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April 2004

The British Unregistered Design Right: Will It Survive Its New Community Counterpart To Influence Future European Case Law?

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10 Colum. J. Eur. L. 265

Columbia Journal of European Law
Spring, 2004

Article

*265 THE BRITISH UNREGISTERED DESIGN RIGHT: WILL IT SURVIVE ITS
NEW
COMMUNITY COUNTERPART TO INFLUENCE FUTURE EUROPEAN CASE
LAW?

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SUMMARY

The article compares the British unregistered design right ("UDR") and the new Community Unregistered Design Right ("CUDR"). The conclusion draws on the lessons learned from this analysis to evaluate whether CUDR will erase UDR from the legal landscape and whether UDR case law will influence future Community design case law.

I. INTRODUCTION

Design law has gained increased topicality since the implementation of the Directive on the legal protection of designs (the "Directive") [FN1] in the law of the Member States, and the enactment of the Regulation on Community designs (the "Regulation"). [FN2] A little more than 10 years after the initial Max Planck Proposal, [FN3] the Regulation introduced, in addition to the Community registered design right ("CRDR"), a Community unregistered design right which is very similar to the CRDR. [FN4]

The CUDR came into force a little more than two years ago, on 6 March 2002. It is in part based on the British invention of the unregistered design right or design right. [FN5] Before the introduction of the CUDR, this type of right did not exist anywhere *266 else in Europe. While the registered design right ("RDR") existed in Great Britain since the 18th century, [FN6] the British legislature only introduced UDR in 1988 while reforming the Copyright, Designs and Patents Act ("CDPA"); [FN7] the UDR entered into force on 1 August 1989. Thus, it is a relatively new right compared to traditional intellectual property rights, although no longer in its infancy, nonetheless still in its youth. Is the British UDR remote from the new CUDR as

introduced by the Community lawmaker? The object of this article is to compare the main features of the UDR and the CUDR, in particular focusing on the requirements for protection and infringement, in order to evaluate whether or not the UDR will survive the CUDR. Comparisons with copyright will also be made where relevant. This article does not purport to tout or critique the scope of one right to the detriment or benefit of the other. [FN8]

The article is divided into eleven sections, eight of which reflect the features of each right. Each of the next eight sections is further subdivided into three subsections. The first subsection presents the features of the UDR, the second of the CUDR, and the third compares the characteristics of each right, drawing attention to their similarities and differences. The eleventh section, the conclusion, evaluates whether the new CUDR will erase the UDR from the legal landscape, and whether UDR case law will influence future Community design courts case law. Finally, the article raises a further question: how to accommodate the relationships between all coexistent intellectual property rights, national and Community rights on the one hand, and traditional and new rights on the other?

II. NATURE AND SUBJECT-MATTER

A. UDR

The UDR is a "property right which subsists in an original design." [FN9] It is thus an intellectual property right of the same nature as copyright, patents and trademarks.

*267 Like copyright, the UDR arises automatically, with no need to fulfil any formality in order for it to take effect. "Design" is defined as the "design of any aspect of shape or configuration (whether internal or external) of the whole or part of an article." [FN10] Hence it protects only three-dimensional aspects. Examples of protectable shapes are as varied as those of clothing, [FN11] furniture, [FN12] steering wheel locks, [FN13] pumpkin cut-outs for use at Halloween, [FN14] and breast prostheses. [FN15] Examples of configuration are the diagonal ribs of a hot water bottle [FN16] and ribs engraved on a plastic garden chair. [FN17] The right can subsist in the aspect of the shape or configuration of an article even invisible to the naked eye. [FN18] As a matter of fact, contrary to the old Registered Design Act, [FN19] Parliament intended to protect functional aspects of shapes and configurations of products as well. There is thus no condition of an aesthetic nature in order for the right to subsist.

B. CUDR

The Community unregistered design right is by its nature an intellectual property right like patent, copyright and trademarks. Even if this does not appear clearly in a sentence at the beginning of the Regulation, as Part III of the CDPA does for the UDR, it is apparent not only from article 27(1) of the Regulation, [FN20] but also from the fact that it is linked for procedural reasons to the Community trademark, [FN21] which is an intellectual property right. In addition, due to the unitary character of the right, [FN22] the CUDR will subsist in the same format in the 15 Member States, as does the Community trademark. The CUDR arises automatically like UDR.

*268 Under the CUDR, design is defined as follows: "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." [FN23] Product is defined as follows: "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." [FN24]

C. Comparison

Both the UDR and the CUDR are intellectual property rights. They both protect aesthetic and purely functional designs. The term "appearance" in CUDR does not mean that only aesthetic designs are covered. [FN25] That the words "shape or configuration" are used in the CDPA whereas "appearance" is used in the Regulation should not make any difference. The broad meaning of appearance includes both senses of sight and touch. [FN26] Since shape can be said to relate to both senses of sight and touch, as it can be apprehended by either of those two senses, both terms cover the same notions. The senses of taste, hearing and smell are excluded from both rights. [FN27]

The subject-matter of the CUDR is both broader and narrower than that of the UDR. The CUDR is broader because it encompasses two-dimensional features, i.e. almost anything, such as the aspects of shape and configuration that define the design protected by UDR. It is less broad in the sense that the term "article" used in UDR is broader than the term "product" used in the Regulation. [FN28] Product being defined as any industrial or handicraft item, it is obvious that the notion does not include parts of the human or animal body, [FN29] or for that matter, parts of plants. In this regard, if the courts interpret the CUDR notion of product strictly, parts of the human or animal body or of plants cannot have an impact in the interconnection exception. [FN30] The interconnection exception is therefore less broad than the must-fit exception in UDR. Hence, there is an advantage for right holders to choose CUDR rather than UDR.

*269 III. EXCLUDED SUBJECT-MATTER

A. UDR

UDR does not protect four areas: methods or principles of construction, must-fit and must-match aspects, and surface decoration. [FN31]

The concept of method or principle of construction was explained in the leading case *Kestos v. Kempat*. [FN32] The UDR holder only gets a right for one particular individual and specific appearance of the article. "If it is possible to get several different appearances which all embody the general features claimed, then those features are too general and amount to a mode or principle of construction." [FN33] Subsequently, in a case involving designs for mobile phone cases, stitching in seams was held to be a method of construction. [FN34] The relative locations of interrelated functional parts of a baby safety barrier, i.e. the positioning of the parts, were also held to be a method or principle of construction. [FN35]

The aim of the "must-fit" (section 213 (3)(b)(i)) and "must-match" (section 213 (3)(b)(ii)) [FN36] limitations was to reduce the protection by UDR of spare parts (especially of automobile vehicles). The rather complex must-match exception will not be explained here because it has actually not been harmonized by the Directive nor unified in the Regulation [FN37] and might soon disappear. Recital 13 of the Regulation states that it is appropriate not to confer any protection as a Community design for a design which is applied to or incorporated in a product which constitutes a component part of

a complex product upon whose appearance the design is dependent and which is used for the purpose of the repair of a complex product so as to restore its original appearance

*270 until a new Commission proposal on the issue is laid down. Since this reflects UK law, there is, for the moment, no difference between the UDR and the CUDR in this respect. [FN38]

The courts have variously construed the meaning of the terms used in the must-fit exception. First, the words "to be connected to, placed in, around or against another article" have been interpreted in conflicting ways in two main cases. It was held in *Electronic Techniques* [FN39] that since the Act makes no distinction between an article and part of an article, interface features cannot be protected even if they are internal features of a larger article. Thus "another article" can mean a part of a larger article in which a UDR is claimed. In other words, "where two articles are joined together to make a single article, the must-fit exception not only applies to the parts as separate articles, ... [but it also] applies to the interfaces that become elements of the integrated whole." [FN40] The consequence is that more features are excluded from UDR protection.

Later, in *Baby Dan*, the words were given a more restrictive meaning: since the UDR can subsist in the various components of a larger article, section 213 (3)(b)(i) does not exclude the shape or configuration of the various parts of an article to enable such parts to be assembled into the final article. Thus the must-fit exception only applies to external and not internal interfaces of a whole article. However, since parts can be seen as articles themselves, if the UDR is applicable, the must-fit exception might apply to them as well. Therefore this will reduce the scope of protection of such parts seen as articles interfacing with other parts also seen as articles. The result of this ruling is that UDR must be claimed on the relevant part of a larger article in order to have more of a chance to win a case. If only component parts are copied, they should be relied upon as part of a larger article in case the defendant makes the same type of article as the claimant. If the defendant supplies the component part separately, or includes it in a different type of article as the claimant, the latter should rely upon the component part as an article in itself. Since *Baby Dan* is the more recent case on point, it seems that its view must now be the law in the area.

Second, the term "article," which is not defined in the Act, has been construed to encompass parts of the human body as well [FN41] (and supposedly by extension parts of animals and plants). In *Ocular Sciences v. AVCL*, [FN42] the court decided that the exception applied because the human eye can be understood as an article. Thus certain aspects of contact lenses could not be protected by UDR because, among others, they were made to fit the eye. [FN43]

*271 Third, features are only excluded as must-fit features if they "enable" one article to fit with another article. The question is how closely shapes need to correspond to each other for the feature of one article to be said to enable it to be connected to the other. There are two conflicting views on the question. In *Amoena*, [FN44] the court held that the must-fit exclusion is concerned with a very precise correspondence between two articles, e.g. a plug and a socket. This interpretation of the exception restricts its scope, thereby allowing more features to be protected. Later, *Ocular* construed the exception more widely. If a number of designs are possible, each of which enables the two articles to be fitted together but in a way that allows either or both to accomplish its function, each design is excluded. Thus fewer features can be protected.

Finally, "surface decoration" is not protected. This term, also without legal definition, has been construed in two decisions. In *Mark Wilkinson*, [FN45] it was held that the term "surface decoration" included decoration simply placed on the surface of an article (e.g. painting) as well as decorative aspects of the surface itself (e.g., beading or engraving). Hence, surface decoration includes not only two-dimensional but also three-dimensional elements. This was reiterated in *Jo-Y-Jo v. Matalan Retail*: [FN46] embroidery was surface decoration since it was made of stitches, added to the garment after it was made.

B. CUDR

Excluded subject matter is provided in articles 8, 9 and 25 of the Regulation. [FN47] Article 8(1) of the Regulation states that the right will not subsist in features of appearance of a product solely dictated by its technical function. Article 8(2) provides for an "interconnection exception." It states that

a Community design shall not subsist in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either product may perform its function.

Designs contrary to public policy or to accepted principles of morality are excluded in article 9. Immoral designs could include pornographic designs, designs depicting racial hatred, or designs of torture instruments. [FN48] Finally, under article 25, a CUDR will not subsist in three additional cases: (1) if a distinctive sign is used in a subsequent design, and Community law or the law of the Member State concerned governing that sign confers on the right holder of the sign the right to prohibit such use; (2) if the design constitutes an unauthorized use of a work protected under the copyright law of the Member State concerned; or (3) if the design constitutes an improper use of any of the items listed in Article 6 ter of the Paris Convention for the Protection of Industrial Property, or of badges, emblems and escutcheons other *272 than those covered by Article 6 ter of the said Convention which are of particular public interest in the Member State concerned.

