The Patentanwaltskammer thanks the European Commission for requesting user's feedback on the Evaluation of EU legislation on design protection, and will be grateful if the following comments could be taken into consideration:

1. With regard to the protection of the marketing value of a registered design we urge the commission to require all Member States to join the Hague Agreement (Act of Geneva).

2. Analogous to the amendments made with respect to trademarks, we would very much welcome it if the terms “Gemeinschaftsgeschmacksmuster” and “Community Design” would be amended to “Unionsdesign” in German language and “European Union Design (EU-Design)” in English language.

3. We urge the Commission to review the regulations regarding the conditions for obtaining a filing date (Article 36 (1) RCD).

The formal examination of a design application is an important part for clarity in later determining the scope of protection in any infringement proceedings. The quality and the consistence of the submitted representation is an important part. But if during the formal examination of the application papers as filed any problems to the quality or to the consistence of one or more representations result in that the representation is objected and the applicant does not deal that objection(s), this may result in a rejection of the application as a whole but not in that no filing date is obtained.

3.1 Article 36 of Council Regulation (EC) no. 6/2002 of December 12, 2001 on community designs, entitled “Conditions with which application must comply”, provides as follows:

1. An application for a registered community design shall contain:
   a) a request for registration;
   b) information identifying the applicant;
   c) a representation of the design suitable for reproduction.

2. The application shall further contain an indication of the products in which the design is intended to be incorporated or to which it is intended to be applied.

3.2 Article 38 (1) of the Regulation defines the date of filing of an application for registration of a community designs as follows:

“How the date of filing of an application for a registered community design shall be the date on which documents containing the information specified in Article 36 (1) are filed with [EUIPO]...”

3.3 In case C-217/17 P [(ECLI):EU:C:2018:534 – Mast-Jägermeister SE vs. EUIPO] the Court of Justice of the European Union judged that “a representation of the design suitable for reproduction” (Article 36 (1c)) has a broader meaning than “suitable for copying” since the entry of a design in a public register has the aim of making it accessible to the competent authorities and the
public, particularly to economic operators. The
cOMPETENT authorities must know with clarity
and precision the nature of the constituent
elements of a design in order to be able to fulfill
the obligations in relation to the prior examina-
tion of applications for registration and to the
publication and maintenance of an appropriate
and precise register of designs (see par. 53). That
conclusion is indeed also confirmed by the fact
that the obtaining of a date of filing, which,
in accordance with Article 38 of regulation no.
6/2002, is the date on which documents con-
taining the information specified in Article 36 (1)
are filed with EUIPO, enable the proprietor of
the design concerned to benefit from the right of
priority, as provided for in Article 41 of regula-
tion no. 6/2002. Since on the reproduction filed
with EUIPO a beaker and a bottle were visible
and the products in respect of which the applica-
tion for registration was made were beakers in
class 07.01 of the Locarno Agreement, the Court
decided that this reproduction was not sufficient
in obtaining a filing date for the application.

3.4 We are of the opinion that formal examinations
must be performed very fast and that the exami-
nation of the quality of a reproduction with
respect to the scope of protection needs time and
experienced Examiners.

To obtaining a filing date must be as easy as
possible for any applicant. We therefore urge the
commission to clarify Article 36 (1) (c) of Council
Regulation (EC) no. 6/2002 in that “suitable of
reproduction” has the meaning of “suitable for
(electronic) copying.”

Please be aware that the non-recognition of a
filing date has the effect that no priority right
will be established. This legal consequence
seems to us to be inadequate in the case of
designs representations that are complete in
itself but inadmissible for formal reasons.

4. We support the review’s recommendation to
allow a higher number than the current 7 views
or to lift the number restriction all together, and
that there should be harmonization between
national offices such as with dotted and broken
lines and that it should be possible to submit
additional file types to protect a wider range of
designs or designs more effectively such as
movement with design such as transformation or
opening/closing. Only 7 views are not enough
for representing animated designs.

Graphical user interfaces, including movements,
should generally be protectable by design rights.

Additionally, the limitation to a maximum of 7
illustrations also leads to problems in claiming
the priority of a European design application.
Asian countries in particular require that all 6
basic views (4 side views plus top view and
bottom view) must be submitted when filing a
design application. In order for these views to be
included in the priority document, the applica-
tion establishing the priority must also contain
these six views. But then there is only one possi-
bility available to display further details of the
design. Especially in the case of large samples,
where details are barely or not recognizable
on the overall representation, it would then be
hardly possible to show all peculiarities of
the design.

Only 7 views for a registered design are insuffi-
cient for giving appropriate protection.

5. We agree with the request deleting the require-
ment for the same Locarno class in Article 37 of
the regulation, and with an amendment of the
directive so that Member States may not provide
for a same class requirement.

6. Regarding the consistency of representations for
a community design application the guidelines
of EUIPO state in par. 5(2) of Examination of
Applications for Registered Community Designs: “Where the views are inconsistent and relate to more than one design, the applicant will be invited either to withdraw some views or to convert the application into a multiple application for different designs, and pay the corresponding fees.” In practice Community Designs are quite often registered with a mixture of photographs and drawings or a mixture of color and black/white drawings. No remedy is possible since lack of clarity/inconsistency/unity is not a ground of invalidity. On one hand EUIPO should be stricter when assessing if an application include consistence views “and not multiple variations”, on the other hand EUIPO should introduce remedies/invalidation grounds if the community design lacks of clarity, of inconsistency and/or of unity.

However, in our opinion this must be a question of the registrability of the design and in no case of obtaining a filing date for a design application (see no. 3).

7. Finally, we ask the Commission to reconsider the fixing of publication fees. In our opinion, once electronic publication has taken place in the meantime, publication fees should be waived.

A comparison with the fees of the German Patent and Trade Mark Office makes this evident:

In the case of a European design application, the fees for a design application are € 230.00 for the first design and € 115.00 for further designs up to the 10th design and € 50.00 for further designs. In addition there are publication fees for the first design in the amount of € 120.00, in the case of a multiple application for the first 2nd design and each further design up to the 10th design in the amount of € 60.00 each and then for each further design in the amount of € 30.00 in the case of a purely electronic publication.

These rather high fees (caused in particular by the publication fees) make EU design applications unattractive in comparison, for example, with a German design application: In Germany, the first 10 designs of a multiple application are subject to a total fee of € 60.00 and then € 6.00 for each additional design. Publication fees are no longer charged since the registrations are subject of an electronic publication.

In this connection it should be borne in mind that the fees for designating the EU in the context of an international deposit are much lower.

April 15, 2019

Dr. Christof Keussen Thorsten Rehmann, LL.M.
Vicepresident Chairman of the
Design Committee