

**Joint Comments of ECTA, INTA and MARQUES  
on the European Commission's Inception Impact Assessment on the review of the Design  
Directive and Community Design Regulation  
January 2021**

The signatories of this joint contribution would like to thank the European Commission for the opportunity to provide feedback on its Inception Impact Assessment on the review of the [Design Directive](#) (the Directive) and [Community Design Regulation](#) (the Regulation).

The comments below follow the structure of the Inception Impact Assessment, notably the tentative set of specific objectives and associated solutions/options proposed by the European Commission to frame the reform of European Union (EU) legislation on design protection.

Our input builds on the recommendations provided to the Commission over the past two years, in particular our [Joint Paper on Legal Review of EU Designs System](#), submitted in July 2018.

As an overarching remark, **we strongly welcome the Commission's intention to revise the EU legislation on design protection**. We fully agree that while the dual system of design legal protection in the EU works generally well, there are several shortcomings that need to be addressed to modernize the legal framework, making it more harmonized, user-friendly and in line with the digital and green transitions. We look forward to the opportunity to contribute to the public consultation on the draft legislative amendments, expected on the first quarter of 2021.

With regard to the specific objectives and policy options for the legislation reform advanced in the Inception Impact Assessment:

**A. To modernize, clarify and strengthen design protection**

We support this objective as we agree that the EU legislation should clarify and strengthen some elements of the protection afforded to designs. Nevertheless, we take the view that **amendments to definitions of essential notions such as "design" and to the wording of what can be protected and relating to the scope of protection should be cautiously chosen**. Such amendments should only be introduced when a clarification or correction is necessary. Otherwise, there is a high risk of introducing uncertainties and ambiguities. Further, any substantive changes in the law should be accompanied by appropriate transitional provisions making clear the temporal nature of the changes.

With respect to the particular suggestions of the Inception Impact Assessment:

- **Clarification in the law that graphical user interfaces (GUIs) are eligible for protection as design rights.**

As mentioned in the Evaluation Report, "*the significance of new technological designs such as graphical user interfaces and icons has grown dramatically*". We consider that design protection of the visual appearance of GUIs, animated designs, fonts and icons should be provided, independently from any other form of protection available, regardless of the technical means of creating it, and whether they are projected onto a screen or otherwise only appear when technology is activated. Because the lifespan of such designs can be very

short, to the extent that GUIs, animated designs, fonts and icons may be eligible for overlapping protection, we believe that design law is a good tool to provide short-term protection.

Accordingly, we would welcome a **clarification (be it by way of recitals or by amending the law) to ensure that GUIs, animated designs, fonts and icons, although derived from computer code, are not “computer programs” in the sense of Articles 1(b) of the Directive/3(b) of the Regulation, and are therefore eligible for design protection. The same should be clarified with regard to interior designs, be they real or virtual.**

- **We support changes in the legislation to address properly and fight design infringing goods in transit.**

We agree with the Evaluation Report that the lack of alignment between the scope of design rights and the trademark acquis concerning the possibility to enforce design rights against goods in transit limits the scope of action of customs. Therefore, the issue of design infringing products in transit through the EU or EU Member States should be addressed in line with the solutions adopted under Directive (EU) 2015/2436 approximating the laws of the Member States relating to trade marks (TMD) and Regulation (EU) 2017/1001 on the European Union trade mark (EUTMR).

Considering the importance of designs to the EU economy, it is essential to safeguard design protection more effectively. For that purpose, design holders should be entitled, without hampering the free flow of legitimate international trade, to prevent third parties from bringing design-infringing goods into a Member State/the Union even if these infringing goods are not intended to be placed on the market in the Member State concerned/the Union. To this effect, it should be permissible for design holders to prevent the entry of design infringing goods and their placement in all customs situations, including transit, transshipment, warehousing, free zones, temporary storage, inward processing or temporary admission, also when such goods are not intended to be released for free circulation in the Member State concerned/the Union.

