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Designs for Functional Articles

In this information sheet we give a brief overview of the law as it relates to the protection of designs for functional articles such as furniture, garden ornaments, fashion accessories, machinery, toys and homewares. We focus on how these types of articles are protected under copyright law and under designs law.

The purpose of this information sheet is to give general introductory information about copyright. The Copyright Council's lawyers do not give advice on the design/copyright overlap issues discussed in this information sheet. If you need to know how the law applies in a particular situation, you will need to see a lawyer in private practice who has the relevant expertise.

We update our information sheets from time to time. Check our website at www.copyright.org.au to make sure this is the most recent version, and for information about our other information sheets, other publications and our seminar program.

Key points

- In many cases, if you want to protect yourself against people making replicas of functional or mass-produced items, you will need to look at your options under design law, not copyright law.
- You will generally be able to rely on copyright protection if you want to protect a 2D design, a "work of artistic craftsmanship", or a design for an item that you haven't yet started to exploit commercially.
- If an item is registered as a design, copyright law may still be relevant in relation to activities such as filming and photographing items made to the design.
- The interaction between design and copyright law is complex. If you want to commercialise a design you should get specific legal advice on how to protect it **as early as possible**. Once you start marketing it or manufacturing it, it may be too late.

Copyright protection for artistic works

The *Copyright Act 1968* (Cth) sets out how copyright law works in Australia. In many cases, however, the courts have had to decide how the Act should be interpreted, and how it applies to particular situations.

There is **no** registration procedure for copyright in Australia. Rather, the Copyright Act lists the types of material which are protected by copyright. They are all protected from the moment they are made.

The types of material protected by copyright include "artistic works". There are three categories of material which can be "artistic works":

- paintings, sculptures, drawings, engravings and photographs;

- buildings and models of buildings; and
- "works of artistic craftsmanship".

If something can be classified as falling within one of these categories, it is automatically protected as soon as it is made (whether by hand, on computer, or even, in some cases, by machine provided there is sufficient original contribution by a person).

Something which falls within the first two categories of "artistic works" may be protected even if it doesn't have any aesthetic appeal. Engineering and design drawings, architectural plans, models and design prototypes can fall within these categories, and can therefore be protected by copyright even though they are created purely for utilitarian purposes.

On the other hand, a "work of artistic craftsmanship" is only protected by copyright if it displays both aesthetic appeal and "craftsmanship". Courts have said that something displays "craftsmanship" if the people making it display skill, knowledge of materials and pride in their workmanship. From the cases, it is clear that something doesn't have to be handmade to be protected as a "work of artistic craftsmanship" – in one case involving machine-knitted clothing, the court said that all that is necessary is that the item satisfies the two criteria of craftsmanship and aesthetic quality. However, the item must be something that is not purely functional.

Examples of "works of artistic craftsmanship" include pottery, glasswork, jewellery, tapestry, and woodwork.

Limitation of copyright protection for functional articles

The Copyright Act contains provisions which are often referred to as the "copyright/design overlap provisions". These are intended to prevent dual protection under designs and copyright law for things which should really only be protected under the Designs Act. Where something is, or could be, registered as a design, and is applied "industrially", a rightholder's ability to rely on copyright protection is very limited.

In comparison with copyright law, design law offers limited protection. For example, the maximum period of time a design can be protected under design law is ten years. Also, while copyright protection is free and automatic, a design must be registered before it is protected under the Designs Act. See the information on "Design Registration" towards the end of this information sheet for information on registering designs; for a more detailed overview of design law, see the information on the website of IP Australia: www.ipaustralia.gov.au

The reasoning behind the copyright/design overlap provisions is that, whether registered under the Designs Act or not, things which are essentially functional and intended for mass production should not get the very extensive protection of copyright law.

We provide below a brief overview of how these provisions have changed over time. Note, however, that the extent to which any of the earlier provisions might still apply to prototypes, sketches, plans and items created during these periods is not clear.

Designs and prototypes created before 1 May 1969

If an artistic work "capable of being registered" under the Designs Act was created **before 1 May 1969** (for clarity we refer to this as **pre-1969** material) and was either used or intended to be used as a model or pattern to be "multiplied by an industrial process", it does not qualify for copyright protection at all.

Therefore there is no copyright protection for pre-1969 material created with the **intention of applying the design industrially**. Such material may be freely photographed and otherwise reproduced.

A difficulty arises, however, if it is not clear that the pre-1969 item was, at the time it was made, created with the intention of industrial application. For example, an artwork created as a one-off but subsequently industrially applied (such as a drawing that was subsequently used on wallpaper) may not be excluded from copyright protection because the drawing may not have been intended, at the time of its creation, to be either a "model" or "pattern" used in an industrial process. In such a case, permission to make reproductions may be needed.

