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Cumulation of Protection in the EC Design Proposals**

(Summary)

The recent proposals of the EC Commission for a Regulation on the Community Design and a Directive on the legal protection of designs evade the most essential problem of harmonisation in the matter. This problem consists in the present legal diversity within the Community with respect to existing or not existing protection of designs by actions based on unfair competition and copyright. In the proposals the solution is postponed. This author's opinion is that this fatal postponement is not at all necessary. In fact, the souls of national legislatures have already to a high degree been massaged by other - copyright - Directives, into acceptance of one uniform solution of the underlying key issue: the harmonised originality requirement of copyright protection.

1. Design Protection: vexation, neurosis and rancour

Gerald Dworkin, who first approached me to give this lecture, wrote in 1989:¹ "How best to protect industrial designs has been one of the most vexed issues in UK intellectual property law." Not only in UK law one might add, but globally so. Two years later Bill Cornish contributed an "Opinion" to the lively European Intellectual Property Review,² "Designs Again", a title which conveys an audible sigh. It opened with the

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¹ In: Stewart, International Copyright and Neighbouring Rights, London 1989, 520.

² EIPR 13, 1991/1, 3.

sentence: "Industrial design protection seems these days to provoke a degree of anxiety that is positively neurotic." Again two years later James Lahore quoted this sentence in his Herchel Smith 1992 Lecture³ and added, that in his own Australian experience "the word 'neurotic' is not too strong a word to use in this context." He then wondered: "One is led to question why this issue of protection for designs creates such rancour." Again two years later, i.e. today, this speaker can only heartily subscribe to these qualifications in the past given by his most distinguished English-Australian colleagues. Their words have certainly not been belied since.

2. Objectives of EC Design Regulation and Directive

The most recent and important European development in our field is of course the presentation at the end of 1993 of the EC Commission's Proposals for a Regulation on the Community Design⁴ and, as "an essential accompaniment", a Directive on the national protection of designs.⁵ Both texts follow closely the draft proposals of the 1991 EC Green Paper on the protection of industrial design,⁶ at least as far as our topics of today are concerned.

The Explanatory Memorandum to the recent Proposal for a Regulation on the Community Design describes⁷ the objective pursued by the measure: "the creation of a Community-wide right coming into existence and expiring at the same time for the whole area of the Community and conferring upon its right holder a unitary right." The

³ Lahore, The Herchel Smith Lecture 1992: Intellectual Property Rights and Unfair Copying: Old Concepts, New Ideas, EIPR 14, 1992/12, 428.

⁴ Proposal for a European Parliament and Council Regulation on the Community Design, Com (93) 342 final-COD 463, Brussels, 3 December 1993, O.J. EC No. C 29/20 of 31 January 1994.

⁵ Proposal for a European Parliament and Council Directive on the legal protection of designs, Com (93) 344 final-COD 464, Brussels, 3 December 1993, O.J. EC No. C 345/14 of 23 December 1993.

⁶ Brussels, June 1991, III/F/5131/91-EN.

⁷ Com (93) 342 final-COD 463, Brussels, 3 December 1993, paragraph 2.3.

reasoning behind this is also explained: "Unless a Community-wide right is introduced, the reliance upon Article 36 (EC Treaty) as a legitimate defence for maintaining restrictions on the importation of goods will be perpetuated and the action suggested is therefore necessary to achieve the objectives as regards the internal market."

The Explanatory Memorandum to the Proposal for a Council Directive on national design protection then proceeds:⁸ "Introducing a Community design protection system raises the question of what should become of the existing national or regional protection systems. The Community protection system to be created by the Regulation cannot supersede existing national protection systems overnight. A period of at least temporary co-existence will be necessary, as occurs in the approach adopted for trademarks, where national trademarks will co-exist with the Community trademark." But then: "The co-existence of national and Community systems presupposes, however, that national design protection laws are, at least in essential respects, harmonized to become mutually compatible as regards their most salient features and also compatible with the future Community protection system." And "(t)herefore this proposal for a Directive on the legal protection of designs is an essential accompaniment to the Regulation on the Community design."