C. Comparison

First, it is submitted that as under the UDR, methods or principles of construction are not protected by the CUDR. This is because even though there is no such explicit exception in the Regulation, it is implicitly included in article 6, which obliges consideration of the degree of the designer's freedom in developing his design when assessing individual character, the discussion of which follows under that title.

[FN49]

Article 8(1) of the Regulation reflects part of the UDR must-fit exception. [FN50] The scope of these two exceptions seems to be equal in practice. [FN51] The "interconnection exception" also partially mimics the must-fit exception. However, this CUDR exception is narrower than its UDR sister in that the words "which must necessarily be reproduced in their exact form and dimensions" [FN52] imply that the provision will not apply to interconnecting features which can be reproduced in alternative forms or dimensions but which nevertheless facilitate assembly or connection with another product. This is one more advantage for the right holder to resort to the CUDR rather than the UDR. Interconnection features are also required to permit product A to interface with product B, so that either product may perform its function. What if the interconnecting feature is capable of other functions? This has as

yet no answer as there is no case law under the new CUDR. [FN53] One more advantage of CUDR over UDR is that the interconnection exclusion does not apply to features within a modular system. [FN54] Hence modular systems are protected under the CUDR, but not under the UDR because the connecting parts would be excluded by the must-fit exception.

The public policy/morality limitation does not exist in UDR law. But, in view of the extreme dearth of cases occurring under the previous RDA in the UK, which *273 included such an exception, [FN55] it should have no notable influence on making the UDR more attractive than the CUDR. In addition, in view of the relatively close relationship of copyright and the UDR and the fact that copyright of an immoral material is not enforced, it would appear rather extraordinary that an immoral design could benefit from UDR.

With regard to limitations provided for in article 25, they also apply in the UDR, even if not explicitly so under the CDPA. This is because the uses in article 25(1) and (2) infringe upon pre-existing intellectual property rights, and because the use of flags and emblems is prohibited by an international convention to which the UK has adhered. [FN56]

Finally, surface decoration is not excluded from CUDR protection, as the definition of design includes both three- and two-dimensional features. In this respect, the CUDR provides more protection than the UDR.

IV. PROTECTION REQUIREMENTS

A. UDR

In order for a design to be protected, it must first be recorded in a design document. [FN57] This document is defined as "any record of a design, whether in the form of a drawing, a written description, a photograph, data stored in a computer or otherwise." [FN58] Second, the design must be original, which already appears in the definition of design as indicated above. [FN59] The concept of originality is defined negatively in section 213 (4): "a design is not 'original' ... if it is commonplace in the design field in question at the time of its creation." Finally, as the UDR is a new right not covered by international agreements, protection is limited by qualification criteria. In order to benefit from the protection of design right, a person needs to be a designer, employer, commissioner or a person who first puts the product on the market in the United Kingdom or in the EU. [FN60] These persons can be nationals or residents, and individuals or companies.

1. Originality and commonplaceness

As can be seen from the wording of the Act, the protection requirement in the UDR is a combination of the copyright notion of originality and the new notion of "non-commonplaceness." Neither notions of originality and commonplaceness are *274 defined in the CDPA. As to originality, it was held early on in *C&H Engineering* [FN61] that the notion was common to both copyright and the UDR. Hence, as in copyright law, a design is original if it is not copied and is the fruit of the independent labor of the designer; it must be the result of skill, judgment and labor. [FN62] This notion of originality was followed by later courts [FN63] and is now well settled. Commonplaceness was first judged to be akin to the novelty requirement in patent law. [FN64] The *Ocular* case thereafter shed more light on the origins and meaning of the term: "commonplace" is derived from the Directive on the legal protection of

topographies of semi-conductors [FN65] and means hackneyed, trivial and that which does not attract the attention; a combination of commonplace aspects can be original but in general, such a combination will also be banal. Finally, the Court of Appeal definitely distinguished commonplaceness from novelty and set forth a test to establish a design's commonplaceness in *Farmers Build v. Carrier Bulk Materials*. [FN66]

Thus the issue of "originality" is determined in two steps: first, is the design original in the classical sense of copyright? Second, is the design commonplace in the design field in question? The test is thus stricter than that in copyright law since it introduces an additional condition, but it is less stringent than that in patent law since no condition of novelty is required in order for the design to be protected.

The precise workings of the test are as follows. First, the design of the article on which the UDR is claimed must be compared with the design of other articles in the same field, including the design of the alleged infringing article at the time of its creation. Second, the degree of similarity between the design in question and the design of similar articles in the same design field must be determined. This comparative exercise must be made objectively [FN67] with the help of the testimony of experts in the field in question, who must in turn show the similarities and differences between the designs and explain their relevance. Finally, it is the court who decides whether the design is commonplace or not on the basis of the facts in each case.

A few additional guidelines for establishing commonplaceness were given by the Court of Appeal. First, the greater the similarity between designs, the more probable that the designs are commonplace, especially if there is no causal link between them, such as copying. If several designers working independently come to analogous designs coincidentally, the most plausible explanation is that there is only *275 one way to design the article. [FN68] Second, a functional design which works better than a previous one will normally not be commonplace. Third, the UDR being close to copyright and the aim of copyright not being to protect the novelty of a work, the word "commonplace" must not signify "not novel." "Commonplace" must be interpreted restrictively in order to avoid having only a very few designs protected. Thus if the design is neither similar nor new, it can nevertheless be valid. A corroborating argument is that had the legislator wanted to require novelty it would have written it down clearly in the Act. Later on, courts further elaborated this finding by the Court of Appeal, holding that a few examples of obscure prior art will generally not imply that a design is commonplace. [FN69] It must also be noted that a commonplace article can have a non-commonplace design. A clear distinction must be made between the concepts of article and design; the appreciation of commonplaceness refers to the design of the article, not to the article itself. This is because the UDR does not confer a right on the article, but on one of the aspects of its shape or configuration. [FN70]

The notion of commonplaceness as elaborated in *Farmers Build* has been applied in *Scholes Windows v. Magnet* [FN71] and *Guild v. Eskandar*. [FN72] These cases show that the commonplaceness test seems to operate more harshly in the field of decorative designs than in the field of functional designs. [FN73] This is probably because there is greater likelihood of having a larger field of "prior art" in the field of decorative designs.

The *Farmers Build* test refers to the concept of the design field. However, this concept has not been much interpreted by courts. One is forced to note that the choice of design field is made by the judges through unknown criteria. Thus, a priori, this

choice seems to be arbitrary. Although it is not easy to draw clear lessons on this notion from the case law, the trend is to assume narrow fields; [FN74] only in *276 Scholes Windows, the court took the field of window design in general rather than the narrower field of PVC window design. The narrow view is consistent with legal history because the UDR was inspired by the Directive on topographies of semiconductor chips, of which article 2(2) states: "not commonplace in the semiconductor industry." [FN75] It seems that the narrower the field, the less commonplace the design will tend to be as the less prior art will be taken into account. Thus the courts tend to be in favor of a rather solid protection by the UDR. A final point is whether or not the field is restricted to British designs. Nowhere in the Act, nor elsewhere, is the design field restricted to UK designs; it is therefore preferable to interpret the Act as meaning that "if a design is commonplace in any country, then it is commonplace for the purpose of the section." [FN76] However, in the recent *Fulton v. Totes Isotoner* case, [FN77] it was held that the design field could only comprise British designs. The court held that designs commercialized outside the UK are not relevant for the determination of the commonplaceness of the design, because the UDR is a typically British right, the result of both political and historical reasons specific to the UK, and has no international dimension.

B. CUDR

Nowhere is the design required to be recorded in a design document, nor is it required that the right holder be a qualifying person - anyone can benefit from the CUDR, which is a strong advantage over the UDR. As opposed to being original and not commonplace, to gain protection by the CUDR, a design must be novel and have individual character. In addition, some designs need to be visible in order to be able to attract protection.

1. Visibility

Normally the rule is that a design need not be visible to the eye to qualify for CUDR protection. However, a criterion of visibility has been introduced under the provisions governing novelty and individual character relating to a design that is applied to or incorporated into a product which constitutes a component part of a complex product. For the design of a component part to be protected, the component part will have to be visible during the normal use of the product and its features must have individual character and be novel. [FN78] For example, parts of an exhaust pipe will *277 not be protected under the CUDR because they are not apparent during normal use of a car. However, as has been rightly pointed out, [FN79] article 4(2) as phrased, even if intended to exclude only designs for "under the bonnet" automobile parts, will leave out many other functional designs.

2. Novelty

Article 5 of the Regulation provides in substance that a design shall be considered new if no identical design has been made available to the public before the date the unregistered design has been first disclosed to the public. Designs shall be deemed to be identical if their features differ only in immaterial details; in other words, to be novel, the design for which registration is applied must differ from other designs in material details.

The test is an objective one, comprising a necessary and objective comparison between the design under consideration and the previous designs constituting the prior art. [FN80] The date for considering the existing prior art for purposes of novelty is

the date of filing of the application or the date of priority for registered designs. For unregistered designs, it is the date on which the design has been made available to the public. There are no factors or guidelines in the Regulation as to how to assess novelty, although factors currently taken into consideration under Member States' laws will surely play a role in assessing novelty. [FN81] Hence the following will be important: the extent of the designer's freedom in developing the design, the existence of a crowded design field, the application of a known design to a new product or medium, and the fact that the design is a novel arrangement of known design features. The novelty test is also a relative one, meaning that obscure designs will not be taken into consideration. Under article 7 of the Regulation, a design is not disclosed where the availability of the design could not reasonably have become known to the circles specialized in the sector and concerned in the normal course of business, operating within the Community. This "exception" has been provided in order to avoid the invalidation of design rights by potential infringers claiming that prior designs could be found in remote places or museums of which the European industry could not possibly be aware.

3. Individual character

Article 6 of the Regulation states that a design shall be considered to have individual character if the overall impression it produces on the informed user differs *278 from the overall impression produced on such a user, by any design which has been made available to the public before the date at which the unregistered design has been disclosed to the public. The individual character shall consider the degree of freedom of the designer in developing the design. Based on recital 14 of the Regulation giving indications as to how the criterion of individual character has to be assessed, U. Suthersanen identifies the assessment of individual character as a four-step test, [FN82] which can be summarized as follows.

First, the assessment of the individual character is relative to all designs that have been previously made available to the public. This step is the same as under the appreciation of novelty. [FN83]

Second, the notions of overall impression and of degree of freedom of the designer must be assessed.

The overall impression test reinforces the notion that the design must be looked at in its entirety. [FN84] This suggests a visual test, with the informed user's eye as the measure of the impression. [FN85] Under the test, even if there are some differences between the design in question and the prior design, if the overall impression is one of similarity, the subsequent design will not have individual character.

The assessment of the overall impression must take account of the degree of the designer's freedom in developing the design, as an objective consideration. It takes into account several factors: the functional character of the design; basic ideas; methods of construction; and whether the prior art is crowded.

