

Protection of industrial design in the US and in the EU

- Different concepts or different labels? -

Lena Schickl

University of Washington, Seattle

Abstract

Industrial designs matter. It is undisputed that design is crucial for the success of a product. That is why companies are using intellectual property laws in an effort to protect their industrial design. This article will describe how intellectual property laws can protect design and compare the design protection regime in the US and the EU. The comparison will show that design protection is significantly different in the US and the EU. Within the EU, further harmonization is needed in order to provide for a strong coherent design protection. The paper will point out that the ubiquitous requirement of non-functionality outside the realm of utility patent law in the US is no longer appropriate in a world where the most successful designs purposefully combine functional and aesthetic elements.

Keywords design protection; community design; design patent; trade dress

Table of Contents

- I. Why design protection matters
- II. Terminology
- III. Overview: Design Protection Standards in International Treaties
 - A. The Berne Convention
 - B. The Paris Convention for the Protection of Industrial Property
 - C. The TRIPS Agreement
 - D. The Hague Agreement
- IV. Design Protection in the US
 - A. Design Patent
 - 1. Legislative History
 - 2. Threshold for Protection
 - a. Novelty and Non-Obvious Requirement
 - b. Original and Ornamental
 - 3. Problems related to Patent-like Approach
 - B. Trade Dress Protection
 - C. Copyright Protection
 - D. Interrelationship of the Different Forms of Protection
- V. Design Protection in the EU
 - A. Background
 - 1. Directive on the Legal Protection of Designs (1998)
 - 2. Community Design Regulation (EC) No 6/2002
 - 3. Justification of the European Laws
 - B. Registered and Unregistered Community Design
 - 1. Threshold for Protection
 - a. Definition of Design
 - b. Novelty and Individual Character
 - c. Not Solely Dictated by Technical Functionality
 - 2. Registration Process at the OHIM

3. Scope of Protection
 - a. Registered Community Design
 - b. Unregistered Community Design
4. Infringement Proceedings
- C. Community Trademark
 1. Application Procedure
 2. Threshold for Protection
 3. Protecting Designs with Trademark Law in Practice
- D. Other forms of protection in the EU
 1. National Copyright Laws
 2. National Unfair Competition and Design Laws
- E. Interrelationship of Different Forms of Protection
- VI. Comparison US and EU Design Laws
 - A. Sui Generis Form of Protection vs. Patent Approach
 - B. Possibility of Unregistered Design Protection
 - C. Eligible Subject Matter for Design Protection
 1. Design Definition
 2. Individual Character (EU) vs. Non-Obviousness (US)
 3. Originality Requirement in the US
 4. Ornamentality Requirement in the US
 - D. Application Procedure
 1. Costs and Duration
 2. Level of Examination
 - E. Test for Infringement
 - F. Term of Protection
 - G. Role of Functionality in General
- VII. Conclusions

I. Why design protection matters

Think of Apple's iPad. What picture comes to mind? Maybe you are already thinking of the design war between Apple and Samsung in the US and the decision *Apple, Inc. v Samsung Electronics Co., Ltd.*, where Apple failed to get a preliminary injunction because the court doubted the validity of Apple's design patent due to possible lack of novelty.¹ Or of Apple's successful Community design law suit in Düsseldorf, Germany, where the company has been granted a preliminary injunction against Samsung's Galaxy, barring all distribution of its allegedly infringing tablet in the entire EU except for the Netherlands.²

But let us first go back to the basic questions. Why do you think that people pay a lot of money for these kinds of products? Because of the reputation of the company producing them? Because they want to belong to the customer group that uses them? Because of the quality and functionality of the products? Because of their appealing designs? The answer is the typical one for the legal profession: "It depends". But it is very likely that many or even all of these reasons affect the customer's purchase decision.

Nowadays customers are used to having a broad range of products to choose from. Most customers base their buying decision not only on the functionality or quality of the product but also on its design. The iPad example perfectly illustrates what a modern customer finds appealing: simple and elegant design adorned with little or no ornamentation. These products enjoy a high reputation, which primarily derives from the fact that customers perceive them as embodying the perfect combination of functionality and appearance (Di Rienzo, 1993, p. 79). At the same time, industrial design is increasingly important for a company's success. Not only does it define the visual appeal of the product itself, but also has an essential impact on its competitiveness and commercial success within a certain market (Suthersanen, 2010, pp. 4-5). From a company's point of view, design is often considered as a strong marketing tool, and from a consumer's perspective, it allows product differentiation as well as "socio-economic differentiation among the consuming public" (Suthersanen, 2010, p. 4).

¹ *Apple, Inc. v Samsung Electronics Co.*, [2011] No. 11-cv-1846 (N.D. Cal. Dec. 2, 2011); The US Court of Appeals for the Federal Circuit, however, recently declared that the District Court erred in its analysis of the validity issue. The court remanded for findings on the balance of hardships and the public interest; *Apple, Inc. v Samsung Electronics Co., Ltd.*, F.3d, 2012 WL 1662048 (Fed. Cir.).

² *Apple, Inc. v Samsung Electronics Co., Ltd.*, [2011] 14c O 194/11 (District Court of Düsseldorf 2011). The injunction did not include the Netherlands since at the time there were separate proceedings under way.

To stick to the example, Apple probably made sure to protect their designs with as many layers of intellectual property rights as possible. The crucial question, however, is: what form of protection are simplistic designs like those by Apple eligible for? Further, what kind of protection is most effective?

The answers to these questions are different in each case and jurisdiction. Industrial design protection is debated all around the world and different jurisdictions offer different approaches. Their common denominator is that legislators and courts see the need to offer protection for industrial design. But especially when it comes to simplistic design having little or no ornamentation, there is a lot of controversy as to whether and under which intellectual property laws protection can be granted. Modern designs are often created in such a way that the “form [i.e., design] follows the function” (Afori, 2007-2008, p. 1105, p. 1122). From a designer’s perspective this may bring disadvantages in effectively protecting their work, since legislators and courts are traditionally rather reluctant to offer protection to designs under trademark or copyright law. This reluctance is based on the assumption that the purpose of these laws does not really include design protection.

Therefore, it is no surprise that both the US and the EU offer a specifically tailored form of protection for industrial design, namely Community design in the EU and design patent in the US.

This article will describe and compare design protection in the US and the EU. The comparison will show that design protection is significantly different in the US and the EU. Within the EU, further harmonization is needed in order to provide for a strong coherent design protection. The paper will point out that the ubiquitous requirement of non-functionality outside the realm of utility patent law in the US is no longer appropriate in a world where the most successful designs purposefully combine functional and aesthetic elements.

II. Terminology

Industrial design is easy to describe but hard to specifically define. It can be merely ornamental and connote an element that is separable from the product itself, but it can

also be a functionally irremovable element of the product. In any case it is usually neither purely artistic, since it is always aligned with the function and technology of the product, nor is it purely functional (Heskett, 1980, p. 10).³

Due to this natural ambiguity (Suthersanen, 2010, 18) or hybrid nature of industrial design it is difficult to classify industrial design within existing intellectual property laws (Reichmann, 1992, p. 281, p. 287). It seems plausible to consider it as artistic creation, but it can also imply a functional solution, and/or it can stand for a particular company. Depending on the industrial design, it can, therefore, have much in common with classical intellectual property rights, namely copyright, utility patents, and trademarks (Afori, 2007-2008, pp. 1107-1108). Legislators have to decide whether industrial design can be sufficiently protected under copyright, trademark, unfair competition, and patent law, or whether *sui generis* protection is needed.

The definition of industrial design is crucial for that decision. Unfortunately legislators have not agreed on a generally applicable definition of “industrial design”. In traditional legal terms it is described as the external appearance of articles (Afori, 2007-2008, p. 1107). The US Patent and Trademark Office (USPTO) uses a much stricter definition. As a result, in the US industrial design “consists of the visual ornamental characteristics embodied in, or applied to, an article of manufacture” (USPTO, Design Patent Application Guide). Within the EU, however, industrial design is defined as “outward appearance of a product or part of it, resulting from the lines, contours, colors, shape, texture, materials and/or its ornamentation”⁴. As a result, an appearance that is legally defined as design in the EU does not necessarily constitute a design in US legal terminology.

This difference in defining design is also reflected in the different forms of protection in each jurisdiction. While the US design patent is based on utility patent law, the EU has introduced a freestanding *sui generis* form of protection, the community design.

³ Heskett finds the following definition: “Industrial design is a process of creation, invention and definition separated from the means of production, involving an eventual synthesis of contributory and often conflicting factors into a concept of three-dimensional form, and its material reality, capable of multiple reproduction by mechanical means” (Heskett, 1980, p. 10).

⁴ See Art. 3 CDR.

III. Overview: Design Protection Standards in International Treaties

Intellectual property rights are subject to a number of international treaties such as TRIPS, the Berne Convention, or the Paris Convention. With respect to design, however, there has always been a lack of international agreements that clearly determine its legal protection (Suthersanen, 2010, p. 28). One possible reason for this might be the ongoing debate about the nature of design. As mentioned above, different jurisdictions classify industrial design differently. The classification, however, is essential for determining which international treaty covers the subject matter of industrial design protection (Suthersanen, 2010, p. 28).

A. The Berne Convention

The Berne Convention became effective in 1886 and was the first major international copyright treaty. Art. 2 (1) of the Berne Convention provides a non-exclusive list of works protectable under copyright law. Industrial design is not specifically regulated in the Berne Convention but might fall under the concept of “applied art” that is not further defined in the convention. According to Art. 2 (7) of the Berne Convention it is in the discretion of the signatory states whether they want to protect industrial design as applied art, and if so, to set the conditions of protection.