3. The Registered Community Design

The main part of the proposed Community design protection system consists of the Registered Community Design. This confers upon the right holder a genuine monopoly right for a maximum period of 25 years. This is the traditional patent approach⁹ to design protection, which in the past has always made national design laws so ineffective and indeed practically irrelevant. The EC Commission has borrowed this basic feature of the registration requirement, and most details as well, from a preceding 1990-draft for a Community Design of the Munich

⁸ Com (93) 344 final-COD 464, Brussels, 3 December 1993, paragraphs 1.3 and 1.4.

⁹ This terminology does not find favour with Kur, The Green Paper's 'Design Approach'- What's Wrong with it?, EIPR 15, 1993/10, 374.

Max-Planck-Institute.¹⁰ As Cornish has pointed out:¹¹ "At root, the Max Planck plan comes back to a preference for registered industrial property rights." He then makes a comparison with the recent experience with protection of computer programs, which has favoured the informal system provided by copyright and he concludes: "In most countries where the copyright law has been adapted to incorporate this striking new, essentially industrial, subject-matter, registration has not been required. This is not merely a higher dictate imposed by international conventions drafted for very different subject-matter. It is a freedom from constraint which has been welcomed enthusiastically by an industry rabid for rights." What is good enough for computers would be equally good for the rest of industry: i.e. an unregistered design right, operating for a substantial period, rather than a purely transitional protection for a few years (two years in the Max-Planck-, three years in the EC Proposal). Cornish then concludes his article with: "Indeed, are not the Community's efforts best directed towards introducing such a right rather than a new registration system?"

Cornish is not the only one to propose such a solution. The eminent French specialist in design law, Marie-Angèle Pérot-Morel, admitted in a debate in 1990,¹² that personally she was in favour of "a sui generis legislation for designs including certain positive aspects of copyright, particularly the absence of obligatory deposit formalities."

Existing design laws on the other hand, and now also the EC proposals, in general follow the rule of nearly all industrial property laws: they do prescribe formalities, like deposit, payment of dues and publication. This is based on presumed advantages of registration of designs. As Annette Kur, one of the co-authors of the Max-Planck-draft, and thus partly and indirectly of the EC Proposal, has recently written: "registration is found to be very useful, both as a means of information and even as a source of inspiration for the interested public, and as an instrument to

¹⁰ Published in German in GRUR Int. 1990, 559 and in English in IIC 22 (1991), 523.

¹¹ See note 2.

¹² Symposium on Industrial Designs, Amboise (France), October 4 and 5, 1990, WIPO, Geneva 1991, 175.

safeguard legal security."¹³ I would say here, as did Goethe's Faust: "Die Botschaft hör ich wohl, allein mir fehlt der Glaube" (The message I do hear, but I lack the faith).

As I have already remarked in 1983:¹⁴ "The bother of these formalities and the sometimes rather substantial costs involved are indeed very often prohibitive, with the result that only a dwindling percentage of all new industrial designs is deposited and consequently protected by design law. The non-deposited designs, maybe 99% of all new designs, can then only rely on copyright protection in countries with a system of cumulative protection (France and the Benelux-countries). In countries which normally exclude copyright protection for designs (Italy, Germany) those 99% of new designs in general can freely be copied."

In December 1993 Jeremy Phillips has given new documentary evidence of the design registration as "the Cinderella of intellectual property rights."¹⁵ The whole proposed Registered Community Design now again relies, as indicated by its name, on registration. One can wonder, whether this future Registered Community Design will enjoy the same status as the present national design laws, i.e. the status of the poor relative of industrial property."¹⁶

It would even seem that after adoption of the Regulation and the Directive even much less practical use will be made of the specific design right than already is the case now. Regulation as well as Directive will introduce an extra requirement for design protection. Article 4 (1) of the Regulation and Article 3 (2) of the Directive not only require that the design be new, but they add that the design should have "an individual character". According tot Article 6 of the Regulation and Article 5 of the Directive a design shall be considered to have an individual character if the overall impression it produces on the informed user differs significantly from other designs,

¹³ Kur, op. cit. (note 9).

¹⁴ Cohen Jehoram, Protection of Industrial Designs Between Copyright and Design Laws: A Comparative Study, General Report for the ALAI Congress of the Aegean Sea I, 1983, *Annuaire ALAI*, 1984, 77 and Copyright 1983, 317.

¹⁵ Phillips, International Design Protection: Who Needs It?, *EIPR* 15, 1993/12, 431.

