

15 A Delimitation of Design Protection and Copyright

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The proposed paper aims to contribute to solving the question whether industrially designed articles can be protected by copyright. It undertakes to outline the principles for protection of such industrially designed articles in Germany and under the present Japanese legislation. The focus of the presentation lies on protection based on previous and new German Design legislation in comparison with the current discussion about Design protection in Japan.

I Current situation in Germany and Europe

The starting point of the proposed analysis is the current legislation in Germany and Europe, respectively. It shall be determined under which conditions industrially designed articles can enjoy copyright protection. The decisive question is thus whether such designs can be acknowledged as a product which can be protected by copyright or whether they rather fall within the scope of mere design patents. The main objective of this research project, therefore, is to give an outline of the protection of designs and models in Germany under the former Design Act in comparison with the new implemented Design Act of June 2004. The differences and following consequences shall be identified and presented in detail.

II Current Situation in Japan

Furthermore, the current legislation in Japan is to be analyzed. In Japan, there are also different understandings of how to protect industrially designed articles. According to the Japanese Copyright Act, artistic works are protected (Sec. 2 (2) Japanese Copyright Act). Therefore protection of industrially designed articles is possible under the Japanese Copyright Act as well as their protection under the Design Act of April 13, 1959. According to the original intention of the legislation, copyright protection should only be available for aesthetically designed individual pieces of works of fine art, whereas protection of products manufactured in series should be reserved to design protection. However, this view is not generally taken by the courts, which will be revealed in the proposed essay in detail.

I Introduction

The design has become, due to its growing importance, irrevocably interwoven with the today's consumer's daily life. Apart from being the most important means of expression for manufactured products, the design also plays a vital role as marketing factor.^(*) Hardly any product can nowadays be (successfully) marketed without a special design, i.e. an external form perceivable by the consumer.^(*)

The present essay aims at providing an

overview of the current situation of design protection in Germany as well as a comparison thereof with the legal situation in Japan by way of referring to the excellent articles already available to the public.^(*)

II Current Situation in Germany and Europe

On June 1, 2004, the new Design Act was introduced in Germany. This Act does not only represent the implementation of a Directive of

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(*) See Ritscher, Auf dem Wege zu einem europäischen Musterrecht, GRUR Int. 1990, p. 559. For further details see also Lorenzen, Designschutz im europäischen und internationalen Recht, p. 48 et seq.

(*) For details about the development of designs as a marketing factor see Eck, Neue Wege zum Schutz der Formgebung, p. 5 et seq. In particular as regards products, which differ from a technical point of view hardly from manufacturer to manufacturer, changes in the external appearance offer an interesting opportunity to manufacturers to distinguish the own product from those of the competitors. Apple PC, iPods and Bang & Olufson should be mentioned.

(*) Pentheroudakis, Die Umsetzung der Richtlinie 98/71/EG über den rechtlichen Schutz von Mustern und Modellen in den EU Mitgliedstaaten, GRUR Int. 2002, p. 668-686 and Liu, Hisao-Chien, Copyrightability of Functional Designs, Intellectual Property Law and Policy Journal Vol. 6, March 2005, p. 211-215.

the European Parliament and Council on the legal protection of designs and models (Design Directive)^(*)4), but fundamentally reforms the old Design Act.^(*)5) Particular relevance in this context has also the Regulation on the European Community Design.^(*)6) Based on the Community Trade Mark, this regulation has created uniform rules for a European Community Design, aiming at as much harmonisation of the legal situation as possible regarding European trademark protection.

1 Design Protection according to the old Design Act (GeschmMG a.F.)

(1) Background of the old Design Act

The old Design Act, which has been in force in Germany until last year, was generally regarded as industrial property law on a copyright basis.^(*)7) Starting point for the evaluation of protectability was thus the so-called „copyright approach“. Subject of protection of the original Design Act was according to the regulation of the copyright law any intellectually aesthetic form, which was according to Sec. 1 (1) of the old Design Act, however, restricted to industrially utilisable designs and models.^(*)8) A product was supposed to be industrially utilisable, if it could be produced or used in any industrial field, whereby the mere suitability of the design or model as template for an industrial product was sufficient.^(*)9) A design could then be enforced through correct application and registration at the German Patent and Trademark Office (Berlin), as long as the material prerequisites for protection were fulfilled.^(*)10)