Interestingly, however, the Berne Convention concludes that industrial design should be protected as artistic work, and therefore under copyright law, in the event that the signatory state’s laws are silent as to the form of protection offered for industrial design. As a result, in case of doubt, industrial design should be protected under copyright law.

B. The Paris Convention for the Protection of Industrial Property

The Paris Convention was the first international treaty that regulated patents. It was signed in 1883 and was last revised in 1967. Unlike the Berne Convention, the Paris Convention directly addresses the protectability of industrial designs. Art. 5*quinquies* of the Convention sets forth that “industrial designs shall be protected in all the countries of the Union”. Contrary to the rule of doubt in favor of copyright protection set forth in the Berne Convention, industrial design is categorized as *industrial property* in Art. 1 (2) of

the Paris Convention. This suggests a more patent-like protection. However, the Paris Convention does not provide any regulations about the subject matter, the requirements, or the scope of protection.

C. The TRIPS Agreement

The Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) became effective in 1994 and is administered by the World Trade Organization (WTO). It imposes minimum standards for the protection of intellectual property in general. However, only two provisions of TRIPS directly refer to industrial design protection.

Art. 25 TRIPS sets forth the requirements for protection, whereas Art. 26 TRIPS defines the scope of protection. According to Art. 25 (1) of TRIPS member states are required to protect certain types of industrial design:

“Members shall provide for the protection of independently created industrial designs that are new **or** original. Members may provide that designs are not new or original if they do not significantly differ from known designs or combinations of known design features. Members may provide that such protection shall not extend to designs dictated essentially by technical or functional considerations.”

Although TRIPS gives some guidance as to the requirements of protection (independently created, new or original), it does not provide a definition of industrial design or the subject matter constituting industrial design. TRIPS adopted both the Berne and the Paris Conventions but did not take a position as to their different classifications regarding the nature of design protection. It remains unclear, therefore, what type of protection should be applied to industrial design by the member states. The “independent creation” as well as the “originality” requirement seems to point to copyright protection; whereas the novelty requirement might refer to patent-like protection or a *sui generis* design regime (Suthersanen, 2010, p. 42).

Since TRIPS did not settle the dispute about the nature of protection and only guarantees a minimum standard, member states are still relatively free in drafting their national laws in such a way as to match their local objectives (Reichman, 1995, p. 345, p. 375).

D. The Hague Agreement

The Hague Agreement was first concluded in 1925 and consists of several individual treaties. It was last revised in 1999 with the adoption of the Geneva Act. The Hague Agreement's purpose is to simplify registration of industrial designs for several countries. Therefore, it provides an international deposit system that allows national design proprietors to obtain protection in all member states by filing one application and depositing one sample. The eligibility for and scope of protection, however, are subject to the national laws of the member states in which protection is sought.

As a result, it can be concluded that the international legal framework does not give sufficient guidance as to the definition of design and the nature of protection.

IV. Design protection in the US

At first sight it would seem that the US provides a *sui generis* form of protection for designs. This so-called design patent, however, is no single, freestanding form of protection (Dinwoodie and Janis, 2010, p. 17). In fact, it is affiliated to federal patent law (Dinwoodie and Janis, 2010, p. 17) and relies heavily on the requirements used for utility patents such as ornamentality and non-obviousness.

Furthermore, compared to the term for copyright (*70 years post mortem auctoris*) and trademark protection (indefinite), the term of fourteen years that is granted for a design patent seems relatively short. As a result, most companies in the US do not rely solely on design patent protection, but also seek protection under other intellectual property laws, such as copyright or trademark law (Dinwoodie and Janis, 2010, p. 17; Keebaugh, 2005, p. 255, pp. 260-261; Dinwoodie, 2008, p. 10). Accordingly, in the US there are currently three major paths companies pursue for protecting their designs: copyright, trademark, and design patent law.

A. Design Patent

1. Legislative History

The first Design Patent Law was enacted in 1842 with the aim of establishing a form of protection that would not only provide protection for authors (copyright law), or

inventors (patent law), but also for creators of “new and original designs”⁵. The design patent statute was revised several times; the current statute is the Patent Act of 1952. The most important revision took place in 1902 when the previous complicated and narrow eligibility requirements were replaced. From that time on, “any new, original, and ornamental design for an article of manufacture”⁶ has been eligible for design patent protection.

The reason why design protection was placed under patent law and not under trademark or copyright law can be traced to the fact that at that time the Patent Office was in charge of administering intellectual property law (Magliocca, 2003, p. 845, p. 850).⁷

2. Threshold for Protection

The Supreme Court stated in its *Bonito Boats vs. Thunder Craft Boats* decision in 1989 that “to qualify for protection, a design must present an aesthetically pleasing appearance that is not dictated by function alone, and must satisfy the other criteria of patentability”⁸. In other words a design is eligible for design patent protection if it is (1) new, (2) non-obvious, (3) original, (4) ornamental, and (5) used for an article of manufacture. Once those requirements are met, a design patent prevents others from copying the design for 14 years from the date of issuance.⁹

a. Novelty and Non-Obvious Requirement

The standards for novelty and non-obviousness derive from the ones used for utility patents.¹⁰ According to the former Court of Customs and Patent Appeals a design meets the novelty requirement “when the average observer takes the new design for a different, and not a modified, already-existing design”¹¹.

⁵ § 2 U.S. Design Patent Act of August 29, 1842.

⁶ U.S. Design Patent Act of May 9, 1902, ch. 783, 32 Stat. 193.

⁷ Note that it was not until 1879 that another agency for intellectual property, the Copyright Office, was established.

⁸ *Bonito Boats Inc. v Thunder Craft Boats Inc.*, 489 U.S. 141, 9 U.S.P.Q.2d 1847, 1851 (1989).

⁹ 35 U.S.C. § 173 (2000).

¹⁰ The requirement of non-obviousness cannot be found in the statute. However, it is recognized that the non-obvious requirement is incorporated into design patent law by the language of 35 U.S.C. 171.

¹¹ *In re Bartlett*, 300 F.2d 942; 133 USPQ 204 (CCPA 1962).

The threshold for non-obviousness was set out by the Supreme Court in its *Graham v John Deere Co.* decision in a case involving utility patents.¹² According to the court non-obviousness needs to be determined in three steps. First, courts/examiners have to define the scope and content of the prior art and the claims at issue. Second, the differences between the prior art and the claims at issue need to be determined. Third, it has to be evaluated whether a designer having ordinary skills in the art would find the design to be obvious.¹³ This is very reminiscent of the requirements for utility patents. Unlike with utility patents, however, an examiner or court cannot objectively determine whether a new design is obvious or not. Instead, the decision determining non-obviousness of the new design is a more normative and subjective one.

b. Original and Ornamental

The threshold for originality is similar to that under copyright law. Any design that is not just copied will be found to be original (Suthersanen, 2010, p. 215). Furthermore, the design patent applicant must show that the design for which protection is sought is ornamental, in other words non-functional (Saidman, 1989, p. 167, p. 183).

Thus, the examiner or court has to determine whether the design is perceived as an aesthetic feature rather than as a functional part of the product itself. There are difficulties regarding proof inherent in such a standard, and it is often criticized as being “confusingly subjective” (Suthersanen, 2010, p. 210). Merely ornamental designs like the decoration of china might meet this requirement. But for modern designs that incorporate functional elements of the product, like the design of Apple’s iPad, this might cause a problem. In such cases, it is difficult for courts and examiners to distinguish the ornamental design elements from the functional ones (Keebaugh, 2005, p. 255, p. 262). This, however, is a well-known problem. The USPTO guidelines expressly state that many articles of manufacture might comprise both functional and aesthetic features and that it is, therefore, possible for the same article to be covered by both design and utility patents.¹⁴ This is why courts focus primarily on the question of whether the design is solely governed by the function of the product (Manual of Patent Examination Procedure,

¹² *Graham v John Deere Co* 383, U.S. 1 (1966).

¹³ Compare to *Graham v John Deere Co* 383 U.S. 1, 17 (1966); *In re Nalbandian*, 211 USPQ 782, 784 (CCPA 1981); *In re Carter*, 213 USPQ 625, 625 (CCPA 1982).

¹⁴ *In re Webb*, 916 F.2d 1553, 1558; 16 USPQ 2d 1433, 1436 (Fed. Cir.1990).

§ 1502.01). In other words, if the “pleasing aesthetic is only an inadvertent byproduct”¹⁵, it is not eligible for a design patent.

3. Problems related to Patent-like Approach

One crucial feature of the current US design patent is that it relies heavily on rules that were tailored for utility patents (Du Mont and Janis, 2011, p. 6). The non-obviousness requirement, as well as the utility patent-like novelty requirement, does not really match the nature and purpose of design. Unlike inventions that might be eligible for utility patents, design is not (primarily) about groundbreaking innovations never seen before (Dinwoodie, 2008, p. 10). In practice, it is not easy to obtain design patents for modern, functional designs (Dinwoodie, 2008, p. 10; Rienzo, 1993, p. 83).¹⁶ Some scholars, therefore, argue that design patent protection has been relatively ineffective (Dinwoodie, 2008, p. 10; Rienzo, 1993, p. 83). Their argument is supported by the high rate of invalidation of design patents.¹⁷

Apart from the high threshold for protection, design patent protection is also criticized for its lengthy and expensive application process (Dinwoodie, 2008, p. 10; Keebaugh, 2005, pp. 261-262). Protection is granted as soon as the patent is issued. Currently the examination process takes about thirteen months, a time period that seems too long for an industry of usually short product cycles (Dinwoodie, 2008, p. 10). The prior art research raises the costs of the patent significantly (Keebaugh, 2005, p. 262; Suthersanen, 2010, p. 211).¹⁸ Therefore, copyright and trademark protection are attractive alternatives or additional forms of protection, as they do not require registration.

