

Kur, Annette

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# From “Local Privilege” to “Global Standard”: Facilitating Design and Copyright Protection for Non- EU Product Shapes

Annette Kur

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**Abstract** It is well known that EU law tends to offer rather generous protection for product shapes, not least under industrial design and copyright law. Until recently, however, the statement had to be qualified with regard to works or designs not originating in the EU (or the EEA). For designs, this resulted from the fact that, pursuant to the majority opinion, designs first published outside the EU were not entitled to benefit from Unregistered Community Design protection under Art. 11 of the Community Design Regulation. Concerning copyright, Art. 2(7) of the Berne Convention was assumed to bar access to protection for works that in their country of origin are only amenable to protection under industrial design law. In both aspects, recent developments in EU law have levelled the bars, turning “EU-style” protection into a “global standard”.

**Keywords** Design law reform · Unregistered Community designs · Supplementary unregistered design · Works of applied art · Reciprocity · Law applying to aliens

## 1 Introduction

Compared to other legal systems, protection of product appearances in the EU tends to be rather generous. This concerns protection for shape marks, which is complemented in a number of Member States by specific, as yet non-harmonised rules on unregistered trade mark protection or protection under unfair competition law. In addition, EU law grants low-threshold access to industrial design

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A. Kur (✉)  
Prof. Dr. Dr. h.c.; Affiliated Research Fellow, Max Planck Institute for Innovation and Competition,  
Munich, Germany  
e-mail: [annette.kur@ip.mpg.de](mailto:annette.kur@ip.mpg.de)

protection,<sup>1</sup> and, due to CJEU case law, the prerequisites for protection under copyright are confined to the work being an author’s own intellectual creation.<sup>2</sup> However, until recently, the generous tableau concerning industrial design and copyright law had to be qualified with regard to works not originating in the EU. Regarding industrial design protection, the special instrument of the Unregistered Community Design (UCD) was held to apply only to designs that were first published within the territory of the EU, thereby practically withholding that option from designers located outside the EU.<sup>3</sup> In copyright, Art. 2(7) second sentence of the Berne Convention establishes an obstacle to protection for works which, in their country of origin, can only profit from design protection.<sup>4</sup> In its recent *Kwantum* decision,<sup>5</sup> the CJEU has declared that, lacking an express reservation to that effect in the InfoSoc Directive, Art. 2(7) Berne Convention cannot be invoked vis-à-vis non-EU works. And concerning UCDs, the recent design law reform consciously removed wording from the previous law which had been quoted by the majority opinion in support of its restrictive approach.

This article recounts and comments on the developments. First, it addresses the background and presumable reasons for the change in design legislation (Sect. 2). The *Kwantum* decision is then put in context, including a reference to the preceding *RAAP* judgment (Sect. 3). Finally, the question is posed as to the consequences, and whether measures are called for to safeguard justified interests of right holders or the public within the EU (Sect. 4).

## 2 Design Legislation

### 2.1 Regulation No. 6/2002

As a unique feature among unitary EU rights created so far, Art. 11(1) of the Community Design Regulation No. 6/2002 (CDR) established a right that comes into existence without registration. Pursuant to the provision, designs fulfilling the substantive requirements for protection (i.e. which are novel and have individual character) “shall be protected by an unregistered Community design for a period of three years as from the date on which the design was first made available to the

<sup>1</sup> The EU industrial design system was established by Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs (DD) and Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (CDR). The DD was replaced in 2024 by Directive (EU) 2024/2823 of the European Parliament and of the Council of 23 October 2024 on the legal protection of designs; the CDR was amended by Regulation (EU) 2024/2822 of the European Parliament and of the Council of 23 October 2024 (EUDR).

<sup>2</sup> See Sect. 3.2.

<sup>3</sup> See Sect. 2.1.

<sup>4</sup> “Works protected in the country of origin solely as designs and models shall be entitled in another country of the Union only to such special protection as is granted in that country to designs and models; however, if no such special protection is granted in that country, such works shall be protected as artistic works”.

<sup>5</sup> Case C-227/23 *Kwantum v. Vitra Collections* [2024] ECLI:EU:C:2024:914.

public within the Community”. The wording does not clearly state whether the territorial element (“within the Community”) relates to the place of publication or to the location of the target public. Article 11(2) CDR offers a somewhat closer definition:

For the purpose of paragraph 1, a design shall be deemed to have been made available to the public within the Community if it has been published ... in such a way that, in the normal course of business, these events could reasonably have become known to the circles specialised in the sector concerned, operating within the Community.

While that phrase as well is not unambiguous, it invites drawing a parallel to Art. 7(1) second half-sentence CDR, which stipulates, in nearly identical wording, that a pre-published design is *not* deemed to have been made available to the public “where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community”. As was clarified by the CJEU in *Gautzsch*, Art. 7(1) second half-sentence CDR applies irrespective of where the place of publication was located.<sup>6</sup> Does this mean that Art. 11(1) CDR must be interpreted accordingly?

