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, the same product can be protected by both a design right and copyright.

It should be noted that UK copyright may subsist in the industrial product itself, as well as design drawings for that industrial product. Both copyrights may be used to protect the industrial product by preventing the sales of infringing products.

The various possible means of protecting designs in the UK are:

- UK registered design;
- UK unregistered design;
- Community registered design;
- Community unregistered design; and
- Copyright.

The scope of the right in question, its term of protection and provisions concerning overlapping protection are all relevant to the possibility of cumulative protection in the UK.
Scope of right in question

Cumulative protection is only possible where the scope of protection of two or more rights overlaps. There are a large number of differences on a detail level. In summary, the main areas of protection are:

- Community registered design: the appearance of the whole or part of a product resulting from such features as lines, contours, colours, shape, texture, materials, ornamentation, but not:
  - parts not visible during normal use;
  - features dictated solely by function;
  - must fit features.
- Community unregistered design: same as the Community registered design.
- UK registered design: same as the Community registered design.
- UK unregistered design: the shape and configuration of the whole or part of articles, but not:
  - methods or principles of construction;
  - must fit features;
  - must match features;
  - surface decoration.
- Copyright: the copyright works most relevant to industrial designs are literary and artistic works (which includes graphic works, photographs, sculptures, collages and works of artistic craftsmanship).

Provisions concerning overlapping protection

The UK has statutory provisions of extraordinary complexity in the Copyright Designs and Patents Act 1988 (CDPA) concerning the overlap of designs and copyrights. These provisions are set out in Annex A below. The overall effect of the provisions has been litigated in a number of cases, and the main principles that have emerged are as follows:

- there is no infringement of copyright in a design document, if the design document is a design for “anything other than an artistic work.”
  - But, the definition of “design” for this purpose excludes surface decoration, so where a designer designs the surface decoration of a product, then this will still be protected under copyright.
- infringement is negated after 25 years from the date of first marketing where an artistic copyright is exploited by an industrial process. This limitation arises when 50 or more articles which are copies of an artistic work are made.
  - But, “sculptures”, printed matter primarily of a literary or artistic character and wall plaques and medallions are excluded from this limitation.
  - The term of copyright for surface decoration in industrial objects is likely to be limited to 25 years as well: Fearns v Anglo-Dutch [2008] EWCA.

Thus, copyright in design documents is effectively lost for most industrial designs, and even if the design is artistic, copyright is effectively only available for 25 years if the design is exploited industrially (25 years is also the maximum term of design protection under UK and Community registered designs). Exceptions to this include surface decoration which can receive protection for the full copyright term and sculptures. As a result of these limitations the debate in some cases has focused on whether a particular 3D object should be classified as a “sculpture”; which is an unusual debate in litigation about commercial matters and following Lucasfilm v Ainsworth [2011] UKSC, is unlikely to be satisfied by many industrial designs.

In addition, where copyright subsists in a work which consists of or includes unregistered design right, then UK law provides that it is not an infringement of the design right to do
anything which is an infringement of the copyright in that work (section 236 CDPA). Because it is unclear in some situations whether copyright subsists in a design and is infringed, making the availability of unregistered design protection conditional on the non-availability of the copyright introduces additional uncertainty.

These provisions apply equally to designs created outside the UK, where copyright is sought to be enforced in the UK. However, the enforcement of copyright for UK-created works outside the UK may not be similarly limited and a mixture of protection in various states may well result (especially in light of the ruling in Tod’s v Heyraud, see question 2 below).

The legal analysis is further complicated by the recent ruling of the Court of Justice of the European Union (CJEU) in Flos SpA v Semeraro Casa e Famiglia SpA (C-168/09). In that judgment the CJEU considered the interaction of national EU legislation with EU Council Directive 93/98/EEC (the “Term Directive”) and EU Directive 98/71/EC (the “Designs Directive”). The Court made inter alia the following findings:

- Article 17 of the Designs Directive requires that copyright protection must be conferred on all designs protected by a design right registered in or in respect of the Member State concerned;
- The second sentence of Article 17 of the Designs Directive cannot be interpreted as meaning that Member States have a choice as to whether or not to confer copyright protection for a design protected by a design right registered in or in respect of a Member State if the design meets the conditions under which copyright protection is conferred;
- The fact that the Member States are entitled to determine the extent of copyright protection and the conditions under which it is conferred does not affect the term of that protection, since the term has already been harmonised at European Union level by the Term Directive.

