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Overview of Developments in Europe on Industrial Design Protection[†]

Hugh Griffiths*

Ladies and gentlemen, I would like to say that I am very honored to have been asked to say something to you about one of the remaining areas of intellectual property protection that has not been mentioned in the last few days. What is it? Is it a patent? Is it a trademark? Is it a copyright? No, it's a design!

Now, this sums up, a little lightheartedly, the situation in which design protection finds itself. I think it's in a sort of gray area, between the areas covered by the other major rights. However, it also spreads into the rights that we have already heard about insofar as some of the products that will be covered by patents will also be covered perhaps by designs.

What I perhaps should establish, first of all, is that a design such as I am going to speak about concerns the appearance of a product. Now, there are different interpretations of how this appearance should be considered. In some countries they require aesthetic criteria; in other countries they have other criteria.

But appearance does, of course, touch upon copyrights. The scarves and the neckties that you are wearing very probably are protectable as designs, but clearly they include some artistic content that may be copyrightable. The contents of that microphone over there undoubtedly will contain patentable products inside it, but the actual appearance of it, the shape of it, the way it feels in your hand, may well persuade you to buy that one rather than another one because it looks nicer and that's why you prefer it; so that's

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protectable by design. The motor car you buy, you buy bearing in mind the engine capacity, how fast it will go, how big your family is, and so on. You would also be concerned about how it looks, and so designs will protect the appearance of the motor car. They will also protect the parts of the motor car that have to be replaced when it runs into another motor car, the crash parts. There, within two minutes, I have raised a nice, contentious point that I'll move on quickly from because we will come back to it perhaps a little later on.

One small comment I will make about myself—without going into my *C.V.*—I am on a secondment to the Commission of the European Communities (“Commission”) at the present time, which means that I am employed by the Department of Trade and Industry in London, the Patent Office in particular, and I have been working for a year with the Commission on a loan basis. Therefore, I have to make it clear that what I am saying to you now is my own view and does not necessarily express the official view of the Commission nor of the U.K. administration.

First, I should explain why the Commission is doing something about designs. I think the first question that we have to ask, therefore, is: How many different designs laws are there in the countries of the European Community (“Community”) at present? Here we have a situation where, even if designs are not in some eyes considered as economically valuable as patents and copyrights and so on, nevertheless, even within the confines of the Community, the actual disparate nature of the laws is greater in the design area than it has been in virtually any of the other areas.

There are almost as many laws as there are countries in the Community. Admittedly, there are some similarities between them, but there are significant differences. For a body intended to be an economic community with a minimum of trade barriers between its members, it is clearly desirable to have as uniform as possible a practice in the area of intellectual property laws and designs, in particular. This is the subject I will speak about.

So what do they have in common? Well, first of all, Greece does not have a specific design protection law. Of the other eleven Member States, Belgium, the Netherlands, and Luxembourg have

formed a joint Benelux design protection law;¹ which, therefore, leaves another eight individual Member States each of whom has its own law. Therefore, there are about nine different design protection laws in the Community alone—and I'm not even speaking about the other countries of the European continent.

The first element that these have in common, I think, is the facility for registration of a design in a public register. This mechanism perhaps has more in common with the provisions which exist widely for industrial property protection of the patent-kind than with the copyright approach which applies to original artistic creations and which to some extent might be considered to arise in connection with the artistic aspects of industrial designs. However, the reasons for preferring a registration system are centered on the greater legal certainty that this is perceived to give to the protection.

However, it is, in my opinion, a largely illusory confidence. There can rarely be any justified assumption of the validity as a result of registration because in some Member States there is no examination of substance, as to whether the requirements for protection are met, prior to registration. Even where there is an examination, the nature of any search is usually so limited in scope, either on a geographical basis or a time basis, or the examination is so cursory, that no degree of certainty can really be placed on it.

So, that was the first common feature of the nine sets of different designs laws in the Community. Let's look at the second one—or perhaps, I should say, let us look for a second one, because I haven't actually managed to find one yet.

