

Industrial Designs

The Legal Protection of Industrial Designs

2.629 The formulation of a legal system for the protection of industrial designs, like the provision of legal protection for all forms of intellectual property, requires the establishment of a balance of interests. On the one hand, there is the need to provide efficient and effective protection, in order that the law may fulfill its function of promoting the design element in production. On the other hand, there is the need to ensure that the law does not unnecessarily extend protection beyond what is necessary to create the required incentive for design activity, so that the least number of impediments are introduced to the free use of available designs. The establishment of this balance requires careful consideration of a number of matters, of which the most important are:

- the definition of the subject matter of protection;
- the rights which apply to the proprietor of the subject matter;
- the duration of such rights;
- the entitlement to such rights;
- the method of acquisition of such rights.

Definition of Subject Matter of Protection

Design as Conception or Idea

2.630 The subject matter of the legal protection of industrial designs is not articles or products, but rather the design which is applied to or embodied in such articles or products.

2.631 The emphasis is on an abstract conception or idea as the subject matter of design protection. Design protection does not apply to articles or products in such a way as to grant the proprietor of the design exclusive rights over the commercial exploitation of those articles or products. Rather, design protection only applies to such articles or products as embody or reproduce the protected design. Protection does not, therefore, prevent other manufacturers from producing or dealing in similar articles fulfilling the same utilitarian function, provided that such substitute articles do not embody or reproduce the protected design.

2.632 The conception or idea that constitutes the design may be something which can be expressed either two-dimensionally or three-dimensionally. The definition of “design” which is used in the Registered Designs Act 1949 of the United Kingdom, for instance, refers to “features of shape, configuration, pattern or ornament” (Section 1). It has been generally considered that, in this definition, the words “shape” and “configuration” are synonymous, and that both signify the form in which an article is made or, in other words, something three-dimensional. Likewise, it has also been considered that the words “pattern” and “ornament” are synonymous, and that both refer to something embossed, engraved or placed

upon an article for the purpose of its decoration or, in other words, to something essentially two dimensional.

2.633 The Copyright, Designs and Patents Act 1988, of the United Kingdom, also provides for a “design right.” Design is defined as referring to “any aspect of the shape or configuration (whether internal or external) of the whole or part of an article” (Section 213(2)).

2.634 A similar approach, emphasizing the inclusion of both two-dimensional and three-dimensional designs, is to be found in the laws of other countries. Thus, the Design Law of Japan (Law No. 125 of April 13, 1959, as amended) refers to “design” as meaning “the shape, pattern or color or a combination of these in an article”, and laws of France and Italy refer to both drawings or sketches (dessins—two dimensional) and models (modèles—three-dimensional).

Application to or Embodiment in an Article

2.635 While the subject matter of design protection is an essentially abstract conception, one of the basic purposes of industrial design protection is the stimulation of the design element of production. It is, accordingly, a usual feature of industrial design laws that a design can be protected only if the design is capable of being used in industry, or in respect of articles produced on a large scale.

2.636 The requirement that a design must be applied to utilitarian articles in order to be protected is one of the principal matters which distinguishes the objectives of industrial design protection from copyright protection, since the latter is purely concerned with aesthetic creations. The requirement is variously expressed in different laws. For example, the Design Law of Japan similarly extends protection to designs “capable of being used in industrial manufacture” (Article 3(1)).

Exclusion of Designs Dictated by Function

2.637 The concern of industrial design protection with appearance only is also apparent from the requirement, commonly found in industrial design laws, that designs which are dictated solely by the function which the article is to perform shall be excluded from protection. In this respect, Article 25.1 of the TRIPS Agreement provides, for example, that Members of the WTO may provide that industrial design protection shall not extend to designs dictated essentially by technical or functional considerations.

2.638 A fundamental purpose is served by the exclusion from protection of designs dictated solely by the function which the article is to perform. Many articles to which designs are applied are not themselves novel, and are produced by a large number of different manufacturers. Belts, shoes, screws and piston rings, for example, may be produced by hundreds of different manufacturers, and all articles within each class are intended to perform the same function. If a design for one such article, for example, screws, is dictated purely by the function which the screw is intended to perform, protection for that design would have the effect of excluding all other manufacturers from producing items intended to perform the same function. Such an exclusion is not warranted, unless the design is sufficiently novel and inventive to qualify under the rigorous standards for patent protection.

