

The RCD is dead – Long live the EU design!

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On November 18, 2024, the text of “Regulation (EU) 2024/2822 of the European Parliament and of the Council of October 23, 2024, amending Council Regulation (EC) No 6/2002 on Community designs and repealing Commission Regulation (EC) No 2246/2002” (“*EU Designs Regulation*”)¹ and the text of “Directive (EU) 2024/2823 of the European Parliament and of the Council of October 23, 2024, on the legal protection of designs (recast)” (“*Designs Directive*”)² were published in the Official Journal of the European Union.

I. No major changes to the overall system of design protection

After a total of ten years of preparation and consultation, the European Union (“EU”) finally arrived at some sort of “new” design law, which, however, when taking a closer look, does not seem to provide for any drastic changes. This certainly is because the former Community design regime proved to be a great success in daily practice, also thanks to being trimmed like an Imperial Bonsai by the EUIPO and Community design courts over the past 20 years. In particular, EU design law will, for very good reasons, continue to provide for **protection without substantive examination**. Applicants of EU designs will therefore continue profiting from fast and sound application proceedings at the EUIPO, allowing design registrations within a few days. Notably, this pole position compared to major other jurisdictions such as the United States, Japan, or China, comes with overall no significant fee increases in sight.

And: Article 25 (3) Designs Directive now explicitly provides that the (mandatory) indication of the products in which the design is intended to be incorporated or to which it is intended to be applied (“title”) shall not affect the scope of protection of the design. That shall also apply to a description, and to any verbal disclaimers included therein, explaining the representation of the design if such a description is provided for by a Member State. This is a clear statement that, under EU law, it’s all about **design protection** (“What you see is what you get”). Unlike under, for example, trade dress or trademark law, a EU design showing, for instance, a hat is innately as such configured to also protect against reproductions of the hat’s design in any other product category (for example, against flower pots, parasols or swimming pools with that design).

II. Some changes in detail

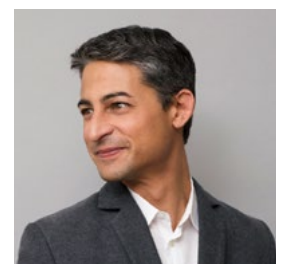
Nonetheless, both the amended EU Designs Regulation and the recast Designs Directive



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¹ OJ L 2822, 18.11.2024, p. 1.

² OJ L 2823, 18.11.2024, p. 1.

contain some significant changes, starting with **formalities** and **fees**.

As part of the reform package, the term “Community design” is replaced by “EU design” (from a German-speaking perspective, it is certainly a downer that the German language version retains the term “Geschmacksmuster” and does not use the term “Design”, which has already been introduced in German design law). It is very much hoped that the linguistic adaptation will still be made as part of the planned codification of Regulation 6/2002, especially since the German version of, for instance, Article 14 (1) lit e Designs Directive already goes ahead and uses the term “Unionsdesign” instead of “Gemeinschaftsgeschmacksmuster”.

One aim of the reform project was to adapt the legal regulations to the digital age and developments in information technology. Accordingly, the definition of “design” in Article 3 (1) EU Designs Regulation and Article 2 No. 3 Designs Directive is supplemented (“appearance of the whole or part of a product resulting from the features, including movement, change of state or any other way of animating those features”). The same is true for extending the definition of “product” to **non-physical objects**, according to Article 3 (2) EU Designs Regulation and Article 2 No. 4 Designs Directive. This codification follows the established practice of the EUIPO, which has been accepting applications for graphical user interfaces and animated designs for many years.

It remains to be seen which other forms of representation will be accepted once the EU Designs Implementing Regulation and the Guidelines of the EUIPO and the national

offices enter into force in order to allow for a perfect representation of the subject matter of the design.

Article 26 (1) Designs Directive already provides for a reproduction which “may be static, dynamic or animated and shall be effected by any appropriate means, using generally available technology, including drawings, photographs, videos, computer imaging or computer modelling.” For applicants, it would be desirable – also in view of harmonizing the practice of other offices and synchronism with EU trademarks – if the EUIPO also permitted the representation of the design via videos and/or would **abandon the restriction to seven views** provided for in Article 4 (2) of the current Community Designs Implementing Regulation. However, given that no changes in that regard can be found in the draft of the EUIPO’s new Design Guidelines published a few days ago, we should not be too optimistic about fast changes – even 3D computer-animated design generating motion simulation continues to only be considered as an additional technical means of viewing the design, not replacing conventional static views.

