Question Q231

National Group: Spain

Title: The interplay between design and copyright protection for Industrial products

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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?

Yes. In our country the shape and appearance of a product can be protected cumulatively by the rights conferred under both design law and copyright law, provided that it meets the necessary conditions in order to be respectively protected by the different laws.

In this respect, it must be taken into account that the design right protects the value added by the design to the product from the commercial point of view, regardless of its aesthetic or artistic level and of its originality. Nevertheless, this does not prevent that an original or particularly creative design may also be protected by copyright law, since both forms of protection are independent, cumulative and compatible. It is thus
provided by the following legal provisions: Article 3(2) of Royal Legislative Decree No 1/1996 of 12 April 1996 adopting the revised text of the Intellectual Property Law (Spanish Copyright Act); Tenth Additional Provision of Law No 20/2003 of 7 July 2003 on the Legal Protection of Industrial Design (LDI); and Whereas 32 of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (RDC).

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?

As far as we are aware, no Spanish court has ever ruled on this issue. In any event, in light of the judgment of the Court of Justice of the European Union of 30 June 2005 in case C-28/04 Tod's Spa and others against Heyraud S.A., we believe that it would be necessary to distinguish between two different situations: a) disputes arising in relation to works of applied art originating in another EU Member State; and b) disputes arising in relation to works of applied art originating in a non-EU State.

In the first case, i.e. situation a), Article 2(7) RBC could not be used in Spain as a ground for rejecting the protection of copyright since this would go against the principle of non-discrimination on grounds of nationality enshrined in Article 12 of the Treaty establishing the European Community (Article 18 of the current Treaty on the Functioning of the European Union).

To the contrary, in the second case, i.e. situation b), there would be nothing to prevent Article 2(7) RBC from being applied in Spain*.

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?

In Spain a design can be protected either by the rights granted by the Community legislation, or by the rights granted by the national legislation. On this regard, it must be taken into account that both rights are not mutually exclusive, as it is stated in the Whereas 31 of RDC.

According to the Spanish legislation a design must be registered to be protected. A registered design confers on its holder the exclusive right to use it and to prevent any third party not having his consent from using a design which does not produce on the informed user a different overall impression. The protection will be for a maximum period of twenty-five years.

Notwithstanding it, the unregistered design is specifically protected by the Community legislation, as it is stated in RDC. The scope of protection of the unregistered design is smaller than the scope of protection of the registered Community design: it is only protected for a period of three years as from the date on which the design was first made available to the public within the European Community and constitutes a right only to prevent copying.

The registration system is not based upon substantive examination as to compliance with requirements for protection prior to registration. The register just proceeds to a
formal examination as to compliance with formal conditions and other minimums, as checking that it actually is a design from a legal point of view and that it is not contrary to public policy or to accepted principles of morality. The register does not check if the design fulfills the requirements as to novelty and individual character, nor looks up if there are any prior rights whose object of protection coincides.

With the publication of the design, once the registration has been granted, it is opened a period to raise oppositions against the registration. The oppositions may be based on the grounds of lack of novelty, lack of individual character, or the existence of a prior right, such as a trademark or a work protected by copyright.

Requirements

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

In order for a product, be it industrial or otherwise, to obtain industrial design protection, it must fulfill the requirements of novelty and individual character (Article 5 of the Spanish Industrial Design Act). In order for a product, be it industrial or otherwise, to obtain copyright protection, it must be an original creation (Articles 5 and 10 of the Spanish Copyright Act).

The differences essentially lie in the fact that designs must have individual character, whilst in the case of intellectual creations, the only requirement is objective novelty.

*Individual character* means that the design for which protection is sought must produce a different overall impression on the informed user from other designs made accessible to the public prior to the filing date or priority date. Account must be taken of the degree of freedom of the designer in developing the design (Article 7 of the Spanish Industrial Design Act).

The *originality* stipulated in the Spanish Copyright Act is nevertheless not defined. The most authoritative legal opinion and Spanish case law describe it as a kind of objective novelty. In that sense, the Spanish Supreme Court holds as follows in its judgment of 24 June 2004: "*originality consists of having created something new, something which did not exist before; in other words, a creation which brings with it and constitutes objective novelty compared to any other preexisting creation: a novel creation is original, and that objective novelty is what determines its recognition as a work and the copyright protection conferred on its creator*".

