



2022/0392(COD)

15.6.2023

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DRAFT REPORT

on the proposal for a directive of the European Parliament and of the Council
on the legal protection of designs (recast)
(COM(2022)0667 – C9-395/2022 – 2022/0392(COD))

Committee on Legal Affairs

Rapporteur: Gilles Lebreton

(Recast – Rule 110 of the Rules of Procedure)

Symbols for procedures

- * Consultation procedure
- *** Consent procedure
- ***I Ordinary legislative procedure (first reading)
- ***II Ordinary legislative procedure (second reading)
- ***III Ordinary legislative procedure (third reading)

(The type of procedure depends on the legal basis proposed by the draft act.)

Amendments to a draft act

Amendments by Parliament set out in two columns

Deletions are indicated in ***bold italics*** in the left-hand column. Replacements are indicated in ***bold italics*** in both columns. New text is indicated in ***bold italics*** in the right-hand column.

The first and second lines of the header of each amendment identify the relevant part of the draft act under consideration. If an amendment pertains to an existing act that the draft act is seeking to amend, the amendment heading includes a third line identifying the existing act and a fourth line identifying the provision in that act that Parliament wishes to amend.

Amendments by Parliament in the form of a consolidated text

New text is highlighted in ***bold italics***. Deletions are indicated using either the ▯ symbol or strikeout. Replacements are indicated by highlighting the new text in ***bold italics*** and by deleting or striking out the text that has been replaced.

By way of exception, purely technical changes made by the drafting departments in preparing the final text are not highlighted.

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DRAFT EUROPEAN PARLIAMENT LEGISLATIVE RESOLUTION

on the proposal for a directive of the European Parliament and of the Council on the legal protection of designs (recast)

(COM(2022)0667 – C9-395/2022 – 2022/0392(COD))

(Ordinary legislative procedure – recast)

The European Parliament,

- having regard to the Commission proposal to Parliament and the Council (COM(2022)0667),
 - having regard to Article 294(2) and Article 114(1) of the Treaty on the Functioning of the European Union, pursuant to which the Commission submitted the proposal to Parliament (C9-395/2022),
 - having regard to Article 294(3) of the Treaty on the Functioning of the European Union,
 - having regard to the Interinstitutional Agreement of 28 November 2001 on a more structured use of the recasting technique for legal acts¹,
 - having regard to Rules 110 and 59 of its Rules of Procedure,
 - having regard to the report of the Committee on Legal Affairs (A9-0000/2023),
1. Adopts its position at first reading hereinafter set out, taking into account the recommendations of the Consultative Working Party of the legal services of the European Parliament, the Council and the Commission;
 2. Calls on the Commission to refer the matter to Parliament again if it replaces, substantially amends or intends to substantially amend its proposal;
 3. Instructs its President to forward its position to the Council, the Commission and the national parliaments.

Amendment 1

Proposal for a directive

Recital 7

Text proposed by the Commission

(7) In its **report** of 10 November 2021 on **the** intellectual property action plan²⁸ the European Parliament welcomed the

Amendment

(7) In its **resolution** of 11 November 2021 on **an** intellectual property action plan²⁸ the European Parliament welcomed

¹ OJ C 77, 28.3.2002, p. 1.

Commission's willingness to modernise the Union legislation on design protection, called on the Commission to further harmonise the application and invalidation procedures in the Member States, and suggested to reflect upon aligning Directive 98/71/EC and Regulation (EC) No 6/2002 with a view to creating greater legal certainty.

the Commission's willingness to modernise the Union legislation on design protection *in order to better support the transition to a sustainable and digital economy*, called on the Commission to further harmonise the application and invalidation procedures in the Member States, and suggested to reflect upon aligning Directive 98/71/EC and Regulation (EC) No 6/2002 with a view to creating greater legal certainty.

²⁸ **Report** on an intellectual property action plan to support the EU's recovery and resilience (2021/2007(INI)).

²⁸ **European Parliament resolution of 11 November 2021** on an intellectual property action plan to support the EU's recovery and resilience (2021/2007(INI)) (*OJ C 205, 20.5.2022, p. 26*).