These material prerequisites for protection of old Design Act were “*Neuheit*” (novelty) and “*Eigentümlichkeit*” (originality) of the product for which protection was sought.^(*)11) Both features had to be examined separately and generally independently of each other. Regarding the novelty of a design, the German Federal Supreme Court started from a relative-objective understanding of novelty, according to which a design was only then to be considered as new, if the design elements establishing the product’s individual character were neither known to persons skilled in the art at the time of application, nor could have been known to them under consideration of designs of relevant or neighbouring industrial fields.^(*)12) The feature of originality according to Sec. 1 (2) of the old Design Act was fulfilled in the case, when – apart from the personal creation of the manufacturer – also a particular aesthetic content was innate to the work in comparison to other products; merely a straightforward delimitability was, however, not sufficient.^(*)13) The required creative content of a design was to be objectively identified under consideration of the prior aesthetic development within the entirety of a certain field, as well as in connection with other available free forms.^(*)14) At which point the threshold to originality worthy of design patent protection was crossed, was, however, problematic and in many cases debated.

As a result, the originality to be determined was many times put on a par with the “*Schöpferische Eigentümlichkeit des Urhebers*” (creative singularity of the copyright), which required according to Sec. 2 (2) of the copyright law of 1965 a “*persönliche geistige Schöpfung*”

(*)4) Directive 98/71/EC of October 13, 1998; OJL 289/28 of October 1998 (hereinafter Design Directive); Richtlinie 98/71/EG des Europäischen Parlamentes und des Rates vom 13.10.1998 über den rechtlichen Schutz von Mustern und Modellen, ABl. L 289/28.

(*)5) Wandtke/Ost, Zur Reform des deutschen Geschmacksmustergesetzes, GRUR Int. 2005, p. 91 et seq.

(*)6) Council Regulation 6/2002 of December 12, 2001, OJ L 3/1 of January 5, 2002 (hereinafter Design Regulation), in force since March 6, 2002; Verordnung des Rates (EG) vom 12.12.2001, ABIEG Nr. L 3/1 v. 5.1.2002.

(*)7) Von Gamm, Die Problematik der Gestaltungshöhe im deutschen Urheberrecht, p. 110.

(*)8) See von Gamm, Die Problematik der Gestaltungshöhe im deutschen Urheberrecht, p. 110; for details see also von Gamm, Sec. 1 Geschmacksmustergesetz par. 26; Nirk/Kurze, Geschmacksmustergesetz, Einführung par. 38.

(*)9) See Eichmann/von Falckenstein, Sec. 1 Geschmacksmustergesetz (Second edition 1997) par. 8; von Gamm, Sec. 1 Geschmacksmustergesetz par. 17.

(*)10) Only the formal prerequisites had to be registered by the registration office, see von Gamm, Die Problematik der Gestaltungshöhe im deutschen Urheberrecht, p. 111.

(*)11) Katzenberger, Protection of Industrial Designs in Germany, IIC 1975, p. 304 (307).

(*)12) BGH (German Supreme Court), May 8, 1968, GRUR 1969, p. 90 „Rüschenhaube“. Novelty of the aesthetic creation in view of its combination was sufficient. See also BGH (German Supreme Court), May 20, 1974, GRUR 1975, p. 81 (83) „Dreifachkombinationsschalter“.

(*)13) Koschtial, Die Einordnung des Designschutzes in das Geschmacksmuster-, Urheber-, Marken- und Patentrecht, p. 273. The design was considered to be original, if it could be seen as a result of a creative work, which exceeded the work average designer, BGH (German Supreme Court), May 8, 1968, GRUR 1969, p. 90 (95) „Rüschenhaube“; see also von Gamm, Die Problematik der Gestaltungshöhe im deutschen Urheberrecht, p. 112.

(*)14) Von Gamm, Die Problematik der Gestaltungshöhe im deutschen Urheberrecht, p. 112.

(personal intellectual creation), wherefrom both literature and jurisdiction concluded, that no factual difference existed between design law and copyright law, but rather only a gradual one.^(*15) This particular delimitation of design law and copyright law was therefore to become one of the most debated and discussed topics of the old Design Act.

