

## Introduction

---

*Estelle Derclaye*

The world (hi)story of the protection of designs<sup>1</sup> has been extremely diverse. It is so because of the special, hybrid, nature of such works: they often combine utility and beauty so that it involves deciding whether to protect the work only by design law or only by copyright law, or by both. For over a century, legal systems, not only at national but also at regional and international level, have struggled to find the most adequate solution: a single protection may be under- or overprotective and two or more can be overprotective. The relationship or interface between copyright and design law at regional and international level crystallised over the years because of the entrenched and opposite positions (from minimal protection to maximal protection) the different countries have carried on taking on the issue. Indeed, countries and periods when protection for designs changed can be grouped in five different categories according to the type of interface chosen: single protection by copyright law (i.e. no design law exists), demarcation (i.e. no cumulation between copyright and design law), partial cumulation, full cumulation and total cumulation.<sup>2</sup> Furthermore, the countries and periods with some cumulation can be subdivided between those with rules and those without rules regulating the interface. In addition, the criteria to regulate the interface (in the main protection requirements, term of protection, authorship and ownership, infringement) vary considerably among the cumulation countries along with the type of right (anti-copying right or monopoly right). What's more, the UK is even more special as it is the only country in the world to have a national unregistered design right along with very detailed rules regulating the registered and unregistered design/copyright interface.

Since the Design Directive was adopted in 1998, design applications from all over the world have soared especially in Europe, the United States,

<sup>1</sup> I use the 'neutral' term designs on purpose to include both works of applied art and industrial designs. These terms are often used to demarcate the boundary between art (the domain of copyright law) and industry (the domain of design law).

<sup>2</sup> For a definition of these terms, see below.

Australia and Asia.<sup>3</sup> EU and national case law on designs has increased as well. Therefore, design law is no longer the ‘Cinderella’ of intellectual property law it once was.<sup>4</sup> Nevertheless, the interface between copyright and design is still in disarray. Looking at the EU alone, the Design Directive legislated very minimally on the interface as the EU legislature only required the Member States to cumulate copyright and design laws without specifying rules to regulate the overlap (art. 17 Design Directive, art. 96 Design Regulation and art. 9 Infosoc Directive). Subsequently, Member States have in the main kept to their traditions, which means that some have full cumulation and others partial cumulation between the two bodies of law, with very different rules organising the interface or no rules at all. The recent CJEU *Flos* judgment,<sup>5</sup> which seemingly imposes the author’s own intellectual creation level of originality for unregistered designs but leaves the level of originality for registered designs to Member States, has created even more uncertainty. Post *Flos*, some national courts still apply a higher level of originality for unregistered designs (e.g. Germany, the UK and Italy). The *Flos* decision also triggered the repeal of section 52 of the UK Copyright Act, which organised the overlap between registered designs and copyright.<sup>6</sup> The CJEU *Donner* decision also illustrates well the problems caused by the lack of harmonisation relating to designs (furniture whose protection expired in Italy parallel-imported in Germany where protection was still in force).<sup>7</sup> Therefore, the current state of affairs is paradoxical – design protection is gaining momentum but it is far from harmonious. Rules to regulate the overlap between copyright and design law are badly needed, at the very least at EU level. To find the most appropriate rules, it is essential to review how Member States’ and other relevant countries’ laws have organised the interface in the past and how successfully (or not) they have dealt with it. It is only by comparing national experience through history that an adequate solution can be found.

The book has the triple aim of:

- 1 tracing the history of the design/copyright interface or in other words of the protection of designs, of several countries, selected for their rules regulating the interface, for their absence of rules or for their choice to protect designs only by one body of law,

<sup>3</sup> See WIPO statistics at <http://ipstats.wipo.int/ipstatv2/>.

<sup>4</sup> C.-H. Massa and A. Strowel, ‘Community Design: Cinderella Revamped’ (2003) *European Intellectual Property Review* 68–78.

<sup>5</sup> Case C-168/09, *Flos SpA v. Semeraro Casa & Famiglia SpA* [2011] ECDR 161.

<sup>6</sup> For sharp criticism of *Flos* and the decision to repeal s. 52, see L. Bently, ‘The Return of Industrial Copyright?’ (2012) *EIPR* 654.

<sup>7</sup> Case C-5/11, *Re: Donner* [2012] ECDR 349.

- 2 examining how these countries have coped with the problems engendered by the rules they applied over the years and the reasons for legislative changes,
- 3 in order to find the most appropriate rules that can be used to regulate the interface at EU level, and even at global level.