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

No. The Spanish Copyright Act does not differentiate among products due to their nature, be they industrial or otherwise. Protection is afforded to works that are original in the sense laid down in the provisions of the law.

Scope of Protection and Assessment of Infringement
6) Is there a different scope of protection through the intellectual property for products with industrial application than for works of art (Fine Arts)? In case of affirmative answer: In what sense?

In general, the scope of protection for copyright is not different for the works of art than for any other artistic works protected by a copyright; however, there is an exception stated in Section 5, Article 19 of the Copyright Act which excludes, within the distribution right, the rent and loan rights of the scope of protection of the applied works of art.

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

Different criteria

In general, it can be assumed that there are different criteria for assessing infringement of copyright protected industrial products and for assessing infringement of a design right. The formalities and the requirements for obtaining copyright protection differ from these required for obtaining design protection. Thus the scope of protection is certainly divergent.

National and Community design: registered and unregistered

As for the protection conferred by the design right -hence its infringement-, it is understood that the one referring to the registered design is completely different to the one referring to the unregistered design, regardless if it is strictly National or EC (Community).

A registered design is an exclusive right that covers the outward appearance of a product or part of it. The protection of the registered design embraces every design -in a legal sense- new and with an “Individual Character”. New, while it must not be identical, that is to say, not differing but in insignificant details of the ones compared previously (article 6 LDI and 5 RDC). With individual character, this means that it does not produce, to the informed user, an impression of a different whole and in its determination; the degree of freedom of the developer author of the design, will be taken into account (article 47 LDI and 10.1 RDC). The regulations do not define what an informed user is, entrusting its interpretation to the courts and the procedural practice in charge of materializing it, depending on the related sector.

Regarding the degree of difference towards other designs as a different overall impression, the first proposal of the EU directive mentioned that these differences should be outstanding. This requirement was suppressed. It finally remains in the 13 Whereas of the Directive 98/71/CE and the article 14 of the RDC the following terms: the assessment as to whether a design has individual character should be based on whether the overall impression produced on an informed user viewing the design “clearly” differs from that produced on him by the existing design corpus, taking into consideration the nature of the product to which the design is applied or in which it is incorporated, and in particular the industrial sector to which it belongs and the degree of freedom of the designer in developing the design.

It must be remembered that the relation of the products in which the design is going to be incorporated or applied, must appear in the registry application as an obligatory mention (article 36.2 RDC). This administrative requirement it does not affect the scope of protection (article 26.6 RDC), what means that the exclusive right is absolute in the
sense that the right conferred applies to any sort of product even though the registration contains an indication of the type of article for which it is intended. It is also an absolute right because it grants the holder of the right the exclusive use of it and the prohibition of third parties use without consent. Registered designs are protected even against the independent development of similar designs (article 45 LDI and 19.1 RDC), and the relevant date for judging the comparison of the design is the application date. If the unionist or exposition priorities have been claimed, the relevant date is this priority date (articles 6.1 and 7.1 LD; 5. b) and 6.b RDC).

It must also be recalled, that in case of conflict of a design with a previous copyright, the validity of the design supposing an unauthorised work protected by copyright may be contested [article 25.1.f) RDC y 13.g LDI, corresponding to 11.2.b) DDM]. Regarding this ground for invalidity, the proof of the previous right relies in whom appeals for it, thus the need of proving the creation of which arises the birth of the copyright (article 1 LPI) expressed by any media, no matter if it has been published or not. Furthermore, the work has to be protected in a Member State, in order to enjoy the automatic international protection conferred by the Bern agreement.

A valuable proof is the inscription in the Intellectual Property Register, which is not compulsory for the birth of the copyright. Since the RDC, the LPI or the DDM do not refer to the previous right but to the “unauthorised use”, if the holder of the design can prove the independent creation, the holder of the previous work could not oppose his right which is only protected against copies.

An unregistered Community design, thus protected in Spain, confers on its holder a right to prevent copying. Unlike a registered Community design, it is not required to file an application to protect an unregistered design. The relevant date for judging the novelty and the individual character is the day on which the design or model has first been made available to the public (articles 5.a and 6.a RDC). Protection could not therefore extend to design products which are the result of a design arrived at independently by a second designer (art. 19.2 RDC). The burden of proof of being an independent creation and not a copy will be assumed by the claimer.

