
5. The protection of cultural heritage by designs

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This chapter examines the (potential) role of design law for the protection of cultural heritage (CH). While the intersection of CH with other intellectual property rights (IPRs) is relatively well researched,¹ the literature on the usefulness (or its lack) of design law for protecting CH has not been thoroughly explored.² This chapter seeks to partially close this gap. One difficulty in exploring the relation between design law and CH as a protective regime is that both, designs and CH, are broad notions that encompass a variety of subject matter. An initial definition should therefore serve to limit the scope of our analysis.

The term ‘cultural heritage’ is as loaded as it is broad.³ Its definition depends on the circumstances and the context in which it is being used. Nonetheless, for the purposes of the discussion in the present chapter, we will limit ourselves, in order to sharpen the focus, on ‘intangible cultural heritage’ (ICH) as one important aspect of the larger field of CH. The notion of ICH is quite far-reaching in itself – it encompasses elements of folklore, traditional knowledge, and indigenous cultural expressions.⁴ These concepts can be distinguished from ‘cultural

¹ See for example the relevant chapters in Heath & Sanders (eds) *New Frontiers of Intellectual Property Law. IP and Cultural Heritage – Geographical Indications – Enforcement – Overprotection* (Hart Publishing 2005); the topic has also found attention in general collections on cultural heritage, see e.g., Mira Burri, ‘Cultural Heritage and Intellectual Property’, in: Francesco Francioni & Ana Filipa Vrdoljak (eds), *The Oxford Handbook of International Cultural Heritage Law* (Oxford University Press 2020), specific copyright-related aspects have been addressed comprehensively in Derclaye (ed) *Copyright and Cultural Heritage* (Edward Elgar 2010) and Michal Koščik & Matěj Myška, ‘Copyright law challenges of preservation of “born-digital” digital content as cultural heritage’ [2019] *European Journal of Law and Technology* 48; see on the propertization of indigenous cultural heritage: Kristen A. Carpenter, Sonia K. Katyal, & Angela R. Riley, ‘In Defense of Property’ [2009] *Yale Law Journal* 1022, replying is Michael F. Brown, ‘Culture, Property, and Peoplehood: A Comment on Carpenter, Katyal, and Riley’s “In Defense of Property”’ [2010] *International Journal of Cultural Property* 569.

² Writing mainly from an Australian perspective, Sainsbury makes an important contribution, see Maree Sainsbury, ‘Indigenous cultural expression and registered designs’, in: Matthew Rimmer (ed), *Indigenous Intellectual Property* (Edward Elgar 2015); see further covering developments at international level: Margo A Bagley, *Illegal Designs? Enhancing Cultural and Genetic Resource Protection through Design Law*, (2017) CIGI Paper No. 155, available at: <https://www.cigionline.org/publications/illegal-designs-enhancing-cultural-and-genetic-resource-protection-through-design-law/>.

³ See on the complex nature of the term: ‘Introduction’, in: Francesco Francioni & Ana Filipa Vrdoljak (eds), *The Oxford Handbook of International Cultural Heritage Law* (Oxford University Press 2020).

⁴ These concepts that constitute a definition of ICH are not defined at international level (see e.g., with a brief overview and an attempt to define ‘traditional cultural expressions’ as part of intangible cultural heritage: Lily Martinet, ‘Traditional Cultural Expressions and International Intellectual Property Law’ [2019] *International Journal of Legal Information* 6, 1–9, see also Burri (n 1), 460 et seq.; Fiona Macmillan, ‘Contemporary Intangible Cultural Heritage: Between Community and Market’, in: Charlotte Waelde, Catherine Cummings, Mathilde Pavis, & Helena Enright (eds), *Research Handbook on Contemporary Intangible Cultural Heritage* (Edward Elgar 2018). Some of the terms are used interchangeably in the relevant literature, see for further examples of definitory delimitations e.g., Patricia

heritage’, as defined in the 1972 Convention Concerning the Protection of the World Cultural and Natural Heritage (WHC)⁵ by their lack of physicality. While the former considers cultural heritage to cover monuments, groups of buildings and sites,⁶ or natural features, geological, any physiographical formations and natural sites,⁷ the 2003 Convention for the Safeguarding of the Intangible Cultural Heritage (ICHC)⁸ defines ICH as “the practices, representations, expressions, knowledge, skills (...) that communities, groups and, in some cases, individuals recognize as part of their cultural heritage.”⁹ ICH is characterized by its intergenerational transmission, constant contextual re-creation and its importance for the identity of groups and communities.¹⁰ Examples of ICH provided in the Convention are oral traditions and expressions, performing arts, social practices, rituals and festive events, knowledge and practices concerning nature and the universe, and traditional craftsmanship.¹¹

The other object of our examination are industrial designs. Industrial designs are part of the larger family of intellectual property rights, which are exclusive rights granted to individuals, usually the inventor, author or creator. Design rights protect “the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials”¹² of a product. The design must therefore be part of a product, which is itself a broad notion, including handicraft items.¹³ Examples of cultural heritage that will most likely qualify, in principle, for design rights are rug pattern of the Navajo Nation,¹⁴ jewelry designs,¹⁵ or Māori tattoo patterns.¹⁶ These examples fall squarely into the definition of ‘intangible cultural heritage’ as per Article 2 ICHC. The Convention expressly recognized traditional craftsmanship as a domain in which intellectual cultural heritage manifest itself.¹⁷

L. Judd, ‘The Difficulties of Harmonizing Legal Protections for Traditional Knowledge and Intellectual Property’ [2019] *Washburn Law Journal* 249, 252–255.

⁵ UN Educational, Scientific and Cultural Organisation (UNESCO), *Convention Concerning the Protection of the World Cultural and Natural Heritage*, 16 November 1972.

⁶ Article 1 WHC.

⁷ Article 2 WHC.

⁸ UNESCO, *Convention for the Safeguarding of the Intangible Cultural Heritage*, 17 October 2003.

⁹ Article 2 ICHC.

¹⁰ Cf Article 1 ICHC, cf. also the definition of Martinet, who identifies three key characteristics that define traditional cultural expressions: (i) a cultural content, (ii) a collective essence, and (iii) intergenerational transmission (Martinet (n 4), 9).

¹¹ Article 2 (a)–(e) ICH Convention.

¹² Article 3(a) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, *OJ L 3, 5.1.2002, p. 1–24 (CDR)*; although the Regulation has been updated in 2006 to reflect changes due to the EU’s accession to the Geneva Act of the Hague Agreement concerning the international registration of industrial designs, other than for trademarks, the European design tile has not been renamed into EU design, see Council Regulation (EC) No 1891/2006 of 18 December 2006 amending Regulations (EC) No 6/2002 and (EC) No 40/94 to give effect to the accession of the European Community to the Geneva Act of the Hague Agreement concerning the international registration of industrial designs, *OJ L 386, 29.12.2006, p. 14–16*.

