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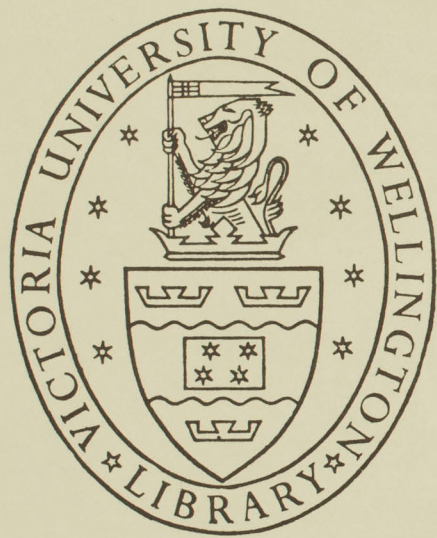
"Ceci N'est Pas Une Pipe": Copyright Protection For Industrial
Designs And The Copyright Amendment Act 1985.

Submitted for the LL.B (Honours) Degree at the
Victoria University of Wellington.

1 MCC McCLELLAND, T. P. "Ceci n'est pas une pipe."

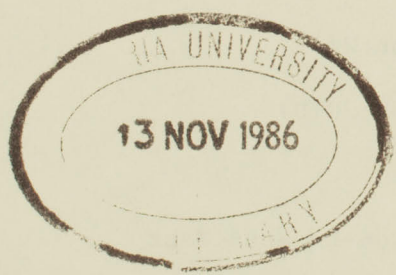
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I INTRODUCTION

In 1923 Charles-Edward Jeanneret, better known as Le Corbusier reproduced in Towards an Architecture, as an emblem of plain functional design - a pipe. Five years later, René Magritte painted his riposte to Corbusier's single level rationalism in "The Treason of Images" 1923-9. It was a painting of a pipe, captioned "Ceci n'est pas une pipe", "This is not a pipe".

In this phrase is condensed the two bases of this paper.

It is not a pipe in two ways, firstly and most obviously because it is a painting. In the same way as a drawing is not an exhaust pipe. A drawing then is not a design and yet industrial designs can receive copyright protection, although the copyright is in the design drawing, how does this arise?

Secondly it is not only a pipe but also an artistic work, it is functional but not purely so, it can be mass produced and yet still be art. It is an example of the modern view of design.

(i) The Law and Art

The law and art, the meeting of two complete opposites perhaps. Law, logical and verbal, art, emotional and spatial. Even our brains divide the two functions into separate hemispheres. Perhaps because the two are so different, this is why designs protection has caused so many problems.

When the United Kingdom Designs and Copyright Acts were first enacted it was against the background of what was known as the arts and crafts movement, which propounded the view that design should consist of ornament and elaboration, this has been reflected in the Designs Act.

It was not long however before all this changed with the arrival in 1919 of the Bauhaus Movement.

It did not try to fight the machine age but came to terms with it by creating designs for industry such as tubular steel chairs which could be mass produced without losing their elegance, without ceasing to be art.

The law is seventy years behind in its conception of design and the relation of art and craft.

New Zealand from being I submit one of the most progressive countries in some ways in this area, has now I believe taken a step back in some ways with the Copyright Amendment Act 1985.

II Copyright Protection for Industrial Designs

In New Zealand and the United Kingdom copyright law has developed over the years, both by accident and by design, from protecting works of fine art, paintings or drawings, to protecting industrial articles, from lavatory pan connectors ¹ to exhaust pipes. ²

This is possible under the Copyright Act 1962 due to the fact that copyright subsists in engineering diagrams and drawings which Section 2 of the Act makes clear are artistic works, "irrespective of artistic quality", and that the restricted act of reproduction is defined as including reproducing the work in three dimensions. ³

Actual copying of the article and not the drawings can in addition constitute indirect copying. ⁴

Due to the fact that copyright law protects industrial articles there is some degree of overlap between that which is protected under the Copyright Act and that which is protected under the Patents and Designs Acts. ⁵

There also existed an overlap in the terms of protection of the Designs and Copyright Acts, if the proprietor of a design invokes both simultaneously then copyright protection would continue after design protection had expired, this would occur after fifteen years whereas copyright protection continues for the lifetime of the author plus fifty years. ⁶

Another perhaps more major concern was that some industrial articles, excluded from protection under the Patents and Designs Acts could receive a much longer term of protection than under either of these Acts.

The Copyright Amendment Act 1985 has attempted to deal with some of these problems.

The aim of this paper is to consider whether it succeeds, and in doing so to determine that which the Copyright Act should be protecting in the field of industrial designs, and for how long this protection should last.