¹⁶ Baeumer, at the Amboise Symposium, op. cit. (Note 12), 177.

known by commercialization or registration. Finally, it is provided that in order to assess the required "individual character" more weight shall be given to common features than to differences. By all means the "individual character" should not easily be accepted. The Explanatory Memorandum to Article 6 of the Regulation openly admits that in this way fewer models will in future qualify for design protection than up till now has been the case under some national design laws.

The drafters of the whole proposal make the impression that with this requirement of "individual character" they have snuggled up so closely to copyright, that no independent reason of existence has remained for specific design protection.

Luckily, however, the proposals contain also some provisions on the competing forms of legal protection of designs. The most important ones are the actions based on unfair competition and on copyright. They are dealt with in Article 100 of the Regulation. It would seem to be the only practically relevant article of the total of 128 articles of the Regulation. I will therefore restrict myself to treating this subject of unregistered design protection, which is centred around Article 100 of the Regulation and the corresponding Articles 17 and 18 of the Directive.

4. Unfair competition

Article 100 of the proposed Regulation is indeed, as the Explanatory Memorandum says, "a fundamental provision, setting out the rule governing the relationship between the protection resulting from the Community Design system and the protection that a design can obtain under other legal instruments offered by Community or national legislations. The general principle on which this provision is based is 'cumulation': if a design protected by a Community Design can also be protected under Community or national law by a different legal instrument, the existence of the protection under the Community design system should constitute no hindrance for the right holder to invoke such further protection."

Article 100 section 1 then starts with the provision that nothing in this Regulation shall prevent actions concerning designs protected by Community Designs from being brought under any legal provisions of the Community or of a Member State

relating to other industrial property rights and, notably, unfair competition. Article 17 of the Directive provides for a corresponding rule.

Indeed, most national legal systems, in addition to providing statutory rights, also supplement the protection of designs with a remedy for "unfair competition" to cover situations where designs have been unfairly adopted by competitors,¹⁷ as Hugh Brett wrote in 1981.¹⁸ He had to add wistfully: "United Kingdom law recognises no tort of unfair competition." Two years before the same author had already remarked that the absence of a tort of unfair competition may lead to difficulties in meeting the objectives of the Common Market. He foresaw already in 1979:¹⁹ "Strong pressure will be placed on the UK to conform with the civil law concepts in the field of intellectual property, but unless a general principle of unfair competition is developed, so that it may be used to 'catch' situations presently outlawed by the statutory monopolies, harmonisation may result in a reduction of existing remedies."

Others have also bemoaned the absence of the unfair competition action in the United Kingdom.²⁰ It has been seen as the result of "late Victorian attitudes."²¹ Christine Fellner has once proposed a British "Unfair Copying Act."²²

Outside the United Kingdom, however, the new EC proposals will not restrict the existing general "safety valve" of unfair competition actions in cases of slavish imitation of designs. This is a most important positive element of those proposals - for the non-British at least.

¹⁷ This is now even true for the Netherlands, since a decision of the Dutch Supreme Court of 31 May 1991, *Ars Aequi* 42 (1993), 680-687, note Cohen Jehoram.

¹⁸ Brett, The danger of throwing the baby out with the bath water - the reform of the UK copyright law and the protection of designs, *EIPR* 3, 1981/6, 163.

¹⁹ Brett, Unfair competition - not merely an academic issue?, *EIPR* 1, 1979/11, 295.

²⁰ See Cornish, *Intellectual Property*, London 1989, 10, Dworkin, Unfair Competition: Is the Common Law Developing a New Tort?, *EIPR* 1, 1979/9, 241, the same, *op. cit.* (Note 1), 522.

²¹ In this sense Cornish, see previous note.

²² Fellner, *The Future of Legal Protection for Industrial Design*, Oxford 1985, 199

Not quite the same can be said with respect to the proposals concerning the cumulation of design protection with the most important concurring way of protecting designs, copyright. This calls for an introductory explanation.

5. Fundamental and practical differences between copyright and specific design protection

Both aims and techniques of copyright and design protection of industrial design differ. Copyright aims at protecting the designer. The specific design right, part of the industrial property field, tries to provide legal security for industry. This basic difference in orientation leads to a whole range of practical divergencies between the two legal means of protection. In this context I will treat the four most impressionable ones.