(2) Delimitation of Design Law and Copyright Law

Both the old Design Act and the copyright law required – from a *qualitative* point of view – a "*persönliche geistige Schöpfung*" (individual intellectual creation); the difference in obtaining the respective protective right was simply the *degree* of the actual creative achievement, which had to be reached in either case. According to the former legal situation, both protective rights differed thus only in a quantitative way.^(*16) A strict border between the protection of art and design, distinguished only by terminological features, could therefore not be drawn. Rather, the difference was by degree.^(*17) The literature has based this argumentation on the explicit regulation in the copyright law, stating that also a design product was capable of protection according to Sec. 2 (2) No. 4 "*Urheberrechtsgesetz*" Copyright Act as a potential work of the applied arts and as such as a subgroup of the works of the fine arts.^(*18) The Design Act was thus, according to the understanding of the literature, a kind of subdivision of the protection of works of the fine arts.^(*19)

Also the jurisdiction attempted to delimit the old Design Act and the copyright law according to the degree of personal creative achievement. In doing so, the Federal Supreme Court^(*20) developed three different steps to determine the delimitation of design law and copyright law. Accordingly, the skills of an average designer,

which represents mere craftsmanship, were considered to lie outside protectability. To qualify as a true design, a certain degree of creative achievement going beyond the mere skills of a craftsman was considered to be necessary, which, however, should be considerably distinguished from the aforementioned simple craftsmanship. Copyright protectability, finally, could only be granted when the product showed an even greater distinction therefrom. This latter degree required that the product excelled significantly in creativeness in comparison to the average design and showed a distinguishing character, "*individuelle Geistestätigkeit*" (individual intellectual activity) and a considerable "*ästhetischer Überschuss*" (aesthetic surplus) going beyond the mere purposive form.^(*21)

Also in its more recent decisions, the Federal Court of Justice insisted on these strict criteria for works of the applied arts. Accordingly, for each design it had to be examined and decided, whether the product should be attributed to the applied arts or be considered a work of the purpose-free fine arts, since different criteria had to be applied for each kind of work.^(*22) Although the understanding of the term "work" was similar in each case according to Sec. 2 (2) Copyright Act (*einheitlicher Werkbegriff*), the requirements for the degree of creativity could differ. For works of the applied arts, higher standards have always been stipulated.^(*23) Since, when delimiting design law and copyright law, one does not focus on the *essence* of the work but on the *varying degrees of creativity*, and a design worthy of design protection already has to distinguish itself in this manner from the unprotected average design, an even more prominent creative distinction could be postulated when considering to grant copyright protectability.^(*24)

In practice, the jurisdiction thus differentiated, depending on the form of the work, between

(*15) Von Gamm, Sec. 1 Geschmacksmustergesetz par.56.

(*16) See Lorenzen, Designschutz im europäischen und internationalen Recht, p. 226.

(*17) Eichmann/von Falckenstein, Geschmacksmustergesetz (Second edition 1997), Allgemeines par.19.

(*18) For further details see Koschtial, Zur Notwendigkeit der Absenkung der Gestaltungshöhe für Werke der angewandten Kunst, GRUR 2004, p. 555 et seq.

(*19) Schricker/Loenwenheim, Sec. 2 Urheberrechtsgesetz par.157. Protection under the Design Act was somehow seen as „little brother“ compared to protection under the Copyright Act.

(*20) See BGH (German Supreme Court), January 22, 1952, BGH GRUR 1952, p. 516 „Hummelfiguren“ und BGH (German Supreme Court), May 30, 1958, BGH GRUR 1958, p. 526 „Candida-Schrift“.

(*21) BGH (German Supreme Court), February 12, 1985, BGH GRUR 1985, p. 289 „Tonfiguren“.

(*22) See BGH (German Supreme Court), June 22, 1995, BGH GRUR 1995, p. 581 „Silberdistel“. For delimitation between works of applied arts and works of the fine arts the Federal Supreme Court decided between works for intended use and purpose free works.

(*23) BGH (German Supreme Court), June 22, 1995, BGH GRUR 1995, p. 581 „Silberdistel“.

(*24) BGH (German Supreme Court), June 22, 1995, BGH GRUR 1995, p. 581 „Silberdistel“.

varying requirements for each aesthetic form. Whilst in the field of musical and literary works as well as pure, non-purposive art the simple form, which was just within the limits of worthiness of protection, was accepted as the so-called “*Kleine Münze*” (small coin), higher standards were to be applied for works of the applied arts. Whether this point of view was capable of being combined with the uniform understanding of “work” (*einheitlicher Werkbegriff*) set out in the German copyright law, and whether such a differentiation regarding the requirements of the design level could actually be justified, has been one of the most debated topics in the German design protection in the recent years.

