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## ART AND FUNCTION IN THE LAW OF COPYRIGHT AND DESIGNS

### THE NEED FOR A REAPPRAISAL

The protection of designs used in industry either for the manufacture in quantity of articles which may be said to come within the category of applied art or for the mass production of functional and utilitarian articles has been one of the least satisfactory areas of Australian industrial property law, and both the Commonwealth Designs Act 1906-1968 and the Copyright Act 1968, in so far as the latter Act relates to designs and artistic work, are much in need of review. The aspects of the law which cause the principal difficulties are, firstly, the characterization of "designs" under the Designs Act 1906-1968 and "artistic works" under the Copyright Act 1968, and secondly, the whole rationale of the Designs Act which purports to protect, as a monopoly, a wide range of works which have little in common other than the fact that they are as "designs" applied to articles of manufacture in mass production to improve or alter visual appearance<sup>1</sup>.

As the object of the designs law is to give protection to the visual form of articles which are mass produced for commerce or industry the range of articles in respect of which designs are registered extends over almost the whole field of manufactured articles and includes, for example, electrical goods, building materials, furniture of all kinds, paper hangings, apparel and footwear, horticultural goods, marine goods, toys, jewellery, cutlery, ceramics, work in precious metals and graphic design<sup>2</sup>. Such articles may have little in common other than their industrial or commercial use and yet they comprise applied art as traditionally understood (*e.g.*, pottery, wall hangings and porcelain), useful articles of distinctive appearance (*e.g.*, chairs, basins and space heaters), and also the small invention or functional article which makes no claim to any aesthetic consideration, and where appearance may seem quite secondary to function (*e.g.*, a scaffolding clamp, gutter joint or an electrical terminal). What is the relationship between such "designs" within the meaning of the Designs Act 1906-1968, on the one hand, and, on the other hand, "artistic works" within the meaning of the Copyright Act 1968? Does it make any sense at all to create a separate class of "designs" or would it be preferable to abandon altogether this category of industrial property and seek other forms of protection?

The Copyright Act 1968 contains complex provisions for the purpose of obviating the possibility of dual protection under both Acts for those "designs" as defined by the Designs Act 1906-1968 which are also "artistic" works within the meaning of the Copyright Act<sup>3</sup>. The background to this legislation and the

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1. Designs Act 1906-1969, ss.4 and 5, and see Part 3 *infra*.
2. Interesting examples are given in the Report of the Departmental Committee on Industrial Designs 1962, Cmnd. 1808 (referred to as The Johnston Committee Report), Appendices C and J.
3. Ss.74 to 77.

problems to which it gives rise have been examined elsewhere<sup>4</sup>. It is only necessary to point out here that the general effect of these provisions is that an artistic work is deprived of copyright protection under the Copyright Act 1968 if a design which results in a reproduction of the artistic work when applied to an article, is so applied to more than fifty articles or to one or more articles manufactured in lengths or pieces, other than hand-made articles<sup>5</sup>. Two or more articles that are of the same general character and intended for use together and to which substantially the same design is applied are deemed to constitute a single article<sup>6</sup>; an example of such articles would be a dinner service. The loss of copyright in the artistic work is limited to its field of actual industrial or commercial exploitation for a period of fifteen years after the articles are first put on sale or hire if the design has not been registered under the Designs Act<sup>7</sup>. Thereafter the loss of artistic copyright is over the whole field of potential industrial application<sup>8</sup>. If a design has been registered the loss of copyright in the work is limited to those exclusive rights in the design given by the Designs Act while registration subsists<sup>9</sup>. Thereafter, as in the case where the design is not registered, the loss is over the whole field of potential industrial application<sup>10</sup>.

Thus, if a drawing of a Peanuts cartoon character such as Snoopy is applied industrially by the mass manufacture of Snoopy dolls according to that design, there is a loss of copyright protection for the artistic work under the Copyright Act 1968 to the extent of its commercial exploitation and the design proprietor must register his design under the Designs Act 1966-1968 if he is to receive any statutory protection for his work. However, as it will be hoped to show in this article, the statutory concept of "design" is itself rooted in early nineteenth century conceptions as to the relationship between art and craft, and is not responsive to modern ideas of the totality of art and all creative work. Thus, the characterization of a work as a "design" can have serious consequences for the artist or designer.

The purpose of this discussion is to examine the concepts of "design", "artistic work" and the "utility model" and suggest a new disposition for the protection of machine art and designs of useful and functional articles in industry. The Commonwealth Attorney-General has recently announced the appointment of a Designs Law Review Committee with the following terms of reference:

1. To examine the Australian law relating to designs and to recommend any alterations of the law that may be thought desirable.
2. To consider and to recommend whether separate legislative provision should be made in Australia with respect to utility models and, if it so

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4. J. C. Lahore, "Industrial Designs and The Copyright Act 1968", 43 A.L.J. 139 (1969).

5. Copyright Act 1968 (No. 63), ss.74(1), 75 and 77; Copyright Regulations (S.R. 1969 No. 58), Reg. 17(1).

6. Copyright Regulations (S.R. 1969 No. 58), Reg. 17(2).

7. Copyright Act 1968 (No. 63), s.77(1) and (2).

8. *Id.*, s.77(3).

9. *Id.*, s.74(a).

10. *Id.*, s.75(b).

recommends, the provisions that it is thought should be included in that legislation.

It is hoped that the Committee will give careful consideration to the question of whether designs as a separate form of industrial property should be abandoned altogether. If designs are to be so abandoned it is suggested that copyright protection under the Copyright Act 1968 should be extended to cover works of craftsmanship which may not, under the present law, be considered sufficiently "artistic" to come within the category of "artistic works". For many useful articles which are functional or serve the purpose of work or utilization, and which are more analogous to subject matter patentable under the Patents Act 1952-1969, the utility model system of registration might well be the most appropriate form of protection.

Before passing to an analysis of the concepts of "design" and "artistic work" it is necessary to give some consideration to the historical development of industrial design protection and the reasons for the introduction and development of a separate statutory category of works called "designs" or "industrial designs" with a hybrid protection neither patent nor copyright and yet with more similarity to the former<sup>11</sup>.

### I. Origin of the "Design"

The growth of industrial design and the demands for specific protection by manufacturers and craftsmen is only a facet of the general commercial and mechanical developments which were taking place in England at the end of the eighteenth century<sup>12</sup>. The mechanical inventions of Arkwright, Watt and others stimulated a rapid and unprecedented growth in the patent system<sup>13</sup>, and the number and variety of manufactured products, which were exposed throughout the world, had increased enormously by the last decade of the eighteenth century<sup>14</sup>. Also of considerable importance in the development of the design industry was the establishment of many societies for the encouragement of the arts and manufacturers. The Society of Arts (which became the Royal Society of Arts in 1909) was established in 1754 and was concerned with encouraging design in order that English manufacturers could more successfully compete with the French whose superiority in the field of applied art was generally acknowledged<sup>15</sup>. The Royal Academy of Arts was founded

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11. Pursuant to the Designs Act 1906-1969, ss.12 and 17, *registration* gives the *exclusive* right "to apply the design or authorize another person to apply the design, to the articles in respect of which it is registered" (s.12); only *new or original* designs which have *not been published in Australia* prior to application for registration can be registered (s.17). Emphasis supplied.
  12. See generally Holdsworth, *A History of English Law* Vol. XI, 426 *et seq.* (1938), and Vol. XV, 37 to 41 (1965).
  13. Hulme, "The History of the Patent System Under the Prerogative and at Common Law", 12 L.Q.R. 141 (1896); 13 L.Q.R. 313 (1897).
  14. F. Wendeborn, *A View of England towards the Close of the 18th Century*, 222-225 (London, 1797). ("The principal English manufactures are those of wool, leather, flax, hemp, glass, paper, porcelain, cotton, silk, lead, tin, iron and steel . . ."; "The iron, steel and metal manufactures of Birmingham and Sheffield are sent to almost all parts of the globe . . . watch chains, buttons, knives and thousands of other things are made with incredible facility . . .").
  15. See 42 H.C. Jour. 546 (March 15, 1787); 56 Parl. Deb., H.C. (3rd ser.) 483 (1841); 61 Parl. Deb., H.C. (3rd ser.) 667 (1842).

in 1768 and it has been claimed that these societies did much to improve the taste and skill of English industrial design and artistic workmanship in the making of patterns and textiles and drawings<sup>16</sup>.

It is not surprising that with such growth in industry attention should be given to the question of suitable protection for the designer to enable him to obtain a proper economic return for his work, and in fact a Petition was presented to the House of Commons in 1787 by "the calicoe printers, artists, designers of drawings, engravers and other proprietors of original patterns for printing linens, cottons, calicoes and muslins"<sup>17</sup>. The Petition recited that many persons, to save themselves the expense of original designs, had taken the liberty of copying, printing and publishing "great quantities of base and mean copies and imitations thereof to the great detriment of the Petitioners" and they prayed that a Bill be brought in "for securing the properties of the Petitioners for a limited time in the same manner as the laws now in being have preserved the properties of authors of books . . . and the inventors and engravers of historical and other prints". As a result of such petitions the first Act of Parliament giving protection to industrial designs was passed in the same year, 1787<sup>18</sup>. This Act gave to ". . . every person who shall invent, design and print, or causes to be invented, designed and printed, and become the proprietor of any new and original pattern or patterns for printing Linens, Cottons, Calicoes or Muslins" the "sole right and liberty of printing and reprinting" the design for the term of two months from the first day of publication.

With this first Act the basic question is raised—should designs and models constitute a separate branch of industrial property at all or should they be classified either with inventions or with intellectual works? The interest of the Act of 1787 is that it appears to give only a right to prevent others from copying the work and not an exclusive right in the design itself, the regime of designs under this Act being similar to that of the subject matter of copyright, but the references to invention and novelty are confusing and the provisions of the Act suggest an *ad hoc* approach to the problem of protecting the works referred to. It has been maintained<sup>19</sup> that despite the sudden outburst of inventive activity in the later decades of the eighteenth century there developed during this period, especially in the North of England in connection with textile inventions, strong opposition to patents as a method of rewarding inventors and various other methods were devised or suggested; and yet the

16. Bowden, *Industrial Society in England towards the end of the 18th Century*, 12 (1925) citing Wendeborn, n.14 *supra*.

17. 42 H.C. Jour. *supra* n.15 at 546. The problem was also being canvassed on a more popular level. A booklet was published in 1774 under the title "An Address to the Artists and Manufacturers of Great Britain respecting an Application to Parliament for the Further Encouragement of New Discoveries and Inventions in the Useful Arts" which contained the following ditty:

"'Tis great, 'tis wonderful, sublime  
No doubt to build the lofty rime!  
But, deaf to what the poet sings,  
Tho' charm his muse the ear of kings,  
The patriot sees more wit and good in  
Th' invention of a marrow pudding".