Copyright

Under the Spanish Law, the protection of the design by copyright, as an original creation of its author, belongs to the fine arts category (“obras plásticas”, article 10.e LPI). What it is protected is the original intellectual creation of the work, and the author is under its protection. In case of infringement, courts shall decide if the work meets the originality requirement. Regarding the nature of its originality, the work shall be protected by copyright law and, on the other hand, the existence of plagiarism shall be determined as well.

Conclusion

Where the infringement of the registered design has to be determined by the individual character, in the above mentioned terms, the copyright infringement has to be determined in the appraisal of originality at the moment of the creation, since no register conditions are required for the birth of the right. The protection of the registered design will be stronger than that resulting from copyright. This is due to the protection even towards an independent creator. What it is protected by the registered design right is not the creation in the sense of “origin”, fundamental in copyright, but the formal innovation, which creates a different overall impression to the informed users, which contributes to new added value to the product from a commercial perspective. Such an
easy obtaining of the copyrights -through the mere creation- contrasts to the probative benefit of having the registered design.

An unregistered Community design confers on its holder a right to prevent copying and the relevant date is the day on which the design or model has first been made available to the public (articles 5.a and 6.a RDC), being different to the moment of creation in the copyrights. In both cases any specific formality is required and the protection is against copies, but the relevant date for the birth of the right, the duration or the scope of protection are different.

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

In connection with industrial designs, our legal system sets forth a different regime for registered and unregistered designs.

In connection with **registered designs**, the LDI, in section IV of its preamble, establishes that: “from the publication of the registered design, after the registration is granted, the protection is full, and entitles its holder to prevent any act of exploitation of the design, such as the manufacturing, offering, commercialization, import, export or the use or stocking for these purposes, of the product incorporating a design falling into the scope of protection of the registered one, even if such design has been created independently”.

In line with the foregoing, article 14.3 LDI sets forth that “if the same design has been created by different persons in an independent manner, the right to register the design will belong to the person having the earlier application for registration in Spain, provided that such registration gets to be granted”.

Therefore, regarding registered designs, the fact that the subsequent design was created independently will neither prevent that such design can infringe a prior registered design (as long as all requirements for infringement are met) nor will entitle the second “creator” to register his/her design, since the right to registration corresponds to the first one in filing the application for registration (subject to this later being successful).

In connection with **unregistered designs**, in regards of which the LDI refers to the RDC (see Additional Provision 8th of the LDI), the situation is substantially different in case that there is (and there is evidence of) a process of independent creation.

As a preliminary comment, it should be reminded that the protection that RDC confers to unregistered designs only consists of the right to prevent the use (understanding as use the making, offering, putting on the market importing, exporting or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes) if the use results from having copied the design at issue. And pursuant to the second paragraph of article 19.2 RDC, and it is in this point where the importance of the independent creation factor lies, “the contested use shall not be deemed to result from copying the protected design if it results from an independent work of creation by a designer who may be reasonably thought not to be familiar with the design made available to the public by the holder”.

It derives from the above, for the purposes hereby relevant, that an infringement (or a copy) of the “prior” design shall not be deemed to exist in case it can be evidenced that the “subsequent” design is the result of an independent creation, which entails proving that its author—reasonably—has not had access to the prior unregistered design.
Case-law has applied the above by requiring evidences or reasonable explanations to the new creator of having carried out an independent creative process.

That is how the Community Trademark and Designs Judge and Court (of Alicante) has understood it, in judgments such as the one passed by the Community Trademark and Designs Judge no. 1 on February 28, 2007. This judgment clarifies that it is the “new creator” who has the burden to prove his/her process of autonomous creation, and consequently, that he/she has not copied the unregistered prior design.

And likewise, in connection with this point, we can mention the Judgment by the Community Trademark and Designs Judge no. 1 dated December 11, 2009 and the Decision by the Community Trademark and Designs Court no. 1 dated March 1, 2006.

Therefore, it can be concluded that with regard to unregistered designs, unlike what it happens with registered ones, the evidence of independent creation enervates the existence of infringement. On the contrary, in case of registered designs, such process of independent creation would not prevent the existence of an infringement of the prior registered design.