¹³ The term ‘product’ is defined in Article 3(b) of the CDR as “any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs.”

¹⁴ Brown (n 1), 573.

¹⁵ Sainsbury (n 2), 236.

¹⁶ Martinet (n 4), 9.

¹⁷ Article 2(2)(e).

Although specific intellectual property rights could protect larger groups,¹⁸ traditionally protection is granted to individuals or smaller teams.¹⁹ Even when rights are provided for a larger group of individuals, protection is not granted because of the individual effort of individual members of a community, but, for example in the case of geographic indications, because specific individuals produce products in a specifically defined manner and/or in a specific region and are therefore allowed to market their products under a specific sign or name.²⁰

The protection offered under industrial design law could, in principle, be particularly relevant for traditional craftsmanship, but also to elements of social practices, festive events and artistic expressions that include some sort of physical representation of shapes, forms and patterns. This is due to the fact that design law protects the appearance of ‘products’ or items in their aesthetic dimension.²¹

The basic tension in design law exists between the rightholder and third parties. On the one side, the rightholder enjoys an area of exclusivity in relation to a specific design and, on the other side, the public (domain) has an interest in developing new designs free from restraints.²² Besides, there is a further layer of complexity stemming from the specific nature of CH – usually, CH and the interests it reflects are further detached from the largely economic interests that drive intellectual property rights.²³ Indeed, CH triggers communal, societal and cultural, possibly religious and spiritual, interests that are representative of communal identities, which are interests that are not supported by the major IPRs, and certainly design rights do not serve to promote communal interests of a non-commercial nature.²⁴

As a result, clear difficulties emerge when analyzing the design/ICH intersection. On the one hand, protection can be difficult to obtain for the communities concerned. The requirements for protection, as will be demonstrated below, are difficult to fulfill in relation to subject matter that lacks a clear creator (or designer in this case) and which ‘has been around’ for centuries. ICH is usually the outcome of an intergenerational process attached to the membership of a group or community in which no single individual has contributed to the creation of a specific cultural expression.²⁵ On the other hand, cultural heritage should be protected against misappropriation for commercial or other purposes that could offend or in other ways

¹⁸ For example, the EU certification and collective marks safeguard the interests of larger groups. The former indicate that goods and services meet certain specific characteristics listed in a regulation of use, while the latter ensures that goods and services protected by the mark in question originate from members of an association.

¹⁹ Cf. The Protection of Traditional Knowledge: Updated Draft Gap Analysis, WIPO/GRTKF/IC/39/6, 16 January 2019, 24.

²⁰ See the definition of EU certification marks in Article 83 and of collective marks in Article 74 of Regulation (EU) 2017/1001 on the European Union trademark, *OJ L 154, 16.6.2017, p. 1–99*.

²¹ Cf. Graham Dutfield & Suthersanen, Uma, *Dutfield and Suthersanen on Global Intellectual Property Law* (Edward Elgar Publishing 2020), 250.

²² Cf. Bernard Volken, ‘Requirements for Design Protection: Global Commonalities’, in: Henning Hartwig (ed), *Research Handbook on Design Law* (Edward Elgar Publishing 2021), 4.

²³ Cf. Burri (n 1), 481.

²⁴ See Justin Hughes, ‘Traditional Knowledge, Cultural Expression, and the Siren’s Call of Property’ [2012] *San Diego Law Review* 1215 on justifications for TK and TCE in relation to intellectual property justifications.

²⁵ Cf. The Protection of Traditional Knowledge: Updated Draft Gap Analysis, WIPO/GRTKF/IC/39/6, 16 January 2019, 24–25.

create a feeling of discomfort among the members of the community that claim rights, of whatever nature, over the cultural heritage concerned.

In this chapter, we seek to highlight the central problems stemming from the intersection between ICT and design law, but also explore potential ways forward. We will rely on the EU legal framework for design protection, in particular the Community Design Regulation. ~~We will make references to national design regimes where appropriate to draw attention to diverging features that can impact on the design/ICH interface.~~ The first part of this chapter introduces two central notions – ‘defensive and positive protection of ICH.’ These will serve as stepping-stones for the analysis in the next sections, both in terms of protecting ICH with design law, but also with respect to preventing others from appropriating ICH in design applications. We then turn to the international and EU legal frameworks behind design law by focusing on the scope of design protection by reference to its main requirements – novelty and individual character. The analysis here is tied to the implications for ICH. One crucial aspect is the assessment of designs against public policy and morality grounds. While this has received little attention, by drawing parallels to trademark law, we make the argument that national and EU offices should make better use of the public policy ground in order to safeguard the interest of ICH communities. This way forward becomes even more pertinent in view of the problems of protecting ICH with design rights, i.e., protecting collective expression is not the aim of design law, which reflects economic end goals.

DEFENSIVE AND POSITIVE PROTECTION OF ICH

‘Protecting’ ICH through design law can take two forms – a positive and a negative one.²⁶ On the one side, traditional cultural expressions that fulfill the relevant subsistence requirements could come within the scope of protection of national or regional design rights. Through positive protection, a particular ICH can be granted a design right and the owners of this right or title would then be able to enforce this right against third parties using the protected subject matter (e.g., a specific tattoo design). On the other side, indigenous communities can be protected against the abuse of ICH by denying cultural expressions the protection under design law while such communities would not directly benefit from denying protection to cultural expressions that are considered part of ICH, the danger of facing legal claims based on design rights by third parties for the use of their cultural heritage can cause significant inconvenience. Defensive protection can be exercised by a registering body when a design right is initially applied for, or in invalidity proceedings after a design has already been registered.

In principle, ICH can be protected by intellectual property regimes, provided that the relevant conditions for protection are fulfilled. However, the specific nature of ICH makes it difficult to obtain protection, especially since most IPRs, such as the Community design right, require as one of their protection requirements some form of novelty or originality, or, in other words, they must be different in relation to prior creations. Cultural heritage, its protection and its conservation pursue somewhat different goals. Protecting ICH does not mean granting exclusivity to incentivize new creativity or inventions, but the (perpetual) protection of old,

²⁶ This distinction is equally applicable for other IPRs, see e.g., (Xanthaki, Valkonen, Heinämäki, & Nuorgam (eds) *Indigenous Peoples’ Cultural Heritage* (Brill – Nijhoff 2017), 220–221).

even ancient creations and expressions against use and abuse.²⁷ An aspiration to protect ICH through traditional IPRs would therefore likely fail because existing cultural expressions, practiced and conserved over generations, would most likely not meet the relevant subsistence criteria and protection under the relevant IP regime and would be limited by the applicable term of protection.

