



Recent developments in European trademark and design law

Part II – The EU Design Reform Package



EU Design Reform Package - Overview & state of play -

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11th GRUR meets Brussels Workshop, 13 June 2023

Introduction: Context and evolution

- **Directive 98/71 (DD) & Regulation 6/2002 (CDR) date back to 1998/2001 (incl. transitional spare parts regime)**
- Proposal COM(2004)582 for introduction of repair clause into DD adopted 14/09/2004
- CDR amended for accession to international Hague System 2006
- Proposal COM(2004)582 withdrawn 2014
- Studies 'Economic review of industrial design' & 'Legal review on design protection' published 2015 & 2016
- Trade mark reform (based on proposals made in 2013) finalised 2017
- First public consultation conducted from 18/12/2018 to 30/04/2019
- **Evaluation Report (SWD(2020)264) published 6/11/2020**
- Council (2020/C 379 I/01) called for proposals to revise legislation on 10/11/2020 (urging prioritisation 25/06/2021)
- Study 'Effect of design protection on price/price dispersion: Evidence from automotive spare parts' published 14/11/2020
- Revision announced in COM IP Action Plan of 25/11/2020, publication of inception impact assessment in parallel
- Second public consultation conducted from 29/04/2021 to 22/07/2021
- Study 'Market structure of motor vehicle visible spare parts in the EU' published 31/08/2021
- European Parliament (A9-0284/2021) stressed need for revision in supportive opinion on IP Action Plan 30/09/2021
- **Impact Assessment (SWD(2022)368) received positive opinion from RSB 26/11/2021**
- **Package proposals COM(2022)666 & 667 adopted 28/11/2022**

Legislative initiatives package of 28 November 2022

1. Proposal to recast Directive 98/71/EC on the legal protection of designs – COM(2022) 667 final – 2022/0392 (COD)
2. Proposal to amend Council Regulation (EC) 6/2002 on Community designs and repeal Fees Regulation (EC) 2246/2002 – COM(2022) 666 final – 2022/0391 (COD)

Objectives

- General objectives
 - Promote contribution to design excellence, innovation and competitiveness in the EU by ensuring that the overall design protection system is fit for purpose in the digital age and becomes more accessible and efficient
 - Complete single market for repair spare parts
- Specific objectives
 - Improve accessibility, efficiency & affordability of reg. Community design protection
 - Enhance complementarity and interoperability between the EU and national design systems, in particular through harmonisation of procedural rules
 - Open up the spare parts aftermarket for competition

Both proposals: Modernisation & more legal certainty

- **Definitions of design and products (Art 2(3),(4) DD/3(1),(2) CDR):**
 - rendered broader and clearer to
 - ✓ align them with digital age realities
 - ✓ increase clarity and transparency on eligible subject-matter of design protection
- **Rights conferred by reg. design right (new Art 16(2)(d),(3) DD/19(2)(d),(3) CDR):**
 - wider scope of rights to fight infringement and counterfeiting in the context of
 - ✓ the deployment of 3D printing technologies to facilitate copying of protected designs
 - ✓ the placement of counterfeit products in customs situations (in line with trade mark legislation)

Proposal for DD: opening up spare parts market

What is the problem?

- Patchwork of diverging national regimes partly providing design protection and partly not
- Provided protection conflicts with essential function of design law and may result in foreclosure of competition and “lock-in” effect
- In case of available alternatives potential savings to EU customers of between EUR 415 to 664 million annually just for vehicle spare parts
- Protection may prevent ‘Motor Vehicle Block Exemption Regulation’ from achieving its objectives
- Market fragmentation creates legal uncertainty and is seen as problem by stakeholders

Proposal for DD: opening up spare parts market

- **Repair clause (new Art 19, Recitals 33 to 35 DD!)**
 - repair clause added to finally terminate transitional regime (current Art 14 DD) and complete single market in repair spare parts,
 - ✓ explicitly limited to form dependent „must match“ parts (only!) used for purpose of repair
 - ✓ involving duty to inform public about origin of the parts to be used for repair (para 2)
 - ✓ with instant legal effect only for the future and
 - ✓ transitional ten-year period for design rights already granted (para 3)
 - ✓ placed among available defences to design right infringement
 - for consistency **corresponding adjustments made to clause already contained in CDR** (transitional Art 110 replaced by new Art 20a CDR, Recital 16 Amend. Reg.!)

Proposal for DD: alignment of principal procedural rules

- **Requirements for the representation of designs (new Art 26 DD!)**
 - detailed provision added to ensure that representation at filing stage is subject to same future-proofed requirements for clear and precise representation
 - complemented by cooperation duty to establish common standards (Art 26(8), Recital 38 DD, mirrored also in Recital 20 of Amend. Reg.)
- **Multiple applications (new Art 27 DD)**
 - provision added in line with Art 37 CDR enabling to combine several designs in one application and without need for relevant products to belong to same Locarno Class

Proposal for DD: alignment of principal procedural rules

- **Grounds for non-registrability & scope of substantive examination (new Art 13 & 29 DD):**
 - to align scope of examination across EU with that at EUIPO level, grounds for refusal are set out exhaustively and with a view to keeping burden/cost for applicants at minimum
- **Administrative procedure for declaration of invalidity (new Art 31):**
 - mandatory provision added in alignment with Art 52 CDR and Art 45 EUTMR enabling third parties to seek for the invalidation of a registered design at national IP office (no need to go to court for that!)

Proposal for DD: transposition into national law

- **Deadline (Art 36(1) DD)**
 - Member States required to transpose new provisions of Recast Directive within a period of **24 months (= 2 years)** after its date of entry into force (= twentieth day following publication in EU Official Journal, Art 38 DD).

Proposal to amend CDR: streamlining of procedures

- **Requirements for the representation of designs (Art 36(1),(c),(5), 36a CDR)**
 - design representation to allow all details of subject-matter of protection sought for to be clearly distinguished and published, regardless of the means used
 - future implementing act to further update requirements (currently in Art 4 IR 2245/2022)
- **Multiple applications (Art 37 CDR)**
 - abolition of unity of class requirement but maximum cap of 50 designs introduced
- Procedure for the declaration of invalidity (Art 52, 53, 53a CDR)
 - future delegated act to include fast track option

Proposal to amend CDR: streamlining of procedures

- Notification & Communication (Art 66 & new Art 66c CDR)
 - henceforth **only by electronic means**
- Cancellation of register entries and revocation of decisions (new Art 66h CDR)
 - provision added in line with Art 103 EUTMR to allow for that
- Continuation of proceedings (new Art 67a CDR)
 - provision added in line with Art 105 EUTMR to allow for that
- Rules on professional representation (Art 77 & 78 CDR)
 - extension to cover entire European Economic Area (EEA) in line with Art 119 & 120 EUTMR

Proposal to amend CDR: Adjustment of EU design fees

- Fees addressed in basic Regulation (Art -106aa(1), Annex I CDR, Recital 24 Amend. Reg.) in line with EUTMR, making Fees Regulation 2246/2002 redundant (therefore repealed!)
- Simplification of schedule for more efficiency and transparency (e.g. merging registration and publication fee, abolishing other fees e.g. for transfer, flat bulk discount for multiple applications)
- Amount of fees changed to make protection more attractive for SMEs & individual designers
- Unity of class requirement deleted for easier filing of multiple applications at bulk discounts
- Renewal fees partly increased to contribute to designs being only kept on Register if utilized (for lack of use requirement compared to trade marks)

Proposal to amend CDR: Adjustment of fees

Cost of first 5 year period No of designs per application	Current	New
Application fee (incl. publication) for 1 design	350€	250€
Extra fee for each design from the 2nd to 10th design	175€	125€
Extra fee for each design from 11th design onwards	80€	125€
Cost of each renewal for another 5 year period		
1st renewal	90€	70€
2nd renewal	120€	140€
3rd renewal	150€	280€
4th renewal	180€	560€

Proposal to amend CDR: alignment to TFEU

- Alignment of Commission powers with Art 290 & 291 TFEU to enact secondary legislation:
 - requires certain rules currently contained in IR 2245/2002 to be incorporated into the basic EUDR (as involving essential elements of legislation!)
 - requires “comitology” powers currently conferred under Art 107 CDR to be converted into specific delegated and implementing powers in accordance with Art 290 & 291 TFEU
 - strictly following approach of EUTMR reform for sake of consistency
 - resulting in new empowerments being added: Articles 28a, 36a, 37a, 42a, 44a, 47b, 49a, 50c, 50f, 50h, 51a, 53a, 55a, 64a, 65a, 66a, 66d, 66f, 66i, 67c, 70a, 73a, 75a, 78a, 98a, 105a, and -106a CDR