To do this it is first necessary to consider how the law has developed in this area and at how the present situation has arisen. We must therefore look first to the United Kingdom.

III The Copyright Act 1911 (U.K.)

The Copyright Act of 1911 was the first British statute to deal with copyright production comprehensively in one Act, the New Zealand Act of 1913 followed it in this respect. It was also the first attempt to avoid overlap and to make copyright and designs legislation separate in their scope.

It included a definition of artistic works, these were to be works of painting, drawing, sculpture and artistic craftsmanship.⁷ Copyright was defined as the sole right to produce or to reproduce the work or any substantial part thereof in any material form whatsoever⁸, it could therefore constitute a reproduction in material form to turn a two dimensional work into a three dimensional one.

The Copyright Act 1911 had the intention that art intended for industrial application should receive its protection under the Patents and Designs Act 1907 and not under copyright legislation.

The most important section of the Act as far as industrial designs are concerned was section 22(i) which was enacted as an attempt to avoid the possibility of dual protection, it read:

"This act shall not apply to designs capable of being registered under the Patents and Designs Act 1907, except designs which, though capable of being so registered are not used or intended to be used as models or patterns to be multiplied by any industrial process."

This provision appears in the Copyright Act (1913) NZ as Section 30(1).

Under Section 30(2) there was provision for regulations to be made under the design legislation to determine the conditions under which a design could be said, for the purposes of Section 30 (1) to be used as a model or pattern to be multiplied by any industrial process. The last regulation to be made was Regulation 78 of the Designs Regulations 1954 which provided that any designs of which more than fifty copies are intended to be made, and any designs to be applied to wallpapers, carpets, textiles and lace are deemed to be multiplied by an industrial process.

Section 30(1) therefore had the effect of allowing cumulative protection to exist in the United Kingdom. Whether the design came under the ambit of designs or copyright legislation would depend upon whether the design was intended to be applied industrially.

A design had to satisfy two main criteria if it was to receive protection under the Designs Act 1907.

The first of these was that it had to be either "novel or original" ⁸. This test appears to be harder to satisfy than that of originality under the Copyright Act, as it seems to involve at least some degree of newness, either in the design itself or in its application.

Secondly the design could not include "any mode or principle of construction".

Nor be "anything which is in substance a mere mechanical device".⁹

This was later changed to:

"designs composed of features of shape or configuration which are dictated solely by the function which the article to be made is that shape or configuration has to perform".¹⁰

If designs fell within this definition they were to be excluded from registration.

IV The Copyright Act 1956 (U.K.)

The Copyright Act 1956 (U.K.) attempted to prevent dual protection through a complex new section, section 10.

Under this section protection for industrial applications of a work could be lost in two ways.

The first way was if the design could have been registered, in which case monopoly protection under the Registered Designs Act 1949 would subsist for a maximum period of 15 years.

The second way was if the copyright owner put the design to industrial use, or authorised such use, then there would be no protection from infringement.

The result of this was that if the designer decided not to register the design and began to apply it industrially then he or she would be unable to prevent its being copied.

The major problem however that arises from Section 10 - and one which is really central to many of the problems in the area of copyright protection for industrial designs is that it is unclear as to how this section affects designs which could not be registered under the Designs Act, if for instance it was a design composed of features of shape or configuration dictated solely by function. Whereas the 1911 Act had applied only to designs which were "capable of being registered", Section 10 of the 1956 Act eschewed this phrase when dealing with designs that had not been registered before being applied industrially. It stated that:

"during the period of fifteen years from first marketing it shall not be an infringement of the copyright in the work to do anything which at the time it is done would have been within the scope of the copyright in the design, if the design had immediately before that time been registered in respect of all relevant articles."¹¹

After the 15 year period had expired another wider provision excluded copyright in respect of all industrial applications of the design.¹² Registration was to be assumed.

The question still remained however as to whether S 10 also applied to unregistrable designs.

(i) Interpretation of Section 10

One hint that Section 10 also applies to unregistered designs can be found in subsection 4 of that section.

This section provides that the limitation on artistic copyright contained in Section 10 shall not apply to certain articles of a primarily literary or artistic nature, the designs for which are excluded from registration by rules made under Section 1 (4) of the 1949 Act.

If in s 10 no reference was intended to those designs which could not be registered then what was the point of this section, it would surely be extraneous.

How Section 10 is to be interpreted is a vital question which lies at the heart of many of the problems which have arisen in this area. If subsections 10 (2) and (3) cover unregistrable designs then subject to section 10 (4) they have no copyright protection for industrial application falling within the scope of the Designs Act.

If Section 10 (2) does not affect unregistrable designs then they can obtain a far longer term of protection than those that are registrable, as it will be an infringement of copyright to copy the design up to fifty years from the death of its author.