18. The Designing and Printing of Linens, Cottons, Calicoes and Muslins Act, 1787 (27 Geo. 3, c.28).

19. Bowden, *supra* n.16 at 12.

Act refers to invention and novelty both of which were essential for grants of patents by the end of the eighteenth century<sup>20</sup>. There were of course very few literary and artistic works included within the scope of copyright protection by 1787. The earliest copyright statute, the Statute of Anne<sup>21</sup>, gave a literary property in books and other writings and in 1734 engravings received copyright protection<sup>22</sup>. But the first Sculpture Copyright Act was not passed until 1797<sup>23</sup> and paintings, drawings and photographs did not receive copyright protection until 1862<sup>24</sup>. Hence the existing law provided no ready analogy for the subject matter of the 1787 legislation.

The Act of 1787 did not prove satisfactory. In particular, it was claimed that the term of protection was so brief as to be no protection at all<sup>25</sup> and that there was extensive pirating<sup>26</sup>. There was continual concern at the pre-eminence of French industrial art and a Select Committee was appointed in 1835 to inquire into the best means of extending a knowledge of the arts and of the principles of design<sup>27</sup>. During the hearing before the Committee it was maintained that there were two essentials in any scheme of protection, cheapness and promptitude, and there was some brief discussion of copyright protection<sup>28</sup>, but no consideration of the nature of the right to be given to the copyright owner. Ladas argues<sup>29</sup> that the formation of a special branch of industrial property to include designs and models was a historical accident and he points to the French law of 1806 which, he claims, influenced and inspired the legislation of all other countries. There is no doubt that the French law was uppermost in the minds of many of the members of the House of Commons during the 1842 debates<sup>30</sup>. It was claimed that the pre-eminence of France in every department of industrial art could in some respects be traced

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20. 13 L.Q.R. 313, 318 (1897).

21. Copyright Act 1709, (8 Anne, c.19).

22. Engravings Copyright Act, 1734 (8 Geo. 2, c.13), amended in 1767 (7 Geo. 3, c.38) and in 1777 (17 Geo. 3, c.57).

23. Sculpture Copyright Act, 1797 (38 Geo. 3, c.71). The word "invent" is used in the Act of 1734, the words "invent" and "new and original" are used in the Act of 1797, and in the Sculpture Copyright Act 1814 (54 Geo. 3, c.56) the sole rights referred to are for all "new and original" sculpture—being a matter of "invention". But it seems that at least until the late 18th century the concept of "invention" denoted primarily a physical act ("invenio"—I come upon) rather than a mental process. See Hulme, n.13 *supra*, 12 L.Q.R. 151, 13 L.Q.R. 313-318.

24. Fine Arts Copyright Act 1862 (25 and 26 Vict. c.68); and see generally Holdsworth, *supra* n.12; Copinger and Skone James, *Copyright* (10th ed. 1965), 12-14.

25. In 1794 the period of protection was extended to 12 months (34 Geo. 3, c.23).

26. The matter was discussed at length in the House of Commons between 1839 and 1842 and many petitions were received. See 47 Parl. Deb., H.C. (3rd ser.) 483 (1841).

27. Select Committee, 5 Brit. Sess. Papers, H.C. 377 (1835). (Mr. John Hennings the popularizer of the Elgin Marbles expressed the feelings of the witnesses: "I think such property [in designs] as much my own as my clothing and no one has any more right to appropriate it than to claim my personal labour without remuneration but what hand nor heart can contend with the covetous and unjust, who, by the cunning labour of a few days can contrive to rob me of years of life and scatter over the whole land the deteriorated casts of my works, much to my prejudice as an artist.")

28. *Id.*, Paras. 233 and 244.

29. Ladas, *International Protection of Industrial Property*, 367 (1930).

30. 61 Parl. Deb., H.C. (3rd ser.) (1842).

to the encouragement and protection derivable from a law of copyright in designs which gave them a remunerative interest in their works for three, five or fifteen years, or even for life if they desired it<sup>31</sup>. In addition, the French law gave to the creator of the design the option to reserve himself the exclusive ownership of the design for all time<sup>32</sup>.

The Acts which were finally passed after these deliberations, the Designs Acts of 1839 and 1842<sup>33</sup>, are the foundations of the modern law. The Act of 1842 clearly conferred a monopoly on the design proprietor for the first time by granting him the sole right to apply his design to any article of manufacture or to certain other substances provided that the design had not been previously published either within the United Kingdom or elsewhere<sup>34</sup>, despite the fact that the Act refers to "copyright" in designs. The reference to "copyright" on the one hand and the granting of patent type monopolies on the other has been retained in all subsequent legislation both in the United Kingdom and in Australia. The Act of 1842 gave protection to "any new and original design whether such design be applicable to the ornamenting of any article of manufacture, or of any substance, artificial or natural, or partly artificial and partly natural, and that whether such design be so applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes and by whatever means such design may be so applicable . . ." <sup>35</sup>. The essentials of this definition, namely that a design is "applied" to an "article" as features of "ornament", "shape", "configuration" or "pattern" remain the essentials of "design" both in the present Designs Act of the United Kingdom<sup>36</sup> and in the Australian Designs Act 1906-1968<sup>37</sup>. This has been a principal source of confusion and difficulty in the modern legislation. The whole concept of industrial design has changed enormously since the early nineteenth century, and the old definition no longer adequately describes features of modern product design<sup>38</sup>.

The Design Act, 1842, repealed all the existing designs legislation including the two Acts of 1839<sup>39</sup>, but the second Act of 1839<sup>40</sup> has considerable importance for the future development of the law in that we find the first substantial departure from the principle of previous copyright Acts that statutory

31. *Id.*, at 667.

32. Ladas, n.29 *supra*, at 34.

33. The Copyright of Designs Acts 1839 (2 and 3 Vict. c.13, and 2 and 3 Vict. c.17); Designs Act 1842 (5 and 6 Vict. c. 100).

34. Designs Act 1842, n.33 *supra*, s.III.

35. *Id.*

36. Registered Designs Act 1949, (12, 13 and 14 Geo. 6, c.88) s.1 (3) (U.K.). "In this act the expression 'design' means 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."

37. S.4, n.54 *infra* and accompanying text.

38. *Infra* n.167 and accompanying text.

39. The Sculpture Copyright Acts of 1797, (38 Geo. 3, c.71), and 1814, (54 Geo. 3, c.56), were not repealed.

40. The Copyright of Designs Act 1839 (2 and 3 Vict. c.17).

copyright accrued to the proprietor of the design upon publication<sup>41</sup>. Under this Act a design had to be registered before publication otherwise there was no protection. The term of copyright commenced from the date of registration. In addition the design must be "new and original". We thus have the beginning of the modern requirement of "novelty" as regards prior publications.

The Acts of 1839 and 1842 form the foundation of the modern law and subsequent legislation in the nineteenth century does little to dispel the general picture of haphazard development<sup>42</sup>. In 1875, by the Copyright of Designs Act<sup>43</sup>, the powers of the Board of Trade under the earlier Acts were transferred to the Patent Office and in 1883 a general consolidating and amending Act was passed which treated Designs with Patents and Trade Marks<sup>44</sup>. The Act of 1883 requires that a design be "new or original" but it is not clear whether novelty and originality are both requirements for registration<sup>45</sup>. The copyright granted by the Act is the exclusive right to apply a design to any article of manufacture or any substance as defined<sup>46</sup>. The distinction between the protection of useful and ornamental designs was abolished and protection was extended to all designs (other than sculptures)<sup>47</sup> without regard to purpose or utility<sup>48</sup>. The term of protection was five years. No substantial changes were made in the law as it stood in the United Kingdom after the Act of 1883 apart from an amendment in 1907 allowing an extension of the term of protection for two further terms of five years each<sup>49</sup> until the Registered Designs Act, 1949<sup>50</sup>.

The first Designs Act in Australia passed by the Commonwealth Parliament, the Designs Act 1906, was to a large extent modelled on the Act of 1883<sup>51</sup>, and the dual system which had developed in the United Kingdom during the eighteenth and nineteenth centuries was perpetuated in the Australian legislation. Henceforth protection under the Designs Act is given to a wide range of works, primarily featural, upon registration and for a maximum term of 15 years<sup>52</sup>, while protection under Copyright Acts is given to original

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41. 2 and 3 Vict. c. 17 (the sole rights subsist from registration); compare the Act of 1787 (27 Geo. 3, c.38), *supra* n.18.
  42. In 1843 it was enacted that copyright should subsist in "any new or original design for any article of manufacture having reference to some purpose of utility" so far as such design should be for the shape or configuration of the article, (6 and 7 Vict. c.65). In 1850 sculpture was brought within the scope of design copyright (13 and 14 Vict. c. 104). Amending Acts were passed in 1858, (21 and 22 Vict. c.70) and in 1861, (24 and 25 Vict. c.73).
  43. 38 and 39 Vict. c.93 (1875).
  44. The Patents Designs and Trade Marks Act, 1883 (46 and 47 Vict. c.57).
  45. *Id.*, s.47(1) (although the form "new and original" appears in s.61 for no apparent reason). The use of "or" rather than "and" also appears in the Designs Act 1843, 6 and 7 Vic. c.65.
  46. The Patents Designs and Trade Marks Act, 1883, n.44 *supra*, s.58.
  47. The Designs Act 1850, (13 and 14 Vic. c.104), *supra* n.42, was repealed by the Act of 1883.
  48. The Patents, Designs, and Trade Marks Act, 1883, n.44 *supra*, s.60.
  49. Patents and Designs Act, 1907 (7 Edw. 7, c.20).
  50. 12, 13 and 14 Geo. 6, c.62.
  51. Designs Act No. 4 of 1906 (Cth.); and see Parl. Deb. Senate 20th June, 1906, Sen. Keating moving the 2nd Reading of Designs Bill 1906.
  52. Designs Act 1906-1968, s.26.

artistic works, such protection being given forthwith on creation, for a protracted term (generally life plus fifty years) and without formality<sup>53</sup>.

There would appear to be no reason for the development or retention of a separate branch of the law dealing with designs outside the Copyright Acts other than historical accident and the fact that at the time of the passing of the first designs legislation the law of copyright had not developed beyond giving protection to a very narrow range of intellectual works, not at all to be equated at that time with the work of the industrious artisan. It is the continuance of this inclination to distinguish and separate art and manufacture which has caused so much confusion in this area of the law. Certainly, to the extent that any thought was given to the nature of design protection in the early Parliamentary Debates, the discussion was in terms of copyright but there was no conscious formulation of any principle based upon patent or copyright law for distinguishing designs as a separate branch of industrial property.

