

Kluwer Copyright Blog

Does the cumulation of IP-rights undermine the effectiveness of the Repair Clause in the Design Directive?

Nina Hoekstra, Christiaan Cornet (IViR) · Thursday, February 8th, 2024

Europeans are the biggest producers of electronic equipment waste ('e-waste'); according to [recent numbers](#), in 2018 approximately 4 million tons of e-waste were discarded in the European Union. This amounts to more than 16 kg of e-waste per capita per year. Common sources of e-waste include televisions, computers, mobile phones and various types of home appliances, from fridges to dishwashers.

One way to reduce our e-waste is to repair broken electronics, instead of throwing them away. According to a [Eurobarometer survey](#), 77% of European Union consumers would rather repair their goods than buy new ones. Yet many consumers choose to replace their product instead of repairing it. This choice may be influenced by the design of the product, the cost of repair or available repairers. But often an underlying, legal obstacle is the presence of IP rights in these devices or parts of these devices. Therefore, the European Commission has, in the context of a [broader set of proposal measures](#) aimed at introducing a 'Right to Repair', also addressed intellectual property rights. One of these measures is the proposal to amend the [Design Directive](#) by including a specific repair clause for design protection.



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Design rights provide protection to the appearance of a (part of a) product. The appearance, or ‘design’, of a product is determined for example by the colour, shape, ornamentation or use of materials. Although the visual appearance is central, an aesthetic aspect is not required for a product to be eligible for design right protection. Provided they meet the legal requirements, both utilitarian objects and objects with a purely decorative function are covered by design protection, such as vehicles, clothing, furniture and home appliances.

To fully understand the significance of this amendment, it is necessary to have a clear understanding of the policy landscape in this area of law. There are two main legislative instruments dealing with the protection of designs in the European Union. First, there is the **Design Directive** which harmonizes the main material aspects of *registered* design law within the EU, such as the definitions, conditions and scope of protection. As the Directive does not have direct effect, it has been transposed into the national design regimes, with each Member State adopting its own approach to implementing the Directive. One key aspect that is not addressed by the Directive is how to deal with spare parts. Member States therefore retained their existing laws on whether or not spare parts benefit from design protection, which has resulted in a patchwork of conflicting national legislation and lack of legal certainty on this particular point.

Second, there is the **Community Design Regulation** which provides for a unified system for obtaining design rights to which uniform protection is given throughout the entire territory of the European Union. The Design Regulation oversees the protection of both registered and unregistered Community Designs. Unlike the Directive, the Community Design Regulation does contain a repair clause. Art. 110 provides that Community design protection ‘shall not exist for a design which constitutes a component part of a complex product used within the meaning of Article 19(1) for the purpose of the repair of that complex product so as to restore its original appearance.’

The amendment relevant to this blogpost concerns the Design Directive. In the **Commission’s proposal**, the so-called Repair Clause is the hottest topic. This clause, integrated in article 19, is one of the most politically controversial aspects of design law policy in the EU. Member States were unable to agree on the introduction of a repair clause when negotiating the Directive. As part of the New IP Action Plan, in November 2022 the European Commission presented **proposals** for a revised Regulation and Directive on industrial designs to ‘modernise the existing Community design framework and parallel national design regimes.’ With excessive protection still granted in some Member States, one of the key aspects is the introduction of an EU-wide Repair Clause in the Design Directive (Art. 19) and the confirmation of a permanent Repair Clause in the Design Regulation (Art. 20a). The new rules will, in the words of the Commission, ‘help to open up and increase competition in the spare parts market, allowing consumers more choice in repairing complex products such as cars in particular.’

In concrete terms, this will mean the following. Products that consist of different parts such as cars, but also household appliances or electrical appliances are, in the words of the law, ‘complex products’. Their components can be replaced, so that the product can be disassembled and reassembled. Without those components, normal use of the complex product would not be possible. Again, think in this context of automotive components such as a bumper, grille or rim. These parts have their own market, and they can be protected separately as designs. For a component part to be eligible for separate protection, it is required that the part remains visible during normal use of the complex product. The visibility requirement is consistent with the function of design law and is mainly intended to exclude from protection mechanical interfaces and

spare parts that have a technical functionality, such as those under the bonnet of a car.

The scope of the repair clause is then explicitly narrowed down to cover only “must match” or “form-dependent” parts, i.e., parts whose shape and configuration are dependent on that of a complex product. Parts which are not determined by the appearance of the complex product are excluded from the benefits of the repair clause. If the part is indeed form-dependent, no design alternatives are possible. This necessarily means that the repair clause applies only to component parts of a complex product that are visually identical to the original parts; parts which are meant for upgrading, accessorising or customising the product do not fall under the repair clause.

The repair clause thus constitutes a legal limitation on the rights of a design holder. Manufacturing spare parts by third parties for example would not constitute an infringement of the original manufacturer’s design rights, thereby liberalising the spare part industry. Design law, however, is not the only IP regime regulating this topic. The overlap with other IP regimes could prove to be problematic. **Copyright in particular could potentially undermine the effectiveness of the repair clause in Design law.**

Component parts that pass the threshold for design protection will likely also be a protected ‘work’ within the meaning of copyright law. Cumulative protection under design law and copyright law remains possible according to art. 96(2) of the [Draft Regulation](#) and art. 23 of the [Draft Directive](#). Since European Union copyright law lacks a corresponding repair limitation, this means that in practice the repair clause could be rendered ineffective if the original manufacturer is still able to stop the production of non-original spare parts by invoking his copyright. This aspect has received little attention in the policy debate so far.

We therefore strongly urge the European legislator to consider the difficulties that could arise when introducing a repair clause for design rights, while failing to consider a similar provision for copyright. A possible solution could consist of **adding a clarification in the Design legislation that the benefit and effectiveness of the repair clause cannot be negated by other types of IP protection** that may potentially extend to the object of repair. In this way, liberalisation efforts of the spare part market will not be undercut by the effect of cumulation with copyright.

This blog post resulted from a policy paper we wrote as a part of the [The Glushko & Samuelson Information Law and Policy Lab](#). For further reading see: ‘[Policy brief on the legal obstacles to the Right to Repair](#)’.

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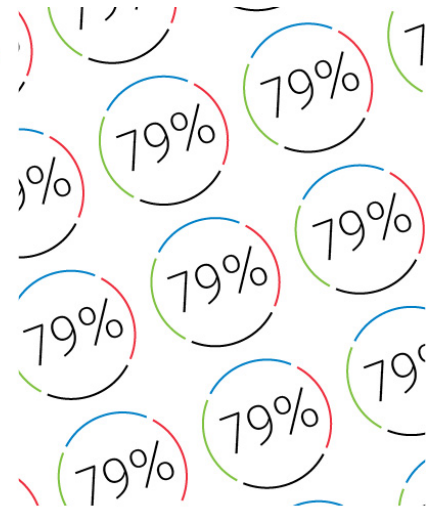
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