I would like to start with a difference which to my taste is often highly overrated: the term of protection. The general copyright protection of applied art is 50 years post mortem auctoris, a term which by a recent Community Directive²³ will shortly be extended to 70 years post mortem auctoris. In this way the total term of copyright protection of a specific design might easily amount to well over a century. This seems to be shocking for industrial property lawyers, who are used to for instance a total of 20 years protection for patents, their constant frame of reference. Indeed, most specific design laws do provide for such more restricted terms of design protection. The proposed Regulation might there even be deemed to be generous in comparison with national laws. It provides for a protection of 5 years, which may be renewed for 5 year periods, to a maximum of 25 years in total. Still quite a distance from the 120 years which copyright easily provides. The reason given for this difference in term is that industrial designs would be so shortlived. Indeed, the long copyright protection has often served as a main objection to the whole idea of protecting designs by copyright. I have never understood this argument. If a specific design is dead after

²³ Council Directive 93/98/EEC of 29 October 1993, harmonizing the term of protection of copyright and certain related rights, O.J. EC No. L 290/9 of 24 November 1993.

three years, who then will be bothered by the copyright in this corpse? Who is bothered by the 120 years of copyright protection of a newspaper article which is obsolete after a day? So it is only for a certain patent lawyers creed's sake that I have mentioned this term difference at all.

A second difference concerns the fact that the design right confers a real monopoly on its owner. He can bar also innocent infringers. Copyright, however, only protects against copying the design of the copyright owner. This difference is, however, rather theoretical. It certainly does not imply, as has been suggested,²⁴ that in an infringement procedure, the copyright owner will have to prove that the defendant knew and reproduced his design. Mere similarity between two designs establishes a legal presumption of infringement by the later one, the defendant. This shifts the burden of proof to defendant.²⁵

Another, and this time indeed significant, difference concerns the object of protection. A design right merely protects the appearance of a certain registered product. The copyright in a design, however, protects it in every conceivable application. Cornish wrote about registered designs years ago,²⁶ and this seems to be in conformity now with Article 3 of the Regulation: "The design is not something distinct from the article to which it is applied.... What is depicted and described in the registration is the article with the design incorporated. So the design must be registered separately for different kinds of articles." This restriction to a specific article

²⁴ Kur, op. cit. (Note 9), 378.

²⁵ In this sense Dutch Supreme Court 21 February 1992 (Barbie doll), *Ars Aequi* 42 (1993), 295-302, note Cohen Jehoram. The same applies to French and Swiss copyright law. See Desbois, *Le droit d'auteur en France*, Paris 1978, 150 and Troller, *Immaterialgüterrecht*, I, Basel-Frankfurt 1983, 369. For the UK the answer to our question goes the same direction, but is not so clear cut. Cornish, *Intellectual Property*, London 1989, 287-8, writes: "If the evidence shows that there are striking similarities between the two works, that the plaintiff's was the earlier in time and that the defendant had the opportunity to get to know the plaintiff's work, then a court may well find copying proved in the absence of any convincing explanation to the contrary by the defendant. But the judges have hesitated to fetter the assessment of each case on its facts by the introduction of rules formally shifting the burden of proof from plaintiff to defendant at any stage of the trial."

²⁶ Cornish, op. cit. (Note 20), 374.

does not apply to copyright protection. The copyright in a pattern of a Scottish plaid covers this plaid, irrespective of the fact whether it is applied to a rug, a tie, a wallpaper or the top of a refrigerator.²⁷

The fourth difference is a really decisive one. Copyright protection does not require any registration or fees. As design protection does, this results in 99% of new designs not being protected by design right at all, but eventually only by copyright. But, as already mentioned before, this essential copyright protection for those 99% of designs can only exist in countries with a system that indeed allows for dual protection, by design and by copyright law. On this crucial point we can, however, witness the widest divergence imaginable between the national legal systems of different Member States of the Community.

The 1991 EC Green Paper quite rightly said:²⁸ "Roughly speaking one could abstract from legal technicalities and conclude that Member States may be divided into two groups: - the group of States which apply copyright protection in a sweeping manner (France, Benelux²⁹ and Greece). To these States the UK should be added even if technically speaking its 'unregistered design' does not qualify as 'copyright';³⁰ - the group of States which have a more or less restrictive approach to protection by copyright (Italy, Germany, Spain, Portugal, Denmark and Ireland)."