In order to reduce the administrative burden at the EUIPO, the **system of fees for EU designs** has also been changed. The new fee structure entails several important changes. Firstly, the separate publication fee will be abolished, so that only a registration fee of 350 EUR and no more publication fee will be payable when applying for an EU design. In the case of multiple applications, there will only be a standardized fee of 125 EUR for all additional designs from the 2nd design onwards. This leads to a reduction in fees for the 2nd to 10th design and a significant increase from 50 EUR to 125 EUR from the

11th design onwards. Collective applications with many designs will become more expensive in future.

Another important point is the significant increase in the renewal fees for European Union designs and the renewal fees for international registrations under the Hague Agreement. This means that IP right holders must expect higher costs when renewing the EU part of their international design registrations.

The fees for invalidity proceedings and appeal proceedings will be reduced. In addition, a number of formal fees, such as fees for transfers and file inspections, will be completely eliminated, which will further reduce the administrative burden and costs for design owners. These changes are aimed at making the system more efficient and cost-effective.

III. Significant changes to substantive law

Furthermore, both the amended EU Designs Regulation and the recast Designs Directive contain some significant, often hidden, **changes to substantive law** (mostly in the interest of rights holders) that appear to require careful consideration in the proceedings before the EUIPO, the national offices, and the EU design courts.

Following established case law, the new EU design law confirms that protection is granted only for those **features of appearance visibly reproduced** in the application. The representation of the design and the perceptibility of the features of appearance are, therefore, fundamental for justifying design protection. Consequently, Article 36 (1) lit c EU Designs Regulation

requires, for the granting of a filing date, a sufficiently clear representation of the design, which permits the subject matter for which protection is sought to be determined. Reproduction and the correct choice of views will therefore continue to gain in importance, both when obtaining and enforcing protection. Comparable provisions have been included in Article 25 (1) Designs Directive. However, it is nevertheless generally still admissible to file a design for a 3D product with a single representation.

Pursuant to Article 47a EU Designs Regulation, the applicant may at any time **amend the representation of the EU design** applied for in immaterial details. According to Article 50e EU Designs 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**. In return, the previous Article 25 (6) Community Designs Regulation according to which a registered Community design could be maintained in an amended form if in that form it complies with the requirements for protection and the identity of the design is retained, was abandoned. While this is good news for EU design holders, there is no corresponding provision in the new Designs Directive, *i.e.*, the previous provision of Article 11 (7) of the old Designs Directive has been abolished without being replaced by provisions corresponding to Article 47a and Article 50e EU Designs Regulation. This discrimination of national designs over EU designs is a highly irritating legislative misstep and extremely unfortunate.

An important change to substantive law, which has not yet been addressed accordingly in the public debate, is the intro-

duction of a ground for invalidity under Article 14 (2) Designs Directive. Accordingly, Member States may provide that a design right is to be declared invalid, where the design contains a “total or partial reproduction of elements belonging to cultural heritage that are of national interest”. This is an interesting move because one would assume that the **cultural heritage** (such as, for instance, the Leaning Tower of Pisa, the Tour Eiffel, or Schloss Neuschwanstein) belongs to the existing design corpus so that a design which contains a total or partial reproduction of elements of prior art may lack novelty or, at least, individual character. Time will tell in which fields this new ground for invalidity will be of practical importance, but at least for fashion industry this could become a game changer for design filings in the endless fields of prints or patterns. Interestingly, the EU Designs Regulation does not provide for such a ground for invalidity.

The EU design law reform package now also includes a final regulation regarding design protection for components of a complex product (“repair clause”). With Article 20a EU Designs Regulation, the repair clause is now included as a **permanent provision for EU designs** and, in its current version, replaces the previous transitional provision. The corresponding new provision of the repair clause under Article 19 Designs Directive makes the repair clause for spare parts **mandatory for all Member States** and thus harmonizes the legal situation within the EU, overcoming significant differences in the laws of the Member States on the use of protected designs for the purpose of permitting the repair of a complex product so as to restore its original appearance.