2 Design Protection according to the new Design Act

The difficulties and controversies shown above regarding the delimitation of design and copyright protection seem at first glance to have been remedied by the introduction of the new Design Act, in force in Germany since June 1, 2004. In the course of its reform, the Design Act was not only revised, but also fundamentally changed from a systematic point of view.

(1) Background of the new Design Act

Basis for the new Design Act (*Geschmacksmustergesetz, GeschmMG*) was not only the European legislation on the design law. Starting point for a harmonisation in the field of the protection of forms was already a discussion paper (Draft for a European Design Law) of the Max-Planck-Institute for Foreign and International Patent, Copyright and Competition Law^(*25), whose „design-approach“, i.e. the development of

a kind of protection taking the specific characteristics of design law into account, influenced the legislative process of the Commission.^(*26) The ongoing discussion was completed on October 13, 1998 in the form of Directive 98/71EG of the European Commission and the Council for the legal protection of designs and models, which cleared the path to the harmonization of the corresponding European laws. On December 12, 2001, the regulation on the European Community Design was passed, which stipulates a uniform system for the protection of European designs and models.^(*27)

As binding basis, the Design Directive provides a uniform definition of the term *design* as well as of the matters of fact regarding *novelty* and *individual character* as material prerequisites for protectability.^(*28) Besides these requirements, the Community Design Regulation introduces a dual design protection with community-wide effect.^(*29) On the one hand, design protection is guaranteed by a simple and cost-saving registration procedure at the Office for Harmonization in the Internal Market in Alicante, and on the other hand through a form-free protection of designs, which are protected from the point of time, when they are made public through offer for sale or advertisement.^(*30) Differences between both kinds of protection lie in the term and scope of protection: Whilst the non-registered designs are guaranteed a protection against unlawful copying for 3 years, the registered design is protected for a total period of 25 years against wilful copying as well as independently developed but similar designs.^(*31) The fundamental reform of the German Design Act confers novel character to this regulation, so that the delimitation to other

(*25) Diskussionsentwurf des Max-Planck-Institutes für ausländisches und internationales Patent-, Urheber- und Wettbewerbsrecht für ein europäisches Musterrecht, GRUR Int. 1990, p. 566 et seq.

(*26) Pentheroudakis, Die Umsetzung der Richtlinie 98/71/EG über den rechtlichen Schutz von Mustern und Modellen in den EU Mitgliedstaaten, GRUR Int. 2002, p. 668 (679). The discussion paper started off from the design as a marketing instrument. It was argued that a potential buyer is significantly influenced in his decision-making process by the design of the object he considers to buy. See also Diskussionsentwurf des Max-Planck-Institutes für ausländisches und internationales Patent-, Urheber- und Wettbewerbsrecht für ein europäisches Musterrecht, GRUR Int. 1990, p. 565 (574).

(*27) Pentheroudakis, Die Umsetzung der Richtlinie 98/71/EG über den rechtlichen Schutz von Mustern und Modellen in den EU Mitgliedstaaten, GRUR Int. 2002, p. 668 (679).

(*28) Recital 9 of the Design Directive (Erwägungsgrund 9 der Richtlinie); Art. 3 of the Design Directive. The protective term is 5 years starting from the date of application and can be extended to a total of 25 years.

(*29) Pentheroudakis, Die Umsetzung der Richtlinie 98/71/EG über den rechtlichen Schutz von Mustern und Modellen in den EU Mitgliedstaaten, GRUR Int. 2002, p. 668 (679).

(*30) For details about the non-registered design see Rahlf/Gottschlak, Neuland: Das nicht eingetragene Geschmacksmuster, GRUR Int. 2004, p. 821 et seq.