There are some similarities between some of the countries. In the France, Germany, Italy, Spain, and the Benelux countries, multiple deposits are allowed; but this is not the case in the United Kingdom and some of the Member States. Some carry out preliminary search and examination of the novelty requirements, such as the rather limited one in the United Kingdom;² others do not. In

1. Uniform Benelux Designs Law, effective Jan. 1, 1975, Benelux Designs Convention, Oct. 25, 1966.

2. See, e.g., Copyright, Designs and Patents Act, 1988, 2 Eliz. 2, ch. 48, § 213 (U.K.)

some there is an opposition procedure prior to registration, while others proceed directly to registration, leaving validity to be tested in the courts. And so it goes on.

Substantive aspects of the laws also vary in different Member States. Here, there is even more variation between the Member States. First of all, one can say that all nine of the different sets of rules in the Community do at least require that a design be new. So, here at least we have one common feature of the legislation on substantive provisions. Well, actually, we do not because the concept of "new" differs between one Member State and another. While the majority do require objective criteria of novelty, there are some such as France,³ and possibly Spain—judging by some of the case law—which have a rather subjective, novelty approach, making the notion of novelty rather similar to that of originality. That is a concept that is so associated with copyright that it is dangerous to try to get too involved with that in the designs area.

The objective novelty countries themselves even differ from one another as to the qualifications to which this notion is subject. In Ireland,⁴ Benelux, and the United Kingdom, there are limitations in space; the design has to be new in the State concerned. In Denmark⁵ and Portugal,⁶ there is a time criterion; the design is deemed to be new if no identical form has been used or protected since a certain point in the past. In Benelux and Germany,⁷ a design is not new if it is known to the national circles specialized in the relevant sector, which is an interesting concept.

Now, an additional criterion to novelty is also required in some of the Community Countries. It must be "original" in the United

(amending Registered Designs Act, 1949, 12, 13 & 24 Geo. 5, ch. 46) [hereinafter English Design Laws].

3. Law on Designs and Models, July 14, 1909, (Fr.) *as amended by decree*, Apr. 24, 1980.

4. Industrial and Commercial Property Act, May 20, 1927 (Ir.).

5. Denmark Designs Act, May 27, 1970 (Den.), *reprinted in* 10 *INDUS. PROP.* 223-40 (1970) (English version).

6. Provisions on Designs, Industrial Property Code Decree No. 30.679 promulgating the *Codigo da Proprieda Industrial*, Aug. 24, 1940 (Port.).

7. Order on Industrial Designs, Jan. 17, 1974 (G.D.R.) *CM.* 11, § 6(2)(ii), *reprinted in* 14 *INDUS. PROP.* 144-45 (1975) (English version).

Kingdom and Ireland in the sense that it differs in more than immaterial details or common variants. It must have "physionomie propre" (own appearance) in France; it must give the product a "special ornament" in Italy;⁸ and in Germany, it must have what is called "eigentumlichkeit" (individual character), implying some creative effort on the part of the designer.

Whatever the complexities of these various notions, I think there is in general a common goal. They represent some kind of effort to ensure that a new design, before it can merit protection, must demonstrate some kind of significant difference over the prior art, not merely novelty, but something which makes it stand out a little from other similar designs in that area; something that makes you want to buy this one rather than that one.

Then there is the term of protection, another area of considerable difference. This varies from ten years in Spain;⁹ fifteen years in Benelux, Denmark, Ireland, and Italy; twenty years in Germany; twenty-five years in the United Kingdom; fifty years in France; and nobody quite knows in Portugal, but it seems to be more or less indefinite.

One more difference which may be worth mentioning at this point is the wholly new design protection in the United Kingdom. I don't think time permits me to give you much of a rundown on that. In addition to the established registration system for protecting industrial designs having aesthetic appeal, it also introduced in its 1988 legislation an unregistered system for the protection of two- and three-dimensional articles, functional or not, with no aesthetic requirement.¹⁰ This lasts for fifteen years, which for practical purposes is in fact ten years. I won't go into the details. It is a right against reproduction and is not a monopoly right. In a sense, it covers those articles which might otherwise have qualified for a petty patent or utility model protection in those administrations which have such systems.