Thirdly, "the criterion of individual character is gauged by the hypothetical informed user." [FN86] The informed user will normally, though not necessarily, be the end consumer or purchaser of the product, [FN87] as opposed to the skilled designer or design experts. However, some are of the opinion that the word "informed" suggests that "the user must have experience in the relevant trade or he or she must have in mind, not only the particular items of prior art relied on, but also a knowledge of the design and design conventions which are common general knowledge." [FN88] In other words, the informed user is a "design-oriented consumer." [FN89] In case of the internal part of a machine or a mechanical device replaced in the course of a repair,

the informed user will be the person replacing the part, rather than the design engineer. [FN90]

Fourthly, the assessment must also consider the nature of the product to which the design is applied or in which it is incorporated, and in particular the industrial sector to which it belongs - in other words, the design field. The Regulation gives no *279 indication how to determine the design field. In addition, it seems that even if the words "within the Community" are used for the assessment of disclosure for novelty and individual character, designs previously disclosed in other countries should also be taken into account. [FN91]

C. Comparison

1. Visibility

The UDR does not require a design to be visible. To take the example of the exhaust pipe, contrary to the CUDR, the UDR will protect its design as long as all requirements are fulfilled. But those hidden parts would in any case fall under the must-fit exception; in such a case, they might not be protected under the UDR either. Since, as has been stated above, the visibility requirement leaves out many functional designs other than "under the bonnet" vehicle parts, there are surely some instances where some invisible parts would on the contrary be protected under the UDR. A good example is the Farmers Build slurry separator and its internal parts. Thus to rely on the CUDR for designs of invisible parts of complex products rather than on the UDR constitutes a disadvantage for the designer.

The above explanation of the requirements of protection indicates three comparisons: one within CUDR law between novelty and individual character; a second between, novelty and individual character, on the one hand, and, originality and commonplaceness on the other; and the third between the concepts of individual character in CUDR law and of originality in copyright/UDR law.

2. Comparison between novelty and individual character

The notion of disclosure, overall impression, designer's freedom and design field are equivalent in both requirements of novelty and individual character. This leads some commentators to think, rightly, that practically the examination of the individual character requirement will likely absorb the examination of the novelty requirement, [FN92] rendering the latter redundant. [FN93] Therefore the concern that "the view ... that because of the binding regulation of article 25 of TRIPS, only one criterion - novelty or individual characteristic/originality - is admissible has thus apparently been ignored," [FN94] while being correct, is unimportant. Since one condition *280 absorbs the other, the fact that there are two requirements in the Regulation will not have much impact and in practice will not even really breach TRIPS.

In addition, the individual character requirement seems more demanding than novelty because it refuses protection to the global "d  j   vu" without regard to materially different details. [FN95] Also, that the degree of freedom of the designer in the elaboration of the design needs to be taken into account conjures up subjective originality: [FN96] "Individual character may well turn out to be interpreted as unconfessed 'original novelty.'" [FN97]

However, it is to be noted that some disagree with the contention that both requirements are similar or that one renders the other redundant since it encompasses it. [FN98] In their view, there are two differences between the two requirements. First, the person conducting the novelty test is the expert while it is the informed user

in the individual character test. However, this will rarely make a difference because the user is unlikely to spot a difference that the expert would miss. Moreover, it is possible that "enough individually immaterial differences might be assembled to lead to an overall different impression. In such a case, a design could lack novelty even if it had individual character." [FN99] The second difference is the nature of the test. Since novelty is assessed by the eye and individual character is assessed by impression (including sight and touch), it is possible, in some rare cases, that a design might have some visually minor difference that significantly affects the sense of touch. In this case, the design will lack novelty but will have individual character. To determine whether the two requirements are truly identical, it is thus necessary to establish whether the effects of differences on both senses are to be considered by the test person used in the novelty assessment. Since it seems that only sight is used to establish novelty, it might well be that the two requirements are different.

3. Novelty and individual character compared to originality and commonplaceness
The notions of novelty in the CUDR and of non-commonplaceness in the UDR, as interpreted in *Farmers Build, Scholes and Guild*, are quite close if not identical. To a large extent, the same notions hide behind different terminology. Both notions are relative, rather than absolute as in patent law. [FN100] They are also both objective tests. They both require a look at the prior art or design field. Obscure designs are excluded from this prior art. The CUDR test of novelty has not yet been interpreted by the Community design courts. As the notions of non-commonplaceness and relative novelty are quasi-identical, one cannot see why the courts, for the sake of *281 simplicity and harmony, could not interpret the notions in the same way and thus follow the *Farmers Build* approach. [FN101] A good reason to do so would be that the CUDR has been molded from the British UDR. If the courts opt for this approach, it provides another occasion for the designer to prefer to rely on the CUDR rather than on the UDR.

Comparison of individual character and non-commonplaceness leads to several observations. A visual test is used to assess individual character. Nothing else transpires from the Regulation, although some add that for designs of textures or materials, this test should be broadened to include the sensory impact on the informed user. [FN102] It is unclear whether such a test would also apply to the UDR. The issue is not covered by the CDPA and has not yet been decided by courts. However, following the recent case law which establishes the test of overall impression as a test of infringement, [FN103] it could be said to include the sensory impact on the user as well. It could be safely added that if the design is functional, a test similar to the one under the UDR could be used - for example, whether defendant's design embodies a similar form, taking into account the way the form operates to achieve its function. The test of non-commonplaceness in the UDR, which involves a comparison or a determination of the degree of similarity between the design in question and the design of other articles in the same field, [FN104] seems to mirror the necessary comparison involved in assessing the individual character of a design in CUDR. In the UDR as in the CUDR, the comparison must be conducted objectively. [FN105] The court in *Farmers Build* added that the test must be done with the help of the testimony of experts in the field in question, who must in turn show the similarities and differences between the designs and explain their relevance. This does not appear in the Regulation, so courts will need to decide in the future whether it should be required. In addition, the CUDR assessment of overall impression is close to the

"substantial similarity" infringement test in the UDR, which involves a global or overall impression as well. [FN106]

The assessment of the overall impression must take into account the degree of the designer's freedom in developing the design. The fact that methods of construction are considered shows that some of the UDR's excluded subject matter, such as methods of construction, are not being protected by the CUDR either.

The notion of the informed user compares to the UDR concept involving the person to whom the design is directed, which will normally be the purchaser. The CUDR proviso regarding the informed user in the case of replacement parts does not exist in the UDR, but can surely be envisaged in the same vein.

*282 The sectors or fields are determined narrowly under the UDR. There is no guidance in the Regulation on this point. Under the Regulation, it seems that even if the words "within the Community" are used for the assessment of disclosure for novelty and individual character, designs previously disclosed in other countries should be taken into account. This seems to mirror the opinion of the literature commenting on UDR despite the ruling in *Fulton v. Totes Isotoner*. [FN107]

To conclude, if the combined requirements of originality and non-commonplaceness in the UDR are not identical to the requirement of individual character, it can be said that they are close enough to it. Additionally, there are further details or refinements as identified above, such as the fact that the comparison between the designs must be conducted with the help of testimonies of experts in the field in question with the breadth of the design field to be taken into consideration, in the assessment of non-commonplaceness in UDR. This is normal due to the established case law in the area. It is expected that once cases come to the Community design courts, the concept of individual character will be further refined. Most probably, the courts will look at the case law relating to unregistered and registered design law throughout the Member States to elaborate further the test of individual character. The British UDR being the spiritual father of the CUDR, it will most probably have more influence in this respect than other rights.

4. Comparison between novelty and individual character in CUDR law and originality in copyright law

A few important differences between the protection requirements of CUDR and copyright can be sketched. First, individual character requires more objectivity than originality. It does not equate to either the notion of originality in continental Europe or in the UK; in fact it is a higher standard than both continental and British notions of originality. Individuality does not refer to creativity or the stamp of the designer's personality, [FN108] but is rather defined by differences of product compared to pre-existing products perceived by an informed user. [FN109]

Second, how individual character is appreciated will have a different impact at the infringement stage than the impact originality has at that stage in copyright law. [FN110] When the subject-matter is examined at the infringement stage, under continental copyright law, the similarities count despite any differences. Thus similarities will suffice to find infringement although there are differences. The test of overall impression is therefore different and less generous than the continental test of copyright infringement. The respective CUDR and UDR tests of individual *283 character and non-commonplaceness are similar, but both are remote from the corresponding notions in copyright law.

On the other hand, CUDR's appreciation of individual character bears two similarities with copyright. First, the assessment of the degree of the designer's freedom seems to

be similar to the copyright law principle of idea/expression dichotomy, whereby ideas and principles must be excluded from protection. [FN111] Second, some suggest that by analogy with strong and weak marks, highly individual designs could enjoy a greater protection than slightly individual ones. [FN112] It is submitted that a similar comparison with copyright can be made. As with some copyright works, the protection may be stronger or weaker depending on the design's degree of individuality. Historical, factual and functional works, such as compilations and computer programs, generally enjoy less copyright protection because the required level of originality is more difficult to attain. [FN113]

V. OWNERSHIP

A. UDR

Section 215 establishes as a principle that the designer is the author of his or her design. [FN114] If the design is computer-generated, the person by whom the arrangements necessary for the creation of the design are undertaken is the UDR owner. [FN115] Commissioned designs belong to the commissioner. Similarly, designs of employees are the property of their employer. [FN116] Finally, as regards joint authorship, the rule is the same as the rule applicable in copyright law. [FN117] Thus Parker [FN118] held that in order to be a co-author, the person must contribute to a significant part of the skill, judgment and labor involved in the work. The person must do more than simply give comments or suggestions on the work.

B. CUDR

Article 14 of the Regulation establishes the same principle as under section 215 CDPA: the design vests in the designer or his successor in title. With regard to designs made by employees, [FN119] the employer is the owner of the CUDR unless otherwise agreed or as specified under national law. Finally, article 14 (2) states that *284 "if two or more persons have jointly developed a design, the right to the Community design shall vest in them jointly." There is no further guidance on this point. The Regulation is also silent on commissioned and computer-generated designs; thus those issues are left to the national level.

C. Comparison

Rules regarding initial and employer ownership are the same in both laws. As regards joint, commissioned and computer-generated designs, since they are either not addressed in detail or left to Member States, British judges will certainly fall back on UDR law in this respect. As a result, there are no apparent differences between the UDR and the CUDR as regards ownership.

VI. TERM

A. UDR

Section 216 states that the term of the UDR will be the shortest of the three following: (1) 15 years from the last day of the year during which the design was recorded for the first time in a design document; or (2) 15 years from the last day of the year during which an article was made to the design; or (3) 10 years from the last day of the year during which the articles made to the design are exposed in order to be sold

or hired. Thus, depending on the circumstances, the term will be a minimum of 10 years or just below a maximum of 16 years. During the last five years of the UDR term, licenses of right are available to anyone. [FN120] Thus anybody is able to copy the design without infringing UDR during these five years.

B. CUDR

The length of the CUDR is three years from the date of its first availability to the public within the Community (art. 11(1) of the Regulation).

*285 C. Comparison

The duration of UDR varies but is practically speaking the length of time starting from the first commercialization of the article embodying the design, which is important, and thereafter 10 years. However, since during the last five years of this term licenses of right are available, usually the design right lasts in practice only for five years. Regarding length, the UDR, even in the "worst" cases, is more advantageous than the CUDR.