This legal divergence is of course intolerable in an internal market, because it threatens the free circulation of all design products across national borders. As the

²⁷ Compare also the Explanatory Memorandum to the Uniform Benelux Design Law.

²⁸ EC Green Paper (see Note 6), par. 11.3.5.5.

²⁹ Compare Cohen Jehoram, Cumulative Design Protection, a System for the EC?, EIPR (1989), 83.

³⁰ Why the British unregistered design right does not dare to speak its name "copyright" is explained by Cornish, op. cit. (Note 20), 385: "One important motive in treating a separate unregistered design right has been to preclude foreigners from entitlement, in a way that was difficult to introduce while protection was accorded under copyright."

Explanatory Memorandum to the Regulation now says:³¹ "Artificial barriers to trade will therefore have repercussions on the trade in most manufactured goods and are therefore incompatible with the functioning of an internal market." This means that the EC Commission in its proposals had to make a choice between the two existing national systems - and up to a point it did - in Article 100, paragraph 2 of the Regulation, which deals, as the Explanatory Memorandum says "with the most important and common form of concurrent protection, the protection under copyright law."

³¹ Explanatory Memorandum (Note 7), par. 1.4.

6. The Principle of Cumulation of Design and Copyright Protection

The EC Commission has at least in principle opted for a cumulative protection of Community designs by the specific design right and by copyright. The first part of the first sentence of Article 100, paragraph 2 bears witness to that: "Pending further harmonization of the laws of copyright of the Member States, a design protected by a Community Design shall also be eligible for protection under such laws."

Everything, however, under the proviso "pending further harmonization of the laws of copyright of the Member States", with all their respective differences in approach to protection of designs as already indicated, ranging from absolute exclusion to full cumulation. The last sentence of the paragraph stresses this further: "The extent and the conditions under which such a (copyright) protection is conferred including the level of originality required, shall be determined by each Member State."

In its 1991 Green Paper the Commission had admitted:³² "As long as design protection under the umbrella of copyright law has not been harmonized, completely satisfactory internal market conditions will not have been fully established, notwithstanding the creation of a Community Design." But then the Commission indicated:³³ "It appears to be extremely difficult to comply with the wishes expressed by some industries as regards a general, generous application in all Member States of copyright law as the instrument for the protection of industrial design." The Commission is of the opinion that the harmonization of the originality criterion would "prove to be an extremely difficult task, because the different application of the criterion is based on different legal and not least cultural traditions." On this I have commented before:³⁴ "Of course, basic legal differences always mirror different cultural traditions. Law is cultural tradition. If those differences in tradition cannot be tackled, then what does legal harmonization in the European Community mean?"

³² Green Paper (Note 6), par. 10.2.1.

³³ Green Paper (Note 6), par. 4.2.7.

³⁴ Cohen Jehoram, The EC Green Paper on the Legal Protection of Industrial Design. Half Way down the Right Track - A View from the Benelux, EIPR 14, 1992/3, 75.

In the meantime, however, the Commission did consider³⁵ that "the principle of the possibility of cumulation constitutes the right policy to follow in this sector and should be acknowledged by all Member States." The Explanatory Memorandum to the proposed Regulation again stresses the principle that paragraph 2 of Article 100 "contains the basic rule of the cumulation of the protection under the Community Design system and the protection under copyright law" and the Commission deems it "important that the Member States be aware of the Commission's intention to proceed in the direction indicated: acceptance of the principle of 'cumulation' of protection, as defined in this paragraph would constitute their first contribution in this direction."

The Commission does indeed push the Member States somewhat in the desired direction by at least requiring the abolition of two of the oddest and most outdated provisions which at the moment exist within the European Community (in Italy, the United Kingdom and Ireland) and which now jeopardize the application of cumulation.

The first such abolition is contained in the provision of Article 100 (2) and Article 18 of the Directive, according to which designs shall be eligible for copyright protection "irrespective of the number of products to which such design is intended to be incorporated or to be applied." This is a reaction to the present systems of Ireland and the United Kingdom. Ireland applies a rule under which the possibility of protecting a design by copyright is linked to the number of products in which the design is intended to be embodied. Should such a number exceed 50, the copyright protection could no longer be afforded. In the United Kingdom the term of protection is dramatically reduced as of 50 copies. Those arbitrary rules will be outlawed by the Commission's design proposals.