In connection with the foregoing, there have been very clarifying conclusions by the Advocate General Mr. Paolo Mengozzi, dated November 8, 2011 with regard to the preliminary ruling request filed by the Community Trademark and Designs Judge No. 1 of Alicante in connection with the concept of “third parties” in the field of designs infringement and, particularly, for which it is hereby relevant, in connection with the relevance of the intention or conduct of the potentially infringing third party.

Thus, the Advocate General, as it was subsequently confirmed by the ECJ in its Judgment dated February 16, 2012, has defended the irrelevance of the intention or conduct of the third party with regard to registered designs (which includes the fact of whether there is an independent creation process) by supporting the difference which exists in this regard towards unregistered designs.

The proposal was explicitly admitted by the Court of Justice in its Judgment dated February 16, 2012.

Lastly, in connection with intellectual property or copyright, leaving aside issues different to the one hereby at stake, the LPI does not regulate the “independent creation” as a relevant factor for the purposes of assessing the existence or non-existence of infringement.

Notwithstanding that, this factor has been taken into account by some authors and case-law when assessing the originality of the work.

Thus, analyzing the trend which interprets the originality requirement as “subjective novelty”, the evidence of the independent creation would be sufficient to establish the originality of the new work and, consequently, to establish that the preexisting work has not been infringed. On the contrary, for the trend which interprets the originality as “objective novelty”, the fact of the “independent creation” would not have any relevance for the purpose of establishing the non-existence of infringement, since the relevant point would be that such work is different to all which existed in the prior heritage.

However, the foregoing must be clarified in the sense that even for the trend which defends the requirement of “objective novelty”, the criterion of “independent creation” although, as we have seen, will not be relevant to assess the existence or non-
existence of infringement of the prior work, it will be relevant for assessing the
“originality” of this work. Thus, in these cases it is understood that the analyzed work is
“original” and consequently protected pursuant to the LPI when the statistical chances
that a replica of the work is created accidentally and independently are scarce.

By way of example, we mention the Judgment by the Commercial Court of Palma of

Therefore, regarding intellectual property, the LPI does not regulate this matter;
nevertheless both the majority of authors and case-law understand that the fact that the
same work (or similar) has been created independently will not be conclusive to assess
the existence of infringement of the prior work, by applying the doctrine of “objective
novelty”. However, it does indeed seem relevant to assess the fulfillment by said work
of the originality requirement to analyze if it is likely that any third party could reach a
similar result, in which case, the originality of said work would be very debatable.

Duration of Protection

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

By industrial design protection:

Protection lasts 5 years from the application date, being this term renewable by periods
of 5 years up to a maximum of 25 years, as from the application date (section 43 LDI).

Drawings and registered models protected under Estatuto de la Propiedad Industrial
(EPI) –former law to LDI-, are protected for 10 years, being this term renewable for 10
years more, as from the date of grant (section 185 EPI and Transitory Provision 4ª of
LDI).

Non registered designs are protected during three years from the first disclosure
(section 11 RDC).

By intelectual property protection:

As a general rule, exploitation rights last during the life of the author, plus a period of
70 years from the death (section 26 LPI).

Special rules are: (i) Pseudonym and anonymous works: 70 years (section 27 LPI); (ii)
Works in collaboration and collective works: 70 years as from the death of last survivor
of the authors (section 28 LPI); (iii) independent works: Each of the independent parts
will have its own duration (section 29 LPI).

When appropriate, terms for protection are to be counted as from 1 January of next
year to the death or as from the date of issue of the death of the author or as from the
date of legal disclosure of the work, (section 30 LPI).

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?

Copyright protection continues, as long as the design itself has the necessary grade of
originality to be protected as an artistic work, as per the regulations relating to IP
(Additional Provision 10ª LDI).
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?

No. Additional Provision 10th LDI establishes that “protection for industrial design recognized by this Act will be independent, cumulative and compatible with protection given to copyright when design would have itself the creativity and originality necessary to be protected as artistic work under the rules of copyright”. Therefore, if the industrial design is eligible to be protected as artistic work (this means, it is “an original creation”, ex article 10 LPI) it may be protected by a copyright at the same time, without any measure for adjustment. That implies that both protections of the product – that one given as an industrial design, because it meets the legal requirements, and the protection given for being as artistic work, because it meets the legal requirements as well – they are completely independent and they are governed by specific rules for each protection, without there being any measure for adjustment that may condition the retention of one or the persistence of another.