VII. RIGHTS

A. UDR

"The owner of a design right in a design has the exclusive right to reproduce the design for commercial purposes (a) by making articles to that design, or (b) by making a design document recording the design for the purpose of enabling such articles to be made." [FN121]

B. CUDR

The holder of a CUDR has the exclusive right to use it and to prevent any third party not having his consent from using it. The aforementioned use shall cover, 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. [FN122]

C. Comparison

The rights granted under CUDR law are more detailed because they include any use of the design, even if for non-commercial purposes. Nonetheless those rights can be said to be identical to those in the UDR. This is because even if section 226 of the CDPA only states "making articles to the design or making a design document recording the design for the purpose of enabling such articles to be made," it can be said with confidence that such a right also includes the acts referred to in the Regulation. It would not make sense that the holder of the UDR could not prevent the importation of infringing articles since this would fall into the notion of infringement under section 226(2) and (3). [FN123] The rights are also identical in both regimes because even if they are more broadly defined in the Regulation, noncommercial uses of a CUDR are thereafter excepted. [FN124]

*286 VIII. LIMITATIONS

A. UDR

Perhaps surprisingly, there is no exception to the UDR similar to the most well-known in the field of copyright and patent laws. The only exception is acquiescence. [FN125] In a way, since the right is relatively narrow, only encompassing reproduction for commercial purposes, exceptions do not need to be written down since they do exist implicitly. For example, an exception of "private use," noncommercial or domestic reproduction, can be deduced implicitly. [FN126] In addition, despite this relative lack of exceptions to rights, there are limitations to the subject of protection. [FN127]

B. CUDR

Limitations are provided in article 20 of the Regulation. There is first an exception for private acts and for acts for non-commercial purposes. Second, acts with experimental purposes are not infringements. Third, acts of reproduction for the purpose of making citations or of teaching, provided that such acts are compatible with fair trade practice, do not unduly prejudice the normal exploitation of the design and mention the source, are also non-infringing acts. A fourth exception is set out in article 20(2) covering equipment on ships and aircraft registered in a third country when these temporarily enter the territory of the Community; the importation in the Community of spare parts and accessories for the purpose of repairing such craft, and the execution of repairs on such craft, are deemed non-infringing when either of those activities would involve infringing the right.

C. Comparison

As can be seen, there are more exceptions under the Regulation than under Part III of the CDPA. Both regimes can be said to have in common only the private use exception. Since the exception of article 20(2) is less important due to its rather rare occurrence, what makes the CUDR less attractive than the UDR for the designer are the copyright-originating citation, educational exceptions and the experimental purposes exception when such an experiment is not made for private purposes but for commercial purposes. In conclusion, the UDR remains better for the right holder since it provides fewer exceptions. However the extent to which this will maintain the current levels of reliance on the UDR rather than the CUDR remains to be seen.

IX. INFRINGEMENT

A. UDR: Substantial Similarity - Visual or Functional Test?

*287 The test of infringement is enshrined in section 226(2) CDPA: [FN128] infringement of a design right is established by proving the design was copied so as to produce article(s) exactly or substantially from the design. The test, applied for the first time in C&H Engineering [FN129] and recently confirmed by the Court of Appeal in Woolley, [FN130] comprises two steps. First, copying must have occurred. Second, the design of the alleged infringing article must be identical or substantially similar to the protected design. The concept of copying is the same as in copyright law, namely that copying can be innocent, direct or indirect, [FN131] and that there must be a causal connection between the two articles. [FN132]

To discover whether the allegedly infringing design is identical or substantially similar to the protected design, the allegedly infringing design must be compared to the protected design. [FN133] The allegedly infringing article does not have to be of the same type. [FN134] This test must be objective and must use as a reference the

perspective of the person towards whom the design is directed. [FN135] Both the similarities and the differences between the two designs must be taken into account. [FN136] However, in some cases, the overall impression will be different, and even if the design has been copied, substantial similarity will be lacking. [FN137]

The C&H Engineering case is here summarized to illustrate how the test works. The design in this case consisted of the incorporation of a metal roll bar at the top of an ordinary pig fender. The metal roll bar was copied. However, the alleged infringing article was not an exact or a substantially similar copy of the protected design because, even though the two designs had the same roll bar in common, taken as a whole, the designs of the fenders were different. A person interested in the designs would definitely be struck by the differentiation in the aspects of the fenders that allowed them to be stacked, an aspect of the design that was only present in the defendant's design and not in the claimant's.

Another approach was taken in Ocular. When the design subsists in the detail and not in the general shape of an article, infringement requires similarity in detail. The shapes of the contact lenses were not visible with the naked eye and the design, consisting in their precise dimensions, was therefore not visible either. Some similarity in the dimensions of the lenses was necessary. This different approach is *288 due to the impossibility of applying the visual test since shapes were not visible with the naked eye.

In Woolley, the Court of Appeal was led to re-interpret the test of infringement. The Court ruled that the court of first instance had misapplied the UDR test, instead applying the copyright test. The Court of Appeal applied the test developed in C&H Engineering without referring to Ocular. Hence, nothing more than what was held in C&H Engineering transpires from this decision. The Court, however, insisted on the fact that with the UDR, contrary to copyright law, it can be insufficient to copy a part, even a substantial part. One must look at the UDR-protected design as a whole. The Court therefore remanded the case. In conclusion, the test is a visual one, or the test of "overall impression:" [FN138] does the allegedly infringing design produce the same global, overall impression on the person to whom the design is directed? In passing, it is to be noted that the test of substantial similarity in UDR is essentially the same as the test elaborated under the old registered design right law. [FN139]

While confirming the validity of the visual test in assessing infringement, the Woolley case has left unclear the application of other tests in situations where the design is functional rather than visual. The visual test is thus open to criticism. How can it be applied in cases where the design is functional and does not subsist in the visual aspect of the article? Another consideration is that when the design is copied but certain elements are added or the color is changed, there is, a priori, no infringement. [FN140] One can sense some inequity towards the designer in these cases. In conclusion, the visual test is inappropriate when the features are invisible and when they are functional. [FN141]

It is suggested that the visual test should apply when the aspects of the design may be appreciated by the eye, while for functional designs, the test should be whether the alleged infringing form performs a similar function to the protected design [FN142] or "whether the defendant's design embodies a form which is similar (taking into account the way the form operates to achieve its function.)" [FN143] For invisible designs, either a microscope may be used to discover the shapes and thus render the visual test adequate, or the similarity of the designs must be appreciated by way of comparing the physical dimensions. [FN144] If the design is invisible because the article cannot be dismantled, then the functional test could be applied.

B. CUDR

*289 Article 10 of the Regulation mimics the requirement of individual character. [FN145] The test in the CUDR involves two steps. The first is whether there has been copying. The second is whether the design produces a different overall impression on the informed user. Therefore in determining the scope of protection, the question to be asked is: does the allegedly infringing design produce an overall impression on the informed user that differs from that of the protected design? If it does not, then there is infringement. Similar to the assessment of individual character, the two designs must be considered in their respective entirety as opposed to focusing on specific details or features. However, the overall impression created on an informed user may include striking differences, which would escape the attention of an ordinary consumer. [FN146] It is also possible that there is no infringement if the same design is applied to a different product because the overall impression will be different. As under the condition of individual character, this suggests a visual test.

C. Comparison

The CUDR test of infringement closely resembles the corresponding test set out in UDR law. A first similarity is that since the UDR and the CUDR are both anticopying rights, there is no infringement if there is no copying. Second, both tests use the same notion of overall impression: with the UDR, the two designs must be looked at as a whole and the comparison must be objective; the same follows with the CUDR since the test reflects the individual character assessment. With regard to the UDR, both similarities and differences have to be examined. The Regulation does not go into this detail, but one can assume that since the designs must be considered as a whole in both rights, this assessment will apply in the case of CUDRs as well. The notions of "person to whom the design is directed" for the UDR and of "informed user" for the CUDR will very probably not differ. Overall, time will tell whether the Community Design courts will apply an infringement test that does or does not resemble the UDR test. However, everything seems to point at a similar assessment of infringement. Additionally, as the subject matter of CUDR covers both eye-appealing and functional designs, a similar remark can be made as under UDR: the infringement test might have to be altered to enable a test of "variable geometry," encompassing at least both a visual and a functional test.

Finally, it is relevant to note a major difference between the infringement tests of UDR on the one hand, and copyright on the other. In order to infringe under the UDR, the allegedly infringing design must be identical or substantially similar to the protected design. In this it differs from the copyright test, which requires that a substantial part of the work be copied. [FN147] The UDR protects less efficiently against copying than copyright. Indeed, if the copyright test were applied in C&H Engineering, it is apparent that as a substantial part (the roll bar) of the "work" (the *290 fender) would have been copied, infringement would be found. In this regard, the test as elaborated in C&H Engineering has been criticized because the UDR not only protects the visual aspects of an article but also of part of an article. [FN148] It is not clear from the decision why the claimant had only pleaded on the basis of the article as a whole, i.e. the fender, rather than the roll bar alone. Since this part was original, the judge would have concluded that it was infringed. It is nonetheless possible to circumvent this lesser protection by the UDR. Since the meaning of article is wide, the claimant can rely on the UDR subsisting in a part of the complex article, which itself also qualifies as an article, rather than on the UDR subsisting in the whole

article. [FN149] A related difference between the UDR test of infringement and that of copyright is that in copyright law, there is no need to compare the two works or to consider their differences and similarities through the eyes of a hypothetical consumer. Since UDR and CUDR infringement tests are analogous, the same difference exists between the respective copyright and the CUDR infringement tests.

X. RELATION WITH OTHER INTELLECTUAL PROPERTY RIGHTS

As is known, Community unitary rights are superimposed over national rights, adding a new layer over and above existing rights. The law does not prevent the cumulation of unregistered design rights with registered design rights, be they national or Community rights, nor does it prevent its cumulation with copyright. [FN150] However, one of the main aims of the 1988 reform of copyright in the UK was to clearly separate copyright for artistic works from design right for non-artistic forms. [FN151] Hence there was a marked intent to avoid the cumulation of protection between copyright and UDR in this respect. On the other hand, UDR only protects aspects of shape and configuration; surface decoration is excluded. Hence, no cumulation will occur between UDR and copyright and between UDR and RDR for two-dimensional aspects. Finally, nothing prevents a design from being registered or simply protected as a trademark.

*291 XI. CONCLUDING COMMENTS

In this part, the respective, current and prospective, success of the UDR and the CUDR, in general and compared to copyright, will first be summarized. Then a recapitulative comparison of the differences between UDR and CUDR will be made. This will highlight the advantages of one over the other. The conclusion will then be drawn: will the UDR survive the CUDR? In the light of these conclusions, the article will raise, merely as a subject worthy of further research, the questions of the appropriateness of the increasing trend of granting additional intellectual property rights and of the proper relationships between these rights.