The question was denied by the German Federal Supreme Court in its *Gebäckpresse* (bakery press) decision, mainly based on the consideration that Art. 7(1) CDR refers to “making available to the public”, while Art. 11(1) CDR adds “within the Community”.<sup>7</sup> On the other hand, the fact remains that the legal definition of that phrase in Art. 11(2) CDR uses exactly the same words as Art. 7(1) second half-sentence CDR. According to established principles of interpretation, this indicates that both must be interpreted concordantly, meaning that it is not the place of publication, but only the location of the target public which is of relevance. Until recently, however, such considerations appeared to be moot in view of a provision inserted in the course of the EU enlargement in 2004. Article 110a CDR, which regulates the consequences of extending the Community design regime to the new Member States, addresses UCDs in paragraph 5 second sentence, stipulating that “(p)ursuant to Article 11, a design which has not been made public within the territory of the Community shall not enjoy protection as an unregistered Community design”. This seemed to disperse the lingering doubts. Pointing to that sentence, the Federal Supreme Court considered the issue to be an “*acte clair*”, which does not call for a referral to the CJEU.

In *BHTB v. PMS*,<sup>8</sup> the High Court of England and Wales (Hacon J.) sided with the German Federal Supreme Court regarding the relevance of Art. 110a(5) CDR. However, being more cautious, the court decided to refer the question, among others, to the CJEU.<sup>9</sup> After the dispute was settled between the parties, the case was withdrawn, leaving the matter open for now.

<sup>6</sup> Case C-479/12 *Gautzsch v. Duma* [2014] ECLI:EU:C:2014:75, para. 33.

<sup>7</sup> German Federal Supreme Court (Bundesgerichtshof, BGH), I ZR 126/06, GRUR 2009, 79 – *Gebäckpresse*.

<sup>8</sup> High Court, 17 September 2019, *Beverly Hills Teddy Bear Company v. PMS International Group Plc* (Hacon J.) [2019] EWHC 2419 (IPEC).

<sup>9</sup> Case C-728/19 *Beverly Hill Teddy Bear Co. v. PMS*, removed from the register by Order [2020] ECLI:EU:C:2020:114.

## 2.2 Changes Under Regulation No. 2024/2822

With the amendment of the CDR by Regulation No. 2024/2822, the situation has changed. While Art. 11 CDR has remained the same, Art. 110a(5) second sentence CDR has been deleted. The change was only announced in the very last version of the proposal. Somewhat surprisingly, it was not preceded by any (documented) discussion in the legislative bodies, nor does it find any explanation in the preamble or the explanatory memorandum. The reasons for altering the text are therefore not quite clear. The only source known so far to shed light on the matter is the statement by a Commission officer that Art. 110a CDR in its entirety, including paragraph 5 second sentence, was limited to application in the context of EU enlargement, and should never have been employed as a tool for interpreting Art. 11 CDR.<sup>10</sup> In other words, Art. 110a(5) second sentence CDR was intended to clarify that designs previously published in the acceding Member States only enjoy UCD protection if they fulfil the necessary requirements, i.e. if they could have become known in the ordinary course of business to the specialised circles operating in the “old” Member States.<sup>11</sup> Consequently, the Commission officer contended that removal of Art. 110a(5) second sentence CDR was a direct reaction to decisions like *Gebäckpresse*,<sup>12</sup> which in the Commission’s opinion erroneously employed the provision beyond its inherent limits.<sup>13</sup>

There is no need to discuss here whether the Commission’s arguments are convincing. The fact remains that, after removal of Art. 110a(5) second sentence CDR, it is no longer possible to rely on the provision to argue that referring the issue to the CJEU is unnecessary.

## 3 The *Kwantum* Judgment

### 3.1 The Conflict

In *Kwantum*, the holder of the copyright to furniture design by the famous designer couple Ray and Charles Eames filed an infringement claim in the Netherlands against a firm reproducing the “Dinner Wood Side (DWS) chair”. For works of applied art such as furniture, Art. 2(7) second sentence of the Berne Convention provides an exception from the principle of national treatment, replacing it with a system of reciprocity. If the work is only amenable to design protection in the country of origin, the same applies in other Member States, irrespective of the national standards otherwise applying. The issue was of relevance because the DWS

<sup>10</sup> Statement by Tomás Eichenberg (EU Commission) at the “GRUR Meets Brussels” conference, 11 June 2022, reported by Kur (2023). Prior to publication the article was submitted to Mr. Eichenberg for confirmation, which was kindly given. It must be noted that at the occasion, Mr. Eichenberg did not speak under the reservation of stating his personal opinion, but acted as a representative of the Commission.