B. Trade Dress Protection

Protection for industrial designs can also be obtained under federal trademark law in the form of trade dress protection. The statutory source for the protection of product

¹⁵ See Manual of Patent Examination Procedure § 1504.01(c)(I) citing *In re Carletti*, 328 F.2d 1020, 140 USPQ 653, 654 (CCPA 1964).

¹⁶ Rienzo states that design protection is “virtually impossible to obtain” for industrial designs (Rienzo, 1993, p. 83).

¹⁷ During the period of the sixties to the early eighties, the Federal courts invalidated almost 70 % of all issued design patents, (Denicola, 1983, p. 707, p. 714).

¹⁸ According to Keebaugh “the application fee for a design patent is \$350 [...], the post-allowance fee is an additional \$490. These fees are in addition to any legal fees incurred to obtain the patent [...] A design patent will likely cost the owner upwards of one thousand dollars” (2005)” (Keebaugh, 2005, p. 262).

design is § 43(a) of the Lanham Act of 1946¹⁹ according to which “a container of goods” can be protected under trademark law. Although the rather limited statutory definition might suggest otherwise, trade dress in the US is a very broad concept that encompasses both product packaging and product design.²⁰

The threshold for protection, however, is relatively high. To be eligible for trade dress protection, industrial designs have to meet two requirements. First, they have to be distinctive.²¹ Second, they must be non-functional.²² If either of these requirements is not met, the shape cannot be protected under trademark law. What makes it even harder to obtain trade dress protection is the fact that product design, unlike product packaging, can no longer be inherently distinctive.²³ Instead the owner of the design has to establish secondary meaning. This requirement is met once the design owner can prove that the relevant public associates the design with a particular source or producer.²⁴ In practice, this means that the design owner has to heavily advertise the product to link it to its company and then conduct customer surveys in order to prove secondary meaning.

With respect to the non-functionality requirements, courts and examiners distinguish between utilitarian and aesthetic functionality. As the Supreme Court pointed out in its *Inwood Labs* case and reaffirmed in its *Traffix* case a “product feature is functional [in a utilitarian sense] if it is essential to the use or purpose of the article or if it affects the cost or quality of the article”.²⁵

Aesthetic functionality is based on the 1938 Restatement of Torts and blossomed in the 9th Circuit’s *Pagliero v. Wallace China* decision, a case about trade dress eligibility of the design of hotel china.²⁶ The court held that a design is aesthetically functional if customers buy the product primarily because of its “attractiveness and eye appeal of the

¹⁹ Corresponds with 15 U.S.C. § 1123 (a) (2008).

²⁰ Wal-Mart Stores, Inc. v Samara Bros., Inc., 529 U.S. 205, 209-210 (2000).

²¹ 15 U.S.C. § 1127.

²² 15 U.S.C.A. §1052(e)(5).

²³ See Wal-Mart Stores, Inc. v Samara Brothers, Inc., 529 U.S. 205 (2000).

²⁴ See Wal-Mart Stores, Inc. v Samara Brothers, Inc., 529 U.S. 205 (2000).

²⁵ See *Inwood Labs., Inc. v Ives Labs., Inc.*, 456 U.S. 844, 850-851 (1982); reaffirmed in *Traffix Devices, Inc. v Marketing Displays, Inc.*, 532 U.S. 23, 32, 33 (2001).

²⁶ *Pagliero v Wallace China Co.*, 198 F.2d 339, 343 (9th Cir. 1952).

design” and not because it functions as a source indicator (Dinwoodie, 1999, p. 611, p. 691).²⁷

Although the concept of aesthetic functionality has never been overruled to this day, most courts in the US are reluctant to apply that doctrine (Kur, 2011, p. 6). Remarkably, the Supreme Court directly addressed and thereby confirmed its vitality and existence in its *TrafFix* decision.²⁸ The Court delineated two types of functionality, the *traditional* (utilitarian) and the *aesthetic* one. It strictly distinguished between utilitarian and aesthetic functionality and established a test consisting of two parts (Markov, 2008, p. 197, p. 201). The first question a court/examiner has to ask when determining whether a feature is functional is whether “it is essential to the use or purpose of the article or if it affects the cost or quality of the article”²⁹. If the court does not affirm that question and, thus, cannot establish utilitarian functionality, it can then apply the modified³⁰ aesthetic functionality test by examining whether the “exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage.”³¹ The Court implied that the answer to this question could be guided by a competitive need analysis.

Compared to other forms of intellectual property protection, trade dress has three major advantages. First, registration is not required for the design to be protected. Second, protection is not limited to a certain period of time but can last indefinitely. Third, since courts have been dealing with trademark issues for such a long time, trade dress owners can rely upon an established body of case law (Keebaugh, 2005, p. 272). Besides, it is advantageous that the standard for infringement is relatively low. The owner of a valid trademark or trade dress can prove trademark infringement by showing

²⁷ *Pagliero v Wallace China Co.*, 198 F.2d 339, 342 (9th Cir. 1952) with reference to *Crescent Tool Co. v Kilborn & Bishop C.*, 247 F. 2d 299 (2nd Cir. 1917). Since then this so-called aesthetic functionality doctrine has been widely criticized for various reasons. Some saw in it “the potential to emasculate trade mark protection for designs” and that this doctrine would “reward fruitless designs with unnecessary protection, but exposed successful designs to unchecked imitation” (Dinwoodie, 1999, p. 611, p. 691)

²⁸ *TrafFix Devices, Inc. v Marketing Displays, Inc.*, 532 U.S. 23, 33 (2001). The Courts exact words “where the design is functional under the Inwood formulation there is no need to proceed further to consider if there is a competitive necessity for the feature. In *Qualitex Co. v Jacobson Prods. Co.*, 514 U.S. 159 (1995), by contrast, *aesthetic functionality* was the central question [..]”

²⁹ Classical test for utilitarian functionality, see *Inwood Laboratories Inc. v Ives Laboratories, Inc.*, 456 U.S. 844, 850 (1982); affirmed in *TrafFix Devices, Inc. v Marketing Displays, Inc.*, 532 U.S. 23, 1261 (2001).

³⁰ Modified in *Qualitex Co. v Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995).

³¹ *Qualitex Co. v Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995); *TrafFix Devices, Inc. v Marketing Displays, Inc.*, 532 U.S. 23, 1261 (2001).

that the alleged infringer's design is likely to confuse customers as to the source of the product.

However, especially the non-aesthetic functionality requirement is a hard one for non-ornamental aesthetic designs to pass. The idea behind a successful design is to be unique and eye appealing; this, however, could easily be interpreted as an aesthetically functional element for the commercial success of a product.

Furthermore, trade dress protection is not easy and quick to obtain. Since product design can never be inherently distinctive, the design owner first has to show secondary meaning. Unfortunately, establishing secondary meaning is a lengthy and costly process. It requires expensive advertising campaigns focusing on a product's design in a way that customers start associating the design with its source (McCarthy, 2012, pp. 8-16). Before secondary meaning is established the design is not protected under trademark law. Within this crucial time period, designers have to rely on other forms of design protection such as design patents (Keebaugh, 2005, p. 273).

C. Copyright Protection

Interestingly, in 1976 prior to the enactment of the Copyright Act, the Copyright Bill included a clause specifically protecting ornamental designs. This clause was dismissed last minute and never came into effect. However, the copyright statute today provides protection for a broad range of artistic works. The scope of protection is very broad³² and protection is granted until seventy years after the death of the creator.³³ According to 17 USC 102 copyright law protects original works fixed in a tangible medium.

At first sight, these requirements do not seem too strict. Looking at the variety of artistic works protected under copyright law one might assume that industrial design would easily meet the requirements for copyright protection. And indeed, copyright protection has been granted to a variety of designs such as jewelry and merely ornamental designs. However, with respect to industrial designs, copyright protection is generally almost impossible to obtain. The reason for this is the "useful article doctrine", set forth

³² See 17 USC § 106.

³³ See 17 USC § 302.

in 17 U.S.C. § 101.³⁴ It excludes designs from protection that (1) fall under the “pictorial, graphic, and sculptural work definition”, (2) are used for useful articles, and (3) are not identifiable separately from or cannot exist independently of the utilitarian aspects as a work of art.³⁵ Similar to the functionality doctrine in trademark law, the rationale underlying the useful article doctrine is that utilitarian improvements should exclusively be protected by utility patent law. Thereby, it is claimed that the careful limits in scope and term of protection provided for the owner of utility patents will not be bypassed by trademark or copyright protection (Magliocca, 2003, p. 854).

One characteristic element of industrial design, however, is precisely that it is used for useful articles. As a result, in order to obtain copyright protection for a design that meets the general copyright requirements³⁶, it is also necessary to show that the design is separable from the utilitarian aspects of the useful article it is attached to. The crucial question, however, is what does inseparability in the context of 17 U.S.C. § 101 mean exactly?

Two separate approaches for defining separability have arisen: physical and conceptual separability. The physical separability approach is rather narrow and objective and focuses on the exact wording of the statute, whereas conceptual separability is broader and subjective (Fischmann Afori, 2008, p. 1105, p. 1121).³⁷ If a design is separable either in a conceptual *or* in a physical way from the useful article, it can be protected under copyright law.³⁸

A design is *physically separable* when its aesthetic, non-functional elements can be physically removed from the useful article itself (Dinwoodie, 2008, p. 8). This standard seems to be very strict in the context of industrial design. Not only must the design be

³⁴ “Pictorial, graphic, and sculptural works” include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship *insofar as their form but not their mechanical or utilitarian aspects are concerned*; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.

³⁵ 17 U.S.C. § 101.