As far as registrable designs are concerned their only protection for industrial application is through the registration system. This affords the wider protection of a complete monopoly, but for a much shorter period.

V Dorling v Honnor Marine Ltd 13

When this issue arose however in the case of Dorling v Honnor Marine Ltd Whitford J. accepted the latter interpretation with little discussion.

In this case the plaintiff was the designer of a new kind of sailing dinghy, known as a "Scorpion" which was sold in the form of a kit of parts, to be assembled by the purchaser.

The second defendant, Colonel Honnor who had a license from the plaintiff which had since expired, formed the first defendant company which continued to sell both completed Scorpions and kits of parts.

Dorling v Honnor Marine is an important case in this area as it was the first to demonstrate that the Copyright Act 1956 could apply to functional articles of no artistic merit.

This result followed from the court's interpretation of section 10 as only applying to registerable designs, and therefore where a design was not registerable under the Registered Designs Act it could receive protection under the Copyright Act.

This interpretation of section 10 was preferred because the court felt that the words "where the corresponding design is registered" in section 10(1) clearly implied that the corresponding design had to be registerable. It was said that

"To hold otherwise would be to deprive unregistrable designs which were exploited industrially of virtually any protection at all".

VI Amp Inc v Utilux Pty Ltd ¹⁴

The area of application of s10 was diminished further by the House of Lords' decision in Amp Inc v Utilux Pty Ltd.

This case considered the meaning of section 1 (3) of the Registered Designs Act which provides that the expression "design" shall mean features applied industrially to an article which "appeal to and are judged solely by the eye", and which "are not dictated solely by the function which the article has to perform".

The House of Lords decided in this case that even if the article could have been produced in more than one way and still have performed the same function it was not a registerable design if it did not in some way appeal to the eye of the customer (not the eye of the court).

On that reasoning the design in this case which was for an electrical terminal for a washing machine was held to be unregistrable as it did not appeal to the eye of the customer, who purchased it simply on the basis that it performed a specific function.

The effect of the decision in this case was that the class of designs which were unregistrable under the Designs Act and therefore outside of s10 of the Copyright Act, at least in the Dorling v Honnor interpretation of it as being purely functional was greatly enlarged.

(i) The 1968 Amendment

The Design Copyright Act 1968 amended s10 of the Copyright Act. It however did little apart from postponing the loss of artistic copyright, in the case of unregistered designs applied industrially for fifteen years from the date of commercialisation.

It was generally ^{thought} that the amendment to section 10 had had no effect, and that the decision in Dorling v Honnor still represented the law.

VII Hoover v Hulme 15

In the case of Hoover v Hulme, Whitford J. reappraised his decision in Dorling v Honnor Marine on the meaning of s10, and as to whether the Design Copyright Act 1968 had had any effect on it.

His decision places registrable and unregistrable designs on the same footing. The wording of s10 as amended by the Act of 1968 appeared to Whitford J. to present no difficulty "The section deals with the situation in which a corresponding design is applied industrially, it is not concerned with whether a design is or is not registrable".

Once the artistic copyright owner chose to apply a design industrially then the copyright in that design would be limited to a term of 15 years from the date of commercialisation. Whitford J. did however state "In case I should hereafter be held wrong on the question of term, I make a concession to the plaintiffs who had argued the conventional view by examining the drawing in respect of the items which fall outside the 15 year period and concluding that they should have infringed copyright if copyright were subsisting".

This interpretation of s10 was however overruled by the Court of Appeal in British Leyland Motor Corporation Ltd v Armstrong Patent Co Ltd and Armstrong. 16

VIII British Leyland v Armstrong ¹⁷

In the recent case of British Leyland Motor Corporation Ltd v Armstrong Patents Co Ltd the House of Lords had the opportunity to consider in detail the historical development of copyright protection for industrial designs.

In this case the respondents British Leyland, who were manufacturers of motor cars and spare parts, claimed that their copyright in blueprints for spare parts, namely exhaust pipes had been infringed by the appellants, Armstrong's reproduction of them in three dimensional form.

All of their Lordships recognised the manifest absurdity of conferring not merely on British Leyland's drawings as such, but in effect on the exhaust pipes themselves, which could never qualify for the protection of a registered design under the Act of 1949, the much more effective protection which the Act of 1956 gives to an artistic work, with its fifty year term, its criminal sanction and its threat to an infringer of liability for conviction damages.

Lord Bridge of Harwick also expressed the view that copyright protection for functional designs as extended to articles of functional utility manufactured in accordance with those designs would certainly be capable of abuse as a means of circumventing the many stringent conditions and safeguards to which patent protection is subject.

