

# **EXPOSE**

INTRODUCTION OF THE DOCTORAL DISSERTATION AT THE COURSE  
INTELLECTUAL PROPERTY LAW

## **„ AN INTERDISCIPLINARY APPROACH TOWARDS DEFINING THE INDIVIDUAL CHARACTER OF INDUSTRIAL DESIGN “**

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**INDEX:**

<b>1. Introduction to the Subject Matter.....</b>	<b>2</b>
<b>2. Main Topics, Issues and Questions.....</b>	<b>2</b>
<b>3. Aims and Implications of the Dissertation.....</b>	<b>4</b>
<b>4. Boundaries, Problems and Challenges.....</b>	<b>5</b>
<b>5. Methodology .....</b>	<b>6</b>
<b>6. Time-line and Study Stages .....</b>	<b>7</b>
<b>7. Structural Outline .....</b>	<b>8</b>
<b>8. Literature and Sources .....</b>	<b>9</b>

## **1. Introduction to the Subject Matter**

Since the European Council regulation on Community Designs (EC 6/2002, dated 12.12.2001) came into force in 2002 it pretty much unified the legislative systematic of design as an intellectual property right across all EU member states. According to the provisions of the Regulation a product can obtain legal protection via design rights, if it meets two essential criteria: the design must be new and it must convey the so called individual character. While the criterion of novelty (at least in most cases) is pretty straight forward, the criterion of individual character is much harder to define when dealing with industrial products in practice. We tend to encounter a similar problem when granting copyright protection, where the question is whether the product is or is not a work of art, or more specific, whether it possesses the required artistic originality. These questions are particularly difficult to answer when it comes to works of applied art, meaning products, whose purpose is not solely aesthetic or artistic but primarily functional. If consider on of the fundamental principles of design, namely Form Follows Function, the realm of industrial products should be quite monotonous and uninventive. Clearly this is not the case. In the increasingly competitive world of mass consumption designers are forced to face the challenge of creating products with features that exceed the mere functionality. It is exactly those features that require and indeed deserve to be protected through design rights. The aim of my dissertation therefore is to determine the nature of these features in order to distinguish a particular design from all others on the market and thus make it eligible for protection.

## **2. Main Topics, Issues and Questions**

As will be more explicitly elaborated below, the dissertation will be structured around two fundamental issues: the conception of “product” in the legal context and the formation of practical criteria, which enable the identification of those design elements that allow industrial design items to be protected through either copyright or through industrial design rights. Alongside these two focal points, attention will also be devoted to the historic overview of the conceptual development of “individual character” and “originality” criteria, as well as to the discussion on the role of courts and registering authorities (such as OHIM) at the formation and application of criteria for the assessment of individual character/originality of industrial products.

The main questions and issues regarding the conception of “product”: What is the currently valid definition of a “product” within the EU law, the laws of the member states (especially Slovenia, Austria and Germany) and the laws of other countries (especially the United States of America)? Is this definition flexible enough to be extended to all forms of industrial products, also those emerging from new technologies? Could and/or should the definition be altered in order to become more adaptable to the ever widening scope of industrial design products? What are those “borderline” product categories, which could potentially fall outside the scope of legal protection due to non-compliance with the legal definition of “product”? What impact will future technological advances have on the development of new product categories and what kind of “products” can be anticipated in the future? To what extent can the concepts of public policy and morality be the grounds for the refusal of the legal protection of design items? What are the key elements of a product that label it morally controversial, and can these elements even be uniformly defined, considering the cultural differences between separate countries?