## II. What is a "Design"?

The words which continually appear in the Designs Acts such as ornamentation, pattern, shape, configuration and design are alike in having no clearly distinguishable meanings and judicial attempts at classification are marked by a pronounced lack of precision<sup>54</sup>. Thus we are told that "Design means . . . a conception or suggestion or idea of a shape or of a picture or of a device or of some arrangement which can be applied to an article by some manual, mechanical or chemical means. It is a conception, suggestion, or idea, and not an article, which is the thing capable of being registered . . . it is a suggestion of form or ornament to be applied to a physical body"<sup>55</sup>. In *Re Clarkes Registered Design*<sup>56</sup> which was concerned with the design for an electric lamp applicable for its shape Lindley L.J. said<sup>57</sup>: "The word 'design' must be taken to be used in its ordinary signification of something marking out a plan or representation of something." The Act only extends " . . . to such designs as are applicable to some article of manufacture." Lindley L.J. went on to distinguish between a design for a pattern or ornament and a design for the shape of a thing. "A design applicable to a thing for its shape can only be applied to a thing by making it in that shape". It is thus clear that a differentiation must be made between the "design" and the "article" to which the design is applied<sup>58</sup> but that merely emphasizes the actual wording of the statutory definition in the Designs Act 1906-1968<sup>59</sup>.

53. Copyright Act 1968 (No. 63), ss. 32 and 33.

54. A "Design" is defined in the Designs Act 1906-1969, s.4, as ". . . an industrial design applicable, in any way or by any means, to the purpose of the ornamentation, or pattern, or shape, or configuration, of an article, or to any two or more of those purposes."

55. *Dover v. Nürnberger Celluloidwaren Fabrick Gebrüder Wolff* (1910) 27 R.P.C. 498, 503.

56. (1896) 13 R.P.C. 351.

57. *Id.*, at 358.

58. See also *Macrae Knitting Mills Ltd. v. Lowes Ltd.* (1936) 55 C.L.R. 725; *In Re Wolanski's Registered Design* (1953) 88 C.L.R. 278; *Saunders v. Wiel* (1893) 10 R.P.C. 29, 32; *Harrison v. Taylor* (1859) 4 H. & N. 815, 820.

59. See n.54 *supra*.

Kitto J. in commenting on the Designs Act 1906-1950<sup>60</sup> emphasized, "It is necessary to keep steadily in mind that that which is the subject of the impugned registration . . . is nothing but a design applicable . . . to the purpose of the ornamentation, or pattern, or shape, or configuration, of an article. It is not an article made according to a particular shape or pattern. Much less is it a method of making such an article, or a method of achieving an end by the use of such an article." The design in question was in respect of a neck-tie support and the representation consisted of drawings showing front and rear views of the article shaped so that it would resemble the knot of a tie when covered with a suitable material. Kitto J. considered that this design was not one applicable to ornamentation or pattern, but rather that it was an idea of shape or configuration "two words between which there is no need to draw a distinction"<sup>61</sup>.

The learned Judge clearly regarded shape and configuration as synonymous and this view has been taken in many of the early cases<sup>62</sup>. In a case where the design was for the handles of spoons representing a particular view of Westminster Abbey, taken from a photograph<sup>63</sup>, Lindley L.J. held that there was something which answered both to shape and pattern, "the shape being the configuration and the pattern being the engraving upon it"<sup>64</sup>. But assuming that the photograph in this example is the subject matter of copyright under the Copyright Act it is not at all clear when the photograph becomes a "design" capable of being registered under the Designs Act. Lindley L.J. states that the photograph is not a design within the Act until it is applied to something<sup>65</sup>. In this case, the handles of spoons, and thus the photographic representation of Westminster Abbey, must be reduced into a form capable of registration either by being embodied in the actual article or by being represented in such a way that the shape and pattern of the article are clear before there is something which is a "design".

The Designs Act 1906-1968, s.5(a), provides that a design shall be deemed to be applied to an article when the article is made from or in accordance with the design and this would normally envisage, as constituting design, works such as drawings of industrial articles or a drawing which is the basis of a three-dimensional article, or casts and models. The Act also provides in s.5(b) that a design shall be deemed to be applied to an article when the design is applied to the purpose of the ornamentation, or pattern, or shape, or configuration, of the article, or any two or more of those purposes. As has been stated above, the design is sharply to be separated from the article to which it is affixed or upon which it is impressed, but the nature of the design will inevitably be determined by the type of article to which it is applied. The Designs Act, s.4, defines "article" as meaning "any article or substance"

60. *In Re Wolanski's Registered Design* (1953) 88 C.L.R. 278, 279.

61. *Id.*, at 280.

62. See generally *In Re Clarke's Registered Design* (1896) 13 R.P.C. 351, 358-361; *Wells v. Attache Case Manufacturing Co. Ltd.* (1932) 49 R.P.C. 113; *Kestos Ltd. v. Kempat Ltd. & Kemp* (1936) 53 R.P.C. 139, 152.

63. *Saunders v. Wiel* (1893) 10 R.P.C. 29.

64. *Id.*, at 31.

65. *Id.*, at 32.

whereas the Registered Designs Act 1949 provides that an article means "any article of manufacture . . ." <sup>66</sup>.

It would appear at first sight that the definition in the Australian Act gives an enormous scope to the operation of the Act as many works of fine art such as drawings, paintings and photographs are applied to paper or canvas which would normally be regarded as "substances". Thus drawings and paintings on ordinary paper or canvas would appear to be designs equally with patterns applied to wallpaper, wrapping paper or textiles. And how does one categorize objects such as Christmas cards and posters—all are articles to which a "design" has been "applied" industrially but are nevertheless artistic works within the meaning of the Copyright Act 1968, s.10.

However, the cases which were decided prior to the Registered Designs Act 1949 indicate that an "article" must have some function other than that of merely carrying the design. In *Re Littlewoods Pools Ltd. Application* <sup>67</sup>, application was made to register a form of football coupon, consisting of a rectangular sheet of paper on which was a pattern formed by straight lines, the spaces between which were filled with literary matter, and Wynn-Parry J. in holding that the paper was not an article stated that as the function of the paper was "solely to carry the imprint of the design" and did not have any other function it was not an "article" within the meaning of the Act <sup>68</sup>. Similarly, comic strip drawings of "Popeye the Sailor" were held not to be themselves designs capable of registration under the Patents and Designs Acts, although when the features of shape and configuration depicted in the drawings were applied by industrial process to dolls and brooches a registrable design came into existence <sup>69</sup>.

The Designs Regulations now provide <sup>70</sup> that designs for certain articles including articles that are primarily literary or artistic in character and on which there is printing are excluded from registration under the Designs Act. This only provides a further step in the long confusing process of attempting to separate art and manufacture.

The Registered Designs Act 1949 of the United Kingdom gives a more specific definition of "design" than that set out in the Australian Designs Act 1906-1968. Pursuant to s.1(3) of the United Kingdom Act a "design" means "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" <sup>71</sup>. There are three aspects of this

66. Registered Designs Act, 1949 (12, 13 and 14 Geo. 6 c.88) s.44.

67. (1949) 66 R.P.C. 309.

68. *Id.*, at 310 (the decision was based on the Patents and Designs Acts 1907-1947 (U.K.)); accord, *Diego De La Branchardiére v. Elvery* (1849) 18 L.J. Ex. 381; *Masson Seeley & Co. Ltd. v. Embosotype Manufacturing Co.* (1924) 41 R.P.C. 160.

69. *King Features Syndicate Inc. & Betts. v. O. & M. Kleeman Ltd.* (1941) 58 R.P.C. 207, 222; [1941] A.C. 417, 443-444.

70. S.R. 1969 No. 64, Reg. 20 A.

71. Registered Designs Act, 1949 (12, 13 and 14 Geo. 6, c.88) s.1(3).

definition which are important in a discussion of the meaning and scope of design in the Australian legislation. Firstly, in the Australian Designs Act 1906-1968 "design" means an "industrial design . . ."<sup>72</sup>, whereas in the English Act a "design" means "features . . . applied to an article by any industrial process or means". Secondly, the features which are thus applied to an article are those "which in the finished article appeal to and are judged solely by the eye", whereas there is no such qualification in the Australian Designs Act. Finally, in the English definition, there is specifically excluded a method or principle of construction and features of shape or configuration which are purely functional. Again, there is no such specific exclusion in the Australian legislation.

It might be argued that to define a design as an industrial design applies a qualitative criterion and thus limits the application of the Designs Act 1906-1968 to designs applicable to articles of manufacture or articles of practical utility. But an article to which a design is applied may comprise any article or substance—it is not the article which is characterised as industrial but the design. On this basis it may be that an "industrial" design is a purely functional design (such as the design of a boiler) which contains no separable pattern or ornamentation. However, the Designs Act 1906-1968, s.4, specifically refers to the possibility of a design being applicable to the purpose of pattern or ornamentation. The design is distinct from the article, it has nothing to do with the function that article serves or of the utility which it possesses. On the other hand the cases have established that a shape cannot be a design where all the features are dictated solely by the function which the article to be made in that shape has to perform<sup>73</sup>. It is more likely that "industrial" is quantitative rather than qualitative and imports no more than that the design can be reproduced on articles in mass production. The definition makes clear the purposes for which a design may be used, not the nature of the design<sup>74</sup>.

If the distinctive feature of the designs legislations is protection for a design apart from the article to which it is applied, registration of the design will confer no protection for the elements of which it is composed nor upon any other combination of these elements. It then becomes essential to distinguish the design from what may be called the "fundamental form"<sup>75</sup> and it has been held in many cases that "the appeal is to the eye and the eye alone is the

72. S.4.

73. *Amp Incorporated v. Utilux Pty. Limited* [1970] R.P.C. 397, 425-428; and see n.84 *infra* and accompanying text.

74. Copyright in designs which were primarily or purely for ornamental purposes was regulated by the Designs Act, 1842 (5 and 6 Vict. c.100), *supra* n.33, while other designs with regard to the shape or configuration of articles of practical utility were dealt with in the Designs Act 1843 (6 and 7 Vict. c. 65), *supra* n.42. The Act of 1883 (46 and 47 Vict. c.57) abolished the distinction between "ornamental" and "useful" designs. In the Parliamentary Debates which preceded the passing of the Designs Act 1906 (Cth.) it was claimed that there was no intention to depart from the principle of the English Act. See Hansard Parl. Deb., H.R., August 1, 1906. In the Senate, Senator Keating stated that the word "industrial" was used in the same sense as it is used in what is known as an industrial exhibition or the industrial arts. See Hansard Parl. Deb., Senate, June 20, 1906.