Or. fr

Justification

These are the terms used in paragraph 32 of the European Parliament resolution of 11 November 2021 on an intellectual property action plan to support the EU's recovery and resilience.

Amendment 2

Proposal for a directive Recital 13

Text proposed by the Commission

(13) The attainment of the objectives of the internal market requires that the conditions for obtaining a registered design right be **identical** in all the Member States.

Amendment

(13) The attainment of the objectives of the internal market requires that the conditions for obtaining a registered design right be **uniform** in all the Member States.

Or. fr

Justification

It being a directive and not a regulation, the term 'identical' seems too strong; the term 'uniform', already used in paragraph 35 of the report (2021/2007), seems preferable.

Amendment 3

Proposal for a directive Recital 18

Text proposed by the Commission

(18) While design features **do not need** to be visible at **any particular time** or in **any** particular situation in order to **benefit from design** protection, as an exception to this principle, protection should not be extended to those component parts which are not visible during normal use of a complex product, or to those features of such part which are not visible when the part is mounted, or which would not, in themselves, fulfil the requirements as to novelty and individual character. Therefore, those features of design of component parts of a complex product which are excluded from protection for these reasons should not be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection.

Amendment

(18) While design features **need to be visible to benefit from design protection, it is not necessary for those features** to be visible at **all times** or in **a** particular situation in order to **qualify for such** protection; as an exception to this principle, protection should not be extended to those component parts which are not visible during normal use of a complex product, or to those features of such part which are not visible when the part is mounted, or which would not, in themselves, fulfil the requirements as to novelty and individual character. Therefore, those features of design of component parts of a complex product which are excluded from protection for these reasons should not be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection.

Or. fr

Justification

Linguistic clarification.

Amendment 4

Proposal for a directive Recital 27

Text proposed by the Commission

(27) The substantive grounds for non-registrability and the substantive grounds for the invalidation of registered design rights in all the Member States should be exhaustively enumerated.

Amendment

(27) **For reasons of legal certainty**, the substantive grounds for non-registrability and the substantive grounds for the invalidation of registered design rights in all the Member States should be exhaustively enumerated.

Or. fr

Justification

This reference to legal certainty underlines the importance of exhaustively listing the substantive reasons for such non-registrability and invalidation.

Amendment 5

Proposal for a directive

Recital 29

Text proposed by the Commission

(29) In order to strengthen design protection and combat counterfeiting more effectively, and in line with international obligations of the Member States under the World Trade Organisation (WTO) framework, in particular Article V to the General Agreement on Tariffs and Trade on freedom of transit, and, as regards generic medicines, the Declaration on the TRIPS Agreement and Public Health, the holder of a registered design right should be entitled to prevent third parties from bringing products from third countries into the Member State where the design is registered without being released for free circulation there, where without authorisation the design is identically incorporated in or applied to these products, or the design cannot be distinguished in its essential aspects of the appearance from such products.

Amendment

(29) In order to strengthen design protection and combat counterfeiting more effectively, ***as called for by the European Parliament in its resolution of 11 November 2021***, and in line with international obligations of the Member States under the World Trade Organisation (WTO) framework, in particular Article V to the General Agreement on Tariffs and Trade on freedom of transit, and, as regards generic medicines, the Declaration on the TRIPS Agreement and Public Health, the holder of a registered design right should be entitled to prevent third parties from bringing products from third countries into the Member State where the design is registered without being released for free circulation there, where without authorisation the design is identically incorporated in or applied to these products, or the design cannot be distinguished in its essential aspects of the appearance from such products.

Or. fr

Justification

It is worth noting that this concern to combat counterfeiting more effectively has been expressed by the European Parliament previously.

Amendment 6

Proposal for a directive

Recital 32

Text proposed by the Commission

(32) The exclusive rights conferred by a registered design right should be subject to an appropriate set of limitations. Apart from private and non-commercial use and acts done for experimental purposes, such list of permissible uses should include acts of reproduction for the purpose of making citations or of teaching, referential use in the context of comparative advertising, and use for the purpose of comment or parody, provided that those acts are compatible with fair trade practices and do not unduly prejudice the normal exploitation of the design. Use of a design by third parties for the purpose of artistic expression should be considered as being fair as long as it is at the same time in accordance with honest practices in industrial and commercial matters. Furthermore, this Directive should be applied in a way that ensures full respect of fundamental rights and freedoms, and in particular the freedom of expression.

