Working Guidelines

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Q231

The interplay between design and copyright protection for industrial products

Introduction

1) The appearance of industrial products may be protected by an industrial design right or a design patent (collectively referred to as "design right"). This corresponds to Article 5quinquies of the Paris Convention stating that "industrial designs shall be protected in all the countries of the Union." Further, Article 25 of TRIPS requests that "members shall provide for the protection of independently created industrial designs that are new or original."

2) On the other hand, the appearance of industrial products may also be protected under copyright laws. Article 2 (1) of the Revised Berne Convention ("RBC") provides that "literary and artistic works" shall include "works of applied art" and Article 2 (7) RBC further specifies that " subject to the provisions of Article 7(4) of this Convention, it shall be a matter for legislation in the countries of the Union to determine the extent of the application of their laws to works of applied art and industrial designs and models, as well as the conditions under which such works, designs and models shall be protected. 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". Article 7(4) RBC requires that the term of protection of works of applied art shall last at least until the end of a period of twenty-five years from the making of such a work.

3) Given that both the laws of design rights and copyright may be relevant to the same industrial products, there can be considerable overlap between the protection provided by design rights and the protection provided by copyright laws.

4) The purpose of this question is to examine how industrial products are protected by design rights and/or copyrights, to explore the degree of overlap of protection provided by them and to encourage proposals for adopting uniform rules in this respect.

5) The term "industrial products" as used in the title of this question is intended in a broad sense. While examining this question as to all types of "products" would be overly broad, inclusion of the term "industrial" is not intended to narrow the question so far as to limit the types of products only to products for industrial use. Rather, "industrial products" shall be considered to include all types of products for which protection is available based on appearance, shape, or ornamentation, including, for example, handicraft products and works of applied art, i.e. artistic products for a practical use.

6) This question focuses on the interplay between design and copyright protection for industrial products. While the Groups will necessarily have to provide some background of their respective design and copyright laws, this question does not intend to study in detail the requirements and the scope of protection under national and international design and copyright law. Rather, it seeks to highlight some areas of overlap between these laws with regard to the protection of industrial products. Other laws such as patent, trademark and unfair competition laws may be equally relevant to industrial products. However, these laws are also beyond the scope of this question.

Previous work of AIPPI

7) AIPPI has studied the relationship between the law on the protection of industrial designs and models and copyright law in previous questions.

8) In the 1960s in the context of WIPO's plans to revise the Arrangement of The Hague, Special Committee Q34 undertook a detailed study on the unification of the law on industrial designs and models. In this study AIPPI proposed basic features of legislation for the protection of industrial designs and models which it wished to see appear in the different national laws. Respective Resolutions were adopted in 1960 (Congress of London), in 1964 (Executive Committee of Salzburg) and in 1966 (Congress of Tokyo). With regard to the nature of protection, AIPPI resolved that industrial designs and models must be protected by a system of their own which can co-exist with the copyright protection system in accordance with domestic laws.

9) In the 1980s AIPPI reaffirmed the economic importance of the protection of designs and models and entrusted Special Committee Q73 with the study of the "Legal and economic significance of design protection". In 1985 the Executive Committee of Rio de Janeiro resolved as follows: "AIPPI, being aware of the advantages and the inconvenience that can be caused by the double protection of designs and models by copyright law and by the specific law, considers it desirable that the countries which recognize double protection without imposing on the copyright protection a requirement of a certain individual quality, should arrange this protection in the following way: (1) The legislation for copyright protection should provide a special system for industrial designs and models, defined as industrial articles considered in a broad sense, that is to say including in particular objects of artistic craftsmanship; (2) The protection of copyright law should be given to these works for a reduced period, which could be fixed at 25 years; (3) The protection based on the specific design law should be arranged in such a way that the duration does not exceed the protection given by copyright law; and (4) The transfer of copyright should automatically include the transfer of rights arising under the specific law and vice versa. Similarly, the grant of a licence of the copyright should automatically include a grant of a licence of the rights arising under the specific law, and vice versa. These two statements do not affect the 'droit moral'".

Discussion

Differences between the Design Protection and Copyright Protection

10) There are differences between design protection and copyright protection as regards the following aspects:

11) Formalities: no formalities must be completed under Article 5(2) RBC, while registration is typically necessary for design right protection in most jurisdictions.

12) Requirements: originality is typically required for obtaining copyright protection, while novelty or originality is required for obtaining design protection. Under Article 25, Paragraph 1 TRIPS, members may stipulate that designs are not new or original if they do not significantly differ from known designs or combinations of known design features. Members may stipulate that such protection shall not extend to designs dictated essentially by technical or functional considerations.

13) Term of protection: the term of protection is at least 10 years for design protection under Article 26(3) TRIPS, while it is at least 25 years under Article 7(4) RBC for copyright protection.

14) Infringement: industrial products that were independently created without access to another party's previous work (or product) can infringe a design right, but not a copyright.

15) The above differences may cause inconveniences to creators or industry people.

Approaches currently taken by countries/regions

16) Overall, design protection has been harmonised to some extent across the world, but the approaches to protect industrial products under copyright law vary from jurisdiction to jurisdiction.

17) One approach is to protect industrial products/works under copyright law in the same manner as other works such as fine arts. For example, in France, designs and works are protected cumulatively under the theory of unity of art, under which the requirements for protecting both kinds of works are the same.

18) Another approach is to require higher standards for copyright protection in case of artistic products for practical use than in the case of other works. For example, German case law in the last decades followed the so-called "Stufentheorie": In order for an artistic work to be protected under copyright law, the skill of an author of a work for an industrial use must be considerably above the skill of average designers at the time of creation. If the author has this very high level of skill, his/her work will enjoy both copyright and design protection. In a very recent decision, however, the German Federal Supreme Court left open whether it still followed this approach.