Proposal to amend CDR: phased entry into force

- Necessary alignment of Commission powers to enact secondary legislation requires transitional regime for amendments to CDR becoming applicable (see Art 3 Amend. Reg.), similar to that provided for in Art 4 of Regulation (EU) 2015/2424 amending CTM Regulation (EC) 207/2009:
 - amendments not dependent on new secondary legislation being enacted (in form of delegated or implementing acts) to become applicable **3 months after entry into force**;
 - amendments dependent on such new secondary legislation to become applicable only **18 months after entry into force**

Proposal to amend CDR: Amendment to IR 2245/2002

- Transitional period until delegated/implementing acts are effective requires interim adaptation of IR 2245/2002 to mirror proposed amendments to the basic CDR:
 - complementary draft Implementing Regulation to amend IR 2245/2002 was published on 7 Dec 2022 on the Better Regulation Portal for feedback
 - Member States experts will have to be consulted in the relevant Comitology Committee before this draft amending Regulation can be adopted by the Commission
 - timing of that adoption will require coordination with adoption of the revision of the CDR to ensure same date for amendments to both CDR and IR becoming applicable

State of play and outlook

- **Council**

- Initiatives package introduced in CWP on 19/12/22
- Article-by-article reading of proposals already concluded in CWP on 20/03/23
- 2nd Pres rev. text on Directive & 1st Pres rev. text on Regulation for CWP on 20/06/22
- General approach aimed for July/September

- **European Parliament**

- MEP G. Lebreton (FR, ID Group) appointed Rapporteur in JURI Committee on 28/02/23
- First preliminary exchange in JURI on 25/04/23
- Draft report due for presentation in JURI on 03/07/23
- Final votes in JURI and EP Plenary expected for 22-23/10/23 & 08/11/23

Conclusion

- Package involves a significant, coherent step in updating and further harmonising the law
 - **fulfilling the objectives** of making it future-proofed, more accessible and efficient across entire EU, as well as of completing a single market for spare parts
 - **meeting stakeholder needs and demands** in response to solid and ample consultation and based on thorough analysis and research
 - **without succumbing to the temptation of over-interfering with a well-performing system.**
- Promising progress in Council confirms prospect of package being adopted by co-legislators rather smoothly and well in time before end of term.

Thank you

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Efforts to modernise EU legislation on design protection

The GRUR activities over time

Prof. Dr. Alexander Bulling, Patent Attorney, Stuttgart



Agenda

13 June 2023
Brussels

- **Timeline Community Design**
- **GRUR activities related to:**
 - **First Public Consultation (2019)**
 - **Second Public Consultation (2021)**
 - **EU-Design Reform Package (2022/2023)**

Timeline Community Design

- 1991 Green Paper: 157 pages plus Regulation/Directive (Draft)
- 1998 Designs Directive: 21 Articles
- 2002 Community Designs Regulation (CDR): 118 Articles**
- 2006 Amended by Council Regulation No. 1891/2006
- 2015 Economic Review (2015): 252 pages
- 2016 Legal Review (2016): 165 pages plus Annex 1 – 4
- 2018 Roadmap for First Public Consultation (2018)
- 2019 First Public Consultation (2019): 59 Questions**
- 2021 Second Public Consultation (2021): 18 Questions**
- 2022 EU-Design Reform Package** (Feedback period: 28.11.2022 – 31.01.2023)
 - Proposal for a directive COM(2022)667
 - Proposal for a regulation COM(2022)666
- 2023 (?) Approval and entry into force of Design Reform Package**

2019 – First Public Consultation

GRUR position I:

- Further harmonization
 - of the national laws to eliminate the remaining gaps (Q4, Q6)
 - of Design Regulation and the Design Directive: neither the indication of the products nor the description shall affect the scope of protection of the design (Q7)
- Renaming German wording “Gemeinschaftsgeschmacksmuster” to “Unionsdesign” (Q8)
- Protection of spare parts by designs (GRUR’s Design Law Committee vs. GRUR’s Anti-Trust Law Committee) (Q16)
- Supplementary protection under Unfair Competition Law, Copyright and Trademark law is essential (Q18)
- Importance of national designs (Q20)
- Design search option (Q31)

GRUR position II:

- Improvement of online tools (e.g., request for invalidation) (Q32)
- “visibility” and “intended use” requirement (Article 4 CDR): Contradiction between the scope of protection and the protection requirement
Proposal: Amending Article 4 CDR that “visibility” and “intended use” are no requirement for protection but only limitation of the scope of protection (no infringement as long as design is not visible) (Q39)
- More strict use of clarity and consistency requirement (Q42)
- New forms of designs: Animated designs and graphical user interfaces (ten views and video-clips) (Q43)
- Clarification of international jurisdiction (e.g., action in Germany when offered via internet and sold in Germany) (Q47)
- Further harmonization between IR trademarks and IR designs (Q51)

2021 – Second Public Consultation

GRUR position I:

- Exclusion of protection of Spare parts: a date should be specified and exclusion from protection should only apply to designs applied for thereafter (Q3)
- New types of designs (Q4):
 - Nonphysical objects as holographs, firework, lightshows
 - Combination visual and acoustic elements as video sequences
 - Rather critical: Pure smells or pure sounds/jingles or voices
- Definition “set of articles” and “get-ups” and its harmonization via a convergence program (Q6)
- Clarify limitations to design rights (non-commercial and experimental purposes, citations, teaching) (Q7, 8, 9)
- Clear distinction between design and copyright law (Q10, 11, 12)

GRUR position II:

- No objections to novelty examination (Q16)
- Reject a use-requirement for designs (Q17)
- Design-marking “© + country code + registration number” (Standard ISO 16016:2017-08) (Q18), e.g., © EU12345678
- Further aspects (Q19)
 - Better protection for designs using 3D printing methods (e.g., protection of the “data stream” defining the design)
 - Regulations concerning the clarity and consistency of designs and providing a related ground for invalidity
 - No exclusion of AI autonomously created designs

2022 – EU Commission proposal

GRUR position I:

- On November 28, 2022, the Commission adopted two proposals to modernise the legislation on design protection,
 - a “Proposal for a Regulation amending the **Community Designs Regulation**” and
 - a “Proposal for a **Directive** on the legal protection of designs (recast)”
 - Feedback period only eight weeks (over Christmas and new year)
- Formal remarks
 - Not anymore *Gemeinschaftsgeschmacksmuster* or *Geschmacksmuster* but *Design* or *Unionsdesign* (under German legislation in 2014 *Geschmacksmuster* was replaced by *Design*)
 - Inconsistencies between the German and the English text versions (e.g., Article 25 Directive)
 - New articles are inserted between existing articles (e.g., Articles 20a, 28a, 32a; 33a); better to renumber articles
- Regulation and the Directive
 - Regulation and Directive should contain the same provisions of substantive law
 - Important procedural provisions should be also the same



GRUR position I: Views

- **Commission:**
Still limitation to 7 views (Art. 4 (2) CDR)
 - **GRUR:**
Seven views not enough for
 - complex / complicated products
 - animated, moving or altering designs
- See presentation from Sabine Kossak



KR Design D20110100 (Bags with towel and purse)



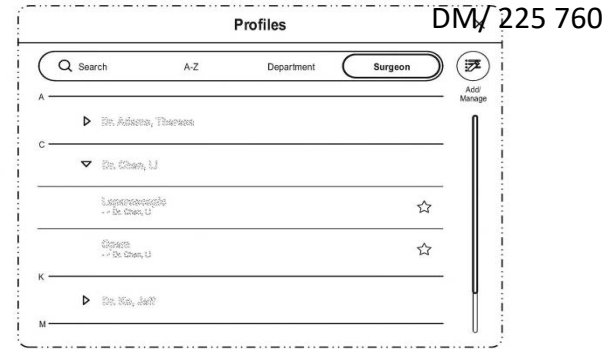


GRUR position II: Visual disclaimer

- **Commission:**
Visual disclaimer (Article 26 (6) Dir.)
 - Dotted or broken lines or
 - Shading, boundaries or blurring
- **GRUR:**
 - Proposal is unclear and vague
 - See presentation from Sabine Kossak



RCD 4247229-0001



RCD 8634380-0002



GRUR position III: Altering Designs

- **Commission:**

Possibility to alter the representation of the design in immaterial details (Art. 47 (2) CDR)

- **GRUR:**

Proposal is welcome

➤ See presentation from Sabine Kossak

GRUR position IV: Unregistered EU design (territory)

- **Commission:**

Article 110a (5) sentence 2 CDR shall be removed, stating that a “design which has not been made public within the territory of the Community shall not enjoy protection as an unregistered Community design”

- **GRUR:**

leads to legal insecurity

➤ See presentation from Hennig Hartwig

GRUR position V: Repair Clause

- **Commission:**

Introduction of a Repair Clause (Article 19 No. 3 Directive)

- **GRUR:**

If a repair clause is inserted, it should clearly be limited to must match parts (“form-dependent parts”)

➤ See presentation from Torsten Dilly

GRUR position VI: Non-binding novelty search

- GRUR would welcome it if the EUIPO was to offer a non-binding novelty search upon request
- Search should not be limited to the Locarno classification of the design, since the concept of novelty is not bound to any Locarno classification
- Search offers at least a certain degree of legal security with respect to the validity of the design
- Other Offices also offer searches (USPTO, UK Intellectual Property Office, Korean Intellectual Property Office, Japan Patent Office, Israel Patent Office, Russian Patent Office etc.)

