The Cumulative Protection of Designs in the European Union and the Role in such Protection of Copyright

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Designs are protected in the EU by a multiplicity of different, overlapping, intellectual property rights. Traditionally however there has only been limited scope in most EU member states to protect designs by copyright. This is set to change, as the result of an only recently appreciated interaction between legislative changes harmonising the term of protection for copyright works made back in 1993, a decision of the CJEU in 2009 as to the threshold of originality for copyright works generally, and another decision of the CJEU in 2011 as to the consequences in practice of a requirement in EU designs legislation that there be cumulative protection as between copyright and designs. This article discusses how this situation has come about, and what its significance for the future of design protection in Europe is likely to be.

Keywords: Design, copyright, unitary protection

Designs Protection in the EU

Designs are protected in the member states of the EU by a multiplicity of different, overlapping, intellectual property rights. Thus Regulation 6/2002 on Community designs provides two types of unitary protection effective throughout the EU for designs (which it defines in broad terms) – automatic protection of 3 years term against copying for designs without any need for registration and, subject to payment of renewal fees, full protection of up to 25 years for designs which are registered at OHIM (the Office for Harmonisation in the Internal Market), which also serves as the registry for the Community trademark regime. Another EU measure, Directive 98/71 on the legal protection of designs, mandates EU member states to provide harmonised national protection for designs by means of national registration procedures. Some designs can be protected by trademarks, which in the EU can, in the same way as designs, be registered both nationally and with OHIM, in the latter case as unitary rights with effect throughout the EU. Many EU member states also protect designs against copying under national unfair competition laws, which are not harmonised at an EU level. In the UK, designs are also given 15 years protection without registration against copying, although the definition of design for this purpose is narrower than that under Regulation 6/2002 on Community designs. Moreover, because designs tend to be both artistic and functional in nature certain designs are also protected, generally as works of applied art, by copyright laws, and it is with the extent of such protection that this article is concerned.

Designs and their Interface with Copyright under International Treaties

The Berne Convention by Article 2(1) (and thus TRIPS) mandates the protection of ‘works of applied art’ as an example of ‘artistic works’. However by Article 2(7) it goes on to allow countries freedom ‘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’ subject only to Article 7(4). This in turn allows countries freedom in determining the term of protection of ‘works of applied art in so far as they are protected as artistic works’ provided that ‘this term shall last at least until the end of a period of twenty-five years from the making of such a work.’

Section 52 of the UK Copyright Designs and Patents Act 1988 (restating equivalent provisions found in earlier UK copyright legislation) provides an example of a provision of national law that avails itself of the flexibilities that Berne thereby confers. It provides that making an article to a design which is an artistic work does not infringe copyright in that artistic work if such artistic work has been exploited

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with the consent of the copyright owner by being made by an ‘industrial process’ and sold, if done more than 25 years after such exploitation and sale. This reflects a view that the creator of an artistic work has an option either to treat his work as a work of pure art, in which case he can benefit from the full term of copyright protection, or instead to exploit it by an ‘industrial process’ and so only benefit from the shorter term of protection of the same order as that associated with other intellectual property rights.

Articles 2(7) and 7(4) of the Berne Convention make it clear that the obligation to protect works of applied art by copyright applies only in so far as such works are regarded under national laws as artistic works. This serves to emphasise a particular hurdle that is encountered in most common law countries which have a ‘closed list’ of copyright works as opposed to ‘open list’ of most civil law ones. Again using the example of the UK, as a common law country only some types of work are listed in its legislation as qualifying as copyright works, and the only types of copyright work in its ‘closed list’ potentially suitable for protecting three dimensional designs are sculptures and ‘works of artistic craftsmanship’. However the UK courts have adopted a narrow interpretation of what constitutes such works, leaving the vast majority of three dimensional designs unprotected by copyright and, even where they are so protected, either as sculptures or as works of artistic craftsmanship, limiting their term of protection to 25 years.

But even in the civil law countries in Europe, which do not avail themselves of the Berne Convention flexibilities, and which moreover have long accepted the principle of cumulative protection by copyright and designs law, designs have traditionally encountered impediments to their protection by means of copyright. Thus such civil law countries generally require a higher standard of originality for ‘applied art’ as opposed to ‘fine art’ if copyright is to subsist in it. Thus France and many other countries hold that if functional features dictate the shape of a product to such an extent that there is no room for personal expression, then there can be no copyright protection. In Germany copyright only subsists in works of applied art which demonstrate a ‘considerably above average design skill’, whereas in Italy they must (now) have ‘inherent creative and artistic value’. Some other European countries which appear at first sight not to have such a high threshold for copyright to subsist in works of applied art, such as Denmark and Sweden, tend to approach such matters by requiring that to infringe copyright in a design there must be a very close imitation. Thus in practice, and by whatever means this has been achieved, the application of such approaches has resulted in a situation in which relatively few designs have proved capable of being protected by the application of copyright protection in such jurisdictions, and those that have been tend to be designer furnishings, and notably chairs and lights.

