

ESTUDIOS

Halfway Between Protection and Competition: The “Repair Clause” After the Recent Reform of the EU Design Acquis. Next Steps for the Spanish Legal Framework¹

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RESUMEN: La reciente reforma de la normativa europea para la protección del diseño ha supuesto la culminación (exitosa) de un largo debate sobre el alcance de la protección como diseño industrial de los componentes de productos complejos mediante la adopción de la conocida como “*cláusula de reparación*” en la Directiva, una limitación a los derechos del titular del diseño en favor de terceros para facilitar la reparación. En este artículo se estudia el alcance de la versión finalmente aprobada y su compleja historia legislativa y se analizan los posibles pasos a dar para su transposición a la legislación española en la materia, la Ley 20/2003, de 7 de julio, de protección jurídica del diseño industrial.

Palabras clave: diseño, propiedad industrial, diseño industrial, reparación, piezas de recambio, limitaciones.

ABSTRACT: The recent reform of the EU legislation for the protection of designs entailed culminating successfully a longstanding debate over the extent of protection of component parts of complex products under a design law system thanks to the adoption of the so-called “*repair clause*” in the Design Directive, which is formally a limitation to the rights attributed to the holder of the Design that allows the use of the design by third parties for the purpose of repair. This article will analyze the remit of

¹ This article is a revised and extended version of one of the chapters of the original Master’s Thesis submitted by the author as part of the final examination of the Master of Intellectual Property and ICT Law of KU Leuven (Katholieke Universiteit Leuven), Belgium, promoted by prof. Dr. T. Margoni and co-promoted by M. Frigeri. Their ideas, corrections, timely suggestions and general guidance were of great value.

² The opinions and ideas of the author are solely of his own and do not represent the views of the organization he currently works for, not even in case of overlap or coincidence.

the provision as finally adopted and its complex legislative history, and will outline the potential way forward for Spain to incorporate the repair clause to the Spanish relevant legislation, which is the Act 20/2003, of 7th July, for the legal protection of designs.

Keywords: design, intellectual property, industrial design, complex products, components, repair, spare parts, limitations.

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I. INTRODUCTORY REMARKS: THE ANATOMY OF THE EU DESIGN ACQUIS AND ITS RECENT REFORM

The outward form of any given product plays a more than relevant role in its marketing success (or failure thereof), particularly under the premises of the capitalist socio-economic system. Following what the great French-American designer Raymond Lowy illustratively said, ugliness does not help sales³. Where markets operate under open and competition-based conditions, it is common for the most successful (and profitable) companies around the world to conform their commercial strategies on product differentiation tactics, based on the extremely thoughtful and precise final outlook of their products, particularly in scenarios of mass-production scale. This is particularly pertinent in mature markets, where consumers are normally able find a varied supply of products essentially fulfilling the same necessity⁴. This behavior shows a willingness to introduce, at least, a certain level of creativity and applied innovation in the business model, with the aspiration of acquiring an identifiable market value by enhancing product attractiveness, while highlighting its individuality⁵.

³ Raymond Loewy (París, 1893-Monte Carlo, 1986) is widely considered as the father of the modern American design industry. He worked for big companies in relevant industries such as Shell, Exxon, Trans World Airlines o BP but also for public institutions such as NASA. He was the designer behind the omnipresent vending machine and the iconic crystal bottles of Coca Cola, the GG1 train of the Pennsylvania Railroad company, the cars Studebaker Commander and Studebaker Avanti, the *Le Creuset* pot and the external outlook and color scheme the Air Force One had in the decade of 1970. One of his books, originally written in French, was called "*La laideur se vend mal*".

⁴ FERNÁNDEZ-NÓVOA, C., OTERO LASTRES, J.M., BOTANA AGRA, M., *Manual de la Propiedad Industrial*, 3ª ed., Marcial Pons, Madrid, 2017, p. 346.

⁵ APLIN, T., DAVIS, J., *Intellectual Property Law. Text, cases and materials*. 2n ed., Oxford University Press, Oxford, 2009, p. 773; CORNISH, W., LEWELLYN, D., APLIN, T., *Intellectual Property: patents, copyright, trade-marks and allied rights*, 8.ª ed., ed. Thompson Reuters, Londres, 2013, p. 589. F. CERDÁ

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Further, it is well known that benefits arising from the incorporation of the design to a product far outweigh the actual productive costs, which demonstrates why these investments do make sense in terms of expected revenues⁶. From the other side of the market structure, the appearance of products can be pivotal to the consumer final choice, despite and even above the price itself. According to the introduction of the Green Paper of the European Commission on the matter, “superior design is an important instrument for European industries in their competition with industries from third countries with lower production costs”⁷. This idea of promoting the competitiveness of design industries in Europe is capital and supported by enough evidence: between 2017 and 2019, the sector of the EU industries making intensive use of design accounted for as much as 15.5% of the European GDP and represented a share of 12.9% of the total of workers at the EU level⁸.

The previous background explains why protection of designs in the EU presents a rather unique approach in the form of a *sui generis* system, highly influenced by the legal traditions of France, Germany and the United Kingdom⁹, but decisively breaking from existing models to find a distinctive third way¹⁰. Those distinctive silhouettes are conformed by, among other elements, a long grace period, the existence of a short-term unregistered right, the individual character as a substantive requisite (instead of a copyright-like requirement of originality), and a clear market-oriented approach reflected in the pivotal notion of “informed user”¹¹. As argued by some commentators, this is a tailor-made

ALBERO: “Diseño industrial: protección jurídica en España y perspectivas en la Comunidad Europea”,

Revista General de Derecho, 595 (1994), pp. 3670-3671.

⁶ BERCOVITZ RODRÍGUEZ-CANO, A., *Apuntes de Derecho Mercantil*, 18ª ed., Aranzadi, 2017, pp. 521-522.

⁷ COMMISSION OF THE EUROPEAN COMMUNITIES, *Green Paper on the Legal Protection of Industrial Design*, Doc. 111/F/5131/91-EN, 1991, p. 2.

⁸ EUROPEAN PATENT OFFICE, EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE, *IPR-Intensive Industries and economic performance in the European Union*, 4º ed., 2022, pp. 78-79. Unsurprisingly, half of the European Union industries are IP-intensive, in the sense of having an above-average use of IPR per employee, which obviously includes the use of the industrial design systems, according to the report edited by EUROPEAN COMMISSION, *The economic review of Industrial Design in Europe*. Publications Office of the European Union, Luxembourg, 2015, p. 21.

⁹ QUAEDVLIEG, A., “Protection of industrial designs: a twenty-first-century challenge for WIPO” in RICKETSON, S. (ed.): *Research Handbook on the World Intellectual Property Organization. The first 50 years and Beyond*, Edward Elgar, Cheltenham, 2020, p. 171 y ss.

¹⁰ SUTHERSANEN, U., “Function, art and fashion: do we need the EU design law?” in GEIGER, C. (ed.): *Constructing European Intellectual Property. Achievements and new perspectives*, Edward Elgar, Cheltenham, 2013, p. 377.

¹¹ KUR, A., “Twenty Tears in Design Law– What has changed?”, in BOSHER, H., ROSATI, E.: *Developments and Directions in Intellectual Property Law*. Oxford University Press, 2023, pp. 146 a 147.

system mostly addressing the needs of traditional industrial sectors that were relevant in Europe at the end of the last century and not so useful for individual designers¹².

Legally speaking, the EU system has been governed since its inception by a two-fold set of rules: first, the Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998, on the legal protection of designs, a short legal act destined to harmonize certain substantive rules by forcing national design laws to approximate, letting aside the procedural elements. Secondly, the Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (published in the EU Official Journal of 5.1.2002), a more ambitious and comprehensive instrument that creates a brand-new, truly European Union-wide intellectual property right (with effects throughout the entire territory of the Union), upon which uniform protection is conferred to the applicant after a quick registration procedure managed by the formerly known as Office for the Harmonization of the Internal Market (OHIM), currently European Union Intellectual Property Office (EUIPO). For the ease of reference, hereinafter, we will use DD and CDR acronyms, respectively, to refer to those two pieces of legislation of the EU *acquis*¹³. This unifying EU approach was thought to be necessary because, by that time, there was no other intellectual property right as diversely regulated, comparing the systems in place between member states back then¹⁴.

Notably, the two-tier system was (and still is) aimed at, on the one hand, completing the internal market, ensuring its smooth running by approximating those national provisions of design law which affect its correct functioning (recitals 2 and 5 of DD) and, on the other hand, promoting individual designers and encouraging innovation and investment in the field of the development of new products, in the words of the (then) EU legislator, (recital 7 of the CDR). The DD had to be transposed into the national legislations of the member states no later than the 28 October 2001¹⁵. Almost at the same time, the DCR entered into force by February 2002¹⁶, although the first applications for the registration of a community design had to wait until the 1st of January, 2003 to be filed. The basic principles governing the system are those of unitary character of the Community Design, autonomy of both stratum within the

¹² MARGONI, T.: "Not for designers. On the inadequacies of EU Design Law and how to fix it", *JIPITEC*, 4, 3 (2013), pp. 225 a 226.

¹³ This kind of legislative structure was not *terra incognita* within the EU intellectual property realm: this legal scheme mirrored what had previously been undertaken in the field of trademark law, with the First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trademarks and the Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark. Vid. Footnote 20 for further developments.

¹⁴ FIRTH, A.: "Aspects of design protection in Europe", *European Intellectual Property Review*, 15, (1993), pp. 42 y ss.

¹⁵ Pursuant to art. 19 DD.

¹⁶ As stated in art. 111 CDR.

overall system and, clearly attached to it, the principle of coexistence¹⁷. In such legal acts, almost all elements of substantive law were essentially the same, creating powerful registrable intellectual property rights capable of conferring patent-strength exclusionary rights for up to 25 years¹⁸. However, certain lack of alignment remained: some provisions differed only in insignificant terms, while others entailed (and showed) different underlying considerations, especially in procedural terms. For instance, the DD allowed some member states to keep their traditionally preferred *ex officio* examination for novelty and distinctive character at a national level by not forcing all of them to adopt a mandatory procedure to follow, while the CDR procedure was strictly limited in that sense. In the same vein, the respective DD and CDR catalogues of mandatory and optional grounds for refusal differed¹⁹.

In 2020, following the steps of the reform of the EU trademark *acquis* undertaken and completed in the previous institutional cycle of 2014-2029²⁰, the Commission unveiled its plans to revise the EU legislation to improve the accessibility and affordability of design protection in Europe, to better support the transition to the digital and green economy and to tackle the fragmentation of the internal market for spare parts. In their own words, this last problem severely distorted competition and hampered the transition to a more sustainable and greener economy²¹. In compliance with that self-imposed commitment, after more than 20 years during which the DD and the CDR were fully in force and correctly

¹⁷ VON BOMHARD, V., VON MÜHLENDAHL, A., *Concise European Design Law*, Kluwer Law International, 2023, p. 6.