A. General Considerations on the Success of UDR and CUDR

As this analysis has shown, there is not much litigation involving the UDR. [FN152] Since its coming into force in 1989, there have only been a dozen cases dealing with substantive matters relating to UDR, most having been decided between 1997 and 2002, including only two Court of Appeal decisions. In addition, there is no decision by the House of Lords in the area yet. All things considered, the small number of litigated cases is rather surprising as, since the 1988 CDPA reform, the law has restricted the scope of copyright for industrial objects and there were many copyright cases before 1988 involving the protection of such objects. [FN153] Perhaps that the UDR gives less protection than copyright explains the relatively low number of UDR-based cases litigated. However, this low number of cases remains strange since in theory at least, copyright and UDR are now almost totally mutually exclusive. Compared to other intellectual property rights, UDR is a very new right, [FN154] which has only just started to "shape" itself more or less concretely. D. Barron's 1999 comment, at the dawn of the UDR's tenth birthday, that the UDR "still has the feeling of an intellectual property right that has yet to be fully developed" [FN155] still holds partially true. UDR is still evolving: even if the notions of originality and commonplaceness as well as part of the infringement test seem now to be well-

established, decisions are still needed to indicate how to determine the design field and which test(s) of infringement to apply to functional and invisible designs. What of the CUDR? It is too early to be able to provide an assessment as it is barely two years old. [FN156] No cases involving CUDR have yet been litigated. But law firms have already started advising clients on its ambit. [FN157] As for its sibling, the CRDR, it is doing quite well; in less than a month, around 1200 designs had already *292 been registered at OHIM. [FN158] Although more time has to pass to evaluate its success, as has been pointed out, [FN159] in view of the cumulation that is allowed and the relative burden in registering a Community design, copyright might still remain king, both at the registered and unregistered level. [FN160] Some commentators criticizing the UDR for its meager scope of protection and duration, extend their criticisms to the CUDR. According to them, the CUDR has not yet achieved a satisfactory level of protection: first, the scope of protection and the infringement test are similar to that of the UDR and those features are not protective enough, and second, the CUDR's duration is even shorter than UDR. [FN161] Another indicator that copyright may remain the preferred protection is that both the level of originality is easier to reach and the copyright infringement test is more protective than the UDR and CUDR tests. In addition, the very possibility of accumulating diverse types of protection inevitably means that one of the two rights might become superfluous, where one overlaps in greater part or even absorbs the other. Whether copyright absorbs CUDR is a matter beyond the scope of this article. Until the issue of their co-existence is resolved, one will inevitably overshadow the other. [FN162]

B. Any Future for the UDR?

Will the UDR disappear with the introduction of the CUDR? The question depends on whether the CUDR absorbs the UDR; in other words, whether the protection is identical or very similar, in that the two differ only in immaterial details. With a small amount of minor differences, most likely the UDR will disappear naturally to the benefit of the CUDR. When recapitulating the similarities and differences between the UDR and the CUDR, the comparison shows that few differences separate the two rights. [FN163]

*293 First, as regards the nature of the right, they are both intellectual property rights. In addition, the CUDR has an advantage: it applies in the same way throughout the EU. Thus if it is infringed, it is infringed for the whole Community and there is no need to litigate in every Member State; a single infringement decision is sufficient. Furthermore, it can transform itself, like the frog into the prince, into a registered Community right within 12 months of its disclosure. Regarding protected subject matter, excluded subject matter, requirements, ownership, rights and infringement, the CUDR will absorb the UDR. The CUDR holds a few additional advantages. Surface decoration is protectable. Because of the definition of product, the interconnection exclusion will not apply to all "living parts" (humans, animals or even plants). In addition, designs of modular systems will be protected by the CUDR, as opposed to the UDR. Nowhere is it required that the design be recorded in a design document. And there is no need to be a qualifying person to benefit from the CUDR. However, the CUDR has three disadvantages over the UDR. First, the criterion of visibility for complex products restricts the subject-matter of protection. Second, the CUDR does not last as long. And third, the rights are more limited.

In conclusion, one can identify seven advantages and three disadvantages of the CUDR as compared to the UDR. Will these disadvantages really make any

difference? The criterion of visibility seems perhaps the most onerous disadvantage of the CUDR. However its aim, like that of the UDR, was to avoid the protection of spare parts designs. Thus, whether it will have a broader scope than the must-fit exception remains to be seen. It is hard to tell whether the two more years of UDR protection matter. Perhaps the longer duration will influence sectors like those where it takes longer to recoup investments, to rely preferably on the UDR. Finally, the three additional exceptions provided for in the CUDR are not very threatening. It seems that they might not direct the choice of the UDR rather than the CUDR, except perhaps for the exception of use for experimental purposes. In conclusion, it is difficult to assess the extent to which the three differences between the UDR and the CUDR will influence the reliance on the UDR rather than the CUDR. It is undeniable that CUDR is in many more respects more attractive for right holders than the UDR, but it does not seem to mean that the UDR will totally disappear. Nevertheless, the numbers of cases relying on the UDR may certainly tend to diminish. [FN164]

Member States are not obligated to align their national unregistered design laws with the Community design. Thus the UK is not obligated to change its current UDR and has not done so. In many respects, the CUDR, which took the British unregistered design as a model, unsurprisingly copies and even absorbs the latter. However, it generally also broadens its scope, except to some extent for the narrower concept of product as compared to article and the visibility criterion of complex products. On the other hand, it also adds a few exceptions to the rights. In this connection, if the UDR is utilized less or even not utilized at all anymore due to this unification, the Community lawmaker will have indirectly harmonized national unregistered design laws as well, killing two birds with one stone. For the sake of simplicity, it would not be too damaging if the UDR naturally faded from the legal *294 landscape. [FN165] However, there is a glimmer of hope that it can remain, as a few of its features can still be of use and even appealing to right holders, compared to those of the CUDR. This is so especially if the right holder does not consider the whole Community, but is a manufacturer with an exclusively local market. In addition, it offers a good basis on which to rely for products which cannot attract copyright protection and cannot be CUDR-protected either.

It will be interesting to see how the British judges will continue to accommodate the different notions, concepts, requirements, etc. in national design law. Equally, the fact that the CUDR and the CRDR are substantially the same strongly implies that UK design right case law might serve as a model for the Community design courts in interpreting some provisions, especially the similar and identical ones, and ironically even if the UDR finally disappears. One can only hope that the new state of play will not further complicate the matter, since certain areas can already be protected by no less than nine different intellectual property and related rights. [FN166]

C. Plethora of IPR and Their Proper Relationships

This discussion of the relationships between the UDR and the CUDR brings out a more fundamental issue: the ever-growing plethora of intellectual property rights and the relationships amongst them. [FN167] In less than 15 years, there has been a sustained trend to create new intellectual property rights, at least at the EU level, that started with the enactment of the semi-conductor chip sui generis right, followed by the database sui generis right and the CUDR, and ending with the proposal for a utility model. Layers were added to the traditional level of intellectual property rights, even while attempts were being made to harmonize and unify intellectual property laws. While there is a generally sound and global approach to the harmonization and

unification of the main industrial property rights, the deliberately taken piecemeal approach to copyright inevitably impacts the relationship between copyright and other intellectual property rights. [FN168] This is especially relevant for borderline subject-matter, such as computer programs and works of applied art.

Although there is harmonization within intellectual property rights themselves, respectively within patents, trade marks, copyright and designs, this legislative approach does not address the issues globally; i.e. it leaves the relationship between rights unharmonized and relatively unorganized. Generally, the "end articles" of Community legal instruments in the field of intellectual property ultimately state *295 simply that protections are without prejudice against one another. [FN169] Ironically, they are added to the end of legislative texts, [FN170] whereas the issue of the organization of the relationship among the rights is perhaps one of the most fundamental issues regarding rights. The Community's initial and current approach was perhaps to first attempt a harmonization inside each right and to leave the harmonization of rights inter se to a second stage. Time has now come to start tackling this second phase, and especially to delve into the relationship between copyright and other rights. [FN171] Indeed if new sui generis rights are introduced or even if certain traditional intellectual property rights are harmonized, the need to accommodate their imbrication with other intellectual property rights harmoniously must also be sustained. [FN172] The final aim of the Commission, in its role of initiator of proposals, and more generally the aim of the European Community legislative bodies, should be "harmonious inter se harmonisation." Despite the obvious fact that the field of copyright law is the least harmonized of intellectual property fields and is therefore in need of further approximation, the Community would also be well-advised to read through its set of numerous Directives and Regulations and begin to create more links between them.

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[FN1]. Parliament Directive 98/71/EC, 1998 O.J. (L289) 28 (on the legal protection of designs)[hereinafter the Directive], implemented in the UK by Registered Designs Regulations, No. 3949 (2001)(Eng.), which entered into force on 9 December 2001.

[FN2]. Council Regulation 6/2002/EC, 2002 O.J. (L003) 1 (on Community designs)[hereinafter the Regulation].

[FN3]. 1990 Draft for a Community Design, 1990 *Gewerblicher Rechtsschutz und Urheberrecht Internationaler Teil* [GRUR Int.] 559 (1990) translated in 22 *Int'l Rev. of Indus. Prop. & Copyright* L. 523 (1991).

[FN4]. The clearest difference is that Community unregistered designs are protected only for three years. On the CUDR, see Victor Saez, *The Unregistered Community Design*, 24(12) *Eur. Intell. Prop. Rev.* 585 (2000). On the registered Community design, see e.g. William T. Fryer III, *European Union (EU) Revolutionizes General Industrial Design Protection*, 84 *J. Pat. & Trademark Off. Soc'y* 899 (2002); Charles-Henry Massa & Alain Strowel, *Community design: Cinderella Revamped*, 25(2) *Eur. Intell. Prop. Rev.* 68 (2003).

[FN5]. Apart from the UK, only two former colonies, namely Hong Kong and New Zealand, have such a right. See *Design and Copyright Protection of Products: World Law and Practice* (Morag MacDonald et al., eds., 1997). For literature on the UDR, see e.g., Lionel Bently & Brad Sherman, *Intellectual Property Law*, 632 (2001); William Cornish & D. Llewelyn, *Intellectual property Patents Copyright, Trade Marks and Allied Rights*, 535 (2003); Jeremy Philips & Alison Firth, *Introduction to Intellectual Property Law*, 370 (2002); *The Modern Law of Copyright and Designs* (Hugh Laddie et al., eds., 2000); Martin Howe & Russell-Clarke on *Industrial Designs* (1998); Uma Suthersanen, *Design Law in Europe*, 1, 224 (2000); Christine Fellner, *Industrial Design Law* (1995); From the same author, see *Industrial Design Rights, an International Perspective* 75, 295 (Brian W. Gray & Effie Bouzalas eds., 2001); Kevin Garnett et al., *Copinger and Skone James on Copyright* (1999); Lionel Bently & Alain Coulthard, *From the Commonplace to the Interface: Five Cases on Unregistered Design Right*, 19(8) *Eur. Intell. Prop. Rev.* 401 (1997); Jane Mutimear & Susan Storor, *From Pig Fenders to Baby Gates: a Review of Unregistered Design Right in the United Kingdom*, 86 *Copyright World* 31 (1998/99); David Barron, *Unregistered Design Right: Ten Years On*, 91 *Copyright World* 27 (1999); Sara Ashby, *Protection of Designs: U.K. Design Right Under the Copyright, Designs and Patents Act, 1988*, 23(5) *Eur. Intell. Prop. Rev.* 255 (2001).