75. A. D. Russell-Clarke, *Copyright in Industrial Designs*, 19 (4th ed. 1968).

judge of the identity of the two things"<sup>76</sup>. As we have seen, the Registered Designs Act 1949 includes this test in the definition of "design" in s.1(3), but although the Australian Designs Act 1906-1968 is less specific the courts have adopted the same method of determination. In *Malleys Ltd. v. J. W. Tomlin Pty. Ltd.* the High Court stated that there must be sufficient "individuality of appearance" to distinguish the design from "the fundamental form", "the existence of that sort of individuality is to be determined by the eye and not by measuring dimensions"<sup>77</sup>. Such a distinction is essentially an exercise in semantics and will involve a difficult, and to some extent arbitrary, choice as to the elements of the design which will be given the protection of the monopoly grant. It is in this area that so many of the problems of the hybrid nature of design protection arise. An exclusive right to apply the design to the articles in respect of which it is registered is granted<sup>78</sup>, and it is therefore necessary to limit the terms of the grant and avoid what might otherwise be a monopoly in a method of manufacture. But in many respects the design is the article, that is, the design of the article is not something applied to it but is the entire article. It is this comparison which has given rise to many of the problems arising out of the overlap between the Copyrights Acts and the Designs Acts<sup>79</sup>.

The problem of distinguishing design and fundamental form is well illustrated by the example of a chair. It will be difficult in any particular case, but especially in the case of a chair of modern design and simple line, to determine what constitutes the design applied to the fundamental form of "chair". As Lindley L.J. pointed out in *Re Clarkes Registered Design*<sup>80</sup>, "a design applicable to a thing for its shape can only be applied to a thing by making it in that shape". The question was discussed in *D. Sebel & Co. Ltd. v. National Art Metal Co. Pty. Ltd.*<sup>81</sup>. In that case the plaintiff company was a manufacturer of Sebel metal chairs and the design had been registered under the provisions of the Designs Act 1906-1950. The registration was in respect of a metal chair frame and photographs of the chair frame were annexed to the certificate of registration. The defendant manufactured a chair frame and the plaintiff alleged that its design had been applied by the defendant to the latter's chair frame. Jacobs J. carefully examined the structural features of the chair and came to the conclusion that there was not previously a conjunction of the various features which appeared in the metal chair frame. "There is to me a distinctive splay of the two legs, which taken with the in-setting of the supports of the back rests, the simplicity of outline and the general proportions gives a distinctive character to the design . . ." <sup>82</sup>. What

76. *Holdsworth v. M'Crae* (1897) L.R. 2 H.L. 380; *Hecla Foundry Co. v. Walker, Hunter & Co.* (1889) 14 A.C. 550, 555; *Cooper v. Symington* (1893) 10 R.P.C. 264, 267; *Re Bayers Design* (1907) 24 R.P.C. 65, 74; *Amp Incorporated v. Utilux Pty. Limited* [1970] R.P.C. 397, 419-423.

77. (1961) 35 A.L.J.R. 352. See also *In Re Wolanski's Registered Design* (1953) 88 C.L.R. 278; *D. Sebel & Co. Ltd. v. National Art Metal Co. Pty. Ltd.* (1965) 10 F.L.R. 224, 226-227.

78. Designs Act 1906-1969, s.12(1).

79. See Roy Jackson, "Industrial Designs in the United Kingdom" (1963) 45 J. Pat. Off. Soc'y. 488.

80. (1896) 13 R.P.C. 351, 358.

81. (1965) 10 F.L.R. 224.

82. *Id.*, at 227.

is necessary is to define visually a difference from the fundamental form and this must be a purely subjective operation—what does one imagine as the fundamental form of a chair? This approach and the statutory definitions which give rise to it not only favour obvious ornamental design at the expense of modern functional design, but give rise to problems in the application of the Copyright Acts. Copyright protection will be for the article itself if it is a work of artistic craftsmanship, and in the case of an article such as the chair the design may well constitute the article itself.

The *Sebel* case raises a number of other issues relevant to the present discussion. The defendant denied that the registered design was new or original and denied its validity as a registered design. The particulars of objection alleged that the design was not a new or original design by reason of prior publication and common general knowledge, and also claimed that the alleged design was solely a principle of construction and that its design was dictated solely by function in order to perform the purpose for which the article was to be used<sup>83</sup>. As we have seen, the Registered Designs Act 1949 of the United Kingdom specifically provides in s.1(3) that protection does not extend to the “method or principle of construction or to such 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”. But although no similar provisions are contained in the Australian Designs Act 1906-1968 the courts in this country have indicated that they accept the English decisions declaring these registrations to be invalid<sup>84</sup>. In the *Sebel* case Jacobs J.<sup>85</sup> held that the onus lay on the defendant to prove the invalidity of the registration, and if it were alleged that the design was not novel or not original or that it was dictated solely by function, or was merely a principle of construction, then the defendant must satisfy the court accordingly.

Both the functional and the mechanical tests are methods by which the courts attempt to limit the scope of the monopoly grant and exclude from design protection those articles which would more properly fall within the protection of the Patents Acts. The protection under the Designs Act 1906-1968 is given to an individuality of appearance and to one such specific appearance only. This, of course, increases the possibility of applying copyright concepts. It will however be difficult in many cases to say that the features of shape of an article are dictated solely by the article's functions. When, for example, does a chair, or a lamp, or a table cease to be purely functional? We again

83. *D. Sebel & Co. Ltd. v. National Arts Metal Co. Pty. Ltd.* (1965) 10 F.L.R. 224, 225.

84. *In Re Wolanski's Registered Design* (1953) 88 C.L.R. 278, 279 per Kitto J. citing *Pugh v. Riley Cycle Co. Ltd.* (1912) 29 R.P.C. 196; *Malley's Ltd. v. J. W. Tomlin Pty. Ltd.* (1961) 35 A.L.J.R. 352, 353 (“It is not the function of design to indicate a process of manufacture; indeed, anything amounting to a method of construction that would permit differences of shape spells invalidity,” the High Court citing *Pugh v. Riley Cycle Co. Ltd. supra* and *Rosedale Associated Manufacturers Ltd. v. Airfix Products Ltd.* [1956] R.P.C. 360); *Macrae Knitting Mills Ltd. v. Lowes Ltd.* (1936) 55 C.L.R. 725 at 730 (“The Designs Act is concerned with shape and configuration not function.”) It is to be noted in discussing the English authorities that prior to the Patents and Designs Act 1919 (9 and 10 Geo. 5, c.80 (U.K.)) the definition of “design” was similar to that in the Australian Act and contained no express limitations but the statutes have only clarified what had previously been decided by the courts.

85. (1965) 10 F.L.R. 224 at 226.

fall back on the "eye" test and the distinction between article and fundamental form. "A design . . . must be capable of being applied to an article in such a way that the article to which it has been applied will show to the eye the particular shape, configuration, pattern or ornament, the conception or suggestion of which constitutes the Design"<sup>86</sup>. Thus the registered design must show the particular shape and the courts will not uphold as valid an attempt to register a generalized conception as to the mode of construction<sup>87</sup>, or an attempt to register a design where the design feature is the only shape which will ensure performance of the function of the article to which it is applied<sup>88</sup>. As we shall see, the introduction of a utility model system would obviate some of the difficulties here. The present law was summarised by Lloyd-Jacobs J. in *Stratford Auto Components, Ltd. v. Britax Ltd.*<sup>89</sup>:

"It is obvious that the functional use of a designed article may well limit the type of suitable shape and configuration features for inclusion within the design. For example, a containing bowl of some character must be present in a design for a tea pot or some lens holder present in a pair of spectacles. If this functional use not only restricts the type of feature suitable but additionally prescribes a particular shape or configuration to which that feature must conform such feature is dictated solely by function and must in consequence be excluded from consideration . . . the test to be applied is an objective one, namely whether or not the function to be subserved by the article to which the design is applied imposes such control upon the freedom of the manufacturer as in substance to leave him no option but to adopt a feature or features appearing in the representation of the registered design."

In addition it now seems to be the position since the decision of the Court of Appeal in *Amp Incorporated v. Utilux Pty. Limited* that a design is not registrable only if *all* its features of shape are dictated solely by the function which the article has to perform<sup>90</sup>. In the United Kingdom, Rule 14(2) of the Designs Rules 1949 (S.R. 1949, No. 2368) provides that every application to register a design (with certain limited exceptions) shall be accompanied by a statement of the features of the design for which novelty is claimed. Such a statement defines "the ambit or scope of the monopoly, and is, therefore, to a certain extent analogous to a claim in the specification of a patent"<sup>91</sup>. On the other hand there is no such provision in the Australian Designs Regula-

86. *Pugh v. Riley Cycle Co.* (1912) 29 R.P.C. 196, 202.

87. See *Moody v. Tree* (1892) 9 R.P.C. 333, where the registered design was the picture of a basket, the claim being for the pattern of the basket showing a particular arrangement of the osiers and it was held that there could be made by this method of construction any number of baskets differing in pattern.

88. *Tecalemit Ltd. v. Edwards Ltd. (No. 2)* (1927) 44 R.P.C. 503; *Re Wingate's Design* (1935) 52 R.P.C. 126, 131; *Kestos Ltd. v. Kempat Ltd. and Kemp* (1936) 53 R.P.C. 139, 151; *Stenor Ltd. v. Whitesides (Clitheroe), Ltd.* [1948] A.C. 107, 121; *Amp Incorporated v. Utilux Pty. Limited* [1970] R.P.C. 397, 423-425.

89. [1964] R.P.C. 183, 189-190. (This case concerned a novel windscreen for motor cycles and scooters made of light thin material and deriving its rigidity from being moulded into a contour having a vertical channel throughout its height. It was argued that the channel was a feature of the screen dictated solely by function.)

90. [1970] R.P.C. 397, 425-428, 433.