2.639 Since, under certain theories of design, form should follow function, it is often said that the exclusion from protection of designs which are dictated purely by function may have the effect of excluding too broad a range of designs from protection. Such a fear is in practice, however, unwarranted, since the exclusion relates only to those designs which are indispensable for achieving the desired function. In reality, many ways of achieving a given function will be possible. Thus, only if the given function could not be achieved after a design is altered would the design be excluded from protection. The question is thus whether the design for which protection is sought constitutes the sole solution for an intended function.

Novelty or Originality

2.640 It is a requirement of all industrial design laws that protection through registration shall be granted only to designs which are novel or, as it is sometimes expressed, original. The novelty of the design constitutes the fundamental reason for the grant of a reward to the originator through protection by registration of the industrial design.

2.641 While the requirement of novelty is to be found in all laws, the nature of the novelty that is required as a condition of protection differs amongst the laws of various countries. The novelty required is sometimes absolute or universal, meaning that the design for which registration is sought must be new as against all other designs produced in all other parts of the world at any previous time and disclosed by any tangible or oral means. On the other hand, a qualified standard of novelty is sometimes required. In this latter situation, the qualification may relate to time, meaning that novelty is judged by reference to designs published within a limited preceding period of time; or may relate to territory, meaning that novelty is judged by reference to all designs published within the relevant jurisdiction, as opposed to anywhere in the world; or may relate to means of expression, meaning that novelty is assessed by reference to written or tangible disclosures anywhere in the world and to oral disclosures only within the relevant jurisdiction.

2.642 The broad policy argument in favor of a standard of unqualified universal novelty is that exclusive rights by registration should be granted only where the originator of the design has produced something which is truly novel, and which therefore justifies the reward of exclusive rights. The broad policy argument in favor of a qualified standard of novelty is that one purpose of design registration is to encourage new design within the relevant jurisdiction, so that a novel design registered within that jurisdiction should not be deprived of protection by the publication elsewhere of a design which its originator did not introduce into the jurisdiction to add to the designs available to industry. It should be noted, however, that it would not necessarily follow from a qualified standard of novelty that a person could obtain valid rights within the jurisdiction simply by registering a design which he had seen overseas and copied, since it is often also a requirement of design law that the applicant be the author of the design.

Rights in Industrial Designs

2.643 The rights which are accorded to the proprietor of a validly registered industrial design again emphasize the essential purpose of design law in promoting and protecting the design element of industrial production. Thus, whereas copyright accords to an author the right to prevent the copying of a work, industrial design law accords to the proprietor the exclusive right to prevent the unauthorized exploitation of the design in industrial articles.

Entitlement to Rights

2.644 The right to legal protection in respect of an industrial design belongs to the creator (or author or originator) of the industrial design. Two questions concerning the operation of this principle arise and are often the subject of particular legislative provisions.

2.645 First, there is the question of the entitlement to legal protection in respect of an industrial design that has been created by an employee, or by a contractor pursuant to a commission. In these situations, the law usually provides that the entitlement to legal protection of the design shall belong to the employer, or to the person who has commissioned the design. The basis for this rule is that the creation of the design falls within the duties which the employee is paid to perform, so that the employee should seek the reward for his creative activity in an appropriate level of remuneration, responsibility and other conditions of employment. Likewise, in the case of the contractor, the thing for which the contractor is being paid is the production of the design for the use of the person commissioning the design.

2.646 Much contemporary design is produced with the assistance of computers. The question arises whether it can be said that there is an author or creator who is entitled to legal protection in respect of designs generated with the assistance of a computer. One approach to this question is to treat the computer like any other tool which may be used by a designer to assist in the process of generating a design. On this basis, the person who is responsible for manipulating the computer's capacity to produce a design would be considered to be the author of the design. A provision to this effect is to be found in Section 214(2) of the Copyright, Designs and Patents Act 1988, of the United Kingdom which provides:

"In the case of a computer-generated design the person by whom the arrangements necessary for the creation of the design are undertaken shall be taken to be the designer."

Acquisition of Rights

Registration

2.647 Industrial design protection is usually granted pursuant to a procedure for the registration of such designs. The most commonly adopted examination system provides for a formal examination only of an application for a registered design. According to this system, an application is examined to ensure that it meets with each of the formal requirements for an application which are imposed by the relevant law (for example, whether the requisite number of representations or specimens of the design are filed with the application), but no search is made of the prior art to determine whether the substantive criterion of novelty or originality is satisfied by the design for which registration is sought.