<sup>11</sup> That interpretation was endorsed even prior to the change in Howe et al. (2022), chapter 2, marginal note 2-121.

<sup>12</sup> *Supra* note 7.

<sup>13</sup> Statement by Tomás Eichenberg, reported by Kur (2023).

chair originates from the USA, where copyright protection is not a valid option for articles that are characterised by a conscious (and artful) merger of functional and aesthetic elements.<sup>14</sup> The Dutch Supreme Court therefore referred to the CJEU a number of questions, *inter alia* whether this was a matter for EU copyright to decide and, if so, whether it would have been necessary to explicitly provide for a reservation in the relevant EU legislation.

### 3.2 Uniform and Autonomous Notion of “a Work”

Since its *Infopaq* decision,<sup>15</sup> the CJEU endorsed the position that by harmonising the notion of reproduction in the InfoSoc Directive (29/2001), the EU legislators also harmonised the notion of a work. Little did it matter that such far-reaching harmonisation was not intended when the InfoSoc Directive was passed;<sup>16</sup> the CJEU continued to affirm and complement its jurisprudence in a line of subsequent decisions.<sup>17</sup> Pursuant to that case law, a work must satisfy two cumulative conditions, namely, it must be original in the sense that it is the author’s own intellectual creation, and second, the subject matter to be protected by copyright must be expressed in a manner that makes it identifiable with sufficient precision and objectivity.<sup>18</sup> In *Cofemel*<sup>19</sup> and *Brompton*,<sup>20</sup> the same criteria were declared to apply to works of applied art. The issue had been contentious before, due to the fact that Art. 17 of the Design Directive (1998/71) and Art. 96 CDR (6/2002), while obliging Member States to accept cumulation of copyright and industrial design as a matter of principle, explicitly left it to the Member States to determine the conditions and extent of copyright protection, including the required level of originality. Without even addressing that reservation or the doubts resulting therefrom, the CJEU contended that the provisions remain unaffected by the harmonisation of copyright allegedly occurring through the InfoSoc Directive.<sup>21</sup> Somewhat more explicitly, the Advocate General pointed out that the deference to the Member States was motivated by the diversity of national systems at the relevant time, and had become obsolete when harmonisation was achieved.<sup>22</sup>

<sup>14</sup> So-called “doctrine of separability”. For details, see Ginsburg (2018), pp. 297–340.

<sup>15</sup> Case C-5/08 *Infopaq v. DDF* [2009] ECR I-06569, para. 37.

<sup>16</sup> As confirmed in Commission staff document, SEC(2004) 995, 19 July 2004.

<sup>17</sup> Case C-145/10 *Painer v. Standard* [2011] ECLI:EU:C:2011:798, para. 87; Joined Cases C-403/08 and C-429/08 *Football Association Premier League v. Murphy* [2011] ECLI:EU:C:2011:631, para. 97; Case C-393/09 *BSA v. Ministerstvo kultury* [2010] ECLI:EU:C:2010:816, para. 45; Case C-604/10 *Football Dataco v. Yahoo!* [2012] ECLI:EU:C:2012:115, para. 38.

<sup>18</sup> Case C-310/17 *Levola Hengelo v. Smilde Foods* [2018] ECLI:EU:C:2018:899, paras. 36–40.

<sup>19</sup> Case C-683/17 *Cofemel v. G-Star* [2019] ECLI:EU:C:2019:721.

<sup>20</sup> Case C-833/18 *Brompton Bicycle v. Get2Get* [2020] ECLI:EU:C:2020:461.

<sup>21</sup> Case C-683/17 *Cofemel v. G-Star* [2019] ECLI:EU:C:2019:721, paras. 44–47.

<sup>22</sup> Opinion by Advocate General Szpunar, Case 638/16 *Cofemel v. G-Star* ECLI:EU:C:2019:363, paras. 37, 38. That reasoning is somewhat precarious, as the InfoSoc Directive – on which the CJEU’s assumption of full harmonisation of the notion of a work is grounded – went into force several months earlier than the CDR. The Advocate General considered and discarded that argument as well, pointing out that the respective legislative processes ran more or less parallel, and that, if the legislature had actually

In a number of national jurisdictions, works of applied art had indeed been subject to distinct standards differing from other work categories, and varying between Member States.<sup>23</sup> Against that background, the CJEU’s contention of full harmonisation having been achieved without any legislative measures addressing the point (apart from certain special areas<sup>24</sup>) was bound to create problems. The unease caused thereby is enhanced by uncertainties surrounding the distinction between copyright and design protection: while the CJEU insists that overlaps between both fields must be limited to “certain cases”, the criteria offered for distinguishing between the two fields are theoretical and abstract rather than providing concrete guidelines for practice.<sup>25</sup> This may lead to a situation where the borderlines between design and copyright law, though being upheld in theory, are gradually eroded, so that total cumulation becomes the rule rather than the exception. In that scenario, applying Art. 2(7) Berne Convention would make a real difference for works originating from Berne Member States applying a much higher threshold for copyright protection.

