Introduction to the *Research Handbook on Design Law*

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Whether or not designs form part of a ‘great conundrum’,¹ their protection is becoming more and more important, particularly on a global scale. Be it German functionalism (‘Bauhaus’),² French ‘Art Déco’,³ Italian ‘Radical Design’⁴ or Scandinavian ‘Minimalism’,⁵ the concept of design, then and now, may range from ‘form follows function’ (common in design theory and practice)⁶ to ‘anything goes’;⁷ design law, likewise, wanders between antipodes, lying at the intersection of practical yet functional demands and the sphere of expression and art – or, legally speaking, at the crossroads of utility patents, copyright law and branding.

New products continue to fascinate both experts and consumers with their innovative designs – and simultaneously to attract copies from near and far. International companies, therefore, seek to secure corresponding design protection worldwide, or at least in the major economies. Designs have become valuable business assets and, thus, effective legal protection of designs is needed on a worldwide scale.

Given that substantive requirements of international design protection are not harmonised⁸ (in terms of both establishment⁹ and enforcement of such rights, often in a multinational scenario¹⁰), exchange of knowledge and search for consent beyond purely formal alignment of standards seem to be more urgent than ever before. This task includes aspects such as the relation between validity and scope of protection¹¹ – that is, whether,

¹ JEREMY PHILLIPS, *The great design conundrum* [2011] JIPLP 507.

² Cf. MAGDALENA DROSTE, *Bauhaus: 1919–1933* (Taschen 2019).

³ Cf. BRIDGET ELLIOT/MICHAEL WINDOVER (ed.), *The Routledge Companion to Art Deco* (Routledge 2019); NORBERT WOLF, *Art déco* (Prestel 2013).

⁴ E.g., MARIA CRISTINA DIDERO, *SuperDesign: Italian Radical Design 1965–75* (Monacelli 2017).

⁵ CHARLOTTE FIELL/PETER FIELL, *Scandinavian Design* (Taschen 2002).

⁶ Following LOUIS H. SULLIVAN, *The Tall Office Building Artistically Considered*, Lippincott’s Magazine (March 1896) 403, 408: ‘It is the pervading law of all things organic and inorganic, of all things physical and metaphysical, of all things human and all things superhuman, of all true manifestations of the head, of the heart, of the soul, that the life is recognizable in its expression, that form ever follows function. *This is the law.*’ (original emphasis)

⁷ For STEFAN WEWERKA, a leading representative of post-modern ‘deconstruction’, see <https://www.tecta.de/en/gestalter/stefan-wewerka/> (accessed 31 July 2020).

⁸ BERNARD VOLKEN, *Requirements for Design Protection: Global Commonalities* (Chapter 1).

⁹ ESTELLE DERCLAYE, *Protection of Designs on the Basis of Use* (Chapter 7).

¹⁰ ANNETTE KUR, *Enforcing Design Rights throughout Europe* (Chapter 9).

¹¹ HENNING HARTWIG, *Reciprocity in European Design Law* (Chapter 4). See already HECTOR T. FENTON, *The Law of Patents for Designs* (William J. Campbell 1889) 18: ‘It is seen therefore that the same test of identity, applied to determine the issue of infringement, as laid down by the Supreme Court in *Gorham v White*, is to be applied to determine the issue of patentable novelty, where the court is called upon to consider that question in view of evidence of the state of the art, or more properly of prior designs of the same genus, class or character.’

for instance, formal, sometimes even mandatory requirements such as the indication or title of a product (or a written description or disclaimer) may affect the scope of protection of the claimed design. Likewise, issues such as standards of evidence (such as expert opinion, consumer surveys, relevance of design awards, press echo, and so on), priority claims¹² or functionality¹³ become more and more important.

Be there different schemes of design protection when looking at jurisdictions such as the United States,¹⁴ the European Union¹⁵ or elsewhere; be there more differences than consistencies in applying standards for testing validity and infringement of a design (and the right order to do so) – one thing should be beyond doubt: design law presents the challenge of using words to describe what is perceived by the human eye. A thrilling car design, a striking new logo or even a graphical user interface¹⁶ – whatever first comes into existence by way of a creative intellectual process will later materialise in terms of sketches, drawings, writings and, often, a product. Interaction between what is described in words and what is perceived will then become relevant.¹⁷ How to construct a design patent claim? How to draft the mandatory list of goods when filing a 3D trade mark? How to find the appropriate language when assessing the scope of protection of a design? Day by day, the eye and the words interact constantly and almost automatically, in a flow trained and practised for decades: ‘it is usually very difficult to select any one feature of a design, a line, a flower, a curve, etc., and say, with any degree of certainty, what effect on the whole is produced by its presence or absence.’¹⁸

Creative minds seek to translate the world of thoughts and imagination into visual and written works. The legal process also endeavours to improve and optimise this process and its results – through the actions of courts and offices all over the world interpreting and applying legal rules, putting the results in words, with the aim of guaranteeing consistency and predictability, with the purpose of fostering ‘innovation and development of new products and investment in their production’.¹⁹ Still, when it comes to the interaction between the eye and the word, inconsistencies remain.