2.648 A system requiring only formal examination has the effect of shifting the burden of assessing novelty to those interested persons in the market who may wish to use, or who may have used, the design or a substantially similar design. Any person interested in using such a design will have the opportunity either to oppose the registration of the design for which application has been made, if the relevant law provides for an opposition procedure, or of bringing proceedings for the cancellation of a registration which it is alleged is invalid. The system thus offers a means of reducing the administrative burden of the maintenance of a system of registration of industrial designs. It also offers a solution to the problem of maintaining an adequate search file to undertake a substantive examination of the novelty of

designs. Such a search file can very often be almost impossible to maintain, since, on the basis of a condition of unqualified universal novelty, it would need to include all designs made at any time in any part of the world since the commencement of recorded history.

2.649 The alternative system of examination provides for a search of past designs and an examination of the design for which registration is sought to ascertain whether it satisfies the required condition of novelty. It necessitates the maintenance of a search file and sufficient skilled manpower to undertake the substantive examination.

Creation and Fixation

2.650 Rights in designs may, under certain laws, also be acquired by the act of creation and fixation of the design, in a document or by embodying the design in an article. These systems do not require any formal registration procedure for the acquisition of exclusive rights in the design. Examples of this system are provided by the Law of France, and the “design law” under the Copyright, Designs and Patents Act 1988, of the United Kingdom.

Nature of the Rights

2.651 The right to prevent others from exploiting an industrial design usually encompasses the exclusive right to do any of the following things for industrial or commercial purposes:

- make articles to which the design is applied or in which the design is embodied;
- import articles to which the design is applied or in which it is embodied;
- sell, hire or offer for sale any such articles.

2.652 In some laws, the exclusive rights of the proprietor also extend to preventing another from stocking any articles to which the design has been applied or in which it is embodied. While this right is sometimes considered as excessive in that it deals only with preparatory acts, it is on the other hand often included in order to facilitate the enforcement of a proprietor’s rights, since it may often be easier to locate a stock of infringing articles than to apprehend a person in the act of selling or offering for sale such articles.

2.653 As opposed to copyright, where the subject matter of the right is the work which is created by the author and which is thus defined by the author, the subject matter of the rights of the proprietor of an industrial design are defined by the design which has been registered. However, it is usual to provide that the proprietor’s rights extend not only to the unauthorized exploitation of the exact design which has been registered, but also to the unauthorized exploitation of any imitations of such a design which differ from the registered design only in immaterial respects.

Duration of Rights

2.654 The term for an industrial design right varies from country to country. The usual maximum term goes from 10 to 25 years, often divided into terms requiring the proprietor to renew the registration in order to obtain an extension of the term. The relatively short period of protection may be related to the association of designs with more general styles of fashions,

which tend to enjoy somewhat transient acceptance or success, particularly in highly fashion-conscious areas, such as clothing or footwear.

Relation to Copyright

2.655 Objects qualifying for protection under the law of industrial designs might equally well receive protection from the law of copyright. Thus, industrial designs law has relations both with copyright law and with industrial property law. Supposing a particular design embodies elements or features which are protected both by the copyright law and the industrial design law, may a creator of an industrial design claim cumulatively or simultaneously the protection of both laws? If this question is answered affirmatively, protection is cumulative.

Cumulation of protection means that the design is protected simultaneously and concurrently by both laws in the sense that the creator can invoke the protection of either or both, the copyright law or the industrial design law, as he chooses. It also means that if he has failed to obtain the protection of the industrial design law by failing to register his design, he can claim the protection of copyright law, which is available without compliance with any formality. Finally, it means that after the term of protection of the registered design expires, the creator may still have the protection of the copyright law.

2.656 But it is to be noted that cumulation must be distinguished from “co-existence.” Co-existence of protection means that the creator may choose to be protected either by the industrial design law or by the copyright law. If he has chosen the one, he can no longer invoke the other. If he has registered the industrial design, at the expiration of such registration he can no longer claim protection under the copyright law, at least for the particular application of the industrial design.

2.657 The system of cumulation of protection by the industrial design law and the copyright law exists in France and in Germany. And the system of co-existence of protection by both laws prevails in most other countries.

2.658 The difference between protection by the copyright law and protection by the industrial design law is as follows. Under the industrial design law, protection is lost unless the industrial design is registered by the applicant before publication or public use anywhere, or at least in the country where protection is claimed. Copyright in most countries subsists without formalities. Registration is not necessary. Industrial design protection endures generally for a short period of three, five, ten or fifteen years. Copyright endures in most countries for the life of the author and fifty years after his death.

2.659 The right conferred by registration of an industrial design is an absolute right in the sense that there is infringement whether or not there has been deliberate copying. There is infringement even though the infringer acted independently and without knowledge of the registered design. Under copyright law, there is infringement only in the reproduction of the work in which copyright subsists.