GRUR position VII: “Product”

Article 1 (4) (b) CDR: Legal definition “**product**”, providing the appearance for a design, should be broaden due to nonphysical designs

(4) ‘**product**’ means any ~~industrial or handicraft~~ item other than computer programs, regardless of whether it is embodied in a physical object or materialises in a digital form, including:

(b) graphic works or symbols, logos, surface patterns, typographic typefaces, graphical user interfaces, light installations, and multimedia works, including projections, holograms and video sequences; (...)”

GRUR position VIII: Priority

- **Commission:**

Article 41 (1) limits the claiming of the priority right to design or utility model application

- **GRUR:**

There is no apparent reason why a priority right of a patent or trademark application (especially for a logo or a 3d-trademark) shall not be possible

GRUR position IX: Format of representation of a RCD

- **Commission:**

EUIPO: Where the representation of a RCD application is provided electronically, the format of the electronic file is **JPEG** (Article 9 Decision Exe. Director of Nov. 3, 202)

- **GRUR:**

In the future it should be possible to submit the representation of the design also in other formats, especially in a **.pdf** format. The **.pdf** format is the most common format among the users of the system.

**2023 (?) – Approval and entry into
force of Design Reform Package**



GRUR is curious about the upcoming amendments and would be pleased to provide further recommendations while this is still possible!



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studied mechanical engineering at the University of Stuttgart and IP-Law at the Humboldt University of Berlin, where he obtained his doctoral degree in law (Dr. jur.). He has been working as a patent attorney in Stuttgart since 1999. Since 2004, Mr. Bulling has been lecturing Patent and Design Law at the University of Stuttgart, where he was appointed as an honorary professor in 2011. Among others, he is author of the study script *Principles of Design Law* of the University of Hagen and co-author of the handbook *Design Law in Germany and Europe*. From 2016 to 2023 he has been chair of the GRUR Committee on design law.

Thank you for your attention!
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**Representation of a registered design
(limitation of views, visual disclaimer,
alteration of representation)**

The GRUR position

Dr. Sabine Kossak, Patent Attorney, Hamburg



Agenda

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- **Limitation of views**
- **Visual disclaimer**
- **Alteration of the representation**

Limitation of views



- Article 4 (2) Community Designs Implementing Regulation (current):

2. The representation may contain no more than seven different views of the design.





GRUR comments

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- No seven-view limitation!
- Abandon seven-view limit to allow for a higher number of representations (as design regimes of many other countries already do)



- Article 26 (3) Directive provides:

The reproduction shall show all the aspects of the design for which protection is sought in one or more views.

- Proposal adding sentence:

There is no limitation as to the number of views representing the design.



Practical implications

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- Existing limitation causes severe restrictions for design protection under EU design regime compared to other jurisdictions
- Disadvantage for tech industry and protection of digital designs



Practical implications

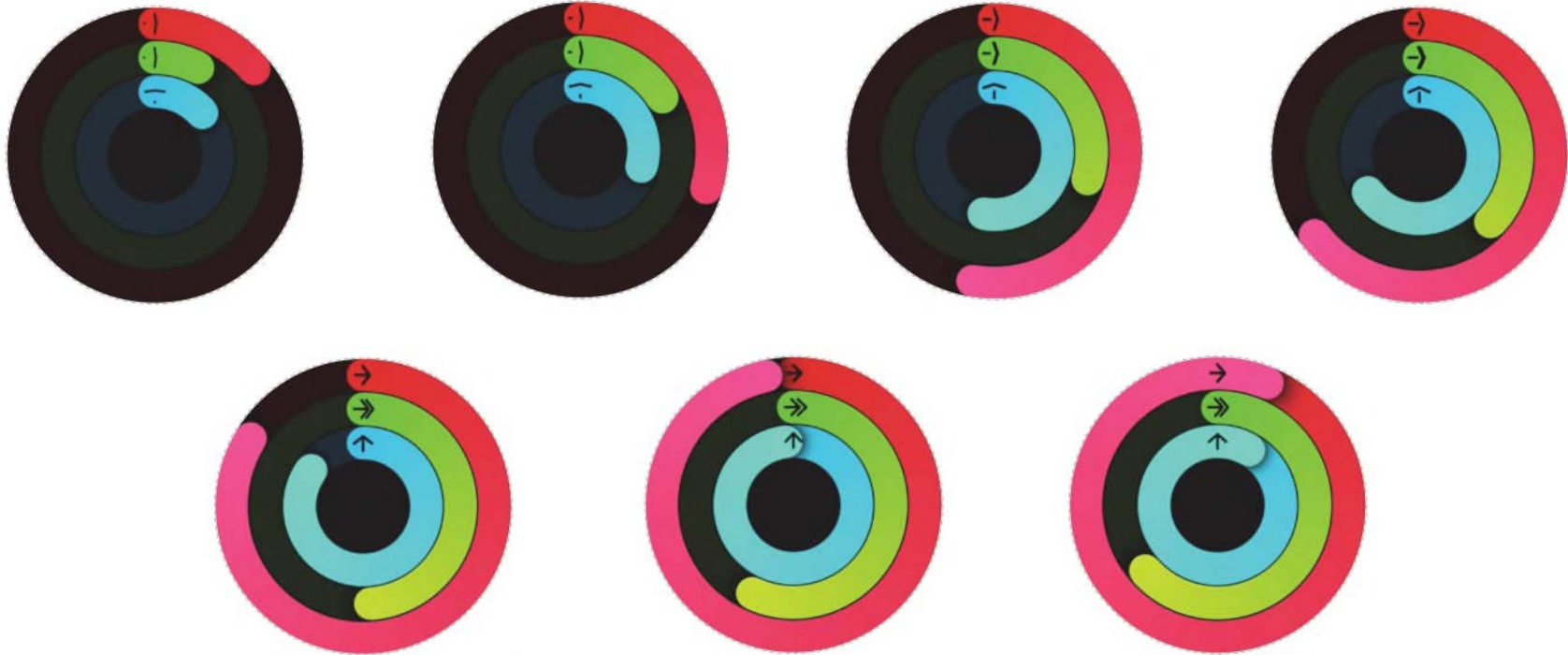
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- Representation of complex or “complicated” products may require filing of more than seven views
- Representation of animated, moving or altering digital designs such as GUIs may require filing of more than seven views



Practical implications

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RCD 2765396-0009 “Animated Graphical User Interfaces”



Practical implications

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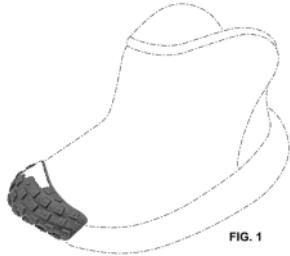


FIG. 1



FIG. 2



FIG. 3

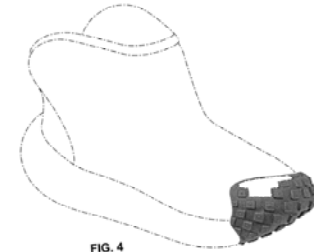


FIG. 4



FIG. 5

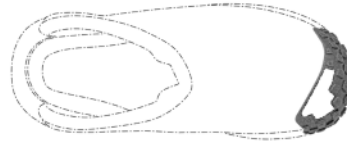


FIG. 6

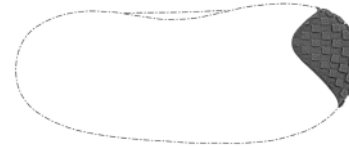


FIG. 7

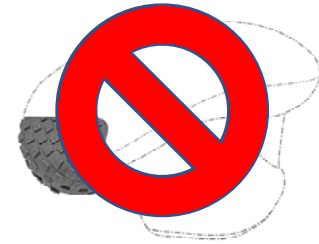


FIG. 8

US D 984,789 S

Visual disclaimer



Status quo (law and practice)

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- No legally binding convention on visual disclaimers in Directive or Regulation
- Practice: EUIPO Guidelines “*Examination of applications for registered community designs*”



EU Commission proposal

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- New Article 26 (3) Directive:

*The **reproduction** shall show all the aspects of the design for which protection is sought in one or more views.*

- New Article 26 (6) Directive:

Matter for which no protection is sought shall be indicated by way of visual disclaimers, preferably in the form of dotted or broken lines. If this is not possible for technical reasons or because of the type of design concerned, other visual disclaimers may be used, such as shading, boundaries or blurring.