¹⁸ CORNWELL, J., “Under-referred, under-reasoned, under-resourced? Re-examining EU design law before the Court of Justice and the General Court”, *Intellectual Property Quarterly*, 4, 4 (2016), p. 319.

¹⁹ STONE, D., *European Union Design Law. A Practitioner’s Guide*. 2nd ed, Oxford University Press, Oxford, 2016, pp. 616 a 625.

²⁰ Two proposals for recast Directive and an amending Regulation were tabled in 2013. Based in an evaluative study of the Max Planck Institute for Intellectual Property and Competition Law, the proposals intended to update the regulatory framework on trademarks and complete the harmonisation of trademark law in the EU, making national legislation more consistent with the Union-wide European system. In institutional terms, another goal was facilitating the cooperation between the offices of the EU member states and the then-OHIM. The reform concluded with the enactment of the Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (recast) and the Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark. Both test are currently under partial evaluation, so it is expectable to expect targeted amendments in the near future, particularly in governance-related issues. To have a broader picture, GIL CELEDONIO, J.A.: “Una solidaridad de hecho: la configuración del sistema europeo de marcas”, *Anuario de la Facultad de Derecho. Universidad de Extremadura*, 38 (2022), pp. 485 y ss.

²¹ EUROPEAN COMMISSION, “Making the most of the EU’s innovative potential. An intellectual Property action plan to support the EU’s recovery and resilience”, Doc. COM (2020) 760 final, pp. 6-7.

-serving their foreseen purposes, a time for reform arrived when the Commission revealed its proposals for a recast Directive and for an amended version of the CDR in November 2022, after two public consultations (comprising almost 80 questions to stakeholders of all kind) and taking into account the conclusions of two wide-ranging reports on the legal aspects²² and the economic impacts of the EU Design system²³.

Among the main findings of the Impact Assessment of this reform package, the Commission unequivocally identified the disruption of the intra EU trade (due to the lack of harmonization of the legal regime applicable to spare parts) as the “*first and most important problem...design protection for spare parts may result in the foreclosure of competition...*”²⁴. Nevertheless, other elements were considered suitable for reform, in both substantive and procedural terms, and they were included as part of the design package so that member states could consider them as well²⁵. It is interesting to highlight that, although the responses collected by the Commission in the public consultations diverged as regards the policy goals to pursue and their subsequent directions to take²⁶, the proposal for a recast DD forwarded by the Commission pushed for a solution to this component parts problem in the form of the proposal for adoption of a mandatory repair clause.

At the very core of this proactive reform attempt, intertwined with other relevant policies, lied the Commission willingness to put an end to the following legal questions (seeking a reply in a pro-competitive manner): could right holders rely on their exclusivity to prevent the use of necessary components for repairing and restoring the appearance of a product and, should the answer be positive, to what extent²⁷? That question had EU member states split into two opposite

²² EUROPEAN COMMISSION, *Legal review on industrial design protection in Europe – Final report*, Publications Office of the European Union, Luxembourg, 2016.

²³ EUROPEAN COMMISSION, *The economic review of Industrial Design in Europe*. Publications Office of the European Union, Luxembourg, 2015.

²⁴ EUROPEAN COMMISSION, ‘Impact Assessment Report accompanying the documents to the Proposal for a Regulation of the European Parliament and of the Council amending Council Regulation (EC) No 6/2002 on Community designs and repealing Commission Regulation (EC) No 2246/2002 and the Proposal for a directive of the European PARLIAMENT and of the Council on the legal protection of designs (recast)’ COM (2002) SWD 368 final, pp. 7-9.

²⁵ LOUREDO CASADO, S.: “Análisis de las modificaciones previstas en la legislación de diseño industrial a nivel europeo”, *ADI* 43 (2023), pp. 133-155; GIL CELEDONIO, J.A., “La reforma del régimen jurídico para la protección de los diseños industriales en Europa: principales elementos de una (esperada) innovación normativa” in CANDELARIO MACÍAS, M.I. (dir.): *Los nuevos horizontes y metas de la propiedad industrial*. Aranzadi, Las Rozas, 2024, pp. 161-175;

²⁶ HARTWIG, H.: “Evaluation of EU legislation on design protection”, *Journal of Intellectual Property Law & Practice* 17 (2023), p. 109.

²⁷ BRITKA, R., OP DE NEECK, D.: “EU design laws: changes on the horizon”, *European Intellectual Property Review* 45, 8, (2023) p. 470; HARTWIG, H.: “Protection of car designs in Europe –some observations from a practitioner’s perspective”, *ERA-Forum* 11, 3, (2010), p. 451.

groups during the initial DD negotiations and beyond, and so it remained for a long time, until the reform took place and the fragmentation was resolved in a celebrated achievement: the reform culminated with the publication of the Directive (EU) 2024/2823 of the European Parliament and of the Council of 23 October 2024 on the legal protection of designs (recast), on the one hand, and, on the other hand, the Regulation (EU) 2024/2822 of the European Parliament and of the Council of 23 October 2024, amending Council Regulation (EC) No 6/2002 on Community designs and repealing Commission Regulation (EC) No 2246/2002 (currently being subject of codification).

In this article, the focus will be first put on a systematic review of this novel feature of the design reform, the long (until now) unresolved debate around the treatment of spare parts under EU design law and the subsequent introduction of the repair clause in the recast DD. Secondly, the impact of that element of the overall reform in the intellectual property legal framework of Spain will be showcased, providing for an explorative overview on what to do (and how) in the (near) future with regard to this issue, bringing its national particularities into consideration.

II. DESIGN OF COMPLEX PRODUCTS (AND ITS COMPONENTS) IN THE EU UNDER AN INTERNATIONAL LENS

Design can solve problems, give delight and inspire thoughts and deeds²⁸. That explains why the discipline of design was born as a way to satisfy the needs of the citizens, by means of developing objects (serially and grounded on a standard form) whose aim is improving the daily life of the everyday person and the society as a whole. For that to occur, designers have to follow diverse formal, functional, esthetic, economic and symbolic trends or constraints, all in compliance with the existing legal framework(s) and using the technological possibilities at their disposal²⁹. The discipline is based on the idea of conceiving an object, which, while serving the same purpose and performing the same function other objects may also serve and perform, presents a certain degree of individuality³⁰, with the aim of making it more appealing to the potential consumer. Consequently, a good piece of design will be that one being sufficiently attractive to the public and/or the consumers because of the right combination between the final outlook and the function it performs, although it must be brought into consideration that both elements do not have to carry the same weight in all cases³¹. In sum, the

²⁸ TOMITSCH, M., BATY, S., *Designing Tomorrow*, Bis Publisher, Amsterdam, 2023, p. 11.

²⁹ GAY, A., SAMAR, L., *El Diseño Industrial en la historia*. Ediciones TEC, Córdoba, 2007, p. 10.

³⁰ LENCE REIJA, C., *La protección del diseño en el derecho español*. Marcial Pons, Madrid, 2004, p. 17.

³¹ BEEBE, B., “Design Protection” in DREYFUSS, R.C. AND PILA, J.: *The Oxford Handbook of Intellectual Property Law*, Oxford University Press, Oxford, 2018, p. 573.

notion defines how a product looks like rather than (solely) the way it works³², encompassing a dividing line between its outer appearance and the functional destiny. Last, the term can be used to describe both a process and an outcome³³.

Under Intellectual Property Law, the precise definition of design purposely focus on the outcome, in order to allow a univocal legal construct to capture such a multi-faceted and dynamic concept³⁴. It has been rightly said that at the very core of every system for the (intellectual) protection of design, a tension between a desire to protect and promote competition in the commercial sphere and desire of promotion of the arts, creativity and culture can be found³⁵. Therefore, is the set of intellectual operations of designing a product what has deserved particular attention that, in turn, translated into its protection as an intangible asset, supported by the idea of a pre-existing “*corpus mysticum*”, differentiated from the “*corpus mechanicum*”, which is the embodiment of such intellectual creation, that is, the product itself³⁶. Design law is thus concerned with the features or elements applied to an item, but never with the raw item itself as a unit³⁷.

Nevertheless, beyond this apparent straightforwardness, divergent approaches can be found across jurisdictions, whose differences are based on the absence of a common understanding on several elements conforming the system of protection. Many differences arise on substance: what exactly may a design be? What should stand as main legal requisites for a design to acquire protection? What should be left out of the potentially protectable subject matter? How ample the bundle of rights conferred to the right holder should be? How should their relations with other IP rights work?, just to mention a few. Procedurally, whether the systems should be based on registration (or not) is another capital question as it is the case of, finally, the maximum length of time of the conferred protection.

The varied range of national and regional replies to all those questions (and many others) explains why the system for the protection of designs has been considered as a hybrid figure within the intellectual property territory³⁸, in the intersection of the somehow more classic (and, therefore, more consolidated)

³² LAHORE, J.: “Harmonization of Design Laws in the European Communities: the copyright dilemma”, *Common Market Law Review*, 20, (1983), p. 233.

³³ BAINBRIDGE, D.I., *Intellectual Property*, 10th ed., Pearson, Londres, 2018, p. 405.

³⁴ ASO, T., RADEMACHER, C., DOBINSON, J. (eds.), *History of Design and Design Law. An international and interdisciplinary perspective*. Springer, Singapore, 2022, p. 540.

³⁵ KINGSBURY, A.: “International Harmonisation of designs law: the case for diversity”, *European Intellectual Property Review*, 8, (2010), p. 382.

³⁶ FERNÁNDEZ-NÓVOA, C., OTERO LASTRES, J.M., BOTANA AGRA, M., *Manual...*, cit., pp. 350 a 364.

³⁷ PILA, J., TORREMANS, P., *European Intellectual Property Law*. 2nd ed., Oxford University Press, Oxford, 2019, p. 461.

³⁸ CORNISH, W., LLEWELYN, D., APLIN, T., *Intellectual Property: patents...*, cit., p. 10.

patents, copyright and even trademarks systems³⁹. In spite of all that, several common characters are indeed present across different legal systems, such as the requisite of visibility during normal use, the need for a peculiar appearance or the embodiment in an object destined to be commonly used⁴⁰.