The second abolition of an existing blatant limitation of copyright is contained in the following provision of Article 100 (2) of the Regulation and Article 18 of the Directive: a design shall also be eligible for copyright protection "irrespective of whether the design can be dissociated from the products to which it is intended to be incorporated or applied." This is a reaction to the existing Italian requirement for

³⁵ Green Paper (Note 6), par. 11.3.2.

copyright protection of design: "scindibilità", the possibility of conceptually separating the work of applied art from the product in which the work is embodied, like the flower pattern on a teacup, but unlike the shape of a chair. As the Explanatory Note to the Regulation says: "The interpretation given by the case-law to this notion has led to the impossibility for modern industrial design to benefit in Italy from copyright protection, even for the most prestigious and authoritative creations by contemporary artists, whilst protection can be recognized to two-dimensional ornamental designs even with a very low originality level. The Commission considers appropriate, and its feeling is indeed supported by the very strong request in this sense expressed by all the interested circles, that such a provision should be abolished without awaiting the future harmonization." One of the two co-authors of the Commission's draft, the Italian Scordamaglia, did not mince words about this at a Dutch design symposium in 1992:³⁶ "Italy is required to abandon this position, which corresponds to a traditional, deep-rooted, reactionary conviction of some academic circles and of the administrative authorities in my country that, basically, industrial products have nothing in common with works of applied art."

Apart from this pruning of the wildest branches of existing restrictive national copyright laws, in essence the Regulation leaves everything where it now stands, "pending further harmonization of the laws of copyright of the Member States." Especially the required level of originality still remains to be determined by each Member State. This leaves intact the present German impossible requirement of such a heightened level of originality of the design that "art" must be at issue. This has led to such a restrictedly cumulative system, that for all practical purposes Germany can be counted to the group of countries which exclude copyright protection for designs.³⁷ The Commission did not dare to tackle this problem. As Scordamaglia has clearly said:³⁸ the proposal "is based on 'political' and not on 'scientific' considerations."

³⁶ Scordamaglia, *Obstacles on the Road to Harmonization of Legal Protection of Design*, in: Cohen Jehoram a.o., *Bescherming van vormgeving in Europa* (eds. Jonkers, Keuchenius and Schaap), Deventer 1993, 53.

³⁷ See for this Cohen Jehoram, *Cumulative Design Protection* (Note 29).

³⁸ See Note 36.

Nevertheless, the proposal surreptitiously does provide for a surrogate. Article 12 of the proposed Regulation now also provides for a short-term protection of three years without any formalities by an Unregistered Community Design. The function of this three-year period of protection for unregistered designs is indeed to remedy to a limited extent the lack of copyright protection in those Member States which at this moment exclude that protection, and which by Article 100 will be allowed to continue this exclusion. The unregistered Community Design, borrowed from the US Semiconductor Chip Protection Act of 1984, is a new weak hybrid between industrial property protection and copyright.³⁹ In this way the sharpest edges of the lack of copyright protection in the so-called exclusive countries are being filed away. As the Green Paper remarked:⁴⁰ "But after the expiry of the duration of protection for the Unregistered Community Design the discrepancies between the legal position of Member States may show an effect, which at the appropriate time needs to be assessed. Such cases will only arise, by definition, some years after the entry into force of the Regulation of the Community Design. It would therefore be possible for the Community to develop measures to take care of that problem in the meantime" and in conclusion: "The problem stemming from the application of copyright to the protection of designs, which differs widely from Member State to Member State as regards the conditions for protection and the term of protection is likely in practice to prove its effects essentially some time after the entry into force of the Regulation on the Community Design. The introduction of the Community Design will - at least for some time - mitigate existing problems, not exacerbate them." In other words: We'll cross that bridge when we get to it. I suppose that the extremely cautious and incomplete solutions of Article 100 (2) with respect to the dual protection of design, combined with the palliative of the Unregistered Community Design, were indeed the maximum which at the time of the 1991 Green Paper could be proposed by the

³⁹ See Cohen Jehoram, Hybrids on the borderline between copyright and industrial property law, *Intellectual Property Journal (Australia)*, 2 (1991), No. 4, 190-205, and *RIDA* 153, 1992, 74-145.