[FN6]. *Act for the Encouragement of the Arts of Designing and Printing of Linens, Cottons, Calicoes and Muslin, 1787*, 27 *Geo. 3*, c.38 (Eng.). The current UK design law is the *Registered Designs Act 1949 [RDA]* as amended in 2001 by the implementation in British law of *Parliamentary Directive 98/71/EC*, supra note 1 at 28. References to the earlier version of the RDA will be to the un-amended *Registered Designs Act 1949*, 12, 13 & 14 *Geo. 6*, c.88 [hereinafter old RDA].

[FN7]. See *Copyright, Designs, and Patents Act, 1988*, c.48 § 213-64 (Eng.) [hereinafter CDPA]. The origin of the UDR is *Council Directive 87/54/CEE, 1987 O.J. (L 24) 36* (on the legal protection of topographies of semi-conductors), which is itself derived from the *Semiconductor Chip Protection Act of 1984*, codified in 1988 in 17 *U.S.C* § 901-14. See Uma Suthersanen, supra note 5 at no. 16-024, 16-280.

[FN8]. For a criticism of the overly restrictive scope of UDR, see David Bainbridge, *Why the Design Right is Failing Innovators*, 21(9) *Eur. Intell. Prop. Rev.* 423 (1999). For a criticism of the Community Design, see James Lahore, *The Protection of Functional Designs: The Amended Proposal for a European Design Directive*, 1 *Intell. Prop. Q.* 128, 130 (1997).

[FN9]. *Copyright, Designs and Patents Act, 1988*, c.48, § 213 (1) (Eng.).

[FN10]. *Id.* at § 213(2). By the word "article," the CDPA refers to what one commonly understands by "product," although this latter word is never used. On the contrary, the Directive and the Regulation use the term "product." That the terminology is important shall be seen below.

[FN11]. *Guild v. Eskandar* [2003] *F.S.R.* 3 (C.A.).

[FN12]. *Mark Wilkinson v. Woodcraft Designs*, [1998] *F.S.R.* 63 (fitted kitchen units); *Dyrlund Smith A/S v. Turberville Smith Ltd.*, [1998] *F.S.R.* 403 (office

furniture); *Frayling Furniture v. Premier Upholstery*, unreported decision of 5 November 1998 (Ch.D.) (chair).

[FN13]. *Carflow Products (UK) Ltd. v. Linwood Securities (Birmingham) Ltd.*, [1996] F.S.R. 424 (Pat. Ct.).

[FN14]. *Lone Star Toys Ltd. v. J.M. Enterprises of Whetherby Ltd.*, [1996] F.S.R. 857 (Pat. Ct.).

[FN15]. *Amoena v. Trulife*, SRIS C/72/95 (May 25, 1995) (unpublished).

[FN16]. *P.B. Cow v. Cannon Rubber Manufacturers (No. 1)*, [1959] R.P.C. 240.

[FN17]. *Sommer Allibert (U.K.) Ltd. v. Flair Pastics Ltd.*, [1987] R.P.C. 599 (C.A.). Although the Cow and Sommer decisions concern registered designs, their relevance lies in that the notion of configuration is the same in both UDR and old RDA.

[FN18]. In a case concerning contact lenses the High Court held that the microscopic dimensions of the lenses were protectable. See *Ocular Sciences Ltd. v. Aspect Vision Care Ltd.*, [1997] R.P.C. 289 (Pat. Ct.).

[FN19]. Under the old RDA, eye-appeal was one of the conditions in order to benefit from protection.

[FN20]. Council Regulation 6/2002, *supra* note 2 at 8. Article 27, entitled "Dealing with Community designs as national design rights" states: "1. Unless Articles 28, 29, 30, 31 and 32 provide otherwise, a Community design as an object of property shall be dealt with in its entirety, and for the whole area of the Community, as a national design right of the Member State in which: (a) the holder has his seat or his domicile on the relevant date; or (b) where point (a) does not apply, the holder has an establishment on the relevant date." (Emphasis added).

[FN21]. Community trademarks and Community designs are both registered by the Office for Harmonisation in the Internal Market, based in Alicante.

[FN22]. Council Regulation 6/2002, art. 1(3), *supra* note 2 at 4.

[FN23]. *Id.* art. 3(a) at 4.

[FN24]. *Id.* art. 3(b) at 4.

[FN25]. See David Musker, *Community Design Law: Principles and Practice*, n. 1-011 (2002).

[FN26]. *Id.* at n. 1-012, referring to the Oxford Dictionary. The Original Green Paper draft at art 3(a) also refers, while describing appearance, to features capable of being perceived by the human senses as regards form and/or color. The Explanatory Memorandum of the original proposed Directive also refers to sight and tactility.

[FN27]. *Id.* at, n. 1-012.

[FN28]. For the interpretation of the term "article," see *infra* subsection 3.A.

[FN29]. This does not mean that aspects of the human body could not be protectable, such as a new hairstyle, tattoo or make-up. See e.g. Musker, *supra* note 25 at n. 1-025.

[FN30]. On this exception, see *infra* subsection 3.B.

[FN31]. Section 213(3) of the Copyright, Designs and Patent Act states that Design right does not subsist in (a) method or principle of construction; (b) features of shape or configuration of an article which i) enable the article to be connected to, placed in, around or against, another article so that either article may perform its function or ii) are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part; or (c) surface decoration. Copyright, Designs and Patent Act, 1988, c.48, § 213(3) (Eng.). On the must-fit exception, see Elizabeth Green, *Unregistered Design Right in Practice*, 79 *Copyright World* 32 (1998); Jane Mutimear, *Unregistered Designs*, 21 *Eur. Intell. Prop. Rev.* N30 (1999), discussing *Baby Dan SA v. Brevi SRL*, [1999] F.S.R. 377 (Eng. Ch. 1998).

[FN32]. *Kestos Ltd v. Kempat Ltd & Vivian Fitch Kemp* [1936] R.P.C. 139 (Eng. Ch. 1935). *Kestos* was decided under the old RDA but since provisions are the same in both old RDR and UDR law, this case is relevant for the UDR.

[FN33]. *Id.* at 151 (quoting Alan Daubney Russell-Clarke, *Copyright in Industrial "Designs"* 17 (1930)).

[FN34]. *Parker v. Tidball*, [1997] F.S.R. 680 (Eng. Ch. 1997).

[FN35]. See *Baby Dan SA v. Brevi SRL*, [1999] F.S.R. 377 (Eng. Ch. 1998).

[FN36]. Copyright, Designs and Patent Act, 1988 c.48 (Eng.).

[FN37]. Council Directive 98/71/EC, *supra* note 1, at 30 (recital 19); Council Regulation 6/2002, *supra* note 2, at 2 (recital 13).

[FN38]. For an explanation of the workings of the exception in the UDR, see Bently & Sherman, *supra* note 5, at 637-9.

[FN39]. *Electronic Techniques (Anglia) Ltd. v. Critchley Components Ltd.*, [1997] F.S.R. 401 (Eng. Ch. 1996).

[FN40]. Bently & Sherman, *supra* note 5, at 636.

[FN41]. Already in *Electronic Techniques* the word "article" was held to have a wide meaning. For arguments *contra*, see *Renaissance Design NPD v. Greenscreen*, 21 June 1996, unreported (face masks and filter for cyclists).

[FN42]. *Ocular Sciences v. AVCL*, [1997] R.P.C. 289 (Eng. Ch. 1996).

[FN43]. This aspect of the Ocular ruling has been restated in Parker, in which the judge noted that certain aspects of the shape of a mobile phone case were excluded from protection because they allowed the cases to be placed around the thumb.

[FN44]. See supra note 15.

[FN45]. See Mark Wilkinson, [1998] F.S.R. 63 (Eng. Ch. 1997).

[FN46]. Jo-Y-Jo v. Matalan Retail, [2000] E.C.D.R. 178 (Eng. Ch. 1999).

[FN47]. Council Regulation 6/2002, supra note 2, at 5, 8.

[FN48]. Musker, supra note 25, at n. 1-094, 52.

[FN49]. See also Designs Practice Notice (DPN) 5/03, Patent Office, Aug. 18, 2003, (Eng.) (regarding the corresponding article of the Directive, the Directive goes in the same direction); available at www.patent.gov.uk/design/reference/dpn/dpn0503.htm.

[FN50]. Id.

[FN51]. In support of this, see Bently & Coulthard, supra note 5, at 405. The effect of the Ocular and Parker decisions seems to be that "to enable" in the must-fit exception is similar to the idea of features being dictated by function in the old UK RDR regime. They suggest that in view of legislative history, the two exceptions have the same scope. Since the old RDR exception is phrased in similar terms to the exception in the Regulation, one can assume the same conclusion applies to the CRDR and CUDR.

[FN52]. Emphasis added.

[FN53]. However, the courts could base themselves on one of the two different views stemming from case law in UDR; See e.g. Amoena or Ocular, infra part 2.1.

[FN54]. Council Regulation 6/2002, supra note 2, at 5, art. 8: "Notwithstanding paragraph 2, a Community design shall under the conditions set out in Articles 5 and 6 subsist in a design serving the purpose of allowing the multiple assembly or connection of mutually interchangeable products within a modular system." Modular systems are not defined but include for example fittings which permit a chair of a specific make to be stacked or to be fitted in rows to other chairs of the same make, or, the interconnecting element of toys designed in order for them to be assembled. See Explanatory Memorandum.

[FN55]. The only reported case is Masterman's design, [1991] R.P.C. 89 (Registered Designs Appeal Tribunal, 1990) (concerning a male doll whose genitals could be seen by lifting his kilt; it was decided that the design was not contrary to morality).

[FN56]. Although the Paris Convention for the Protection of Industrial Property does not make it illegal to register or protect designs incorporating emblems and the like, but only prohibits the incorporation of trademarks, it can be assumed that the UK would be reluctant not to apply the same provision to designs. Paris Convention for

the Protection of Industrial Property, Mar. 20, 1883, as last revised July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305.

[FN57]. Copyright, Designs and Patent Act, 1988, c. 48, § 213(6) (Eng.).

[FN58]. Id. § 263(1). See also id. § 51 (using the same definition).

[FN59]. Id. § 213(1).

[FN60]. Id. §§ 213(5)-220.

[FN61]. C&H Engineering v. Klucznik & Sons, [1992] F.S.R. 421 (Eng. Ch. 1992).

[FN62]. Although this interpretation was not explicitly held in C&H Engineering, it was confirmed in subsequent decisions.

[FN63]. Respectively in Amoena, Ocular, and Parker (*supra* at notes 15, 18, and 34). See also *Farmers Build v. Carrier Bulk Materials*, [1999] RPC 461.

[FN64]. C&H Engineering, *supra* note 61.

[FN65]. See *supra* note 7, at art. 2(2).

[FN66]. *Farmers Build*, *supra* note 63. This case was the first (reported) Court of Appeal case relating to the UDR. It was confirmed and very slightly re-elaborated in a more recent case, *Guild v. Eskander*, [2003] FSR 23 (CA). *Farmers Build* concerned a slurry separator, i.e. a machine that separates slurry in solid and liquid parts to be used as fertiliser. For an account of this case, see Caddick and Radcliffe, *When is a Design Commonplace*, 21 *Eur. Intell. Prop. Rev.* 264 (1999).