GRUR comments

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- Suggested language in Article 26 (6) may have major implications on design practice
- Lack of clarity as to meaning and legal impact of different types of lines



- Meaning of “dotted or broken lines” unclear
- International practice “broken lines”, “broken lines”

include e.g.

- dotted lines

- dashed lines - - - - -

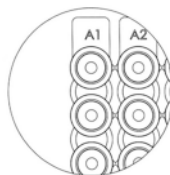
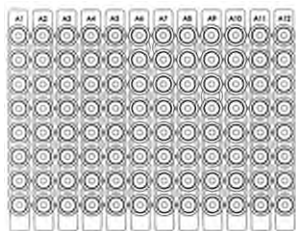
- dot-dashed lines - . - . - . - . -




GRUR comments

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“Circles”



RCD 19113 690-0002
Sec. 5.3.3. Examples for **acceptable magnified view**



RCD 2182238-0002
Sec. 5.4.4. Examples for **correct boundaries as disclaimer**

From EUIPO Guideline “Examination of applications for registered community designs”



- “Circles” could be used
 - showing disclaimed matter or
 - as magnified views showing a specific part of an overall design on an enlarged scale
- Circles should not be used as visual disclaimers



- Article 26 (6) Directive:

Subject matter for which no protection is sought shall be indicated by way of visual disclaimers, preferably in the form of nonsolid lines, namely dashed, dot-dashed, or dot-dot-dashed lines. Alternatively, shading, blurring or colour shading can be used. Any such visual disclaimers shall be used consistently. Examples are shown in Annex 3.



GRUR comments

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- “other visual disclaimers, such as shading, boundaries or blurring”
- “boundaries” unclear, as “boundaries” shown by “non-solid lines”



Blurring

RCD 3502574-0001



IR 200 906



Color shading RCD 8634380-0002



Practical implications

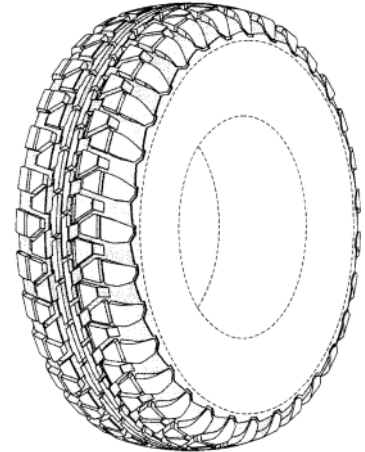
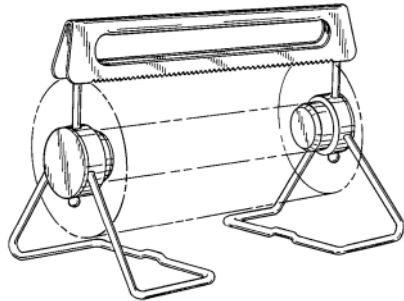
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- Dotted lines as disclaimer?
- Stitching?



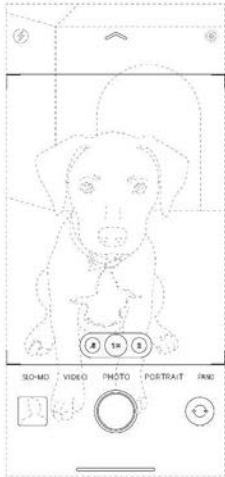
Example: RCD 7310750-0001

- International harmonization
- US design patent practice: parts of the article of manufacture that is not claimed shown in broken lines

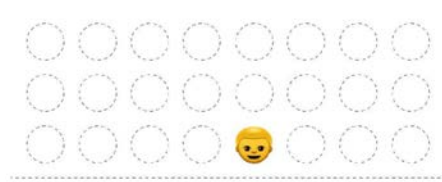


Source: USPTO Design patent application guide

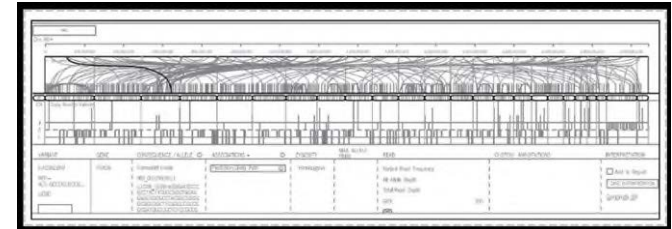
- Broken lines – food for thought



RCD 7733027-0001
dashed lines



RCD No 2954453-0001
dashed lines



IR No 102120
dashed lines?



Practical implications

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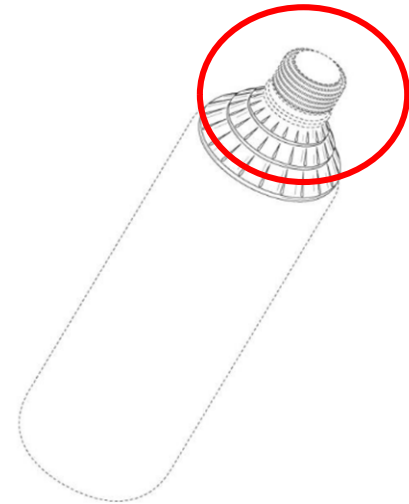
- Broken lines – food for thought



RCD 3012475-0001
dot-dashed lines



RCD 4247229-0001
dot-dashed lines

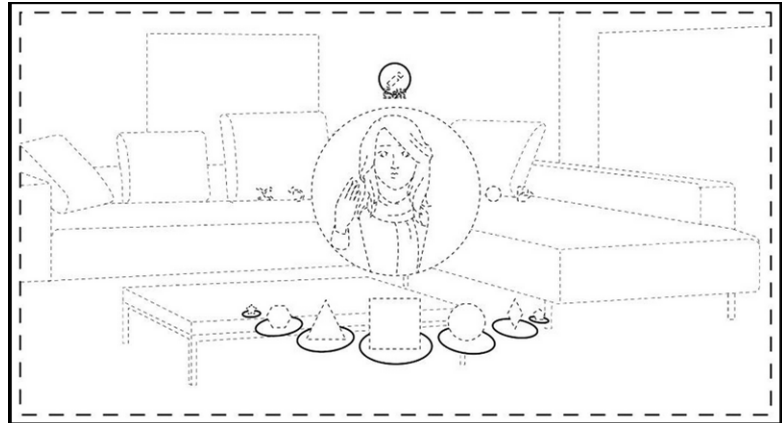


IR 201 443
dotted lines

- Broken lines – food for thought



US D730,754
dotted lines



IR No. D207838
broken lines and circles

Alteration of the representation

- Article 11 (2) Implementing Regulation (current):

The Office shall specify a time limit within which the applicant may submit his/her observations, withdraw the application or amend it by submitting an amended representation of the design, provided that the identity of the design is retained.

- Article 12 (2) Implementing Regulation (current):

Only the name and address of the applicant, errors of wording or of copying, or obvious mistakes may be corrected, at the request of the applicant and provided that such correction does not change the representation of the design.

- ECJ C-217/17 P MAST-Jägermeister:

Thus, it should be noted, as EUIPO correctly submits, that Article 12(2) of Regulation No 2245/2002 provides that a correction of the application for registration cannot change the representation of the design concerned. (Recital 59)

- Article 47 (2) Regulation:

In the notification referred to in paragraph 1, the Office shall specify a period within which the applicant may submit observations, withdraw the application or the objected views or submit an amended representation of the design that differs only in immaterial details from the representation as originally filed.