⁴⁰ See Note 6, par. 11.3.6.9-10.

Commission - with any prospect of success.⁴¹ In the meantime, however, we have witnessed some developments in Community law, which could promise a brighter future.

7. Harmonization of "originality" in the Community

To quote once more, and for the last time, the Explanatory Note to Article 100 of the Regulation: "The smooth functioning of the internal market for products embodying design is going to be fully achieved only if the Community Design is supplemented by harmonized national rules of copyright law relating to the protection of design. This is, however, a formidable task which needs intense preparation, further comparative studies and contacts with national authorities and interested or academic circles." This whole passage sounds just as obsolete as the exclusion of the reciprocity rule in Article 100 (3) of the Regulation after the Phil Collins decision of the Court of Justice of the European Community.⁴²

The whole difficulty would really seem to reside in the widely divergent national traditions within the Community with respect to the most central question of copyright protection: when does a work qualify as an object for copyright protection? This question of requirement is closely linked with the whole purpose of copyright as it is understood in different legal traditions.

Within the European Community in essence two fundamentally different systems exist at this moment: the common law tradition which takes a very relaxed

⁴¹ One development, which need not be treated fully here, is the Phil Collins decision of the European Court of Justice of 20 October 1993, in the joined cases C-92/92 and C-326/92, Common Market Law Reports, 21 and 28 December 1993, Vol. 68, No. 947-948, p. 773-799, which has done away with international reciprocity rules in copyright law within the Community, because of its incompatibility with a fundamental principle of the EC Treaty, the non-discrimination-rule of Article 6 of the EC Treaty. Article 100 (3) of the Regulation also tried to achieve this goal with respect to international copyright protection of designs. This paragraph has now been superseded by the Phil Collins decision of the Court of Justice and can consequently be withdrawn.

⁴² See previous note.

view of requirements for copyright protection and the more demanding civil law tradition. To complicate things further the civil law tradition is split in two branches, the very strict and therefore most unrelaxed German approach and the more intermediate position of the rest of the European Continent.

For clarity's sake I start with the last, the intermediate Continental system. In France, the Benelux and most other Continental systems the general requirement for copyright protection is "originality" in the sense of creativity, of personal expression of the author. This is not at all a high threshold: a private letter, a jingle, a snapshot will qualify for copyright protection. Still, some products are excluded, like for instance a telephone directory, to borrow the example of the famous Feist-case of the American Supreme Court, which has indeed aligned itself in 1991 with the general European Continental tradition.⁴³

Only Germany forms a sub-group in itself on the Continent, in the sense that for certain categories of works, like designs (not for written works curiously enough), it requires more than just personal expression in the sense of a human designers touch. Here it requires all of a sudden a certain quality, it requires art.⁴⁴ The German Bundesgerichtshof and the lower courts do not seem to have any hesitation in assessing the quality, the "art", involved in a design under consideration. Needless to say that those judges hardly ever recognize "art" in the designs submitted to their decision.⁴⁵ Therefore indeed Germany, for all practical purposes, has to be counted to the group of countries which effectively bar designs from copyright protection.⁴⁶

⁴³ US Supreme Court 27 March 1991, Feist Publications, Inc. v. Rural Telephone Service Co., III S.Ct. 1282 (1991).

⁴⁴ The German courts seem to have based this stronger requirement only on the existence of two different statutes, Cohen Jehoram, Copyright 1983, 321. Compare also Pérot-Morel, Symposium Amboise (Note 12), 30: "it is somewhat contrary to Cartesian logic to apply two laws with different origins and regulatory provisions to the protection of the same subject matter." Compare also Troller, as quoted in Copyright 1983, 321.

⁴⁵ Compare Pérot-Morel, Symposium on Industrial Designs, Amboise (Note 12), 27.

⁴⁶ See note 37 and Cimoli, Towards a New Italian Design Law, EIPR 15, 1993/11, 425.

The extreme opposite we find in the common law countries, the United Kingdom and Ireland. It is true that also here "originality" is a requirement for copyright protection. But here the word does not mean "personal expression", let alone "art", but merely that the work originates from the author, and is not copied from another source.