International conventions do not envisage any specific IPR for ICH or one of its related sub-concepts. The United Nations Declaration on the Rights of Indigenous Peoples²⁸ merely provides that indigenous people have the right to “maintain, control, protect and develop their intellectual property over such cultural heritage, traditional knowledge, and traditional cultural expressions.”²⁹ The right to protect and develop intellectual property reflects an active approach to IP protection of ICH that provides indigenous or other cultural communities and societies with exclusive rights over their cultural heritage. Attempts at international level to develop an effective legal instrument in this respect have, so far, been unsuccessful.³⁰ To avoid that the protection of ICH is undermined by third parties that are not members of indigenous communities, the 2019 Draft Articles on the Protection of Traditional Cultural Expression (TCE)³¹ foresee that the erroneous grant of intellectual property over TCEs should be avoided.³² In regards to TCEs, at WIPO’s 37th session it was suggested to investigate an option for their defensive protection, without, however, making concrete proposals.³³

The WIPO Gap Analysis on the Protection of Traditional Cultural Expressions acknowledges that parallels exist in relation to the active protection of TCEs, and therefore also ICH, between literary and artistic productions³⁴ and industrial designs. While more recent creations can, in principle, be protected as long as the substantive protection requirements are fulfilled, older designs “from the distant past” would not qualify for protection.³⁵ Similar concerns have been raised in the Gap Analysis on the Protection of Traditional Knowledge, though design protection is deemed less relevant in this regard.³⁶ Both documents refer to discussion in the

²⁷ See on this differentiation Stephen R. Munzer & Kai Raustiala, ‘The Uneasy Case for Intellectual Property Rights in Traditional Knowledge’ [2009] *Cardozo Arts & Entertainment Law Journal* 37, 47; Judd (n 4), 255–256.

²⁸ United Nations Declaration on the Rights of Indigenous Peoples, 13 September 2007 (UNDRIP).

²⁹ Article 31(1) United Nations Declaration on the Rights of Indigenous Peoples.

³⁰ Cf. Johanna Gibson & Bernd Justin Jütte, ‘The EU Stance in International Matters’, in: Irini Stamatoudi & Paul Torremans (eds), *EU Copyright Law* (Edward Elgar 2021), paras. 26.49–26.56.

³¹ WIPO, The Protection of Traditional Cultural Expressions: Draft Articles, WIPO/GRTKF/IC/40/5, 9 April 2019 (hereinafter the *TCE Draft Articles*)

³² The 2019 *TCE Draft Articles* list three alternative formulations for “Article 2 Objectives”. Alternatives 1 and 3 expressly state that the erroneous grant of IPRs over TCE traditional cultural expressions should be prevented, merely proposes “to support the appropriate use and effective, balanced and adequate protection of traditional cultural expressions within the intellectual property system.”

³³ WIPO, The Protection of Traditional Cultural Expressions: Updated Draft Gap Analysis, WIPO/GRTKF/IC/37/7, 6 July 2018.

WIPO, The Protection of Traditional Cultural Expressions: Updated Draft Gap Analysis,

WIPO/GRTKF/IC/37/7, 6 July 2018.

³⁴ See to that effect The Protection of Traditional Knowledge: Updated Draft Gap Analysis, WIPO/GRTKF/IC/39/6, 16 January 2019, 25.

³⁵ See to that effect The Protection of Traditional Knowledge: Updated Draft Gap Analysis, WIPO/GRTKF/IC/39/6, 16 January 2019, 4.

³⁶ WIPO, The Protection of Traditional Cultural Expressions: Updated Draft Gap Analysis, WIPO/GRTKF/IC/40/7, 9 April 2019, however the analysis states that “international standards on design pro-

context of the draft Design Law Treaty to require “disclosure of the origin or source of TCEs, TK or biological/genetic resources utilized or incorporated in an industrial design.”

Considering these preliminary points, it appears that IPRs are ill-suited to protect a systematically different subject matter such as cultural heritage through traditional exclusive rights like patents, copyright and trademarks. Unsurprisingly, design rights are not much different, meaning that the protection of cultural heritage with design rights will certainly experience difficulties.³⁷

LEGAL FRAMEWORK

International

Compared with other IPRs, designs have received little attention at international level. Article 5*quinquies* of the 1883 Paris Convention (as amended) merely states that “[i]ndustrial designs shall be protected in all the countries of the Union.” It does not however prescribe a specific protection regime, nor does it mandate that designs must be protected by a specific design title.³⁸ Similarly, Article 25 of the TRIPS Agreements merely states that “Member States shall provide for the protection of independently created industrial designs that are new or original,” without determining the form such protection should take.³⁹ Article 25(2) TRIPS serves to ensure that all member states protect textile designs but expressly leaves the choice to member states to provide this protection “through industrial design or through copyright law.”

However, the TRIPS Agreement defines the basic conditions for protection, which require that designs must be “new or original,” and leaves room for discretion to the member states to exclude from protection designs that “do not significantly differ from known designs or combinations of known design features.”⁴⁰ Similar to the Madrid System for trademarks and the Patent Cooperation Treaty, the Hague System for the International Registration of Industrial Designs was established to provide support for the registration and management of designs across multiple jurisdictions.

At WIPO level the discussions on the Design Law Treaty seem to have stalled. In December 2019, at its 51st Session, the WIPO General Assembly considered a proposal by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) to convene a diplomatic conference for the adoption of a Design Law Treaty at the end of the first half of 2020.⁴¹ As no consensus could be reached to convene a diplomatic conference, it was postponed to the next session, which took place in September 2020.⁴² No progress has been made since, but it is worth noting that one of the remaining aspects that needed clarifi-

tion may provide some indirect protection for some TK, particularly when designs are closely associated with a particular TK system, such as a way of producing tools, musical instruments or handicrafts.”

³⁷ Michael Blakeney, ‘The protection of traditional knowledge under intellectual property law’ [2000] *European Intellectual Property Review* 251, 252.

³⁸ See Dutfield & Suthersanen (n 21), 239, states are therefore free to provide protection to designs under copyright law (see Article 2(7) Berne Convention).

³⁹ TRIPS Commentary, para. 25.01.

⁴⁰ Article 25(1) TRIPS.

⁴¹ WIPO General Assembly, WO/GA/51/18, 13 December 2019, at 151.

⁴² *Ibid* at 155.

cation is the national policy space for substantive requirements pertaining to the protection of TK and TCEs.⁴³

European Union

Turning to the European Union, one can clearly identify a much more structured and elaborated legal framework. The discourse revolves around two central legal texts – the 1998 Directive on the legal protection of designs⁴⁴ and the 2002 Regulation on Community designs. The former seeks to harmonize the laws in the different member states as far as national registered design law is concerned, while the latter introduced a unitary design title, similar to the EU Trademark – the so-called Registered Community Design (RCD). Registration for the RCD is managed by the European Union Intellectual Property Office (EUIPO). The Directive's main goal is to ensure the well functioning of the internal market and to that end rendering identical the conditions for obtaining a registered design in all member states is central.⁴⁵ This would then facilitate the free movement of goods among the member states.⁴⁶ Equally, the Regulation seeks to overcome the territoriality issue of national designs by introducing a unitary title, as the alternative could lead to a possible division of the internal market and hence could constitute an obstacle to the free movement of goods.⁴⁷ Thus, it becomes clear from the outset that the justification of the Design Directive as well as the Regulation is economic. Indeed, designs' main function is that of investment.⁴⁸

In addition to the RCD, the European Union introduced a second layer of design protection – the Unregistered Community Design (UCD). This specific type of right lasts for three years from the moment in which the design is first made available to the public.⁴⁹ It is ideal for industries where the designs have a short market life and registration formalities would unnecessarily burden the stakeholders.⁵⁰ One such area is fashion, where EU unregistered designs have been used very effectively. EU law does not envisage, however, a national harmonized unregistered design.

