement of “*visibility*” and the further specification “*during normal use*”. The uncertainty resulting from this contradiction however, is doubled with regard to the specification of what constitutes “normal use” aside from servicing, maintenance and repair. In the underlying case for example one may well have a dispute over the question if the cleaning of a bicycle by means of putting it upside down would already fall into the category of “*service*”.
- 35 The uncertainty could be resolved by an interpretation that “visible during normal use” just specifies a situation where the complex product is assembled for “normal use by the end user” (excluding in particular visibility only when disassembled for maintenance, servicing or repair as clarified in Article 3 (4)).

5. As regards the term “Normal Use” in Article 3 (3) and (4) Design Directive

- 36 As the referring Court notes, the phrase “normal use” in Article 3(3)(a) of the Designs Directive is preceded by the word “during” (in French “*lors*”, in German “*bei*”, in Italian “*durante*”). Therefore, visibility must exist while normal use is taking place. The term “normal use” is defined in the Designs Directive and therefore it should not be understood in accordance with its usual meaning in everyday language but according to the definition provided in the law.
- 37 As follows from the wording of the provision, normal use is that made “by the end user”. There are no restrictions in the wording itself, even though as the referring Court correctly states there is no express inclusion of the word “every” use. INTA submits that from the absence of any express restriction, such use shall be understood as indeed “every” use made by the end user. This also follows *a contrario* from the wording of the provision excluding only maintenance, servicing or repair work. These uses would otherwise fall within normal use interpreted broadly. As the referring court states in par. 25 of the referral decision “*The legislature clearly took the view that maintenance, service and repair work are fundamentally part of normal use; otherwise, there would have been no need to provide for these exceptions*”.

- 38 This is also supported teleologically. INTA agrees with the referring court that a narrow interpretation of normal use would lead to a lesser degree of protection of designs for component parts of complex products, in comparison to other designs. INTA submits therefore that “normal use” as defined in the law shall be interpreted broadly.

6. As regards the legislative history of Article 3 (3) and (4) Design Directive

- 39 The legislative history of the relevant provisions is outlined by the referring court in par. 11 of the referral decision: “*The legislative history of Directive 98/71 suggests that exempting internal components of motor vehicles through special provisions to protect designs has a **strictly limited** regulatory purpose, namely seeking to prevent abuse of design protection aimed at monopolising components which are not visible when mounted*”. Against this background the term “*component of a complex product*” results in a much broader scope of application than initially intended. Therefore, the scope of application should be narrowed down to a strict exemption from design protection.

7. As regards the principle of Design Protection

- 40 The questionable legal concept (rationale) behind the restrictions imposed on components of complex products triggers questions on a higher level as to the appropriateness and proportionality of such restrictions in comparison to the principle of design protection. The referring court has rightfully addressed respective concerns in regard to Article 26 (2) TRIPS-Agreement which narrows the discretion of Member States to impose restrictions on the concept of design protection. Further the Charter Of Fundamental Rights Of The European Union has in the meantime been integrated in the bodies of EU-Treaties which calls for each law to take the fundamental human rights into account which – inter alia – guarantee a particular protection of private (intellectual) property in Article 17 (2). Against this background one may well conclude that if there is leeway for interpretation, it should rather be used to re-install the principle of design protection than to further weaken its scope and strength.

8. As regards the unsolved problem of “must match” parts

- 41 Until today the provisions of Article 14 Design Directive and Article 110 Community Design Regulation stand for the inability of the Member States to find a common answer to the problem of spare parts which not only must fit in technically, but also aesthetically as they necessarily contribute to the overall outer appearance of a complex product; *i.e.* the so called “crash parts” for motor vehicles. This topic is very much a problem of competition and of securing a secondary market for those spare parts in the interest of end consumers. Bearing in mind this political interest one may well come to the view that the particular restrictions imposed on components of complex products serve to a certain extent as a substitute for the inability to effectively harmonize rules applicable for “must match” parts.
- 42 Against this background however, the legislative approach of Article 3 (3) and (4) Design Directive focusing on the term “visibility” provides no help. Must match spare parts by definition are visible during normal use.