³⁶ Original work fixed in tangible medium, 17 USC § 102.

³⁷ For the physical test, see *Esquire*, 591 F.2d at 803–05. For the conceptual test, see *Kieselstein-Cord v Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980).

³⁸ *Brandir International, Inc. v Cascade Pacific Lumber Co.* 834 F.2d 1142, 1145 (2d Cir. 1987) where the court found that the curved metal bike rack design is not protectable.

non-functional in itself, it must also be separable from the useful article. Particularly for modern designs integrating form and function it seems almost impossible to meet this requirement (Dinwoodie, 2008, p. 8).

As to conceptual separability, courts take different views on how to interpret and apply this concept (Dinwoodie, 2008, p. 8; Magliocca, 2003, p. 856; Keebaugh, 2005, p. 264). The prevailing view seems to be that a design is conceptually separable if its “elements can be identified as reflecting the designer’s artistic judgment exercised independently of functional influences”.³⁹ “To be conceptually separable, [the design element] must be the result of aesthetic decision-making that is independent of functional considerations”.⁴⁰ This means that if the design is the result of utilitarian considerations, a court will not find it to be separable in a conceptual way. But if the designer can prove that he was creating the design regardless of its utilitarian benefits but for the sake of creating something artistic, it has a good chance of being protected under copyright law. Generally speaking, industrial design has a better chance of obtaining copyright protection using the conceptual approach.

However, the conceptual separability doctrine is far from settled. Scholars criticize it for its ambiguity and high level of subjectivity (Dinwoodie, 2008, p. 8; Magliocca, 2003, pp. 855 – 856; Keebaugh, 2005, pp. 267-268).⁴¹ It also seems that courts struggle as to how to apply the conceptual functionality test (Magliocca, 2003, pp. 855 – 856).⁴² Unfortunately, there is no clear guidance and courts apply different interpretations. Consequently, many companies do not want to rely on copyright protection for their designs since it is highly unpredictable how a court might decide in the event of an alleged infringement (Magliocca, 2003, p. 856; Keebaugh, 2005, p. 272).

D. Interrelationship of the Different Forms of Protection

The different forms of protections are not exclusive. Different intellectual property laws might be applicable as long as the requirements of the respective laws are met. Although industrial design can theoretically be protected under trademark, copyright and

³⁹ *Brandir International, Inc. v Cascade Pacific Lumber Co.* 834 F.2d 1142, 1145 (2d Cir. 1987).

⁴⁰ *Eliya Inc. v Kohl's Department Stores*, 82 USPQ2d 1088, 1094 (SDNY 2006).

⁴¹ Magliocca also talks about the problem that neither Congress nor the Supreme Court have given any guidance on how to interpret § 101 (Magliocca, 2003, pp. 855-856).

⁴² Magliocca who states that “at the moment [2003] there are at least five tests being used to delineate the critical boundary between design and utility” (Magliocca, 2003, pp. 855-856).

design patent law, the major threshold seems to be the non-functionality requirement that is present in all intellectual property laws outside the realm of utility patent law.

Should an examiner or court find a design to be functional, it is barred from trademark, copyright, or design patent protection. Functional elements of a product are eligible solely for utility patent protection. As a result, chances are that an industrial design that meets, for instance, the requirements for trade dress protection will also meet the requirements for a design patent and copyright. In contrast, a design that is denied protection in one of those areas of law due to a finding of functionality is likely to not obtain protection under the other areas.

The rationale behind this functionality doctrine that can be found under different labels in US design patent, trademark, and copyright law, is that art should be separated from utility (Afori, 2008, p. 1118).⁴³ This stands in sharp contrast to the nature of modern design that combines functional and aesthetic elements.

Furthermore, it is important to note that the scope and term of protection varies. While a design patent protects its owner from imitation by third parties, trademark law only protects against unauthorized use that is likely to cause confusion, while copyright protects against copying and use that is not covered by the fair use doctrine.

V. Design protection in the EU

A. Background

Design protection has always played an important role at the European level. Already in the 1950s, the Europeans aimed to harmonize patents, trademarks and design (Musker, 2001, p. i). After a failed attempt to harmonize the national laws, the European Commission finally succeeded in introducing European legislation intended to lead to a European design patent regime.

The European Union passed a Design Directive in 1998 and a Design Regulation in 2001. Similar to the Community Trademark, the goal was to first harmonize the national

⁴³ Afori (Afori, 2008, p. 1118) states that “the separation of “beauty” from “utility” in the American legal discourse was at that time an axiom rooted in Enlightenment ideal” and refers to J.H. Reichman, 1983, p. 1143, p. 1145.

laws of the member states and subsequently create a parallel form of protection at Community level, known as the Community design system (Musker, 2001, p. ii).

1. Directive on the Legal Protection of Designs (1998)

The Directive was adopted in 1998 and Member States had to revise their national design laws by October 28, 2001. The Directive sets minimal standards as to the eligibility and scope of protection for industrial designs. In order to be eligible for protection, a design must be novel and have individual character.⁴⁴ The owner then has the exclusive right to use it and to prevent others from using it.⁴⁵ The term of protection can be renewed every five years but may not exceed twenty-five years.⁴⁶

However, Member States are still free to independently regulate the “procedural provisions concerning registration, renewal and invalidation of design rights and provisions concerning the effects of such invalidity”.⁴⁷

2. Community Design Regulation (EC) No 6/2002

The Design Directive alone would have retained the territorial nature of design protection. To encourage and “allow goods embodying designs to flow freely within the internal market”⁴⁸, a uniform form of design protection was considered essential.⁴⁹ The Community Design Regulation (hereinafter the “CDR”) was adopted on December 12, 2001 and came into force on March 06, 2002. It introduced the concept of registered and unregistered Community designs. While the unregistered Community design was already protected after March 06, 2002, the registration of Community designs was not possible before April 01, 2003 (Schlötterburg and Folliard-Monguiral, p. 2).⁵⁰ From then on, companies and individuals were able to obtain protection at European level without having to obtain design protection for each Member State at national level. In the case of

⁴⁴ See Art. 3 (2) Design Directive.

⁴⁵ See Art. 12 Design Directive.

⁴⁶ See Art. 10 Design Directive.

⁴⁷ See Recital (6) Design Directive; note, that the substantive grounds for refusal of registration and invalidation are not subject to the Directive.

⁴⁸ See Explanatory Memorandum to Design Directive/ Regulation; Green Paper on Design, paragraph 3 (9) (2) – 3 (9) (3).

⁴⁹ See Recital (1), (3), (4) Community Design Regulation (EC) No 6/2002.

⁵⁰ An implementing regulation and a fee regulation had to be adopted in order to be able to apply for registration; see Art. 107 Community Design Regulation (EC) No 6/2002.

registered Community designs, it is possible to obtain Community-wide protection through one application in one language.⁵¹

It should be mentioned that the concept of unregistered Community designs does not necessarily exist at national level in all twenty-seven Member States. Unlike the registered design, the unregistered design is a concept at European Community level. The European legislator has not obliged Member States to introduce a comparable form of protection at national level.

3. Justification of the European Laws

The CDR, coupled with the Design Directive, has a high impact on design protection in Europe. Not only were the Member States required to harmonize parts of their national design laws, but the European legislator also introduced a totally new form of design protection called Community design.

There are several reasons why design protection is so strongly regulated by the European legislator. The most prominent one goes back to one of the original core objectives of the European Union, namely the establishment of an internal market as set forth in Art. 26 of the Treaty on the Functioning of the European Union (TFEU) (Suthersanen, 2010, p. 87). In the mid 1980s, legislators recognized the high impact of design for a product's commercial success and found it to be crucial for the trade between the Member States.⁵² The fact that Member States offered design protection at very different levels was, therefore, seen as a threat to undistorted competition within the internal market (Suthersanen, 2010, p. 87).

There was also increasing concern at European as well as at national level that companies might use national copyright and design protection to protect designs that are highly functional and thereby harm free and undistorted competition (Suthersanen, 2010, p. 87).

The European laws, therefore, point out that design protection can only refer to the appearance of a product and may by no means extend to aspects that are solely dictated by the product's technical function.⁵³

⁵¹ Recital (5), Art. 35, 98 Community Design Regulation (EC) No 6/2002.

⁵² Recital (2) Design Directive; Recitals (3)-(5) Community Design Regulation (EC) No 6/2002.

⁵³ See Art. 7 (1), (2) Design Directive, Recital 10, Art. 8 Community Design Regulation (EC) No 6/2002.

Another aim of the European laws was to comply with and implement the obligations under the TRIPS (Trade Related Intellectual Property Issues) Agreement, which set minimum standards for protection, compulsory licensing and enforcement (Musker, 2001, p. 6, p. 27).

B. Registered and Unregistered Community Design Patent

As mentioned above, the CDR introduced registered and unregistered Community designs, thereby significantly increasing the attractiveness of protecting designs. Of course there are differences between registered and unregistered Community designs with respect to enforcement and scope as well as term of protection. The material threshold for protection, however, is identical.

1. Threshold for Protection

Designs can be protected if they fall within the scope of the Directive, are novel, have individual character, and are not solely dictated by their technical functions and/or by interconnections.

a. Definition of Design

The term “design” is legally defined in Art. 3 (1) CDR as “the appearance of the whole or a part of a product, resulting from the features of, in particular, the lines, contours, colors, shapes, textures and/or materials of the product itself and/or its ornamentation”. The definition of the term ‘product’ is very broad and covers “any industrially-produced or handcrafted item, including among other things parts intended to be assembled into a complex product, as well as packaging, get-up, graphic symbols and typefaces, but excluding computer programs”.⁵⁴

b. Novelty and Individual Character

The two main requirements for Community design protection are novelty and individual character. The CMR requires worldwide absolute novelty. According to Art. 5 CDR a design meets the novelty requirement if “no identical design has been made

⁵⁴ See Art. 3 (2) CDR.

available to the public” before its date of first disclosure (unregistered Community design) or its filing date or the date of priority (registered Community design). Art. 7 (2) CDR affords a twelve months grace period. This means that disclosure of the design does not exclude design protection, as long as the application is filed within twelve months of disclosure.