The most obvious consequence of this pre-existing diversity, is the lack of binding international provisions: the rather laconic article 5 *quinquies* of the Paris Convention for the Protection of Industrial Property (whose first version dates back to 1883) was added, as a result of a compromise, after the Lisbon Diplomatic Conference held in 1958⁴¹. The content of the provision is far from including any mandatory substantive element, other than a generic obligation of protecting designs (without prescribing exactly how). Likewise, and despite the vast consequences of this international instrument in the intellectual property global landscape⁴², the 1994 Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS hereinafter) includes only two (albeit extremely relevant) articles about requirements for protection and other substantive elements of design rights, which seems modest, at least compared to the evidently more numerous (and also more detailed) provisions dedicated to patents, trademarks and copyright, but involved a certain degree of approximation between jurisdictions (for instance, with the adoption of a mandatory minimum term of protection of 10 years or the requirement of independent creation). The different instruments comprised within the Hague system, of voluntary and independent membership, provide for the easing of international design registrations. Only recently, this international panorama has been completed with a new international instrument, mostly dedicated to harmonizing formalities and procedural elements: the Riyadh Design Law Treaty (known as DLT) was adopted⁴³, clearly late, despite the rising and well-documented trend in design applications worldwide dating back, at least, to

³⁹ CORNISH, W., LLEWELYN, D., APLIN, T., *Intellectual Property: patents...*, cit., p. 590.

⁴⁰ WORLD INTELLECTUAL PROPERTY ORGANIZATION, “Industrial Designs and their relation with works of applied art and three-dimensional trademarks”, doc. SCT/9/6, 2002, pp. 7-8. https://www.wipo.int/edocs/mdocs/sct/en/sct_9/sct_9_6.pdf; VOLKEN, B., “Requirements for design protection: global commonalities”, in HARTWIG, H.: *Research Handbook on Design Law*, ed. Edward Elgar, Cheltenham, 2021, pp. 1 a 29.

⁴¹ PIRES DE CARVALHO, N., *The TRIPS regime of trademarks and designs*. Ed. Wolters Kluwer, Alphen aan den Rijn, 2014, p. 26.

⁴² ABBOTT, F., COTTIER, T., GURRY, F., *The international intellectual property system: comments and materials*. Ed. Kluwer Law, The Hague, 1999, p. 3; CORNISH, W., LIDDELL, K., “The origins and structure of the TRIPS Agreement” en ULLRICH, H. and others: *TRIPS plus 20. From Trade Rules to Market Principles*, ed. Springer-Verlag, Berlín, 2016, pp. 3 a 51; BOTANA AGRA, M.: “Las normas sustantivas del A. ADPIC (TRIP’s) sobre los derechos de propiedad intelectual”, *ADI*, 16, (1995), pp. 109 a 162;

⁴³ GIL CELEDONIO, J.A.: “El Tratado de Riad sobre Derecho de los diseños (DLT) y su contribución al sistema internacional para la protección de la propiedad industrial e intelectual”, *Revista de Propiedad Intelectual e Innovación Digital*, 2, 1 (2025), p. 71.

2010⁴⁴. The common denominator is clear: almost no substantive provisions of mandatory nature, allowing a broad margin of national or regional regulatory flexibility.

In our EU context, the underlying rationale presiding over the whole system of protection builds on the notion that the subject matter comprised under a (registrable) design has to be as broad as possible⁴⁵, what can be read as a neutral approach: pursuant to art. 3 a) of the RCD, design makes reference to “*the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation*”. Some commentators have said that it is a much easier exercise to focus on what is excluded from protection than focusing on what could be potentially included under its *aegis*⁴⁶. Anyhow, this notion is closely linked to the legal meaning of “*product*”, which is intentionally ample as well: as per article 3 b) CDR, in their consolidated version once affected by the last year amendments, product comprehends “*any industrial or handicraft item, other than a computer program, regardless of whether it is embodied in a physical object or materialises in a non-physical form, including a) packaging, sets of articles, spatial arrangements of items intended to form an interior or exterior environment, and parts intended to be assembled into a complex product and b) graphic works or symbols, logos, surface patterns, typographic typefaces, and graphical user interfaces*”. Therefore, under this category both bidimensional and tridimensional designs are suitable for protection, and so one-pieced designs, but also those meant to be incorporated to the so-called “*complex products*”, even though the requirements for protection of the former are thought to be more stringent than the ones set out for the latter⁴⁷.

Pursuant to art. 3. c) RCD, a complex product is defined as “*any product composed of multiple components that can be replaced, permitting disassembly and re-assembly*”. Such a notion could well encompass goods like, for instance, motor vehicles (doubtless, the epitome of the category), but also bicycles, lawnmowers, reclining chairs and divans, pellet boilers and even welding torches⁴⁸. Following

⁴⁴ In 2023, almost one million and two hundred thousand design applications were filed worldwide, containing about one million and half designs, a 2.8% increase with respect to year 2022. WORLD INTELLECTUAL PROPERTY ORGANIZATION, *World Intellectual Property Indicators 2024*, p. 110.

⁴⁵ KUR, A., LEVIN, M., “The design approach revisited: background and meaning”, in KUR, A., LEVIN, M. and SCHOVSBO, J.: *The EU Design Approach. A global appraisal*. Edward Elgar, Cheltenham, 2018, p. 10.

⁴⁶ MUSKER, D., “Community design regulation. Art. 3”, in GIELEN, C., VON BOMHARD, V.: *Concise trade mark and design Law*. Wolters Kluwer, The Hague, 2011, p. 364.

⁴⁷ VRENDENBARG, C. J.S.: “Durable design: what role for EU Design Law in the green transition”, *GRUR International*, 74, 6, (2025), p. 525.

⁴⁸ BOARDS OF APPEAL OF THE EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE, *Component parts of complex products (articles 4(2) and (3) EUDR). Case-law Research Report*, Alicante, 2025, pp. 6-7.

the EU legislative framework, both the complex product as a whole and its individual parts are suitable for protection, provided compliance with the requirements of novelty and individual character (like any other protectable subject matter), as long as, following art. 4.2 RCD, the component part whose protection is sought, once assembled into the complex product, remains visible during normal use and is capable of being defined by those features constitutive of its particular appearance, in a way not to be lost in the overall appearance of the product as a whole⁴⁹. The aforementioned notion of normal use, in the case of this component parts, is to be understood not as an *in abstracto* evaluation but, instead, covering utilizations assessed from the perspective of the user of the product itself as well as from the perspective of an external observer⁵⁰.

It is in the intersection of those notions where the dispute lies: no legal controversy has occupied more thoughts and debates than the one related to the extent of the protection (or its denial thereof) of designs of certain visible component parts of expensive complex products of long lifespan. This category constitutes a particular species within the field of complex products (used routinely on a daily basis): as told, the quintessential example of this category might well be a car, even though other complex products such as watches, smartphones, tablets, coffeemakers or vacuum cleaners may also serve as examples of products of that kind⁵¹. The major discontent in this contentious debate is no other than the possibility that strong protection of certain designs that sort of products may inadvertently produce undesired impacts and distort competition⁵². That is why whether to recognize protection for the components as independent designs and, should this protection be accepted, to what extent and how, varies considerably comparing jurisdictions, since, in principle, diverse regulatory options could find acceptance under TRIPS: members are free to introduce “*limited exceptions*” affecting the scope of the protection of industrial designs they provide for, as long as those exceptions are carefully drafted and in agreement with the so-called “*three-step test*”. This multi-faceted standard is a policy guide for national legislators which originated in the Bern Convention for the Protection of Literary and Artistic Works, but later expanded to other intellectual property remits and, thus, to the international treaties governing them: pursuant to article 26.2 TRIPS, any foreseen exception (or limitation) in the field of design must be 1) limited in purpose and scope and cannot 2) unreasonably conflict with the normal exploitation of protected industrial

⁴⁹ Judgment of 28 October 2021, *Ferrari SpA v Mansory Design Holding GmbH WH*, C-123/20, ECLI:EU:C:2021:889, para. 46.

⁵⁰ Judgment of 16 February 2023, *Monz Handelsgesellschaft International mbH & Co. KG v Büchel GmbH & Co. Fahrzeugtechnik KG*, C-472/21, ECLI:EU: C:2023:105, paras. 45 and 46.

⁵¹ HARTWIG, H.: “Spare parts under European design and trade mark law”, *Journal of Intellectual Property Law & Practice*, 11, 2, (2016), pp. 128-129.

⁵² SUTHERSANEN, U., *Design Law: European Union and USA. Second ed.*, Sweet and Maxwell, London, 2010, chapter 4.

designs nor 3) unreasonably prejudice the legitimate interests of the owner of the protected design, taking account of the legitimate interests of third parties⁵³.

Under this premises, the most heated legal and economic discussions between the Commission and multiple stakeholders were about the length of the protection to be attributed to such component parts and, in particular, the affectation that any particular policy decision on that matter may have upon the automotive and its subsidiary industries in Europe, *vis a vis* other equally relevant economic sectors⁵⁴, as we will delve into below.

III. THE EXTENT OF PROTECTION GIVEN TO COMPONENTS PARTS AND THE AUTOMOTIVE INDUSTRY: THE SPARE PARTS PROBLEM

What it is that makes the automotive industry so sensitive to this dilemma? From the 1970s, fueled by technological developments easing the making and reproducing of crash and other component parts and the expansion of the repair markets, automotive manufactures shifted in their business strategies⁵⁵ and started using design rights in order to control that aftermarket, as the CJEU judgments in *Volvo v. Veng*⁵⁶ or *CICRA v. Renault*⁵⁷ illustrate. The secondary market of repairs generally incorporates two types of components: body panels (outer elements heavily influenced by the overall design of the car, in the sense that body panels from different cars present different shapes) and hard parts (merely mechanics part, normally out of sight and subject to standards)⁵⁸. The first segment of this market of components became a very profitable market, and consequently, heavily influenced by intellectual property rights: while it is not the only possible IP-related strategy, it has been demonstrated that the adequate protection of design rights provide for increased prices for spare parts by 5-8%⁵⁹. Furthermore, it is thought to be a truly competitive one under the right

⁵³ For a detailed and historically well-informed comparative analysis, FRANKEL, S., GERVAIS, D.J., *Advanced introduction to international Intellectual Property*. Edward Elgar, Cheltenham, 2016, pp. 56-77.

⁵⁴ HOLTON, A.: "European Design Law and the spare parts dilemma: the proposed regulation and Directive", *European Intellectual Property Review*, 16, 2 (1994), p. 51.

⁵⁵ GIMENO, L.: 'Spare parts in Spain and from a European perspective', *European Intellectual Property Review* 19 (1997), p. 537.

⁵⁶ Judgment of the Court 5 october 1988, *AB Volvo v. Erik Veng (UK) Ltd.*, C-238/87, (ECLI:EU:C:1988:477)

⁵⁷ Judgment of the Court 5 october 1988, *Consorzio italiano della componentistica di ricambio per autoveicoli and Maxicar v. Régie nationale des usines Renault*, C-53/87, (ECLI:EU:C:1988:472).

⁵⁸ LENCE REIJA, C.: "La propuesta de Directiva sobre la protección del diseño: el freno de la cláusula de reparación" *ADI* 18 (1997), p. 1116.