On the merits, after a long struggle and weighing up the interests of IP holders on the one hand and the preservation of the free market and consumer rights on the other, the repair clause will remain part of EU design law, albeit in a modified form. Accordingly, component parts of complex products that are used to repair the products (“spare parts”) are excluded from design protection, which allows defendants to raise the corresponding **defense to infringement**.

However, in the case of such spare parts, there is now an obligation to inform customers clearly and unambiguously about the origin of the spare parts so that they can make an informed decision. The exemption is also limited to spare parts that may only be used for repair purposes. However, manufacturers or dealers are not obliged to check the actual use of the parts. Compared to the previous repair clause in Article 110 Community Designs Regulation, the new law **applies to molded parts** (“component part of a complex product upon whose appearance the design of the component part is dependent”), such as a fender or a hood (not: wheel rims). Thus, the amended repair clause falls short of Court of Justice case law (C-397/16 and C-435/16), which had found for a broader application of the repair clause.

Another defense to infringement, which is completely new in EU design law, can be found in Article 20 (1) lit e EU Designs Regulation and Article 18 (1) lit e Designs-Directive. Accordingly, rights conferred by a design right upon registration shall not be exercised in respect of acts carried out for the purposes of comment, critique, or parody. While there is a similar provision under European copyright law, it appears unclear how the **use of a design for the purpose**

of comment, critique, or parody shall qualify in practice. Again, despite the legislator's creativity and innovative approach, only time will tell whether this new defense to infringement will ever prove to have any practical importance.

Changes to substantive law also include the **adaptation of the scope of EU design protection to acts of transit** according to Article 19 (3) EU Designs Regulation and Article 16 (3) Designs Directive. Consequently, the bringing of products, in the course of trade, "(...) from third countries into the Union, that are not released for free circulation in the Union, where the design is identically incorporated in or applied to those products, or the design cannot be distinguished in its essential aspects from such products, and the right holder's authorization has not been given (...)" is now also prohibited even if it is only a transit (transit ban). This extension prevents infringing designs from being imported into the EU or a Member State via transit, which further improves and harmonizes the enforcement of design rights within the EU.

Likewise, the new law provides for an extension of rights to 3D printing. According to Article 19 (2) lit d EU Designs Regulation unauthorized "creating, downloading, copying, and sharing or distributing to others any medium or software which records the design" are explicitly prohibited acts. Based on Article 16 (2) lit d Designs Directive, Member States must create corresponding national provisions. This strengthens the position of rights holders against a newly emerging group of infringers who may act differently from previous plagiarists.

In terms of promoting design protection, rights holders of a registered EU design or a registered national design may now also be allowed to draw attention to their IP rights by using a **registration symbol**. In accordance with Article 26a EU Designs Regulation and Article 24 Designs Directive, the letter D may be displayed on the product in which the design is incorporated or to which it is applied:



This "marketing tool" is intended to make it easier for SMEs and individual designers in particular to sell products protected by designs and to raise awareness of the legal protection of designs at EU and national level. The new registration symbol can be used by owners of EU and national designs and, with their consent, by other parties. It remains to be seen whether the "D in a circle" will become as popular as the "R in a circle" registration symbol commonly used for trademarks. At present, it is still somewhat difficult to find this symbol in common word processing programs or on keyboards.

IV. Status quo of unregistered design rights

Article 3 (1) Designs Directive provides that Member States shall protect designs solely through the registration of those designs. This means that once the Designs Directive has been transposed into national law,

Member States are **not allowed to provide for national unregistered designs**

(as the United Kingdom did before Brexit). Instead, protection for unregistered designs will be provided exclusively by the unregistered European Union design, which offers corresponding protection at European level. However, pursuant to Article 22 Designs Directive, the Designs Directive shall be without prejudice to any provisions of the law of the Member State concerned relating to trademarks (including protection based on acquired distinctiveness merely through use) or other distinctive signs or unfair competition (trade dress).

Apart from that, Article 110a (5) Community Designs Regulation has been deleted, clarifying that pursuant to Article 11 Community Designs Regulation, a design which has not been made public within the territory of the Community shall not enjoy protection as an unregistered Community design. While this is another unfortunate legislative misstep, it is established law and practice that Article 11 EU Designs Regulation read in conjunction with Article 7 (1) EU Designs Regulation must be interpreted as meaning that protection for a design does not arise if it is disclosed, for the very first time, outside the territory of the European Union.

