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## **CONTRIBUTION**

From:	the French delegation
To:	Working Party on Intellectual Property (Designs)
N° prev. doc.:	10155/23
N° Cion doc.:	15400/23
Subject:	Proposal for a DIRECTIVE OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL on the legal protection of designs (recast) - Comments from the French delegation

Further to the Working Party on Intellectual Property on 20 June 2023, delegations will find at Annex written comments and drafting suggestions from the French delegation in relation to Articles 13, 14 and 23 of the above-mentioned proposal.

### **Comments and drafting proposals following IP WP of the 20<sup>th</sup> June 2023**

The French delegation would like to submit the following comments and drafting proposals on Design directive and regulation, following the discussions that took place during the IP WP of the 20<sup>th</sup> June.

#### **I. On grounds for non-registrability**

##### **- Comments**

Two concerns remain for the French delegation on article 13.

First, a reference to the consent of the competent authority should be added, to be coherent with article 14 paragraph 2a and the Trademark directive.

Secondly, France has a reserve regarding the “second” ground of point (ba), “*badges, emblems and escutcheons other than those covered by Article 6ter of the Paris Convention and which are of a particular public interest in the Member State concerned*”. France considers that this absolute ground is hard to assess ex officio for IP offices, as the signs concerned are not referenced and may be plentiful. It would be more appropriate to allow those affected by improper use to request the invalidation of the litigious design.

Moreover, the Trademark directive leaves the choice to Member States to examine or not this ground.

##### **- Drafting proposal**

Article 13 should therefore provide:

#### *Article 13*

#### ***Grounds for non-registrability***

1. A design shall be refused registration where:
  - (a) the design is not a design within the meaning of Article 2, point (3);
  - (b) the design does not fulfil the requirements of Article 8;
  - (ba) (moved from Article 14(1)(g)) the design constitutes an improper use of any of the items listed in Article 6ter of the Paris Convention for the Protection of Industrial Property, or of badges, emblems and escutcheons other than those covered by Article 6ter of the said Convention which are of particular public interest in the Member State concerned.**

**1a. Any Member State may provide that a design shall be refused to registration where the design constitutes an improper use of badges, emblems and escutcheons other than those covered by Article 6ter of the Paris Convention and which are of a particular public interest in the Member State concerned, unless the consent of the competent authority to their registration has been given in conformity with the law of the Member State.**

Adjustments need to be done in Article 14:

*Article 14*

***Grounds for invalidity***

1. If the design has been registered, the design right shall be declared invalid in the following situations:

(a) the design is not a design within the meaning of Article 2, point (3);

(b) the design does not fulfil the requirements laid down in Articles 3 to 8;

**(ba) the design has been registered in breach of Article 13, paragraph (1), point (ba);**

**(bb) the design has been registered in breach of Article 13, paragraph (1a)**

**II. On the “Repair clause”**

**- Comments**

As expressed during the WP, France still believes that the repair clause should include copyright, in order to have a complete covering. France does not fully agree with the Commission's and the Presidency's interpretation that the products concerned are not likely to be protected by copyright. While it is true that the nature of these products makes it harder for them to fulfil the higher criteria of copyright protection, the fact remains that they may be protected by copyright, and some of them will. This loophole should therefore be closed.

In addition, this would avoid situations in which car manufacturers attempt to assert their copyright protection against a component parts manufacturer, whether in pre-litigation or litigation. This could be a means of introducing abusive proceedings, extending proceedings and creating legal uncertainty for component parts manufacturers, and thus defeating the purpose of the repair clause.

- **Drafting proposal**

*Article 23*

***Relationship to copyright***

1. A design protected by a design right registered in or in respect of a Member State in accordance with this Directive shall also be eligible for protection by copyright as from the date on which the design was created or fixed in any form provided that the requirements of Union-copyright law are met.

**1a. The repair clause as provided in Article 19 shall also apply to component parts that are eligible for copyright protection.**

- ➔ Recitals 35 of the directive and 16 of the regulation should be amended subsequently, for instance by adding at the end :

**“Finally, in order to ensure that the scope of the repair clause covers every situation and because of the principle of cumulation, protection by copyright shall not be enforceable as well, in the same conditions above-mentioned.”**

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