- Article 47a (2) Regulation:

The applicant may at any time amend the representation of the EU design applied for in immaterial details.

- Article 50e (1) Regulation:

The representation of the registered EU design shall not be altered in the Register during the period of registration or on renewal thereof except in immaterial details.



- Wording of Article 47a (2) and 50e (1) Regulation is less precise than language of Article 47 (2) and, specifically, Article 5 (2) Regulation
 - ▶ Legal uncertainty and source of potential dispute



- Comparison between registered EU design **as originally filed** and registered EU design **in its altered version**
- **Not**: Between representation/view of registered EU design as originally filed and representation/view of the registered EU design in altered version
- Proposed test (like Art. 5 Regulation) whether one design, taken **as a whole**, differs only in immaterial details from another



- Comparison between features of the registered EU design as originally filed and of registered EU design in altered version as established under novelty test, without distinguishing between major versus minor, characteristic versus non-characteristic, etc.
- Notion of Article 5 (2) Regulation test is and should be whether the features of registered EU design as originally filed and the features of the registered EU design in its altered version **differ only in immaterial details**



- Article 47 (2) Regulation should read as follows:
In the notification referred to in paragraph 1, the Office shall specify a period within which the applicant may submit observations, withdraw the application or the objected views or submit an amended representation of the design provided that the features of the registered EU design as originally filed and of the registered EU design in its altered version differ only in immaterial details.



- Article 47a (2) Regulation should read as follows:
The applicant may at any time amend the representation of the EU design applied for if and to the extent that the features of the registered EU design as originally filed and of the registered EU design in its altered version differ only in immaterial details.



- Article 50e (1) Regulation should read as follows:
The representation of the registered EU design shall not be altered in the Register during the period of registration or on renewal thereof except where, to the extent that, the features of the registered EU design as originally filed and of the registered EU design in its altered version differ only in immaterial details.



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Disclosure in case of unregistered EU designs (territorial scope)

The GRUR position

Dr. Henning Hartwig, Attorney-at-Law, Munich



Agenda

13 June 2023
Brussels

- **Status quo (law and practice)**
- **EU Commission proposal**
- **GRUR comments**
- **Practical implications of the EU
Commission proposal**

Status quo (law and practice)

- Article 11 (1) CDR: A design which meets the requirements under Section 1 shall be protected by an unregistered Community design for a period of three years as from the date on which **the design was first made available to the public within the Community**. (*positive wording*)

- Article 11 (2) Sentence 1 CDR: For the purpose of paragraph 1, a design shall be deemed to have been made available **to the public within the Community** if it has been published (...) in such a way that, in the normal course of business, these events could reasonably have become known to the **circles specialised in the sector concerned, operating within the Community.** *(positive wording)*

- Article 110a (5) Sentence 2 CDR: Pursuant to Article 11, a design **which has not been made public within the territory of the Community** shall not enjoy protection as an unregistered Community design. (*negative wording*)

- According to a prevailing opinion taken in law and practice, the (negative) wording of Article 110a (5) Sentence 2 CDR is only declaratory because the (positive) wording of Article 11 (1) CDR is clear (“first made available to the public within the Community”).

- Article 11 (1) CDR: First made available to the public within the *[territory of the]* **Community**
- Not: first made available to the **EU public**
- Not: first made available to the circles specialised in the sector concerned, **operating within the** *[territory of the]* **Community** (obscurity test)

- German Federal Supreme Court, decision of October 9, 2008 – I ZR 126/06, para 17 – Bakery Press:

The wording of Article 11 CDR does not expressly rule out that a first disclosure outside the Community can also be sufficient for protection to arise if this could have been known to the relevant circles specialized in the sector concerned, operating within the Community.

- German Federal Supreme Court, decision of October 9, 2008 – I ZR 126/06, para 17 – Bakery Press:
However, the wording of Article 11 (2) sentence 1 CDR, with respect to the repeated reference to the territory of the **Community**, already suggests that disclosure within the Community is necessary for protection to arise.

- German Federal Supreme Court, decision of October 9, 2008 – I ZR 126/06, para 17 – Bakery Press:

A comparison with Article 7 CDR, which determines when a design is made available to the public and therefore belongs to the existing design corpus, also speaks in favor of this interpretation. This provision does not provide for publication within the Community, which precisely points to a difference between Article 7 and Article 11 CDR.

- Court of Justice of the EU, decision of February 13, 2014 – C-479/12, para 33 – Garden Pavilion:

(...) it can be seen from the wording of the first sentence of Article 7 (1) CDR that it is not absolutely necessary, for the purpose of applying Articles 5 and 6 of that regulation, for the events constituting disclosure to have taken place within the European Union in order for a design to be deemed to have been made available to the public. (*argumentum e contrario*)

- Jestaedt, in: Jestaedt/Fink/Meiser (ed.), German Designs Act/CDR, **2023**, 7th edition, Article 11 para 9
- Maierski, in: Zentek/Gerstein (ed.), German Designs Act, **2022**, A II para 207
- Ruhl/Tolkmitt, CDR, **2019**, 3rd edition, Article 11 para 17
- Starcke, Der Schutz der Gestaltung von Gebrauchsgegenständen, **2018**, 26-27
- George, in: Hasselblatt (ed.), CDR, **2018**, 2nd edition, Article 11 para 11
- Stone, EU Design Law, **2016**, 2nd edition, para 18.13
- Von Mühlendahl, in Hartwig (ed.), Design Protection in Europe, Volume 1, **2007**, 148 margin no. 3.3 *et seq.*

Finally back to TRIPS-compliance? EU design law and the criterion of publication 'within EU territory'

Annette Kur

I. Introduction

On 28 November 2022, the EU Commission published its proposals for amendment of the Community Design Regulation (CDR)¹ and a recast of the Design Directive.² Among the changes proposed—including the long-awaited introduction of a repair clause³ and the extension of limitations to referential use and the use for purposes of comment, critique and parody⁴—figures the rather inconspicuous proposition that the second sentence of what is now Art. 110a(5) CDR should be deleted.⁵ Expressed in more explicit language, this means that the CDR will no longer stipulate that, in order for an unregistered Community design (UCD) to come into existence, the design must first be published 'within the territory of the EU'. This could mean that EU law finally gets rid of a provision that *de facto* discriminates against non-EU nationals and thereby violates Art. 3(1) TRIPS. However, as nothing is said in the explanatory memorandum about the motives for the deletion, and given that the wording of the CDR is somewhat ambiguous, the exact objectives and repercussions of the proposed change remain uncertain.

Before that background, this contribution highlights the reasons for incompatibility of the current regulation with international law and recommends that the requirement of the first publication within EU territory should be deleted for good or should be replaced by a less discriminatory type of 'anchor event'. The same

The author

Annette Kur is an affiliated research fellow at the Max Planck Institute for Innovation and Competition in Munich, where she held a tenured position until her retirement in 2015. She is the author of books and numerous articles on national European and international trade mark and design law and on choice of law and international jurisdiction.

Abstract

To enjoy protection under the title of unregistered Community design, novel designs must have been published 'within the territory' of the European Union (EU). A corresponding provision—referring to UK territory—has been inserted into the UK legislation on supplementary unregistered design.

Both provisions are arguably incompatible with international obligations, as they regularly imply a *de facto* discrimination against foreigners.

In its proposal for amendment of the Community Design Regulation (CDR) published on 28 November 2022, the EU Commission has now taken a step back from its former position by proposing the deletion of the relevant sentence in Art. 110a(5) CDR. Nevertheless, as long as the wording of the law remains ambiguous, uncertainties will linger about its effect. To avoid undesirable consequences, the solution adopted should be expressed as clearly as possible, with the UK hopefully following the same approach.

1 Proposal for a Regulation of the European Parliament and of the Council amending Council Regulation (EC) No 6092/2002 on Community design and repealing Commission Regulation (EC) No 2246/2002 (COM/2022/047 final).

2 COM/2022/047—Proposal for a Directive of the European Parliament and of the Council on the legal protection of designs (recast).

3 COM/2022/047 art 19, COM/2022/047 art 20.

4 COM/2022/047 art 10(1)(d) and (e), COM/2022/047 art 20(1)(d) and (e).

5 COM/2022/046, amendment no. 126 (in art 110e, the second sentence is deleted), in the current version of the CDR, art. 110a(5), 2nd sentence made. Pursuant to article 11, a design which has not been made public within the territory of the Community shall not enjoy protection as an unregistered Community design (emphasis added).