⁵⁹ HERZ, B., MEJER, M.: "The effect of design protection on price and price dispersion: evidence from automotive spare parts", *International Journal of Industrial Organization* 79, (2021), p. 18.

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regulatory framework, due to the presence of two central actors: the original manufacturers of the car, which occupy a preeminent position in the primary (directly selling car units) and secondary markets (selling original equipment and components for repairs but also for other decorative purposes) and, at the same time, any new company specialized in the (re)production of such parts, which in part may enter the secondary market and operate as an independent alternative for consumers across that value chain. The latter produce replicas and the former own the intellectual property rights over the original components, with (compromised) consumer choice and the insurance industry at the end of the market structure⁶⁰.

However, the structure of this market remains far from being as simple and goes well beyond that basic two-elements configuration, and other operators coexist throughout a broad network of workshops, garages and other kind of establishments: those said original equipment manufacturers are normally working together with original equipment suppliers and authorized spare parts distributors, whereas independent suppliers and independent aftermarket spare parts distributors act jointly on their part, just to name a few. All of them can potentially satisfy the needs of the consumers, which, according to market calculations, may account to as much as 94.6 billion euros per year in the EU as a whole, of which 16.3 billion euros (around 17% of the total) correspond to the particular segment of those components that remain visible (the body panels), such as body parts *per se*, glass elements and integrated lighting pieces⁶¹. This sizable market is heavily influenced by a number of factors, among which we could highlight the following ones (not exhaustively) 1) the belief that vehicles are necessary for the daily life of many citizens (both in rural and urban areas) 2) the considerable number of vehicles in circulation (almost 240 million passenger cars included at the end of 2019⁶²), 3) a rising average weighted age of vehicles in circulation, making them more prone to accidents and problems and, therefore, subsequent repairs and 4) in case of accident or deterioration, the high price or purchasing a new unit compared to the (normally) lower cost of repairing it.⁶³

Going back to our legal debate, from a purely factual point of view, the Commission (joined by many other voices) was rightfully drawing attention about this as problematic as multi-faceted scenario: in the absence of a unified legal regime, the existence of different (if not diametrically opposed) rules on the protection of the spare parts created many headaches to all economic operators

⁶⁰ BELDIMAN, D., BLANKE-ROESER, C., TISCHNER, A.: “Spare parts and Design Protection—different approaches to a common problem. Recent developments from the EU and US perspective”, *GRUR International*, 69, 7, (2020), p. 674.

⁶¹ EUROPEAN COMMISSION, *Market Structure of motor vehicle visible spare parts in the EU*, Luxembourg, Publication Office of the European Union, 2021, p. 16-17.

⁶² EUROPEAN COMMISSION, *Market Structure of motor vehicle...*, cit., p. 15.

⁶³ BELDIMAN, D., BLANKE-ROESER, C., *An international perspective on Design Protection of Visible Spare Parts*, Springer, 2017, p. 6.

and all kind of intermediate and end consumers involved in this aftermarket, forcing them to constantly monitor the diverse national legislation on the matter, although regulatory disparities between member states have traditionally been used by carmakers pricing strategies to maximize profits⁶⁴. Taking a bigger picture approach, this illustrates a suboptimal solution for the well-functioning of the EU internal market, undermining its purpose by creating unduly real barriers to the free movement of goods, even in case those goods were in transit between two countries where selling spare parts was legally sound and therefore resulting in higher costs for consumers.

One example of those hard-ball tactics aimed at impeding the transit of spare parts (to hamper competition with the original parts produced in their jurisdiction) came to the fore in the case *Commission of the European Communities v French Republic*⁶⁵: the French custom authorities detained, in the frontier with Spain, spare parts for motor vehicles intended to be placed on the market in another Member State where their marketing was authorised, considering those spare parts in transit to be counterfeit goods and, as such, infringing rights of French rights holders, as set out under the *Code de la Propriété Intellectuelle*. The Court declared that the mere transit of (from the purely national French perspective) unauthorised copies did not form part of the bundle of exclusionary rights of the design holder and, in consequence, France could not apply any measure restricting that transit to other member states where commercialization was undoubtedly lawful. That kind of measure resulted in a violation of the freedom of movement for goods enshrined in the Treaty⁶⁶. It should be recalled that, not in vain, the DD had been already adopted when the conflict took place, but, even with a provision in full force, many daily practical problems were happening, as this judgement shows.

From a broader perspective, this debate is a clear indication of the dilemma all intellectual property systems have to face while setting the scope and boundaries of the attribution of exclusionary rights: while it is true that its basic protection has pro-competition effects, overprotection(s) could lead to the discouragement of innovation and, *in fine*, competition itself⁶⁷. In other words, it is essential to strike a fair and efficient balance between protection and competition interests⁶⁸. Applied to our case, design law must ensure that the exclusivity conferred by the

⁶⁴ HERZ, B., MEJER, M.: *The effect of design protection on price...*, cit., p. 18.

⁶⁵ Judgment of the Court 26 september 2000, *Commission of the European Communities v French Republic*, C-23/99, (ECLI:EU: C:2000:500).

⁶⁶ Judgment of the Court 26 september 2000, *Commission of the European Communities v French Republic*, C-23/99, (ECLI:EU: C:2000:500), pars. 48-49.

⁶⁷ CRUZ GONZÁLEZ, M.: "Algunas reflexiones en torno a la naturaleza híbrida de las creaciones de forma y su tutela material", *Revista Electrónica de Direito RED*, 33, 1, (2024), p. 983.

⁶⁸ DREXL, J., HILTY, R. M., KUR, A.: "Design protection for spare parts and the Commission's proposal for a repairs clause", *International Review of Intellectual Property and Competition Law*, 36 4, (2005), p. 454.

right boosts the abilities of designers to compete but does not turn them into undeserving monopolists⁶⁹, something also relevant to the rest of the pertinent intellectual property rights governing statutes. That outcome can be achieved by not allowing them to capture markets areas going beyond the one where their intellectual advantage, as embodied in a product, is competing with alternative products. Setting hence a clear line between embracing desired benefits and avoiding undesired effects is not an easy regulatory task, something even more challenging at the European level, where different legal traditions, national economic structures and a broad range of diverging interests remain highly influential in the course of the legislative procedure.

To deal legislatively with the problems arising from the competition in this component parts market (or its lack thereof), from a theoretical point of view, an arguably ample margin remains at hand for policymakers. It may be useful to think about multiple scenarios situated between two extreme study cases: in the first one, parts of a complex product, even dependent on the overall appearance of the product, could not find any individual protection under the legal regime of design rights (very likely discouraging formal and innovation that could lead to suboptimal production of necessary complex products). In the second case, those parts can find full protection under the scope of design law in every situation, creating serious problems from a competition perspective in the aftermarkets and making consumers of those complex goods subject to a *pseudo* contractual lock-in effect well after and beyond the first purchase of the complex product. It is true that between those theoretical extreme study cases, other feasible regulatory options may have included a shorter term of protection for that specific kind of designs (an option raising serious concerns about TRIPS conformity) or a remuneration system with proportional royalties payable to the right holders by their competitors, the independent producers of the spare parts. The Commission and, previously, the main stakeholders of the automotive sectors discarded both options by considering them as insufficiently effective.⁷⁰ This showcases a classic debate about the extension of the scope of protection any IP statute could concede over a particular type of subject matter and, flipping the coin, the limits to be introduced to mitigate its potentially negative collective or societal effects. The EU attempt to tackle this problem is the so-called repair clause, a controversial provision aimed at balancing interests whose contours have not been easy to define across its lively legislative history, which we will have the opportunity to further analyse in detail.

⁶⁹ SCHOVSBO, J., DINWOODIE, G.B., “Design protection for products that are dictated by function” in KUR, A., LEVIN, M. and SCHOVSBO, J.: *The EU Design Approach. A global appraisal*. Edward Elgar, Cheltenham, 2018, p. 142.

⁷⁰ Other possibilities out of the remit of Design Law, of procedural nature or more closely linked to competition law are revisited in FIRTH, A., “Repairs, interconnections and consumer Welfare in the field of Design”, in HEATH, C., KAMPERMAN SANDERS, A. (eds.): *Spare Parts, Repairs and Intellectual Property Rights*, Kluwer International BV, The Hague, 2009, p. 150.

IV. THE REPAIR CLAUSE: A LEGISLATIVE TALE

From the standpoint of the intellectual property theoretical foundations and dogmatics, the repair clause is a limitation: without interfering with the potentially protectable subject matter, it extracts certain acts from the *ius prohibendi* of the right holders, to balance this bundle of rights with other public interests or even fundamental rights at stake⁷¹, thus preventing the promotion of an undesired market failure⁷². As previously seen, the clause attempts to find that middle-ground scenario, aimed at (at least partially) avoiding the negative consequences present in both theoretical scenarios described above, by allowing those parts of a complex product to find protection under a design law regime in no different way as any other registrable design, whereas limiting the rights over the design of such parts for the purpose of repairing the complex product, if and when several conditions are met on the basis of a crafted derogation. Under the lens of the economic analysis of law, it attempts to fine-tune the right incentives for producing such intellectual property but preventing the right holder to charge a price in exchange of access that may exceed its marginal costs of production⁷³

As we will address in more detail later on, the kind of repair clause the Commission always had wanted to introduce was never intended to be applied to all potential spare parts needed for the repair of a complex product, but only to those necessary to restore the original esthetics of the complex product, therefore being not only visible (during normal use) but identical to the original shape. In simpler terms, not every component of the complex product could benefit from the application of the repair clause. The doctrine identifies those particular parts as “*must-match*” components, such as, in the case of a car, the bumpers, doors, wings or lids, *inter alia*. From a competition-friendly point of view, it is clear that, with regard to the spare parts aftermarket, only imitation, in the sense of offering a component of identical shape, is the way to provide consumers with a substitutable alternative while dealing with these components⁷⁴.

The reception of this debate into the EU design *acquis* and the fine-tuning to agree on a satisfactory balance was straightforwardly problematic and had remained unresolved for a long time: in the case of the 1998 DD, its article 14, under the suggestive title “*transitional provision*”, contained the known as “*freeze-plus*” clause, according to which Member States were allowed to maintain whatever existing legal provisions limiting, denying or accepting the protection of the design of a component part used for repairing the complex product so as

⁷¹ KAPYRINA, N.: “Limitations in the field of Designs”, *IIC*, 49, (2017), p. 43.

⁷² SUTHERSANEN, U., *Design Law: European Union...*, cit., chapter 4.2.

⁷³ POSNER, R. A.: “Intellectual Property: the law and economics approach”, *Journal of Economic Perspectives*, 19 2 (2005), p. 57.