The same reasoning may be said to apply in relation to unregistered Community designs by virtue of article 96 of EU Regulation 6/2002, which contains a provision mirroring article 17 of the Designs Directive.

Although UK law has not been revised yet to implement the ruling in Flos, it is at the very least arguable that it should be or that it national UK law should be construed in a manner consistent with Flos.

With provisions as complex as these, adding to a base level of uncertainty from a mix of different provisions in other countries, this area of law in the UK is ripe for simplification and harmonisation.

Term of protection

UK and Community registered design: 25 years.

UK unregistered design: 15 years from the end of the calendar year in which design is recorded in a design document or, if shorter, 10 years from the end of the calendar year during which articles were first placed on the market in the UK.

Community unregistered design: 3 years beginning from the date the product was first made available to the public within the Community.

Copyright: Life of author plus 70 years in certain circumstances, but as explained above for all practical purposes the term has been cut down to 25 years if copyright protection is available at all.
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?

No. We are not aware of any cases where copyright protection has been refused in the UK pursuant to Article 2(7). There are, of course, a number of decisions in which UK copyright protection has been refused, including where UK copyright protection is narrower than in the country of origin.

UK law does include nationality and other requirements in relation to copyright, such as the nationality of the author. Works originating in RBC/EEC countries will be protected in the UK under UK copyright law, and works in certain countries outside the RBC/EEC (the exact status of a country also depends on whether it is a member of WTO and UCC) may be protected in the UK if those countries provide reciprocal protection. Thus, in theory the UK could refuse copyright protection in relation to works originating outside the RBC/EEC if those countries will not provide reciprocal protection, but we are not aware of such a case.

Works originating in the EEA are guaranteed protection under UK copyright law, irrespective of the level of protection in the country of origin. Article 12 of the EU Treaty has been interpreted by the CJEU in Tod’s v Heyraud (C-28/04) to mean that the UK and UK courts cannot discriminate against designs originating within other Member States of the European Union. The CJEU ruled as follows:

Article 12 EC, which lays down the general principle of non-discrimination on grounds of nationality, must be interpreted as meaning that the right of an author to claim in a Member State the copyright protection afforded by the law of that State may not be subject to a distinguishing criterion based on the country of origin of the work.

This does not mean that the UK should extend the scope of UK copyright protection if copyright protection is broader in the country of origin of the work; merely that the UK should not deny protection under UK copyright law if the country of origin is an EEA Member State.

Conversely, if copyright protection is broader in the UK than in the country of origin, protection under the broader UK copyright law cannot be denied if the country of origin is an EEA Member State.

If the country of origin is not an EEA Member State a denial of protection under UK copyright law would not contravene the CJEU’s ruling in Tod’s v Heyraud.

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?

We assume that “substantial” means “substantive”.

It is not necessary to obtain registration for design protection to subsist. Unregistered design right and copyright both come into existence upon creation in some material form. However, there is also a registered design regime which requires registration.

Where registered design protection is sought, there is no substantive examination.
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?

<table>
<thead>
<tr>
<th></th>
<th>Requires registration?</th>
<th>Qualification by nationality or otherwise?</th>
<th>Substantive requirements?</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>UK registered design</strong></td>
<td>Yes</td>
<td>No</td>
<td>Novelty, individual character, an appearance which is not dictated by the technical function of the item</td>
</tr>
<tr>
<td><strong>Community registered design</strong></td>
<td>Yes</td>
<td>No</td>
<td>Same as UK registered design</td>
</tr>
<tr>
<td><strong>UK unregistered design</strong></td>
<td>No</td>
<td>Yes – complex provisions regarding the designer’s nationality and the place of first marketing</td>
<td>Originality, not commonplace in the field of design, recorded in a design document or an article is made to the design</td>
</tr>
<tr>
<td><strong>Community unregistered design</strong></td>
<td>No</td>
<td>No</td>
<td>Same as Community registered design</td>
</tr>
<tr>
<td><strong>Copyright</strong></td>
<td>No</td>
<td>Yes – complex provisions for largely historical reasons</td>
<td>Originality and the work is recorded in material form</td>
</tr>
</tbody>
</table>

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

The requirements for copyright protection for industrial products and other artistic products are as set out above.