19) In the US, the design of a useful article is considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article. Thus, industrial products may also enjoy copyright protection if these separability and independence requirements are met.

20) In the UK, mass-production, defined as being the manufacturing of more than 50 articles, of certain types of artistic work by an industrial process and subsequent marketing of these articles has the effect of limiting the effective term of copyright protection to 25 years from the first marketing.

21) Australia has legislative provisions that deal with situations of overlap between design and copyright law. These provisions ensure that designs produced on an industrial scale do not attract dual protection under both copyright and design law. Copyright protection is generally preferred over design law as the granted monopoly is for a much greater period of time. If a design has not been registered but has been "applied industrially" and the industrial product has been commercially exploited, then the industrial product does not

attract protection under copyright law. A design has been industrially applied if the design has been applied to more than 50 articles, or to one or more articles if the non-handmade product is produced in lengths or pieces. There is also, however, some scope for the court to decide whether a product has been industrially applied on a case-by-case basis (even if the threshold of more than 50 articles has not been met).

22) Under Swedish law, there is nothing against a product being protected under both design law and copyright law. A rights holder can in the same infringement proceedings rely on dual protection under design and copyright law. Courts decide on each of the invoked IPRs under the respective regimes. Copyright protection is not limited to hand made products but can also be awarded to industrially produced products as long as the general requirements to obtain protection are met.

Issues

23) In view of the above, a number of issues arise. If the requirements for copyright protection for industrial products are different from the requirements for copyright protection for ordinary artistic products (or fine arts), the question arises whether one can justify having stricter requirements for copyright protection for industrial products only because the works in question are created for practical use. The same product might be or might not be protected under copyright law, depending on whether it was created for industrial use or not.

24) On the other hand, one may argue that since it is more difficult to create industrial products than fine arts due to practical requirements arising from a use or function of such industrial products which restrict the room for creation, (1) the level of creativity necessary for the copyright protection of industrial products should be higher than that for fine arts and/or (2) the scope of the copyright protection for industrial products should be narrower than that for fine arts; otherwise, competitors might have very limited choices for new designs for industrial products.

25) In addition, if the requirements for copyright protection for industrial products are the same as the requirements for copyright protection for ordinary artistic products (or fine arts), the raison d'être for the industrial design system might be lost or an industrial designer's incentive to file an application for design protection would be diminished because copyright protection might be sufficient for protecting the appearance of industrial products.

26) If there is cumulative protection by copyright law and design law for a certain industrial product, even after the term for design protection expires, the appearance of such product will not enter into the public domain due to longer copyright protection. One may argue that this is a problem because design protection is provided for a certain term in exchange for the design entering the public domain after the term expires. Therefore the question arises whether adjusting measures should be taken.

27) Another way of viewing this is that the cumulative protection by industrial design rights and that by copyright should be allowed because the requirements and effects thereof are different. Moreover, it may not be proper to deny copyright protection for industrial products only because they can be protected by industrial design rights.

Questions

I. Analysis of current law and case law

The Groups are invited to answer the following questions under their national laws:

Cumulative Protection

1) Can the same industrial product be protected by both a design right and a copyright? In other words, is the cumulative protection of the same industrial product by copyright and design law allowed in your country?

Article 2(7) RBC

2) In your country, has copyright protection for applied art ever been refused for a work with a foreign country of origin pursuant Article 2 (7) RBC?

Registration/Examination

3) In order to enjoy design right protection for industrial products, is registration of a design necessary? In order for the design to be registered, is a substantial examination necessary?

Requirements

4) What are the requirements to obtain industrial design protection or copyright protection, respectively, for industrial products in each country? What are the differences between these requirements?

5) Are the requirements for copyright protection for industrial products different from the requirements for copyright protection for other ordinary artistic products (fine arts)?

Scope of Protection and Assessment of Infringement

6) Is the scope of the copyright protection for industrial products different than that for other ordinary artistic products (fine arts)? If so, in what ways?

7) Are the criteria for assessing infringement of copyright protected industrial products different from the criteria for assessing infringement of a design right?

8) Is it a relevant defence under copyright or design law that the industrial product was created independently of the older work or design?

Duration of Protection

9) How long is the duration of industrial design protection or copyright protection for industrial products, respectively?

10) What happens upon expiration of the IP right having the shorter term? In other words, after the term for industrial design protection expires, does the copyright protection continue?

Measures for adjustment

11) In your country, is there any measure for adjustment so that the same industrial product may not be protected, by both a design right and a copyright or, by a copyright after the design right expires?

II. Proposal for Harmonisation

The Groups are invited to put forward proposals for the adoption of harmonised rules in relation to the protection of the appearance, shape, or ornamentation of industrial products. More specifically, the Groups are invited to answer the following questions:
What should be the requirements for obtaining copyright protection for industrial products?

12) For industrial products, should there be any cumulative protection by industrial design rights and copyright?

13) If so, should there be any measures to resolve this overlap? What measures should be taken? For example, once a certain artistic work has enjoyed industrial design protection, should copyright protection be denied for the same work?

14) National Groups are invited to comment on any additional issue concerning the relationship between design and copyright protection for industrial products that they deem relevant.

NOTE:
It will be helpful and appreciated if the following points could be taken into consideration when editing the Group Report:

- kindly follow the order of the questions and use the questions and numbers for each answer
- if possible type your answers in a different colour
- please send in a word document
- in case images need to be included high resolution (not less than 300 dpi) is required for good quality printing