### 3.3 Extension to “*Fremdenrecht*”?

#### 3.3.1 *Relevance of the Question*

Despite the criticism raised against the CJEU’s robust pro-harmonisation agenda, it is an accepted fact in practice that the notion of a work, including works of applied art, must be interpreted uniformly and autonomously, following the criteria spelled out in the pertinent case law. Without doubting the validity of that starting point, the question posed by the referring court in *Kwantum* concerned an additional element, namely whether harmonisation of substantive law also includes the law applying to aliens (in German: *Fremdenrecht*). Different from private international law determining the law applicable to a given issue,<sup>26</sup> the body of rules forming the law applying to aliens determines whether national law can be relied on by persons or with regard to subject-matter which do not satisfy certain (territorial) requirements. In intellectual property, those rules can be traced back to times when exclusive rights were privileges granted by the sovereign, of which aliens could only benefit, if at all, under the condition of reciprocity. Whereas much of this

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Footnote 22 continued

intended to exempt the field of applied art from the harmonising effect of the InfoSoc Directive, this would have been spelled out more clearly; *ibid.*, paras. 41, 42.

<sup>23</sup> See the detailed overview given in Derclaye (2018), on the history and current situation in France, the Netherlands, Greece, the Nordic countries, Germany and the UK (plus Australia, Japan, and the USA).

<sup>24</sup> See Art. 1(3) of the Software Directive (91/250; now: 2009/24); Art. 3(1) Database Directive (96/6); Art. 6 Term Directive (93/98; now: 2006/116), concerning photographs.

<sup>25</sup> For comments (in English) on *Cofemel* and/or *Brompton* highlighting that point, see Inguanez (2020), pp. 797–822; Endrich-Laimböck (2020), pp. 264–269; Fhima (2020), pp. 761–767; Kur (2020), pp. 290–300; Schovsbo (2020); for an overview on post-*Cofemel* court practice, see Derclaye (2024), pp. 121–138. Clarification of the criteria for protection is currently sought in pending Cases C-580/23 *Mio v. Asplund* and C-795/23 *konektra v. USM*.

<sup>26</sup> In this case: Dutch and Belgian law as the law of the countries for which protection is sought in the underlying dispute, see Art. 8(1) Rome II Regulation (864/2007).

has become obsolete due to the nearly global coverage of the Paris Convention, Berne Convention and TRIPS with their principle of national treatment, those rules still play a role for copyright and related rights, firstly, because the latter are not so extensively covered by international agreements ensuring national treatment, and secondly, because the Berne Convention itself reverts to reciprocity in a couple of instances, such as Art. 2(7).<sup>27</sup>

### 3.3.2 The RAAP Judgment

The question whether substantive harmonisation also extends to the law applying to aliens was first addressed in the *RAAP* judgment.<sup>28</sup> The conflict concerned the right of performers and producers of phonograms to claim remuneration for the secondary use of their achievements. While this is a mandatory feature under Art. 8(2) of the Rental and Lending Directive (2006/15), the international law provision on which it is based, Art. 15 of the WPPT,<sup>29</sup> allows WPPT members to deposit a reservation with the WIPO. The option had been used by Ireland (but not the EU). The question therefore arose whether the exercise of the reservation vis-à-vis performers who were not residents in the EU or the EEA, or whose performances had not taken place there, was compatible with the obligations under the Rental and Lending Directive. The CJEU denied the question. As the Directive does not grant any deference regarding the conditions under which remuneration is paid by the Member States, invoking the reservation was held to disrupt the envisaged harmonisation.<sup>30</sup> The CJEU added that it is permissible in principle, and might even be commendable, to grant such claims only under the condition of reciprocity.<sup>31</sup> However, in view of the fact that this would amount to a limitation of rights which, in principle, are entitled to protection under Art. 17(2) of the Charter of Fundamental Rights (CFR), the CJEU considered it necessary under Art. 52 CFR to anchor a relevant provision in the written law.<sup>32</sup>

### 3.3.3 Application in *Kwantum*

The *Kwantum* decision<sup>33</sup> runs largely along the same lines as *RAAP*. At first glance, this is no surprise, as the issues are indeed parallel to some extent. However, a closer examination shows certain differences, of which at least the following is quite substantial. Unlike *RAAP*, *Kwantum* did not concern one particular type of remuneration claim, but the more fundamental question of whether copyright can be

<sup>27</sup> Other examples are Art. 7(8) concerning the term of protection and Art. 14<sup>ter</sup>(3) Berne Convention concerning the resale right.