8. Design Statute, Royal Decree No. 1411, Aug. 25, 1940, *as last amended*, June 22, 1979, tit. III, art. 5 (Italy).

9. Registro de la Propiedad Industrial, Madrid, 1951, Clt. I, art. 29 (Spain).

10. See English Design Laws, *supra* note 2, § 216.

Just a word on copyright protection for designs in the countries of the Community. France gives a high degree of protection under its copyright laws to designs. The Berne Convention, to which all Member States are party, gives us much freedom as to how works of applied art, industrial designs, and models may be protected.¹¹ Of course, works of applied art might well be expected to overlap with the concept of design. In the absence of definition, it is open to the owner of a registered design to obtain protection also by invoking a copyright in that same design. The possibility of this so-called "cumulation" is common to at least ten of the Member States, although the conditions under which it applies do vary considerably. The situation is different in Greece¹² and Italy. France has the highest level of cumulation between copyright and specific design protection. Others have a very low level.

By this stage, I hope that you will have a fairly clear picture of why we feel action is necessary by the Community to do something about these disparate laws. The reason is not merely to provide a cosmetic solution by replacing a multiplicity of individual laws with one single law because it would be neat and tidy to do so. There are a number of very important reasons for doing it.

First, of course, it has to be said that the designers themselves have increasingly complained to us about the complexity and cost of securing protection in the first instance for their designs under all these different regimes. Additionally, the problems of enforcement of their design rights once they have achieved them, and the pursuit of infringers, is even more difficult.

During my period in the U.K. Patent Office, I used to get a lot of inquiries from hopeful designers asking how they should go about protecting their designs in the United Kingdom. So, I would tell them. They would say, "Okay. Now I can market in Europe and the world, can I?" I'd say, "No. You have to now apply for

11. Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, *as last revised*, Paris, July 24, 1971, 828 U.N.T.S. 221.

12. Greece has no national law which protects industrial design. However, Greece has ratified the Paris revision of the Berne Convention which invokes copyright protection in such a situation.

another design protection in the European countries.” “Just one?” “Oh, no, there will be as many—more or less—as there are countries.” Then, having heard all this, they would feel pretty upset by what I had told them. Of course, I knew that they were then going to discover even more complications and expenses when they had to go to their attorneys to have these applications processed. In such august company, I won’t say where those expenses arise (!), but clearly it gets very expensive using a separate attorney to process an application in each one of the Member States.

Then, perhaps most importantly, there is the effect of the EEC Treaty¹³ and Articles 30 to 36 concerning trade in the Community. The effect of these Articles is that there should not be barriers to trade between the Member States of the Community, and there should not arise at the border of any Member State anything which gets in the way of trade and openness of trade.

Now, there is an exception under Article 36 for certain situations. One of those is the protection of industrial property. So, it is possible for intellectual property rights to be used at the borders in certain situations to control the flow of goods.

This applies, in particular, in the case where the rights in different countries are in the hands, for example, of different owners where there is no economic link between these owners. This is one of the problems with all the disparate laws we have in the Community, because they give quite separate rights. Even if they were harmonized, you would have a separate right that could be in the hands of different owners in the different Member States of the Community.

The effects of this, for intellectual property rights to act in a way which implies some limitation on the provisions of the EEC Treaty concerning freedom of movement of goods, are likely to be fairly small, in my opinion, in the area of patents and trademarks, where a substantial measure of harmonization of national legislation has already been achieved either directly or indirectly. I’m

13. Treaty Establishing the European Economic Community, Mar. 25, 1957, 298 U.N.T.S. 11 (1958), *amended by* Single European Act, O.J. L 169/1 (1987), [1987] 2 C.M.L.R. 741.

thinking of the European Patent Convention¹⁴ and the Community Directive harmonizing trademark laws,¹⁵ of which you have heard something already. There is also a prospective Community patent¹⁶ and Community trademark,¹⁷ of course. However, in the case of industrial designs, this clause of Article 36 could continue to be called into play really rather more frequently than is desirable because of the disparate nature of these laws.

There are a number of other reasons which I won't go into at this stage because I want to have time to tell you a little about what the Community is considering doing to resolve these problems. These are, however, at least some of the reasons why we feel we need to do something.