The solution supported here would be in line with the one adopted in respect of trademarks, as part of the EU trademark reform. **We therefore recommend including in the Designs Regulation and the Directive provisions similar to those of Art. 9 (4) of the EUTMR and Art. 10 (4) of the TMD respectively, with the necessary adaptations.**

- Other aspects relevant to the scope of design protection not mentioned in the Inception Impact Assessment:
  - **Legal definition of “design”: we see no reason to expand design protection to non-visually perceptible features or tactile features or to amend the definition of “design” in the Regulation or the Directive. We fully agree with the Evaluation Report that other than for component parts of complex products (the design of which must be visible whilst the product is in normal use), a design does not need to be visible at any particular time or situation to attract design protection. We therefore support an amendment to the recitals of the Regulation and the Directive specifically to note that, other than for component parts of complex products, a design does not need to be visible at any particular time or in a particular situation in order to attract design protection. Also, it should be clarified that the notion of “complex product” be interpreted narrowly and referred primarily to complex machinery.**

- **Technical function exception to design protection**: We agree with the Evaluation Report that clarification in this respect is needed. **We recommend an amendment to the recitals of the Regulation and the Directive to clarify that the exclusion for features of a design solely dictated by technical function should be narrowly construed** – the threshold of “solely dictated by technical function” is not met in case of mere functionality of a design.
- **The concepts of ‘informed user’, ‘overall impression’, ‘design freedom of the designer’, and ‘individual character’**: According to the Evaluation Report, coherence has still not been fully achieved for these concepts. **We believe that the concepts of informed user, individual character and different overall impression are largely satisfactory.** The relevant courts, including the CJEU, will continue to develop these concepts and to provide guidance for courts in Member States, the European Union Intellectual Property Office (EUIPO) and national offices (and the Benelux Office for Intellectual Property (BOIP), and should be given the time to do so. **We therefore believe that amendments to the Directive/Regulation in this respect are not required at this stage. Such amendments would be premature. Instead, the better approach is to allow case law to continue to develop.** In this regard, we point out the judgment handed down by the CJEU *Easy Sanitary/Nivelles* (joined Cases C-361/15 P and C-405/15 P, *Easy Sanitary Solutions BV and European Union Intellectual Property Office v Group Nivelles*, at paras 88, 92, 111) which rightfully emphasized that the nature of the product or the sector concerned do not directly affect the assessment of novelty and individual character of a design. We support that understanding of the law as it strengthens the protection of the design creation as such and not the creation of a product bearing a specific design.
- **No product-specific protection**: We agree with the Evaluation Report that there is a need for harmonization in this respect. In particular, **it should be clarified in the Directive that product indication does not affect the scope of protection of the design.** At EU level (EUIPO and EU courts), the product indication is not relevant for the scope of protection (see, in this sense, CJEU, 21 September 2017, C-361/15P and C-405/15P, EU:C:2017:720, *Easy Sanitary Solutions*, para. 96). The same rule must apply in all EU Member States.
- **Broadening the list of limitations (e.g., in line with the limitations in EU trademark law)**

In section 5.2.4, the Evaluation Report notes that “*The catalogue of limitations now appears too narrow to effectively strike the right balance between the interests of designers and design users and incoherent with the system in place for other IPRs. Extending and adapting the catalogue of limitations could be considered to ensure it is relevant in view of new technologies. In that respect, the possible reach of the private use limitation in the context of 3D printing should be further assessed, also in coherence with the copyright regime*”.

We understand the need to address limitations of rights, but we believe that the language in the Evaluation Report is somewhat vague. We are concerned with the apparently proposed alignment of exceptions under design law to those existing under trademark or copyright law. There are different reasonings, aims and legislative basis for each of those IP law branches and, therefore, we do not see this as sufficient justification to broaden the list of limitations under design law. Each such right requires very different prerequisites being met and protects different aspects of creative or market related achievements.

