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An International Perspective on Design Protection of Visible Spare Parts



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An International Perspective on Design Protection of Visible Spare Parts

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Preface and Acknowledgements

A few words about the context and the genesis of this publication.

Policymakers have long struggled with the question whether design protection for spare parts of a complex product extends to the aftermarket (use of parts for repair purposes), or whether that market should remain open to competition. The decision primarily impacts the automotive industry and involves control over the lucrative and highly competitive market for automotive visible spare parts. From a legal perspective the question hinges on a provision of industrial design law, known as the repair clause. This clause is intended to exempt from design protection visible spare parts, to the extent they are used for repair purposes and in order to restore the original appearance of a complex product.

In the EU the debate whether a repair clause should be included into the Design Directive (98/71/EC), has been ongoing for years. Adoption of the clause in the Directive would result in a binding obligation on member states and has been so far prevented by some member states, including Germany. Positions on the issue are divided. Supporters include spare parts manufacturers, insurance and consumer organizations, whereas opponents are manufacturers of complex products, primarily the automotive industry.

Against this background, the Center for Transnational IP, Media and Technology Law and Policy of Bucerius Law School, Hamburg, Germany (Bucerius IP Center) held on 28 October 2015 a full-day Expert Roundtable Discussion on the above topic. The Roundtable assembled leading experts from academia, industry, policy and law for a discussion aimed at identifying approaches which might lead to possible compromise positions among the stakeholders in the debate.

The following experts participated in this Roundtable:

- Marianne Grabrucker (President of the Circle of European Trademark Judges; former Presiding Judge at the Federal Patent Court of Germany)
- Professor Dr. Philipp Fabbio (Università Mediterranea di Reggio Calabria, Italy)
- Professor Dr. h.c. Annette Kur (Max Planck Institute for Innovation and Competition, Munich)

- Professor Dr. Dana Beldiman (Academic Director of Bucerius IP Center)
- Dr. Jutta Figge (Federal German Ministry of Justice and Consumer Protection)
- Dr. Peter Stiefel (Markenrechtsschutz, Daimler AG)
- Robert Sterner (Leiter Marken- und Produktschutz, Audi AG)
- Dr. Ingo Gehring (IP Legal, Siemens AG)
- Dr. Gerhard Riehle, LL.M. (Former CEO, The European Campaign for the Freedom of the Automotive Parts and Repair Market, ECAR)
- Johannes Hübner (Automobilclub von Deutschland e.V., AvD) (*unable to attend; provided information in writing*)

The meeting was held at the Bucerius Law School in Hamburg and was moderated by Marianne Grabrucker, President of the Circle of European Trademark Judges and former Presiding Judge at the Federal Patent Court of Germany.

The present publication was inspired by the intellectually stimulating and spirited discussion among the Roundtable participants. However, the facts and opinions stated herein are solely those of the authors and do not necessarily reflect the opinions of any of the Roundtable participants. The publication is also not to be understood as the outcome of the meeting or as a common understanding reached among the participants to the meeting. In fact, because of the multilayered nature of the issues that prompted further research and because of legal developments which occurred in the interim, this publication ended up covering many more and different points than the Roundtable. The authors have sought to consider the issues from multiple different vantage points and to provide a balanced, impartial view of IP-related issues surrounding the spare parts debate.

Our thanks go to the participants in the Roundtable Discussion for having pointed to this fascinating area of the law and for their contributions to the Roundtable discussion. In particular, we appreciate the efforts of Marianne Grabrucker, who has inspired the project and was able to lead the debate with extraordinary thoughtfulness and skill, thus ensuring the meeting's constructive and creative atmosphere. Ms. Grabrucker also provided important support in the preparation of the Roundtable and development of the main discussion points. Further, our thanks go to the ZEIT-Stiftung Ebelin und Gerd Bucerius for its generous financial support. Finally, we express our appreciation to Karsten Windler, the Executive Director of the Bucerius IP Center, and Vera Kortfunke, student assistant, for their organizational support, as well as the management of Bucerius Law School, represented by Meinhard Weizman, CEO, Dr. Hariolf Wenzler, former CEO, and by Benedikt Landgrebe, deputy CEO of Bucerius Law School for the ongoing support and encouragement for the activities of the IP Center. Moreover, we thank Prof. Fabiano Teodoro de Rezende Lara, Universidade Federal de Minas Gerais, Brazil, for his contribution to the section on the legal situation in Brazil.