The individual character requirement is met if an informed user gets a different overall impression compared to the designs seen so far.⁵⁵ The CDR does not provide a legal definition as to who constitutes an “informed user”.

The Court of Justice of the European Union defined the concept of the informed user in its recent *PepsiCo v Grupo Promer Mon Graphic and OHIM* decision as referring “not to a user of average attention, but to a particularly observant one, either because of his personal experience or his extensive knowledge of the sector in question”.⁵⁶ Interestingly, the Court established that the informed user is located in the range between the average consumer as used in trademark matters and the person skilled in the art as used in patent matters.

c. Not Solely Dictated by Technical Functionality

Under the CDR, it is not necessary to differentiate between ornamental, aesthetic, and functional designs. All of these designs can, theoretically, be protected as Community designs. To ensure, however, that technical solutions embedded in a design cannot be monopolized outside the realm of patent law, Art. 8 CDR sets forth that design features are excluded from protection if they are solely dictated by the product’s technical function or must necessarily be reproduced in their exact form and dimension in order to define the product in which the design is incorporated.

Although the wording “solely dictated” suggests that technical design features are only excluded if no alternative forms are available which will achieve the same technical function, the case law shows that this is not true. The Third Board of Appeal of the OHIM held that it does not matter if there are alternative features available.⁵⁷ Instead, the

⁵⁵ See Art. 6 CDR.

⁵⁶ *PepsiCo v Grupo Promer Mon Graphic SA and OHIM*, [2011] CJEU Case C-281/10 paragraph 53, 54. Note that this was the CJEU’s first decision of Community design rights.

⁵⁷ OHIM, Decision of the Third Board of Appeal of 22 October 2009 in Case R 690/2007-3 Lindner Recyclingtech GmbH v. Franssons Verkstäder.

designer's motivation should count.⁵⁸ If a reasonable observer comes to the conclusion that the technical product features “were chosen exclusively for the purpose of designing a product that performs its function, as opposed to features that were chosen, at least to some degree, for the purpose of enhancing the product's visual appearance”⁵⁹.

However, even if certain features are excluded from protection, other, non-functional parts of the design can still be protected as long as they fulfill the requirements for protection (Suthersanen, 2010, p. 101).

2. Registration Process at the OHIM

The Community design is what is known as an unexamined intellectual property right. This means that registration is granted without prior substantive examination. For the sake of providing quick and cheap registration, the Office for Harmonization in the Internal Market (OHIM) does not examine novelty and individual character. Registration is only denied if the design does not fall within the CDR's design definition or does not comply with public policy or morality.⁶⁰ The substantive requirements for protection are only examined in case of dispute by a civil court. Should the court find that the design was not eligible for design protection, the design is deemed to be invalid with retroactive effect even if the design was initially registered. From the perspective of the applicant, this lack of substantive registration has one major advantage: A registered Community design can be granted very quickly, usually within eight weeks of filing the application (OHIM, Comparison US design patents and Community design, 2007, p. 2).

3. Scope of Protection

Both the registered and the unregistered Community design are protected in the European Union as a whole. It is not possible to obtain Community design protection only for particular Member States.⁶¹

⁵⁸ Lindner v Franssons, supra note 57.

⁵⁹ Lindner v Franssons, supra note 57.

⁶⁰ See Art. 45, 47 CDR.

⁶¹ See Art. 11 CRD.

a. Registered Community Design

The registered Community design (RCD) gives its holder the right to prevent any unauthorized use. Particularly, no third party is allowed to make, offer, put on the market, import, export or utilize or possess the design or a design that creates the same overall impression.⁶² Accordingly, the right holder can prevent any third party from manufacturing and distributing the design regardless of whether the design was intentionally copied or independently developed.

An RCD is protected for five years from the date of filing and can be protected for up to twenty-five years provided that the owner renews the protection every five years.⁶³

b. Unregistered Community Design

Unlike an RCD, you do not have to apply for an unregistered Community design (UCD). The rights are automatically conferred upon creation. However, the UCD gives its holder fewer rights to proceed against third parties that are using the design without permission. Unlike the RCD, the UCD only confers protection against copying; there is no recourse against independent creation.⁶⁴ Also, protection is only granted for a period of three years from the date of disclosure.⁶⁵

If a company or person relies solely on a UCR, it is well advised to provide exact proof of when the design was first disclosed.⁶⁶ This is because the question of priority inevitably arises in the event of subsequent infringement proceedings. The holder of the UCR must then prove that it was the one that first disclosed the design.

3. Infringement Proceedings

In infringement proceedings, courts will deem the design to be valid, unless the defendant questions its validity.⁶⁷ In the case of an UCD, that presumption requires the holder of the right to provide proof as to the novelty and indicate the individual character of the design.⁶⁸ However, if the defendant raises the validity question, the court can stay

⁶² See Art. 19 (1) CRD.

⁶³ See Art 12 CRD.

⁶⁴ See Art. 19 (2) CRD.

⁶⁵ See Art. 11 (1) CRD.

⁶⁶ This can be done through publication in a national design gazette.

⁶⁷ See Art. 85 CRD.

⁶⁸ See Art. 85 (2) CRD.

the infringement proceedings until it has been decided whether the design protection is valid.⁶⁹ Both the OHIM and the national Community design courts have jurisdiction for invalidation proceedings and declarations thereof.⁷⁰

C. Community Trademark

Another way to protect industrial design is to apply for a three-dimensional Community trademark. Protecting design through trademark law is becoming increasingly popular. From a company's point of view this makes sense. A Community trademark is not limited to a specified term of years, but can be renewed indefinitely for periods of ten years.⁷¹ Besides, it gives its holder a broad scope of protection; he can prevent any use that is likely to cause confusion.⁷²

1. Application Procedure

Similarly to the registered Community design, the Community trademark is popular for its simple application procedure. In order to obtain protection for all twenty-seven Member States, only one application at the OHIM in one language is needed. It can only be obtained or cancelled with respect to the European Union as a whole. Unlike the Community design, a CTM is not considered an unexamined right. CTM applications are examined upfront on absolute grounds of objection and on formal requirements of the application.⁷³ Absolute grounds for refusal, as opposed to relative grounds for refusal, refer, inter alia, to distinctiveness, trademark eligibility such as non-functionality and non-descriptiveness. Relative grounds for refusal exist if the proprietor of an earlier trademark successfully opposes the application.⁷⁴

As a result, the registration process takes longer. Typically for an unopposed application it takes six to twelve months to reach registration.

⁶⁹ See Art. 86 (3) CRD.

⁷⁰ See Art. 24, 81 CRD.

⁷¹ See Art. 46, 47 CTMR

⁷² See Art. 9 CTMR

⁷³ See Art. 36, 37 CTMR.

⁷⁴ See Art. 8 CTMR.

2. Threshold for Protection

The definition of a sign eligible for trademark protection has expanded remarkably in the last 25 years. Nowadays, it is possible to register a three-dimensional sign as a trademark in the EU.⁷⁵ Thus, designs in the form of shapes can in principle be protected under trademark law. However, three-dimensional signs have to pass two major bars in order to be eligible for trademark protection.

First, they have to be distinctive. That means that the design must be able to identify the goods it protects as originating from a particular source. In other words, the design must be capable of being perceived as a source indicator. Second, the design must be non-functional.

If either of these requirements is not met, the design cannot be protected under trademark law. However, whereas non-functional designs can overcome a lack of inherent distinctiveness through use, once a sign is considered functional, it can never be protected under trademark law. This is true regardless of whether it can or will be established that the functional design is perceived as a source indicator.⁷⁶

Signs are considered functional, if they (i) exclusively consist of shapes deriving from the nature of the product, or (ii) are necessary to achieve a certain technical outcome, or (iii) give substantial value to the goods.⁷⁷ Especially in the realm of design protection it is hard to draw the line between functional and non-functional designs since many of the modern designs are characterized by their simple and reduced style. This is particularly true with respect to the third ground of exclusion, also known as the aesthetic functionality exclusion clause.

The question as to how aesthetic functionality should be defined within the European Union has still not been settled. The prevailing interpretation of that provision is presumably that a shape “gives substantial value to the goods” if it is aesthetically appealing and customers essentially base their buying decision on its aesthetic characteristics (Schober, 2011, p. 12; Gonzáles, 2010, p. 7; Ingerl and Rohnke, 2010, § 3, para 40).

⁷⁵ On the European level as community trademark, or on the national level as national trademark.

⁷⁶ *Koninklijke Philips Electronics NV v Remington Consumer Prods. Ltd.*, [2002] CJEU Case 2999/99, paragraph 74, 75, 76.

⁷⁷ See Art. 7 (1) (e) CTMR.

The crucial question the courts face in the realm of industrial designs, however, as to whether the requirements of Art. 7 (e) (iii) TMD are met occur when an aesthetically appealing shape is bought not primarily for its aesthetic appeal but also for other reasons, such as its technical function or the reputation of the company that produces and sells it. National courts do not apply a uniform approach to this problem. So far, the Court of Justice of the European Union (CJEU) has not taken a position on this issue.⁷⁸ However, the General Court (previously known as the European Court of First Instance) ruled in its *Bang & Olufsen v. OHIM* decision that the focus should be on how the product is marketed, regardless of what factors the customer bases their buying decision on.⁷⁹ According to the court, it is irrelevant whether the customer bases their buying decision on not only aesthetic characteristics but also on other factors, such as technical function, or the quality that is associated with the brand and/or manufacturer.⁸⁰

The General Court's decision is currently under appeal. The CJEU now has the opportunity to address the issue of whether Art. 7 (1) (e) (iii) CTMR excludes shapes from trademark protection that are bought not only for their aesthetic characteristics but also because they are perceived as an indicator of the company behind it.