Consequently, as EU law currently stands, there are several instruments to protect designs, and some do not even require formalities such as registration. This puts the EU design law system in the spotlight, which is in fact currently undergoing a public consultation with a view of being reformed.⁵¹

⁴³ Ibid at 150.

⁴⁴ Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs, *OJL* 289, 28.10.1998, p. 28–35.

⁴⁵ Recital 9 Directive 98/71/EC.

⁴⁶ Recital 1 Directive 98/71/EC.

⁴⁷ Recital 4 CDR.

⁴⁸ Recital CDR, see also as well as Case C-395/16, *DOCERAM GmbH v CeramTec GmbH*, EU:C:2018:172, para. 28.

⁴⁹ Article 11 CDR.

⁵⁰ Recital 16 CDR.

⁵¹ European Commission 'Commission seeks public opinion on protection of industrial designs and EU-wide geographical indications for products (29 April 2021) <https://ec.europa.eu/growth/content/commission-seeks-public-opinion-protection-industrial-designs-and-eu-wide-geographical_en> accessed 31 August 2021.

SCOPE OF DESIGN PROTECTION

When assessing the requirements for a design, it appears that the protection is broad and narrow at the same time. While the subject matter within the scope is broadly defined, the specific conditions triggering protection certainly appear very restrictive.

In the EU, ‘design’ is defined as “the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation.”⁵² Such a definition would certainly include a vast variety of subject matter, including the above-mentioned examples of ICH as per the 2003 Convention for the Safeguarding of the Intangible Cultural Heritage (ICH Convention).

Turning to the requirements, it transpires that the protection is carefully limited. In order to attract protection, a design must be new, it must possess an individual character, and it must be part of a product.⁵³ The perspective from which such an assessment is made is that of the so-called ‘informed user.’⁵⁴ This fictitious figure positions itself between trademark law’s ‘average consumer’ and patent law’s ‘expert skilled in the field.’⁵⁵ Thus, when analyzing designs, one is expected to be familiar with the restraints in the specific field, able to spot differences in designs (thus, not perfect recollection like the ‘average consumer’),⁵⁶ but certainly far from an expert familiar with all the prior art and intricacies of the specific design field. This specific aspect will have certain implications for the positive protection of ICH with design law. We will turn to this aspect further below.

Besides the scope, there is another aspect that speaks for the rather narrow design protection. The right only extends to acts of copying the protected design and acts that relate to the marketing of the design.⁵⁷ It does not cover aspects akin to the protection offered under copyright’s moral rights.⁵⁸

Protection Requirements

To obtain protection under EU design law, a design must meet two substantive requirements: novelty and individual character.⁵⁹ For the EU, novelty means that “no identical design has been made available to the public.”⁶⁰ In principle, a strict application of this standard would mean that a Community design cannot be granted if an identical design already exists anywhere in the world at the relevant time.⁶¹ A global novelty standard would provide effective

⁵² Article 3(1)(a) CDR.

⁵³ Article 4(1) CDR.

⁵⁴ Article 5 Design Directive; Article 6 CDR.

⁵⁵ *PepsiCo* Case C-281/10 P, *PepsiCo, Inc. v Grupo Promer Mon Graphic SA*, EU:C:2011:679, para. 53.

⁵⁶ *PepsiCo* Case C-281/10 P, *PepsiCo, Inc. v Grupo Promer Mon Graphic SA*, EU:C:2011:679, para. 55.

⁵⁷ Article 18 CDR.

⁵⁸ Cf. Henning Hartwig, ‘Claiming Priority under the Community Design Scheme’, in: Henning Hartwig (ed), *Research Handbook on Design Law* (Edward Elgar Publishing 2021), 171.

⁵⁹ Article 4 CDR.

⁶⁰ Article 5(1) CDR. The term ‘identical’ is defined in Article 5(2) meaning that designs are “deemed to be identical if their features differ only in immaterial details.”

⁶¹ The CRD distinguishes between unregistered Community designs, for which the relevant time is “the date on which the design for which protection is claimed has first been made available to the public”

protection against the assertion of design rights over expressions of ICH and protect indigenous communities against claims by third parties in relation to their cultural expressions.

However, EU design law seems to limit the geographical scope of the novelty standard. It considers a design to be made available for the purpose of assessing novelty and individual character if it has been published or otherwise disclosed before the relevant date, “except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community.”⁶² This standard of reasonableness excludes situations in which designs have been disclosed only in remote regions of the world and leaves room for independent creations. Nonetheless, Dutfield and Suthersanen argue convincingly that in a globalized and interconnected world, this exception is of limited relevance.⁶³ Therefore, disclosures of potentially novelty-destroying designs must be considered on a worldwide basis. This was indeed the case with the famous Crocs shoes.⁶⁴ Crocs held a registered EU design for their landmark shoes since 2005. Gifi Diffusion slammed the Crocs design with an application for invalidity, claiming the Crocs design was not novel as it was displayed more than 12 months before the registration on the company’s official website, at an exhibition at a boat show in Florida (United States). It also stressed the fact that the clogs to which the design had been applied were available for sale. The General Court dismissed Crocs’ appeal and held that there is no requirement that the events constituting disclosure to have taken place in the EU. To this end, the disclosure in the US, which was considered a particularly important market for the EU, destroyed the novelty of the registered design, which was then held invalid. Importantly, the General Court found that Crocs failed to demonstrate that the three disclosure events established by EUIPO could not reasonably have become known in the normal course of business to the circles specialized in the sector concerned, operating within the EU (that is to say, professionals in the trade and manufacture of footwear).⁶⁵ Similarly, in the US, design patent law does not exclude obscure designs pre-existing in remote and secluded places and instead applies a worldwide novelty standard.⁶⁶

As a result of the relatively strict novelty requirement, it will prove difficult for an indigenous community or other cultural group to register a design that exists already for generations in various permutations and evolutions. Any record of the design would automatically compromise the novelty and thus make it challengeable by a third party in invalidity procedures. An active protection of cultural heritage by design law would therefore already fail because cultural heritage by default will not fulfill the novelty criterion. As the above example demonstrates, prior art can be taken into consideration worldwide as long as this has become known in the EU.⁶⁷

and registered Community designs, for which the relevant time is “the date of filing of the application for registration of the design for which protection is claimed, or, if priority is claimed, the date of priority” (Article 5(1)(a) and (b)).