[FN67]. This finding originally comes from *Ocular*, as cited by Suthersanen, *Design Law*, *supra* note 5, no. 16-296, at 308.

[FN68]. [1999] RPC 482-483. See also *Howe, Russell-Clarke*, *supra* note 5, no. 4-41, at 143. *Howe* notes that it is irrelevant that a design is not novel as long as it is not commonplace, in the sense that it already exists provided that it was made independently and not copied.

[FN69]. See *Frayling*, *supra* note 12, and *A. Fulton Company v. Grant Barnett & Co.*, [2001] RPC 16. *Garnett, James and Davies*, first supp. 2002, *supra* note 5, no. 13-78, at 137. See also *Fulton v. Totes Isotoner*, [2003] RPC 499, commented on by Harris and England, *Unregistered Design Right: Meaning of "Commonplace" - Relevance of "Prior Art"*, 25 *Eur. Intell. Prop. Rev.* 43 (2003), affirmed by the Court of Appeal in *A. Fulton Co Ltd v. Totes Isotoner (UK) Ltd*, [2003] EWCA Civ 1514. "The fact that an example of a design could be found in the UK public domain was not of itself sufficient for the design to be commonplace. This was not a 'novelty exercise.' The design example needed to be more than merely a museum piece or something commercially obscure."

[FN70]. This has been reiterated and applied in *A. Fulton Company*, *supra* note 69.

[FN71]. [2001] EWCA Civ 561. The claimant claimed UDR on the design of a window in U-PVC, whose aim was to imitate a traditional sash window. One of the aspects of the design was "horns" imitating Victorian horns. Since there were a lot of documents from that era with similar designs, the design was held to be commonplace.

[FN72]. Supra note 11.

[FN73]. See Bently and Sherman, *Intellectual Property Law*, supra note 5, at 640.

[FN74]. In *Farmers Build*, the field was of slurry separators, and therefore very narrow (as opposed to a field of agricultural machines). The court stated that evidence relating to agricultural machinery generally or engineering fields other than slurry separators was irrelevant to the question of what was commonplace. [1999] RPC at 476. In *Mark Wilkinson*, supra note 12, the court merely stated that the field was not the field of cabinetry but the narrower field of fitted kitchen furniture. Other examples include *Round Imports v PLM Redfean Ltd.*, [1999] 22(7) I.P.D. 22071 (field of the design of long-necked beer bottles); *Spraymiser Ltd. v. Wrightway Marketing Ltd.*, [2000] E.C.D.R. 349 (field of wooden configurable figures of human form). *Garnett, James and Davies*, first supp. 2002, supra note 5 at no. 13-80. Finally, in *L. Woolley Jewellers Ltd. v. A&A Jewellery Ltd.*, [2003] FSR 15; reported by M. Harris, 24 Eur. Intell. Prop. Rev. 195, which concerned a pendant, the relevant field was the field of coin-mounted jewellery design and manufacture.

[FN75]. *Laddie, Prescott & Vitoria*, *Modern Law of Copyright*, supra note 5, at 2185, prefer a wide definition of design field but note that it is both inconsistent with *Farmers Build* and legislative history.

[FN76]. *Id.* at 2184, *Howe, Russell-Clarke*, supra note 5, no. 4-46, at 145 and *Garnett, James and Davies*, supra note 5, no. 13-81, at 740:

It is not clear whether the design field is limited to the UK or whether a court may look at the international position A design might become well known in the UK within the design field in question even though no article made to the design has been or is being marketed in the UK.

[FN77]. Supra note 69.

[FN78]. Paras. (2) and (3) of art. 4 of the Council Regulation EC No. 6/2002, 12 December 2001, on Community designs state that:

2. A design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character: (a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter; and (b) to the extent that those visible features of the component part fulfil in themselves the requirements as to novelty and individual character. 3. "Normal use" within the meaning of paragraph (2)(a) shall mean use by the end user, excluding maintenance, servicing or repair work.

Art. 3, sec. 1, (b) and (c), define what a complex product is: a product composed of multiple components that can be replaced permitting disassembly and reassembly of

the product. For an article on the visibility requirement, see David Musker, Hidden Meaning? UK Perspectives on Invisible in Use Designs, 25 Eur. Intell. Prop. Rev. 450 (2003).

[FN79]. See Lahore, Protection of Functional Designs, *supra* note 8.

[FN80]. Suthersanen, Design Law, *supra* note 5, no. 6-037, at 37.

[FN81]. *Id.* at 37.

[FN82]. Suthersanen, Design Law, *supra* note 5, no. 6-040 to 6-048, at 38- 40.

[FN83]. See art. 7 of the Regulation for the notion of disclosure common to both novelty (art. 5) and individual character (art. 6).

[FN84]. See also Musker, Community Design Law, *supra* note 25, no. 1-056, citing the Green Paper, para. 5.5.8.2.

[FN85]. See Recital 13 of Directive 98/71/EC on the legal protection of designs. However, some argue it is broader (see below, subsection 4.C.2).

[FN86]. Suthersanen, Design Law, *supra* note 5, no. 6-046, at 39.

[FN87]. See e.g. Musker, *supra* note 25, n. 1-055, at 32.

[FN88]. R. Durnyn, European Community Design Law, in *Industrial Design Rights, an International Perspective 89* (Brian Gray and Effie Bouzalas, eds., 2001).

[FN89]. Musker, *supra* note 25, n. 1-055, at 32, referring to the Max Planck draft.

[FN90]. Suthersanen, Design Law, *supra* note 5, no. 6-046, at 39. She adds, as regards the hypothetical user test in general that "the degree of knowledge presumed on the part of the informed user will be difficult to evaluate." Inevitably, a similar consideration can be formulated with regard to the UDR. In both laws, this assessment will surely be subject to some degree of subjectivity.

[FN91]. See Herman Speyart, The Grand Design: An Update on the E.C. Design Proposals, following the Adoption of a Common Position on the Directive, 19 Eur. Intell. Prop. Rev. 603, at 607 (1997):

Despite the wording 'within the Community,' this clause is rather flexible because it actually provides that trend-setting designs from outside the Community must be taken into account. Futon designers, for example, cannot afford to ignore developments in Japanese design. In this example Japanese futons can be taken into account in nullifying the novelty of (quasi-) identical European futon designs.

See also Saez, Unregistered Community Design, *supra* note 4, at 587, who confirms that "there are no geographical limitations for assessing the novelty and the individual character of a design."

[FN92]. Massa & Strowel, Community Design, *supra* note 4, at 73.

[FN93]. Speyart, *Grand Design*, supra note 91, at 607: "Indeed, designs which produce different overall impressions (individual character) will a fortiori differ in details which are more than immaterial (novelty)."

[FN94]. A. Kur, 'Freeze Plus' Melts the Ice - Observations on the European Design Directive, 30 *Int'l Rev. Indus. Prop. & Copyright L.* 6, 623 (1999), referring to Speyart, supra note 91, at 607, who rightly points out that according to the last version of the draft Directive (published in 1996), there is no absolute necessity for a terminological distinction between the requirements for protection.

[FN95]. Massa & Strowel, *Community Design*, supra note 4, at 73.

[FN96]. *Id.*

[FN97]. *Id.* Herman Speyart expresses the same idea in another fashion: individual character sounds like an "objectivated originality criterion." See Speyart, supra note 91 at 606.

[FN98]. See Musker, supra note 25, at 27-28.

[FN99]. *Id.*

[FN100]. However note that in *Farmers Build*, Rattee J. decided that the machine was not commonplace since there had been no other machine like it on the market. Interestingly, he took into account the fact that the claimant's machine performed significantly better than its predecessors, a factor that bears some similarities to the "long-felt want" test for obviousness in patent law. See Bently and Coulthard, supra note 5, at 406-407.

[FN101]. I.e. (1) the greater the similarity between designs, the more probable that the designs are commonplace, especially if there is no causal link between them such as copying. (2) If several designers working independently come to analogous designs coincidentally, the most plausible explanation is that there is only one way to design the article. (3) A functional design which works better than a previous one will normally not be commonplace. It has been remarked that the appreciation of the design as a whole is missing from the approach, whereas it is a component of the appreciation of novelty under CUDR. However, a test of overall impression appears at the infringement stage in UDR. See also below the comparison between commonplaceness and individual character.

[FN102]. Suthersanen, supra note 5, at 39. Musker, supra note 25, at 27- 28.

[FN103]. See Woolley, supra note 74.

[FN104]. As construed by the Court in *Farmers Build*, supra note 74.

[FN105]. See next paragraph for the discussion of the "degree of freedom of designer."

[FN106]. See supra, note 103 and infra section 9.A.

[FN107]. See *supra* note 66 and accompanying text. In this case, the court held that only designs commercialized in the UK could be taken into consideration to assess commonplaceness.

[FN108]. Stefan Martin, *Les dessins et modèles communautaires: analyse du Règlement no 6/2002 du Conseil du 12 décembre 2001*, 15 *Les Cahiers de Propriété Intellectuelle* 1, 147 (2002). It is interesting to note that the terms "individual character" have been used by the Belgian Supreme Court to define originality in copyright law (Cass., 27 April 1989, Pas., 1989, 1, 908). For a discussion see Alain Strowel & Estelle Derclaye, *Droit d'Auteur et Numerique: Logiciels, Bases de Données, Multimedia* 27 (2001). It seems quite apparent here that the terms 'individual character' cover another notion.

[FN109]. See Martin, *supra* note 108, at 147.

[FN110]. The concept of originality in copyright law is reflected at the infringement stage. Similarly, the CUDR concept of individual character is reflected at the infringement stage as well. See below.

[FN111]. This is especially close to the test of infringement elaborated for computer programs in the U.S. case *Computer Associates v. Altai*, 982 F. 2d 693 (2nd Cir. 1992). The filtration step involves eliminating ideas, facts, functionalities, standards, things dictated by external factors or by considerations of efficiency.

[FN112]. Massa & Strowel, *supra* note 4, at 75.

[FN113]. Alain Strowel, *L'originalité en droit d'auteur: un critère à géométrie variable*, 110 *Journal des Tribunaux* 513 (1991).

[FN114]. Confirmed by *C&H Engineering*, *supra* note 61.

[FN115]. Copyright, Designs and Patent Act 1988, c. 48, § 214(2) (Eng.).

[FN116]. *Id.* at §§ 215(1)-(3). A commissioned design must be commissioned for money or money's worth. The employee is defined as the person employed under a contract of service or apprenticeship. See *Id.* § 263 (1).

[FN117]. Established in *Cala Homes v. McAlpine*, [1995] FSR 818.

[FN118]. See *supra* note 34.

[FN119]. The Regulation further specifies "in the execution of his duties or following the instructions given by his employer" which reflects the law under UDR and copyright.

[FN120]. Copyright, Designs and Patent Act, 1988, c. 48, § 237 (Eng.).

[FN121]. Copyright, Designs and Patent Act 1988, c. 48, § 226 (Eng.).

[FN122]. Art. 19 of Council Regulation of 12 December 2000, *supra* note 2, at 7.