This decision is currently under appeal. If the CJEU confirms the General Court's judgment, aesthetic shapes that are specifically marketed for their attractiveness will no longer be protectable, regardless of whether customers buy them just for their appealing design or for other reasons as well (Kur, 2011, p. 17).

3. Protecting Designs with Trademark Law in Practice

Most three-dimensional designs are not inherently distinctive and modern three-dimensional designs are often not clearly separable from the product's technical function. Nevertheless, there has been a trend towards protecting designs under trademark law (Fezer, 2009, § 3, para 699). This is due to the registration practice of the national trademark offices and the Office of Harmonization for the Internal Market (OHIM),

⁷⁸ Some scholars refer to the *Benetton v G-Star* decision to discuss the meaning of aesthetic functionality. In this case, however, the court did not have to decide the question whether a shape is aesthetically functional, if it is perceived as a source indicator and in the same time bought for its appealing design. The CJEU solely reaffirmed that aesthetic functionality cannot be overcome by proving distinctiveness; *Benetton Group Spa v G-Star International BV*, CJEU, GRUR 2007, 970.

⁷⁹ *Bang & Olufsen v OHIM* [2011], General Court, Case T-508/08, paragraph 70-73.

⁸⁰ *Bang & Olufsen v OHIM* [2011], General Court, Case T-508/08, paragraph 72.

which is rather generous when it comes to the registration of three-dimensional trademarks (Fezer, 2009, § 3, para 699).

As far as functionality requirements are concerned, the OHIM is guided by the CJEU's decisions. For example, the Court explicitly stated in its *Lego* decision, that when drafting the CTMR and the Trademark Directive, the European legislator was aware of the fact that "any shape of goods is, to a certain extent, functional and it would therefore be inappropriate to refuse a trademark protection solely on the ground that it has functional characteristics."⁸¹

Since most industrial designs are not inherently distinctive it usually takes some time to establish distinctiveness. Companies, however, want to protect their designs from the moment the product is launched on the market. Consequently, many companies first apply for a Community design and try to obtain trademark protection subsequently.

D. Other forms of protection in the EU

Besides Community designs and Community trademarks, designs might also be protected as other kinds of intellectual property right. At national level, protection might be obtained under copyright law, unfair competition law or national trademark⁸² and design law.

1. National Copyright Law

Compared to patent, trademark, and industrial design, copyright is the least harmonized intellectual property law in the EU (EU Assessment Panel, 2011, p. 7). Despite twenty years of harmonization efforts, copyright law continues to remain within the aegis of national law. Although seven core Directives regarding copyright law⁸³ have been implemented in the last twenty years, only certain aspects are harmonized.

⁸¹ *Lego v OHIM/Mega Brands* [2010] CJEU, Case C48/09 P, paragraph 48.

⁸² National Trademark Laws are highly harmonized. If a design is eligible for a community trademark, it may also obtain a national trademark. Therefore, I refer to what has been explained above under the Community Trademark section.

⁸³ The following seven core directives have been implemented: (1) Directive 91/259 EEC on the Protection of Computer Programs; (2) Directive 2006/115/EC on Rental and Lending Right; (3) Directive 93/83/EEC on the coordination of certain rules concerning copyright and rights related to copyright applicable to satellite broadcasting and cable retransmission; (4) Directive 2006/116/EC that harmonizes the terms of protection of copyright and neighboring rights; (5) Directive 96/9/EC on the Protection of Databases, (6) Directive 2001/84/CE on the resale right; (7) Directive 2001/29/EC on the harmonization of certain aspects of copyrights and related rights in the information society.

Traditionally, copyright law aims to protect personal and human expression as incorporated in a creative work of art or literature (Suthersanen, 2010, p. 182). It protects original works of art fixed in a tangible medium.

In most Member States, copyright law specifically protects works of applied art. At least in theory, designs can be protected as applied works of art since most European member states do not have a doctrine similar to the US “useful article doctrine” that categorically excludes utilitarian features. Both the Design Directive and the Community Design Regulation expressly introduce a “cumulative protection principle to design” (Suthersanen, 2010, p. 178) by stating that Member States are free to open their national copyright to designs and can determine the conditions that must be met in order to obtain protection.⁸⁴

However, many legislators and courts are reluctant to protect designs under copyright law. In Germany, for instance, designs are usually not protected under copyright law due to lack of originality. In Germany, design can only be protected under copyright law if considerable creative effort is present which exceeds the level of an average designer’s performance. Other countries such as France or the Netherlands take a much more liberal approach and protect designs under copyright law on a regular basis (Suthersanen, 2010, p. 178).

2. National Unfair Competition and Design Laws

The substantive parts of the national design laws were harmonized by means of the Design Directive, which required them to provide protection for designs that are novel and have individual character. National design rights are particularly popular for companies that operate geographically within the Member State they are located in (Suthersanen, 2010, p. 90).

Unfair competition law is partially harmonized within the EU, but there is as yet no uniform European unfair competition law. With respect to design protection it can offer another layer of protection. However, most courts are reluctant to apply it in order to prevent imitation of designs. They follow the general principle that in the absence of

⁸⁴ See Art. 17 Design Directive, Art. 96 (2) CDR.

further special circumstances, such as unethical business practices, imitation is allowed as long as other intellectual property laws do not protect the imitated object.⁸⁵

E. Interrelationship of Different Forms of Protection

There is no barrier to protecting a design under various forms of intellectual property laws at the same time. As long as the requirements under the different laws are met, protection is granted. The fact that a design can cumulatively be protected under trademark, copyright, and design laws only reflects its hybrid nature. In other words, designs in the EU are subject to a multi-faceted protection regime (Suthersanen, 2010, p. 93, 182). But it is important to bear in mind that it is quite difficult for modern industrial designs to meet the requirements for trademark protection and, in many Member States, for copyright protection.

VI. Comparison of US and EU Design Laws

The US and the EU offer different design protection regimes. While the US seems to rely more on a mix of different laws, the trend in the EU seems to be moving towards uniform European design protection. However, in both jurisdictions it is common for companies to protect designs with various different intellectual property rights. Trademark law, in particular, seems to be playing an increasingly important role in protecting unusual designs both in the US and in the EU.

Looking at the numbers of design patents issued compared with registered Community designs over the past few years, however, it is extremely striking that far fewer design patents were granted in the US than registered Community designs in the EU. In the EU 472,714 designs were granted between 2003 and 2011 (OHIM statistics report, 2011). In the US, however, only 183,083 patents were granted in the same period (USPTO Report, 2011).

Although statistics show that companies have started filing more US design patents in the last few years⁸⁶, the question remains as to how the difference in the total numbers can be explained. There is no clear answer on that. But if we compare the European

⁸⁵ WIPO, Protection Against Unfair Competition (Geneva: WIPO, 1994), paragraph 61.

⁸⁶ According to the USPTO Design Patents Report 21,356 design patents were granted in 2011, while in 2005 only 12,951 design patents were granted.

registered Community design to the US design patent, certain differences become obvious.

A. Sui Generis Form of Protection vs. Patent Approach

Design patents in the US are classified in the patent tier whereas Community designs constitute sui generis forms of protection independent of the preexisting copyright or patent system. This difference is not merely dogmatic, but also leads to differences in practice such as the non-obvious requirement in the US for design patents that derive from utility patent law.

B. Possibility of Unregistered Design Protection

Unlike in the US, the EU's design laws offer protection for unregistered designs through the unregistered Community design. In the US, protection without registration can only be obtained under common law trademark and copyright law.

Particularly for small companies or freelancers, unregistered Community designs are attractive for protecting products with a short product life cycle such as fashion, since a registration process would take too long and might also be too expensive.

C. Eligible Subject Matter for Design Protection

1. Design Definition

Most importantly, the definition of a design is much broader under EU Community patent law than under US design patent law. While the US limits design patent eligibility to articles of manufacture⁸⁷, the EU design definition encompasses the appearance of any product or part of it (OHIM, statistics report, 2011). As a result, under EU law products can be protected that would not be eligible for a design patent in the US such as fashion, packaging, graphic user interfaces, logos and other graphic symbols. The fact that the EU's Community design can be obtained for a much broader range of designs might be one reason for the different filing figures.

⁸⁷ See Art. 3 (a) CDR.

2. Individual Character (EU) vs. Non-Obviousness (US)

It is often argued that the requirement for individual character set forth in Art. 6 CDR is easier to meet than the non-obviousness requirement in 35 USC § 103 in the US. As a result, some claim that it is easier to obtain a registered Community design under EU law than a design patent in the US (Suthersanen, 2010, p. 209).

This, however, is not necessarily true. In fact, the EU “individual character” requirement and the US “non-obvious” requirement are just the two sides of the same coin reflecting the different approaches of the two jurisdictions. The US design patent system is closely related to patent law, so that it is only natural for designs to be examined from the point of view of a person skilled in the art (that is also used for examining utility patent application). Conversely, in Europe a design is examined from the point of an informed user. In short, in Europe a registered Community design is granted if the design makes a different impression on an informed user, whereas in the US a design patent is only granted if the design’s creation “goes beyond the ordinary skills of a designer” (OHIM Newsletter 10/2010). It is only natural for these approaches to lead sometimes to different solutions. However, there is no evidence that it is easier to obtain design protection under the European approach (OHIM Newsletter 10/2010).