V. Simplification of application procedures

In addition to adapting the Union-wide legal regulations on design law to the digital age, another key aspect of the reform project was the further **simplification of the application procedures** and the reduction of the administrative burden at the EUIPO and the national offices. The EU Designs Regulation and the Designs Directive, therefore, also

contain some procedural changes to reorganize administrative procedures.

As only a small number of Community designs have been filed with the national offices, this channel for filing EU designs will be closed. In the future, **EU designs can only be filed centrally at the EUIPO** in accordance with Article 35 (1) EU Designs Regulation. This relieves the offices of the EU member states of the obligation to provide all necessary systems and information for the application.

The efficiency of the application procedure is also increased by strengthening the multiple application system. One of the main changes in Article 37 EU Designs Regulation is the **removal of the restriction** that all designs in a multiple application must belong to the same Locarno class. This allows applicants to combine several designs in a single application, regardless of their classification.

However, the number of designs that can be filed in a multiple application has been **limited to a maximum of 50**. Previously, the Community Designs Regulation did not provide for such an upper limit, which could lead to very large applications. In the interests of worldwide harmonization, it would have been desirable for the new upper limit to consider Rule 7 of the Common Regulations of the Hague Agreement, which provides for an upper limit of 100 designs per multiple application. When **filing a design application via the Hague system designating the EU**, it may be necessary in the future to divide the application, which does not do justice to the idea of making the application system more efficient and reducing the administrative burden at the EUIPO.

VI. Further practical implications

In terms of **practical implications**, the EU design will remain an attractive IP right for designers even under the amended EU design law. Both the amended EU Designs Regulation and the recast Designs Directive contain a number of useful clarifications and ensure further harmonization of the law in the Member States. In future, multiple applications will be even more widely usable for applicants and make the application more attractive. The costs will also remain competitive in international comparison.

However, the EU Commission missed the opportunity to truly adapt the EU Designs Regulation and the recast Designs Directive to the digital age and to consider and include other aspects beyond the presentation of the design.

In particular, the EU design law reform package does unfortunately not contain provisions on designs **generated autonomously by artificial intelligence**. It is disputed whether such a design can be protected without a human designer. The EU legislator could and should have provided clarity here as to whether protection of AI-generated designs should be possible in principle. Since indicating a designer is not and will not be binding under EU design law, it is for the time being not possible for third parties to identify with legal certainty whether the design originates from a human designer.

VII. Going forward – important deadlines to watch!

The recast Designs Directive was published in the Official Journal on

November 18, 2024, and will therefore enter into force on December 8, 2024 (20 days after its publication). Hence, Member States must in general bring into force the laws, regulations, or administrative provisions necessary to comply with the Designs Directive by **December 9, 2027**, at the latest.

As the amendment to the EU Designs Regulation was also published on November 18, 2024, it will also enter into force on December 8, 2024. However, it will be implemented in several phases. Most of the amendments will take effect four months after their entry into force, *i.e.*, on **May 1, 2025** (Phase I).

Pursuant to Article 19 (4) Designs Directive, there is a grace period until **December 9, 2032**, for those Member State which currently provide protection for spare parts so that there is no defense to infringement in the case of designs for which registration has been applied for before December 8, 2024.

Other provisions that require further development through secondary legislation, such as the implementing regulations and delegated acts, will not take effect until 18 months after their entry into force, *i.e.*, on **July 1, 2026** (Phase II).

In addition, the EUIPO must also implement the changes resulting from the amended EU Designs Regulation. This includes, for example, an update of the **EUIPO Designs Guidelines**, which has been announced for April 2025 and is to take place following a prior user consultation. It will also be necessary to adapt the terminology and numbering of the legal texts in all EUIPO materials and media, as

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well as to feed the new fee structure into the EUIPO's systems.

Even if 2025 may not hold the same historic events for design lawyers as 2024, it will still be an eventful year for practitioners due to the EU's secondary legislation, the conversion of the Designs Directive into national law, and the practical implementation of the changes at the offices.

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