[FN123]. See *infra*, section 9.

[FN124]. See *infra*, section 8.

[FN125]. See *Farmers Build*, in which the Court of Appeal rejected the application of the exception in that particular case. *Farmers Build*, [1999] RPC at 461.

[FN126]. *Suthersanen*, *supra* note 5, at 315.

[FN127]. See *supra*, subsection 3.A.

[FN128]. "Reproduction of a design by making articles to the design means copying the design so as to produce articles exactly or substantially to that design"

[FN129]. *Supra* note 61.

[FN130]. See *supra* note 74.

[FN131]. Copyright, Designs and Patent Act, 1988, c. 48, § 226(4) (Eng.).

[FN132]. See especially *Ocular Sciences*, [1997] RPC, at 289; *Parker* [1997] FSR, at 680; and *Mark Wilkinson*, [1998] FSR, at 63.

[FN133]. *C&H Engineering*, [1992] FSR at 421.

[FN134]. *Garnett, James & Davies*, *supra* note 5, at 771.

[FN135]. For *Suthersanen*, this means the potential user or customer. See *Suthersanen*, *supra* note 5, at 313. In *Mark Wilkinson and Baby Dan*, the visual test was applied and refined: the person to take into consideration is the person to whom the design is directed as already previously held in *C&H Engineering*, but this person is not only the end consumer. See *Mark Wilkinson*, [1992] FSR, at 421; *Baby Dan*, [2003] FSR, at 23, *C&H Engineering*, [2003] FSR, at 23.

[FN136]. *Garnett, James and Davies*, *supra* note 5, at 771: "Any similarities, in particular similarities in respect of unusual or attractive design features, may lead to the conclusion that despite any other differences, the allegedly infringing article has been made substantially to the claimant's design."

[FN137]. *Id.* at 772.

[FN138]. *Suthersanen*, *supra* note 5, at 313. *Bently and Coulthard*, *supra* note 5, at 409, note that certain dicta in *Electronic Techniques v. Critchley* already seemed to confirm that similarity is to be tested visually. See *Electronic Techniques v. Critchley*, [1997] FSR, at 401.

[FN139]. I.e. whether the design is not substantially different. See *Howe*, *supra* note 5, at 161.

[FN140]. Suthersanen, *supra* note 5, at 313.

[FN141]. See also Howe, *supra* note 5, at 144, 161, (Howe believes the test of substantial similarity is surely a good test when the features are eye-appealing but wonders whether it is appropriate when the features are functional).

[FN142]. *Id.* See also Bently and Coulthard, *supra* note 5, at 409, who state this for functional designs but do not address the issue of invisible designs.

[FN143]. Bently and Sherman, *supra* note 5, at 645.

[FN144]. As in *Ocular Sciences*, 1997 RPC, at 289.

[FN145]. Art. 10 states:

(1) The 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.

(2) In assessing the scope of protection, the degree of freedom of the designer in developing his design shall be taken into consideration.

See also Massa and Strowel, *supra* note 4, at 75; Fellner, *supra* note 5, at 284.

[FN146]. Explanatory Memorandum to the Directive and Regulation.

[FN147]. Copyright, Designs and Patent Act, 1988, c. 48, § 16(1), 16(3) (Eng.); Garnett, James and Davies, *supra* note 5, at 769.

[FN148]. See Mutimear and Storor, *supra* note 5.

[FN149]. Garnett, James and Davies, *supra* note 5, no. 13-163, at 775.

[FN150]. The cumulation between national UDR and RDR and with copyright does not emanate expressly from any Act, but proofs of the allowance of cumulation can be found in CDPA § 224 and in § 3(2) of the old RDA. On the other hand, the Community legal instruments specifically impose such cumulation, see Art. 96 of Council Regulation of 12 December 2001, *supra* note 2, at 33 and art. 16 of Council Directive of 13 October 1998, *supra* note 1, at 22.

[FN151]. Before the 1988 reform, copyright, in view of the generosity in its conditions of protection (notably through the low level of originality required), allowed the protection of practically any type of form. Shapes such as moulds to be used in toasted sandwich makers (*Breville v. Thorn EMI*, [1995] F.S.R. 77) and hand-carved wooden moulds to make metal moulds in which plastic can be poured (*Wham-O Manufacturing Co. v. Lincoln Industries*, [1982] R.P.C. 281) were held to be sculptures. Similarly, the said metal moulds and the plastic Frisbees resulting from the moulding were engravings *Id.*. The British lawmaker thought that this protection by copyright was inappropriate and thus reduced the said protection among others by CDPA § 51. In substance, § 51 excludes any infringement of copyright of design documents by their reproduction in three dimensions, as long as the design document is for anything other than an artistic work. For an overview of the history of the copyright and design protection in the UK, see especially Laddie, Prescott and

Vitoria, *supra* note 5 at chapter 59; Neil Davenport, *United Kingdom Copyright and Design Protection*, (1999); Hector MacQueen, *Copyright, competition and industrial design*, 3(2) *Hume Papers on Pub. Pol'y*, (1995).

[FN152]. See also Barron, *supra* note 5, at 31. UDR seems to be advised more than litigated upon: examples of designs where advice has been given are display boards, greeting cards, garden lights, clothes including dresses, household fittings and railway station platform indicators (based on data collected from two main intellectual property law firms, Bird & Bird and Taylor Wessing).

[FN153]. Too strong and too easy copyright protection for industrial objects was indeed one of the main reasons for introducing the UDR in the first place, and organizing the copyright/UDR interface in §51 of CDPA. See e.g. *British Northrop v. Texteam*, [1974] R.P.C. 57; *Solar Thomson Engineering Co. v. Barton*, [1977] R.P.C. 537; *British Leyland Motor Corp. v. Armstrong Patents Co.*, [1986] A. C. 577, [1986] R.P.C. 279, [1986] F.S.R. 221; *Canon KK v. Green Cartridge Co. (Hong Kong) Ltd.*, [1986] F.S.R. 874 (Hong Kong C.A.), [1997] F.S.R. 817. See also CDPA § 226(4), *supra* note 131.

[FN154]. Although it is based in part on the relatively old RDR. See *supra* note 6.

[FN155]. Barron, *supra* note 5, at 32.

[FN156]. CUDR entered into force in March 2002.

[FN157]. Based on data given by Bird & Bird.

[FN158]. Based on a discussion with Arnaud Folliard-Monguiral, OHIM (25 April 2003). Registration started in April 2003.

[FN159]. U. Suthersanen, *European Design: A Model Design Law?*, 11th Fordham *Intell. Prop. L. & Pol'y Conf*, 14 (N.Y. 24-25 April 2003) highlights some reasons why the CUDR might not be successful: copyright is easier, longer and thus better to get, and there is the umbrella of international agreements (Berne Convention and Trade-Related Aspects of International Property Rights) which are lacking in unregistered design law. The precedence of copyright law might not hold true for the UK, since, as previously noted above, the UK has reduced the scope of copyright for industrial objects.

[FN160]. Herman Cohen Jehoram, *Cumulation of Protection in the EC Design Proposals*, *Eur. Intell. Prop. Rev.*, 514, 514-520 (1994), even stated that because registered design involves registration, fees, etc., 99 percent of designs will not be registered but will instead rely on copyright.

[FN161]. Bainbridge, *supra* note 8.

[FN162]. At the time the Commission first proposed the Directive and the Regulation, the Proposal as it stood, with the option for cumulation of copyright and designs, was the maximum that could be achieved as far as harmonization was concerned. Harmonizing the level of copyright's originality requirement - the crux of the

relationship between design and copyright laws - was seen as too big a task at the time in relation to the prospect of success to enact the Directive and the Regulation. See Council Directive of 13 October 1998, *supra* note 1; and Council Regulation of 12 December 2001, *supra* note 2. See also Jehoram, *supra* note 160, at 518, citing also the explanatory note to Article 100 of the Regulation.

[FN163]. The author thus respectfully dissents with Suthersanen, *supra* note 159, at 14, who believes that "one witnesses a very different creature in the UK unregistered design right" (emphasis added) and with Saez, *supra* note 4, at 586, who thinks that there are more differences than similarities between UDR and CUDR, both in terms of form and substance. The author also disagrees with Saez's further comment that "this suggests that the experience accumulated in the United Kingdom in applying this right might only be of limited use as regards the unregistered Community design."

[FN164]. This is even though a claimant could rely on both in litigation as they can be cumulated.

[FN165]. William Cornish is against abandoning the UDR, because the UDR should remain to protect the designs which may not be protected by the CUDR. See William Cornish, *Informal Rights in Industrial Designs: Why Impose Community Constraints?* in *Intellectual Property and Information Law, Essays in Honour of H. Cohen Jehoram*, 253, 259 (Jan Kabel & Gerard Mom eds., 1999).

[FN166]. These are the national copyright/author's right, national UDR, national RDR, CRDR, CUDR, national trademark law, Community trademark law, unfair competition, and national utility model. On the cumulation of certain of these types of protection, see among others, Suthersanen, *supra* note 5, chapters 19-20; Alison Firth, *Aspects of Design Protection in Europe*, *Eur. Intell. Prop. Rev.*, 42, 42-47 (1993); Jehoram, *supra* note 160; Massa and Strowel, *supra* note 4.

[FN167]. Lahore, *supra* note 8, at 132, already thought in 1997 that the "momentum for increasing rights seem[ed] unstoppable."

[FN168]. In this connection, Cornish, *supra* note 165, notes that the CUDR is "likely to achieve very little other than a new layer of complication and uncertainty." He further adds that in the field of trademarks, while the Community trademark has been introduced and harmonization of national trademark laws has been achieved, there has been no initiative to harmonize unfair competition laws, including passing off.

[FN169]. Article 9 of Council Directive 91/250/EEC of 14 May 1991, 1991 O.J. (L 122) 42 (on the legal protection of computer programs); Article 13 of Council Directive 96/9/EC of 11 March 1996, 1996 O.J. (L 77) 20 (on the legal protection of databases); Article 16 of Council Directive 98/71/EC of 13 October 1998, 1998 O.J. (L 289) 28 (on the legal protection of designs); Article 9 of Council Directive 2001/29/EC of 22 May 2001, 2001 O.J. (L 167) 10 (on the harmonisation of certain aspects of copyright and related rights in the information society; Council Regulation of 12 December 2001, *supra* note 2, Article 96. An example of a timid organization of relationships amongst rights can be seen in Article 6 of the Proposal for a Directive on the Patentability of Computer-Implemented Inventions, COM(02)92 final (February,

2002) which safeguards clearly the decompilation exception provided for in the Software Copyright Directive.

[FN170]. An exception is Article 1(2) of Council Directive 2001/29 of 22 May 2001 O.J. (L 167) 10.

[FN171]. Broadening the view of Suthersanen, supra note 5, who talks of inter se harmonization between copyright designs.

[FN172]. This is notwithstanding the fact that the first question to be asked is whether a new sui generis right is really needed or rather whether a traditional intellectual property right needs to be reshaped. See Lahore, supra note 8, at 132, questioning the merits of a new type of protection for functional designs and wondering whether, if the patent system is not accommodating those 'inventions,' patent law should not be revised instead of introducing new rights.

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