(*31) The non-registered design protection is in particular useful for designs with a short life circle, Pentheroudakis, Die Umsetzung der Richtlinie 98/71/EG über den rechtlichen Schutz von Mustern und Modellen in den EU Mitgliedstaaten, GRUR Int. 2002, p. 668 (679).

forms of protection, in particular the copyright, have to be carried out anew.^(*32) A double protection according to both legal institutions is, however, still possible and explicitly provided for in Art. 17 of the regulation to be implemented.^(*33)

(2) Novelty and Individual Character

Novelty and *individual character* are necessary prerequisites for protection. Besides the term *design*^(*34), also these two terms have been taken from the directive.^(*35) Thus, the objective-relative term of novelty continues to exist in Germany.^(*36) Novelty is assumed if there have been no designs on the market that are identical or that differ only in immaterial details from the design for which protection is sought.^(*37) Modification of the item *originality* into the new term *individual character* means more than a linguistic redraft. The term “individual character” was so far only known from competition law, whereas now a distinct delimitation from the copyright law is emphasized and a term has been chosen, which was as unencumbered as possible.^(*38)

The required individual character of a design according to Sec. 2 (3) Design Act is given, if the overall impression the design produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the date of filing of the application for registration or, if priority is claimed, the date of priority.^(*39) Thus it now only depends on the fact that the overall impression of a design differs from the general variety of forms; a certain creative standard of the design is, however, not required anymore.^(*40) Decisive feature for the acknowledgement of a design worthy of protection is therefore not any more its innate creative character but the degree of difference from other forms.

III Current Situation in Japan

Similar to the situation in Europe and Germany, also in Japan there are different understandings of how to protect industrially designed artistic (artefacts). Therefore, this part of the paper tries to examine under which

(*32) The former Design Act was based on a copyright approach, and it was considered a commercial protective right on a copyright basis. This tight connection to the copyright law is now to be avoided in that the new law considers the design to be an independent commercial protective right and not merely a branch of the copyright law; Wandtke/Ost, Zur Reform des deutschen Geschmacksmustergesetzes, GRUR Int. 2005, p. 91 (92).

(*33) Wandtke/Ost, Zur Reform des deutschen Geschmacksmustergesetzes, GRUR Int. 2005, p. 91 (92).

(*34) Whereas the old Design Act did not yet contain an independent definition of the term design, Sec. 1 GeschmMG (Design Act) now literally quotes the legal definition of the directive, which defines a design as „appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation“. Besides designs also products are now protected, whereby a product according to Sec. 1 (2) Design Act encompasses any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces. Finally, complex products and their components are protected, which are defined according to Sec. 1 (3) Design Act as products, which are composed of multiple components which can be replaced permitting disassembly and reassembly of the product. The definition of a product is fairly broad and also comprises graphic symbols and typographic typefaces, yet excludes computer programs. See Heath, “The protection of Aesthetic Creations as Three-Dimensional Marks, Designs, Copyright or under Unfair Competition”, New Frontiers of Intellectual Property Law (IIC Studies), p. 182.

(*35) Recital 9 (Erwägungsgrund 9) of the Design Directive alleged a uniform wording for European Countries.

(*36) Eichmann/von Falckenstein, Sec. 2 GeschmMG (3rd edition 2005) par. 1. Compared with the old Design Act there are no differences, see BGH (German Supreme Court), May 8, 1968, GRUR 1969, p. 90 „Rüschenhaube“.

(*37) The novelty test is measured against the previous publication of an “identical design“, see Heath, “Protection of Aesthetic Creations as Three-Dimensional Marks, Designs, Copyright or under Unfair Competition”, new Frontiers of Intellectual Property Law (IIC Studies), p. 182. The date to determine novelty in the case of a registered design is the application date. In case of an unregistered design the date should be the day, when the design was first made available to the public. Novelty is lost, if the previous design “reasonably have become known in the normal course of business to the circles specialized in the sector concerned, operating within the community.” The standard comes close to worldwide novelty, if one considers the worldwide use of the internet, which is still increasing. For further details see Heath, “The Protection of Aesthetic Creations as Three-Dimensional Marks, Designs, Copyright or under Unfair Competition”, New Frontiers of Intellectual Property Law (IIC Studies), p. 182.

(*38) Wandtke/Ost, Zur Reform des deutschen Geschmacksmustergesetzes, GRUR Int. 2005, p. 91 (96)

(*39) See Heath, „The Protection of Aesthetic Creations as Three-Dimensional Marks, Designs, Copyright or under Unfair Competition“, New Frontiers of Intellectual Property Law (IIC Studies), p. 182: “The individual character requires a distinction in the overall impression produced by the design on an informed user vis-à-vis previously existing designs.”

