

mind the gap: copyright and product designs

by Josephine Inge, Principal, and Judy Wills

"[We] resembled each other like two drops of water, but we had different reflections".

Salvador Dali, *The Secret Life of Salvador Dali*

Artistic copyright and registered design rights can each provide protection for a product design but, taking a leaf from Salvador Dali, they provide different reflections. One can long survive the other, or be extinguished by it. The art is in finding the gaps and exploiting them as best you can.

This article addresses the overlap (and gaps) between what is known as "artistic copyright" and design protection. We present a series of theoretical scenarios involving some of Dali's designs to illustrate the boundaries of copyright protection for product design.

We continue the Dali theme, because Dali's work typifies that of many designers in the sense that it spans a broad range of industrial or commercial spheres (see the box). We have taken great artistic licence in relation to actual events (we made them up), timing (now) and location (Australia).

Scenario 1: copycat design when there is no design registration

Dali creates a new design for a sofa in 2007: the Mae West Lips Sofa. He has created some design drawings and a handmade wood and satin prototype but not applied to register the design.

He displays the prototype sofa at a design fair later that year and receives interest from manufacturers. As a result, the sofa is made by Vogue Manufacturer (Vogue), a high end manufacturer with a strong reputation in design, under licence from Dali. The Mae West Lips Sofa is a runaway success, with the first run of 50 sofas sold out at the product launch in 2008.

Some of Dali's designs

- (a) Furniture (the Mae West Lips Sofa);
- (b) Electrical goods (the Lobster Telephone);
- (c) Fashion (e.g. a lobster motif for "the Lobster Dress", an evening dress by Elsa Schiaparelli; the Shoe Hat also in collaboration with Schiaparelli – shaped like a high heeled shoe with the heel worn straight up and the toe tilted over the forehead);
- (d) Textiles (a fabric design for Schiaparelli featuring *trompe l'oeuil* rips and tears);
- (e) Jewellery (e.g. The Ruby Lips Pin, again inspired by Mae West's lips);
- (f) Theatrical set designs; and
- (g) Consumer goods (e.g. CHUPA CHUPS logo)

Rogue Manufacturing (Rogue) is always scouting for new designs with consumer appeal. It buys one of the Mae West Sofas, and makes drawings and measurements from it in order to copy it and make its own line of lip-shaped sofas to sell to the public.

Dali comes across Rogue's sofas. He has no design registration for his sofa design. Can he stop Rogue on the basis of copyright infringement?

Turning first to Dali's design drawings, they fall into the category of works known as "artistic works" under the *Copyright Act 1968* (s10). Therefore, assuming they are "original" and created by Dali, he will have copyright protection in his design drawings as "artistic works".

Dali may have created more than one design drawing – perhaps different perspectives and several detail drawings. Each of those drawings is potentially a separate and independent copyright work (to the extent that each is original and not a direct copy of an earlier version). In assessing whether copyright has been infringed, a critical first step is to consider – what are the copyright works and which of those works has been infringed?



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What about the handmade sofa prototype? It is an original artistic work in its own right and therefore has copyright protection independent of Dali's drawings. Therefore, Rogue's actions may have infringed copyright in one or more drawings as well as the sofa prototype.

Thus a single product design can encompass a body of copyright works, each separately protected by copyright (and indeed potentially other intellectual property (IP) rights). The copyright works recognised in law do not necessarily correspond precisely to the "thing" protected (here, a sofa). Conversely, the physical product or object (sofa) protected is often an aggregation of copyright works, each capable of being independently and separately infringed. It is important to recognise the range of possible copyright works in a single product.

Returning to Rogue's activities, the drawings and sofas it makes are 2D and 3D reproductions, respectively, of Dali's design drawings (or at least one of his drawings, but for convenience they will be referred to as drawings). Under the *Copyright Act* (s21), a 3D artistic work is reproduced if a version of the work is produced in 2D form, and *vice versa*. However, are Rogue's 2D and 3D reproductions infringing?

The *Copyright Act* provides a defence to infringement to reproduce an artistic work by embodying that work in a product if a "corresponding design" of the artistic work has already been "industrially applied" by or with the licence of the copyright owner (section 77).

In other words, if a corresponding design (namely, Vogue's sofas) of Dali's artistic works is industrially applied (50 copies made and sold) then B may have a defence that effectively excludes Dali's copyright protection in his artistic works. However, all may not be lost because the defence under s 77 does not apply if the artistic work is a "work of artistic craftsmanship".

Is Dali's sofa prototype a "work of artistic craftsmanship"? Quite likely, since it possesses aesthetic qualities and, in making his sofa prototype, Dali had significant freedom of design choice relatively unconstrained by the function or utility of the article: see *Burge v Swarbrick* [2007] HCA 17; (2007) 234 ALR 204. Therefore, assuming that Dali's sofa prototype is a work of artistic craftsmanship then copyright protection is not excluded even after industrial application of the work. Therefore, production and sales of the sofas by Vogue does not preclude copyright protection in Dali's sofa prototype.

Conclusion: Rogue's drawings and sofas infringe copyright in Dali's sofa prototype.

In relation to Dali's design drawings, they are not works of artistic craftsmanship and therefore copyright protection in the drawings was extinguished by industrial application of the design drawings to sofas made and sold by Vogue.

