European Commission

These slides accompany the explanation of the acquis to Albania and North Macedonia and can only be used for that purpose. Their content is subject to further development of the acquis and interpretation by the Court of Justice of the European Union.

INDUSTRIAL DESIGN PROTECTION IN THE EU

European Commission, DG GROW

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1. Acquis on design protection

- **Directive 98/71/EC (DD)** of the European Parliament and of the Council of 13/10/1998 on the legal protection of designs: harmonizes main substantive aspects of design law for registered design rights (Art 2 DD).

- **Council Regulation (EC) No 6/2002 (CDR)** of 12/11/2001 on Community designs (implementing rules in COM Reg.(EC) No 2245/2002 & 2246/2002): establishes unitary system in parallel to national design systems (Principle of co-existence!).

- **Substantive provisions are the same** in both instruments and based on unique (autonomous) concept for the protection of designs (**Design approach**!).

2. Subject-matter of protection

- **Definition of design** (Art 1(a) DD): appearance of whole/part of a product, resulting from features of, in particular, the lines, contours, colours, shape, texture and/or materials of product itself and/or its ornamentation.

- Only sense of sight relevant to design rights (Recital 14 CDR).

- Product-oriented (see interplay between Art 1(a) and (b)), incl. graphic symbols/topographic typefaces, but excl. software.

- Parts of complex products qualify as protectable products (Art 1(b)) but protection is restricted (see following slides).

3. Protection requirements

- **Novelty** (Art 4 DD): no identical design made available to the public before date of filing of the application for registration.

- **Individual character** (Art 5 DD, reflects design approach): overall impression needs to be different from existing design corpus (considering degree of designer freedom).

- **Disclosure** (Art 6(1) DD): relevant prior art not limited to certain product categories (CJEU, C-361/15 & C-405/15, shower drainage channel) and covers what could reasonably be known by EU professional circles (exclusion of obscure disclosures!).

- **12 months grace period** (Art 6(2), (3) DD) to disclose and attempt to commercialise design (Recital 20 CDR) during which disclosure does not count as prior disclosure.

4. Exclusions from protection

- **Component parts** incorporated into a **complex product** (i.e. that can be replaced after disassembly) which are **not visible during normal use** of the product (Art 3(3), (4) DD).

- **Features** of appearance of a product which are **solely dictated by its technical function** (Art 7(1) DD). This is the case **where considerations** other than the need for that product to fulfil its technical function, in particular those **related to the visual aspect**, **have not played any role** in the choice of those features, even if other designs fulfilling the same function exist (CJEU, C-395/16, DOCERAM, para. 31).

- Designs **contrary to public policy or morality** (Art 8 DD).

5. No harmonization for spare parts

- **Transitional provision** (Art 14 DD, 'freeze plus' clause).
- Allows Member States **to retain their existing laws relating to parts used for the purpose of the repair of a complex product** so as to restore its original appearance until amendments of the Directive are adopted, but permitting only to amend those laws if purpose is to liberalize the market.
- No single market in that area due to different national regimes (majority still provides design protection).
- Proposal (COM(2004) 582 final) for introduction of a Repairs Clause (as contained in Article 110 CDR) withdrawn in 2014.

6. Scope of protection & rights conferred

- **Scope of protection** (Art 10 DD) extends to any design in the same or a different product category that fails to produce a different overall impression.
  - Protection of a registered design is objective, i.e. the establishment of copying is not necessary;
  - Mirrors protection requirements (Art 5 DD) and its check forms part of infringement assessment.

- **Exclusive right conferred** (Art 12 DD) **to use** and **prevent third parties** not having the consent **from using the design**.
  - Such use covers, in particular, the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes.

7. Term of protection

- Registered design to be **protected for one or more periods of five years** from date of filing the application (Art 10 DD).

- Art 10 DD deviates from wording of Art 12 CDR where the initial period is described as "a period of five years from the date of filing of the application".

- **Most EU Member States have an initial term of five years** to be consistent with CDR (even though it could also be 10, 15 or even 20 years).

- **Renewal** at any rate cannot be more or less than **five years**.

8. Grounds of refusal/invalidity

- Mandatory grounds (Art 11(1) DD):
  - CD not a design within meaning of Art 1(a);
  - Requirements for protection of Art 3 to 8 are not fulfilled;
  - Lack of entitlement of applicant/holder of design right;
  - Conflict with a prior registered design right.
- Optional grounds (Art 11(2) DD):
  - Conflict with earlier distinctive sign;
  - Conflict with earlier copyright;
  - Improper use of flags and other symbols.

9. Specific features of CD system

- Protection available in two forms (Art 1(2) CDR):
  - as **registered Community design ('RCD')** with the European Union Intellectual Property Office (EUIPO), protected for 5 years (renewable up to total of 25 years);
  - as **unregistered Community design ('UCD')**, obtainable without registration for 3 years from date of disclosure and (contrary to registered CD) effective against copying only (!).
- Contains Repairs Clause (transitional Art 110 CDR).
- Infringement proceedings handled by national courts designated as CD courts (Art 80, 81 CDR).

10. Ongoing evaluation of acquis

- Extensive evaluation of overall functioning launched in 2014.
- Aim is to see whether design acquis is still fit for purpose.
- Two studies published so far in that framework:
  - Economic review of industrial design in Europe (January 2015);
  - Legal review on design protection in Europe (May 2016).
- Public consultation launched on 18/12/2018 (**open until 15/04/2019**) to complement information/evidence base:
  - https://ec.europa.eu/info/law/better-regulation/initiatives/ares-2018-3527248/public-consultation_en
- Legislative reform initiative for new Commission to decide on.