The majority however felt that they had to follow a line of authority which stretched more than twenty years from Dorling v Honnor, and which had had a profound impact on many aspects of industrial practice.

It was felt that any change in the law should be left for Parliament to make.

Lord Griffiths however in a dissenting judgment felt that the concept of indirect copying had never been intended for the situation where a defendant has not copied the copyright work itself i.e. the drawings, but a reproduction of it in the form of a product, usually with no knowledge of the drawing at all.

He could find nowhere in the cases which had established this view of indirect copying any consideration given to the reasons why indirect

copying was originally introduced by the judges to extend the natural meaning of reproduce or copy at whatever such reasons justify the extended meaning where the mechanical drawing is of a functional object and its only purpose is to provide an instruction for the production of the object.

IX The Australian Position

The provisions in the Australian Copyright Act dealing with the limitation of copyright protection when an artistic work is industrially applied were very similar to the provisions of the United Kingdom Act of 1911, until 1968.

In 1968 a new Australian Copyright Act brought Australian Copyright Law into line with the British Act of 1956 on the recommendation of the Spicer Committee.¹⁸ In the same year in the United Kingdom the Design Copyright Act 1968 was enacted, amending Section 10 of the 1956 Act by postponing the loss of copyright for industrially applied designs for a period of 15 years.

Australia was therefore left with the least liberal view as to copyright protection for industrial designs, ordinary copyright was wholly lost if the design had been industrialised and could not have been registered under the Designs Act. In the United Kingdom the loss of Copyright Protection was postponed for fifteen years and in New Zealand it continued for the full copyright period.

(i) The Designs Amendment Act 1981

In 1981 the Australian Law relating to designs was subjected to major amendment. The Amendment Act's aim was to give effect to the recommendations of the Franki Committee Report.¹⁹

In its report the Franki Committee considered the question of protection for purely functional designs. The case of Amp v Utilux was considered, and the committee decided that very few examples, if any, would fall within the exception as interpreted by Graham J. This was that if

the shape is not to appeal to the eye, but solely to make the article work, or to perform functional requirements, no design within the definition existed.

The Committee added that

"We feel that protection should be available on as broad a basis as practicable, and provided that the ordinary requirements of the community and industry are not unreasonably impeded, we can see no real reason why all features of shape or configuration, whether they serve a purely functional purpose or not, should not come within the definition of design." ²⁰

To achieve this aim the committee recommended that the following provision be enacted, which now appears in substantially the same form in a new section 18.

"An application for registration of a design shall not be refused, and a registered design is not invalid by reason only that the design consists of or includes, features of shape or configuration that serve or serve only a functional purpose."

In the Dorling v Honnour Marine interpretation of section 10 (1) of the U.K. Act 1956 (Section 77 of the Australian Act 1968) is to be adopted in Australia, there being no authority on the question, and Section 77 does not apply where a corresponding design could not be registered, because it was not within the definition of a design under the Designs Act, then the 1981 Amendments to that Act are of great importance.

If purely functional designs are now encompassed by the Designs Act then Section 77 of the Copyright Act will apply and they will lose all copyright protection on industrial application.

X The New Zealand Position

Up until the Copyright Act of 1962 New Zealand had by s30 of the 1913 Act followed the United Kingdom in its attempt to make the Copyright and Designs Act mutually exclusive but in 1959 the Dalglish Committee ²¹ recommended that s30 of the 1913 Copyright Act be repealed thus allowing overlap between copyright and designs legislation and also with patent legislation.

The Dalglish Committee's aims were admirable in that the main purpose of the repeal was that all artistic works should be protected equally by copyright legislation, including industrial designs. This was in response to submissions by the Justice Department, the English Pottery and Glassware

Agents Association of New Zealand and the UK Manufacturers and New Zealand representatives Associations.

It criticised the situation where, trade circulars, timetables or advertising posters are automatically protected by the Copyright Act, whereas designs for application to fabrics, china, or glassware are denied this protection however high their artistic quality.

It was argued that the term of copyright protection is too long for industrial designs which are in general ephemeral in nature, but this was met by the reply that there are many works through the whole field of copyright which have an ephemeral existence, but that this is of no significance in regard to the acquisition of copyright in such works.

The Pottery and Glassware Association claimed that it was financially and economically impossible for a pottery manufacturer using industrial art in the manufacture of his goods to register all the designs that were produced. For example manufacturers of ceramics in the Midlands produced 10,000 of designs each year.

(i) P.S. Johnson & Associates Limited v Bucho Enterprises Ltd & Others ²²

This was a landmark case in New Zealand. It was the first New Zealand case to show that the Copyright Act 1962 extended to the functional articles.