⁷⁴ KUR, A., “Limiting IP protection for competition policy reasons” in DREXL, J. (ed.): *Research Handbook on Intellectual Property and Competition Law*, Edward Elgar, Cheltenham, 2008, p. 327.

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to restore its original appearance. National approaches subsisted in one way or another. But, in an attempt of promoting the liberalization of the secondary market of those spare parts, the obligatory content of the freeze-plus clause stated that any Member State willing to change their existing national legislation could proceed as long as it was in line of not granting legal protection under design law for those spare parts in the aforementioned set of circumstances. In other words, only a route of the promotion of competition was allowed for those considering changing their direction.

In addition, article 18 of the DD tasked the Commission with an analysis of the problems that transitional measure could entail and, consequently, with formulating a proposal comprising any changes considered necessary⁷⁵. The results of this cherry-picking policy were evident: once the national transposition procedures of the DD were completed, and after the accession of 10 new member states from 2004 onwards, 11 member states allowed for the use of a spare part under the conditions of the repair clause⁷⁶, while the remaining 17 Member States did not, seriously undermining the harmonizing effects of the DD and creating a patchwork of legal regimes. The *statu quo* prevailed with certain frustration, and the solution was postponed in the form of a future report to

⁷⁵ A more detailed explanation can be found in part of the long recital 19: “...whereas full-scale approximation of the laws of the Member States on the use of protected designs for the purpose of permitting the repair of a complex product so as to restore its original appearance, where the product incorporating the design or to which the design is applied constitutes a component part of a complex product upon whose appearance the protected design is dependent, cannot be introduced at the present stage; whereas the lack of full-scale approximation of the laws of the Member States on the use of protected designs for such repair of a complex product should not constitute an obstacle to the approximation of those other national provisions of design law which most directly affect the functioning of the internal market; whereas for this reason Member States should in the meantime maintain in force any provisions in conformity with the Treaty relating to the use of the design of a component part used for the purpose of the repair of a complex product so as to restore its original appearance, or, if they introduce any new provisions relating to such use, the purpose of these provisions should be only to liberalise the market in such parts; whereas those Member States which, on the date of entry into force of this Directive, do not provide for protection for designs of component parts are not required to introduce registration of designs for such parts; whereas three years after the implementation date the Commission should submit an analysis of the consequences of the provisions of this Directive for Community industry, for consumers, for competition and for the functioning of the internal market; whereas, in respect of component parts of complex products, the analysis should, in particular, consider harmonisation on the basis of possible options, including a remuneration system and a limited term of exclusivity; whereas, at the latest one year after the submission of its analysis, the Commission should, after consultation with the parties most affected, propose to the European Parliament and the Council any changes to this Directive needed to complete the internal market in respect of component parts of complex products, and any other changes which it considers necessary”;

⁷⁶ Belgium, Spain, Ireland, Italy, Luxembourg, the Netherlands, Poland, United Kingdom, Hungary, Latvia and Greece (although with some particularities).

determine how the situation could be sorted out, but the DD, covering many other elements considered necessary, was finally adopted⁷⁷.

Nevertheless, such a limitation of the registered design right did find fortune in the case of the CDR: its article 110, under the title “*transitional provision*” as well, outspokenly outlined that “*protection as a Community design 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 most obvious consequence appeared to be that, as a result of this diverse approach, in order to not relinquish any market advantage, producers of the original parts of the complex product would immediately seek protection for the designs of such parts only in those countries without a repair clause-like provision in force one by one, without using the unitary protection granted by the Community Design, by simply not filing before the (then) OHIM and following the most complicated (but also most profitable) routes before national Intellectual Property Offices⁷⁸.

The fact that the same member states that had previously denied the recognition of the repair clause in the DD in 1998 were, only a few years later, in a position to accept a corresponding provision in the CDR scheme was (and still is) somehow surprising, although it is probably a result of some kind of trade-off in the overall context of the inter-institutional negotiations, as recital 13 of the CDR illustratively suggests⁷⁹. Another hypothetical interpretation could be that some member states, after consultations with the relevant national stakeholders and bearing in mind the traditionally robust national systems for the protection of industrial designs and the experience of their national IP Offices, underestimated the potential of the new unitary system, treating it as a not-very attractive filing system, incapable of competing with their own well-established national systems in place. History proved all parties wrong: on the one hand, in 2003, the first year of operation of the system for registering the Community designs, 10.691 applications were filed containing 37.084 designs⁸⁰, and by 2005 the number grew up to 16.741 applications comprising 63.255

⁷⁷ STONE, D., *European Union Design Law...*, cit., p. 621.

⁷⁸ KUR, A., GYÖRGY, A., “Protection of spare parts in design law: a comparative analysis”, in HARTWIG, H. (ed.): *Research Handbook on Design Law*. Edward Elgar, 2021, p. 308.

⁷⁹ In that recital it can be read, in fine, as follows: “...it is appropriate not to confer any protection as a Community design for a design which is applied to or incorporated in a product which constitutes a component part of a complex product upon whose appearance the design is dependent and which is used for the purpose of the repair of a complex product so as to restore its original appearance, until the Council has decided its policy on this issue on the basis of a Commission proposal.”

⁸⁰ OFFICE OF THE HARMONIZATION OF THE INTERNAL MARKET, *Annual Report 2003*, p. 26. https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/about_euipo/annual_report/ar2003_en.pdf

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designs⁸¹. In 2010, the number of applications received at the Office surpassed the threshold of 80.000 applications⁸², making OHIM the second receiving institution worldwide, only after the intellectual property authority of China. On the other hand, the transitory agreement, whose final solution was relying on the introduction of a targeted amendment the Commission had committed to present, was not transitory at all and was there to stay way longer than expected, since the proposal tabled by the Commission for the (definitive) introduction of the repair clause into DD was indeed adopted in 2004⁸³ but, after long and unsuccessful negotiating attempts between member states at the Council level, was withdrawn for good in 2014⁸⁴.

Whatever the motives behind that strategic policy decision, it seems clear that having two different substantive provisions on the same topic in two different European pieces of legislation which were drafted and enacted with the aim of coexisting more or less harmoniously and approximating the until-then-disperse legal regime for the protection of design in the (formerly) European Community could look like a satisfactory temporary political outcome, as reflective of a *status quo* difficult to overcome, but created distortions in the internal market and also raised problems in commercial and legal practice. As sharply pointed out by the Commission itself, “*there is a single market for cars but no single market for their spare parts. Automotive spare parts cannot be freely produced and traded within the Community... parts producers, especially SMEs, cannot use the economies of scale offered by a single market*”⁸⁵. It is therefore unsurprising that this market complexity, involving such a diversity of underlying economic interests and policy goals, led operators to ask the Courts for guidance. For obvious systemic reasons, judicial interpretation of the relevant provision of the CDR, namely article 110 (and, by analogic extension, the national provisions of those countries fully implementing the repair clause due to the transposition of the article 14 of the DD) was to arise sooner than later.

And so it happened: in the first relevant occasion, upon referral from the *Tribunale di Torino*, the Court declared in the *Ford v. Wheeltrims* case something predictably from a purely legalistic point of view: the repair clause does not

⁸¹ OFFICE OF THE HARMONIZATION OF THE INTERNAL MARKET, *Annual Report 2005*, p. 52-53. https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/about_euipo/annual_report/ar2005_en.pdf

⁸² EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE, *EUIPO Design Focus. 2010 to 2019 evolution*, p. 6. https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/news/EUIPO_DS_Focus_Report_2010-2019_Evolution_en.pdf

⁸³ Proposal for a Directive of the European Parliament and of the Council amending Directive 98/71/EC on the legal protection of designs. Doc. COM (2004) 582 final, 14 of September.

⁸⁴ BELDIMAN, D., BLANKE-ROESER, C.: “European Design Law: Considerations relating to protection of spare parts for restoring a complex product’s original appearance”, *IIC*, 46, (2015), p. 916.

⁸⁵ Doc. COM (2004) 582 final, p. 2.

admit analogic application to other intellectual property rights since, as present only in the CDR, the derogation cannot be invoked as a defense in cases involving trademark law, as it was the intention of Wheeltrims⁸⁶. There was therefore no possibility of application *per analogiam* of the repair clause in trademark law *acquis*, as it was confined only to design law and, in particular, to the EU-wide system. This settled a line of legal reasoning of utmost importance for future debates. Because of the formulation of the questions submitted by the Italian referring court, there was no opportunity to construe the provision in substantive terms.

Nevertheless, the moment of consideration in substance will arrive with the joined cases C-397/16 and C-435/16, submitted, respectively, by the *Corte d'appello de Milano* and the German Supreme Federal Court of Justice. The cases concerned the interpretation of the scope of the article 110 CDR, in two parallel proceedings being held in Italy and Germany, which had Acacia Srl (and its manager Rolando d'Amato) as a central element because of their alleged infringement of registered community designs whose holders were the companies Pneusgarda Srl, Audi AG and Dr. Ing. h.c. F. Porsche AG. Among the main findings of the verdict, the Court declared first that the article 100 CDR does not impose as a condition to trigger the repair clause that the protected design incorporated in the spare part has to be dependent upon the appearance of the complex product⁸⁷, thus showing an inconsistency between the content of recital 13 CDR and what it is stated in the operative part of such legal act, that is, the relevant rule of the CDR. With this interpretation, the Court supported a wider interpretation of the clause, based also on the legislative history of the provision, contrary to the ideas brought up to the proceedings by Audi and Porsche. Traditionally, that approach was key for the Commission too.

Secondly, the ruling rejected the idea that the repair clause could allow for any use of a component part for mere reasons of preference or pure convenience, including the replacement of a part for aesthetic purposes or to customise the complex product, therefore clearly confining its scope to the purpose of repairing and restoring the original appearance of such complex product⁸⁸. Furthermore, collaterally, it confirmed that the provision was compliant with the three-step-test of article 26.2 of the TRIPS Agreement⁸⁹. And last, but importantly, the

⁸⁶ Order of 6 October 2015, *Ford Motor Company vs Wheeltrims srl*, c-500/148, (ECLI:EU:C:2015:680), paras. 39-45.

⁸⁷ Judgment of 20 december 2017, *Acacia Srl v Pneusgarda Srl (in insolvency), Audi AG and Acacia Srl, Rolando D'Amato v Dr. Ing. h.c. F. Porsche AG*, joined cases C-397/16 and C-435/16 (ECLI:EU:C:2017:992), para. 34.

⁸⁸ Judgment of 20 december 2017, *Acacia Srl v Pneusgarda Srl (in insolvency), Audi AG and Acacia Srl, Rolando D'Amato v Dr. Ing. h.c. F. Porsche AG*, joined cases C-397/16 and C-435/16 (ECLI:EU:C:2017:992), paras. 70 and 75.