The questions relating to the formation of practical criteria for the assessment of originality/individual character of industrial products: What are the crucial components of product design? Which of these elements enable the product to be legally protected against design and copyright infringement? How can we distinguish the purely functional elements of a product (which cannot be protected) from its individual/original features? What is the significance of aesthetic requirements for the legal protection of industrial products? Is it possible to create a set of practically applicable criteria for the evaluation of the originality/individual character which could be applied to all categories of industrial products? What are those legally relevant elements of industrial product design, which would provide a reliable basis for granting/denying of design rights and/or copyright? Can the same criteria be applied for the assessment of individual character (industrial design rights) and for originality (copyright)? If yes/no, what are the crucial similarities/differences between the criteria for granting design rights and for copyright? Which authorities are currently called upon to decide on the granting/denying of legal rights in industrial design cases within the EU and its member states, as well as other countries? What is their audit based on and how relevant and applicable is the provided legal definition of the debated concepts? Can previous court cases, settled by European and American courts, provide useful guidelines for the identification of those product features eligible for protection and the establishment of practical design evaluation criteria? What is the role of design registering authorities such as the OHIM and

would it be advisable for these authorities to validate the compliance with the criteria of novelty and individual character and thus avoid possible disputes later on?

### **3. Aims and Implications of the Dissertation**

At the registration of a particular design most registering authorities (in case of community registered designs the OHIM - Office for Harmonisation in the Internal Market) do not examine, if the applied design meets the statutorily defined criteria of novelty and individual character, as they only examine the compliance with formal requirements. Furthermore, with regard to copyright and unregistered designs, as rights that require no previous registration, no such authorities and proceedings exist by default. The question of whether or not an industrial item is in fact protectable from a material point of view most commonly arises only in case of a legal dispute about the justification of granted/denied intellectual property rights. This implies that more often than not the decision on whether or not a product is protectable lies with the court appointed judge. As I have witnessed in practice, the judges only rarely consult experts from the field of design in such matters and tend to base their decision on their personal estimation and expertise. This poses the imminent risk that the decision will be unprofessional and biased (in essence lay), due to judges often being incapable of ignoring their personal taste, subjective opinion and artistic perception. This is where the existence of objective and practically applicable criteria could prove to be a welcome innovation. The legal definitions of individual character and artistic originality have so far been set quite broadly and abstract, thus offering little support to judges, lawyers, registering authorities as well as designers. The main goal of my dissertation therefore will be to establish a system or set of practical criteria, accompanied by and based on actual examples, which could serve as guidelines in determining whether or not a product is eligible for legal protection (based on its form, configuration, colour, surface, pattern, ornamentation and/or other criteria).

The secondary aim of the dissertation is to study the newest developments in the field of design, meaning new design possibilities resulting from emerging technologies and materials, and researching whether the existent legal provisions are flexible enough to encompass the range of future products, or if some amendments could or in fact should be made.

#### **4. Boundaries, Problems and Challenges**

The major challenge of my dissertation will be the forming of practical criteria, which would be precise enough to be practically comprehensible and applicable, thus providing a useful tool for legal authorities, deciding on granting or denying intellectual property rights. Furthermore, they must reflect a sufficiently high level of design expertise, making them acceptable not only within the legal sphere but also for designers and design experts. Another fundamental issue is flexibility of the criteria; though adequately precise they must also prove to be wide and universal enough to be relevant for all kinds of products that fall into the scope of industrial design or will fall within that scope as industrial design progresses in the future. It is necessary to bear in mind that the industrial design world encompasses an extensively wide range of products, from various consumer goods to extremely specific items used in medicine, science, technology and so forth. If the task of establishing uniform criteria for all product categories proves an impossible task, resulting in overly complicated and thus practically inapplicable criteria, I intend to limit the focus of the dissertation only on consumer goods (furniture, clothing, household items, etc.), since this is the area where effective protection of intellectual property rights is of utmost relevance.

The dissertation will also discuss some legal considerations as to whether the same criteria can be applied for both design rights and copyright and whether the threshold of individual/artistic expression is higher when granting copyright than it is for design rights. In this context it is also necessary to consider that while the European legislation on industrial design rights has been to a certain point unified by the Regulation on Community Designs, the institute of copyright is still subject to various national regulations within individual member states and the differences between these regulations can be relatively extensive.