⁶² Article 7 CDR.

⁶³ Dutfield & Suthersanen (n 21), p. 254.

⁶⁴ Case T-651/16, *Crocs, Inc. v EUIPO*, EU:T:2018:137, further under appeal before the CJEU (C-320/18 P), but was eventually settled. Crocs lost at the General Court.

⁶⁵ Case T-651/16, *Crocs, Inc. v EUIPO*, EU:T:2018:137, para. 63.

⁶⁶ Dutfield & Suthersanen (n 21), 255. See for other approaches: Volken (n 22), 12–14

⁶⁷ Cf. also Commission Staff Working Document. Evaluation of EU legislation on design protection, SWD(2020) 264 final, Brussels, 6.11.2020. p. 28.

In relation to the UCD, the requirement of novelty is also applicable in the same way as it applies to registered designs, but disclosure must occur within the EU.⁶⁸ This may appear favorable for indigenous communities seeking to protect their designs due to the fact that most indigenous communities are situated outside of the EU; the overall utility of the UCD is very limited. Conversely, the restriction of the act of disclosure of prior art to the EU enables designers to rely on a UCD although an identical or similar design has already been disclosed elsewhere outside the EU. This potential threat to indigenous communities is somewhat mitigated by the duration of the UCD, which is limited to three years starting from the moment of disclosure.⁶⁹

The second requirement for a design is that of individual character. While the novelty requirement is an objective standard in the sense that the analysis lies in the notion of disclosure, the requirement that the design displays an individual character is not entirely void of subjective elements. To assess whether design for which registration is sought – or for unregistered sign simply protection – a court will look at the overall impression of the contested design from the perspective of an informed user and compare it with the prior designs.⁷⁰ A design displays an individual character if “the overall impression which that design produces on the informed user [is] different from that produced on such a user not by a combination of features taken in isolation and drawn from a number of earlier designs, but by one or more earlier designs, taken individually.”⁷¹ In the course of this analysis, the freedom of a designer developing the design must be taken into consideration. In this respect, some designs require certain specific features to be always present – a shoe design would always have a sole to step on. Consequently, the more limited the design freedom is, the smaller the differences will be that are likely to create a different overall impression, and vice versa. However, this can never be a mathematical calculation and should always consider the overall impression of the informed user.⁷²

Turning briefly to the US, the protection standards differ slightly from those in the EU, and applications for design patents are dealt with in the same way as applications for utility patents. Registration can be sought for “any new, original and ornamental” design.⁷³ The first two requirements are nominally identical to those that apply equally to utility patents, while the latter is unique to design patents. However, only a small proportion of applications for design patents is rejected, most of these for formal reasons and not because they are pre-empted by the prior art.⁷⁴

The novelty standard that applies for utility patents also applies to design patents. A design that is anticipated by an earlier design would fail at the novelty stage. The US courts, in order to determine whether a design possesses novelty, will compare the new design against the prior

⁶⁸ Article 11 Design Regulation 6/2002.

⁶⁹ Article 11 Design Regulation 6/2002.

⁷⁰ See for a definition of an informed user, laying out her specific characteristics: *Samsung v Apple* UK Court of Appeal [2012] EWCA 133, paras 39–51, see also Dutfield & Suthersanen (n 21), 253 and Volken (n 22), 15.

⁷¹ Case C-345/13, *Karen Millen Fashions Ltd. V. Dunnes Stores*, EU:C:2014:213, para. 35.

⁷² David Stone, Philip Davies, Another case of handbags at dawn: General Court rules out mathematical approach to assessment of overall impression, *Journal of Intellectual Property Law & Practice*, Volume 11, Issue 1, January 2016, Pages 14–16, page 16

⁷³ Cf. 35 U.S.C. §§ 171(a)–(b) (Supp. I 2013), see Dutfield & Suthersanen (n 21), 255–256.

⁷⁴ See Sarah Burstein, ‘Is Design Patent Examination Too Lax?’ [2018] *Berkeley Technology Law Journal* 607, 610, with further references.

art through the eyes of an ordinary observer with specific attention to the differences between the prior art and the design as it is being claimed.⁷⁵ As a result, unless almost completely identical, a design based on a design which is part of a community's ICH will not struggle at the hurdle of novelty. But even at the non-obvious stage, the US courts tend to require a relatively high level of identity.⁷⁶

Excluded Subject Matter

The Community Design Regulation only excludes such designs from registration that are solely dictated by their function⁷⁷ or which are “contrary to public policy or to accepted principles of morality.”⁷⁸ We discuss below why the current examination procedure in the EU is unsuited to prevent registration of designs based on ICH *ab initio*. This is because the substantive examination of design applications in theory would bar designs contrary to public policy or to accepted principles of morality as per Article 9 CDR, but in practice this ground has not been relied on.

The public policy argument, if understood broadly, could be particularly helpful to prevent the registration of designs that are offensive to indigenous communities, even if such designs were to meet the novelty and individual character requirements. However, the EU Courts and the EUIPO interpret public policy and morality strictly, and to date no design has been refused registration on these grounds. In fact, in its Guidelines the EUIPO stresses explicitly that the Office will apply the concepts of public policy and morality as explained in the Guidelines on trademarks following the case law of Article 7(1)(f) EUTMR.

In relation to trademarks, ‘public policy’ and ‘accepted principles of morality’ are two separate concepts that often overlap. The CJEU established that the concept of ‘accepted principles of morality’ refers “to the fundamental moral values and standards to which a society adheres at a given time.”⁷⁹ When assessing this standard, regard must be had to “the cultural, religious or philosophical diversities that characterise” the relevant social context.⁸⁰ The relevant social context is one of “that society at the time of the assessment,” and therefore seems to be limited to the country of registration. As much as the registration might injure or offend an indigenous community at the other end of the globe, it is unlikely that ‘remote’ cultural sensitivities would cause moral offense in a member state of the European Union.

An objection based on ‘public policy’ must be based on objective criteria. ‘Public policy’ is the body of all legal rules that are necessary for the functioning of a democratic society and the state of law. In the context of Article 7(1)(f) EUTMR, ‘public policy’ refers to the body of EU law applicable in a certain area, as well as to the legal order and the state of law as defined by

⁷⁵ The test is the same for novelty as it is for infringements, see *Int'l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1239, 1238.

⁷⁶ Cf. Burstein (n 74), 617; the author provides the example of a design application for a “Pocket Key Organizer” in *Key-Bar, LLC v. Curv Brands, LLC*, 2017 WL 1096586, at *1 (Mar. 22, 2017).

⁷⁷ Article 8 CDR; the provision also excludes features that requires a certain form and dimension to interoperate with another product, the so-called ‘Must-Fit’ Exception, cf. Justine Pila & Torremans, Paul, *European Intellectual Property Law* (2nd edn, Oxford University Press 2019), 469–470.