⁸⁹ Judgment of 20 december 2017, *Acacia Srl v Pneusgarda Srl (in insolvency), Audi AG and Acacia Srl, Rolando D'Amato v Dr. Ing. h.c. F. Porsche AG*, joined cases C-397/16 and C-435/16

Court went beyond the literal wording of article 110 CDR and dived into the prevention of the consequences of the misuse of the provision, by adding a due diligence duty manufacturers or sellers of non-original spare parts would have to comply with as a way to preserve the effectiveness of the repair clause (and, obviously, the rights of the original design holders), although the Court was conscious about the fact those manufacturers or sellers of the spare parts could not be expected to guarantee, objectively and in all circumstances, that the parts they make or sell for use in accordance with the abovementioned conditions are actually used by end users in compliance with those conditions. The set of obligations jurisprudentially construed are manifold: it included informing the downstream user, through a clear and visible indication on the product, on its packaging, in the catalogues or in the sales documents that the component part concerned incorporates a design of which they are not the holder and that the part is intended exclusively to be used for the purpose of the repair of the complex product so as to restore its original appearance. It also imposed those producers or sellers the obligation to ensure, using the contractual means at their disposal, downstream users do not intend to use the component parts at issue in a way that does not comply with the conditions of the repair clause. Finally, the manufacturer or seller must refrain from selling such a component part in case they know or, in the light of all the relevant circumstances, ought reasonably to know that the part would not be used in accordance with said conditions⁹⁰, all in line with the abovementioned Commission's 2004 proposal.

This line of judicial reasoning was welcomed by some scholars as a clear development of the EU Design Law *acquis*, since it settled a new interpretation standard against what had been previously applied by many national Courts⁹¹ and, on the basis of an in-depth opinion of the AG Saugmandsgaard Oe, showed greater understanding of the role of the repair clause in the full implementation of the idea of a common market while also acknowledging the need for precautionary measures from its beneficiaries⁹². Other commentators consider the rule to be apparently broad in scope but rather narrow in terms of its

(ECLI:EU:C:2017:992), para. 76. Nevertheless, it could be argued that the Court of Justice of the European Union is not the entity having the last word on the interpretation of the TRIPS Agreement, as any alleged violation relating to the TRIPS application of any party of the Treaty is left to the WTO dispute settlement mechanism. For the time being, the EU has been never accused of violating art. 26.2 TRIPS because of the repair clause as it currently is so no case is open nor concluded in that forum.

⁹⁰ Judgment of 20 december 2017, *Acacia Srl v Pneusgarda Srl (in insolvency), Audi AG and Acacia Srl, Rolando D'Amato v Dr. Ing. h.c. F. Porsche AG*, joined cases C-397/16 and C-435/16 (ECLI:EU:C:2017:992), paras. 86 a 88.

⁹¹ KUR, A., GYÖRGY, A., "Protection of spare parts ...", cit., pp. 308 a 310.

⁹² TISCHNER, A., "Chopping off Hydra's Heads: Spare parts in EU Design and Trade Mark Law", in BRUNN, N., DINWOODIE, G.B., LEVIN, M., OHLY, A. (eds.): *Transition and Coherence in Intellectual Property Law. Essays in Honour of Annette Kur*. Cambridge University Press, Cambridge, 2020, p. 395.

application in practice⁹³ while others, on the contrary, have complained about the alleged flaws of a policy-driven decision and the rejection of the value of recitals as means of interpretation of the operative provisions⁹⁴.

This background, composed of two failed legislative attempts and the *Acacia* decision of the Court, is key to understand further developments until the adoption of the Commission’s proposals of 2022, which included, in the DD, a full-scale implementation of the repair clause and, in the CDR, amendments to article 110 to align it to the corresponding article of the DD. According to the public consultations the Commission undertook, the lack of harmonization of the repair clause issue remained as a top concern for many users and industries, but, in our opinion, due to the confronted and long-standing opinions of several member states, it could be naïve to believe these reasons suffice to explain the bold and self-conscious movement of the Commission proposal on that matter. While it is true that many environmentally-friendly principles enshrined in high-level strategic documents of the Commission (such as the European Green Deal⁹⁵) and, in particular, the emergence of the so-called “right to repair”⁹⁶ are factors influencing the design reform⁹⁷, for the repair clause to succeed several Member States had to change their position or, at least, tolerate a change in the overall situation.

⁹³ SCHOVSBO, J., DINWOODIE, G.B., “Design protection for products that are dictated by function” in KUR, A., LEVIN, M. and SCHOVSBO, J.: *The EU Design Approach. A global appraisal*. Edward Elgar, Cheltenham, 2018, p. 162.

⁹⁴ CORNWELL, J.: “Nintendo v BigBen and Acacia v Audi: design exceptions at the CJEU”, *Journal of Intellectual Property Law & Practice*, 14, 1, (2018), pp. 51 a 61.

⁹⁵ Not by chance, it is so mentioned in recital 33 of the Directive (EU) 2024/2823 of the European Parliament and of the Council of 23 October 2024, on the legal protection of designs (recast).

⁹⁶ SVENSSON, S., RICHTER, J.L., MAITRE-EKERN, E. et alii, *The emerging “right to repair” legislation in the EU and the US*. Paper presented at Going Green CARE INNOVATION, 2018; OZTURKCAN, S.: “The right-to-repair movement: sustainability and consumer rights”, *Journal of Information Technology Teaching Classes*, 14, 2, (2024), pp. 217 a 222. In this regard, the EU institutions passed the Directive (EU) 2024/1799 of the European Parliament and of the Council of 13 June 2024, on common rules promoting the repair of goods, commonly known as “Right-to-repair Directive”, whose article 5.6 prohibits manufacturers from impeding the repair of their products by several tools or elements such as software or hardware techniques, contractual clauses, or opposing the use of spare parts, but with no prejudice to legislation on the protection of intellectual property rights.

⁹⁷ As openly said by the Commission itself, behind the reform initiative was (also) the idea of modernising the EU legislation on industrial designs to better support the transition to the green and digital economy. Vid. EUROPEAN COMMISSION, *Making the most of the EU’s innovative potential An intellectual property action plan to support the EU’s recovery and resilience*, COM/2020/760 final, p. 10. Clearly connected with those environmental ideas although out of the remit of intellectual property law, but constraining the freedom of the designers (and therefore the potential protectable subject matter), the EU institutions have also adopted the Regulation (EU) 2024/1781, of the European Parliament and of the Council of 13 June 2024, establishing a framework for the setting of ecodesign requirements for sustainable products, known in daily practice as “Eco-Design Regulation”.

And so it happened: Germany⁹⁸ and France⁹⁹, two of the most influential member states within the EU political and legal system and traditional opponents to the liberalization of the spare parts markets, introduced repair clause-like provisions in their respective national design legislations, therefore moving towards the direction envisaged in the transitional provision of the DD¹⁰⁰. It is as obvious as unconfessed that the Commission was aware of the scope of those changes, which greatly increased the likelihood of the future adoption of the repair clause. Without those two big countries in the blocking minority in the sense of the current Council voting rules on the qualified majority, any legislative discussion would look very different¹⁰¹.

Article 19 of the (then) proposal for a DD included a comprehensive repair clause, of mandatory nature for all member states, definitely deleting the transitional provision as set out in the then-in-force article 14 DD. The initial text was as follows:

1. Protection shall not be conferred on a registered design which constitutes a component part of a complex product, upon whose appearance the design of the component part is dependent, and which is used within the meaning of Article 16(1) for the sole purpose of the repair of that complex product so as to restore its original appearance.

2. Paragraph 1 cannot be invoked by the manufacturer or the seller of a component part of a complex product who failed to duly inform consumers, through a clear and visible indication on the product or in another appropriate form, about the origin of the product to be used for the purpose of the repair of the complex product, so that they can make an informed choice between competing products that can be used for the repair.

3. Where at the time of adoption of this Directive the national law of a Member State provides protection for designs within the meaning of paragraph 1, the Member State shall, by way of derogation from paragraph 1, continue until ... [OP please insert the date = ten years from the date of entry into force of this Directive] to provide that protection for designs for which registration has been applied before the entry into force of this Directive.

In the case of the CDR, the proposals of the Commission involved deleting art. 110 and introducing a new article 20a, identical in terms of substantive

⁹⁸ The case of Germany is analysed down to the last detail in BELDIMAN, D., BLANKE-ROESER, C., TISCHNER, A.: "Spare parts and Design Protection...", cit., pp. 682 a 685.

⁹⁹ The repair clause was introduced, as par. 3 of Article L513-6 in the *Code de la propriété intellectuelle*, by the Act n° 2021-1104, to support the fight against climate disturbance and strengthen the resilience against its effects, which somehow indicates the relation between the limitation and the environmental targets to achieve.

¹⁰⁰ FALTA TEXTO NOTA

¹⁰¹ FALTA TEXTO NOTA

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contents to what we referred to above, but related to the EU-wide registered design right instead. Due to the own legal nature of the Regulation, the previous paragraph 3 was not included since it does not require any transitional period for transposition.

As it can easily be seen, the substantive content is identical, overcoming the regulatory differences between the two levels of the two-tier system for the protection of designs in the EU, thus achieving the desired harmonizing goal. The due diligence duties envisaged in the *Acacia* decision are introduced less ambitiously, and the form-dependency requirement of the spare part for the repair clause to be duly triggered is proposed, deviating from the interpretation of the clause given by the Court, in what can be considered, in the best case, as a political gesture to the countries traditionally opposed to the implementation of the repair clause, since it narrows its application. Not haphazardly, it should be recalled that was also the position heralded by the Government of Germany in the context of the *Acacia* proceedings. The proposal was quickly (and fully endorsed) by the Max Planck Institute for Innovation and Competition¹⁰² and, less enthusiastically (pointing out at some caveats), by other relevant groups such as the German Association for the Protection of Intellectual Property¹⁰³ or, in a joint position, the International Trademark Association (INTA), the European Communities Trademark Association (ECTA) and MARQUES¹⁰⁴.

No significant changes were introduced during the inter-institutional discussions. The European Parliament position tried to significantly depart from this approach by eliminating the form-dependency requirement, lowering the threshold of the due diligence obligations towards downstream or final users to a mere presumption and even allowing member states to adopt or not adopt the repair clause, which seems even internally contradictory¹⁰⁵, but negotiations with the Spanish Presidency of the Council of the EU paid off and achieved to reframe the debate. The final position was by far closer to the initial Commission proposal on the matter, overwhelmingly supported by the member states on the

¹⁰² KUR, A., ENDRICH-LAIMBÖCK, T., HUCKSCHLAG, M., *Position statement of the Max Planck Institute for Innovation and Competition of 23 January 2023 on the “Design Package”*, pp. 10-11.