It was an action concerning infringement of Copyright in a product drawing commissioned by the plaintiffs, from which a mould was made for the production of lavatory pan connectors.

Chilwell J. held that the defendant's manufacture and sale of their lavatory pan connectors infringed the plaintiff's copyright in their design drawings.

A product drawing was within the definition of "artistic work" in s 2(1) of the Copyright Act 1962 and as it was not required to be of artistic quality copyright could subsist therein.

The defendants had committed a restricted act in reproducing the work in material form s 7(4)a of the Act, "Reproduction" being defined

in s2(1) as including in the case of an artistic work:

"....a version produced by converting the work into a three dimensional form....."

XI The Copyright Amendment Act 1985

The first problem which the Copyright Amendment Act has attempted to deal with is the fact that New Zealand law provides full copyright protection after the expiry of design and patent registration. Why was this thought to be an undesirable situation.?

It is firstly generally thought that the period fifteen years is about right for the protection of industrial property. An important justification for the patent system is that it is in the public interest that methods of production are constantly being improved upon. To encourage improvement, and to make the knowledge available to the public the person who makes the invention should be given a monopoly or its use for 16 years after registering it at the Patent Office. After 16 years the knowledge given by the patentee in exchange for the monopoly will fall into the public domain, and the temporary monopoly is justified in that without the inventor the new improvement would not exist, no one would know about it and no one would have been able to use it at that or at any other time. As the information given by the patentee in exchange for his or her monopoly will not fall into the public domain for an enormously long period under Copyright Law, its usefulness is greatly diminished. In addition a long period of protection would not be in the public interest as the owner of copyright can reap the large financial rewards of monopoly pricing for a far longer period than is necessary to cover development costs.

(i) Section 20 (A)

The Copyright Amendment Act has sought to limit copyright protection in designs applied industrially. The Act seeks to achieve this in two ways, the first is by a new Section 20A which reads:

The making of any object in three dimensions (including a reproduction

in two dimensions reasonably required for the making of the object) does not infringe the copyright in a literary or an artistic work, if the work or a reproduction thereof forms part of -

(a) a patent specification which

(i) is open to public inspection in the New Zealand office in respect of a New Zealand patent which has ceased to exist; and

(ii) is used for the purpose of making the object or

(b) a representation or specimen of a design which

(i) is open to public inspection in the New Zealand Patent Office in respect of a design for which registered protection in New Zealand has ceased: and

(ii) is used for the purpose of making the object.

The plain effect of this section is that material which has been published in New Zealand in patent specifications and design representations and for which the term of protection has expired will no longer receive protection under the Copyright Act. Therefore if someone has produced an object in three dimensions with the help of a patent specification or design representation which has expired no suit will be able to be brought under New Zealand Law. Section 20 (A) comes into force at the commencement of the Copyright Act 1962 and thus applies to those patents and designs for which patent or design protection has expired today.

(ii) Section 20(B)

The Section 20(A) Amendment only solves the problem of artistic works which are registered as part of a design representation or patent specification. It did not deal with unregistered works or more importantly the question of works which are unregistrable under either act, for example if the work was not sufficiently inventive to form part of

a patent specification and was purely functional and so could not receive protection under the Designs Act.

A new section Section 20(B) has attempted to deal with these artistic works, it reads:

- (1) The making of any object in 3 dimensions (including a reproduction in two dimensions reasonably required for the making of the object) does not infringe the copyright in an artistic work, if, when the object or reproduction is made, the artistic work has been lawfully applied industrially in New Zealand or in any other country more than 16 years before the object or reproduction is made.

As to the definition of the term "applied industrially" the legislators had two options, they could either have adopted the provision in Regulation 78 of the Designs Regulations 1954 (which is incorporated in clause 3 of the second schedule to the Copyright Act 1962) or instead to adopt the wording of Regulation 17 of the Australian Copyright Regulations which has a similar effect, the latter course was followed. An artistic work is now deemed to be applied industrially if, Section 20(B) Subsection 2(a) more than 50 reproductions in three dimensions are made of it, for the purposes of sale or hire; or

- (b) it is reproduced in 3 dimensions in one or more articles manufactured in lengths for the purposes of sale or hire; or
- (c) it is reproduced as a plate which has been used to produce (a) and (b).

This section came into force on 1 October 1986.

(iii) Marking

One problem which still remained however with giving automatic copyright protection to the appearance of industrial designs is that it leads to uncertainty for other manufacturers. As there is no requirements for deposit of a design, which would only lead to an increase in costs

and in some trades would be impractical, a manufacturer is not in a position to know whether an article which he or she wishes to utilise is making his or her own product has copyright protection. If for example he or she does not know whether design drawings exist or not. The manufacturer will not wish to invest large sums of money to develop a new product if he or she does not know whether the article is protected.