To meet the perceived needs of the industrial designers, a Green Paper was produced.¹⁸ I have a copy of it here. It's in a nice lilac color. I learned with some interest when I joined the Community that the reason for the Green Paper being lilac is that I have an English copy. In case you haven't thought about this, most of the countries of the Community speak different languages, so most of the official documents have to be produced in all of those languages. There is color coding. English is the lilac one. So my Green Paper is a nice shade of lilac.

Before this appeared, some of the formative work and discussion were done by a helpful degree of collaboration between some of my colleagues at the Commission and members of the Max Planck Institute. I'm not saying that the Institute produced this document, but I think they played a very helpful part in the formative work leading up to it.

The Green Paper proposed a number of things. Firstly, a regu-

14. Convention on the Grant of European Patents, Oct. 5, 1973, Munich, 13 I.L.M. 270.

15. First Council Directive of 21 December 1988 to Approximate the Laws of the Member States Relating to Trade Marks, 89/104/EEC, O.J. L 40/1 (1989).

16. Agreement Relating to Community Patents, O.J. L 401/1 (1989).

17. Amended Proposal for a Council Regulation on the Community Trade Mark, EUR. PARL. DOC. EEC(91)4595 draft (PI 10).

18. Commission of the European Communities, Green Paper on the Legal Protection of Industrial Designs, III/F/5131/91-EN (June 1991).

lation setting up a unitary Community design. Now, what are the advantages of a regulation as opposed to a directive? A directive is a legal instrument which has to be brought into effect in the Member States by the national administrations legislating appropriately. A regulation, however, is something which has direct effect in all of the countries of the Community.

Now, the reason for proposing a regulation in connection with designs is that it would generate an autonomous Community design legislation rather along the lines of a Community trademark, about which you have already heard. This would be developed with greater freedom than any changes to be introduced into existing national legislation. It would produce a Community design right which is directly applicable in each Member State, and it would create a Community design authority, to be called the Community Designs Office, whereby designers would be able to obtain through one application in one office in accordance with a single procedure under one law a unitary right encompassing all the Member States of the Community. I make no apologies for laboring that point as that is really what matters to us, having a single system to replace all the disparate ones.

In addition, it proposes that we should consider a directive harmonizing national laws. Now, why should that also be necessary? Well, for much the same reasons why it is necessary in the trademark field, to harmonize national laws with the regulation, or with what is proposed in the regulation; otherwise, there would be a tendency for a designer to pick and choose perhaps which suits him or her best between this national law, that national law, and the Community law. This would run counter to the objective of a simpler, consistent overall system.

Second, it would harmonize the national laws with one another. There is no overwhelming reason for the Community to interfere in Member States' affairs so far as to insist that their national laws should be scrapped when the Community design law comes into operation, but they do need to be aligned sufficiently to avoid problems of the kind I mentioned earlier. It is hoped that, nevertheless, as the Community design becomes established, the national laws would be reduced considerably in significance.

It must be remembered, however, that, on its own, a directive would not solve this problem of rights being exercisable separately in different Member States. In the hands of different owners having no economic links, there would still be the risk of conflicts at borders. That is a reason why one has to bear in mind the importance of a regulation. It is, therefore, the Regulation that I shall direct my attention to rather than the Directive. The substantive provisions within the Directive, while much shorter, mirror those of the Regulation. However, the Regulation goes on and says a lot more about how the system would work in the European context.

Now, at the time of the Green Paper, a number of industries, particularly those from countries where a copyright regime plays a major role in the protection of designs, made it clear that they thought the ideal solution would be a copyright protection of some kind. It would be long-lasting, automatic, no formalities, and no fees.

However, against this, one would have to set the interests of competing designers. They, after all, would be faced with extensive exclusion from a market on the basis of a right which exists primarily for literary and artistic works. For such works the protection is really only against unauthorized reproduction; it's not a monopoly right. It is the proposal here to provide a monopoly right of some kind.

The protection is limited in the case of a copyright, of course, to the expression of the idea of the author or the conception of the artist. Such protection does not exist in the item itself, and there are no constraints therefore on the freedom of the creator.