On the British isles, which have never been conquered by Napoleon, the whole concept of copyright dates back to the ancien régime, to those times from before the French Revolution. Then indeed the whole of Europe was still unified in its approach to copyright privileges. What had to be protected there was not the personal work of an author, but simply copyright industries: "skill, labour and investment". The Feist telephone directory would still today qualify for copyright protection in the UK. The generous - and in my Continental view - overgenerous English copyright system is "used to compensate for lack of a roving concept of unfair competition."⁴⁷

This fundamental divergence in approach to copyright between common and civil law systems and even between two branches of the civil law area, may explain the fear and trepidation of the Commission and its halfhearted proposal for harmonizing copyright protection of designs within the Community. Nevertheless, it should be noted that precisely in the field of designs the UK copyright law 1988 has made a departure from its general copyright position by indeed requiring something extra with respect to designs: they should not be "commonplace". Now this sounds to me suspiciously similar to the Continental and US approach of a "modicum of creativity".⁴⁸

The situation with respect to harmonization of "originality" is not all that bleak. Harmonization of copyright within the Community has already been underway for years. At this moment five Directives to harmonize certain aspects of copyright are in place, and others are drafted. Each Directive in principle restricts itself to a very particular copyright subject, like the protection of designs of integrated circuits and of computer programs, rental and lending rights, satellite broadcasting and cable-retransmission and the term of protection of copyright and neighbouring rights. The Commission has always stressed that it wanted to approach the harmonization of

⁴⁷ See Cornish, op. cit. (Note 20), 271.

⁴⁸ See about this the interchange Cohen Jehoram-Fellner at the Amboise Symposium (Note 12), 183.

copyright piece-meal, and not with sweeping, all-encompassing texts. It always professed that it refrained from solving fundamental copyright problems through so-called "horizontal provisions" in the various Directives.

Nevertheless, broader and fundamental copyright problems unavoidably sometimes had to be tackled. This then precisely gave rise to such "horizontal" provisions which in fact would go far beyond the boundaries of the specific Directive and would indeed have an impact on copyright as a whole. The mere repetition of such provisions in consecutive Directives would stress this phenomenon.

A prime example of such a "horizontal" provision we now find with respect to precisely our subject, that fundamental problem of the scope of the "originality" requirement in copyright. In the context of the Software Directive⁴⁹ one could not avoid giving a definition of "originality" as a requirement for software protection. The Community had to choose between the described three existing national systems and it did in Article 1 (3) of the Directive with the following provision: "A computer program shall be protected if it is original in the sense that it is the author's own intellectual creation. No other criteria shall be applied to determine its eligibility for protection." This definition starts with a formal bow to the English concept of originality with the words "the author's own", but then continues embracing the general Continental approach with the word "creation". Further qualitative requirements, as exist in Germany, are ruled out with the last sentence: "No other criteria shall be applied." This definition of originality we find repeated for photographs in the Duration Directive⁵⁰ and for databases in the Proposal for a Database Directive.⁵¹ The final touch of the Continental personality approach to copyright we detect in Recital 17 of the Duration Directive which speaks of "the author's own intellectual creation reflecting his personality" (italics added).

⁴⁹ Council Directive 91/250/EEC of 14 May 1991 on the legal protection of computer programs, O.J. of the EC No. L 122/42 of 17 May 1991.

⁵⁰ Article 6 of the Council Directive 93/98/EC of 29 October 1993, harmonizing the term of protection of copyright and certain related rights, O.J. of the EC No. L 290/9 of 24 November 1993.

⁵¹ Article 2:3 of the Amended Proposal for a Council Directive on the legal protection of databases, Com (93) 464 final SYN 393, Brussels, 4 October 1993.

Article 100 (2) of the Design Regulation and Article 18 of the Design Directive start out with the words "pending further harmonization of the laws of copyright in the Member States." This implies a postponement of the most essential problem of the whole harmonized protection of designs in the Community. But then this future to which the design proposals refer might indeed be within hand's reach. "Originality", the core issue of our problem, has already been harmonized to such a high degree, that it should now be very easy indeed for the Community to just add designs to all the subject matter already treated in previous Directives. Only then indeed the task, set with the design proposals, will really be accomplished: the realising of an internal market in most manufactured goods.