One method of partially remedying this problem is not to allow damages to be recoverable in respect of an infringement committed, unless notice of the copyright claim has been given by way of marking on the article or on its packaging or accompanying literature. Marking is not compulsory under the Copyright Act and to make it so could probably be inconsistent with New Zealand's obligations under the Berne Convention. Article 5(2) of the Berne convention states that:

"...the enjoyment and the exercise of rights [claimed by virtue of the convention] shall not be subject to any formality".

However the Copyright Amendment Act encourages marking by the insertion of Section 27(A) to the principal act. It provides a rebuttable presumption that the defendant had knowledge that copyright existed in the artistic work, that the person named on the label or mark as the owner of copyright was the owner of the copyright and that the reproduction was first made available to the public in the year specified on the label or mark. The form of marking which is required for this presumption to come into effect is marking with the symbol "©" together with the name of the owner of the copyright in the artistic work, and any person who holds an exclusive license granted by the owner of that copyright to make that reproduction, and the year the reproduction was first made available.

IV The "Non-Expert" Test

The Copyright Amendment Act 1985 repeals Section 20(8) of the Copyright Act 1962, which was derived from Section 9(8) of the Copyright Act 1956

(U.K.).

Under the 1962 Act any question of infringement which involved the comparison of an artistic work in two dimensions with an alleged infringement in three dimensions had to be considered in relation to Section 20(8) of the Act.

Section 9(8) of the U.K. Act had been an attempt to give effect to the recommendations of the Gregory Committee's Report ²³, which was established by the United Kingdom Government to consider Copyright Law as a precursor to the 1956 Act.

The Committee had been concerned about the possible repercussions at the "Popeye Case" ²⁴, which was the first case to show that a three dimensional reproduction could infringe copyright in a two dimensional work, after Parliament by the Copyright Act 1911 (U.K.) had provided that copyright could be infringed by reproduction in any material form.

In this case the House of Lords held that copyright in a drawing of a fictitious cartoon character known as "Popeye the Sailor" had been infringed by the defendant who without the license of the author of the cartoon reproduced Popeye toys and broaches.

The reproduction of the drawing in the three dimensional form of broaches and dolls appropriated the creativity, skill and labour of the artist, those things which copyright law is meant to protect.

Indirect copying, copying of the three dimensional work and not the drawings can be said to infringe copyright in the drawings, as that which is taken is still the creative skill of the artist.

However this case has been used as authority for saying that copying of a purely functional article can infringe the copyright in design drawings, whose shape owes nothing to the creative skill of the draughtsman but owes everything to the skill and labour of the inventor.

The Gregory Committee was concerned that this might happen.

In paragraph 258 the report considered the possible repercussions of the Popeye case.

"....we consider that a limitation (additional to any imposed according to our recommendations in respect of section 22) is desirable in the protection to be given to a drawing by reason of its reproduction as a building, machine or utilitarian article; otherwise the scope of the Copyright Act would again be extended into fields far beyond its main or original intent and properly to be covered by other forms of protection if at all. We have noted that in the case of industrial designs registered under the Registered Designs Act 1949, the protection is limited to "features of shape, configuration, pattern or ornament applied to an article by any industrial process or means, being features which in the finished article appeal to and are judged solely by the eye, but does not include a method or principle of construction, or features of shape or configuration which are dictated solely by the function which the article to be made in that shape or configuration has to perform" (Section 1(3)). It should not be possible to protect under the Copyright Act more in the constructional or functional field than is protectable under the Registered Designs Act....".

Unfortunately the provisions of Section 9(8) of the Copyright Act 1956 (U.K.), Section 20(8) N.Z. were not sufficient to carry out the intention of the Gregory Report, that it should not be possible to protect under the Copyright Act more in the constructional or functional field than was protectable under the Designs Act. The section read:

"The making of an object of any description which is in three dimensions shall not be taken to infringe the copyright in an artistic work in two dimensions if the object would not appear to persons who are not experts in relation to object of that description to be a reproduction of the artistic work."

The test was a negative one, this means that the point was not whether a non-expert would regard the object as a reproduction of the drawing but whether the object would not appear to him or her to be a reproduction of the drawing. I would however submit that there is little if any difference in outcome from the two types of test.

The test did not arise until there was an affirmative finding of copying, and the court should not have repeated the process which led up to that finding. 25

The defence gave rise to difficulty as to the nature of evidence which could be received and as to the degree of non-expertise of the judge.

As to the question of what type of evidence could be received one answer was given in the case of Lerose Ltd v Howick Jersey International Ltd 26. Evidence was allowed to be admitted from a national non-expert in relation

to the/^{res}litigiosa i.e. the hypothetical "man on the Clapham omnibus".