¹⁰³ GRUR, *Comments of the GRUR Committee for Design Law on the European Commission’s Proposal for a Regulation amending the Community Designs Regulation [COM(2022)666] and a Proposal for a Directive on the legal protection of designs [COM(2022)667]*, https://www.grur.org/uploads/tx_gstatement/2023-01-20-GRUR_Comments_on_Proposal_CDR_and_Design_Directive_with_annexes.pdf, p. 8.

¹⁰⁴ ECTA, INTA, MARQUES, *Joint comments of ECTA, INTA and MARQUES on the EU’s proposed new Design Law, January 2023*. https://www.inta.org/wp-content/uploads/public-files/advocacy/testimony-submissions/20230202_FINAL_Design-Law-Reform_Joint-Comments-of-ECTA-INTA-MARQUES.pdf

¹⁰⁵ The position of the Parliament is tabled in document A9-0317/2023, adopted in JURI Committee the 30th of October, 2023 by 17 votes in favour, 6 abstentions and 2 votes against.

Council side¹⁰⁶: a clearer structure was given to the article but the only change, non-substantive, was related to the deadline for the full implementation of the repair clause, by reducing the deadline given to those Member States not having the repair clause introduced by the time of the entry into force of the DD from the initial period of 10 years (as per both the Commission proposal and the general approach of the Council) to a shorter timeframe of 8 years from such said date.

The final iteration of the provision is now law of the land: art. 19 of the current DD can be read as follows

“1. Protection shall not be conferred on a registered design which constitutes a component part of a complex product upon whose appearance the design of the component part is dependent, and which is used within the meaning of Article 16(1) for the sole purpose of the repair of that complex product so as to restore its original appearance.

2. Paragraph 1 shall not be invoked by the manufacturer or the seller of a component part of a complex product who failed to duly inform consumers, through a clear and visible indication on the product or in another appropriate form, about the commercial origin, and the identity of the manufacturer, of the product to be used for the purpose of the repair of the complex product, so that they can make an informed choice between competing products that can be used for the repair.

3. The manufacturer or seller of a component part of a complex product shall not be required to guarantee that the component parts they make or sell are ultimately used by end users for the sole purpose of repair so as to restore the original appearance of the complex product.

4. Where on 8 December 2024, the national law of a Member State provides protection for designs within the meaning of paragraph 1, the Member State shall, by way of derogation from paragraph 1, continue until 9 December 2032 to provide that protection for designs for which registration has been applied for before 8 December 2024.”

Likewise, a new article 20a CDR, introduced by Regulation (EU) 2024/2822, shows now identical content, mirroring the same structure set out in the DD, other than the paragraph 4 (not necessary in the legal form of a Regulation).

The final legislative compromise on the repair clause was almost unanimously applauded by both the political groups of the European Parliament and the member states representatives at the Council of the European Union. The Committee of Permanent Representatives was keen to endorse the legislative agreement and declared that this particular achievement was the most

¹⁰⁶ The general approach of the Council was adopted in the meeting of the Council on Competitiveness held the 25th, September, 2023, per doc. 12714/23 and their addenda 1 and 2.

tangible outcome of the inter-institutional negotiation, as well as the most important element of the reform from an economic standpoint¹⁰⁷. Likewise, the Commission explicitly confirmed its deep satisfaction because of the successful cloture of a very sensitive legal issue after almost 30 years of negotiations. The Committee on Legal Affairs of the European Parliament approved the overall political agreement without any abstentions or votes against, and the Plenary endorsed the final resolution comprising the unaltered outcome by 455 votes in favour, 7 votes against and 68 abstentions. It is therefore easy to conclude that expectations were generally fulfilled: among member states, only Sweden opposed the agreement in their final vote of confirmation (in no way putting the agreement in jeopardy). The repair clause is now settled law of the land, with defined contours and with parallel contents in both legal texts in force, guaranteeing consistency and harmonization.

V. WHAT IS NEXT FOR SPAIN?

As noted in article 36 of the recast DD, the general transposition time limit given for member states to comply with is set by 9 December 2027, 36 months after the DD entered into force. Therefore, Spain, as the rest of the member states, will have to incorporate the substantive content of the recast DD into national legislation, considering whether or not to adopt part of its non-mandatory elements. However, as seen above, the repair clause was purposely given a way longer timeframe for adoption and implementation, as per par. 4 of article 19 DD. In the case of Spain, all things considered, it seems burdensome to conduct two partial transpositions in two (separate) dates. The apparently non-problematic main features of the DD should be easily considered and passed by the national legislators and, for reasons of procedural and legislative economy, it looks advisable to do everything at once. According to the Royal Decree 1270/1997, the Spanish Patents and Trademarks Office (SPTO) should initiate all the pertinent preparatory work related to this legislative proposal, as the national entity not only legally charged with the application and promotion of international intellectual property legal acts and regulations (including European law, in our opinion), but also guardian of the right expertise and knowledge on this particular field.

Whatever the path chosen, it will definitely imply adopting a legal act for the purpose of amending the current legislation in force, the Act 20/2003, of 7th July, on the legal protection of industrial design¹⁰⁸. Although it may seem preliminary, this legislative procedure may also provide an excellent opportunity to, at least,

¹⁰⁷ COUNCIL OF THE EUROPEAN UNION, Doc. ST 16476/23.

¹⁰⁸ First published on the Spanish Official Journal (Boletín Oficial del Estado) on 8 of July, 2003, pages 26348 to 26368, it has been partially amended three times, none of them in a detailed way neither touching any major or substantive regulatory dimension.

conduct a detailed assessment on the changes to be necessarily introduced in the Spanish design law framework because of the recent adoption of the DLT, considering the impact this relevant Treaty may have in the national procedure for the registration of designs, taking into account the overall evaluation the Commission will have to conduct on the matter. The alignment between the EU and the national system should be wide-ranging. Formally, passing the reform by using the quasi-legislative capacity conceded to the Council of Ministers in the form of a Royal Decree-Law is an option that remains at hand as a potential avenue, in case of late transposition (although ulterior validation by the Congress will be anyway required), as it was the case of the transposition of the trademark Directive in 2018¹⁰⁹.

It should be recalled that the abovementioned Act 20/2003 was a major step towards the modernization of the intellectual property legislative framework of Spain, whose cornerstone in the moment of its adoption, the comprehensive Industrial Property Statute, dated back to the 1929. Confessedly, the imperatives of the European legislation were behind the adoption of this piece of legislation, as its goal was no other than the (late) transposition of the DD of 1998 into the Spanish legal framework¹¹⁰. The (national) doctrine considers this piece of legislation as a regulatory basis to partially emancipate the *sui generis* design system from the remit of other intellectual property rights in our country¹¹¹. Although consistent with the historical tradition, the terminology used by the legislators was criticized as somehow misleading: from the title of the legal act to the content of its operative part, the addition of the adjective “*industrial*” to the central notion of “*design*” could make readers to consider that only a certain kind of designs, mostly the ones industry-related, are suitable for protection under this piece of legislation, which is not the case at all once diving into the material provisions¹¹². This is particularly relevant, in our opinion, since the notion of “*industrial*”, attached to “*design*”, is not mentioned in the official linguistic versions of the EU legislation on the matter (not even in Spanish). Nevertheless, it does not appear to have created any problem in practice. Indirectly, bearing

¹⁰⁹ This legislative shortcut is constitutionally correct where urgency and necessity are grounded, as confirmed by the settled case-law of the Constitutional Court. Vid. GIL CELEDONIO, J. A.: “Una solidaridad de hecho: la configuración...”, *cit.*, pp. 492-494.

¹¹⁰ As set out at the very beginning of the preamble, this legislation can be understood in the overall context of a legislative package aimed at updating the somehow old-fashioned national intellectual property framework: as immediate precedents, the Act 17/2001, of 7 December, on Trademarks, and the Act 10/2002, of 29 April, to amend the Act 11/1986, of 20 March, on Patents, were adopted, both also driven by European legislation.

¹¹¹ CANDELARIO MACÍAS, M.I., *La creatividad e innovación empresarial: la tutela del diseño industrial en el mercado interior*. Eurobask, Bilbao, 2007, p. 35.

¹¹² DOMÍNGUEZ PÉREZ, E.M.: “La protección jurídica del diseño industrial: la novedad y el carácter singular. Reflexiones en torno al Proyecto de Ley de protección jurídica del diseño industrial”, *Actas de Derecho Industrial y derecho de autor*, 23 (2002), p. 89; LENCE REIJA, C., *opus cit.*, p. 18.

in mind the time of its adoption (2003), the national legislation also mimicked (without any formal obligation to) several provisions of the CDR, as it was adopted and made public in parallel with the national preparatory works¹¹³, this being an example of the so-called “*cold fusion*” trend under the EU *acquis*, a term used to describe a situation where, for reasons other than a mandatory implementation, the national legislation is amended to be aligned with the EU legislation due to the perceived benefits of harmonization¹¹⁴. Precisely because of that, many of the novel procedural features the reform of the DD made mandatory for member states are already present in the Spanish legislation, so no transposition will be required.

Going into substance, and as previously pointed out, in respect of the legal debates on the repair clause Spain was one of those Member States advocating for its adoption, and the national legislators made full use of the legislative margin given by the *freeze-plus* solution. Although hidden in its third transitional provision, the repair clause was (is) included in the Act 20/2003. According to that provision, the rights conferred to any holder of the design of a component part of a complex product could not be exercised as to impede the use of the concerned design, under two mandatory conditions: a) the product that incorporates the design constitutes a component part of a complex product upon whose appearance the design of the component part is dependent, and b) it is used to allow the repair of the complex product to restore its original appearance. According to the Court of Appeal of Alicante, its scope should be construed narrowly but not in such a way as to deprive the provision from its effectiveness, a line of judicial thinking which is consistent with the EU case law¹¹⁵. In sum, as other pro-liberalization member states, Spain admitted the registration of the components as such, but under a special regime which affect those designs in case they need to be used for the purpose of repair (and only in those cases). A good example of how a repair clause-like provision looks in practice.

It is therefore not a coincidence this 2003 wording perfectly matches the recently negotiated and already-in-force wording of article 19, paragraph 1, of the recast DD. Therefore, no material changes will be required, but, for the sake of the systematic understanding of the implications of the repair clause, it would

¹¹³ GÓMEZ SEGADÉ, J.A.: “Panorámica de la nueva ley española de diseño industrial”, *ADI*, 24, (2003), p. 32.

¹¹⁴ As exemplified by the alignment between the EU and national Plan Variety legislation without the enactment of any Directive, vid. KUR, A., DREIER, T., *European Intellectual Property Law. Text, Cases and Materials*. Edward Elgar, Cheltenham, 2013, pp. 324-326.