Another potentially concerning issue is the fact, that the chosen subject matter requires a combined discussion of both practical (aka design) issues and intellectual property issues. Both areas of expertise are tightly interlaced and must be of equal importance, if the dissertation is to achieve its set out aims, which is to benefit both the legal sphere and the design sphere. Yet in my personal opinion, these considerations must not necessarily present a setback, since such interdisciplinary studies can indeed provide the most useful results and can undoubtedly be considered as an interesting and sought after contribution to legal theory and practice.

## 5. Methodology

I will base my methodological approach on three study and research phases:

- Study of available relevant literature
- Consultations with a design expert
- Study of court cases and consultation with appointed judges

To elaborate a comprehensive theoretical foundation I will firstly study available relevant literature from both interest fields - intellectual property law and product design. As already observed in my preliminary literature research, exact literature, which would already combine both aspects, is relatively scarce, but on-line sources can yield promising results. I have also asked for the assistance of a co-mentor from the field of applied arts, a designer and professor of design, who will be able to give me a professional insight into the concept of product design and the most current issues within the sphere of industrial design, as well as point out the legal issues which concern designers in practice. For the added practical applicability of the dissertation I will study court cases from European (EU and individual member states, especially Austria, Slovenia and Germany) and American courts, to establish on what grounds and reasoning the courts decide in design and copyrights cases concerning industrial products and filter out which elements of the products in question were crucial for the decision of the court. I will also address some of my research questions directly to judges who deal with intellectual property cases to establish the practical challenges and problems they encounter and possibly gather some valuable “first hand” ideas on finding practical solutions to the discussed issues.

## **6. Time-line and Study Stages**

### **SS 2010:**

- Study Course Methodology (Seminar Methodenlehre)
- Study Course Caselaw and Text Analysis (Seminar Judikatur und Textanalyse)

### **WS 2010/2011:**

- Dissertation Course Intellectual Property Law (Seminar aus dem Dissertationsfach - Immaterialgutrecht)

### **WS 2011/2012:**

- Dissertation Seminar for the Introduction of the Disposition (Dissertantenseminar zur Vorstellung des Dissertationsvorhabens)
- Research for the purpose of the Dissertation
- Acquiring of a co-mentor from the field of applied arts
- Elaboration of the Disposition

### **SS 2012:**

- Research and consultations with the Mentor and Co-mentor
- Elaboration of the Dissertation

### **WS 2012/2013:**

- Optional Course (Wahlfach)
- Elaboration of the Dissertation

### **SS 2012 or WS 2013/2014:**

- Completion of the Dissertation (Fertigstellung der Dissertation)
- Submission of the Dissertation (Einreichung der Dissertation)
- Defensio



## 7. Structural Outline

1. Development of the concepts of individual character in design law and artistic originality in copyright
  - 1.1 Development within the law of EU member states
  - 1.2 Development of the Community design
  - 1.3 Development within the US legal system
  
2. Comparison between individual character and artistic originality
  - 3.1 Possible similarities
  - 3.2 Crucial differences
  - 3.3 Discussion on the possibility of establishing common evaluation criteria
  
3. Conception of a “product”
  - 3.1 Definition in the context of industrial design
  - 3.2 Definition in the legal context
  - 3.3 Conceptual boundaries
  - 3.4 Future products and their legal position
  
4. Establishing practical criteria
  - 4.1 Preliminary discussion on the possibilities and boundaries
  - 4.2 Significance and applicability of valid legal provisions and conditions
  - 4.3 Groundwork for deriving relevant criteria
    - 4.3.1 Theoretical suggestions
    - 4.3.2 Case law
  - 4.4 Reasons for denial of protection
    - 4.4.1 Functionality
    - 4.4.2 Public morality concerns
    - ...
  - 4.5 Proposed system of practical criteria for the evaluation of individual character/originality of industrial products
    - 4.5.1 Shape, lines, contours
    - 4.5.2 Texture
    - 4.5.3 Material

- 4.5.4 Colour
- 4.5.5 Ornamentation
- 4.5.6 Exclusiveness
- 4.5.7 Awarded design
- 4.5.8 Designers' reputation