⁷⁸ Article 9 CDR.

⁷⁹ Case C-240/18 P, *Constantin Film Produktion GmbH v. EUIPO*, EU:C:2020:118, para. 39.

⁸⁰ ~~Case C-240/18 P, *Constantin Film Produktion GmbH v. EUIPO*, EU:C:2020:118, para. 39.~~

the Treaties and secondary EU legislation, which reflect a common understanding of certain basic principles and values, such as human rights.

The standard of public policy is equally subject to a strict interpretation.⁸¹ These provisions have been referred to in the past years by reference to extending the IP protection of cultural works in which copyright has expired by virtue of trademark applications. Several years ago, the EFTA court considered the registrability as trademarks of many visual works and sculptures of the Norwegian sculptor Gustav Vigeland.⁸² At stake here was a potential trademark protection for the famous ‘Angry Boy’ sculpture in which copyright had expired. The Municipality of the city of Oslo had sought trademark registration of approximately 90 of Vigeland’s works and the applications were rejected. The grounds included not only the well-known descriptiveness and non-distinctiveness, but also an additional objection on the grounds of public policy and morality. Eventually, the case went all the way up to the EFTA court. The final decision concludes that

it may be contrary to public policy in certain circumstances, to proceed to register a trademark in respect of a well-known copyright work of art, where the copyright protection in that work has expired or is about to expire. The status of that well known work of art including the cultural status in the perception of the general public for that work of art may be taken into account.

Such a reasoning is certainly sound in view of the specific features of trademark protection – different from other IPRs, trademarks protection can be renewed potentially forever. An objection of this kind also considers the dangers of re-appropriation of cultural expression. It is indeed an aggressive technique of artificially prolonging IP protection, which the late US Supreme Court Justice Scalia has labelled as “mutant copyright”.⁸³

Against this background, the absence of design cases tackling public policy and morality grounds suggests, however, that the ground has not been of much use.

THE LIMITS TO PROTECTING CULTURAL HERITAGE WITH DESIGN LAW

Protecting ICH with design law is problematic and of little utility. The inherent restrictions of the scope of design law and the conditions that must be fulfilled to obtain protection under modern design law leave little room for a protective regime that could fulfill the needs of indigenous communities more generally. In this regard, the barriers to effective protection are similar to those of the other classic intellectual property rights.⁸⁴

⁸¹ See Luminița Olteanu, ‘Riding on the Coat-tails of Traditional Cultural Expressions’ [2021] *International Journal for the Semiotics of Law* 861, 880, who argues for a broad interpretation of public policy as an absolute ground for refusal in European trademark law, interpreting Article 7(f) CDR together with the provisions of the TFEU on the protection of Europe cultural heritage e.g., Article 167(2) TFEU; but also Article 13 TFEU and Article 3(3) TEU.

⁸² Case E-5/15 Municipality of Oslo, 6 April 2017.

⁸³ *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003), at 34.

⁸⁴ See e.g., Naomi Palosaari, ‘Intellectual Property Rights and Informed Consent in American Indian Communities: Legal and Ethical Issues’ [2016] *American Indian Law Review* 125,137–139.

Fisher highlights the problems associated with protecting traditional knowledge with intellectual property rights. Such knowledge, including traditional expressions as part of ICH, is produced by groups instead of individuals, it has been created a long time ago, and the initial creators are not in control of its ‘management’ in the present time.⁸⁵ Put differently, the creations of individuals in the distant past, today serve as important elements of a community identity, which this community desires to protect and control. Fisher also highlights why the differences in justifying protection for ‘normal’ intellectual property fail to provide arguments for a greater protection of traditional knowledge.⁸⁶ It is these differences that partially explain why design protection does not provide an efficient framework for the protection of ICH against abuse and misappropriation of ICH, or why it fails to provide indigenous communities with legal mechanisms that could ensure and safeguard their control over their traditional expressions.

Duration and Ownership

The problems that stem from the rules governing ownership of industrial design rights are inherently linked to the duration of such titles. Although it is possible to transfer the title to an industrial design right,⁸⁷ a continuous ownership over generations is not possible.⁸⁸ The ICH Convention defines ICH as being “transmitted from generation to generation” and that it “is constantly recreated by communities and groups in response to their environment, their interaction with nature and their history.”⁸⁹ Intangible cultural property therefore does not belong to an individual. Instead, TCEs as part of ICH belong to a community, the members of which identify themselves with such expression.⁹⁰ The process of creation and conservation through recreation lets individual designers fade into a group with an indefinite number of designers, which are impossible to identify, and which all participate or have participated in these processes. Although there might be a common plan to maintain cultural heritage, such a common plan, a prerequisite for joint ownership,⁹¹ does not exist in relation to the ICH. The nature of ICH is inherently dynamic.

⁸⁵ Cf. William Fisher, ‘Why Is Traditional Knowledge Different from All Other Intellectual Property’ [2019] *Washburn Law Journal* 365, 365–366, see also Hughes (n 24), 1243–1253 and Munzer & Raustiala (n 27), 63–65.

⁸⁶ Fisher (n 85), 366–377, while classical intellectual property rights are granted and protected to guarantee fair rewards for authors and inventors, incentivize innovation through the temporal suppression of competition and to protect the strong bonds between artists and inventors and their creations, arguments to protect traditional knowledge are different: its protection serves to protect the identities of communities against unauthorized use of traditional knowledge by outsiders, which could “corrode those identities”; protection of traditional knowledge promotes distributive justice in relation to communities that are often at a significant economic disadvantage in the countries they are located; and protection of traditional knowledge reduces global cultural homogenization by giving indigenous communities control over their heritage.

⁸⁷ Article 28 CDR.

⁸⁸ See Article 12 CRD for registered designs, which are protected for initially five years and which can be extended in their term for additional periods of five years up to a maximum of 25 years, and Article 11 CRD for unregistered designs, which enjoy a term of protection of three years.

⁸⁹ Article 2(1)

⁹⁰ Martinet (n 4), 11.

⁹¹ Anna Tischner, ‘Design Rights and Designer’s Rights in the EU’, in: Henning Hartwig (ed), *Research Handbook on Design Law* (Edward Elgar Publishing 2021), 180.

This stands in contrast to the static nature of design rights. Their term of protection is limited to a total of 25 years in the EU for registered design⁹² and three years for unregistered designs.⁹³ EU design law also limits the original beneficiary of a design rights. Ownership of an industrial design rests in the designer, i.e., the creator of a design.⁹⁴ While Article 14(2) CRD considers the possibility that two or more persons can jointly develop a design, it does not foresee a gradual development of designs through a community-driven process that would entitle larger groups of indeterminate persons to own a design right; and this disregards the aspect of fluctuating or morphing subject matter in the definition of ICH in the Convention.⁹⁵

The limitation in ownership and duration reflects the inherently economic nature of the design right, which systematically sits oddly between trademarks and copyright. The economic justification and the balance of interests underlying design rights is also reflected in the relatively limited temporal scope.⁹⁶ Similarly, limitation to the scope of protection is foreseen, *inter alia*, for private uses and for non-commercial uses.⁹⁷

Substance

A design that would infringe would not be granted its own title because it would be neither new nor would it display an individual character.⁹⁸ The distance between an existing design, whether currently protected or not, and a design for which protection is sought is determinative for whether the latter can be registered or not.