By way of example, we see the ongoing discussion on how to put into words the legal requirements around determining the overall impression produced by a product’s outer appearance (or a part of that product). Under U.S. design patent law, for instance, a trial court is not required to

provide a detailed verbal description of the claimed design, as is typically done in the case of utility patents (. . .) since (. . .) a design is better represented by an illustration than it could be by any description and a description would probably not be intelligible without the illustration.²⁰

¹² HENNING HARTWIG, *Claiming Priority under the Community Design Scheme* (Chapter 8).

¹³ JASON J. DU MONT/MARK D. JANIS, *Trends in Functionality Jurisprudence* (Chapter 2).

¹⁴ MARGARET POLSON, *Enablement and Indefiniteness in U.S. Design Patents after In re Maatita and Ex parte Kaufman* (Chapter 6).

¹⁵ HENNING HARTWIG, ‘*Mast-Jägermeister*’ before the Court of Justice of the EU: *What the Outcome Really Means* (Chapter 12).

¹⁶ TRACY-GENE G. DURKIN, *Design Protection for Graphical User Interfaces* (Chapter 11).

¹⁷ DAVID MUSKER, *Easier to See than to Say: Catching the Elusive Spirit of Design in a Net of Words* (Chapter 3).

¹⁸ HECTOR T. FENTON (n 11) 69.

¹⁹ Recital 7 Community Designs Regulation.

²⁰ *Egyptian Goddess v Swisa*, 543 F.3d 665, 679 (Fed. Cir. 2008) *en banc*.

Likewise, Lord Justice Jacob found that

the most important things in a case about registered designs are the registered design, the accused object and the prior art. And the most important thing about each of these is what they look like. Naturally, parties and judges have to try to put into words why they say a design has ‘individual character’ or what the ‘overall impression produced on an informed user’ is. But it takes longer to say than to see (. . .) and words themselves are often insufficiently precise on their own.²¹

Contrary to that, the Dusseldorf Appeal Court found that, when judging product imitation under unfair competition law, the features establishing ‘competitive individuality’ and appropriated in the accused design must be spelled out specifically in words in the court order.²²

While words often have multiple meanings and are necessarily open to interpretation, there is another complex challenge to be addressed – the finding of a same or different ‘overall impression’ produced by two different designs, consisting both of similar and dissimilar features. Various jurisdictions require such a finding, either when assessing validity or when assessing infringement. However, according to Justice Mann,

one of the problems with words is that it is hard to use them in this sphere in a way which avoids generalisation. But what matters is visual appearance, and that is not really about generalities. (. . .) it would be possible to articulate the differences in words, but the exercise is pointless, because the ability to define differences verbally does not necessarily mean that a different overall impression is given any more than a comparison of verbalised similarities means that the machines give the same overall impression.²³

Obviously, we need to learn how to read in a very precise way and sharpen our attention to the detail in what we see. Design law consciousness starts perhaps simply with listening deeper and looking harder, by becoming familiar with the eye-to-word and word-to-eye process, because ‘(. . .) while the exercise is a visual one, judgments have to be written and reasons necessarily expressed in words’.²⁴ Comparative studies *de lege lata* and *de lege ferenda* seem to promise a rich opportunity to confront different languages, approaches, solutions and results.²⁵ It is fascinating to see the potential of valid and reliable data that neuroscience-based consumer research technologies and methodologies might provide, particularly in preparing, handling and deciding design infringement proceedings and eventually answering the key question of whether or not two designs produce the same overall impression or are substantially the same.²⁶ Likewise, interaction between different

²¹ *Procter & Gamble v Reckitt Benckiser* [2007] EWCA Civ 936, para 3.

²² *Furniture*, Dusseldorf Appeal Court, 12 January 2010, I-20 U 155/09 [at 2 B].

²³ *Rolawn and another v Turfmech Machinery* [2008] EWHC 989, paras 125 *et seq.*

²⁴ *Samsung v Apple* [2012] EWHC 1882 (Pat), para 32.

²⁵ See, for instance, RAINER FILITZ/JOACHIM HENKEL/BRUCE S. TETHER, *Protecting aesthetic innovations? An exploration of the use of registered Community designs* [2015] Research Policy (44) 1192 *et seq.*; OLIVER CHURCH/ESTELLE DERCLAYE/GILLES STUPFLER, *An empirical analysis of the design case law of the EU Member States* [2019] IIC 685 *et seq.*; see also JEROME H. REICHMAN, *Design protection and the legislative agenda* [1992] Law and Contemporary Problems (55) 281 *et seq.*

²⁶ CHARLES L. MAURO/CHRISTOPHER D. MORLEY, *How Different Is Different? Modern Neuroscience and its Impact on Design Law* (Chapter 16).