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#### 4.6 Discussion on the results of the research and conclusion

## 8. Literature and Sources

Franzosi Mario (edit.), European design protection, Commentary to directive and regulation proposals, edited by, Kluwer Law Internation, The Hague, 1996

Musker David, Community design law, Principles and practice, Sweet & Maxwell, London 2002

Howe Martin (edit.), Russell-Clarke and Howe on Industrial Designs, Seventh edition, Sweet&Maxwell, London 2005

Lidwell William, Manacs Gerry, Deconstructing product design, Rockport, Beverly, Massachusetts, 2009

Schildt-Lutzenburger Christiane v., Der Urheberrechtliche Schutz von Gebäuden, Herbert Utz Verlag, München, 2004

Helfrich Jörg Oliver, Rechtsschutz der Mode, Nomos Verlag, Baden-Baden, 1993

Hensler Eberhard, Urheberschutz in der Angewandten Kunst und Architektur, W. Kohlhammer Verlag, Stuttgart-Köln, 1950

Hensler Eberhard, Geschmacksmuster- und Urheberschutz für die industrielle Formgestaltung, GRUR, 1957

Trampuž Miha, et al., Zakon o avtorski in sorodnih pravicah s komentarjem, GV založba, Ljubljana, 1997

Puharič Krešimir, Zakon o industrijski lastnini s kometarjem, GV založba, Ljubljana, 2003

Schricker Gerhard, Abschied von der Gestaltungshöhe im Urheberrecht, FS für Reinhold Kreile zum 65. Geburtstag, Nomos Verlag, Baden-Baden 1994

Andrews Lori, Nelkin, Dorothy, Body Bazaar: The Market for Human Tissue in the Biotechnology Age, Crown, 2001

Fiell Charlotte, Design of the 20th Century, Taschen, 2005

Fiell Charlotte, Fiel Peter, Industrial Design A-Z, Taschen, 2006

Abrams Howard B., The Law of Copyright, Volume 1, Clark Boardman Company, New York, 1991

Bently Lionel, Sherman Brad, Intellectual Property Law, 3. izdaja, Oxford University Press, Oxford, 2008

Cornish William Rodolph, Intellectual property : patents, copyright, trade marks & allied rights, 5. izdaja, Sweet & Maxwell, London, 2003

Dillenz Walter, Gutman Daniel, Österreichisches Urheberrechtsgesetz und Verwertungsgesellschaftengesetz, Kommentar, 2. dopolnjena izdaja, Springer-Verlag, Dunaj, 2004

Tritton Guy, Intellectual Property in Europe, 3. izdaja, Sweet & Maxwell, London, 2007

Krause Frank-Lothar (edit.), The Future of Product Development, Springer, Berlin, 2007

Gerstenberg Ekkehard, Der Begriff des Kunstwerkes in der bildenden Kunst, GRUR 1963

Sommer Brigitte, Gordon Clara-Ann, Individualität im Urheberrecht - einheitlicher Begriff oder Rechtssicherheit?, sic!, 2001

Straub Wolfgang, Individualität als Schlüsselkriterium des Urheberrechts, GRUR, 2001

Rauscher auf Weeg H.H. von, Kunstschutz bei Verwendung gemeinfreier Formelemente, GRUR, 1967

Reimer Dietrich, Zum Urheberrechtsschutz von Darstellungen wissenschaftlicher oder Technischer Art, GRUR, 1980

Schmidt Karsten, Urheberrechtlicher Werkbegriff und Gegenwartskunst, UFITA 77, 1976

Strömholm Stig, Spielraum, Originalität oder Persönlichkeit?, GRUR, 1996

Mitteregger Peter, Kunstfreiheit jenseits der Ästhetik, Univ. Innsbruck, 1996

Holm Ivar, Ideas and Beliefs in Architecture and Industrial Design, Oslo School of Architecture and Design, 2006

etc.

As well as:

- Case law of EU and US Courts on the chosen topic
- Consultation with judges, legal experts and design experts
- Internet research
- Journal articles
- etc.