<sup>28</sup> Case C-265/19 *RAAP v. PPI* [2020] ECLI:EU:C:2020:677.

<sup>29</sup> WIPO Performances and Phonograms Treaty (1996).

<sup>30</sup> Case C-265/19 *RAAP v. PPI* [2020] ECLI:EU:C:2020:677, para. 68.

<sup>31</sup> Case C-265/19 *RAAP v. PPI* [2020] ECLI:EU:C:2020:677, para. 84.

<sup>32</sup> Case C-265/19, *RAAP v. PPI* [2020] ECLI:EU:C:2020:677, paras. 85, 86.

<sup>33</sup> CJEU C-227/23 *Kwantum v. Vitra Collections* [2024] ECLI:EU:C:2024:914.



invoked at all.<sup>34</sup> The argument used by the CJEU and the Advocate General, that denying copyright in the DWS chair clashes with the wording and the general rules governing the interpretation of Arts. 2 and 4 of the InfoSoc Directive,<sup>35</sup> is therefore beside the point. This is about *whether* those provisions apply in the present case, and not about *how* they must be interpreted. The CJEU’s negligence of the fact that these are different categories of legal rules is rightfully criticised in the literature.<sup>36</sup>

This does not necessarily mean, however, that the decision “rests on feet of clay”.<sup>37</sup> While it is true that substantive harmonisation must be distinguished from harmonisation of the rules governing application of the law vis-à-vis aliens, the CJEU is not hindered from considering the consequences of its ruling within the context of the envisaged harmonisation<sup>38</sup> and, more generally, in the light of the primary law-based principle of free movement of goods. Leaving it to national law to apply Art. 2(7) Berne Convention is liable to create obstacles to the free movement of goods between Member States that do grant full protection and those that do not. Arguing that, while such effects may be undesirable, they are a natural consequence of lacking harmonisation<sup>39</sup> ignores that the question to be decided here is exactly whether harmonisation has in fact occurred; the argument amounts to a *petitio principii* rather than disproving the CJEU’s reliance on the factual connection- and primary law-based logic of synchronisation between the levels of substantive law and the rules governing its application to aliens.

It is true that, instead of foreclosing the option for individual Member States to invoke Art. 2(7) Berne Convention, a uniform solution would also result from treating the provision as part of the “common *acquis*”, as suggested in an opinion by the European Copyright Society (ECS).<sup>40</sup> However, similar to what was held in *RAAP*, the CJEU perceives a problem of fundamental law. As works of applied art are protected in principle by Art. 17(2) CFR, limiting the right in any way needs a basis in written EU law, as postulated in Art. 52(1) CFR. It is true that at this stage of the proceedings the question whether the item satisfies the criteria for copyright protection is a hypothetical one: if Art. 2(7) Berne Convention applies, the

<sup>34</sup> Further aspects are listed in the Opinion issued by the European Copyright Society (ECS), see van Eechoud et al. (2024), pp. 1316, 1323: *RAAP* concerned an obligation under the WPPT of which the EU is a member, whereas it is only indirectly bound to the Berne Convention; unlike in *RAAP*, harmonisation of the notion of a work did not occur by explicit legislation, but was “constructed” by the CJEU; while Art. 15(3) WPPT only offers an option, Art. 2(7) Berne Convention is formulated as a rule. However, those points do not make much difference: the fact that the Berne Convention only applies via other agreements does not change its binding nature; furthermore, it could hardly be expected that the CJEU recognises a difference between “explicit” and merely “judge-made” harmonisation; and lastly, the rule-like wording of Art. 2(7) Berne Convention does not affect the possibility of granting full protection; see also Case C-277/13 *Kwantum v. Vitra Collections* [2024] ECLI:EU:C:2024:914, para. 87 (on Art. 351 TFEU).

<sup>35</sup> Case C-227/23 *Kwantum v. Vitra Collections* [2024] ECLI:EU:C:2024:914, para. 68; Opinion of Advocate General Szpunar, 5 September 2024, ECLI:EU:C:2024:698, para. 53.

<sup>36</sup> Huckschlag (2025); Hugenholtz (2024a) (concerning the Advocate General’s Opinion).

<sup>37</sup> Thus: Huckschlag (2025).

<sup>38</sup> Case C-227/23 *Kwantum v. Vitra Collections* [2024] ECLI:EU:C:2024:914, para. 63, pointing to Recital 6 of the Rental and Lending Directive.

<sup>39</sup> Thus: Hugenholtz (2024b).