national and international schemes appears to be helpful and necessary, with a significant impact on future filing and enforcement strategies.²⁷

Fortunately, various design laws and practices continue to develop²⁸ and further specialise,²⁹ with law makers and IP offices in places such as Australia³⁰ and the European Union³¹ increasingly seeking public views on proposals and feedback in order to improve the system of design protection, including regarding the impact of new technologies such as 3D printing on the biotope of IP rights.³² A constant challenge is the interaction between different IP rights for the same subject matter, which is most prominent in design law. Such overlaps – that is, different IP rights for the same object – most notably tend to happen in the areas of copyright³³ and trade marks.³⁴ As with every IP right, knowing who owns it is essential.³⁵ It is also important to reflect on how these exclusive rights impact on competition and what room is left for freedom.³⁶

Written to reflect recent changes and new trends, situated at the cutting edge of current design law research, this Research Handbook gathers the contributions of leading scholars and practitioners in their distinguished fields of expertise and addresses both practitioners and academics, providing global coverage while also considering specific jurisdictions and national laws.

The subjects covered consider practical interests and needs; the following 16 chapters

²⁷ ROBERT M. STUTZ, *International Design Law Policies: Present and Future* (Chapter 13).

²⁸ At the time of submitting the manuscript of this book, the United Kingdom was still treated as a Member of the European Union. Hence, the impact of so-called Brexit shall not be discussed hereafter. For details see TAWHIDA AHMED/ELAINE FAHEY, *On Brexit – Law, Justices and Injustices* (Edward Elgar Publishing 2019).

²⁹ It is welcome that the General Court of the European Union, within the third stage of the reform of the judicial structure of the European Union based on Regulation (EU, Euratom) 2015/2422 of the European Parliament and of the Council of 16 December 2015 amending Protocol No 3 on the Statute of the Court of Justice of the European Union, decided to create specialised Chambers, including six (of the total of ten) Chambers dealing with intellectual property matters: see ‘Criteria for the assignment of cases to Chambers’, OJ C 246, 2 (22 July 2019).

³⁰ See https://consultation.ipaustralia.gov.au/policy/design-reforms-implement-acip-recs/user_uploads/2020-05-08-ip_australia_response_to_public_consultation-2.pdf (accessed 31 July 2020).

³¹ See <https://ec.europa.eu/info/law/better-regulation/have-your-say/initiatives/1846-Evaluation-of-EU-legislation-on-design-protection/public-consultation> (accessed 31 July 2020). See also the inventory compiled by spiritus rector ANNETTE KUR/MARIANNE LEVIN/JENS SCHOVSBO, *The EU Design Approach: A Global Appraisal* (Edward Elgar Publishing 2018); see also HENNING HARTWIG, *The ‘Legal Review on Industrial Design Protection in Europe’: A closer look* [2018] JIPLP 332 et seq.

³² For, e.g., a ‘Motion for a European Parliament Resolution on three-dimensional printing, a challenge in the fields of intellectual property rights and civil liability’ (2017/2007(INI)) see www.europarl.europa.eu/doceo/document/A-8-2018-0223_EN.html (accessed 31 July 2020); see also ROSA MARIA BALLARDINI/MARCUS NORRGÅRD/JOUNI PARTANEN, *3D Printing, Intellectual Property and Innovation – Insights from Law and Technology* (Wolters Kluwer 2017). Given the factual and legal complexity of this matter, this submission will not address the interface of 3D printing and IP law.

³³ UMA SUTHERSANEN, *Cross-border Copyright Protection in Europe* (Chapter 15).

³⁴ ALEXANDER VON MÜHLENDahl, *Three-Dimensional Trade Marks and Designs: Comparison and Conflict* (Chapter 14).

³⁵ ANNA TISCHNER, *Design Rights and Designer’s Rights in the EU* (Chapter 5).

³⁶ ANNETTE KUR/ÁDÁM GYÖRGY, *Protection of Spare Parts in Design Law: A Comparative Law Analysis* (Chapter 10).

provide the reader with a general overview of current challenges faced by design law and will hopefully stimulate further reflection about the future of this vivid area of law. In fact, many of the topics addressed are still unexplored or deserve a transnational or comparative approach: we must think and act more globally and overcome traditional limitations.

At this point, I would like to extend my deep gratitude to the series editor Jeremy Phillips for his trust and support in this project, as well as to Luke Adams, Laura Mann, Barbara Pretty and Saffron Watts of Edward Elgar for the excellent cooperation in realising this Research Handbook, and to Christine Hehle for her invaluable help in copyediting.

My greatest and warmest thanks go to all the highly recognised and prominent authors of this volume for their willingness to share their knowledge and expertise within this challenging project, and, particularly, for their commitment and enduring patience.

Hopefully, the wealth and diversity of this Research Handbook will assist readers – students and researchers, practitioners and policy makers – when seeking help or guidance in understanding and navigating the fascinating world of design law.

The text takes account of relevant developments up to 31 July 2020, the date of submission of the manuscript.