Conclusion

- 43 INTA's view is that, in the absence of general legislative revision of the rules applicable on components of complex products, an abstract concept of "*visibility*" serves best to align the rules on the protection of components of complex products to the legal concept of design protection in general.
- 44 **Question 1 should be answered in support of the first alternative:** The term "*visible*" should be interpreted in an objective sense applicable to any kind of a complex product and independent from the subjective capacities of a given user as well as independent from a specific angle, just as "*capable to be seen*" on the mounted product.
- 45 • **Question 2 should be answered in the negative:** Certain conditions of use or a certain observer perspective shall not become decisive factors for the application of Article 3 (3) and (4) Design Directive under any aspect.
- 46 If necessary, further guidance can be given to the term "*visibility*" in that it should be aligned to the concept of design protection for simple products. For any user, the attractiveness of designs is being perceived through the sense of vision. This perception is either captured by "*visibility*" or by "*appearance*". Against this background "*visible*" shall be understood *a contrario* to "*hidden*", as is the case when the part is completely enclosed in the product. When the design in/on the part is visible, irrespective of whether it is visible at any and all times, from any and all angles and at any and all circumstances, protection shall apply, subject to the exceptions mentioned expressly (visible during maintenance, service, repair).

ANNEX A

INTA has filed the following *amicus*-type submissions in cases before European courts:

- Letter of submission on August 16, 2021 in the case *X BV v. Classic Coach Company vof, Y, Z* ([C-112/21](#))

Letter of submission on June 28, 2021 in the case *Leinfelder Uhren GmbH & Co KG v. E. Leinfelder GmbH and others* ([C-62/21](#))

- Letter of submission on December 23, 2020 in the case *ACACIA S.R.L v. Bayerische Motoren Werke Aktiengesellschaft* ([C-421/20](#))
- Letter of submission to Novartis AG on September 28, 2020, in Joint Cases C-254/20 *Novartis AG v. Impexco NV* and C-254/20 *Novartis AG v. PI Pharma NV* ([C-253/20](#) and [C-254/20](#))
- Letter of submission to Novartis AG on August 27, 2020, in Joint cases C-147/20, *Novartis Pharma GmbH v. Abacus Medicine A/S* and C-224/20, *Merck Sharp & Dohme B.V. et al. v. Abacus Medicine A/S et al.* ([C-147/20](#) and [C-224/20](#))
- Statement of Intervention on January 6, 2016, in the case *DHL Express (France) v EUIPO* ([T-142/15](#)).
- Statement of Intervention on April 25, 2014 in the case *Voss of Norway v OHIM* ([C-445/13 P](#)).
- Written Observations on March 16, 2010 in the case *Nokia Corporation v. Her Majesty's Commissioners of Revenue and Customs* (HMRC) ([C-495/09](#)).
- Letter of submission to Specsavers International Healthcare Limited on August 23, 2012 in the trademark case *Specsavers International Healthcare Limited & others vs Asda Stores Limited* ([C-252/12](#)).
- Letter of submission to Intel Corporation on September 5, 2007, in the trademark case *Intel Corporation v. CPM United Kingdom Ltd.* ([C-252/07](#)).
- Letter of submission to Adidas and adidas Benelux on June 12, 2007 in the trademark case *Adidas and adidas Benelux* ([C-102/07](#)).
- Letter of submission to SARL Céline on April 25, 2006 in the trademark case *SARL Céline v. SA Céline* ([C-17/06](#)).
- Submission as intervener to the English Court of Appeals on October 16, 2006 in the case *Special Effects v L'Oreal SA* ([HC 05C012224, Court of Appeal 2006 0744](#)).
- Letter of submission to Bovemij Verzekeringen N.V. on June 17, 2005 in the case *Bovemij Verzekeringen N. V. v. Benelux Merkenbureau* ([ECJ - C-108/05](#)).
- Letter of submission to Schering-Plough Ltd. on December 5, 2003 in the trademark case *Schering-Plough Ltd v. European Commission and EMEA* ([CFI T-133/03](#)).
- Letter of submission to Merck Inc. on April 4, 2003 in the trademark case *Paranova A/S v. Merck & Co., Inc, Merck, Sharp & Dohme B. V. and MSD (Norge) A/S* ([EFTA Court E-3/02](#)).
- Letter of submission to Praktiker Bau - und Heimwerkermarkte AG on March 20, 2003 in the trademark case *Praktiker Bau - und Heimwerkermarkte AG* ([ECJ C- 418/02](#)).

- Letter of submission to Shield Mark on November 1, 2001 in the trademark case *Shield Mark v. J. Kist* ([ECJ C-283/01](#)).
- Letter of submission to Libertel Groep B.V. on July 6, 2001 in the trademark case *Libertel Groep B.V. v. Benelux Merkenbureau* ([ECJ - C- 104/01](#)).
- Letter of submission to Glaxo Wellcome Limited on October 10, 2000 in the trademark case *Glaxo Wellcome Limited v. Dowelhurst Limited and Swingward Limited* ([ECJ - C-143/00](#)).