**Designs and their Interface with Copyright under EU Law**

The established order in Europe as to design protection by means of copyright is however now at risk. This is the consequence of an only recently appreciated interaction as between legislative changes harmonising the term of protection for copyright works made back in 1993, a decision of the CJEU in 2009 as to the threshold of originality for copyright works generally, and another decision of the CJEU in 2011 as to the consequences in practice of a requirement in EU designs legislation that there be cumulative protection as between copyright and designs. The requirement in EU designs legislation at the root of this is at first sight unexceptional and permissive as to the approach that EU Member States can take to such matters, being set out in Recital 8 and Article 17 of Directive 98/71 on the legal protection of designs. The former notes that:

(8) Whereas in the absence of harmonisation of copyright law, it is important to establish the principle of cumulation of protection under specific registered design protection law and under copyright law, whilst leaving Member States free to establish the extent of copyright protection and the conditions under which such protection is conferred.

The latter mandates EU Member States to apply cumulation in the following terms:

(17) A design protected by a design right registered in or in respect of a Member State in accordance with this Directive shall also be eligible for protection under the law of copyright of that State as from the date on which the design was created or fixed in any form. The extent to which, and the conditions under which, such a protection is conferred, including the level of originality required, shall be determined by each Member State.
The apparently permissive last sentence of Article 17 rather blinded people for many years to the full consequences of this provision, and quite what it meant in practice was not apparent until the CJEU had to interpret it in Case C-168/09 Flos v Semarao Casa e Famiglia in the context of a challenge to transitional provisions in the national Italian legislation which had sought to implement Directive 98/71/EC (Italian law having previously provided that the provisions of copyright law were not applicable to industrial designs). These transitional provisions had initially prevented copyright being asserted in relation to designs for 10 years after such implementation as against third parties that had before such implementation manufactured and marketed the goods in issue in good faith, but had subsequently been amended simply to exclude copyright protection for any design that had fallen into the public domain before the date of implementation. The CJEU held that neither type of transitional provision was consistent with Article 17.

The reasoning behind such decision is however of much wider application. Thus the CJEU observed that although Member States were, as Article 17 stated, free to establish the extent of copyright protection and the conditions under which such protection is conferred, that there was no such freedom as to the term of copyright protection, since the term of copyright protection in the EU had already, nearly twenty years previously, been harmonised at EU level at the life of the author plus 70 years by Directive 93/98 on the harmonisation of term, which made no distinction between works of applied art and other copyright works, and that this had been expressed to apply to any copyright work which, on 1 July 1995, was protected in at least one EU Member State. Directive 93/98 had no separate provision as to works of applied art.

The effect of this reasoning would appear thus to prevent EU Member States from availing themselves of the Berne Convention flexibility which permits countries to limit the term of protection for works of applied art in so far as they are protected as artistic works to 25 years. This is certainly how the UK Government is interpreting it, having proposed in May 2012 to repeal of Section 52 of the UK Copyright Designs and Patents Act 1988, legislation to which end is currently proceeding through Parliament.

But what other flexibilities in terms of copyright protection for designs might EU Member States retain? Term of protection was the only issue addressed in Case C-168/09 Flos. In particular no attention was paid in it to the issue of originality, which as discussed above is in practice in many European jurisdictions that have long applied cumulation higher for copyright to subsist in works of applied art than in other types of work. However, originality has in other areas of European copyright started to attract a considerable body of controversial case law at a CJEU level, starting with the CJEU decision in Case C-5/08 Infopaq A/S v Danske Dagblades Forening. This held that despite the EU legislation only mandating use of the concept of the ‘author’s own intellectual creation’ in establishing the threshold for originality for copyright to subsist in relation to computer programs, databases and photographs, this concept was of general application in the EU to all copyright works. Does this presage a challenge to the standard of originality in such other countries, such as for example Germany, where copyright only subsists in works of applied art which demonstrate a ‘considerably above average design skill’? Neither have Member States any flexibility as to designs in terms of exceptions and reservations, as designs do not feature specifically in the exhaustive list of these set out in Article 5 of Directive 2001/29 on copyright in the information society.

Conclusion

It can thus be argued that EU copyright law as interpreted by the CJEU leaves Member States with little, if any, latitude, for limiting the protection to be afforded by copyright to designs; attempts to do so by means of term restrictions, higher standards of originality (and thus more restricted scope for the restricted acts of reproduction and distribution) would appear to be foreclosed. The same may also apply to ‘closed list’ definitions of types of copyright work such as that exists at present in the UK. As a result the scope for protecting designs by copyright in the Member States of the EU may be much greater than anyone had previously appreciated.

In an earlier article in this journal the author observed that the longstanding difficulty with designs, and even with the very rationale for having a protection regime for designs that is separate to that of patents and copyright (or for that matter unfair competition) is evidenced by manner of their
treatment in the Paris Convention, which until its Lisbon revision of 1958, did not even require that they be protected. Even then Article 5 quinquies of the Paris Convention, introduced at that revision, simply mandates the protection of industrial designs without either saying what they are, or how they are to be protected, and though Articles 25 and 26 of the TRIPS Agreement go a little further and add some specifics, they only do so to a limited extent.