¹¹⁵ Due to that interpretation, as happened in the vast majority of national court cases, supplementary parts such as wheel rims (the contested products in this dispute) cannot be recognized under the umbrella of the repair clause, since they are parts of complex products but their influence over the overall appearance of the product is not decisive. SAP A 2214/2010 of 18 of June (ECLI:ES:APA.2010:2214), valid before the *Acacia* ruling.

be advisable to eliminate the current third transitional provision and, instead, to introduce the substantive content in the operative part of the legal act, probably as a new paragraph within the article devoted to the exceptions and limitations imposed to the design rights holder, that being article 48, under Chapter 1 of Title VI.

But, as explained in detail above, the repair clause-related content does not end with the wording around the exception in itself, but it is accompanied by two other paragraphs outlining the due diligence and informative obligations the distributors or sellers of the non-original spare parts have to comply with to avoid any liability, should the final user not dedicate such spare part for repairing purposes, in line with the *Acacia* ruling mandate. In this regard, the Spanish legislator will be obliged to incorporate those elements, due to the absence of that substantive content in the Act 20/2003. While it could be argued this normative content is more connected to consumer protection laws than to the more traditionally oriented intellectual property-like provisions, the incorporation of the abovementioned content should follow the DD structure without further deviations, to comply with the EU mandate, but also for systematic reasons and legal certainty. The most logical outcome would be, in that case, to amend said article 48 to incorporate two paragraphs on that matter, for the sake of clarity and with the aim of showing that those conditions are closely tied to the rightful and compliant deployment of the repair clause.

VI. PROBLEMS IN THE HORIZON? TWO CONCLUDING CAVEATS.

In spite of the warm political welcoming this long-awaited achievement has received, it should be borne in mind that their true results will potentially have to wait until 9 December 2032. Its full-scale implementation in practice will need time, according to the timeframe given to member states, as per paragraph 4 of article 19 DD. Therefore, no immediate appraisal is possible. In the meantime, economic operators presenting conflicting market positions will remain, unable to operate under a full scenario of liberalization of this particular aftermarket unless the most reluctant member states decide to proceed faster, something probably unlikely. Performing what it could be nothing but an anticipatory exercise, it is expectable though that the relations between the right holders of designs over the original parts and the manufacturers of non-original spare parts will take place in a somehow clearer scenario: the latter will rely on a sound legal provision already informed by the case law of the CJUE, and, at the same time, the former will have enough grounds to monitor carefully that the conditions under which this limitation can be invoked and triggered are respected, empowering them so as to avoid misuse. In theory, the situation is now resolved within the realm of the EU Design law statutes as the repair clause was adopted without ambiguities and presents a fair solution balancing contradictory interests, while giving enough time for different operators to adapt

to the foreseen regulatory environment. The tool will be there to add clarity to the routine problems generated in usual commercial relations.

Nonetheless, the hybrid nature of the subject matter protectable under our *sui generis* UE design regime poses other kind of risks meriting due consideration: because of the ambivalent status of design law within the intellectual property world, heavily encroached by copyright, trademark and even patent law¹¹⁶, overlapping rights over the same subject matter are legally allowed and more plausible in practice than it looks first-hand. As dictated by the CJEU in the *Ford v. Wheeltrims* case, the repair clause cannot possibly expand beyond the remit of design law, so there may well be a problem arising at the frontiers between design and copyright law when works of applied arts constitute the subject matter at issue: by-passing the repair clause, a clearly undesirable outcome. This idea of circumventing the limitation enclosed in the repair clause by means of the use of the right of reproduction (and probably also the right of communication to the public) over the same subject matter has been the object of several theoretical discussions well before the adoption of this limitation¹¹⁷ and it is inextricably related to the notion of overprotection¹¹⁸. At the end of the day, the EU principle of cumulation, expressly sought by the legislators, entails the exploitation of two different intellectual property rights over the same subject matter, thus allowing the right holder to act against any potential infringer using one of the

¹¹⁶ SUTHERSANEN, U.: “Breaking down the intellectual property barriers”, *Intellectual Property Quarterly*, 3, (1998), p. 284.

¹¹⁷ Just to name a few, SPEYART, H.M.H.: ‘The grand design: an update on the E.C. design proposals, following the adoption of a Common Position on the Directive’, *European Intellectual Property Review* 19 (1997), p. 611; BELDIMAN, D., BLANKE-ROESER, C., TISCHNER, A.: “Spare parts and Design Protection...”, cit., pp. 681 a 682; KUR, A., “Limiting IP protection for competition...”, cit., p. 331; DERCLAYE, E., “Doceram, Cofemel and Brompton: how does the current and future CJUE case law affect digital designs”, en PASA, B. (ed.): *Il design, l’innovazione tecnologica e digitale, Un dialogo interdisciplinare per un ripensamento delle tutele – Design, technological and digital innovation. Interdisciplinary proposals for reshaping legal protections*, Edizioni Scientifiche Italiane 2020, pp. 11-12. <https://ssrn.com/abstract=3507802>; BONADIO, E. and others, “Copyright and Designs– a renewed relationship”, Report of the Global Digital Encounter 28 FIDE-TIPSA, (2023), pp. 2-3 <<https://thinkfide.com/wp-content/uploads/2023/07/Final-Report-GDE-28-Copyright-and-designs-%E2%80%93-a-renewed-relationship.pdf>>

¹¹⁸ SENFTLEBEN, M., “Overprotection and protection overlaps in Intellectual Property Law– the need for horizontal fair use defences”, in KUR, A. y MIZARAS, V. (eds.): *The structure of Intellectual Property Law: can one size fit all?*, Edward Elgar, Chentelham, 2011, p. 136. Although any assessment in this regard is necessarily subjective, the most obvious and undesired outcome might well be the unduly extension of the time limits of protection, from a maximum of 25 years from the date of registration as permitted under Design law (provided renovations every 5 years) to the 70 years after the death of the author/designer time limit present in copyright law.

two intellectual property rights in force, or even using both simultaneously¹¹⁹. That situation could lead to a scenario of overprotection.

Could any competitor, legitimately producing replicas of the original components in observance of the conditions set out in the provisions governing the repair clause, be infringing the copyright over the design of the original component? The recent developments of the case-law over the originality requirement of copyright law as regards works of applied arts, in cases such as *Cofemel*¹²⁰, *Brompton*¹²¹ and others yet to come¹²², merit duly consideration to avoid upsetting the repair clause due to the recognition of copyright over a component part. As theoretical as it may sound, the broad array of judgments with more than questionable outcomes on this regard suggests complicated national judicial digestions of the abovementioned rulings¹²³. The enforcement of claimed copyright over the component by the original producer could unduly block the full rollout of the repair clause, what would contradict both the spirit and the admitted objectives of such a limitation.

Beyond the copyright/design interface, problems arising from trademark law may also be present. Some commentators have argued that the apparent insufficiencies of the current EU trademark law *acquis*, as it is now, could also have negative implications for the proper rollout of the right to repair¹²⁴. The repercussions of trademarks over the repairing activity are well known, since trademarks play a pivotal role not only for the commercialization of the spare parts, but also to indicate their purpose of repair¹²⁵. A recent decision of the CJUE, the case *Audi AG v GQ*¹²⁶, has clearly shown many practical and problematic facets of this relation. The central question of this dispute, submitted to the CJEU by a court of Poland, is essentially an iteration of the core of the legal discussion

¹¹⁹ JÄNICH, V. M.: “Perspectives on the relationship between copyright and Design Law after Cofemel/G-star– The Australian regulation of copyright/design overlap as a Role model for European Law?”, *GRUR International* 72, (2023), p. 451.

¹²⁰ Judgment of 12 of september 2019, *Cofemel-Sociedade de Vestuário SA v G-Star Raw CV*, C-683/17, ECLI:EU:C:2019:721.

¹²¹ Judgment of 11 of june, 2020, *Brompton Bicycle Ltd v Chedech/Get2Get*, Case C-833/18, ECLI:EU:C:2020:461

¹²² Joined cases C-580/23 y C-795/23, *Mio AB, Mio e-handel AB, Mio Försäljning AB v Galleri Mikael & Thomas Asplund Aktiebolag and konektra GmbH, LN v. USM U. Schärer Söhne AG* (ruling forthcoming)

¹²³ CRUZ GONZÁLEZ, M.: “Algunas reflexiones en torno a...”, cit., p. 97.

¹²⁴ *Inter alia*, PIHLAJARINNE, T., “Repairing and re-using from an exclusive rights perspective—towards sustainable lifespan as part of a new normal?” in ROGNSTAD, O. and ØRSTAVIK, I. B. (eds.): *Intellectual Property and Sustainable Markets*. Edward Elgar, London, 2021, p. 81; IZYUMENKO, E.: ‘Intellectual Property in the age of environmental crisis: how trademarks and copyright challenge the human right to a healthy environment’, *IIC*, 55, (2024), p. 864.

¹²⁵ TISCHNER, A. and KSTASIUK, K.: “Spare Parts, Trade Marks and consumer understanding”, *IIC* 54 (2023), p. 27.

¹²⁶ Judgment of 25 of January 2024, *Audi AG v GQ*, C-334/22, ECLI:EU:C:2024:76.

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already analysed in *Ford v. Wheeltrims* and, likewise, although comprising many different factual elements, it was resolved for the benefit of Audi (the owner of the concerned trademark), showing how the expandable strength of a trademark was able to invalidate the kind of competition the repair clause was aimed at creating. While it is not an actual case of overlapping between a (shape) trademark and a registered design, the overreaching expansion of the capital trademark notion of “*use in the course of trade*” is concerning, as an example of the sometimes controversial relation between trademark and design law. It seems pertinent to recall what AG Medina argued in the opinion she delivered on the case, whose literal content can be read as follows:

“*in cases where EU trade mark law converges with other domains of intellectual property law, the Court has consistently interpreted fundamental provisions of Regulation 2017/1001 – and its predecessors – in such a manner as to avoid the neutralisation of the common objectives of those domains and to ensure that they are satisfied in full, especially with a view to protect a system of undistorted competition in the market.*”¹²⁷

Even bearing in mind we are referring to different intellectual property statutes, both identified situations share the problems regulatory asymmetry creates in cases of overlapping rights over the same subject matter, which illustrates the always-complex demarcations between classical intellectual property rights. Unduly maximizing protection when stakeholders have different catalogues of rights and limitations to rely on appears to be a risk worth preventing¹²⁸. It has been rightfully claimed that the contribution of the case-law to solve legal intricacies, no matter how decisive it may be, should not represent the standard solution in isolation¹²⁹, even recognizing the degree of flexibility it helps inserting in the system by “*shaping and reshaping*” the overall intellectual property legal framework¹³⁰. If legal inconsistencies were to be found, the right response to overcome any foreseen problems that may arise, such as the ones we have identified above, needs to be of regulatory nature.

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