I recognise that it is ambitious to aim to find such rules as it may not be possible. But if these rules cannot be found, at least, the book will have summarised the advantages and disadvantages of each system, allowing for a better understanding of the interface. That said, in the final chapter, I propose what I think are achievable and workable rules to regulate the copyright/design interface. I chose only fifteen countries, namely, the USA, the UK, France, Germany, Italy, Greece, the three countries that form the Benelux, Sweden, Norway, Finland, Denmark, Australia and Japan, because they are among the most striking in terms of the copyright/design interface. It is not necessary for the number of countries to be bigger let alone exhaustive to achieve the desired result. In addition, there must be sufficient differences between countries and ample case law to make the comparison worthwhile and interesting. Thus, for instance, Malaysia and Singapore have followed the UK law closely (with only very small differences) and have relatively little relevant case law. Thus taking only the UK is sufficient as it has a wealth of case law and is the prime example as former colonies modelled their law on UK law. On the other hand, Australia has departed from the UK relatively early and more drastically and has an abundant case law. There is no EU chapter. This is deliberate. Legislatively speaking, there is nothing to say as the interface was left unharmonised. On the judicial front, we only have the *Flos* decision but the judgment is obscure and by definition partial as constrained by the questions posed to the CJEU. Some commentators address it in their chapters and, otherwise, much commentary has already been written on the issue.<sup>8</sup>

The chapters only review substantive law, leaving procedural law (in the main, design registration and remedies) aside. This is not to say that no differences exist there but I had to work with a set word limit and the line had to be drawn somewhere. Protection of designs by unfair competition laws is also not discussed. It could have been reviewed but it is not

<sup>8</sup> E. Ventose, 'ECJ Rules on Legislative Limitations on Copyright Protection for Designs in Europe' (2011) *JIPLP* 367; L. Bently, 'The Return of Industrial Copyright?'; A. Tischner, 'Focus on the Polish Regulation of Copyright and Design Overlap after the Judgment of the Court of Justice in Case 168/09 (*Flos v Semeraro*)' (2012) *IIC* 202; B. Lauriat, 'Copyright for Art's Sake?' (2014) *EIPR* 275; P. Masiyakurima, 'Copyright in Works of Artistic Craftsmanship: An Analysis' (2016) *OJLS* 505–4; and literature cited at [https://curia.europa.eu/jcms/jcms/Jo2\\_7083/en/](https://curia.europa.eu/jcms/jcms/Jo2_7083/en/).

necessary in order to find the best rules to organise the interface. As I have already explained in previous writings,<sup>9</sup> it is sufficient to say in this respect that the overlap between slavish imitation and any intellectual property right cannot be sustained when a specific right has been introduced simply because the intellectual property right replaces the unfair competition action for slavish imitation in this case and that there is no problem to cumulate the unfair competition action involving a risk of confusion with an infringement of copyright or design rights as the two causes for the actions (copying as opposed to causing confusion) are different.

That said, some chapters do discuss unfair competition law. This is inevitable as contributors map the history of the interface and some countries used unfair competition law instead of or in addition to copyright law before design protection existed (e.g. the Netherlands and Greece). While it would be interesting and totally comprehensive to examine the interface with trademark law, like with unfair competition law, there was no space. Furthermore, in contrast with the copyright/design interface, it is regulated at EU level, even if not fully, and is also addressed in detail elsewhere.<sup>10</sup>

The chapters follow the same structure, except the final chapter, which analyses all the chapters and compares countries' experiences in an attempt to find the most adequate rules to regulate the interface at international level. There is one chapter for all three Benelux countries, focusing on Dutch law and the Uniform Benelux Law on Designs and Models, one on all four chosen Nordic countries and two on US law, one focusing on copyright, the other on design patents. The chapters start with a table detailing the periods that the country has had in relation to the way it has dealt with the interface. A country could have started with full cumulation, then amended its law to adopt a partial cumulation system, etc. The table lists the different acts the country has enacted in the field of protection of designs during these periods. The table also adds if courts have followed or deviated from the legislature's mandate (e.g. an Act could have mandated demarcation but the courts applied cumulation). For each period, the tables list the total and average numbers of designs filed and registered. This data is analysed in the last chapter and shows that, in some cases, there is a link between the legal system chosen to

<sup>9</sup> E. Derclaye and M. Leistner, *Intellectual Property Overlaps: A European Perspective* (Oxford: Hart, 2011); E. Derclaye, *The Legal Protection of Databases: A Comparative Analysis* (Cheltenham: Edward Elgar, 2008).