EU Commission proposal

- GRUR notes that Article 110a (5) sentence 2 current Regulation is **removed** while Article 11 current Regulation remains **unchanged**
- No explanation for the removal
- Source of legal uncertainty
- Also noted by other stakeholders (ECTA, INTA, MARQUES)

GRUR comments



- Should it have meant “first made available to the public anywhere” it should read “first made available to the public” as in case of Article 7 (1) sentence 1 Regulation (*argumentum e contrario*)



GRUR comments

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- Two provisions merely two sides of the same medal
- Existing Community design law and practice compatible with international obligations (TRIPS)
- No *de facto* discrimination against foreigners
- WTO Member States have authority to impose conditions for the acquisition of an IP right for its territory



- For example: Events or actions taking place in the territory, such as the application for patent or trademark protection or the **commencement of use to establish trademark protection through use** (like in Germany)



GRUR comments

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- No discrimination of non-German companies over German companies
- Rather, companies from WTO Member States are treated equally in the sense that whoever wants to establish trademark protection through use must show use in Germany



GRUR comments

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- Many non-German companies active in Germany
- Many German companies active abroad
- Some German companies even less active in Germany (and more active abroad) than some non-German companies
- Lack of empirical data demonstrating protectionist character of Article 11 CDR



- Not against TRIPS when linking the protection of unregistered designs to a domestic event (be it use or publication)
- Both TRIPS and the Paris Convention only require that all members be treated equally



- GRUR notes that – to the best of our knowledge – not a single tribunal ever argued that existing EU design law and practice was incompatible with international obligations (TRIPS), allegedly implying a *de facto* discrimination against foreigners



- During two rounds of extensive evaluation, the EU Commission did not address the issue of whether disclosure in case of unregistered Community designs should be unlimited
- GRUR takes the position that Article 110a (5) Sentence 2 current Regulation should **not be removed**



- **Likewise:**
 - APRAM
 - Federal Association of German Patent Attorneys
 - Federation of the European Sporting Goods Industry
 - German Chamber of Patent Attorneys



- **No comments** (for instance): CITMA and JIPA
- **Different:**
 - BMM (“location of disclosure applicable on unregistered designs must be in line with the rules on disclosure affecting the validity of designs”)
 - Max Planck Institute for Innovation and Competition (“place of publication matters little”)



- **Alternate wording** of Article 11 (1) Regulation: “A design which meets the requirements under Section 1 shall be protected by an unregistered EU design for a period of three years as from the date on which the design **was first made available** to the public within the territory of the Union provided that the design **was not made available** to the public outside the territory of the Union before that date.”

Practical implications of the EU Commission proposal



- Legal uncertainty would return to daily practice
 - Establishing EU rights limited to the territory of the EU could depend on **facts and evidence established abroad in languages** such as, for instance, Japanese, Mandarin, Korean, and Hebrew

- Legal uncertainty would return to daily practice
 - **Physical disclosure** established abroad will trigger extensive discussions as to where such event “could reasonably have become known to the circles specialised in the sector concerned, operating within the Community”

- German Federal Supreme Court, decision of January 29, 2004 – I ZR 163/01, para 11 – Computer Casing
 - In the sector of computer casings, the Taiwanese market is to be taken into account by the relevant circles when considering prior art. Publication of a design in an advertisement in a foreign professional journal does not in itself have the result that this design (...) could reasonably have become known to the relevant circles before the date of publication (...).



- Online disclosure allows non-EU companies to establish protection
 - Established law and practice that, as a rule, virtual disclosure allows for establishing protection under the regime of the unregistered EU design right



Practical implications

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- Online disclosure allows non-EU companies to establish protection
 - The “Ferrari” saga ...
 - <https://www.allcarindex.com/blog/2014-ferrari-fxx-k/>



Practical implications

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Practical implications

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ALLCARINDEX
Discover unknown



BREAKING – Ferrari FXX K unveiled

DEZ. 03, 2014

2014 FERRARI FXX HYPERCAR

SUPERCAR

Ferrari has issued the following press release:

BREAKING – Ferrari FXX K unveiled

DEZ. 03, 2014

2014 FERRARI FXX HYPERCAR

SUPERCAR

Ferrari has issued the following press release:

WORLD PREMIERE OF THE FXX K AT THE FERRARI FINALI MONDIALI IN ABU DHABI

Maranello, 2 December 2014 – Ferrari's new FXX K research and development programme receives its world premiere next weekend at the Yas Marina Circuit in Abu Dhabi. The laboratory-car is based on Maranello's first hybrid model and will grace the world's tracks from next year onwards. The K in its moniker is a reference to the "KERS" kinetic energy recovery system it adopts in maximising its track performance.



Practical implications

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Practical implications

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Dr. Hennig Hartwig's practice involves prosecution and litigation of IP rights in the fields of trademark, design, copyright and unfair competition law, with a focus on industrial design law, particularly multinational infringement proceedings and invalidity proceedings before the EUIPO and the Court of Justice of the EU, including the landmark case "*Nintendo v Bigben*". As the editor of the four-volume casebook "Design Protection in Europe", the only one of its kind, Hennig has unique access to unpublished decisions of Community and national design infringement courts throughout Europe. He is also the editor of the brand-new "Research Handbook on Design Law" ([Research Handbook on Design Law \(e-elgar.com\)](#)). You can follow him on Twitter: @HenningHartwig_

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The Commission's proposals for a repair clause in the Regulation and the Directive

The GRUR position

Dr. Torsten Dilly, Senior Legal Counsel, BMW AG, Munich*

* Presentation does not reflect BMW AG's position



Agenda

13 June 2023
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- **Status quo (law and practice)**
- **EU Commission proposal**
- **GRUR comments**

DIRECTIVE 98/71/EC (“Design Directive”)

Article 14 Design Directive requires member states to maintain

“existing legal provisions relating to the use of the design of a component part used for the purpose of the repair of a complex product so as to restore its original appearance”



and allows the introduction of changes

“to those provisions only if the purpose is to liberalise the market for such parts.”

➤ “freeze-plus”



COUNCIL REGULATION (EC) No 6/2002 (“CDR”)

Recital 13 CDR states that, for a transitional period, no protection shall be conferred as to

“a Community design for a design which is applied to or incorporated in a product which constitutes a component part of a complex product upon whose appearance the design is dependent and which is used for the purpose of the repair of a complex product so as to restore its original appearance.”



Article 110 CDR provides that

“protection as a Community design shall not exist for a design which constitutes a component part of a complex product used within the meaning of Article 19 (1) for the purpose of the repair of that complex product so as to restore its original appearance.”



Complex product

is “a product which is composed of multiple components which can be replaced permitting disassembly and re-assembly of the product.”

(Judgment of the Court in joined cases C-397/16 and C-435/16, Acacia, margin no. 64)

Component parts of a complex product

are “components, intended to be assembled into a complex industrial or handicraft item, which can be replaced permitting disassembly and re-assembly of such an item, without which the complex product could not be subject to normal use.”

(Judgment of the Court in joined cases C-397/16 and C-435/16, *Acacia*, margin no. 65)



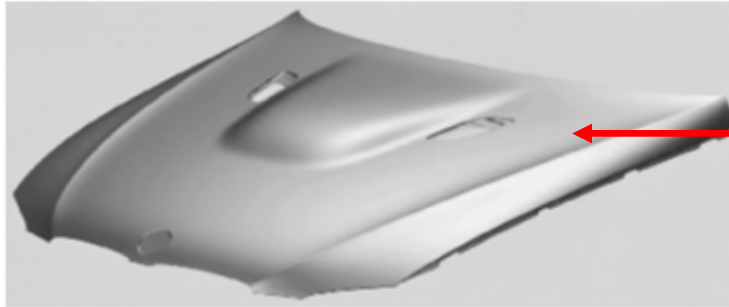
Form-dependent parts (= fixed-shape parts / must-match parts) are

“parts whose shape is in principle immutably determined by the appearance of the complex product and cannot therefore be freely selected by the customer.”