However, for a designer working in the field of industrial articles often having functional purposes or attributes, and often with a low or even zero aesthetic content in some cases, there needs to be some restriction on the nature of the protection, taking into account the probably more limited extent to which a designer can exercise his creativity. The designer is to some extent constrained by needing to meet criteria in order that the product he has been asked to design will fulfill its intended purposes.

Admittedly, some Member States which do allow a limited use

of copyright to protect designs do so by modifying the originality criterion, and perhaps by raising the threshold of that originality criterion. But we feel that going down that road would generate a lot of its own difficulties for the Community as a whole, for example, harmonizing the originality criterion could be extremely difficult.

In this situation, therefore, it is proposed to create a specific design protection law. This would provide a system for registration giving a monopoly-type of right. At this stage, I will go fairly quickly through what it is going to provide, and then if you wish to ask questions about it, that will be the time to do so.

The parameters of the specific design protection law are fairly self-evident: it should provide for registration. It should provide for the requirement of the existence of novelty.

It also needs to provide for the making of multiple applications, to help those who produce designs in areas of products where there is a family of similar articles, as happens frequently in textiles, fashions, and shoes, to make a multiple application. They might file for a hundred designs in one application. This would enable them to then wait and see which designs prove to be the most successful in the market and then follow up that with full prosecution of the registered design.

Deferred publication has been requested by a number of industries, including both motor cars and textiles. That would, I think, be something we need to provide for. Duration should be standardized. Challenge to validity should be readily available, particularly as it is not intended that there should be any examination system, as such, in the Community design.

It is also proposed that there should be an unregistered right. Now, why should we have that? Well, a number of sectors of industry dealing with short-lived products—again, in fashions and textiles—have said that the bureaucracy that goes with registering a design is not something they have time for in fast-moving products; and, equally, by the time they got the protection it's probably too late because their product is now out of fashion. So, short-term unregistered right providing an automatic protection against copy-

ing only is something which it is felt should be provided for.

Therefore, in the proposed Community system we aim to meet these requirements. First of all, in the definition of "design," we try to set out what it is we're protecting. I have said a little about this. It is the appearance of a product. I don't want to belabor this point any longer. We make no aesthetic criteria, but we do make certain exclusions. We exclude functionally dictated designs because if the designer sets out to solve a functional problem where there is only one possible solution to that problem, then there really is no design freedom and there should be no protection. That is an exclusion which I think exists in many industrial design protection laws already.

There should also be an exclusion for what is called "must fit" designs. The "must fit" exception is a colloquialism invented in the United Kingdom to explain those articles whose shape and configuration is constrained wholly by the need for that article to fit to another article, either by nuts and bolts, or by screws and threads, or in some other way. Again, very similar to functionally dictated designs, there is no real freedom for the designer to operate and there should be no protection.

However, for motor car parts it gets a little more difficult. Clearly, there are parts of a motor car which are constrained by the way they have to fit with the rest of the car. But, in addition, it is important that the shape of the new wing on your motor car, that has to replace the one that has a dent in it, look the same as the one on the other side. There is a provision now in the U.K. law which colloquially is called the "must match" exception.¹⁹ You cannot get design protection for a design constrained by its need to match the shape of the rest of the complex object of which it forms a part.

That is an area in which the Commission is carefully considering which way to go. Let me say that this is an area where we have had representations from all sides of industry—not only the motor car industry, but clearly that is the most significant area. It

19. See English Design Laws, *supra* note 2, ch. 48, § 1(1)(b)(i).

would be very sad for us if the sort of pressure that has been brought to bear, I believe, in connection with the U.S. design bill by those who would seek to avoid protection for motor car crash parts should cause our proposal to founder. I say that because, if it founders, we are back to this chaotic state of a vast number of individual laws which we find it difficult to cope with.

We are working very hard to find a way—if it can be found—of resolving this difficulty, of how to provide design protection for the designer of a motor car, but also to find ways of freeing up competition for the provision of crash parts and of making it possible for consumers and insurers to replace and repair a part or an article on a composite product such as a motor car with articles of their choice. So we have a difficult balancing act to perform here. I can assure you we are doing it. We are quite clear that the time has come to arrive at some sort of summary of our position to put before the Commission for its consideration soon.