3. Originality Requirement in the US

Unlike in the US, in the EU there is no explicit originality requirement for design protection. In practice, however, the originality requirement is unlikely to lead to significant differences, since it is similar to that under copyright and, therefore, does not constitute a major hurdle.

4. Ornamentality Requirement in the US

The ornamentality requirement under 35 USC § 171 is highly similar to the non-functionality requirement set forth in Art. 4, 8 CDR. Both focus on whether and to what degree the design is governed by functional necessity and considerations.

D. Application Procedure

1. Costs and Duration

After submitting the design patent application in the US, it takes about thirteen months for the design patent to be granted (USPTO Report, 2011). In the EU, 80 % of registered Community designs are issued within eight weeks (OHIM, Comparison US design patents and Community design, 2007, p. 2).⁸⁸ One reason for this relatively quick processing, however, is that the European registered Community design is an unexamined right, which means that no examination of novelty is carried out during processing. Besides, the fees for a design patent are significantly higher than the fees for a registered Community design. While a US design patent costs \$1520 USD in total (USPTO Fee Schedule),⁸⁹ a registered Community design costs €350 (OHIM Fee Schedule).⁹⁰

These significant differences with respect to fees and processing time might at least in part explain why registered Community designs seem to be more popular than US design patents.

2. Level of Examination

While US design patents are fully examined before registration, EU design patents are registered without prior substantive registration. Should a company find that the registered Community design infringes their design embodying prior art, it can request the OHIM to declare the registered Community design invalid.

Although the EU design patent can be challenged after being registered, this practice can have a large impact. Rights holders can apply to the courts for a preliminary injunction that prevents the alleged infringer from importing/selling its products based on an unexamined right.⁹¹ The validity of a Community design is presumed in law, under Art. 85 (1) CDR. This means that the onus is on the defendant to prove that the plaintiff's design is not novel or non-obvious and thus invalid. Although the decision to grant a

⁸⁸ The OHIM report is based on data from 2007.

⁸⁹ The fees consist of the basic filing fee \$250, search fee \$120, examination fee \$160, issue fee \$990.

⁹⁰ The fees consist of the registration fee €230 and publication fee €120.

⁹¹ For instance, Apple successfully requested a preliminary injunction from a German court stopping Samsung from selling its tablets in Germany.

preliminary injunction must be based on a careful balance of the interests at stake, the legal validity presumption gives the right holder a strong advantage.

E. Test for Infringement

According to Art. 10 CDR, the scope of protection includes any design producing the same overall impression on the “informed user”. Accordingly, a court will see an infringement of a Community design if the alleged infringing design does not produce a different overall impression on the informed user (i.e. not an average user or a design expert). Thus, in the EU, the point of view of an informed user is decisive for a finding of infringement.

The test for infringement in the US has shifted significantly over the last few years, which might be one explanation for the recent increasing popularity of design patents. In its *Egyptian Goddess v Swisa* landmark decision from 2008, the US Court of Appeals for the Federal Circuit adopted the “ordinary observer” test as the sole test for assessing design infringements.⁹²

Infringement has hitherto been deemed to exist if two requirements were met. First, the right holder had to show that the alleged infringing product’s design would confuse an ordinary observer in such a way that he would have difficulties in distinguishing the original and the alleged infringing design.⁹³ Second, the right holder had to prove that the accused design incorporated the features that were found novel and therefore protectable with respect to the original design.⁹⁴ This second test was referred to as a “point of novelty” test. Defendants usually pursued one of the following two strategies to prevent a court from finding infringement. They would either claim that the copied parts of the design do not encompass the features rendering the original design novel and, therefore, patentable (Kugler and Mueller, 2009, pp. 71-72). Or they would eliminate some (minor) details of the design and argue that those features were the ones that arguably were the point of novelty (Kugler and Mueller, 2009, p. 72). Thus, under previous case law, an imitated design did not infringe the original one, as long as it did not encompass its points

⁹² *Egyptian Goddess, Inc. v Swisa, Inc.*, 543 F.3d 665 (Fed.Cir. 2008).

⁹³ *Egyptian Goddess, Inc. v Swisa, Inc.*, 543 F.3d 665, 670 (Fed.Cir. 2008).

⁹⁴ *Egyptian Goddess, Inc. v Swisa, Inc.*, 543 F.3d 665, 670 (Fed.Cir. 2008).

of novelty, irrespective of whether informed consumers considered the appearance of the products to be confusingly similar.

This point of novelty test was overruled by the Court of Appeals for the Federal Circuit in its *Egyptian Goddess* decision. From now on, what matters for a finding of infringement is whether an ordinary observer, i.e. an individual who is familiar with the prior art, would mistake the alleged infringing design for the original one.⁹⁵ This decision was highly appreciated by design patent holders, who now have to meet less strict requirements to prove an infringement. Interestingly, the ordinary observer test is strongly reminiscent of the “overall impression on the informed user” standard that is applied in the EU.

This change in US design patent case law has thus further approximated the US and EU design protection regimes.

Another important difference between the US and EU lies in the different infringement proceedings in the two jurisdictions. While in the US, a design patent owner can only sue for infringement before a court; it is possible in the EU to bring invalidity claims at the OHIM, which is usually cheaper than court proceedings (OHIM, *Comparison US design patents and Community design*, 2007, p. 2).

F. Term of Protection

Another crucial difference consists in the term of protection. While a design patent in the US can be protected for a period of 14 years, a community design can be renewed up to a total period of 25 years. This makes a big difference in practice, especially with regard to industrial design that enjoys long-lasting popularity.

G. Role of Functionality in General

In the US one of the main concerns of the legislator and courts is to prevent monopolization of functional aspects outside the realm of utility patent law. This concern is reflected not only in the non-functionality requirement for design patents and trademark law, but also in the useful article doctrine in copyright law.

⁹⁵ *Egyptian Goddess, Inc. v Swisa, Inc.*, 543 F.3d 665, 672 (Fed.Cir. 2008).

Apart from trademark law that follows the same approach, the laws of the EU, at both national and Community level, do not make that clear distinction. Designs that embody functional elements are not categorically excluded from national copyright and design protection, at least not as a whole. This makes it a lot easier, particularly for modern simplistic designs, to obtain protection.

The EU's generous approach also has disadvantages. Some fear that the EU may be granting patent-like protection and thereby circumventing the strict requirements of patent law. Functional products, however, are crucial for undistorted competition and, indirectly, for consumer welfare as well.

VII. Conclusions

After comparing the two systems, the ultimate question now is: do the two systems provide the same level of protection or is one system more effective than the other?

Naturally, there is no clear answer to this question. The EU and the US take different approaches on how to protect designs. As a matter of fact, the EU protects a broader range of design, such as fashion. It is also true that it is significantly quicker and cheaper to obtain design protection in the EU than it is in the US.

However, once protection is granted, it is hard to assess which system is more effective. Apple's design war against Samsung perfectly exemplifies the power of design protection in the two jurisdictions. In the EU Apple has been granted a preliminary injunction barring Samsung from selling its Galaxy tabs which have a design highly similar to that of Apple's iPad.⁹⁶ And in the US, the Court of Appeals for the Federal Circuit has just declared that Apple's design patent is valid. The court did not grant a preliminary injunction itself but recessed for findings on the balance of hardships and the public interest.⁹⁷ This shows that design protection in the two jurisdictions is a strong tool that can be used by the right holder to force competitors out of the market.

From a policy perspective, it is hard to evaluate how much design protection is desirable and how strong it should be. Industrial design has a hybrid nature. The

⁹⁶ Apple, Inc. v Samsung Electronics Co., Ltd., Landgericht (District Court) Düsseldorf, 14c O 194/11, August 09, 2011. The injunction did not include the Netherlands since at the time there were separate proceedings under way the German Court issued the preliminary injunction.

⁹⁷ Apple, Inc. v Samsung Electronics Co., Ltd., F.3d, 2012 WL 1662048 (Fed. Cir.).

combination of function and aesthetics makes it accessible for different forms of protection. It is understandable that legislators do not want to grant protection so strong that competition becomes impossible. It is in the interests of the consumer for a broad range of products to be available that follow a similar design trend. Simplistic design can be compared to a form of style, and we know from copyright law that style must be in the public domain to incentivize innovation.

Drawing the line between how much protection is needed and what form of protection is too much seems almost impossible. This, however, should not result in incoherent design protection regimes. At international level, the biggest factor for incoherency is that there is no uniform design protection.

But even within the US and EU jurisdictions there is no coherent design protection across the intellectual property spectrum (Suthersanen, 2010, p. 260).

Although the EU offers a *sui generis* Community design as well as a largely harmonized national design law system, the differences as to the level of protection between the Member States are still significant. The reason for this different level of protection is that copyright law is largely unharmonized and, in particular, the design/copyright interface is still not regulated at European Level.

In the US design protection seems even more incoherent. Companies do not rely on design patent law since it often denies protection to designs that incorporate form and function. The same is true of copyright law. As a result, trademark protection is gaining in popularity even though it is hard to obtain.

The answer as to whether any form of protection outside the realm of utility patents is granted depends highly on whether a design is considered to be ornamental/aesthetic as opposed to functional. That, in turn, is dependent on the examiner's or judge's subjective assessment. After all, how is a court supposed to objectively distinguish ornamental aspects from functional ones in cases where a design incorporates both?

The strict distinction between functionality and ornamentality that is pursued in particular in the US does not, therefore, seem appropriate any more. It is hard to obtain protection especially for modern designs purposely combining aesthetic and functional elements. This results in the paradoxical situation where simplistic design is highly popular and valuable and, therefore, in need of that very protection.