With respect to 3D printing in particular, we are concerned that under the mentioned private use exception, consumers could be enabled to domestically 3D print potentially infringing

designs. We believe that the focus of the legislation should be placed on commercial uses of 3D printing files and resulting products and any private use exception should be interpreted in a restrictive manner.

In conclusion and while we would appreciate to have more clarity on what is proposed under these sections of the Evaluation Report and Inception Impact Assessment, our view is that the balance is currently appropriate and that taking inspiration from trademark and/or copyright law to broaden the list of limitations could dangerously shift that balance in favor of infringing activities, or distort the underlying aims of design law, without clear rationale to do so.

- **Clarifying the intersection between design and copyright protection**

We believe that the law in relation to the intersection between design law and copyright has been clarified to some extent by the Court of Justice of the EU (CJEU) in its decisions in *Flos v Semeraro* (Case C-168/09, *Flos SpA v Semeraro Casa e Famiglia SpA.*) and more recently *Cofemel* (Case C-683/17, *Cofemel v. G-Star*) and *Brompton* (Case C-833/18, *SI, Brompton Bicycle Ltd. v. Chedech / Get2Get*).

**Cumulative protection of a design through design law and copyright law is and should be possible provided that the requirements are met in relation to each right.** Indeed, in order to spur innovation and creativity, intellectual property rights owners should be free to pursue any and all available sources of protection, both limited-term protection in the form of designs, and unlimited-term protection in the form of trademark and other intellectual property and related rights (such as unfair competition).

Accordingly, and as mentioned in the preceding section, design and copyright (and trademark and patent) law have each their particular reasoning, aim and legislative basis. Considering that EU copyright law is not harmonized, cumulation under different IP rights, where legally allowed, should be preserved. We would also caution strongly against introducing into design law notions from recent copyright jurisprudence, for instance, we would not want designs needing to reflect the personality of the designer.

## **B. To improve accessibility and affordability of design protection in the EU**

We support this objective and provide the following suggestions about the particular actions proposed:

- **Streamlining and simplifying filing procedures:**

- **Representation:** We note that the Evaluation Report indicates that the lack of alignment in national design procedures is problematic, making it difficult to develop common IT tools and hampering the interoperability of the design systems. We fully agree and consider that **harmonization as between the EUIPO and the national offices (and the BOIP) is an essential valid goal itself. We have supported the European Cooperation project CP6 ‘Convergence on graphic representations of Designs’ and its adoption and implementation by all relevant offices** to enhance transparency and predictability, and thus user friendliness. For designers, especially individual designers and SMEs, having a single set of requirements across the EU will aid design filing, and should lead to more designs being filed and fewer deficiencies needing to be remedied. In this respect, we see the value of incorporating the cooperation requirement into law, similarly to the position with respect to trademarks.

Further, the Evaluation Report concludes that the 7 views limit for Community designs is too low and that an analysis is required as to whether a higher limit or unlimited views should be allowed, also given the option of filing a dynamic representation. **We fully agree and recommend that the 7-view limit be changed to allow a higher number of representations, as many countries already do, to as many representations as may be required to fully disclose the design.** This promotes user choice, and enables designers properly to capture, as they wish, the design they wish to protect. Indeed, for moving designs, it may be that a video file better captures the design than does a series of static representations. Technology now allows it and therefore we consider that video files should be acceptable across the EUIPO and national offices (including the BOIP). Along the same lines, we welcome the enhancement of the possibility of filing **dynamic views** (e.g., 3D digital representations and video files) supported in the Evaluation Report. Similar to trademarks, a design may be represented in any appropriate form using generally available technologies. Indeed, we agree that 3D animated representations are helpful, and increasingly common, and advocate for their acceptance by the EUIPO and the national offices (including the BOIP), possibly through the cooperation projects. For the avoidance of doubt, 3D or dynamic representations of designs should be an **optional representation tool**. It should be the choice of the applicant whether or not to file static or dynamic views, or both, irrespective of the nature of the design. Search tools and databases should be updated accordingly to reflect video or other acceptable representation forms.