<sup>40</sup> van Eechoud, Metzger, Quintais and Rognstad (2024), pp. 1316, 1325.

fulfilment of those criteria would not even be tested. By invoking Art. 17(2) CFR in this situation, the CJEU extends the coverage of the provision from intellectual property *strictu sensu* to the theoretical potential of subject matter to be so protected. In the light of decisions by the European Court of Human Rights (ECtHR) that is a consequent move: the ECtHR accorded protection under Art. 1 First Protocol to the European Convention of Human Rights (ECHR) to trade mark applications,<sup>41</sup> meaning that maturation into a full right cannot be denied on the basis of provisions inserted into the law after the relevant filing date. The situation is different here, but the fact remains that the position of the author or right holder of subject matter which – if meeting the relevant standards – would fall within the category of applied art is protected insofar as the requirements governing the attribution (or denial) of copyright for such items must live up to basic legal standards. In the present context, this includes Art. 52(1) CFR, according to which limitations must be “provided by law”. It is true that Art. 52(1) is usually understood as referring to limitations such as those listed in Art. 5 InfoSoc Directive, while Art. 2(7) Berne Convention concerns the more fundamental question of whether copyright is acknowledged at all. This does not make Art. 52(1) CFR inapplicable or meaningless. On the contrary, what must be observed with regard to limitations of individual claims is certainly also a valid requirement for measures hindering the attribution and exercise of a right as such.

That being said, the CJEU’s conclusion is correct that Art. 2(7) Berne Convention does not suffice for the purpose. EU law differs in that regard from national systems which, after ratification and, where necessary, further measures (such as a positive vote in Parliament and publication in the official gazette), allow for direct application of norms from international treaties under the condition that they are expressed clearly and unconditionally.<sup>42</sup> In the EU, that option is lacking not only concerning the Berne Convention itself – of which the EU is not a member – but also concerning TRIPS<sup>43</sup> and the WPPT.<sup>44</sup>

Against that background, it does not come as a surprise that for the CJEU, the absence of an express reciprocity clause in the InfoSoc Directive is tantamount to excluding the application of Art. 2(7) Berne Convention. While the reasoning is consequent, it is also somewhat ironic. Instead of reflecting the will of the legislature to grant uninhibited access of non-EU works to copyright protection, the silence on this point rather confirms that the legislature had no intention at all to harmonise the notion of a work through the InfoSoc Directive. Had the legislative bodies been aware of what the CJEU would read into the text, the consequences would at least have been debated, and might have resulted in adopting a reciprocity clause reiterating Art. 2(7) second sentence Berne Convention. However, it is of no

<sup>41</sup> ECtHR, 11 January 2007, 73049/01 *Anheuser-Busch v. Portugal*, para. 78.

<sup>42</sup> Those requirements are met by Art. 2(7) Berne Convention, which is therefore directly applied, e.g. in France (see Cour de Cassation, 7 October 1020 – D 18–19, 441, *Knoll v. Mobilier*, concerning the “Tulip” chair by Eero Saarinen), and in Germany (Düsseldorf District Court, 22 December 2022, 14c O 45/21, concerning a movable wall; Hamm Court of Appeal, 25 June 1992, 4 U 100/92, concerning the “Tube Light” lamp created by Eileen Gray).

<sup>43</sup> Joined Cases C-300/98 and 392/98 *Dior v. Assco* [2000] ECLI:EU:C:2000:688, para. 44.

<sup>44</sup> Case C-135/10 *SCF v. Del Corso* [2012] ECLI:EU:C:2012:140, para. 48.

use now to complain. Whether it was a lack of diligence on the part of the legislature, which did not fully realise the consequences of the InfoSoc Directive, or whether the blame lies on an over-active Court: either way, it would have been unrealistic to expect that the logic underlying the *InfoSoc* decision,<sup>45</sup> and becoming visible in its full extent in *Cofemel*,<sup>46</sup> would stop at the issue of “*Fremdenrecht*”.

## 4 Conclusions and Consequences

### 4.1 Unregistered Designs

The removal of Art. 110a(5) second sentence CDR during the design law reform did not meet with much resistance, but it was also not unanimously supported. *Inter alia*, in an opinion by the German Association for Intellectual Property (GRUR), it was urged that Art. 110a(5) second sentence CDR should remain unchanged or that, if a “paradigm shift” was indeed intended, it should be expressed more clearly in Art. 11(1) CDR and/or in the recitals.<sup>47</sup> Express statements to that effect would indeed have been helpful, all the more so as the Commission itself had previously refuted suggestions to delete Art. 110a(5) second sentence, based on the argument that “allowing for the creation of a UCD on the basis of disclosure occurring everywhere outside the EU” would be “to the clear detriment of EU industries”.<sup>48</sup> The fact that the provision was nevertheless removed from the final text therefore marks a change of position on the Commission’s part, without the reasons being clearly revealed.<sup>49</sup> While that is unfortunate, it is not a tenable position to claim that, absent more explicit explanations, the changes should simply be ignored, and the matter be treated as “established case law”. Earlier decisions do not offer a basis for that. In *Gebäckpresse*,<sup>50</sup> the BGH expressly relied on Art. 110a(5) second sentence CDR as a reason for not referring the matter to the CJEU, and Hacon J. in *BHTB v. PMS* considered the matter not to be an “*acte clair*” even under the old law.<sup>51</sup> Thus,

<sup>45</sup> *Supra* note 15.