91. A. D. Russell-Clarke, *Copyright in Industrial Designs*, 58 (4th ed. 1968).

tions 1906, but the applicant must describe the nature of the design and state whether it is to be applied to the purpose of the ornamentation, pattern, shape, or configuration of the article and the manner in which it is to be applied<sup>92</sup>. The English requirements are more specific, and it is often the claim embodying general features which is in fact a claim for a method or principle of construction<sup>93</sup>. If there is no claim to any particular feature the courts will adopt the usual test of construing the design, that is in the appeal to the eye. Protection is granted to a particular appearance and it is immaterial that the shape does or is intended to serve a useful purpose<sup>94</sup>. A case which illustrates both the argument as to function and the argument as to principles of construction is *Cow & Co. Ltd v. Cannon Rubber Manufacturers Ltd*<sup>95</sup>. The design was for rubber hot water bottles and showed on the back and front a series of ribs disposed diagonally on the surface and extending right up to a narrow side strip at the union of back and front. It was stated that "the novelty resides in the shape or configuration of the article as shown in the representations". The validity of the design was attacked on the grounds firstly that it included a method or a principle of construction and secondly that it included features of shape or configuration dictated solely by the function that the article had to perform. It was held by Lloyd-Jacobs J. that the first argument failed as it was impossible to hold that the design was of so comprehensive a character that it embraced "every conceivable figuration of the faces of a hot water bottle wherein raised portions of prescribed dimensions alternate with hollows of prescribed dimensions"<sup>96</sup>. As to the second argument, it was urged that the ribbing was necessary to permit heat to be radiated and to remove the possibility of discomfort and burning. This argument was rejected and it was held that the ribbing was not essential to achieve this effect and in fact properly constituted a design feature<sup>97</sup>.

If one design and no other must be adopted for the performance of a particular function, if the function dictates that design and that design alone, then the design will not be registrable, although it may be possible to obtain a monopoly grant under the Patents Act. However, the hot water bottle case does illustrate how difficult it is to determine this question and leads one to query the suitability of the Designs Act for the protection of such functional

92. Designs Regulations 1906, Reg. 16(1)(b).

93. See, e.g., the claims in *Moody v. Tree* (1892) 9 R.P.C. 333 ("claim for the pattern of the basket consisting in the osiers being worked in singly, and all the butt ends being outside"); *Re Bayer's Design* (1907) 24 R.P.C. 65; *Pugh v. Riley Cycle Co. Ltd.* (1912) 29 R.P.C., 196.

94. *Hecla Foundry Co. v. Walker, Hunter & Co.* (1889) 6 R.P.C. 554; (1889) 14 A.C. 550 (Lord Herschell said, at 558: "I quite agree with what was said by Lord Shand in *Walker Hunter & Co. v. Falkirk Iron Co.* [(1887) 4 R.P.C. 390, 393] that the Act in this branch gives protection only to the shape or configuration or to the design for the shape or configuration, in such a case as the present. The result of such protection may be, however, to secure important advantages, such as attend a mechanical contrivance, if these advantages should be the result, directly or indirectly, of the shape or configuration adopted."); *Jones and Atwood Ltd. v. National Radiator Company Ltd.* (1928) 45 R.P.C. 71; *Kestos Ltd. v. Kempat Ltd. and Kemp* (1936) 53 R.P.C. 139; *Rosedale Associated Manufacturers, Ltd. v. Airfix Products, Ltd.* [1956] R.P.C. 360, [1957] R.P.C. 239.

95. [1959] R.P.C. 240.

96. *Id.*, at 245.

97. *Id.*, at 245-246.

designs. A system of utility model registration, similar to that referred to in Part V, which clearly acknowledges that protection is sought for the useful idea as embodied in the design, could provide a more satisfactory scheme of protection for such designs. Lloyd-Jacobs J., in a recent decision relating to the design registration of an electrical terminal has indicated the "sense of unreality in endeavouring to relate the product of an avowedly functional exercise to the requirements of an Act which offers protection for attempts to provide individuality of appearance"<sup>97a</sup>. In that case the designer admitted that in designing the terminal he had no object in mind other than providing something which would satisfactorily perform the function required by Hoover for their washing machines. The sense of unreality is heightened by the fact that the "design" envisaged by the Designs Acts has many of the characteristics of an artistic work within the protection of the Copyright Acts, the only distinction being the application of designs to articles for mass production. But as we have seen the design often is the article. The whole concept of a "design" separable from an article to which it is applied and with an identity distinct from "artistic works" or works of "artistic craftsmanship" is artificial since there is, in many cases, no separable design and no distinction in fact apart from that imposed by statute. However, in considering the application of the Copyright Acts to "designs" it is necessary to determine the nature of an "artistic work" and the relevance of aesthetic or artistic criteria in establishing the subsistence of copyright.

### III. What is an "artistic work"?

Under the Copyright Act 1968, s. 10, copyright subsists in original artistic work which includes paintings, drawings, engravings, photographs and sculptures whether such works are of artistic quality or not. The protection previously given to architectural works of art is, under the 1968 Act, given to a building or a model of a building, again irrespective of artistic quality.

A "drawing" is also defined in s.10 as including "a diagram, map, chart or plan," and it is clear that with such a wide definition many drawings will constitute designs capable of registration under the Designs Act 1906-1968. In like manner, sculpture is widely defined to include "a cast or model made for purposes of sculpture", and many such sculptures could potentially be designs provided they are new and original conceptions as to shape or pattern applicable to an article. A three-dimensional work is equally as capable of registration under the Designs Act as a two-dimensional work<sup>98</sup>.

The question of copyright protection for buildings and models for buildings presents a slightly different problem. The Copyright Act 1968 adopts a different approach from that of the Copyright Act 1956 of the United Kingdom and the Imperial Copyright Act, 1911. It was essential under the 1911 Act that an architectural work possessed "artistic character and design"<sup>99</sup>. However, in the Copyright Act 1956, while drawings and plans are protected "irrespective of artistic quality" these words are omitted with regard to works

97a. *Amp Incorporated v. Utilux Pty. Limited* [1970] R.P.C. 397, 405.

98. See e.g., *Con Planck, Ltd. v. Kolynos Inc.* [1925] 2 K.B. 804; *Pyram Ltd. v. Models (Leicester) Ltd.*, [1930] Ch. 639.

99. Copyright Act 1911 (1 and 2 Geo. 5, c.46) s.35(1).

of architecture<sup>100</sup>. The Australian Copyright Act 1968 departed from this principle and no artistic quality is required for copyright to subsist in buildings or models of buildings, a "building" being defined to include "a structure of any kind"<sup>101</sup>. It is thus clear that copyright can subsist not only in the plans and drawings of a building but in the building itself quite apart from its architectural excellence or aesthetic qualities.

In addition to the enumerated categories of artistic works the Copyright Act 1968, s.10, includes within "artistic works" works of artistic craftsmanship generally, and such works were also included in the Copyright Act 1911<sup>102</sup>. However, in the case of works of artistic craftsmanship there is no provision to the effect that copyright subsists in such a work whether the work is of artistic quality or not. This would seem to provide an obvious distinction between artistic works falling into this category and designs, as it is quite clear that a design need not possess any artistic merit<sup>103</sup>, but the task of making a distinction among artistic works on any aesthetic principle becomes increasingly difficult and it is simply not possible to make clear division between works of art and works of utility; the two are not logically separable categories. There are two aspects of the problem, the extent of copyright protection to works of craftsmanship not necessarily purely "artistic" in the sense of being of the fine arts, that is, how "artistic" must such works be, and on the other hand, the applicability of works of artistic craftsmanship as designs and the possibility of obtaining design registration for them.

It might be thought that the words "works of artistic craftsmanship" would cover a high proportion of industrial designs but the courts have experienced considerable difficulty in reaching any clear view as to the meaning of "artistic"<sup>104</sup>. Under the Copyright Act 1911 it had been argued<sup>105</sup> that as no criterion of "literary" merit was applied in the case of literary works, protection being given to such works as examination papers<sup>106</sup>, a Football League fixture list<sup>107</sup> and a railway timetable<sup>108</sup>, it was not necessary that an artistic work should have any special artistic merit; the word referred to the method of creation of the work not to its aesthetic merit. However, whereas the Copy-

100. Copyright Act 1956 (4 and 5 Eliz. 2, c.74) s.31(1) (a) (b).

101. S.10.

102. Copyright Act 1911 (1 and 2 Geo. 5, c.46) s.35(1).

103. *Walker Hunter & Co. v. Falkirk Iron Co.* (1887) 4 R.P.C. 391, *supra* n.94.

104. Compare the broad interpretation given by the Copyright Office in the United States to "works of artistic craftsmanship" 37 F.R. s.202.10(a), "statuettes, book-ends, clocks, lamps, door knockers, candlesticks, inkstands, chandeliers, piggy banks, sandals, salt and pepper shakers, fish bowls, casseroles and ash trays" have been copyrighted. See *Mazer v. Stein* 347 U.S. 201, 221 (1954), 74 S. Ct. 460, 472 (1954); see also *Boucher v. Du Boyes, Inc.* 253 F. 2d. 948 (2d. Cir. 1958); and the comments of Clark J. in *Vacheron and Constantin-Le Coultre Watches Co., Inc. v. Benrus Watch Co., Inc.*, 260 F. 2d. 637, 644 (2d. Cir. 1958).

105. Copinger and Skone James, *supra* n.24 at 63-66, 73-74; The Report of the Committee on the Law of Copyright (the Gregory Committee) (U.K.) Cmd. 8662, 93-94, para 235.

106. *University of London Press, Ltd. v. University Tutorial Press, Ltd.* [1916] 2 Ch. 601 ("In my view the words 'Literary work' cover work which is expressed in print or writing, irrespective of the question whether the quality or style is high", Peterson J. at 608).

107. *Football League, Ltd. v. Littlewoods Pools, Ltd.* [1959] Ch. 637.

right Acts of 1956 and 1968 have made it clear that certain artistic works are protected irrespective of artistic quality, there is no similar provision with regard to works of artistic craftsmanship. The Gregory Committee<sup>109</sup> stressed that owing to the enormous range of works within the category of works of "artistic craftsmanship", including the work of craftsmen working in many media such as "silversmiths, potters, woodworkers and hand-embroiderers", it was not practicable to draft a statutory definition equally applicable to the large range of activities and the varieties of the materials used.