- **Disclaimers/description:** We welcome the intention, expressed in the **Evaluation Report, to harmonize visual disclaimer rules**, codifying the common practice established by the CP6 in national laws. Whilst it is our view that the **availability of a description should be optional for the applicant**, it is important to note that a description can help clarify what is shown in the images submitted or other aspects of the design and can help users of the system and enforcement bodies interpret the scope of protection of a design (without, it being said, the description defining such scope of protection in and of itself). Harmonization regarding descriptions – in the sense that the option for description should be mandatory at Member State level – would be desirable across the Community design regime and national law.
- **Deferment of publication:** As noted in the Evaluation Report, the period of deferral varies significantly in national laws and some Member States do not provide for deferral at all. Against this backdrop, we strongly agree that harmonization of the rules on and the length of deferred publication should be the aim, especially for establishing a level playing field. Indeed, differences in the time period of the deferment of publication may cause legal uncertainty as there may arise confusion on the date of first disclosure of a design and this directly affects the user's strategy in this regard. For designers and undertakings managing their designs, differences in the availability of deferment of publication and in the deferment period are burdensome and potentially give rise to inadvertent disclosure of a design. These differences can also entail significant increases in portfolio management costs and seriously obstruct cross-border activities. Therefore, **we advocate for harmonization, through amendments to the Directive, to ensure that deferment is available in all EU Member States, and to ensure that the deferment period is the same (and the same as under the Regulation i.e., 30 months).**
- **Multiple applications:** We fully support the conclusion of the Evaluation Report that, in its current form, the unity-of-class requirement is no longer relevant. We also agree

that harmonization in respect of multiple applications is desirable. We consider that substantial cost and administrative savings can be made by users through the filing of multiple designs in a single application (“multiple applications”) and therefore strongly recommend that Industrial Property Offices allow the filing of such multiple applications. We further recommend that Industrial Property Offices not require that the designs within a multiple application need to be in the same class. Accordingly, **we strongly recommend deleting the requirement for the same Locarno class in Art. 37 of the Regulation, and amending the Directive so that all Member States must offer multiple applications and must not provide for a same Locarno class requirement.**

However, it should not be disregarded that third parties should be able to search designs. For that purpose and without delay to the abandonment of the same Locarno class requirement, best efforts should be made to improve the search tools of the design as such, irrespective of the Locarno class.

- **Electronic filing:** We note that, under the Evaluation Report, the usefulness of maintaining mail or fax filing is questioned and that increased digitalization across IP offices is encouraged, possibly even making proceedings fully digital at national level. **We agree that, due to the loss in quality in transmission by facsimile (fax), the use of this method for design applications be phased out,** in favor of more reliable methods of secure electronic transmission. One option could be limiting the use of fax to a back-up option where the e-filing tools are unavailable. Indeed, we view the expansion of the possibilities to rely on electronic communications as a positive development for users who can benefit from more efficient, expeditious and economical means of communication with IP offices. Nevertheless, we believe that users should not be penalized for failing to file electronically where electronic filing is not possible (for example, in case of technical problems affecting either the user’s or the office’s electronic system). For this reason, **the maintenance of paper-based means of filing (particularly relevant to individual designers and SMEs), at least as a back-up option where electronic filing is not possible, is recommended. Further, we do not support higher fees for paper-based applications.**

- **Aligning Community design procedures with those for the EU Trade Mark**

We believe that there are some **undesirable procedural discrepancies between the trademark-related laws and the design-related rules before the EUIPO that should be addressed.** The most concerning is the **lack of the concept/remedy of “continuation of proceedings” in relation to designs**, when in fact the consequences of missed deadlines in relation to designs – where novelty/individual character are requirements – may be even more drastic. We note that at an international level a future Design Law Treaty is likely to mandate introducing such a remedy in any event. We also note that the EUIPO is now applying **different rules for the renewal of trademarks** (expiry now 10 years after the filing date, rather than the former “end of the month” rule) **and designs** (renewal payment may be made at the end of the month in which the design expires). This may generate confusion. In contrast, it is our position that **there is a justification for permitting priority claims for design applications after filing the application** (within no later than one month from the date of filing of the design application with the relevant documentation being submitted e.g. within three months). This is again due to the potentially drastic consequences of a loss of priority rights in the context of designs.