<sup>46</sup> *Supra* note 19.

<sup>47</sup> 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], p. 6, item IV, at: [https://www.grur.org/uploads/tx\\_gstatement/2023-01-20-GRUR\\_Comments\\_on\\_Proposal\\_CDR\\_and\\_Design\\_Directive\\_with\\_annexes.pdf](https://www.grur.org/uploads/tx_gstatement/2023-01-20-GRUR_Comments_on_Proposal_CDR_and_Design_Directive_with_annexes.pdf).

<sup>48</sup> Commission Staff Working Document – Evaluation of EU legislation on design protection, SWD(2020) 264 final, pp. 28, 29; at: <https://ec.europa.eu/docsroom/documents/43705/attachments/1/translations/en/renditions/native>.

<sup>49</sup> See, however, the statement by Tomás Eichenberg, *supra* note 10. In the same statement – still not speaking on his own behalf, but as a representative of the Commission – Mr. Eichenberg contended that pursuant to the view held by the Commission, Art. 11 CDR must be interpreted in the same way as Art. 7(1) second half-sentence, that is, irrespective of where the first publication occurred; Kur (2023). That statement as well was submitted to and received confirmation from Mr. Eichenberg.

<sup>50</sup> BGH, I ZR 126/06, GRUR 2009, 79 – *Gebäckpresse*.

<sup>51</sup> High Court, 17 September 2019, *Beverly Hills Teddy Bear Company v. PMS International Group Plc* (Hacon J.) [2019] EWHC 2419 (IPEC), paras. 37–40 (though sympathising with the BGH’s view).

while deleting Art. 110a(5) second sentence may not suffice in itself for determining with certainty that Art. 11 CDR (now: EUDR) does not require publication within the territory of the EU, it definitely gives sufficient reason to seek clarification from the CJEU. Denying a referral under the changed conditions would manifestly clash with basic obligations under Art. 267 TFEU, as first defined in the *CILFIT* decision.<sup>52</sup>

It must be added that renouncing the requirement of first publication in the EU does not have the negative repercussions feared by some. In particular, such protection does not arise “automatically” through publication in non-EU territories, but only if the publication occurs in the manner specified in Art. 11(2) CDR, that is, if it could reasonably have become known in the normal course of business to the circles specialised in the sector concerned which are operating in the EU. Furthermore, in order to successfully invoke a UCD, the plaintiff must prove that the defendant has engaged in an act of copying, meaning that the alleged infringer was familiar with the prior design. Making that proof is not easy in practice, in particular in fields characterised by a high density of shapes and forms. In such circumstances, the plaintiff will typically only satisfy the burden of proof if the designs are nearly identical, especially if further indicia exist, such as preceding relations between the parties.<sup>53</sup> To claim that granting protection in such cases would be a “clear detriment” to EU-based industries would send a rather dubious signal to other countries. And finally, denying UCD protection to designs first published elsewhere *de facto* results in unequal treatment of EU nationals and “foreigners”, which may clash with Art. 3 TRIPS.<sup>54</sup>

The change is of relevance *inter alia* in relation to the UK. After it was not possible in the negotiations on the post-Brexit Trade Agreement to ensure that designs first published in the UK would enjoy UCD protection under Art. 11 CDR, the UK authorities declared in a spirit of reciprocity that designs first published in the EU are not entitled to claim protection under the new instrument of Supplementary Unregistered Design (SUD) replacing the EU right.<sup>55</sup> However, the issue is still unclear, as the wording of the relevant provision corresponds to Art. 11 CDR which, without Art. 110a(5) second sentence, is open to a territorially neutral interpretation.<sup>56</sup> As stated by the UK government as a result of consultations among stakeholders, there is currently much uncertainty about disclosure requirements, which calls for further consideration.<sup>57</sup> With Art. 110a(5) second sentence CDR gone, the way should be open on both sides of the Channel for a more liberal

<sup>52</sup> Case C-283/81 *CILFIT v. Ministero della Sanità* [1982] ECR 03415. Those criteria were qualified to some extent by Case C-561/19 *Consorzio Italian Management (CIM)* [2021] ECLI:EU:C:2021:799, but remain in force in their essence.

<sup>53</sup> That was the factual situation underlying the dispute in BGH I ZR 126/06, GRUR 2009, 79 – *Gebäckpresse*

<sup>54</sup> For a thorough development of that argument, see Kur (2023), pp. 11–17.

<sup>55</sup> <https://www.gov.uk/guidance/changes-to-unregistered-designs#disclosure>.