But the question remains whether an aesthetic test is to be applied or whether "artistic" is merely a generic term in its application to works of craftsmanship. In *Burke and Margot Burke, Ltd. v. Spicer Dress Designs*<sup>110</sup> Clauson J. seems to find some difficulty in regarding a dress as a work of artistic craftsmanship. Mrs. Burke was the author of a sketch showing a frock worn upon a lady and the plaintiff company made a lady's frock by copying the sketch with the consent of Mrs. Burke. The defendant copied the frock and sold reproductions and Mrs. Burke and Margot Burke Ltd. alleged infringement firstly of Mrs. Burke's copyright in her sketch and secondly of the copyright of the plaintiff company in the frock. With regard to copyright in the frock<sup>111</sup>, the learned Judge based his decision on the fact that Mrs. Burke was only the author of the sketch and did not make the frock. Accordingly, whereas the frock could be regarded as a work of craftsmanship, it could not be regarded as a work of artistic craftsmanship because the artistic element did not originate in those who made the work<sup>112</sup>. This conclusion disposed of the case but Clauson J. added some remarks as to the meaning of "artistic" and quoted the Oxford English Dictionary definition of "artistic" as that which pertains to an artist, an artist being defined as "one who cultivates one of the fine arts in which the object is mainly to gratify the aesthetic emotions by perfection of execution whether in creation or representation"<sup>113</sup>. The question of whether a frock gratifies the aesthetic sensibilities is an impossible question for a court to answer; what the learned Judge is really saying is that the frock is too utilitarian for copyright protection. But the comments were purely dicta and Lord Wright in a subsequent case in the House of Lords was prepared to accept the fact that no high artistic merit was necessary in the case of artistic copyright<sup>114</sup>. Moreover the Gregory Committee were of the opinion that a dress need not necessarily be excluded from the scope of the term "works of artistic craftsmanship" even after the *Margot Burke* case<sup>115</sup>. Thus artistic merit in an objective sense may not be the test (and in fact would be an impossible test); it seems that there need only be, at the least, some skill and artistry originating in the person who makes the work. The question was discussed at length

108. *Blacklock (H) and Co. Ltd. v. Arthur Pearson (C) Ltd.* [1915] 2 Ch. 376.

109. The Report of the Gregory Committee, *supra* n.105, para. 260.

110. [1936] Ch. 400.

111. Important aspects of the case relate to the subsistence of copyright in the sketch itself, infringement by reproduction in the form of a made-up frock and the possibility of the registration of the sketch as a design.

112. [1936] Ch. 400, 408.

113. *Id.*, 408.

114. *King Features Syndicate Inc. v. O. & M. Kleeman, Ltd.* [1941] A.C. 417, 439.

115. Report of the Gregory Committee 96, *supra* n.105, para. 261. .

by Pape J. in a recent decision of the Supreme Court of Victoria<sup>116</sup> where he regarded the word "artistic" as requiring that the craftsman, in making the article, should apply his skill and taste to its production "with the main object of creating an article which, even if it be utilitarian, nevertheless will have a substantial appeal to the aesthetic tastes of those who observe it . . . the emphasis is thus upon the object of the author in creating the work, rather than on the reaction of the viewer to the completed work, for it is common place in copyright law that it is immaterial whether the work has any merit"<sup>117</sup>. Pape J. went on to explain that, although as a general rule a court will apply a purely objective test, the object of the creator must be an important determining factor should the objective test be thought to deny that the work is one of artistic craftsmanship<sup>118</sup>.

It seems inevitable that the courts will be drawn into a judgment of taste or aesthetics as long as "artistic" is regarded as connoting more than the application of the original skill of the author or maker<sup>119</sup>, but for the purpose of the present discussion it is essential to note that it is immaterial that the work be functional or utilitarian provided that there is some skill and originality in its execution<sup>120</sup>. Thus a large variety of works registrable as designs would also be works of "artistic craftsmanship" and the reverse is, of course, equally true. However, the attempt to apply aesthetic criteria in determining whether a work of craftsmanship is "artistic" will continue to work hardship on the industrial designer or artist in denying him copyright protection for his labours. Under the present provisions of the Copyright Act 1968<sup>121</sup> he will, of course, lose copyright protection upon commercial exploitation. But if it considered that these provisions should be repealed and that the existence of the Designs Act 1906-1968 is itself in urgent need of review, it will be necessary at the same time to review the definition of "artistic work" in s.10 of the Copyright Act 1968, and make it clear that a work of "artistic craftsmanship" need not possess artistic quality but only the application of original skill to receive the protection of the Act.

#### IV. Novelty or Originality?

The fact that a work lacks novelty or inventiveness or that it involves features which are common in the trade is immaterial under the Copyright Acts, or more specifically, there is no consideration of novelty in copyright to the extent that it is only relevant to put in evidence earlier works for the purpose of showing that they are the same or approximately the same as the

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116. *Cuisenaire v. Reed* [1963] V.R. 719.

117. *Id.*, at 730.

118. *Id.*, at 730.

119. See, e.g., *Hay and Hay Construction Co. Ltd. v. Sloan*, 12 D.L.R. (2d.) 397, 401-402.

120. Compare the position in the U.S.A. where the Regulations of the Copyright Office (37 F.R. s.202.10(c)) provide:

"If the sole intrinsic function of an article is its utility the fact that the article is unique and attractively shaped will not qualify it as a work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration."

121. See n.3 *supra*, and accompanying text.

work whose originality is being questioned to prove that the author copies the former work<sup>122</sup>. Copyright can subsist in a work provided that it is the original expression of thought of its creator who did not copy it<sup>123</sup>, but the difficult question is how much "originality" is needed. Although protection is given only to the author's particular form of expression and not to his ideas<sup>124</sup>, there must also be some skill of labour or mental operation in execution of the work however minimal<sup>125</sup>. Section 17 of the Designs Act 1906-1968 provides that a design must be "new or original" and must also be a design "which has not been published in Australia before the lodging of an application for its registration". There must, as a result, be some comparison with prior art, but the standard is not one of invention. There must be the exercise of intellectual activity so as to originate, that is to say suggest for the first time, something which had not occurred to anyone before as to applying by some manual, mechanical, or chemical means some pattern, shape, or ornament to some special subject matter to which it had not been applied before<sup>126</sup>. Although the design need not be new and original<sup>127</sup> opinions differ as to whether "new" refers to cases where the shape or pattern is completely new in itself and "original" to cases where the shape or pattern, though old in itself, is new in its application to the article in question<sup>128</sup>, but however one chooses to define these terms the courts will normally look for some clearly marked difference between that which is to be registered and that which has gone before. Thus, whether it be a design for a bathing costume<sup>129</sup>, a toilet pan<sup>130</sup> or a chair<sup>131</sup>, the court will look to the distinctiveness of the design in its departure from prior models in its application to the particular article in question, but the judgment is made by the eye<sup>132</sup> and no inventive genius is

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122. *Fred Fisher, Inc. v. Dillingham* 298 F. 2d. 145 (S.D.N.Y. 1924).
123. See, e.g., *Kilvington Bros. Ltd. v. Goldberg* (1957) 8 D.L.R. (2d.) 768; *Alfred Bell & Co. Ltd. v. Catalda Fine Arts Inc.*, 74 F. Supp. 973 (S.D.N.Y. 1947).
124. See, e.g., *Blackie & Sons Ltd. v. The Lothian Book Publishing Co. Pty. Ltd.* (1921) 29 C.L.R. 396, 400; *University of London Press Ltd. v. University Tutorial Press, Ltd.* [1916] 2 Ch. 601, 608.
125. *Macmillan & Co. Ltd. v. K. & J. Cooper* (1923) 93 L.J.P.C. 113; *G. A. Cramp & Son, Ltd. v. Smythson (Frank) Ltd.* [1944] A.C. 329, [1944] 2 All E.R. 92; *Inala Industries Pty. Ltd. and others v. Associated Enterprises Pty. Ltd.* [1960] Qd. R. 562, 570; *Sands & McDougall Pty. Ltd. v. Robinson* (1917) 23 C.L.R. 49; *Blackie & Sons Ltd. v. The Lothian Book Publishing Co. Pty. Ltd.*, *supra* n.124.
126. *Dover Ltd. v. Nürnberger Celluloidwaren Fabrick Gebrüder Wolff* [1910] 2 Ch. 25, 29; *Macrae Knitting Mills Ltd. v. Lowes Ltd.* (1936) 55 C.L.R. 725, 730.
127. *Le May v. Welch* (1885) 28 Ch. D. 24, 34; *Sherwood & Cotton v. Decoration Art Tile Co.* (1896) 13 R.P.C. 351; *Dean's Rag Book Co. Ltd. v. Pomerantz and others* (1930) 47 R.P.C. 485, 490.
128. *Dover Ltd. v. Nürnberger Celluloidwaren Fabrick Gebrüder Wolff* [1910] 2 Ch. 25, 29, 32. Note that under the Australian Designs Act 1906-1969 and the English Designs legislation prior to the Registered Designs Act 1949 designs were registered as being applicable to articles in prescribed classifications and the question of novelty or originality was discussed in this context. See *Stenor, Ltd. v. Whitesides (Clitheroe) Ltd.* (1948) 65 R.P.C. 81.
129. *Macrae Knitting Mills Ltd. v. Lowes Ltd.* (1936) 55 C.L.R. 725.
130. *Malleys Ltd. v. J. W. Tomlin Pty. Ltd.* (1961) 35 A.L.J.R. 352.
131. *D. Sebel & Co. Ltd. v. National Art Metal Co. Pty. Ltd.* (1965) 10 F.L.R. 224.
132. See, e.g., *Pugh v. Riley Cycle Co. Ltd.* (1912) 29 R.P.C. 196; *Wells v. Attache Case Manufacturing Co., Ltd.* (1932) 49 R.P.C. 113, 118; *In Re Wolanski's Registered Design* (1953) 88 C.L.R. 278, 280-281; *D. Sebel & Co. Ltd. v. National Art Metal Co. Pty. Ltd.* (1965) 10 F.L.R. 224.

required. This must follow if Buckley L.J.'s definition of "original"<sup>133</sup> is accepted and novelty or originality may consist in the application of an old design to a new article.

It thus becomes a very difficult question to determine just how much ingenuity is required to satisfy the registration requirements of the Designs Act 1906-1968<sup>134</sup> and works may be excluded from registration while being sufficiently "original" for the purposes of the Copyright Act 1968. However, we have seen the manner in which copyright in a work may be lost by mass manufacture and, as a result, the necessity of effecting a design registration to gain any statutory protection. But the novelty requirements of the Designs Act 1906-1968 may preclude such registration, so that the artist or designer is left without any statutory protection at all.

The Designs Act 1906-1968, s.17A, attempts to mitigate somewhat the harshness of this result, but the fact remains that there are many designs either not registrable at all because they are not new or because there has been mass manufacture and commercial exploitation prior to the registration application. In addition the requirement that the design be new encourages ornamental elaboration so that what can be seen will be "a substantial difference from the fundamental form and from the development in the trade up to the time of the application for registration"<sup>135</sup>. If a copyright approach to the protection of machine art is adopted all original work, whether it be previously published or not, would be protected equally, and it is submitted that originality should be the only test for such art.