Article 10 CRD states that “[t]he scope of the protection conferred by a Community design shall include any design which does not produce on the informed user a different overall impression.” A design that creates a different overall impression in the eyes of an informed user does not infringe and would be eligible for its own design title. Therefore, the interpretation of the notion of ‘overall impression’ and the notional ‘informed user’ are highly significant for the protection granted, positively or defensively, for ICH. In other words, a design that resembles a design that is considered a TCE, and therefore part of the ICH, can formally be registered as an independent design if its overall impression is different from the TCE. But here lies the first difficulty. A design enjoys protection in relation to designs that are not identical or which create an overall different impression. This requires defining ICH that could be compared with a design for which protection is sought. However, defining the ‘scope’ of ICH is often not that easy, or as Brown puts it: “to protect something, we must first identify it and specify its boundaries.”⁹⁹

From a positive-protection perspective, a designer could apply for the protection of a TCE if the design created is different in its overall impression from the corpus of ICH that is taken

⁹² Article 12 CDR; the initial term of protection is five years, which can be prolonged in intervals of further five years until the total term of protection reaches 25 years after the date of filing.

⁹³ Article 11(1) CDR.

⁹⁴ Article 14(1) CDR.

⁹⁵ See on the difference between traditional IP subject matter and traditional knowledge, e.g., Fisher (n 85), 369, with reference to Madhavi Sunder, ‘The Invention of Traditional Knowledge’ [2007] *Law and Contemporary Problems* 97.

⁹⁶ Volken (n 22), 4.

⁹⁷ Article 20 CDR.

⁹⁸ Pila & Torremans (n 77), 471.

⁹⁹ Brown (n 1), 573.

as reference as part of the prior art. Essentially, this assessment comes down to a simple infringement test.

The differences between an existing design and a new design must not be obvious, but the differences must be “sufficiently marked or significant.”¹⁰⁰ A design, in order to be registrable, must therefore merely be non-identical to an earlier design, or the prior art in general, and must further display sufficiently marked or significant differences that must not necessarily be obvious. The standard to be applied here is that of an informed user, which the CJEU has described as

without being a designer or a technical expert, the user knows the various designs which exist in the sector concerned, possesses a certain degree of knowledge with regard to the features which those designs normally include, and, as a result of his interest in the products concerned, shows a relatively high degree of attention when he uses them.¹⁰¹

The protection of the design is not restricted to the product or class of product to which it is usually applied or incorporated into, or which might be the case, in relation to which it has been registered. It is only relevant whether a potentially infringing design produces on the informed user a different overall impression.¹⁰² The nature of the product in which the registered design is intended to be incorporated can, however, be taken into consideration when assessing whether the overall impression of the allegedly infringing design produces an “overall impression of difference or lack of ‘déjà vu’.”¹⁰³

The substantive scope of protection protects the holder of a registered design against acts by others that would violate the “exclusive right to use [the design] and to prevent any third party not having his consent from using it.”¹⁰⁴ The notion of use includes “in particular, the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes.” All these examples refer to a physical use of the design in relation to the marketing of a product. Uses that do not relate to a product are not covered by design law, which therefore fails to provide protection against acts other than copying in the sense of moral rights protection under copyright law and uses detrimental to the reputation of a mark under trademark law.¹⁰⁵ In the absence of protection of acts that are considered wrong as part of the substantive scope of protection, such matters are best dealt, as we argue below, with subsistence conditions and absolute grounds of refusal.

¹⁰⁰ Case C-821/18 P, *Linak A/S v EUIPO*, EU:C:2019:513, paras. 19–25 confirming the judgment under appeal (Case T-367/17, *Linak A/S v EUIPO*, EU:T:2018:694).

¹⁰¹ Case C-361/15 P, *Easy Sanitary Solutions BV and EUIPO, v Group Nivelles* EU:C:2017:720, para. 125, with reference to Case C-281/10 P, *PepsiCo v Grupo Promer Mon Graphic*, EU:C:2011:679, para. 59.

¹⁰² Cf. Case C-361/15 P, *Easy Sanitary Solutions BV and EUIPO v Group Nivelles*, EU:C:2017:720, paras. 90-91.

¹⁰³ Case T-353/19, *Gamma-A SIA v EUIPO*, EU:T:2020:95, para. 39, see also para. 53.

¹⁰⁴ Article 19 CRD.

¹⁰⁵ Cf. Xanthaki et al. (n 26), 223.

CHALLENGING DESIGN CLAIMS FOR CULTURAL HERITAGE

Challenges to the eligibility or validity of a design that reproduces a TCE can be made before it unfolds its legal effects in cases of registration, or as objection in infringement procedures.

Examination

In the EU, designs are registered provided that they comply with all formal requirements.¹⁰⁶ Substantive protection requirements are not subject to prior examination, to keep the administrative burden for applicants to a minimum.¹⁰⁷ The formal requirements are laid down in Article 36 EU Design Regulation, which requires that an application contains a “request for registration,” that it identifies the applicant, and that it contains “a representation of the design suitable for reproduction.”¹⁰⁸

As a result of the limited examination, EU design law does not provide for any effective protection against the initial registration of designs that do not meet the substantive requirements, or where registration should be prevented for other reasons. This stands in stark contrast with the trademark system, where a list of absolute and relative grounds regularly act as a barrier to applications.¹⁰⁹ Without a prior examination, designs that contain elements of or which otherwise resemble ICH could initially be registered, although they could be challenged successfully due to their lack of novelty via invalidity applications. Designs containing elements that would eventually lead to a declaration of invalidity are also likely to be registered initially because the applicant must not necessarily be the designer themselves.¹¹⁰

The situation is different in the US, where applications for design patents are subject to an examination against the prior art and for compliance with the other requirements for protection.¹¹¹ Furthermore, the inventor of the design must submit an oath declaring that they are “the original inventor or an original joint inventor of a claimed invention.”¹¹² However, the standard of review is extremely limited to near-identical designs,¹¹³ with the consequence that non-identical, but still similar designs would still pass the standards of both novelty and non-obviousness.

It is obvious that a thorough examination of a design for which registration is sought would help to prevent the registration of ICH. However, with low standards for subsistence and the absence of an initial examination in important jurisdictions, this hurdle is easily overcome. It

¹⁰⁶ Article 45 CRD.