Besides, the rationale behind the functionality requirement for designs does not seem very convincing. The functionality requirement is intended to prevent an overlap of protection between the various intellectual property rights and also prevent companies from circumventing the specific requirements for a utility design. This overlap, however, just reflects the hybrid nature of industrial design.

With that said, the legislators could try to find other ways to prevent technological monopolies through design rights. For instance, legislators could regulate the strength of protection by introducing a second requirement (as well as the “ordinary observer” or “overall impression test”) that has to be met for a finding of infringement. Courts should examine whether there is a competitive need to copy a design. In other words, courts should examine whether reasonable alternative designs are available to obtain the same technical result. Should no alternatives be available, competitors must be able to copy the design to the extent that is necessary to obtain the same technical result.

Eliminating the functional vs. ornamental requirement by using a new infringement test would ensure that designs can be protected but would, at the same time, limit the scope of protection. After all, one of the main rationales behind intellectual property law in general is to incentivize innovation while not stifling meaningful competition. Design protection should, therefore, not rashly be denied.

Roughly summarized, three things need to be done. First, a uniform design definition is needed. Second, legislators have to understand the hybrid nature of industrial designs and the need for a coherent design protection system. Therefore, the US should stop distinguishing strictly between ornamental and functional designs. The EU, on the other hand should further harmonize national laws, especially with regard to the interface between copyright and design rights.

About the Author:

Lena Schickl graduated from the Intellectual Property Law and Policy Graduate Program (LL.M.) of University of Washington, Seattle in 2012. She is currently working on her legal traineeship in Berlin, Germany. Contact her at: [lena.schickl@gmail.com](mailto:lana.schickl@gmail.com)

Notes:

I thank Professor Signe H. Naeve for her help on the earlier draft of this article. Also, I thank the entire team from the LL.M. Program at University of Washington for facilitating my unique experience at UW School of Law.

References:

Afori, O. (2007-2008) ‘Reconceptualizing Property in Designs’, *Cardozo Arts & Entertainment*, Volume 25, Issue 3, pp. 1105–1178.

Denicola, R. (1983) ‘Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles’, *Minnesota Law Review*, Volume 67, pp. 707-748.

Di Rienzo, J. (1993) ‘Design Innovation and Technology Act of 1991: Effective Protection for the Aesthetic Aspects of Useful Articles’, *Journal of Legislation*, pp. 79-95.

Dinwoodie, G (1999) ‘The Death of Ontology: A Teleological Approach to Trademark Law’, *Iowa Law Review*, Volume 84, pp. 611-752.

Dinwoodie, G. (2008) ‘The Protection of Designs Under U.S. Law’, *IPRinfo 04/2008* [online], pp. 1-12. Available at (http://www.iprinfo.com/julkaisut/iprinfo-lehti/lehtiarkisto/2008/IPRinfo_4-2008/fi_FI/The_Protection_of_Designs_under_US_Law/) [Accessed on March 2013].

Dinwoodie, G. and Janis, M. (2010) *Trade Dress and Design Law*, 1st edition. Aspen Publishers, New York.

Du Mont, J. and Janis, M. (2011) ‘The Origins of American Design Protection’, *Indiana Law Journal* [online], Volume 88. Available at (http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1862182) [Accessed on March 2013].

EU Parliament Science and Technology Options Assessment Panel (2011), *Copyright in the EU - what next? – Final report* [online]. The Parliament of the European Union. Available at ([http://www.europarl.europa.eu/RegData/etudes/etudes/join/2011/460342/IPOL-JOIN_ET\(2011\)460342\(PAR00\)_EN.pdf](http://www.europarl.europa.eu/RegData/etudes/etudes/join/2011/460342/IPOL-JOIN_ET(2011)460342(PAR00)_EN.pdf)) [Accessed on March 2013].

Fezer, K. (2009) *Kommentar zum Markenrecht*, 4th edition. Beck, Munich.

German Patent and Trademark Office, *An Information Brochure on Design Protection* [online]. Available at (http://www.dpma.de/docs/service/veroeffentlichungen/broschueren_en/designs_engl.pdf) [Accessed on March 2013].

Gonzáls, L. (2010) 'Functional Shape Marks, Conditions for the exclusion of protection and limits thereof', *Katholieke Universiteit Leuven Faculty of Law* [online], pp. 1-33. Available at (<http://oami.europa.eu/ows/rw/resource/documents/QPLUS/network/universities/functional%20shape%20marks%20hernandez%202010.pdf>) [Accessed March 2013].

Heskett, J. (1980) *Industrial Design*, 1st edition. Thames & Hudson, London.
Ingerl, R. and Rohnke, C. (2010) *Markengesetz Kommentar*, 3rd edition. Beck, Munich.

Keebaugh, R. (2005) 'Intellectual Property and the Protection of Industrial Design: Are Sui Generis Protection Measures the Answer to Vocal Opponents and a Reluctant Congress', *Journal of Intellectual Property Legislation*, Volume 13, pp. 255-287).

Kugler, B. and Mueller, C. (2009) 'A Fresh Perspective on Design Patents', *The Colorado Lawyer* [online], Volume 38, Issue 7, pp. 71-77. Available at (http://www.sheridanross.com/img_upld/a_fresh_perspective_on_design_patents_1274302472.pdf) [Accessed March 2013].

Kur, A. (2011) 'Too pretty to protect? Trademark law and the enigma of aesthetic functionality', *Max Planck Institute for Intellectual Property and Competition Law Research Paper No 11-16* [online]. Available at (http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1935289) [Accessed on March 2013].

Magliocca, E. (2003) 'Ornamental Design and Incremental Innovation', *Marquette Law Review*, Volume 6, Issue 5, pp. 844-894.

Markov, Y. (2008), 'Raising the Dead: How the Ninth Circuit Avoided the Supreme Court's Guidelines Concerning Aesthetic Functionality and Still Got Away with It in Automotive Gold', *Northwestern Journal of Technology and Intellectual Property* [online], Volume 6, Issue 2, pp. 197-210. Available at <http://scholarlycommons.law.northwestern.edu/njtip/vol6/iss2/5>) [Accessed on March 2013].

McCarthy, T. (2012) *McCarthy on Trademarks and Unfair Competition*, Volume 2, 4th edition, Thomson Reuters/WEST (U.S.A.).

Musker, D. (2001) *The Design Directive*. The Chartered Institute of Patent Agents [online]. Available at (<http://www.jenkins.eu/downloads/the-design-directive-by-david-musker.pdf>) [Accessed on March 2013].

OHIM (2007), *US Design Patent and Registered Community Designs – Comparison of Their Main Characteristics* [online]. The Office for Harmonization in the Internal Market. Available at (<http://www.aipla.org/learningcenter/library/papers/am/AM08Materials/Documents/Rodinger-paper.pdf>) [Accessed March 2013].

OHIM (2010), *Newsletter from October 2010* [online]. The Office of Harmonization for the Internal Market. Available at (<http://oami.europa.eu/ows/rw/pages/OHIM/OHIMPublications/newsletter/1010/RCD/rcd1.en.do>) [Accessed March 2013].

OHIM (2011) *Statistics on Registered Community Designs* [online, last revised on May 2012]. Available at (http://oami.europa.eu/ows/rw/resource/documents/OHIM/statistics/ssc007-statistics_of_community_designs_2011.pdf) [Accessed on May 2012].

OHIM (2012) *Current Fee Schedule* [online, last revised on May 2012]. The Office of Harmonization for the Internal Market. Available at (<http://oami.europa.eu/ows/rw/pages/RCD/FAQ/RCD3.en.do>) [Accessed on March 2013].

Reichman, J. (1983) ‘Design Protection in Domestic and Foreign Copyright Law: From the Berne Revision of 1948 to The Copyright Act of 1976’, *DUKE Law Journal*, Volume 1983, Issue 6, pp. 1143-64. Available at: (<http://scholarship.law.duke.edu/cgi/viewcontent.cgi?article=2862&context=dlj>) [Accessed on March 2013].

Reichman, J. (1992) ‘Design Protection and the Legislative Agenda’, *Law and Contemporary Problems*, Volume 55, Issue 2, pp. 281-296.

Saidman, P. (1989) ‘The Glass Slipper Approach to Protecting Industrial Designs or When the Shoe Fits, Wear It’, *University of Baltimore Law Review*, Volume 19, pp. 167-191.

Schlöteburg, M. and Folliard-Monguiral, A. (2003), *An overview of the Community design system* [online], Available at (<http://www.aippi.de/seiten/pdf/Folliard.PDF>) [Accessed on March 2013].

Schober, N. (2011) ‘The function of a shape as absolute ground for refusal’. *International Review of Intellectual Property and Competition Law*, Volume 44, Issue 1, pp. 35-62.

Suthersanen, U. (2010) *Design Law: European Union and United States of America*, 2nd edition. Sweet and Maxwell, London.

USPTO (2010) *Manual of Patent Examination Procedure*, 8th ed. 2001 (revised on 2010). IP Data Corporation Government Publications.

USPTO (2012) *Design Patent Application Guide* [online]. The United States Patent and Trademark Office. Available at (<http://www.uspto.gov/patents/resources/types/designapp.jsp#def>) [Accessed on March 2013].

USPTO (2012) *United States Patent and Trademark Office Fee Schedule* [online, last revised May 1, 2012]. The United States Patent and Trademark Office. Available at (<http://www.uspto.gov/web/offices/ac/qs/ope/fee092611.htm>) [Accessed on June 2012].

USPTO (2011) *Design Patents Report 2011* [online]. Available at (<http://www.uspto.gov/web/offices/ac/ido/oeip/taf/design.htm>) [Accessed March 2013].

WIPO (1994) *Protection Against Unfair Competition*, 1st edition. World Intellectual Property Organization, Geneva.