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?

See above.

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

Yes, the criteria for assessing infringement are (all) different.
For copyright, following the judgment of the CJEU in *Infopaq* (C-5/08), the test includes an examination of whether the elements reproduced are the expression of the intellectual creation of their author. This is similar to (but from the CJEU decision in *Football Dataco* C-604/10, 1 March 2012) not the same as) the test developed in English law, whether a substantial part of the skill, labour and judgment of the copyright owner has been reproduced by the infringer. This test is qualitative and not quantitative.

For Community and UK registered design right, the test for infringement is whether the infringing design does not produce a different overall impression on the informed user.

For UK unregistered design right, the test is whether the infringing articles exactly or substantially reproduces the design or a feature of it, and is the result of copying. This is determined through the eyes of the intended customer.

For Community unregistered design right, the test is the same as for registered design, except there is an additional requirement that the infringing design has been copied.

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

Independent creation is a defence under copyright and under both Community and UK unregistered design right. It is not a defence under Community or UK registered design right.

**Duration of Protection**

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

See question 1 above.

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?

The design rights and copyright protection exist separately and so upon the expiration of the shorter term, the other right continues to subsist. Though, as discussed above, the presence of both can impact on the length of each type of right.

**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?

See question 1 above.
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?

An overriding policy concern is whether the enforcement of copyright or design rights may be anti-competitive or contravene fundamental rights such as those assuring the free movement of goods or inter-state trade. Subject to there being no such abuse, we do not see any specific reason to make it more difficult to obtain copyright protection for industrial products.

If anything, because both unregistered design rights and copyrights require copying for there to be infringement, there is a case for making copyright equally available and similar to unregistered design rights in relation to industrial designs. However, where an industrial product qualifies for protection as an unregistered or registered design, irrespective of whether a registration is obtained, it would be appropriate to limit the term of copyright protection to not exceed the maximum period of protection that could be obtained by registration.

In the event that an industrial design qualifies for protection under an alternative regime, e.g. unfair competition in the case of designs that have become iconic, such alternative protection should not be affected by any limitation in the term of copyright protection.

Although it would be possible to rely on Courts constraining the enforcement of copyright in appropriate ways (for example, the European Court of Justice in *Magill* and *IMS Health*), it may be advantageous to provide appropriate express safeguards built into copyright law. In relation to designs, certain safeguards have already been provided, such as the must-fit exception for registered designs.

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

We see no problem in principle with cumulative protection, provided that overriding policy concerns are addressed as discussed above.

Furthermore, if provisions are introduced to remove cumulative protection, it is inevitable (as can be seen from the UK experience) that designs in some areas do not get protection and fall into a gap between design rights and copyrights, and the system becomes very complex. Legal certainty is thereby reduced.

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?

N/A

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.
We recommend that a resolution be considered which:

(a) Recalls that design and copyright overlaps are subject to constraints arising from competition law policy and policies regarding the effective free movement of goods.

(b) States that in principle there should be no restriction of copyright in relation to industrial designs, except in narrow circumstances tailored as narrowly as possible to address the policy concerns referred to in (a) above.

(c) Recognizes that the provision of spare parts which ‘must fit’ products is a policy concern warranting exclusion from the scope of copyright and design rights.

(d) Recognizes that where an industrial product qualifies for protection as an unregistered or registered design, irrespective of whether a registration is obtained, it would be appropriate to limit the term of copyright protection to not exceed the maximum period of protection that could be obtained by registration.

(e) Recognizes that purely functional aspects, without any aesthetic element, falls more properly within the scope of patent protection if available and warrants exclusion from the scope of copyright and design rights.