(Judgment of the Court in joined cases C-397/16 and C-435/16, Acacia, margin no. 30)

Form-dependent part:

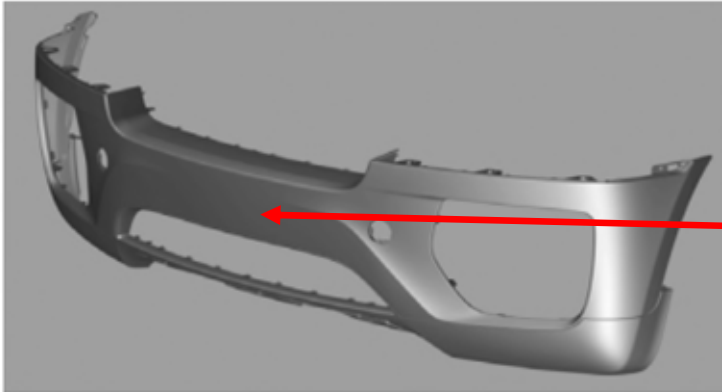
➤ bonnet





Form-dependent part:

- bumper





Non-form-dependent part:

➤ vehicle wheels

Same vehicle

equipped with

different wheels





Status quo

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Same vehicle wheel
used on
different vehicles



Non-form-dependent part:

Parking system for
a vacuum cleaner nozzle





Non-form-dependent part:

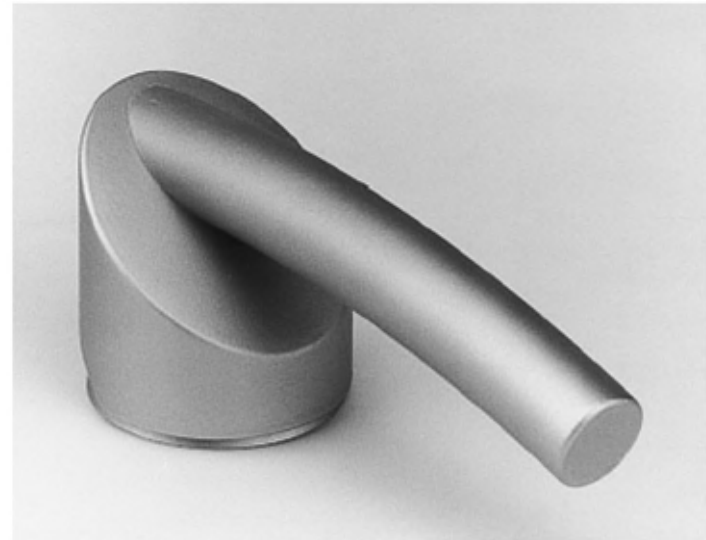
vacuum cleaner handle tube





Non-form-dependent part:

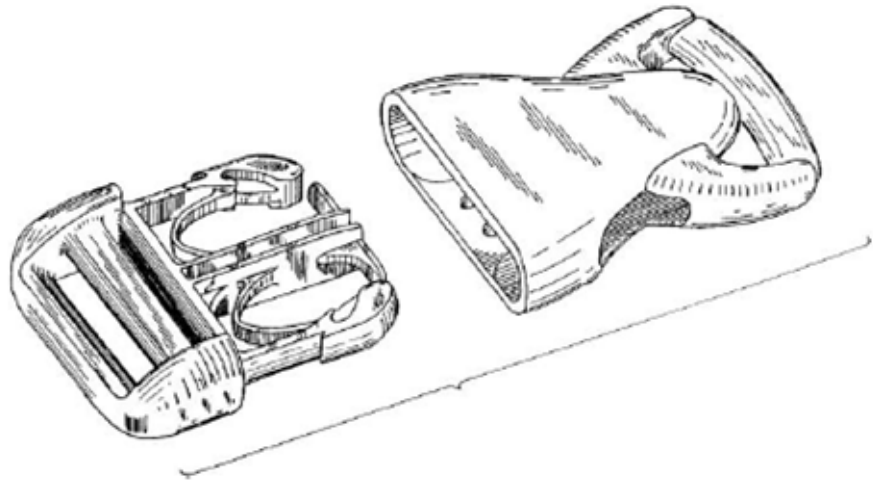
Sanitary fittings





Non-form-dependent part:

Clasp





Judgment of the Court in joined cases C-397/16 and C-435/16, Acacia

- The

“protected design’s dependence upon the appearance of the complex product is not one of the conditions listed”

in Article 110 CDR.



- Article 110 CDR applies only

“to component parts that are visually identical to original parts.”



- The manufacturer / seller is

“under a duty of diligence as regards compliance with the conditions” under Article 110 CDR.

This includes

- information duties,
- use of contractual means,
- obligation to refrain from certain sales.

EU Commission proposal

Directive on the legal protection of designs (recast) (“Directive”)

- The Commission has proposed introduction of Article 19 Directive.
- Article 19 Directive contains a repair clause similar to Article 110 CDR but limited to must-match parts.



EU Commission proposal

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- The manufacturer/seller needs to comply with certain information duties.

- In member states where no repair clause was in force at the time of adoption of the Directive, protection is granted for another period of ten years as of the date when the Directive enters into force for designs applied for before such date.

- **Article 19 Directive: Repair clause**

(1) Protection shall not be conferred on a registered design which constitutes a component part of a complex product, upon whose appearance the design of the component part is dependent, and which is used within the meaning of Article 16 (1) for the sole purpose of the repair of that complex product so as to restore its original appearance.

(2) *Paragraph 1 cannot be invoked by the manufacturer or the seller of a component part of a complex product who failed to duly inform consumers, through a clear and visible indication on the product or in another appropriate form, about the origin of the product to be used for the purpose of the repair of the complex product, so that they can make an informed choice between competing products that can be used for the repair.*

(3) Where at the time of adoption of this Directive the national law of a Member State provides protection for designs within the meaning of paragraph 1, the Member State shall, by way of derogation from paragraph 1, continue until ... [OP please insert the date = ten years from the date of entry into force of this Directive] to provide that protection for designs for which registration has been applied before the entry into force of this Directive.

Regulation on Community designs (“Regulation”)

- Introduction of repair clause as Article 20a Regulation
- Limited to must-match parts
- The manufacturer/seller needs to comply with certain information duties

- **Article 20a Regulation: Repair clause**

(1) *Protection shall not be conferred on an EU design which constitutes a component part of a complex product, upon whose appearance the design of the component part is dependent, and which is used within the meaning of Article 19(1) for the sole purpose of the repair of that complex product so as to restore its original appearance.*

- **Article 20a Regulation: Repair clause**

(2) *Paragraph 1 cannot be invoked by the manufacturer or the seller of a component part of a complex product who have failed to duly inform consumers, through a clear and visible indication on the product or in another appropriate form, about the origin of the product to be used for the purpose of the repair of the complex product, so that they can make an informed choice between competing products that can be used for the repair.*

- **Recital 16 Regulation:**

“Furthermore, for the sake of coherence with the repair clause inserted into Directive (EU) [XXX], and in order to ensure that the scope of design protection is only restricted to prevent design right holders from actually being granted product monopolies, it is necessary to explicitly limit the application of the repair clause set out in Regulation (EC) No 6/2002 to component parts of a complex product upon whose appearance the protected design is dependent.”

GRUR comments



- Should a repair clause be inserted, it should be limited to must-match parts (so called “form-dependent parts”).
 - Form-dependent parts are the only parts for which it could potentially be argued that design rights could provide more than a monopoly for a shape.
 - This is not the case for non-form-dependent parts.



- Strict compliance with the conditions for the derogation must be ensured by manufacturer or seller of component part.

(see Judgement of the Court in joined cases C-397/16 and C-435/16, Acacia, margin no. 85-89 for the relevant criteria as listed below)



➤ Information of downstream users

- that component concerned incorporates third party design

and

- that the part is intended exclusively to be used for the purpose of the repair of the complex product so as to restore its original appearance.



- Manufacturer/seller must ensure, through appropriate means, in particular contractual means, that downstream users do not intend to use the component parts at issue in a way that does not comply with the conditions under Article 20a (1) Regulation.



- The manufacturer/seller must refrain from selling such a component part where they know or, in the light of all the relevant circumstances, ought reasonably to know that the part in question will not be used in accordance with the conditions under Article 20a (1) Regulation.



- Article 19 (2) Directive
and
Article 20 (2) Regulation
should be amended accordingly.



- If a repair clause was inserted in national law following adoption of Directive, it should apply only to designs applied for after adoption of the national law came into force.
 - Required for compliance with guarantee of property
 - Article 19 (3) Directive should be amended accordingly



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Dr. Torsten Dilly is a Senior Legal Counsel with BMW AG's legal department in Munich. He is responsible for trademark and design matters as well as legal issues related to intellectual property law in certain EU countries. He also co-leads BMW AG's Centre of Competence for IP contracts. Prior to joining BMW AG, Torsten worked for international law firms in Munich, London and Frankfurt. He is a member of GRUR's special committee for design law and a certified lawyer for intellectual property law. Torsten has been awarded "European Counsel for Intellectual Property" in 2011 by International Law Office in association with ACC Europe and has been listed by WTR continuously since 2017 as one of the "WTR 300: The World's Leading Corporate Trademark Professionals".