In addition, **terminology should be aligned** to the Treaty of Lisbon, and the terms “EU Registered Design (EURD)” and “EU Unregistered Design (EUUD)” should be adopted in

replacement of the current “Registered Community Design (RCD)” and “Unregistered Community Design (UCD)”.

- **Adjusting fee levels and structure for the Community design rights**

We agree with the Evaluation Report that the Designs Review should consider the need to ensure a balanced EUIPO budget coexistence/complementarity between the Community, national and international systems. Fee schemes should aim to be at least balanced, without any undue disproportion and, certainly, any unjustified increase. At the same time, we are aware that providing a national design protection infrastructure is a resource intensive burden for some (smaller) Member States. Therefore, **fee reductions should not result in a dangerous imbalance between RCD and national fee structures; national design filings must remain attractive for applicants as an alternative to Union designs** while also remaining sustainable for national IP offices. Inappropriate fee reductions could put the parallel existing protection levels at risk, and ultimately encroach upon the freedom of choice of users between national, EU and international protection levels. Therefore, and as mentioned in our Joint Paper, we agree with the 2016 Legal Review’s finding that even a permanent surplus at EUIPO level does not in itself justify a fee reduction for RCDs.

As mentioned in the Evaluation Report, the unity-of-class requirement does not allow applicants to benefit appropriately from the bulk discount available for multiple applications.

Moreover, we **agree with the Evaluation Report that renewal fees are too high** and see no logical reason why the renewal fee should increase each time an RCD is renewed. The cost to the EUIPO of renewing an RCD does not depend on whether it is a first, second, third or fourth renewal. The increase in fees serves only to discourage further renewal of design rights, a notion unaligned with an innovation economy. Further, we **request a substantial reduction of renewal fees at EUIPO level**.

We agree with the Evaluation Report that the registration fees due for the transfer of a Community design are no longer justified or coherent. As the Evaluation also notes, such fee is not required for trademark transfers. We would therefore be in favor of eliminating these fees.

Finally, we **support the alignment of the fee regime for RCDs and for EU designations under the Hague System**, so as not to distort filing behavior. In this regard and as noted in our Joint Paper, commissioning a separate fee review study may be useful.

### **C. To ensure enhanced interoperability of design protection systems in the EU**

We believe that harmonization is key to achieve an accessible and easily usable designs system, which are among the key objectives that the Review should pursue. Accordingly, we fully support the Commission’s objective to enhance harmonization between national laws and between national laws and the Regulation. With respect to the particular aspects referred to in the Inception Impact Assessment concerning harmonization in the area of procedures, we submit the following comments:

- **Aligning standards for the examination of designs**

We agree with the Evaluation Report that the limited examination of the EUIPO works well in practice and that there could be benefits in harmonizing national rules on the scope of substantive examination.

We note that the Evaluation Report supports efforts to develop powerful and user-friendly search tools to enable businesses and designers to conduct reliable searches. We believe this would indeed be very helpful, notably with respect to RCDs. Indeed, and in contrast to the situation with EU trademarks, the EUIPO's design registration process is not transparent as applicants do not have access to online files. It would be desirable to add to the "RCD file information" in the Office's "eSearch plus" database a "Correspondence" section as available for EU trademarks. Further, we note that designs filed through the Hague system and designating the EU are not readily searchable on the EUIPO's website, meaning a search of the EUIPO database is incomplete.