Against that background it is ironic that designs, for so long the ‘Cinderella’ of intellectual property, should attract so many different overlapping types of protection in Europe, even though many forms of such protection may however in practice tend to be narrow in scope. It is even more ironic that they are now likely to attract even more protection, through the medium of copyright, than ever before. Indeed this does raise the policy question as to whether designs merit any protection in Europe other than that conferred by copyright, or whether a radical simplification of the law could usefully be effected by the repeal of the complex specific and separate network of design protection that is endured in Europe.

References
3 In the UK, the obligation under the Paris Convention to protect against acts of unfair competition is met by the law of passing off, which however has little application in practice to the protection of designs.
4 By the Copyright (Industrial Processes and Excluded Articles) (No 2) Order 1989, and subject to certain specific exclusions, an article is treated as having been made by an ‘industrial process’ if it is one of more than 50 articles all of which are copies of a particular artistic work.
5 George Hensher Ltd v Restawile Upholstery (Lancs) Ltd [1976] AC 64 holding a certain, somewhat prosaic, design of furniture not to be a ‘work of artistic craftsmanship’, one member of the House of Lords (Lord Reid) having observed that he found ‘no evidence at all that anyone regarded the appellants’ furniture as artistic’ and Lucasfilms v Ainsworth [2011] UKSC 39 holding a ‘Star Wars’ ‘Stormtrooper’ helmet not to be a sculpture.
6 Within the EU itself one can identify amongst the countries that traditionally accepted such cumulation—Austria, Belgium, Bulgaria, Czech Republic, Denmark, Estonia, Finland, France, Germany, Hungary, Italy (now), Latvia, Netherlands, Portugal, Spain and Sweden and, elsewhere in Europe, Norway (which as a non-EU member of the EEA aligns its laws with those of the EU) and Switzerland. Cumulative protection originates in the theory, first developed in France, of ‘unity of art’, under which there should be no distinction or discrimination as between artistic creations on the basis of aesthetic merit or mode of expression. Such an approach is also suggested by the WIPO Model Law on Industrial Designs of 1970 (Publication No 808(E), Section 1(2)).
7 For full discussions of various national approaches, both within and outside Europe, see the National Reports filed in connection with AIPPI Question 231 on ‘The interplay between design and copyright protection for industrial products, https://www.aippi.org/?sel=questions&sub=workingcommittees&viewQ=231#231 (4 December 2012).
8 The corresponding provisions in Regulation 6/2002 on Community designs are Recital 32 and Article 9(2).
9 Case C-168/09 Flos v Semarao Casa e Famiglia (CJEU 27 January 2011).
11 This approach has been criticised in a letter to ‘the Times’ of 31 July 2012 signed by Professor Lionel Bently and several other intellectual property professors at UK universities, pointing out that the UK did not intervene in Case C-168/09 Flos SpA and thus the CJEU had not been informed that during the passage of Directive 98/71 the UK had secured permission to retain its 25 year term. They argued that before so legislating the UK Government should clarify whether such freedom remained intact and that, even if it did not, there were less extreme legislative options for limiting the extent of protection of copyright in designs. See also Lionel Bently – The Return of Industrial Copyright? – University of Cambridge Faculty of Law Research Paper No. 19/2012 (July 2012) at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2122379 (last accessed 4 December 2012).
12 Case C-5/08 Infopaq A/S v Danske Dagblades Forening (CJEU 16 July 2009).
14 Ironically the ‘author’s own intellectual creation’ rubric was first introduced into EU copyright law in Directive 91/250 on the legal protection of computer programs (now replaced by Directive 2009/24/EC) specifically to reduce the threshold of originality that German law had previously required for copyright to subsist in computer programs as originally established in Inkassoprogramm (Federal German Supreme Court 9 May 1985). The Directive was effective in so doing, as confirmed in Accounting Program (Federal German Supreme Court, 14 July 1993).
15 Directive 2001/29/EC of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society OJ L167, 22.6.2001, p.10. Article 5(3)(o) does however permit Member States to retain exceptions and limitations where these existed already under national law, are of minor importance, concern only analogue uses and do not
affect the free circulation of goods. Even were any Member States to have addressed designs in this way (as the UK purported so to do with Sections 51 and 52 of the Copyright Designs and Patents Act 1988) it is unclear to what extent such exceptions and reservations could be regarded as minor, or as not affecting the free circulation of goods.


Stephen Ladas in *Patents, Trademarks, and Related Rights – National and International Protection* (Harvard University Press 1975) notes (at page 829) that ‘the formation of a special branch of industrial property for designs and models is a historical accident’ which he then traces back to the interpretations placed by the French courts on a law of 1806 introduced in response to complaints, made to Napoleon by the manufacturers of Lyon when he visited that city, that the French copyright law of 1793, although broad enough to cover any kind of design, was in practice inadequate for their purposes.