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The GRUR position and the feedback from other stakeholders

Christian Spintig, Attorney-at-Law, Hamburg



Agenda

13 June 2023
Brussels

- **In summary: Other stakeholders' views on the GRUR positions already presented today**
- **The GRUR position on other important points of the EU Commission proposal**

**In summary:
Other stakeholders' views on the GRUR
positions already presented today**



In summary

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- **Number of views**
 - GRUR Position: There shall be no limitation as to the number of views representing the design
 - Shared by ECTA/INTA/Marques

- **Alteration of the representation**
 - GRUR Position: Comparison must be made between registered EU design as originally filed and registered EU design in its altered version. Suggested language of Commission's proposal not precise enough
 - ECTA/INTA/Marques: Share position re. lack of precision. Concerned about possible misuse. The term "immaterial details" should be clarified by adding examples to the provisions.

- **Visual disclaimers**

- GRUR Position: Lack of clarity re. exact nature, meaning, legal impact of different lines (“dotted lines”, “broken lines”, “dashed lines”, “dot-dashed lines”...)
- ECTA/INTA/Marques advocate harmonization of representation issues in the CDIR and the Directive



- **Unregistered designs – disclosure / territory**
 - GRUR position: Article 110a (5) Sentence 2 current Regulation should not be removed.
 - Shared by APRAM, Federal Association of German Patent Attorneys, Federation of the European Sporting Goods Industry, German Chamber of Patent Attorneys
 - ECTA/INTA/Marques request at least some sort of justification/clarification from the Commission; wording of Article 11 (1) CDR could lead to clarification (alternate wording of Article 11 (1) proposed by GRUR)

■ Repair Clause

- GRUR position: Should a repair clause be inserted it should be limited to must-match parts (“form-dependent parts”). If a repair clause becomes national law, it should apply only to designs applied for after adoption of the national law came into force.
- ECTA/INTA/Marques find that the limitation to must-match parts is a deviation from the CJ’s case-law (Acacia, C-397-16), which should be clarified.
- AIRC et al.: restriction to must-match unjustified. 10-year transition period not justified, a period of up to 3 years would provide sufficient time for Member States to implement the Directive into national law. Similar: Austrian Federal Chamber of Labour (BAK); SMEUnited

- **Novelty search**

- GRUR position: EUIPO should offer a non-binding novelty search upon request by the design owner or a third party.
- Many major Offices conduct novelty searches; the EUIPO has the experience (EUTM searches) and the tools for image searches.



- **Priority right**
 - GRUR position: Article 41 (1) current Regulation limits the claiming of the priority right to design right or utility model; should be extended to trademarks (esp. 3-D) and patents.
 - Shared by Federal Association of Patent Attorneys (DE)

The GRUR position on other important points of the EU Commission proposal



- **Number of designs in multiple applications**
 - **Status quo:** Article 37(1) CDR: No limitation
 - **EU Commission proposal:** Article 37(1) up to 50 designs
 - **GRUR comments:** Under the Hague Agreement, a maximum of 100 is possible
 - **Practical implications:** Higher fees for “multiple-multiple applications”

- **Classification and product indications**
 - **Status quo:** Article 40 (1) CDR: Reference to Locarno Classification only
 - **EU Commission proposal:** Article 40 (2) = separate designs must be filed if product falls in more than one subclass
 - **GRUR comments:** Not justified; example of an undesired burden for SMEs
 - **Other stakeholders:** Business Europe shares GRUR's view

- **Language regime in invalidity proceedings**
 - **Status quo:** Article 98 (4) CDR: Language of invalidity proceedings is the language of the application. If the language of the application is not a language of the EUIPO, the second language shall be the language of the proceedings.
 - **EU Commission proposal:** No change proposed
 - **GRUR comments:** The language rules in *inter partes* cases should be the same as for EU trademarks.
 - **Practical implications:** Proceedings are usually simpler when a “common” language is chosen. This is de facto English in the vast majority of cases.

■ Fees

➤ Status quo:

Registration Fee: 1st Design: € 230, 2nd-10th € 115, 11th-onw. € 50

Renewal Fee: 1st Renewal € 90, 2nd € 120, 3rd € 150, 4th € 180

➤ EU Commission proposal:

Registration Fee: 1st Design: € 250, 2nd-onw. € 125

Renewal Fee: 1st Renewal € 70, 2nd € 140, 3rd € 280, 4th € 560

➤ GRUR comments: Massive increase not justified; as far as Hague registrations are concerned, the difference is even larger.

➤ Other stakeholders: Shared by ECTA/INTA/Marques: at odds with Recital 6 (“improving the accessibility and affordability...”), unifab, FESI (particularly concerned with respect to large entities); LVHM particularly concerned about fees for 3rd and 4th renewal

■ “Alicante torpedo”

- **Status quo:** Article 91 (1) CDR: A Community design court must stay infringement proceedings where the validity of the Community design is already in issue, particularly in invalidity proceedings before the EUIPO. A declaratory non-infringement action (NDA) does not have to be stayed
- **EU Commission proposal:** No change proposed
- **GRUR comments:** Favors the “Alicante torpedo” regardless of the merits of the validity attack; probability standard should be applied. Different treatment of NDAs not justified
- **Practical implications:** Enforcement outside of preliminary proceedings hampered

■ Right of prior use

- **Status quo:** Only provided for in the CDR, but not in the Design Directive
- **EU Commission proposal:** Implementation of Article 21 in the Directive
- **GRUR comments:** Provision should clarify that the right of prior use also covers cross-border scenarios within the EU.
- **Other stakeholders:** Shared by Business Europe, CITMA, PAK; ECTA/INTA/Marques and MPI wish the new provision to be aligned with Article 22 CDR; Finnish Bar Association wants clarification re. burden of proof; APRAM opposes a right of prior use



- **Bad faith as a ground for invalidity**
 - **Status quo:** Not provided for in the CDR or in the Design Directive
 - **EU Commission proposal:** No change proposed
 - **GRUR comments:** Bad faith should be added to the grounds for invalidity in Article 25 CDR and Article 14 Proposed Directive, similar to the provisions in the EUTMR and the Trademarks Directive

- **Sector specialty principle?**
 - **Status quo:** According to CJEU (21.09.2017, C-361/15 P & C-405/15 P (Easy Sanitary Solutions BV/EUIPO v Group Nivelles), a Community design cannot be considered new if an identical design has been made available to the public before, even if that earlier design was intended to be incorporated in or applied to another product.

- **Sector specialty principle?**
 - **Recital 33 Proposed Directive:** “The purpose of design protection is to grant exclusive rights to the appearance of a product, but not a monopoly over the product as such. Protecting designs for which there is no practical alternative would lead in fact to a product monopoly. Such protection would come close to an abuse of the design protection regime.”



- **Sector specialty principle?**
 - **Belgian Group of AIPPI (ANBBPI / BNVBIE)** advocates for an amendment of the Regulation and the Directive to overrule the current interpretation as given by the CJEU

- **Publication of international designs**
 - **Status quo:** Not provided for
 - **EU Commission proposal:** No change proposed
 - **ECTA/INTA/Marques:** A requirement for the EUIPO to publish Hague designs designating the EU in its own database could, e.g., be achieved by amending Article 71 of the CDIR. This would align design and trademark law (as well as international practice with the US and JP) and make searches in the EUIPO database complete and more user friendly. The second reason: clarifying the scope of protection of EU designations, in particular regarding the number of views.



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Christian Spintig has specialized in the areas of trademarks, designs and competition law, including copyright-related aspects. His trademark and design work includes both prosecution and litigation. Christian represents clients from a variety of industries before the national German Office and courts, before the EUIPO as well as before the General Court and the Court of Justice of the EU; he is frequently involved in cross-border matters. Christian is a co-author of *Hasselblatt (ed.)*, Community Design Regulation (2nd ed. 2017) and chaired INTA's Designs Committee during the 2020-2021 term. He is a member of the GRUR Expert Committee on Design Law and has worked as an auditor in the EUIPO's SQAP Project on design invalidity decisions.

Thank you for your attention!
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