- **Aligning procedures for the invalidation of registrations**

We agree with the Evaluation Report that the non-availability of office-based proceedings for invalidation in some EU Member States limits the efficiency of the design system and makes it burdensome. It is also incoherent with the trademark reform, where the introduction of administrative trademark invalidity proceedings has been praised by users for their potential in terms of ease of access, speed and cost-benefits. **We therefore recommend harmonization towards a quick and inexpensive administrative design invalidity system in all Member States.** Given that national offices (and the BOIP) are currently implementing this change with respect to trademarks, we do not see any reason why the implementation period for designs should not be coterminous with that for trademarks.

We also **recommend amending the Design Directive and introducing a counterclaim to invalidate a national design in infringement actions before the courts**, as Art. 84 et seq of the Regulation provides for Community designs.

In relation to Member States without the requisite expertise, we see a role for the EU cooperation projects to assist in capacity building in this regard, and agree that, as an interim measure, it may be appropriate in some Member States to invite special design experts as part of the judicial panel. We also agree that it could be further recommended that cooperation between the EUIPO and national offices (and the BOIP) be increased on this point.

- **Aligning presumptions of ownership and validity**

Presumptions of material ownership (of the registered design owner) and of validity are key factors for enabling right holders to enforce their rights in a lean, effective and resource-saving manner. We therefore suggest amending the Directive to the effect that introducing provisions which reflect Art. 17 and Art. 85 of the Regulation be made mandatory at Member State level. As the Evaluation Report and the Inception Impact Assessment remain silent on these issues, we emphasize the opportunity to facilitate accessibility and effectiveness of the design protection system by relatively mild legislative action.

- **Aligning rules on naming of the designer**

Different procedural requirements for applicants between Member States on the one hand, and between the EUIPO and the Member States, on the other hand, result in time consuming, troublesome obstacles for multi-jurisdictional filings. We therefore strongly support harmonization of the rules on naming of the designer. We suggest amending the Directive so that all Member States provide that naming the designer is optional rather than mandatory for registration.



## **D. To complete the single market for repair spare parts**

We agree with the Evaluation Report that there should be political agreement on the issue of spare parts. Acknowledging that the issue is of high controversy, we urge that any failure to progress on this topic shall not delay the EU designs reform agenda.

### **Additional issues to consider not addressed in the Inception Impact Assessment**

We would also like to raise the following additional issues of relevance in the context of the EU designs Reform but not addressed in the Inception Impact Assessment:

#### **1) Enforcement**

With respect to **enforcement of design rights**, the Evaluation Report states that stakeholders would appreciate better access to enforcement by reducing the cost of proceedings and the time the proceedings take. With regard to **costs**, differential costs in Member States provide a significant obstacle to a “common design market” and we have advocated for further investigation of litigation/enforcement costs in different Member States. With respect to **procedures**, we would urge for greater harmonization of national enforcement procedures relating to Community design rights.

Moreover, we **recommend introducing declarations of non-infringement and actions against threatened infringement as remedies in the EU Design System. Declarations of non-infringement** allow an economic operator who wishes to launch a product and who is uncertain whether a third party design right may thereby be infringed, to apply for a court order. This could be achieved by either an amendment to the Design Regulation to provide for declarations of non-infringement as a matter of EU law, or, alternatively, to require through the Enforcement Directive that they be available as a matter of national law. In any event, the words “if they are permitted under national law” in Article 81(b) of the Regulation should be deleted. This absence of harmonisation has a negative impact on the unitary character of the Community design. We feel supported in that position by the CJEU decision handed down after the Review *BMW v Acacia* (Case C-433/16 – *Bayerische Motorenwerke AG v Acacia Srl*). Further, we suggest a two-fold approach to overcome discrepancies in the Member States concerning **actions with respect to threatened infringements of designs**. First, such actions should be made part of the Regulation-provided legal instruments of the right holder by deleting the parenthesis “if they are permitted under national law” from Art. 81 lit. a of the Regulation. Secondly, such actions should be made mandatory under the Enforcement Directive.