The law between 1 May 1969 and 30 September 1990

Generally, if an artistic work (including a painting, drawing, sculpture or work of artistic craftsmanship) was registered under the Designs Act during this period, the copyright owner could not take action for copyright infringement in relation to any action that would have infringed his or her rights under the Designs Act.

Similarly, if an artistic work had been "industrially applied" and **could** have been registered but wasn't, an exception to copyright infringement applied for 16 years from when the article was first sold or marketed, to the extent that a design registration would have protected the material. (Sixteen years was then the period of design registration; as noted above, it is now ten years.)

The law between 1 October 1990 and 16 June 2004

Generally, as with the previous provisions, if an artistic work was registered under the Designs Act or could have been registered and was "industrially applied" during this period, an exception to infringement applied to the extent that the Designs Act protected, or could have protected the design. However, protection under **both** copyright and design law was available for 2D artistic works, such as drawings to be used on T-shirts.

Special provisions were also introduced for "works of artistic craftsmanship", "models of buildings" and "buildings". Where these provisions applied, the copyright owner would generally be able to take copyright action against people making replicas of the material, whether or not the work had been mass-produced or otherwise commercialised. The copyright owner's rights would, however, be more limited if he or she had in fact registered the item under the Designs Act.

Problems with the sets of provisions that applied between 1 May 1969 and 16 June 2004

Even though there were limits on a copyright owner's ability to rely on copyright law to protect certain types of artistic works under either of the sets of provisions applying between 1 May 1969 and 16 June 2004, and even though an article itself might not be protected by copyright, manufacturers could in some cases still rely on copyright to stop other people or companies copying their material. For example, a manufacturer might rely on a competitor having:

- directly or indirectly copied underlying artistic works such as design sketches, design drawings or engineering plans (so-called "plan-to-plan copying"); or
- used images of articles in advertising.

By either of these means, manufacturers were in some cases able to take action under copyright law against people who made replicas after Designs Act protection had expired.

The provisions that came into effect on 17 June 2004

As a result of the types of problems discussed above, and following a report on design law by the Australian Law Reform Commission, further changes were made to the design/copyright overlap provisions in the Copyright Act. These took effect on 17 June 2004. The aim of these changes was still to limit copyright protection for essentially utilitarian items, but with a focus on closing the various "loopholes". We outline the main points about the current provisions below.

Registered designs

If a design is registered, it is not an infringement of **copyright** to do any of the following:

- make a replica of the design;
- reproduce underlying artistic works (such as design drawings or prototypes) as part of the manufacturing process; and
- reproduce underlying artistic works in promoting and advertising the replica.

However, during the period of design registration, making a replica may infringe the owners' rights under the Designs Act.

Once Designs Act protection has expired, you can make and advertise a replica of the item without infringing rights under **either** designs law or copyright law.

Whether or not Designs Act registration is current, direct or indirect reproduction of underlying artistic works for purposes other than manufacturing the copy or advertising it will generally require copyright permission.

Unregistered designs

If a design is unregistered, the overlap provisions generally apply once the design is either "industrially applied" by the copyright owner and offered for sale, or otherwise made public (for example, by publication of a complete specification of the product). Note that, generally, a design will have been applied industrially if it has been applied to more than 50 articles, or to one or more non-handmade articles that have been manufactured in lengths or pieces.

The provisions relating to unregistered designs do not, however, apply to "works of artistic craftsmanship", or to buildings (other than, for example, portable buildings), or to models of a building: while these might qualify for design registration, the copyright owner has a choice whether or not to register them as a design. Further, the overlap provisions do not exclude copyright protection if the design has been excluded from design registration.

As with registered designs, the copyright/design overlap provisions only exclude copyright protection in relation to the making of replicas or otherwise applying the design to a product. For other uses, copyright law remains relevant.

Garments & dressmaking patterns

Generally, unless a garment qualifies as a "work of artistic craftsmanship", the copyright/design overlap provisions will limit the ability of a clothing manufacturer or designer to take action for copyright infringement against a rival making copies of the garment itself or, as part of its manufacturing process, copies of the patterns for the garment. In other words, the ability to control the making of replicas is generally governed by the Designs Act.

New Designs Regulations

The current Designs Regulations came into effect on 17 June 2004.

The previous regulations listed a great range of items which could **not** be registered for design registration; these could therefore be fully protected by copyright. (The types of products listed in the old regulations included medals and "articles on which there is printing", such as dressmaking patterns, calendars, greeting cards and book covers.)

However, the current list of items which cannot be registered is much shorter. Therefore, if you have in the past relied on the list in the Designs Regulations as a reason not to register designs under the Designs Act, you should get specific advice on your current situation.

Plan-to-plan copying or advertising use

Manufacturers of functional items that otherwise would be excluded from copyright protection can no longer rely on plan-to-plan copying or advertising use to establish a copyright claim.

When to get specialist legal advice

If what you are seeking to protect can be classified as "visual features of shape or configuration" and these are "embodied in" an item, you should consider getting specialist legal advice. (Note that a design is "embodied in" a product if, for example, it is woven or worked into it, or impressed onto it.)