(*40) Begründung zum Gesetzentwurf der Bundesregierung, BR-Drucks. 238/03, p. 77.

conditions the Japanese copyright law protects such industrially designed artistic and under which conditions protection under the Japanese Design Act is available by picking some actual examples out of Japanese Case Law.

1 Design Protection according to Design Law

Under the Japanese Design Act, Designs are protected if they are embodied in an article, i.e. a movable three-dimensional object.^(*41) In order to qualify for protection, the article, in which the design is embodied in must be visible and must be separately traded if it is part of a more complex article. Requirements for protection are novelty and certain creativity or individual characteristics to prove that the article could not have easily been created based on prior art products. Novelty in this context means a standard of absolute novelty with a grace period of six months, i.e. no similar article has been made public prior to the creation of the design for which protection is sought.

Even though these prerequisites sound as if they could easily be met, the Japanese Design system is characterised by substantive examination and a fairly elaborate set of rules regarding the application procedure.^(*42) This often evokes a feeling of dissatisfaction on the designers' side. The problems repeatedly pointed out by the applicants with regard to the provisions and the operation of the Design Law are that the establishment of the right takes considerable time, which does not suit the market trend.

Although the formalities for application have been simplified in recent years^(*43), the procedure of registration is still quite time-consuming and complex, especially as regards the time of the final registration, since the registration procedure

including the examination involves the participation of the Japanese Patent Office (JPO).^(*44) In order to avoid registration and examination, protection under copyright law is sought by many Designers instead, in particular if the life cycle of the product is expected to be shorter than the average examination procedure.

2 Design Protection according to Copyright Law

As shown above, the most common way of protecting aesthetic creations is design protection under the Design Act. However, the Japanese copyright law also provides protection for such aesthetic works: Pursuant to Sec. 2 (2) Japanese Copyright Act, "artistic works" also include works of the "applied art", i.e. so-called works of "artistic craftsmanship", what makes a simultaneous protection of a work of the applied arts under the Japanese Copyright Act and under the Design Act possible.^(*45)

With regard to this simultaneous protection under both the Design Act and the Copyright Act, the attractiveness of the latter one has to be considered. In fact, there is an unofficial but general view that "for most designers, especially graphic designers, the Design Law exists only in name. The lifecycle of the role given to a design, e.g. a graphic design is generally within a few months, and there is no waiting time for the examination under the Design Law."^(*46) This point of view openly criticises the time required for the establishment of the right to protect the short-lived design. For that reason there is an indication that, "when industrial designers discuss design protection starting from the Design Law, they sometimes become slightly inclined to think that industrial designs should also be protected by the Copyright Law."^(*47)

(*41) Icons, for that reason, can not be protected under the Japanese Design Act.

(*42) Heath, "The Protection of Aesthetic Creations as Three-Dimensional Marks, Designs, Copyright or under Unfair Competition", *New Frontiers of Intellectual Property Law (IIC studies)*, p. 187. In the application, it is necessary to indicate the article or part of the article to which the design is applied. The Japanese design classification contains about 5.000 articles. A valid application requires six views of the design/article drawn with the orthogonal projection and having the same scale. Alternatively, it is permitted to submit drawings showing two dimensional views by using the isometric projection method. The perspectives to be shown are top plan, bottom plan, front evaluation, left side and right side view.

(*43) In particular the registration period for the application of the designs has been reduced to one year, which makes it easier to obtain design protection for newly created products.

(*44) The participation of the Japanese Patent Office makes a certain delay before the final registration of the design inevitable. See Heath, "The Protection of Aesthetic Creations as Three-Dimensional Marks, Designs, Copyright or under Unfair Competition", *New Frontiers of Intellectual Property Law (IIC studies)*, p. 192.

(*45) Ganea, *Japanese Copyright Law (Writings in Honour of Gerhard Schricker)*, Chapter III Protected Works, p. 21.

(*46) Morita, *Protections of Designs and Momentum for Design Law Amendment*, Patent 1997, No. 2, p. 2-14.

(*47) Morita, *Protections of Designs and Momentum for Design Law Amendment*, Patent 1997, No. 2, p. 2-14.