There remains, however, the question of how best to dispose of the purely functional design, the scaffolding clamp, gutter joint or electrical terminal. It is suggested that an examination of the utility model system may suggest a new approach.

### V. Utility Models

The utility model, or "petty patent" as it is sometimes called, is unknown to Australian and English law, but it is recognized in a number of foreign countries including Germany and Japan, and it is expressly recognised in Article 1 of The Paris Convention for the Protection of Industrial Property, 1883.

The utility model law (Gebrauchsmuster Act) enacted by the German Federal Republic in 1967 defines a utility model as follows<sup>136</sup>:

- s.1(1) "Tools and other functional articles or parts thereof shall be protected by Gebrauchsmuster registrations in accordance with this Act if they serve their use as tools or their functional purpose by having a new shape, or arrangement, or by constituting a new device".

133. *Dover Ltd. v. Nürnberger Celluloidwaren Fabrick Gebrüder Wolff* [1910] 2 Ch. 25, 29.

134. See the discussion in *D. Sebel & Co. Ltd. v. National Art Metal Co. Pty. Ltd.* (1965) 10 F.L.R. 224, 226-227.

135. *Id.*

136. Gebrauchsmuster Act, Text of January 2, 1968, s.1 (1), reprinted in Patent Act, Trade Mark Act, Gebrauchsmuster Act of the Federal Republic of Germany, Vossins & Jung, Wila, 1968.

In Japan the current Utility Model Law<sup>137</sup> provides, in Article 1, that “the purpose of this Law is, by promoting the protection and utilization of a device relating to shape, structure or assemblage of any article, to stimulate such device and thereby to contribute to the development of industry”. A “device” is defined in Article 2 as “the creation of technical idea made by the use of natural rules”. In contrast the Design Law<sup>138</sup> indicates that the distinguishing feature of a design is that it is a shape, pattern or colour which gives a sense of beauty through sight<sup>139</sup>. Thus the utility model law gives protection to the creation of a useful idea whereas design registration protects a design distinctive in the visual sense. Utility model registration is similar to a patent in that it protects an invention but an invention of lower grade inventiveness<sup>140</sup>. The subject matter of a utility model registration must be a new device, or article such as a product or an apparatus, and articles which cannot be patented may be the subject of utility model registration if they are of practical utility in shape, construction or combination of articles<sup>141</sup>. There is a novelty examination similar to that in patent applications<sup>142</sup> although this is not a feature of the German system (which has only a novelty requirement). The term of a utility model is shorter than that of a patent. In Japan it is ten years from publication<sup>143</sup> whereas in Germany the term is six years from the day following the application date, subject to payment of a renewal fee at the end of the third year<sup>144</sup>.

The rights given upon registration are similar to those given by a patent. Thus in Japan the owner of a utility model has the exclusive right to manufacture, use, transfer, lease, exhibit for transferring or leasing, or import, as a business, articles under his registered utility model<sup>145</sup>.

The importance of the utility model is that it provides a bridge between copyright and patent by giving protection to those purely functional articles of utility which cannot in any way be regarded as products of the industrial arts and which, on the other hand, do not have sufficient inventive subject matter for a patent grant. The extension of protection under the Copyright Act 1968 to such articles would not be appropriate as the protection sought is in fact for an invention or a new idea useful to industry for which a modified form of patent protection is more appropriate<sup>146</sup>. It is one of the principal difficulties of the present Designs Act 1906-1968 that it encompasses both distinctive visual designs and also designs which are merely intended to achieve a functional purpose, or small inventions. Difficulties have of course arisen

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137. Law No. 123 of 1959. English text reprinted in Japanese Law 6 E.H.S. No. 6870A (Japan 1968). Amended May 13 1970.

138. Law No. 125 of 1959. English text reprinted in Japanese Law, 6 E.H.S., No. 6875A (Japan 1965).

139. *Id.*, Article 2.

140. Japan, Utility Model Law, Art. 3(2).

141. Japan, Utility Model Law, Art. 3. Germany, Gebrauchsmuster Act, s.1.

142. Utility Model Law, Articles 3, 10, 11.

143. Utility Model Law, Art. 15.

144. Gebrauchsmuster Act, s.14.

145. Utility Model Law, Art. 16.

146. It is almost a cliché of copyright Law that copyright gives protection to expression not ideas, see n.177 *infra*.

in the latter category because so often shape is dictated by function and the courts have held that such designs are not registrable<sup>147</sup>. However, in many designs it is the function rather than the appearance which is relevant and the design registration is sought because no other protection is available. Certainly in determining whether a work or design is entitled to copyright protection under the Copyright Act 1968 it should not be material that it was created for a useful purpose and exploited industrially. The point made is that this protection may be inadequate for the functional article, the technical "idea" co-existing with the new form. The concept of the utility model is described by the German "Raumform", (distinguishable form), that is the inventive distinction of the subject matter must be perceivable by the senses, and is usually a change in the shape of the device<sup>148</sup>.

The Johnston Committee considered functional designs and utility models and expressed the view that a system of utility model protection would remove from the designs register a substantial number of designs only registered because there is no other protection<sup>149</sup>. The Committee referred to "designs we have seen for such articles as a wheel carrying bracket for attachment to a bicycle, a reinforcing plate for use on lids of boxes, a former for use in forming a cavity in concrete, and a device for securing sheet material to T-section flanges"<sup>150</sup>. In these cases it is not the visual aspect of the design which is important to its creator.

However the distinctions between the utility model and the patent must be carefully emphasized. The utility model law will protect form with an industrial purpose defined by claims filed with a description and illustration or facsimile of the model<sup>151</sup>. As in the case of the German Gebrauchsmuster there will be a novelty requirement<sup>152</sup>. Thus far it is only the requirement of novelty which is similar to requirements for grant of a patent under the Patents Act 1952-1969<sup>153</sup>. However, the clearest distinctions must be made with regard to the requirements of inventive subject matter. Technical progress is not sufficient for the grant of a valid patent. The invention must not be "obvious"<sup>154</sup> and in determining obviousness it has been said that s.100(1)(e) of the Patents Act 1952-1969 "has made all information which was available in Australia, however recondite and esoteric, of the same importance as matters of common general knowledge when judging the obviousness of an alleged invention"<sup>155</sup>. Such a requirement makes no sense for the utility model or

147. See Part 2, *supra*.

148. See generally, K. M. Mott, "The Concept of Small Patent in European Legal Systems and Equivalent Protection under United States Law," 49 Va. L. Rev. 232.

149. Report of the Departmental Committee on Industrial Designs 1962, Cmd. 1808, para. 164.

150. *Id.*

151. Gebrauchsmuster Act, s.2(1), 2(2), and 2(3).

152. *Id.*, s.1(2).

153. Section 48(3) (d) and (e).

154. Sections 59(1) (g), 100(1) (e).

155. *Sunbeam Corporation v. Morphy-Richards (Aust.) Pty. Ltd.* (1961) 35 A.L.J.R. 212, 218, per Windeyer J. who found "some difficulty" in the proposition. See *H. P. M. Industries Pty. Ltd. v. Gerard Industries Ltd.* (1957) 98 C.L.R. 424; *John McIlwraith Industries Ltd. v. Phillips* (1958) 98 C.L.R. 529; and the comments of Dixon J. in *Acme Bedspread Co. Ltd. v. Newlands Bros. Ltd.* (1937) 58 C.L.R. 689, 707-708.

Gebrauchsmuster where the protectable subject matter is the quality of "Raumform" which is new. The protection given by the Gebrauchsmuster is to the "idea", but is limited by or dependent upon the external form which in turn serves utilization or functional purpose.

The anomalous position of machine art and functional designs can now be more clearly seen. Those works of machine art which are also considered to be works of "artistic craftsmanship" will lose all copyright protection within the field of their industrial exploitation upon mass production, and statutory protection, if it is to be had at all, must be sought by registration under the Designs Act 1906-1968 with its requirement of novelty, its shorter term of protection and a definition of "design" which is in many respects completely out of touch with modern conceptions of design and the relation of art and craft. The industrial artist is thus deprived of his copyright in circumstances where the writer or musician is not similarly deprived. In addition, many of the industrial arts, to the extent that they are considered not to be "artistic" works, will be completely outside the scope of the Copyright Act. The purely functional article, where shape or design serves function alone, will be protected by neither copyright nor design law, although design registration is often sought as the only possible protection, thus leading to fine distinctions between design and function. The patent law will be of little avail to the industrial designer as the stringent requirements of novelty and inventive subject matter will exclude most functional design where the inventive step shows little advance over prior art but where there is undoubted technical progress.

It is submitted that it is most undesirable to maintain the principle of retaining an arbitrary dividing line between works capable of registration under the Designs Acts and other artistic works protected by the Copyright Acts. The difficulty of giving any clear meaning to many of the statutory definitions and the conceptual nature of the problem results in uncertainty of operation of the statutory exclusions with the possibility of a considerable loss of the artist's and artisan's rights. And yet it is only to artistic works that this artificial line of demarcation is applied. Copyright is conferred on literary works whatever their utility<sup>156</sup> and protection has been given to such compilations as a directory, a list of Stock Exchange prices, a railway guide and a football fixture list<sup>157</sup>. In addition, copyright protection is now given to television and sound broadcasts<sup>158</sup> however serious or trivial. As far as exploitation of the economic potential of the work is concerned we do not question the right of the copyright owner to exploit dramatic and musical works by reproducing them in the form of records and films, but if the creator of a cartoon character such as "Peanuts" applies his design to articles of manufacture there is the immediate danger of loss of artistic copyright over an enormous area<sup>159</sup>.

156. Under the Copyright Act 1968 (Cth.) s.10, "literary work" includes a written table or compilation.

157. See Copinger and Skone James, *supra* n.91 at 55, and the cases there cited.

158. Copyright Act 1968 (Cth.) ss.86 and 87.

159. The following statement from "The Observer" London, Jan. 26, 1969, 38, col. 4, indicates the scale of industry. "Peanuts" is the world's widest read cartoon strip, appearing in countries from Iran to Korea, and Samoa to Vietnam. In America, the Peanuts merchandising campaign does 20 million dollars worth of business a year, and this year a similar campaign is being launched here. The most

Why should the artist be placed in this position? The answer must be that a design applied to an article having independent utility is essentially different from an artistic work which exists in its own right. But the distinction is not logically maintainable. Even if one were to accept an aesthetic principle for defining "artistic works" a work does not become any less "artistic" because it is applied in the manufacture of articles of utility<sup>160</sup>. Nor is "art" depreciated as a result of industrial mass production<sup>161</sup>.