<sup>56</sup> See Howe, St Ville and Chantrille (2022), chapter 2, marginal note 2-121.

<sup>57</sup> <https://www.gov.uk/government/consultations/reviewing-the-designs-framework-call-for-views/outcome/call-for-views-on-designs-government-response>, paras. 24–27.

handling of the UCD (and SUD) requirements – one which relies on awareness and impact rather than on localisation of physical actions.

#### 4.2 *Kwantum*

The CJEU’s taking of control over the law applying to aliens by declaring it to be part and parcel of substantive harmonisation has evoked critical reactions. This was already true for *RAAP*, for quite practical reasons: as the remuneration collected by copyright management organisations must be distributed to a larger circle of beneficiaries, the share of each person tends to get smaller, unless fees are raised.<sup>58</sup> *Kwantum* as well is received rather critically.<sup>59</sup> Concerning the legal consequences of both decisions, it was argued inter alia that by invoking reservations from international law in areas of harmonised law, liability under the *Franovich* doctrine<sup>60</sup> might ensue.<sup>61</sup> While such fears are most probably unfounded,<sup>62</sup> it is true that it is highly commendable for national lawmakers and courts to thoroughly check the catalogue of rules governing the law applying to aliens, to make sure that domestic rules and practices do not fall short of the standards enunciated by the CJEU.<sup>63</sup>

Regarding the EU level, the question arises whether measures should be taken to change the current situation. As the CJEU emphasised in *RAAP*,<sup>64</sup> it is for the EU legislature to decide whether a reciprocity requirement should be introduced into Art. 8(2) of the Rental and Lending Directive, so as to ensure a level playing field between artists and producers who are resident or active in the EU on the one hand, and those in other countries making use of the reservation on the other. The issue is currently under consideration by the Commission, without any proposals having been tabled so far.<sup>65</sup>

For works of applied art as well, changing EU law so as to reflect the reciprocity requirement of Art. 2(7) Berne Convention would be a valid option. The obligation to grant national treatment does not pose an obstacle, as it applies only to the extent that the Berne Convention does not provide otherwise. The question is therefore one of legal policy: Does it make sense under economic or fairness-oriented aspects to reserve access to copyright protection to works originating from countries with equally generous regimes? For instance, would that create an incentive for other legal systems to relax their own requirements for protection? Would it help to create a level playing field in an area otherwise liable to produce asymmetric disadvantages for authors of works originating in the EU?

<sup>58</sup> For details, see Valk (2024), pp. 850, 854 *et seq.*

<sup>59</sup> Hugenoltz (2024b); Huckschlag (2025); Raue (2024), p. 1807 *et seq.*

<sup>60</sup> Case C-6/90 *Franovich and Bonifaci v. Italy* [1991] ECR I-05357.

<sup>61</sup> Huckschlag (2025); see also Raue (2024), pp. 1807, 1809.

<sup>62</sup> For details, see Huckschlag (2025).

<sup>63</sup> Raue (2024), pp. 1800, 1808.

<sup>64</sup> Case C-265/19 *RAAP v. PPI*, para. 84.

<sup>65</sup> Valk (2024), pp. 850, 856.

Both assumptions appear rather doubtful. After all, Art. 2(7) Berne Convention until now did not have a tangible effect on jurisdictions with rather strict regimes, such as the USA or Japan (to name just two countries), and it is very unlikely that this will change in the future. It is also not very plausible that reintroduction of the reciprocity clause would lead to trade policy advantages, or that it is needed to outbalance protection asymmetries between the relevant jurisdictions. On the contrary, only by renouncing reciprocity will creations originating from the US and the EU be put on an equal footing in both markets: American works receive just as little protection in their country of origin as European works, while both are subject to the same, rather generous standards in the EU. Thus, what is lost by the CJEU's ruling is only the option to "punish" non-EU works for the legal situation in their country of origin. Sure, this may offer business opportunities for operators ready to engage in the reproduction market, and it might ease the access of consumers to copies of expensive design icons. But that is a general issue rather than one to be pinned on territorial aspects. It is no gain for the European cultural landscape if creations by Ray and Charles Eames or other US-based designers are treated less favourably than those of European origin, simply because they are of "foreign origin".

## 5 Final Remarks

By the removal of Art. 110a(5) second sentence CDR and the CJEU's postulation that reciprocity clauses are only applicable in harmonised copyright law if they meet the standards of Art. 52(1) CFR, the prospect for non-EU product configurations to enjoy protection in the EU has clearly been improved. It is still too soon to evaluate whether tangible effects will result from the changes in practice. In any case, taking a positive attitude towards the developments appears more appropriate in an age of global communication and mutual inspiration than insisting on strict compartmentalisation along national or regional borderlines (even though the current *Zeitgeist* might suggest otherwise ...).

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