



Question Q231

National Group: United States

Title: The interplay between design and copyright protection for Industrial products

Contributors: Brent DOUGAL
Sabing LEE
Lauren NYDAM
Andrew SIMPSON

Reporter within Working Committee: Andrew Simpson

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Questions

I. Analysis of current law and case law

The Groups are invited to answer the following questions under their national laws:

Cumulative Protection

- 1) Can the same industrial product be protected by both a design right and a copyright? In other words, is the cumulative protection of the same industrial product by copyright and design law allowed in your country?

Yes, in the United States, the design of an industrial product can be protected by both a design right- a design patent- and by a copyright. To be protected by a design patent, an industrial product must have an ornamental feature that is novel and nonobvious. Design patents protect only the aesthetic features of a product. Copyright protection begins whenever a design is fixed in a tangible medium. To gain copyright protection, the work must be original.

Article 2(7) RBC

- 2) In your country, has copyright protection for applied art ever been refused for a work with a foreign country of origin pursuant Article 2 (7) RBC?

In the United States, works of "applied art" encompass all original pictorial, graphic, and sculptural works embodied in useful articles, regardless of factors such as mass

production, commercial exploitation, and the potential availability of design patent protection. *Mazer v. Stein*, 347 U.S. 201 (1954). There is no specific example of copyright protection for a foreign work of applied art ever having been refused in the United States. However, from the first Copyright Act until the revisions made in the 1976 Copyright Act, Congress conditioned copyright protection on compliance with certain statutory formalities and any work, foreign or domestic, created during that time and failing to comply was refused protection. Since the passage of the Uruguay Round Agreements Act (codified at 17 U.S.C. §104A, 109A), Congress has extended copyright protection to foreign works that garnered protection in their countries of origin, but had no copyright protection in the United States for any of three reasons: lack of copyright relations between the country of origin and the United States at the time of publication; lack of subject-matter protection for sound recordings fixed before 1972; and failure to comply with U.S. statutory formalities. 17 U.S.C. §104A(h)(6)(B)-(C).

Registration/Examination

- 3) In order to enjoy design right protection for industrial products, is registration of a design necessary? In order for the design to be registered, is a substantial examination necessary?

There is no registration system for the protection of industrial designs in the United States. Industrial designs fall within the scope of the patent law and, subject to requirements special to designs, such designs must meet the requirements for regular patent applications and patents. Therefore, a design patent issued by the U.S. Patent and Trademark Office must be obtained for any article to enjoy design right protection. A substantial examination as to novelty and non-obviousness is required before a design patent can be granted.

Requirements

- 4) What are the requirements to obtain industrial design protection or copyright protection, respectively, for industrial products in each country? What are the differences between these requirements?

A design patent issued by the U.S. Patent and Trademark Office must be obtained for any article to qualify for design right protection. A design patent may be available for a new, original, and ornamental design for an article of manufacture. 35 U.S.C. § 171.

A substantial examination as to novelty and non-obviousness is required before a design patent can be granted. Typically, examination includes a detailed review by the U.S. Patent Office to determine that the representations of the article, usually in the form of drawings, are complete, consistent and presented in a manner that satisfy certain rules. The U.S. Patent Office also reviews the claim of the design patent (typically expressed as the ornamental design of the article as shown and described with respect to the drawings) against the prior art. In contrast, copyright protection is automatic, but the work should also be registered with the Copyright Office in order to maximize the scope of protection.

Copyright subsists in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. 17 U.S.C. §102(a).

Such works, while unpublished, are subject to protection without regard to the nationality or domicile of the author. 17 U.S.C. § 104(a). When published, such works are subject to protection under this title if-

(1) on the date of first publication, one or more of the authors is a national or domiciliary of the United States, or is a national, domiciliary, or sovereign authority of a foreign nation that is a party to a copyright treaty to which the United States is also a party, or is a stateless person, wherever that person may be domiciled; or

(2) the work is first published in the United States or in a foreign nation that, on the date of first publication, is a party to the Universal Copyright Convention; or

(3) the work is first published by the United Nations or any of its specialized agencies, or by the Organization of American States; or

(4) the work is a Berne Convention work. 17 U.S.C. § 104(b).

Registration serves as prima facie evidence of a valid copyright and enables the copyright holder to seek statutory damages and attorney's fees. If the copyright is not registered until after an infringement, only actual damages and lost profits are available.

There is examination of an application to register copyright in the United States. An application can be refused if the Copyright Office believes the work does not have sufficient originality.

- 5) Are the requirements for copyright protection for industrial products different from the requirements for copyright protection for other ordinary artistic products (fine arts)?

Copyright protection can only be afforded to aspects of an industrial design where the aspects can be identified separately from, and are capable of existing independently of, the utilitarian or functional aspects of the article. These aspects must otherwise qualify for copyright protection by being pictorial, graphic, or sculptural features.

Scope of Protection and Assessment of Infringement

- 6) Is the scope of the copyright protection for industrial products different than that for other ordinary artistic products (fine arts)? If so, in what ways?

