

A more seaworthy form of protection

Copyright vs Design Protection

The protection afforded by copyright in respect of industrial works was recently considered by the High Court (*Burge v Swarbrick* [2007] HCA17). The Court confirmed that copyright protection is available to artistic works applied industrially in three dimensions if such works can be considered works of artistic craftsmanship and have not been registered as designs. However, the Court's clarification of what could be considered a "work of artistic craftsmanship" clearly supports the notion that industrial designers should use Design Registration, rather than rely on copyright, to protect their R&D investment.

Swarbrick was the designer of a yacht known as the JS 9000. Swarbrick claimed copyright in a plug model, a hull and deck mould, drawings used in the design of the yacht, and in the yacht itself. Significantly, Swarbrick did not protect any of his works by design registration, and instead relied on copyright in asserting infringement by Burge.

The litigation turned upon the proper meaning of section 77(1) of the Copyright Act, and in particular the construction and application of the phrase "a work of artistic craftsmanship". Section 77(1) provides (among other things) that reproduction of an artistic work is not an infringement of the copyright in the artistic work once a product embodying the corresponding design has been applied industrially and unless the artistic work is a work of artistic craftsmanship.

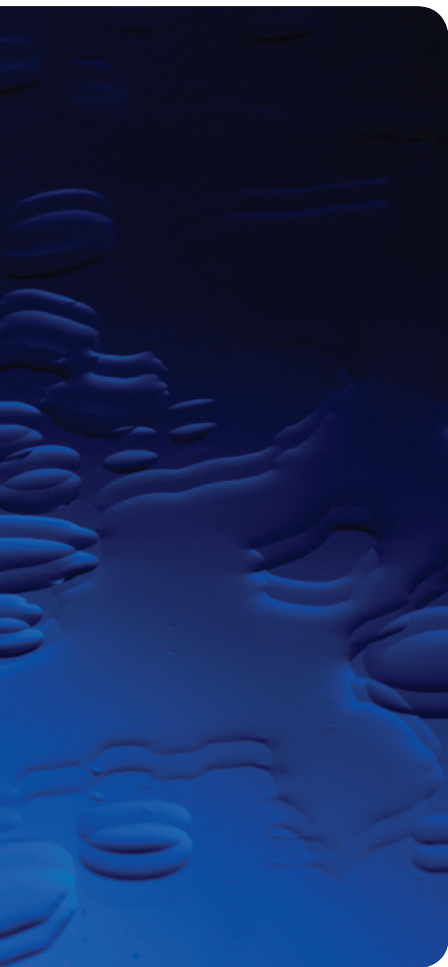
The High Court held that whether a work is a work of artistic craftsmanship does not turn on the beauty or aesthetic appeal of the work. Rather, such a determination should be based on the extent to which the work's artistic expression is unconstrained by functional considerations. The more substantial the requirement to satisfy a functional consideration, the less the scope is for determining the work to be one of artistic craftsmanship. In this regard, the High Court found that the plug was not a work of artistic craftsmanship, the corollary to this being that the hull and deck mouldings made from the plug were also not works of such character.



In reaching this decision, the High Court commented that a prototype such as a plug model may qualify as a work of artistic craftsmanship even though it may be to serve the purpose of reproduction and then be discarded. However, the court found that the design of the plug in question was not one that was unconstrained by the function or utility of the article. In particular, the court referred to a design brief for the JS 9000 yacht, in which it was stated that the JS 9000 was aimed at a market comprising of persons who wanted a yacht of good performance, capable of racing, but also usable for day sailing and relatively simple to sail with a minimum crew size, as well as being attractive. Swarbrick was also quoted as saying that in designing the JS 9000, he

wanted an easily balanced boat that was fast by contemporary standards. Such functional characteristics were deemed to constrain the aesthetics of the plug such that the plug could not be considered a work of artistic craftsmanship.

The High Court further quoted in its judgement statements by renowned architect Frank Lloyd Wright in 1894 to the effect that "It is the influence of nonaesthetic factors... that distinguishes true industrial design from other artistic endeavours" and that "The (industrial) designer cannot follow wherever aesthetic interests might lead. Utilitarian concerns influence, and at times dictate, available choices." In referring to these statements by Frank Lloyd Wright, the Court appeared to



be suggesting that it would be only under exceptional circumstances that an industrial work would be considered a work of artistic craftsmanship, and hence able to be protected by copyright.

With the Court finding that Swarbrick's works were not works of artistic craftsmanship, the claim of infringement failed. It would seem that had Swarbrick instead obtained Design Registration for his works, it is possible that a claim for design infringement may well have been successful.

Industrial designers are therefore encouraged to take a holistic approach to protection of their intellectual property. Copyright exists automatically when an artistic work (e.g. an engineering drawing) is created and can be used to protect the drawing from copying. However, a design registration can be used to protect the three-dimensional (functional) article. The two regimes may work side-by-side. Further, if there is something functionally different or special in the design, patent protection may also be appropriate.



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