<sup>10</sup> See E. Derclaye and M. Leistner, *Intellectual Property Overlaps: A European Perspective*; N. Wilkof and S. Basheer (eds.), *Overlapping Intellectual Property Rights* (Oxford: Oxford University Press, 2012); R. Tomkovicz, *Intellectual Property Overlaps, Theory, Strategies and Solutions* (Abingdon: Routledge, 2012); M. Senftleben, *The Copyright/Trademark Interface* (Alphen aan den Rijn: Kluwer Law International, forthcoming, 2017).

regulate the copyright/design interface and the high or low number of applications. Graphs drawn from WIPO and national IP offices data can be found in the last chapter's annex.

Each chapter then maps the history of the interface for the country or countries in question, in short the evolution of the statutory and case law on the protection of designs and the problems encountered over the years. Many chapters dealing with EU Member States stop with the implementation of the Design Directive as even if their design law was amended to comply with it, their law on the interface did not change. The chapters analyse the success or failure, advantages and disadvantages of the various mechanisms used in their countries to organise the interface over the several periods and explain why the legislatures and/or courts changed the rules over the years. Some then venture to conclude by giving their opinion as to what the best rules regulating the interface could be.

All chapters follow the same terminology regarding the different systems elaborated to deal with the interface. The terms used are: demarcation, partial cumulation, full cumulation and total cumulation. While such terminology is very rarely used by legislatures<sup>11</sup> or courts, many commentators used similar terminology over the years and in different countries, albeit not always consistently.<sup>12</sup> Accordingly, we define the several terms as follows:

*Total cumulation:* if the requirements of one law are fulfilled, there is automatic protection under the other law and this is whether or not the requirements of that other law are fulfilled. In other words, there is assimilation of the protection requirements of one law with that of the other. Among the countries reviewed in this book, this was the case only in France between 1902 and the implementation of the Design Directive.

<sup>11</sup> The European Commission's Green Paper on the legal protection of industrial design uses some of this terminology when it explains the different Member States' systems dealing with the interface.

<sup>12</sup> Some commentators use the term 'cumulation' to describe total cumulation, e.g. S. Ricketson and J. Ginsburg, *International Copyright and Neighbouring Rights: The Berne Convention and Beyond*, 2nd edn (Oxford: Oxford University Press, 2006), 468; W. Duchemin, 'La protection des arts appliqués dans la perspective d'un dépôt communautaire en matière de dessins et modèles industriels' (1978) 97 RIDA 4, 65. Some have used 'non-cumulation' or 'no cumulation' to describe the situation we call demarcation, among them S. Ricketson and U. Suthersanen, 'The Design/Copyright Overlap: Is There a Resolution?' in N. Wilkof and S. Basheer (eds.), *Overlapping Intellectual Property Rights* (Oxford: Oxford University Press, 2012) 159; J. Reichman, 'Design Protection After the Copyright Act of 1976: A Comparative View of the Emerging Interim Models' (1983) 31 *J. Copyright Soc'y* 267 and 'Design Protection in Domestic and Foreign Copyright Law: From the Berne Revision of 1948 to the Copyright Act of 1976' (1983) *Duke Law Journal* 1143 at 1169; Reichman (1983) *Duke Law Journal* 1143 at 1158 also uses the term 'absolute' to talk about what we call total cumulation.

*Full cumulation:* both copyright and design right can subsist if the protection requirements are fulfilled and the two laws apply in tandem whether it raises regime clashes and/or overprotection, or not. In other words, there are no mechanisms in the legislation to deal with these problems.

*Partial cumulation:* both copyright and design right can subsist if the protection requirements are fulfilled but either or both laws (i.e. the Copyright Act or Design Act) has or have one or more mechanisms to regulate the interface. For instance, if copyright and unregistered design right both subsist and are infringed, the UK Copyright Act states that only copyright infringement subsists (s. 236). Another example is alignment of rules to avoid regime clashes, e.g. same authors and owners in both copyright and design laws.

*Demarcation:* if something is protected or protectable by design law then it cannot be protected by copyright or by unregistered design right or vice versa.

Finally, the chapters in the book are ordered by type of system, starting with total cumulation systems and finishing with demarcation systems. Note, however, that most countries have changed systems over the years and thus the countries' place in the book reflects the longest period in which they have retained the respective system.