Conclusion: Rogue's drawings and sofas do not infringe copyright in Dali's design drawings. However, as Rogue's conduct infringes Dali's copyright in the prototype, Dali can prevent Rogue from continuing to make and sell the sofas.

Scenario 2: copycat design when there is a design registration

What if Dali had successfully registered the design in relation to articles of furniture?

Dali would have to rely on the design registration to stop Rogue from making and selling copycat sofas. All artistic works (whether a work of artistic craftsmanship or other form of artistic work) lose copyright protection upon design registration of a corresponding design. Therefore, Dali would lose copyright protection in both the drawings and the prototype.

In Australia, design protection is limited to 10 years. As a result, Dali would have no recourse under copyright or design laws to stop Rogue from making and selling copycat sofas after his design registration has expired.

Conversely, if Dali had not registered the design, he would retain copyright in the sofa prototype for life plus 70 years. The risk, however, is that if a court held that the sofa prototype is not a work of artistic craftsmanship, Dali would be left without either copyright or design protection

Some relevant definitions from the Copyright Act

What is a "corresponding design"?

The visual features of shape or configuration of an artistic work which, when embodied in a product, result in a reproduction of that work (section 74)

When has a "corresponding design" been "applied industrially"?

When it has been applied to 50 or more articles in Australia or elsewhere, or to one or more articles if the article is a thing manufactured (but not hand made) in lengths (Reg 17, *Copyright Regulations*)

"Applied to an article"

A design can be "applied to an article" by a process such as printing or embossing, or by reproducing the design on or in the article during production (Reg 17, *Copyright Regulations*)

from the day Vogue first offered its sofas for sale.

Scenario 3: the copy is not identical

Let's assume that Rogue does not make drawings of the sofa but instead makes a mould from the sofa and has it manufactured as a plastic injected bench seat. Can Rogue be stopped from selling the injection moulded version of the design?

Under copyright law

Under copyright law, an artistic work can be infringed by reproduction of the work or a substantial part of the work. The term "substantial" refers to quality rather than quantity. Whether a part is "substantial" depends on whether it is an essential part of the work – a vital or material part, even if only minor in quantity.

The injection moulded product would infringe a substantial part of Dali's artistic work, assuming that the overall appearance of Dali's work, including in shape and dimensions, is reproduced. As copyright protection in the drawings has been lost (as described in scenario 1), in order to establish infringement Dali's sofa prototype would need to be a work of artistic craftsmanship.

A key aspect of copyright protection is that there must be a causal connection between the thing copied and the copy. In other words, if Rogue had independently come up with the injection moulded design of a bench seat shaped in the form of lips (and can prove this) then Dali has no claim to copyright infringement. Copyright does not prevent independent creation of the same expression of an idea. In contrast, independent creation is not a defence to infringement of a design registration.

Under design law

Assuming Dali has a design registration for his design in relation to articles of furniture, would the registration be infringed?

Rogue's injection moulded bench seat is not identical to Dali's design. The test then becomes whether Rogue's sofa is "substantially similar in overall impression" to Dali's design. "Design" is defined in the Designs Act (s5) to mean the overall appearance of the produce resulting from one or more visual features of the product.

The comparison is made between the visual features of the allegedly infringing product and those of the design registration, not Vogue's sofa (see *LED Technologies v Elecspress* [2008] FCA 1941).

Visual features include the "shape, configuration, pattern and ornamentation of the product" but do not include the feel of the product or the materials used (s7 Designs Act).

More weight is given to similarities than differences and consideration is given to the quality and importance of similarities in the context of the design as a whole. Therefore, similarities between the shape and configuration of Rogue's sofa and those of Dali's design registration (the lip shape, positioning of various components relative to each other) would be important factors, not the differences in materials used (wood and silk versus plastic). On this basis it is likely that Dali's design registration would be infringed.

Scenario 4: print reproduction

Rogue obtains a copy of a marketing flyer distributed by Vogue at the product launch. The flyer contains a sketch of by Dali of the sofa. Rogue makes its own flyer using Vogue's flyer "as a guide" but includes a copy of Dali's sketch. Rogue has infringed copyright in Dali's sketch by reproducing it in a flyer: see *Caroma Industries Ltd v Technicon Industries Pty Ltd* [2008] FCA 1465.

Assuming Dali's sketch for the flyer was a separate sketch made for marketing purposes to his design drawings, this is a separate artistic work with copyright protection independent of the design sketches and prototype. Therefore, copyright in Dali's sketch is not extinguished by his design registration and Rogue's flyer infringes Dali's copyright.

Scenario 5: registration of a 2D design

In collaboration with a fashion designer, Dali creates a *trompe l'oeuil* painting as a fabric design which is printed on fabric and used to create an evening gown. Betty sees the design and copies it for use as a pattern on wallpaper as well as a print for t-shirts.

Assume the design is registered in relation to textile fabrics and garments. The design registrations would not prevent use on wallpaper. However, as the registered designs are purely representations of two-dimensional features, they are not "corresponding designs" under s74 of the Copyright Act (that is, they do not include any visual features of shape or configuration embodied in a product). Therefore, the design registrations do not limit copyright in Dali's artistic work (the original *trompe l'oeuil* painting) and Betty's actions will infringe both copyright and the design registration in relation to garments.

A final word

*"There is only one difference between a madman and me.
I am not mad."
Salvador Dali, Diary of a Genius*