Once the right of industrial design is extinguished, copyright protection shall be in force until it shall terminate in accordance with relevant legislation. This means, it shall be protected until 70 years after author’s death or declaration of death (article 26 LPI), from the first disclosure, whether anonymous or pseudonymous work (article 27 LPI), or the death or declaration of death of the last co-author if collective work (article 28 LPI). Deadline will always start from January 1st of the following year after the death of the author or his/her declaration of death, or the first disclosure, as appropriate (article 30 LPI).

II. Proposal for Harmonization

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

Yes, cumulative protection may be possible.

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 for industrial products that they deem relevant.

No. Exclusion of copyright protection for an artistic work, even it is applied or not, once the protection given by industrial design is terminated, by solely the fact of having enjoyed that protection, it would be an unacceptable discrimination of such creations against the rest of the original creations protected under copyright law.

Courts should be the ones, which (case by case) may adopt the necessary measures for adjustment depending on the degree of originality of the design and the circumstances of every individual case.
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.
Summary

In Spain the same industrial product can be protected by both a design right and a copyright. In order to enjoy design right protection for industrial products, registration of a design is not necessary, but the protection granted to non registered design is weaker (only preventing copies). In order for the design to be registered, a substantial examination is not necessary. In order to obtain industrial design protection it is required that a product be new and has individual character. The requirement to obtain copyright protection is that the product be an original creation, both for industrial products and artistic products; the scope of the copyright protection is also the same for industrial and artistic products. The criteria for assessing infringement of copyright protected industrial products is somewhat different from the criteria for assessing infringement of a design right. For registered industrial designs it is not a relevant defence that the industrial product was created independently from the older work or design. Differently, for unregistered designs it is indeed relevant. Such a defense could be relevant with respect to copyrighted works, even though the Spanish Act keeps silent about this issue. The duration of industrial registered design protection is 5 years as from the date of the filing of the application, and can be renewed for one or more periods of five years each, up to a total term of 25 years; the protection of unregistered industrial designs lasts three years as from the date on which the design was first made available to the public; the duration of copyright is the lifetime of the author plus 70 years after his death. Once the term for industrial design protection expires, the copyright protection may continue provided that the design in question is sufficiently original. In Spain, there are no measures 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.

The Spanish Group considers that cumulative protection should be possible and that it is not desirable to produce measures for resolving this eventual overlap in such cases in which it could take place.

Résumé

En Espagne, un produit industriel peut être protégé en même temps par le droit de modèle et par le droit d’auteur. Il n’est pas nécessaire d’enregistrer le modèle industriel, mais la protection du modèle non enregistré est plus faible (pour la copie seulement). Pour l’enregistrement il n’y a pas d’examen sur le fond. Pour obtenir la protection du modèle il est nécessaire que le produit soit neuf et singulier. Tandis que pour la protection du droit d’auteur il doit exister une création originale, avec les mêmes exigences pour les œuvres industrielles et artistiques. La protection ne diffère pas non plus. Cependant, il a quelques différences à l’heure de juger une infraction contre la propriété intellectuelle ou contre un modèle. Pour les modèles enregistrés ce n’est pas important si le produit a été créé de façon indépendante par rapport à l’œuvre ou modèle précédent. Pour les modèles non enregistrés, c’est important. En ce qui concerne le droit d’auteur, ce fait pourrait être pertinent, bien que la loi espagnole ne le contemple pas. La protection du modèle enregistré dure 5 ans à compter du dépôt, renouvelable pour des périodes de 5 années jusqu’à un maximum de 25 ans; la protection du modèle non enregistré est de 3 ans à compter de la première divulgation; les droits d’exploitation de la propriété intellectuelle ont une durée qui comprend la vie de l’auteur plus 70 ans après sa mort. Lorsque la protection du modèle termine, la protection peut demeurer en vigueur par la voie de la propriété intellectuelle à condition que le dessin soit suffisamment original. En Espagne, il n’y a pas de mesures d’ajustement pour éviter qu’un produit industriel soit protégé en même temps.
par droit de modèle et par droit d’auteur ou bien par droit d’auteur une fois écoutée la protection que confère le modèle.

Le Groupe espagnol considère que la double protection est convenable et que l’adoption de mesures pour éviter un possible chevauchement n’est pas souhaitable, dans les cas où ce chevauchement arrive à se produire.

Zusammenfassung