If you have not sold or marketed copies of your product since 17 June 2004, it is not clear whether you can still enforce copyright rights over the product. If someone copies your product, you should consider getting legal advice about whether or not there are any options available to you under copyright law, rather than assuming that your only rights (if any) are under design law.

You should also seek advice if you want to **copy** someone else's design for a functional item, to ensure that you can rely either on the current overlap provisions or on the "transitional" provision in the Act for designs dating from before 1 May 1969.

*Designs **not** "embodied in" a product (ie 2D designs)*

If you own copyright in a design which is not "embodied in" a product:

- you will generally be able to take legal action under the Copyright Act against anyone who copies that design;
- your rights under the Copyright Act are not affected if you make and sell articles with the design on them; and
- it is not intended that your copyright rights will not be affected if you register the design under the Designs Act.

Examples of designs **not** "embodied in" a product would include designs which are applied to the surface of an article (printed on T-shirts, or painted onto tiles, for example).

In these cases, you may want to get advice about the possible **advantages** of registering the design under the Designs Act, but copyright protection will generally be sufficient.

Examples of designs which **may** be regarded as "embodied in" an article include designs for embroidered items and tapestry, and designs which are embossed or stamped. For these types of designs, you may need advice as to how the overlap provisions might apply, and whether or not you risk losing copyright protection by commercialising your product.

Buildings and models of buildings

If you own copyright in a "building" or a model of a building, you will generally be able to take legal action under the Copyright Act against a person who copies that building. This will almost invariably be the case if you are an architect building houses or office blocks or other types of

permanent structures. People creating buildings or models of buildings can choose whether or not to register the design (but registering will generally result in limitation of copyright protection).

However, for the purposes of the copyright/designs overlap provisions, demountable and portable buildings, sheds and pre-constructed swimming pools are no longer defined as "buildings" and are therefore subject to the overlap provisions. Therefore, you will generally need to register (or have registered) such designs with IP Australia in order to have any real legal protection. This must be done **before** you exhibit, market or sell your product.

Works of artistic craftsmanship

If you own copyright in a work of artistic craftsmanship, you will generally be able to take legal action under the Copyright Act against someone who copies that work. Your rights under the Copyright Act are not affected if you make and sell articles which reproduce the work – for example, if you make and sell copies of a handcrafted teapot.

Generally, if what you are seeking to protect can be classified as a "work of artistic craftsmanship" for copyright purposes, you have the option of registering your design under the Designs Act or continuing to rely on copyright for protection against people making replicas. However, if you register your item as a design and another person copies it, you may not be able to take action under the Copyright Act; you would need to see what legal action is available to you under the Designs Act.

You may therefore want to seek advice about whether or not, in your particular case, there would be advantages to registering your design under the Designs Act.

Also, you may want to get advice about whether or not your design is likely to be a "work of artistic craftsmanship" for copyright purposes: you might need this advice if your item is not what might traditionally be regarded as a craft item, or is something you create as part of the process of manufacturing a product. (This may be the case if your product is a design prototype, for example, or an embossing tool for embossing or stamping designs.)

Designs for 3D features which are not buildings or works of artistic craftsmanship

If you own rights in a design for a functional article, you will generally need to apply for design registration unless the design is:

- in two dimensions only; or
- a building; or
- a work of artistic craftsmanship.

Examples where design registration is likely to be needed include: a design drawing for a machine; a 3D prototype for a household appliance; and a design that is "embodied in" a product (for example, woven into the item, impressed onto it, or worked into it in some other way).

If registration is needed, you **must** register your design before you start exhibiting, manufacturing or marketing it. If you have any concerns about how copyright or design law will apply in your case, you should get advice from a lawyer with the relevant expertise.

Design registration

Applications for design registration need to be made to IP Australia.

IP Australia has its head office in Canberra and sub-offices in each State capital city. IP Australia can be contacted by telephone on 1300 651 010; it also has a website: www.ipaustralia.gov.au

Further information

For information about our other information sheets, other publications and seminar program, see our website: www.copyright.org.au

For information on design law, see also the information on the website of IP Australia: www.ipaustralia.gov.au

For information about protecting **inventions**, see the information on patents on the website of IP Australia: www.ipaustralia.gov.au

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Australian Copyright Council

The Australian Copyright Council is a non-profit organisation whose objectives are to:

- assist creators and other copyright owners to exercise their rights effectively;
- raise awareness in the community about the importance of copyright;
- identify and research areas of copyright law which are inadequate or unfair;
- seek changes to law and practice to enhance the effectiveness and fairness of copyright;
- foster co-operation amongst bodies representing creators and owners of copyright

Australian Government | Australia Council for the Arts

The Australian Copyright Council has been assisted by the Australian Government through the Australia Council, its arts funding and advisory body.

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