Amendment

(32) The exclusive rights conferred by a registered design right should be subject to an appropriate set of limitations, ***which should be listed exhaustively***. Apart from private and non-commercial use and acts done for experimental purposes, such list of permissible uses should include acts of reproduction for the purpose of making citations or of teaching, referential use in the context of comparative advertising, and use for the purpose of comment or parody, provided that those acts are compatible with fair trade practices and do not unduly prejudice the normal exploitation of the design. Use of a design by third parties for the purpose of artistic expression should be considered as being fair as long as it is at the same time in accordance with honest practices in industrial and commercial matters. Furthermore, this Directive should be applied in a way that ensures full respect of fundamental rights and freedoms, and in particular the freedom of expression.

Or. fr

Justification

For reasons of legal certainty, limitations to the exclusive rights conferred by the registration of a design should be listed exhaustively.

Amendment 7

**Proposal for a directive
Recital 34**

Text proposed by the Commission

(34) The 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, where the product incorporating the design or to which the design is applied constitutes a form-

Amendment

(34) The 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, where the product incorporating the design or to which the design is applied constitutes a form-

dependent component part of a complex product, directly affect the establishment and functioning of the internal market. Such differences distort competition and trade within the internal market and create legal uncertainty.

dependent component part of a complex product, directly affect the establishment and functioning of the internal market. Such differences distort competition and trade within the internal market and create legal uncertainty, *as highlighted by the European Parliament in its resolution of 11 November 2021.*

Or. fr

Justification

It is worth noting that this risk of distortion of competition has been highlighted by the European Parliament previously.

Amendment 8

Proposal for a directive Recital 35

Text proposed by the Commission

(35) It is therefore necessary for the smooth functioning of the internal market and in order to ensure fair competition therein to approximate the design protection laws of the Member States as concerns the use of protected designs for the purpose of repair of a complex product so as to restore its original appearance through the insertion of a repair clause similar to that already contained in Regulation (EC) No 6/2002 and applicable to EU designs at Union level but explicitly applying to form-dependent component parts of complex products only. As the intended effect of such repair clause is to make design rights unenforceable where the design of the component part of a complex product is used for the purpose of the repair of a complex product so as to restore its original appearance, the repair clause should be placed among the available defences to design right infringement under this Directive. In addition, in order to ensure that consumers are not misled but are able to make an informed decision between competing

Amendment

(35) It is therefore necessary for the smooth functioning of the internal market and in order to ensure fair competition therein to approximate the design protection laws of the Member States as concerns the use of protected designs for the purpose of repair of a complex product so as to restore its original appearance through the insertion of a repair clause similar to that already contained in Regulation (EC) No 6/2002 and applicable to EU designs at Union level but explicitly applying to form-dependent component parts of complex products only. As the intended effect of such repair clause is to make design rights unenforceable where the design of the component part of a complex product is used for the purpose of the repair of a complex product so as to restore its original appearance, the repair clause should be placed among the available defences to design right infringement under this Directive. In addition, in order to ensure that consumers are not misled but are able to make an informed decision between competing

products that can be used for the repair, it should also be made explicit in the law that the repair clause cannot be invoked by the manufacturer or seller of a component part who have failed to duly inform consumers about the *origin* of the product to be used for the purpose of *the* repair of the complex product.

products that can be used for the repair, it should also be made explicit in the law that the repair clause cannot be invoked by the manufacturer or seller of a component part who have failed to duly inform consumers about the *identity of the manufacturer* of the product to be used for the purpose of repair of the complex product.

Or. fr

Justification

The concept of ‘identity of the manufacturer’ is clearer than the concept of ‘origin’ of the product.

Amendment 9

Proposal for a directive Recital 37

Text proposed by the Commission

(37) In order to improve and facilitate access to design protection and to increase legal certainty and predictability, the procedure for the registration of designs in the Member States should be efficient and transparent and should follow rules *similar* to those applicable to EU designs.