The New Zealand Copyright Committee<sup>162</sup> were firmly of the opinion that all artistic works should be equally protected by the copyright law and all the evidence heard by the Committee from industrial and commercial interest supported this view. In addition, and quite apart from any argument as to the artistic merit of the work, it is in many industries a practical and financial impossibility to register all the designs that may be produced<sup>163</sup>. Similarly in the United States recent Designs Bills before Congress recognise the principle of totality of copyright<sup>164</sup>.

It is not, of course, an answer to the problems which have been presented merely to bring machine art fully within the scope of the protection given by the Copyright Acts. The difficulty in characterizing a separate class of industrial "designs" as distinct from "artistic works" and minor inventions suggests the question of whether designs as a separate form of industrial property should be abandoned altogether<sup>165</sup>. The concepts of novelty and a monopoly which gives a right to sue for infringement even where there has been no copying by the defendant are not appropriate for many of those designs closely related

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astounding number of objects bearing the Peanuts cartoon characters is being sold in America: bridge tallies, sleeping bags, curler caddies, doorknob caddies, lunch kits, tea-sets and wall hangings. The syndicate which handles Peanuts turns down 29 out of 30 applications for a licence to use the Peanuts character."

160. Cf. *Jones Bros. Co. v. Underkoffler* 16 F. Supp. 729 (M.D. Pa. 1936) ("... a certain object may be an article of manufacture as well as a work of art and a design therefore might well come under the Design Patent Law for an article of manufacture or under the Copyright Act as a design for a work of art."); *De Jonge & Co. v. Breuker Kessler Co.* 181 Fed. 150 (E.D. Pa. 1910); *Mazer v. Stein* 347 U.S. 201 (1954).
161. See F. E. Skone James, "Some Proposed Changes in the Copyright Law" (1955), 33 Can. B. Rev. 877, 894-897; Harold G. Fox Q.C., "Copyright and Industrial Designs in Canada" (1958), 5 Bull. Cr. Soc. 117, 136-137; Canada, Royal Commission on Patents, Copyright, Trade Marks and Industrial Designs, Report on Industrial Designs, Ottawa 1957, 15-16.
162. Report of the Copyright Committee, New Zealand, 1959, paras. 302-310.
163. This argument was put to the New Zealand Copyright Committee by the Pottery and Glassware Agents Association, *id.*, at 116, but it is also extremely relevant in the case of Walt Disney and comic strip characters. See The Johnston Committee Report, n.149 *supra*, 94-95, where the question is discussed.
164. 347 U.S. 201 (1954); and see the Hearings before the Subcommittee on Patents, Trade Marks, and Copyrights of the Senate Committee on the Judiciary on s.1237, 89th Congress, First Session (1965): Copyright Law Revision Bill s.13, s.597, 90th Congress, First Session, (1967); Report of the House Committee on the Judiciary on H.R. 2512, No. 83, 90th Congress, First Session, 63-64 (1967). Argentina has also recently adopted a new design law permitting dual protection, see 5 Industrial Property, No. 1 Jan. 1966, 12-15.
165. The Canadian Royal Commission considered whether industrial designs should be protected at all and concluded that the only certain justification for design protection legislation was on the ground of fairness. See Canada, Royal Commission on Patents, Copyright, Trade Marks and Industrial Designs, Report on Industrial Designs, 10-11 (1957).

to "artistic works" within the Copyright Acts. For such designs there seems to be little need of a government reward to accelerate the rate of technological innovation, and little need for a grant of monopoly as the price to be paid by the State for the public disclosure of a useful new idea<sup>166</sup>. But for those designs which do show useful new ideas of minor inventiveness, the utility model system could provide the necessary bounty.

The root of the present confusion lies in history—in the development of the law on a completely *ad hoc* basis, and in the formulation of basic definitions in the first half of the nineteenth century when the conception of design was essentially that of utility and ornamentation. Thus the Designs Acts favour ornament and elaboration. The design is "applied" to an article, the test is by the eye, novelty is required. It is extremely difficult for the good modern design with originality, but not novelty, possibly expressive of function but with fitness in relation to its materials and techniques, to pass the test imposed by the Designs Acts<sup>167</sup>. The position is summarized by Sir Herbert Read<sup>168</sup>:

"It is only the general confusion between art and ornament, and the general inability to see the distinction between humanistic and abstract art and the further difference between rational abstraction and intuitional abstraction, that prevents us regarding many of the existing products of the machine age as works of art, and further prevents us from conceiving the endless possibilities inherent in machine art".

Many of these difficulties would be solved by the adoption of a copyright system for industrial design with the result that copying of the work in its original features would constitute infringement and there would be no requirement of novelty in the sense of prior publication. It would also be possible to rationalize the concept of "design" as there would be no necessity of abstracting certain "features" for the purpose of defining the terms of the monopoly grant. In addition, all artistic works whatever their field of application should be protected under copyright law on the same basis. The Designs Acts have failed to give adequate protection in practice<sup>169</sup> and the effect of the present law is in many cases to deny to the artist and to the designer the proper economic return for their skill and labour.

166. For a general discussion of this problem see Matthew Nimetz, "Design Protection" (1967), 15 A.S.C.A.P. Copyright L. Symp. 79.

167. Bowen, "Design Patents and Modern Industrial Designs" (1955), 37 J. Pat. Off. Soc'y 744; Roy Jackson, "A New Approach to Protection for the Designs of New Products" (1956), 38 J. Pat. Off. Soc'y 448.

168. Sir Herbert Read, *Art and Industry* 37, cited by Roy Jackson, *supra* n.167 at 452.

169. Out of 2296 applications for design registration in Australia in 1969 only 1440 were granted, see Industrial Property Statistics for the year 1969 (B.I.R.P.I.) 27. In the U.K. design applications have dropped from 32,745 in 1910 to 9,427 in 1961, see Johnston Committee Report, Appendix F. See also the comments of the New Zealand Copyright Committee, n.162 *supra*, para. 305.

It is interesting to note that many of the objections of the fashion industry to a copyright system are based on the assumption that fashion cannot exist without freedom to copy the trend of current design (see the Johnston Committee Report at 33) thus assuming the ineffectiveness of the present registration system to stop pirating. The claims of the fashion and retail trades have been much to the fore in the United States. See the Hearings of the Subcommittee of the Senate Committee on the Judiciary, *supra* n.164; 108 Women's Wear Daily No. 2, Jan. 3, 1961, 1 and 111; 114 Women's Wear Daily 20, No. 127, Jan. 30, 1967.

The Johnston Committee recommended the introduction of a copyright system for the protection of industrial designs to be called "Design Copyright"<sup>170</sup>, but also recommended the retention of the present registration system, with amendments, to be called "Design Monopoly"<sup>171</sup>. The Committee was also opposed to dual protection<sup>172</sup>. The Committee's recommendations thus favour the introduction of a further system of protection and not the extension to designs of the protection given by the Copyright Acts. Artificial distinctions between art and industry will be maintained and strengthened. The principal arguments advanced against allowing copyright protection to designs under the Copyright Acts are that there is no registration and that the term of protection is inappropriate, that long term protection under copyright for art which is primarily utilitarian and mass produced will have a far greater impact on the consuming public than similar protection in the realm of the fine arts<sup>173</sup>. However, many objections to the extension of copyright protection under the Copyright Acts to designs seem to be based on misconceptions as to the nature of copyright. Firstly, copyright in the case of a literary or artistic work is the exclusive right, *inter alia*, to reproduce the work in a material form<sup>174</sup>; it is a right to prevent the work being copied in relation to a substantial part of the work<sup>175</sup>. Secondly, for copyright to subsist in a work it must be original, not novel. Thus, there is no restraint at all on individual original work however much it may duplicate prior art<sup>176</sup>. Thirdly, copyright does not give protection to ideas but only to their form of expression<sup>177</sup>. Copyright protection would accordingly be limited to the visual form of the work. Thus, there is no suggestion that original work should be restricted and limited by prior art or by monopolies in "ideas". On the contrary, there is no such limitation at all; it is copying and plagiarism which would be prevented. Provided there is originality of authorship prior works may be repeated.

The Canadian Royal Commission on Industrial Designs has reported the results of a questionnaire sent by The National Industrial Design Council of Canada to a number of companies to elicit their opinions on whether they needed design registration and how they obtained protection of their designs<sup>178</sup>. It is interesting to note that most of the companies replying that they produced original designs (49 of 54 companies answering the questionnaire) replied "Yes" to the following question:

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170. The Johnston Committee Report, n.149 *supra*, para. 47; and see the discussion by the writer (1969), 45 A.L.J. 139, 147, n.4 *supra*.
171. The Johnston Committee Report, para. 49.
172. *Id.*, para. 145.
173. *Id.*, 25-30.
174. Copyright Act 1968, ss.31(a) (i) and 31(1) (b) (i).
175. Copyright Act 1968, s.14(1); *Francis Day & Hunter Ltd. v. Bron* [1963] Ch. 587.
176. Copyright Act 1968, s.32; and see the well known illustration of the distinction in *Fred Fisher Inc. v. Dillingham* 298 F. 2d. 145 (S.D.N.Y. 1924).
177. See, e.g., *Baker v. Selden* (1879) 101 U.S. 99; *Kenrick & Co. v. Lawrence & Co.* (1890) 25 Q.B.D. 99. This statement is an over-simplification of a difficult problem, but it is not necessary to examine the question further for the present discussion.
178. Canada, Royal Commission on Patents, Copyright, Trade Marks & Industrial Designs, Report on Industrial Designs, 11-12 (1957).

“If a different kind of design registration was available that would prevent others from *copying* any of the original features of your new products (not merely features of outer appearance or ornamentation), would you like to see such protection available to you and your competitors? Remember that such design protection, unlike a patent, would not prevent another designer from *independently creating* a similar article”<sup>179</sup>.

Surely the time has arrived when developments in the field of art, craftsmanship and the implications of mass production, such as the German Bauhaus movement in the early decades of this century which showed that art, utility and function are not incompatible, should be taken into account in the law of copyright. The nineteenth century class distinction between artist and artisan, and its legacy, the separation between artistic works and designs, makes little sense when we accept the aesthetics of industry and the products of the machine as a valid artistic study. The United Kingdom is proceeding in a desultory manner with reform in this area, and there is now a limited copyright protection for industrial designs<sup>180</sup>, but little attention has been given to the wider implications of the Johnston Committee Report and the place of industrial and functional machine art in industrial property law. Let us hope for some more radical surgery in this country.

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179. *Id.*

180. Design Copyright Act 1968, c.68. (The result of a private member's Bill).