¹⁰⁷ Cf. Recital 18 CRD.

¹⁰⁸ Further optional elements of an application are contained in Article 36(3) and Article 37 CRD.

¹⁰⁹ Article 7 EUTMR; Article 8 EUTMR.

¹¹⁰ Although the designer or a team of designers has the right to be cited (Article 18).

¹¹¹ See 35 U.S.C. § 131, see also 37 CFR § 1.104(a)(a), which states that “the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention.” Subparagraph (3) further requires that “[a]n international-type search will be made in all national applications filed on and after June 1, 1978.”

¹¹² 37 U.S.C. § 1.63(a)(3), a false statement can lead to criminal liability, see Stephen Yeldermann, ‘The Value of Accuracy in the Patent System’ [2017] *University of Chicago Law Review* 1217, 1266.

¹¹³ Cf. Burstein (n 74), 613–614, 621.

does not help that the current draft of the Design Law Treaty makes a prior disclosure requirement merely optional.¹¹⁴

Declaration of Invalidity

A design can be declared invalid based on several grounds.¹¹⁵ While the most often relied on are the lack of novelty and individual character, for the purposes of this chapter, it is worth stressing that should a design be contrary to public policy and morality, it would also risk an invalidity claim.¹¹⁶

As it was mentioned above, the public policy argument is a difficult one to make. Tied to its understanding in trademark law, the public policy/morality ground has been traditionally relied on to object to obscene expression. The central question has been whether the sign offends and not whether the appropriation of expression and thus its prolonged IPR protection, are against the interests of the general public.¹¹⁷ In this regard, it is fair to say that overlap between the different intellectual property rights is inevitable as the subject matter is often defined very broadly.¹¹⁸ Yet, following the lines of the European Copyright Society and their opinion on the *Vigeland* case,¹¹⁹ it can be convincingly argued that the registration of designs incorporating ICH may seriously offend the broader public and invade the public domain in a manner that is highly inappropriate and overly expansive. Furthermore, as Senftleben argues in the case of trademarks, “if public order and morality are not properly developed and cultivated as grounds for refusal, alternative instruments – ranging from distinctiveness and bad faith to ‘use as a mark’ – are unlikely to yield satisfactory results.”¹²⁰ This becomes even more relevant in the context of designs, where the trademark grounds for lack of distinctiveness, descriptiveness and bad faith do not exist as a safety net. As a result, even though the intersection between ICH and designs seems to have been unexplored for various reasons, instrumentalizing the public policy ground in view of the defensive protection of ICH seems to be the best and most feasible option to safeguard the interests of indigenous communities.

¹¹⁴ Cf. also SWD(2020) 264 final, p. 20.

¹¹⁵ Article 25 CDR.

¹¹⁶ Article 25(1)(b) read together with Article 9 CDR.

¹¹⁷ EUIPO Board of Appeal, 6 July 2006, Case R 495/2005-G, *Jebaraj Kenneth trading as Screw You OHIM (SCREW YOU)*, para 30. See also EUIPO Board of Appeal, 25 March 2003, Case R 111/2002-4, *Dick Lexic Ltd. v OHIM (DICK & FANNY)*.

¹¹⁸ Irene Calboli, ‘Overlapping Copyright and Trademark Protection: A Call for Concern and Action’ [2014] *Illinois Law Review* 25.

¹¹⁹ See European Copyright Society ‘Trademark protection of public domain works A comment on the request for an advisory opinion of the EFTA Court’ (1 November 2016) <<https://europeancopyrightsocietydotorg.files.wordpress.com/2016/11/ecs-efta-reference-vigeland-final-1nov16.pdf>> accessed 31 August 2021.

¹²⁰ Martin Senftleben, ‘No Trademark Protection for Artworks in the Public Domain – A Practical Guide to the Application of Public Order and Morality as Grounds for Refusal’ [2021 forthcoming] GRUR International .



CONCLUSION AND OUTLOOK

Design law seems ill-equipped to provide positive protection for ICH. The structure of design protection with its narrow scope of protection and short term does not serve the demands of indigenous communities and the intertemporal and generation-transcending nature of ICH.¹²¹ The evolutionary nature of ICH requires broader protection than that offered by contemporary design law systems. This is not to say that design law can protect specific instances of ICH expressed in a particular and specific way, created by an individual member of a community which lays claim to the ICH of which the specific sample is representative of. But a larger corpus or style of design does not fit easily in the formalistic corset of design law.

A defensive approach to the protection of ICH against abuse seems to promise more success.¹²² Design law foresees mechanisms that could prevent the abuse of traditional designs that deserve special protection. At the registration phase, but also by way of an invalidity claim, design law has the potential to function as a protective roadblock against a misappropriation of ICH. At this point, these mechanisms still require refinement in order to develop their full effectiveness. At the registration phase, examination of a design against prior art is either non-existent (EU) or fails to scrutinize application to the extent that an effective filtering of applications that could harm indigenous communities is rendered impossible (US).

Although enforcing designs that imitate traditional or indigenous designs could prove difficult, the simple fact that litigation can occur constitutes a severe nuisance for indigenous communities who lack the necessary resources or know-how to defend themselves against cultural misappropriation. A recurring argument in the literature puts indigenous communities in a particularly weak position due to their often-precarious economic situation. As a result, they are not always able to design the legal protection of their ICH, nor are they able to monitor potential abuses or effectively respond to legal challenges brought against them on the basis of registered designs incorporating their own designs.¹²³

A way forward out of this uneasy relationship is difficult to outline. This is not made easier due to the largely unharmonized protection of designs at a global level. Although progress has been made at international level towards a Design Law Treaty, this instrument will not provide much substantive harmonization, but it will rather set minimum standards for the registration of designs. One of the more contentious issues is a disclosure requirement for TCEs, which in the current draft of the treaty has been reduced to a non-binding requirement.¹²⁴ Such a requirement would help, however, to shape a more efficient examination procedure that would detect design application incorporating ICH initially and enable national and regional examination offices to reject such applications. More and better structured information on designs that form part of the world's ICH would also help to make examination more efficient. Finally, another avenue to pursue is to reject designs on public policy grounds due to the fact that they incor-

¹²¹ See however Ruth L. Okediji, *Traditional Knowledge and the Public Domain*, (2018) CIGI Paper No. 176, available at: <https://www.cigionline.org/publications/traditional-knowledge-and-public-domain/>.

¹²² Cf. Burri (n 1), 481–482 and Munzer & Raustiala (n 27), 40.

¹²³ Cf. Sainsbury (n 2), 241 and Fisher (n 85), 369.

¹²⁴ Cf. WIPO General Assembly, WO/GA/51/18, 13 December 2019, at 137, see also the report by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, SCT/43/12, 28 ay 2021, at 19.

porate ICH expression. Such registrations for designs should only be possible with the express consent of the communities concerned.¹²⁵

¹²⁵ Cf. Sainsbury (n 2), 249.