Furthermore, we agree with the Evaluation Report on the need to align the Directive to the Regulation on **prior use as a defence to infringement**. Lack of harmonization regarding “prior use” conditions may cause differences in the legal strength of the same design in different Member States, which may lead to differences in marketing strategies. At the same time, it gives rise to some countries being safer than others, potentially distorting the European Union market. **Therefore, we recommend harmonizing the right of prior use, by amending the Directive and introducing a parallel provision to Art. 22 of the Regulation.**

#### **2) International Dimension**

We welcome the conclusion in the Evaluation Report that the accession of the Member States to the **Hague System** should be considered and the main inconsistencies between the different systems should be addressed. As recommended in our Joint Paper, **we urge the European Commission to consider requiring EU Member States to adhere to the Hague System** and domesticate its requirements. We therefore also urge the Commission, and the Member States, to

continue efforts to aim at international harmonization, including through the Hague System. The EU and its Member States have a strong presence in international organizations (such as the World Intellectual Property Organization (WIPO) and ID5) and the ability to influence international harmonization, and adherence and domestication of the Hague System. We urge the EU and its Member States to continue these efforts in the interests of users. For example, users of the design protection system should be able to use the same set of design representations within all EU Member States, and around the world.

The Evaluation Report notes that the current EU legislation on design protection is not in conformity with the draft provisions of the **Design Law Treaty (DLT)** and that with respect to many draft provisions of the DLT, it is difficult to conclude whether current EU legislation on designs (framework for the RCD) is compatible or not. This matter therefore requires further thorough consideration for the purposes of a potential ratification of the DLT. **We support international harmonisation, e.g. as it could also be achieved through the Design Law Treaty. We also support the work done at the international level in relation to the proposed Design Law Treaty.** Many of the suggested amendments are likely to be appropriate. There are likely to be a few where the different law as between trademarks and designs makes a difference – for example, trademark specifications are an essential element of the scope of protection, whereas an indication of product for a design does not affect the scope of protection “as such”. For these, it will be important to review the proposed amendment language, and comment at that time.

### 3) Unregistered designs

We agree with the Evaluation Report that the existing ambiguity as to the relevant geographical location of disclosure for the creation of an Unregistered Community Design creates unnecessary legal uncertainty. There is thus a need for clarification in this respect.

Further, lack of harmonization in unregistered designs protection may cause legal uncertainty as some Member States may grant a right over the unregistered design which is not enforceable in other Member States. Moreover, the unregistered design scope of protection should be clarified for a uniform enforcement interpretation in all Member States.

### 4) Implications of 3D printing

The comments below take into account the EU Commission’s [report on The Intellectual Property Implications of the Development of Industrial 3D Printing](#), of February 2020 (the “Report”) and the aspects that, in our view, are of particular relevance to the review of the EU designs system.

- **The ability of a 3D printing file to attract design protection** (i.e., whether an RCD is infringed when a computer file which will create a design infringing object is held, offered for sale, etc.)
  - ⇒ **We recommend that the law clarifies that a 3D printing file containing a design in computerized means, and which will create an object that will infringe an RCD, is infringing and there is no need for the design to be 3D printed for infringement to arise.**
- **Private use exception**
  - We believe that two situations should be distinguished:
    - i. Buying an infringing CAD and then 3D printing it for private and non-commercial use: in this situation, we find that there is infringement, in line with the above conclusion that it is not necessary to print the design for infringement to arise;

- ii. Creating a CAD at home and using it privately: our view in this case is that there could be a private use exception; however, difficult questions would arise such as the creation and use of technology that facilitates infringement. It may also be difficult to determine when the use is strictly private or goes beyond that.
- ⇒ **We believe that the focus should be placed on commercial uses of 3D printing files and resulting products. Any private use exception should be interpreted in a restrictive manner.**
- **Exhaustion**
- The Report does not specifically call out the consequences for designs regarding exhaustion of rights.
  - If modifications are made to a CAD file, there can be an argument that there is no exhaustion once that CAD file is put on the market.
- ⇒ **We recommend that it be clarified that exhaustion of a physical product embodying a design does not include exhaustion of a 3D model of it.**