Finally, we would like to thank the following for valuable comments to the draft: Alberto Camusso, Marianne Grabrucker, Prof. Dr. Philipp Fabbio, Dr. Peter Stiefel and Dr. Gerhard Riehle, LL.M.

We hope the material in this book will contribute to further scholarly legal debate on the topic.

Hamburg, Germany
November 2016

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Constantin Blanke-Roeser

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Abbreviations

ABPA	Automotive Body Parts Association
AIPLA	American Intellectual Property Law Association
ANFAPE	Associação Nacional dos Fabricantes de Autopeças
APAA	The Asian Patent Attorneys Association
Art(s).	Article(s)
Berkeley Technology L J	Berkeley Technology Law Journal
BGH	Bundesgerichtshof
BR-Drucks.	Bundesrat-Drucksache
BT-Drucks.	Bundestag-Drucksache
CADE	Conselho Administrativo de Defesa Econômica
CAPA	Certified Automobile Parts Association
Cardozo Arts & Entertainment L J	Cardozo Arts & Entertainment Law Journal
CEAHR	European confederation for watch repairer associations
cf.	Conferre (compare)
DePaul J Art, Tech & Intell Prop L	The DePaul Journal of Art, Technology & Intellectual Property Law
e.g.	Exempli gratia (for example)
ECTA	European Communities Trademark Association
ECWVTA	European Community Whole Vehicle Type Approval
ed(s)	Editor(s)
edn.	Edition
et al.	Et alii (and others)
et seq.	Et sequentes (and the following)
etc.	Et cetera (and so forth)
EWS	Europäisches Wirtschafts- und Steuerrecht

FIGIEFA	International Federation of Automotive Aftermarket Distributors
FS	Festschrift
GDP	Gross domestic product
George Mason L R	George Mason Law Review
Gonzaga L Rev	Gonzaga Law Review
GRUR	Gewerblicher Rechtsschutz und Urheberrecht
GRUR Ausl	Gewerblicher Rechtsschutz und Urheberrecht, Auslands- und internationaler Teil (1952-1966, ab 1967 GRUR Int)
GRUR-Beil	Gewerblicher Rechtsschutz und Urheberrecht – Beilage
GRUR-Int	Gewerblicher Rechtsschutz und Urheberrecht Internationaler Teil
GRUR-Prax.	Gewerblicher Rechtsschutz und Urheberrecht Praktischer Teil
GRUR-RS	Gewerblicher Rechtsschutz und Urheberrecht
Harvard J L & Tech	Harvard Journal of Law & Technology
Hastings L J	Hastings Law Journal
i.e.	Id est (that is)
IAM	Independent Aftermarket
IIC	International Review of Intellectual Property and Competition Law
Int J of Production	International Journal of Production
ISRN	International Scholarly Research Network
ISRN Mechanical Engineering	International Scholarly Research Notes Mechanical Engineering
J Manuf Sci Eng	Journal of Manufacturing Science and Engineering
J Pat & Trademark Off Soc’y	Journal of the Patent and Trademark Office Society
JICE	Journal of International Commerce and Economics
JIPITEC	Journal of Intellectual Property, Information Technology and E-Commerce Law
K&R	Kommunikation & Recht
Ky. L J	Kentucky Law Journal
Ltd.	Limited
Ltda.	Limitada
MarkenR	Markenrecht
Maryland L R	Maryland Law Review
Mitt	Mitteilungen der deutschen Patentanwälte
MMR	MultiMedia und Recht
NAIC	National Association of Insurance Commissioners