It was thought that evidence from national non-experts could be desirable in cases where the judge could not put himself in the position of a non-expert due to the fact he may have possessed some expertise in relation to the articles. For example in Dorling v Honnour Marine the subject matter of litigation was a full scale boat known as a "Scorpion". The judge in that case did in fact possess some experience in building model boats, so the question arose as to whether he was a qualified "non-expert" for the purposes of the section. Evidence from a national non-expert was not however called, although the court felt that the assistance of a jury might have been helpful.

The idea that evidence may be brought from a national non-expert could however have led to the bizarre situation in some cases, where witnesses could be called for both sides, stating that they had no experience or knowledge of the subject in question and going on to state whether it did or did not appear to them that the three dimensional object was a reproduction of the two dimensional work.

The test had to be repealed, due to the fact that it caused so many difficulties, and yet in its aim, that of not allowing protection for purely functional designs it had been a movement in the right direction.

Models

An indication that Parliament did not intend to bestow upon a manufacturer through the draftsman in his drawing office protection for a purely functional object comes from the fact that if a designer originates his or her work in a mechanical drawing then he or she will have a monopoly on that shape but if a designer originates his or her work in the form of a three dimensional prototype then there could be no protection.

The framers of the Copyright Amendment Act saw this anomaly as a reason for allowing articles originating from three dimensional prototypes to receive copyright protection. 27

The Amendment Act achieves this by adding the term "models" to the five categories of artistic work defined in Section 2(1) of the principal act. These could be artistic works irrespective of artistic quality they are, paintings, sculptures, drawings, engravings and photographs. 5 ?

The category of models has also been added to the same group under S9(3) of the principal act which is concerned with ownership of copyright in artistic works.

Before the Amendment Act and the addition of the class of models, a designer who originated his or her work as a three dimensional prototype had one possible means of achieving copyright protection and that was if the design could be classed as a sculpture, it would then not need to be of any artistic merit if it was it would receive protection automatically.

The Court of Appeal in Whamo Co v Lincoln Industries Ltd 28 held that wooden models for frisbees were in fact sculptures.

XII Review and Conclusion

The amendments made to the Copyright Act 1962 were "intended to overcome certain defects in the present law on an interim basis until such time as a comprehensive study is indicated as to the appropriate protection to be accorded to industrial design" 29. It has succeeded in that aim.

By Section 20A it is now no longer an infringement of copyright to produce a three dimensional reproduction of an artistic work which forms part of a patent specification or design representation.

This for the reasons already given and also the fact that the view of Whitford J. in Catric Components v Hill and Smith Ltd 30, that there would be an implied license to produce the product without infringing the copyright, after Patent and Design protection has ended has been rejected by the High Court in Whamo Manufacturing v Lincoln Industries.

Making conversion damages only available where the court considers that ordinary damages would be an insufficient remedy 31 was also necessary, as their extension to industrial designs makes them excessively punitive.

I however submit that the Amendment Act has some flaws.

I respectfully submit that one of the major flaws inherent in the Amendment Act is that it makes a distinction between industrial designs and "Artistic Works". This distinction is both outdated and unfounded.

As I have mentioned in the introduction to this paper it has been seventy years since industrial design was recognised as an art form by the Banhaus Movement, founded by the leading expressionists - Klee and Kandinsky.

A first rate teapot has more artistic merit than a second rate painting. The old objection to copyright protection for industrial designs - that copyright law is placing a Picasso on the same level as a chair is unfounded, as there are mundane designs there are poor paintings, as there are great paintings there are great designs, the Metropolitan Museum of Modern Art has recognised that there are great designs in its design collection.

An article does not cease to be a work of art because it is reproduced, especially as in the case of industrial designs the first is exactly the same as the last article produced. Yet the new section 20(B) enshrines this view by choosing the arbitrary figure of 50 as signifying industrial application and then cutting the terms of copyright protection down to 16 years from that application.

The argument which is also given for distinguishing between industrial designs and other works is that once reproduced in three dimensions more than fifty times the work passes into a different realm, away from protecting and encouraging the creativity of the author to giving large profits to the manufacturer, yet why should industrial applications of artistic works be any different in this respect from their reproduction in books or prints?

I therefore respectfully submit that there should be no distinction between industrial designs and artistic works. I nevertheless believe that the reduction in the protection period for artistic works applied industrially is desirable, not because there should be any distinction between industrial designs and artistic works, but rather because I believe that the period of protection of the life of the author and fifty years is too long across the board, it is unfortunately however beyond the scope of this paper to

go into this question.