We would also like to refer to the Report's section 6.3 (page 184) where it is stated that "*Designing a CAD file from inception (without thus copying any existing protected creation or invention), through the use of modelling software, is unlikely to infringe patent, copyright or design laws*". We believe that it should be clarified that as copying is not a requirement for design infringement, designing a CAD file from inception would still constitute infringement, if it involved creating and commercializing a 3D model of a registered design.

Finally, with respect to the different **means proposed by the EU Commission in order to achieve the above objectives**, we agree that those include (i) strengthening the cooperation between the EUIPO and national IP offices to further converge their practices, (ii) providing further guidance, and/or (iii) legislative intervention taking into account the principles of proportionality and subsidiarity and the results of the further public debate. However, **we believe that a legislative solution is preferable for most of the above points rather than them being left for cooperation. Indeed, in our view, many of these points have, at heart, a legislative foundation and that is the appropriate way to tackle them, notably to ensure that harmonization is real and effective and legally enforceable. Accordingly, we recommend that legislative intervention is indicated as the first (point (i)) avenue to be pursued by the Commission to achieve the objectives of the designs reform. Nevertheless, for the specific issue of fees, we consider that secondary legislation, such as implementing or delegated acts, would provide a more flexible framework.**

As noted, we look forward to having the opportunity to provide input on the Commission's legislative proposals in due course.

**ECTA** was founded in 1980 and brings together IPR professionals who practice in the field of trade marks, designs, geographical indications, copyright and related matters. These professionals are lawyers, trade mark and patent attorneys, in-house counsels focusing on IPR matters, and also other specialists in these fields. **ECTA** has members from all EU Member States and, at the same time, **ECTA** is proud to have associate members from more than 50 countries globally outside of the EU. The extensive work carried out by the Association, following the above guidelines, combined with the high degree of professionalism and recognised technical capabilities of its members, has established **ECTA** at the highest level and has allowed the Association to achieve the status of a broadly recognised expert body on all questions related to the protection and use of trade marks, designs, geographical indications, copyright and domain names in and throughout the European Union. For more information, please visit: [www.ecta.eu](http://www.ecta.eu)

**INTA** is the International Trademark Association, a global association of brand owners and professionals dedicated to supporting trademarks and related intellectual property (IP) to foster consumer trust, economic growth, and innovation. Members include nearly 6,500 organizations, representing more than 34,350 individuals (trademark owners, professionals, and academics) from 185 countries, who benefit from the Association's global trademark resources, policy development, education and training, and international network. Founded in 1878, **INTA** is headquartered in New York City, with offices in Brussels, Santiago, Shanghai, Singapore, and Washington, D.C., and a representative in New Delhi. For more information, visit [inta.org](http://inta.org).

**MARQUES** is the European Association representing brand owners' interests. **MARQUES'** mission is to be the trusted voice for brand owners. **MARQUES** unites European and international brand owners across all product sectors to address issues associated with the use, protection and value of IP rights, as these are vital to innovation, growth and job creation, which ultimately enhance internal markets. Its currently corporate membership crosses all industry lines and its members include IPR owners and legal practitioners representing IPR owners in more than 80 countries. **MARQUES** is an accredited organisation before the European Union Intellectual Property Office (EU IPO), appointed observer at the EU IPO's Management Board and Budget Committee, an official non-governmental observer at the World Intellectual Property Organization and a registered interest representative organisation (ID 97131823590-44) 34 in the Transparency Register set up by the European Parliament and the European Commission, which extends and replaces the former Register of Interest Representatives, opened by the Commission in 2008. More information about **MARQUES** can be found on its website: [www.marques.org](http://www.marques.org).