Amendment

(37) In order to improve and facilitate access to design protection and to increase legal certainty and predictability, the procedure for the registration of designs in the Member States should be efficient and transparent and should follow rules *equivalent* to those applicable to EU designs.

Or. fr

Justification

It being a directive and not a regulation, the term ‘similar’ seems too strong; the term ‘equivalent’, already used in recital 16 of this text, seems preferable.

Amendment 10

Proposal for a directive Recital 42

Text proposed by the Commission

(42) For the purpose of offering efficient means of declaring design rights invalid,

Amendment

(42) For the purpose of offering efficient means of declaring design rights invalid,

Member States should provide for an administrative procedure for declaration of invalidity which is **aligned** to the extent appropriate **to** that applicable to registered EU designs at Union level.

Member States should provide for an administrative procedure for declaration of invalidity, which is **inspired** to the extent appropriate **by** that applicable to registered EU designs at Union level.

Or. fr

Justification

It being a directive and not a regulation, the phrase 'is aligned to' seems too strong; the phrase 'inspired by' seems preferable.

Amendment 11

Proposal for a directive Article 6 – paragraph 1

Text proposed by the Commission

1. For the purpose of applying Articles 4 and 5, a design shall be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Union , before the date of filing of the application for registration or, if priority is claimed, the date of priority. **The** design shall not, however, be deemed to have been made available to the public **for the sole reason that** it has been disclosed to a third person under explicit or implicit conditions of confidentiality.

Amendment

1. For the purpose of applying Articles 4 and 5, a design shall be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Union , before the date of filing of the application for registration or, if priority is claimed, the date of priority. **A** design shall not, however, be deemed to have been made available to the public **if** it has been **only** disclosed to a third person under explicit or implicit conditions of confidentiality.

Or. fr

Justification

Linguistic clarification.

Amendment 12

Proposal for a directive Article 15 – indent 1 a (new)

Text proposed by the Commission

Amendment

Under the conditions laid down in the first subparagraph, this proposal shall extend to new forms of designs linked to new technologies, including virtual and animated designs, of products which may be in digital form.

Or. fr

Justification

Paragraph 1a includes the requirements formulated by the European Parliament in its resolution of 11 November 2021 on an intellectual property action plan to support the EU's recovery and resilience.

Amendment 13

Proposal for a directive Article 19 – paragraph 1

Text proposed by the Commission

Amendment

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.

1. Protection shall not be conferred on a registered design which constitutes a component part of a complex product 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.

Or. fr

Justification

The wording 'upon whose appearance the design of the component part is dependent' is unclear and creates uncertainty as to the scope of the repair clause.

Amendment 14

Proposal for a directive Article 19 – paragraph 2

Text proposed by the Commission

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.

Amendment

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 **identity of the manufacturer** of the product to be used for the **sole** 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. ***This indication of the manufacturer's identity shall include at least the name of the manufacturer, the address of his registered place of business and his nationality.***

Or. fr

Justification

As described, the concept of 'identity of the manufacturer' is clearer than the concept of 'origin' of the product.

Amendment 15

Proposal for a directive Article 19 – paragraph 3

Text proposed by the Commission

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

Amendment

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 = **three** 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.

which registration has been applied before
the entry into force of this Directive.

Or. fr

Justification

The 10-year period appears disproportionate to the stated objective of legal certainty for designs for which registration was sought before the entry into force of this Directive;

EXPLANATORY STATEMENT

The Rapporteur takes a generally favourable view of the Commission's proposal, which repeals and replaces the existing Directive 98/71/EC. It has the merit of adapting design protection to the evolution of digital technologies, in particular the appearance of 3D printers. It also seeks to further align national laws in order to enhance their interoperability and complementarity with the Community design system. Finally, it aims to complete the single market in repair spare parts by introducing a repair clause into the Directive as already contained in the Regulation.

The proposed changes are guided by two general objectives: enhancing legal certainty and reiterating positions previously expressed by the European Parliament. The most important concern the replacement of the concept of 'origin' of the product, which is too vague, with the concept of 'identity of the manufacturer' of the product (Nos 8 and 14), and the replacement of the ten-year period for the application of the repair clause to designs for which registration was sought before the entry into force of the new Directive, which was considered excessively long, with a period of three years (No 15).