All elements of copyright protection- term of protection, restrictions on use of the work, and test for infringement of the copyright- apply identically to copyrights over fine art and copyrights over the artistic elements of an industrial product that are severable from the product's utilitarian function.

- 7) Are the criteria for assessing infringement of copyright protected industrial products different from the criteria for assessing infringement of a design right?

The test for infringement of a copyright is whether copying occurred, which can be inferred from access to the copyrighted work and substantial similarity between the works at issue. The test for infringement of a design patent is "whether an ordinary observer, familiar with the prior art . . . , would be deceived into believing the [accused product] is the same as the patented [product]." *Egyptain Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 681 (Fed. Cir. 2008).

- 8) Is it a relevant defence under copyright or design law that the industrial product was created independently of the older work or design?

Independent creation is not a valid defense for design patent infringement. Independent creation is a complete defense to copyright infringement, however it is difficult to prove if the products are strikingly similar and the copied product is widely available.

Duration of Protection

- 9) How long is the duration of industrial design protection or copyright protection for industrial products, respectively?

A design patent is valid for 14 years after issuance. More than one design patent may be obtained for features of the same product which may be separately valid for 14 years after issuance. This may effectively extend the duration of protection for aspects of the design. Copyrights last for 70 years after the death of the work's author, or, for works for hire, the shorter of 120 years after creation or 95 years after publication.

- 10) What happens upon expiration of the IP right having the shorter term? In other words, after the term for industrial design protection expires, does the copyright protection continue?

Expiration of a design patent does not affect ones rights under copyright. The two are separate. ("Neither the Copyright Statute nor any other says that because a thing is patentable it may not be copyrighted." *Mazer v. Stein*, 347 US 201, 217 (1954).)

Measures for adjustment

- 11) In your country, is there any measure for adjustment so that the same industrial product may not be protected, by both a design right and a copyright or, by a copyright after the design right expires?

No.

II. Proposal for Harmonisation

The Groups are invited to put forward proposals for the adoption of harmonised rules in relation to the protection of the appearance, shape, or ornamentation of industrial products. More specifically, the Groups are invited to answer the following questions:
What should be the requirements for obtaining copyright protection for industrial products?

- 12) For industrial products, should there be any cumulative protection by industrial design rights and copyright?

Yes. Design patents protect the practical application of an ornamental design, while copyrights protect an original work from any copying. The different types of protection afforded by the two creates a need for cumulative protection. Other IPR's can provide cumulative protection in connection with an article or product. There seems to be no reason why design rights and copyright should be treated differently. Nevertheless, a number of jurisdictions restrict the copyright aspect of this cumulative protection, either in the form of a limiting test for qualification for copyright protection or by term limitation.

- 13) If so, should there be any measures to resolve this overlap? What measures should be taken? For example, once a certain artistic work has enjoyed industrial design protection, should copyright protection be denied for the same work?

No, copyright protection should not be denied because it is broader, in that it protects the use of an original design in any context, and because it is subject to fair use and independent creation defenses. Where design patent protection for the practical use of a copyrightable design expires, artists should not be deprived of copyright protection for their creative work. However, we recognize that in the typical case the industrial design has little or no artistic merit, and copyright protection may not be available under U.S. law.

- 14) National Groups are invited to comment on any additional issue concerning the relationship between design and copyright protection for industrial products that they deem relevant.

Harmonization is desirable for users of the system, but as we know it is typically difficult to harmonize national laws effectively. Perhaps WIPO, as the keeper of both the Berne and Hague Conventions could further address this issue.

Neither copyrights nor design patents protect a functional element of an industrial product. Where the look of a product arises out of a practical reason, there can be no design patent protection. "Where a design contains both functional and non-functional elements, the scope of the claim must be construed in order to identify the nonfunctional aspects of the design as shown in the patent." *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396 (Fed. Cir. 1997). Similarly, copyright protection can only be afforded to aspects of an industrial product which can be identified separately from, and are capable of existing independently of, the utilitarian or functional aspects of the product.

Different damages are recoverable for design patent infringement and copyright infringement in the United States. Damages for patent infringement shall be no less than a reasonable royalty for the use made of the invention by the infringer, and a court to award up to triple damages if the infringer has knowingly, deliberately, intentionally, willfully, or wantonly infringed the patent. 35 U.S.C. § 284. Recovery of an infringer's total profits is available for design patent infringement, but the patent holder may not seek both total profits and enhanced damages under § 284. 35 U.S.C. § 289. For copyright infringement, the copyright holder may attempt to recover actual damages. Where proof of actual damages is difficult, the copyright holder may elect to recover statutory damages ranging anywhere from \$200 per act of infringement for "innocent infringers," or a maximum of \$150,000 per act of infringement if the court finds that the infringer acted willfully. 17 USC § 504(c)(2). Typical statutory damages range between \$750 to \$30,000 per act of infringement. 17 USC § 504(c)(1).

While a copyright application is publicly available, a design patent application in the United States is not published and is kept secret until granted.