Since copyright protection arises at the point of time, when a work is created^(*48), and no time-consuming examination undertaken to find out whether design production is to be granted as it is the case according to the current procedure prescribed under the Design Act, designers' creative activities can be protected from the very first beginning. As a consequence, the idea of "protection of industrial designs by copyright" is widely spread amongst and demanded by many designers, including freelance designers, in-house designers and persons concerned in education.^(*49) A critical question to be evaluated is therefore - similarly as in Germany - the delimitation of copyright protection and design protection, e.g. under which conditions an industrially produced design or artistic should be protected under Japanese copyright law and where the differences lie from being protected "only" by Design Law. As in Germany, protection under both laws is possible in Japan according to the respective legal provisions, whereby the intention of the legislator and the decisions of the responsible courts differ in their interpretation of the current legal situation, as will be shown by picking up some actual examples out of Japanese cases.

3 Court decisions

According to the original intention of the legislator in Japan, copyright protection should only be available to aesthetically designed individual pieces of works of fine art whereas protection of products manufactured in series should be reserved to design protection.^(*50) The

courts, however, do not unanimously follow this intention. A number of decisions have excluded protection under the Copyright Act for industrially designed artistics, while others have upheld it.^(*51)

Whilst the Kobe District Court stated in its decision of July 9, 1979^(*52), that any item which has an aesthetic value independent of its practical use can be regarded as an artistic work protected under the Japanese copyright act, irrespective whether it is manufactured in series or not, the Tokyo High Court awarded copyright protection to a mass production article in its Decision of December 17, 1991. Besides the fact, that according to this latter decision slavish imitation of products can now be prohibited under the Japanese Act against Unfair Competition^(*53) the Tokyo High Court has shown some new aspects regarding the more general question of to what extent the shapes, forms and presentation of industrially manufactured products can be protected by Japanese Copyright Law. In order to distinguish protection under the copyright act from protection under the design act, it was argued that:

"According to Sec. 2 (1) Copyright Act, a work of art is defined as the creative expression of ideas or feelings within the scope of literature, science, art or music. In addition, Sec. 2 (2) Copyright Act provides that works of art under the Copyright Act include artisan works. Thus, the provision of Sec. 2 (1) Copyright Act clearly establishes that so-called applied works of art which only use techniques and impressions of real art (as the expression of beauty meant for

(*48) As distinct from industrial property laws, copyright protection does not require prior registration.

(*49) A Questionnaire survey on design protection conducted by JIDA showed that the idea of "protection of industrial designs by copyright gains at least 70% support. See Morita, Protections of Designs and Momentum for Design Law Amendment, Patent 1997, No. 2, p. 2-14.

(*50) See statement of the Culture and Education Committee of the Lower House 6 May 1969, reported in Committee of the Cultural Agency for the Edition of 100 Years of Copyright History Chosakuken hyakunen shi (100 Years of Copyright History) Tokyo 2000, p. 349.

(*51) Denying copyright protectability: Osaka High Court Decision, February 14, 1990, final appeal rejected by the Supreme Court Decision, March 28, 1991 "Neetier"; Tokyo District Court Decision, January 24, 1992 "Decorative Window Bars", Nikkei Design 61 (1992). The most important question regarding this matter is how to define the scope of copyright protection most efficiently. For details see Teramoto, Copyrightability and Scope of Protection for Works of Utilitarian Nature under Japanese Law, IIC 1997, p. 51 et seq., who argues that the degree to which expression in a work is restricted by utilitarian function, is the parameter that defines the scope of copyright protection most efficiently.

(*52) Kobe District Court Decision, July 9, 1979 "Altar Statues", 11-2 Mutaishu 371 (1979). Also affirming protection under copyright law: Osaka District Court Decision, December 21, 1970 "California T-shirts", 2 Mutaishu 654 (1979).

(*53) See Heath, Tokyo High Court 17.12.1991 case No. Hei 2 (Ne), 2733 "Decorative Veneer", IIC 1994, p. 810. Slavish Imitation of products is now prohibited under the Act Against Unfair Competition, provided that no more than three years from the date of first sale have elapsed and provided that the products imitated are not merely of common or functional shape.

edification), for mere utilitarian goods, can only be utilitarian goods themselves. The Copyright Act only protects craft works made in very small numbers. As for works of applied art that fall outside the scope of craftworks, the Copyright Act does not clearly define how far they can be protected under copyright law. First of all it is certainly possible to protect works of applied art that serve as models for mere utilitarian goods that are used as prototypes for goods, made by means of industrial production technically identical and in large numbers, under the Design Act, since it is the purpose of this act to promote the creation of such models and thereby to contribute to industrial development. Also qualifying for protection are the form, pattern and colouring of the above products, including their connections as a subject of design rights. Apart from that, even if the product in question has only been produced as a prototype for mere utilitarian goods – if, for example, a famous artist has created a work of high artistic value (as the highly creative expression of ideas for feelings), and such work can be said to have the quality of art – it should be protected as a work under the Copyright Act.”

