

Deutsche Vereinigung  
für gewerblichen Rechtsschutz  
und Urheberrecht e.V.

Deutsche Vereinigung für gewerblichen Rechtsschutz und Urheberrecht  
Theodor-Heuss-Ring 19-21 • 50668 Köln

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European Commission  
Generaldirektion Binnenmarkt  
Generaldirektor John Mogg  
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Sitz Berlin  
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Ihr Zeichen:  
Unser Zeichen:  
(Bei der Antwort bitte angeben)

**Brief concerning the Revised Proposal of the Commission for a Regulation (EC)  
concerning Community Design Patent**

Dear Mr. Mogg:

The German Association for Intellectual Property and Copyright Law (*Deutsche Vereinigung für Gewerblichen Rechtsschutz und Urheberrecht e.V.*) is a nonprofit academic association of practicing professionals and scholars in the area of intellectual property and copyright law as well as competition law. The purpose of this organization according to its charter is to provide academic continual education in the area of intellectual property law and to aid law-making bodies as well as competent ministries and institutions in the area of intellectual property rights.

Title II of the revised proposal for a regulation concerning Community design patent is, for the most part, in keeping with the substantive law provision of Directive 98/71/EC, and Titles VIII to XI are in keeping with the corresponding provisions in the regulation concerning Community trademarks. Because it can hardly be expected that these amendments will be made, we will not give our opinion on this matter. Rather, we give the following statements:

### Article 10a – Transition Provisions

Paragraph 1 provides that a Community design patent is not based on so-called must-match elements until the Commission's amendment proposal to the regulation has been accepted. The grounds for this statement are that there is temporarily no protection of this design patent; i.e., this design patent for the time being may not be registered.

Not only may the registered Community design patents be declared invalid (see, Article 27(1)(b)), but also unregistered Community design patents (see, Article 26(2) of the proposal). This may lead to legal disputes, which would defeat the purpose of transition laws. A much simpler law could provide that, during the transition period in question, no claims may be asserted against the users of must-match parts.

### Article 12 – Commencement and Term of Protection for Unregistered Community Design Patents

In the *Grünbuch* dated June 1991, the Commission invited comments on the length of period that unregistered Community design patents should be protected (see, Chapter 6.3.1.1). In the Max Planck Institut draft, the proposal was made that the protection period for unregistered Community design patents should be limited to two years (see, Article 10 a and Article 11 of the Discussion Draft dated August 1, 1990, GRUR Int. 1990, 566).

Because protection of unregistered design patents are only subject to the condition that the design was first made accessible to the public within the Community, this special form of Community design patent evades the reliable investigations of third parties. The effect of this protection, however, is considerably weakened by the fact that protection may only be asserted against bad faith copying (see, Article 20(2) of the proposal).

Pursuant to the new grace period rules (see, Article 8(2)(b) of the proposal), a period of one year would be sufficient for this temporary protection with limited effect. However, a provision providing for such a protective period in Germany would run the risk that not only the courts would be "cemented" to limiting the protection of so-called new trends on a competition law basis, but additionally the competition law time period of protection against copying would be generally shortened.

Protection of national design patents (see, Article 3(1) of Directive 98/71/EC) as well as registered Community design patents (see, Article 13 of the proposal) should first commence upon registration. The effects of this entire concept would not pose serious disadvantages for used design patents if unregistered Community design patents are temporarily protected.

#### Article 16 – Claims of Persons Entitled to Apply and Register a Community Design Patent

The wording in paragraph 3 sentence 1 as well as Article 17(1) and (2) could give the impression that the assertion of recognition of legal proprietorship can only be done by court proceedings. Here, clarification could be useful (see, comments to Article 17).

The two-year preclusion period for initiating court proceedings should begin at the time when the Community design patent "comes into existence". Postponement of the notice for three months (see, Article 52 of the proposal) does not change the fact that protection also commences as of the registration (see, Article 52(6) of the proposal). This has as a consequence that in cases where a notice is delayed, the preclusion period would end before notice is given.

Paragraph 4 provides that the court procedural history should be entered into the register. It is unclear, however, whether courts (and if there is an out-of-court settlement, the parties) have a duty to give this information to the registration authorities.

#### Article 17 – Effects of Judgment on the Claims to a Registered Community Design Patent

Paragraph 1 provides that a complete change of proprietorship shall result in the expiration of the registration of the license of the entitled person and other rights. Paragraphs 2 and 3 provide that good faith users may apply for a license for further use.

These legal effects are only applicable to cases where a change is made under court order. It is unclear what the legal consequences are if there is a change of proprietorship brought about out of court due to the fact that the previous proprietor yielded to the threat of a lawsuit and made the demanded changes.

#### Article 20 – Rights Derived from a Community Patent Design

This provision is only aimed at claims to cease and desist. Article 20 of the proposal does not provide regulations concerning other claims, particularly claims for information, seizure, damages, and destruction.

Article 93 states which sanctions may be imposed by a court. It may, however, be helpful if Article 20 provided an instruction corresponding to that in Article 14(1) sentence 1 of the Regulation Concerning Community Trademarks.

### Article 25 – Right of Prior Use Concerning Registered Community Design Patents

The right of prior use requires that the opposing claimant "is able to make a showing" that the requirements for the right of prior use have been met. The term "make a showing" is under German law a lesser standard of proof (see, § 294 ZPO). This standard is not available for proceedings on the merit; rather, a hearing of evidence is carried out. This peculiarity of German procedural law should be taken into account, and the wording

"may make a showing, so that he"

should be deleted completely.

### Article 27 – Grounds for Invalidity

Paragraph 6 provides that a Community design patent which is declared void may be kept in an altered form, and as a result, a partial invalidity or partial waiver is possible.

These procedures should have the requirement that "the design maintains its identity". The design patent, however, like trademarks, are standard intellectual property rights which, at latest, upon registration of the alterations, should not be accessible.

Statements concerning the partial invalidity or a partial waiver are practical for technical intellectual property rights. The reason for this is, however, that the subject of the intellectual property rights does not consist of graphic designs, but of verbally worded claims.

### Article 39 – Application Requirements

Paragraph 1 a (b) provides that the application, among other things, must contain the product classification in which the design is to be included or with which the design shall be used.

Classification is of particular importance for collective applications because consolidation of various designs (except for cases of decorations) patents must belong to the same class (see, Article 40(1) of the proposal). For this reason alone, the final classification should not be done by the applicant, but by the Office. If the final classification is reserved by the Office, then it is proper to have classification as the optional part of the application (see, Article 39(3) of the proposal).

### Article 40 – Collective Application

If a collective application contains designs which do not belong to the same class, the applicant (in keeping with the German law (see, § 7(10) GeschmMG)) should have the option to separate them. This option would also open the way to partial transfers.

The option to separate the collective application is of such importance that one regulation in an execution regulation would not be sufficient. In the previous version (see, Article 40(3) of the proposal), the implementation regulation should only specify the requirements for submitting a collective application.

Article 55 – Waiver

Paragraph 1 sentence 1 provides that waiver becomes effective once registered. This wording may give the impression that the effect of a waiver may not begin at an earlier point in time.

Before proceedings on invalidity are commenced (see, Article 26 of the proposal), the proprietor may be asked to waive his rights in order to avoid such proceedings. If the proprietor complies with this request, then it should be possible to declare that this waiver has effect starting from commencement of protection. It would be advisable to include wording which takes this point into account.

Dr. Gloy  
President

Dr. Loschelder  
Generalsekretär