We do not recommend creating multiple levels of “originality” for industrial and non-industrial products. It has not proved easy applying the UK’s test of whether an object is a “sculpture” or a “work of artistic craftsmanship” and there is real doubt as to whether a workable system of multiple levels of originality could be created.

However, it may nevertheless be possible to exclude purely functional aspects from the scope of copyright, as for Community designs. It would be a question of fact whether an aspect of a work was purely functional. Aspects not visible to a user of a product in normal use would most likely be functional.

Summary
The UK system for copyright and design protection for industrial products is extraordinarily complex and does not assist with legal certainty. It would be of great assistance to both simplify the system and harmonise it with other similar systems so that it is clearer what protection is likely to subsist for industrial designs on a multi-jurisdictional basis.

Proposals for harmonization should, in our view, include an exclusion of purely functional aspects of designs from copyright protection, an exclusion of ‘must-fit’ features so that the commercialisation of spare parts is not inappropriately prohibited, and a limitation on the term of copyright protection to match the maximum period that would be available for registered design protection of the industrial product.

Résumé
Au Royaume Uni, le système de protection des produits industriels par le droit d’auteur et les dessins et modèles est extraordinairement complexe et ne contribue pas à améliorer la
sécurité juridique. Il serait particulièrement utile à la fois de simplifier le système et de l'harmoniser avec d'autres, similaires, pour que, dans un cadre multi-juridictionnel, la protection dont pourraient bénéficier les modèles industriels soit plus clairement établie.

Toute proposition d'harmonisation devrait, selon nous, exclure la protection par le droit d'auteur des aspects purement fonctionnels des modèles, exclure la protection des éléments d'interconnexion, pour que la commercialisation des pièces détachées ne soit pas prohibée de manière inappropriée, et limiter la durée de protection par droit d'auteur à la période maximum qui serait disponible pour la protection du produit industriel par un dessin et modèle enregistré.

Zusammenfassung

Das System des Urheber- und Geschmacksmusterrechts im Vereinigten Königreich ist ausgesprochen komplex und trägt nicht dazu bei, Rechtssicherheit zu gewährleisten. Es würde einen wesentlichen Beitrag darstellen, wenn das System sowohl vereinfacht als auch mit anderen ähnlichen Systemen harmonisiert würde, damit klarer überschaubar ist, welcher Schutz für Geschmacksmuster voraussichtlich auf einer grenzüberschreitenden Ebene bestehen wird.

Annex A – UK statutory exclusions of cumulative protection

51  Design documents and models.

(1) It is not an infringement of any copyright in a design document or model recording or embodying a design for anything other than an artistic work or a typeface to make an article to the design or to copy an article made to the design.

(2) Nor is it an infringement of the copyright to issue to the public, or include in a film or communicate to the public, anything the making of which was, by virtue of subsection (1), not an infringement of that copyright.

(3) In this section—

"design" means the design of any aspect of the shape or configuration (whether internal or external) of the whole or part of an article, other than surface decoration; and

"design document" means any record of a design, whether in the form of a drawing, a written description, a photograph, data stored in a computer or otherwise.

52  Effect of exploitation of design derived from artistic work.

(1) This section applies where an artistic work has been exploited, by or with the licence of the copyright owner, by—

(a) making by an industrial process articles falling to be treated for the purposes of this Part as copies of the work, and

(b) marketing such articles, in the United Kingdom or elsewhere.

(2) After the end of the period of 25 years from the end of the calendar year in which such articles are first marketed, the work may be copied by making articles of any description, or doing anything for the purpose of making articles of any description, and anything may be done in relation to articles so made, without infringing copyright in the work.

(3) Where only part of an artistic work is exploited as mentioned in subsection (1), subsection (2) applies only in relation to that part.

(4) The Secretary of State may by order make provision—

(a) as to the circumstances in which an article, or any description of article, is to be regarded for the purposes of this section as made by an industrial process;

(b) excluding from the operation of this section such articles of a primarily literary or artistic character as he thinks fit.

(5) An order shall be made by statutory instrument which shall be subject to annulment in pursuance of a resolution of either House of Parliament.

(6) In this section—

(a) references to articles do not include films; and

(b) references to the marketing of an article are to its being sold or let for hire or offered or exposed for sale or hire.