This view of distinguishing copyright protection from design protection by the mere numbers of items produced was followed by later decisions from other courts.^(*54) However, none of the courts was able to give clear reasons why the number of reproductions should determine whether or not a design was eligible for protection under copyright law.^(*55)

Similarly to the situation in Germany, the subject of the discussion regarding design protection in Japan has become the question, whether goods, the configuration or appearance of which have been aesthetically created and produced for a practical or industrial purpose (generally called applied art), should be protected as artistic works under Copyright Law. Unfortunately, the law itself does not provide any specific explanation concerning this issue but simply states that an “artistic work includes a work of artistic craftsmanship”. Therefore

confusion is caused since there is no concrete definition of the artistic work as such provided in the legal textbook. As a result, every court has to come to its own interpretation regarding this term, and it remains uncertain for a third party to estimate the scope of the protection. In other words, it is not easy to foresee protectability prior to raising a lawsuit.

The way of delimitation by counting the produced number, which was shown in the Tokyo High Court decision of December 17, 1991, seems to be inapprehensible and unacceptable, since there is no explicit reasoning given by the Tokyo High Court making it even more difficult to understand this argumentation. It is not acceptable, that the Copyright protection should consider the designers’ original intention whether or not to produce large numbers of his work. The intention of creating an artistic work, be it for mass production or one single object, is not decisive for the grant of copyright protection at all. As a consequence, excluding designs from copyright protection because they are mass-produced would mean effectively depriving them of all copyright protection.^(*56)

But it seems questionable whether the Tokyo High Court really wanted to go that far.^(*57) In fact it is more likely that, despite some discrepancies in terminology, Japanese Courts determine copyright protectability in terms of the degree of originality rather than the production method.^(*58) Only if a design shows an aesthetic creativity that exceeds the aesthetic elements usually found in that specific type of work protection under the Copyright Act can be granted. The degree of originality is also more effective for the delimitation between copyright and design protection, since it is closer to the wording and intention of the law itself, which aims to protect the creator and his intellectual property, but does not wish to protect the production of objects of utility. The latter one is also in need of protection, but in another manner, which is provided for by the design law. To arrive at a fair delimitation of copyright and design protection, one should therefore look at the level of creativity, i.e. the affinity to the fine arts. The closer the design comes to the fine arts, the more

(*54) Heath, Tokyo High Court 17.12.1991 case No. Hei 2 (Ne), 2733 “Decorative Veneer”, IIC 1994, p. 805 (811).

(*55) Monya, The Design Act and Related Laws, Annual of Industrial Property Law 1989, p. 118-133.

(*56) Heath, “The Protection of Aesthetic Creations as Three-Dimensional Marks, Designs, Copyright or under Unfair Competition”, New Frontiers of Intellectual Property Law (IIC studies), p. 193.

(*57) See Heath, High Court 17.12.1991 case No. Hei 2 (Ne), 2733 “Decorative Veneer”, IIC 1994, p. 805 (811).

(*58) Teramoto, Copyrightability and Scope of Protection for Works of Utilitarian Nature Under Japanese Law, IIC, 1997, p. 51 et seq.

probable it is to interpret the design as a work of the fine arts itself, which in turn means access to copyright protectability.^(*59)

Thus, in summary it can be concluded that there are certain similarities between the German and Japanese way of protecting industrially designed artistic works under copyright and design law as concerns the requirements of novelty and artistic creativity. However, the delimitation seems to be comparatively more vague under Japanese law, which has led to contradicting decisions and interpretations of what can be protected under either of these acts of intellectual property protection. But, to come to a final conclusion, the first decisions of the national courts in Germany as well as the European Court of Justice are expected with interest.



(*59)See Tamura, Copyright Law Review, 2nd edition, Chosakukenhou Gaisetsu Dai2han, Chapter 1 Section III, pp. 30-40.
“As it turns out, the determining factor seems to be whether or not the article can be regarded as fine art”.