Another area where I believe the Copyright Amendment Act is unsatisfactory is in the area of purely functional designs. These, along with all other artistic works applied industrially can still be protected for 16 years. Although the anomaly that an article which cannot be patented, cannot be registered and is not an artistic work acquires a greater term of protection than those designs which can be registered or patented is eliminated, I respectfully submit that purely functional designs should receive no protection at all, at least under Copyright Law.

The Franki Committee felt that few if any designs are purely functional, yet the vast area of spare parts and expendible accessories that have to fit an apparatus to fulfil their function must surely come within this definition, as British Leyland has demonstrated.

The Patents Act 1953 gives a monopoly to new inventions. All monopolies are undesirable but here the monopoly is necessary for the improvement of industrial techniques and their disclosure. After the 16 year monopoly period has expired it passes into the public domain.

Designs that are purely functional and are not sufficiently inventive to get protection under the Patents Act cannot contribute to an improvement in industrial techniques, at least the Patents Act decrees that they will not by not giving them protection.

Yet under the Copyright Act these designs can achieve as good a protection as a Patent. This occurs due to the fact that the scope for making a fitting part without copying the original is limited by difficulty and cost. The Copyright Act then protects an idea and not its expression.

It is appropriate here to refer again to the words of the Gregory Committee on this point. Copyright protection for purely functional designs would extend copyright into "...field far beyond its main or original intent..." and that "...it should not be possible to protect under the Copyright Act more in the constructional or functional field than is protectable under the Registered Designs Act...". 32

In the United Kingdom, a recent green paper ³³ released by the Government is of the same view, in paragraph 13 it starts:

"More broadly however the Government does not believe that industrial progress will be helped if almost any industrial product is protected against copying. The Government thinks that if an industrial society is to be active and competitive there must be a substantial common pool of experience from which all can freely take. The spectacle of all functional elements being protected carries with it a threat of stagnation of industrial development or at best of a substantial waste of time and money in changing perfectly satisfactory designs for no other reason than to avoid legal consequences."

I would therefore recommend that when a comprehensive study is undertaken as to the appropriate protection to be accorded to industrial design it should:

- (1) provide under the Copyright Act equal protection to industrial designs and the traditional means of exploiting copyright protection - books, paintings and drawings.
- (2) provide no protection to purely functional designs, if these designs need protection then it should be under some form of utility model or petty patent system, with appropriate requirements as to qualification for protection and with an appropriate term.

FOOTNOTES

1. Johnson (PS) v Bucko Enterprises Ltd [1975] 1 N.Z.L.R. 311.
2. British Leyland Motor Coproration Ltd v Armstrong Patents Co Ltd and Another (1985) 31.P.R.32.
3. S.2(1).
4. British Northrop Ltd v Texteam Blackburn Ltd. [1974] R.P.C.57.
5. Patents Act 1953, Designs Act 1953.
6. Copyright Act 1962, s(8).
7. S.35.(1).
8. S.1(2).
9. S.19 Patents and Designs Act 1919.
10. S.1(3) Registered Designs Act 1949.
11. S.10,ss3(a).
12. S.10,ss3(b).
13. [1965] Ch 1 (C.A.).
14. [1972] R.P.C. 103.
15. [1982] F.S.R. 565.
16. [1985] 3I.P.R. 32.
17. [1986] 2 W.L.R. 400 (H.L.).
18. Report of the Committee appointed by the Attourney General of the Commonwealth of Australia to consider what alterations are desirable to the Copyright Law of the Commonwealth. (22 December 1959). Government Printer Canberra, 1965.
19. Designs Law Review Committee, Report on the law relating to designs; Parliamentary Paper Nol of 1973.
20. Para. 45.
21. Dalglish Copyright Committee Report, App. J.H.R. 1959, H 46, 113-118.
22. [1975] 1 N.Z.L.R. 311.
23. Report of the Copyright Committee (1952) (Cmd. 8662).
24. King Features Syndicate Inc. v O. and M. Kleeman, Ltd. [1941] A.C. 417.
25. L.B. Plastics v Swish Products ltd. [1979] R.P.C. 174.

26. [1974] R.P.C.42.
27. I.P.A.C. Recommendations to the Minister of Justice: The Law of Copyright as it applies in New Zealand to industrial designs.
28. [1984] 1 N.Z.L.R. 641. (C.A.)
29. Supra.N.27.
30. [1978] F.S.R. 405.
31. S.24.ss(sA) Copyright Act 1962.
32. Para. 258.
33. Reform of the law relating to Copyright, Designs, and Performer's Protection 'A Consultative Document, Cmnd. 8302 (1981), 8 ("The Green Paper").

1 McClelland, Thomas
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