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A B S T R A C T

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The Conference of the International Literary and Artistic Association (ALAI) was held this year to discuss the theme: Applied Arts under IP Law – The Uncertain border between Beauty and Usefulness. While it is usual to think in terms of copyright protection when we speak about typical artistic works such as those of literature, painting, music, theater or cinema, no great space has been given to discuss that part of the Intellectual Property that concerns aspects of the human creativity which can be also subject of the Industrial Property law, like the shape of industrial products that are often subject of IP tools such as registered designs. The border between “beauty and usefulness” of a product is often quite blurred, and there are differences in the approach of the law and the jurisprudence at national level from country to country. Hence, it is not often easy to say if, how, where and how long an industrial design can be protected, and this uncertainty can be of great impact on authors and industry, who risk losing protection on their original works. The conference offered a high level discussion on this topic with some of the internationally most renowned experts of intellectual property rights. The acts will be published in spring 2017.

1. ALAI

ALAI [1] is the acronym of the Association Littéraire et Artistique Internationale (International Literary and Artistic Association) founded in 1878 by a group of intellectuals including the famous French writer Victor Hugo to promote the international recognition of the legal protection of authors for their intellectual works. ALAI played an essential role in the establishment of the Berne Convention [2] for the Protection of Literary and Artistic Works.

It is extended throughout the world, particularly in Europe, America and in the Far East (Japan, Korea), and counts more than 30 national groups as members, each one providing a substantial contribution to the international debate on legal instruments related to copyright and performers' rights, by organizing congresses and study days dedicated to the in-depth analysis of every aspect of the topic.

Members are mostly lawyers, judges and law professors, members of societies, government advisory boards and special committees dealing with copyright and industrial design protection enforcement of several kind.

The annual conference is the highest moment of the association activity, it is organized every year with a particular theme and on a different country with the support of the national group, in this case the Italian one, which also celebrated the 75th anniversary of the Italian Copyright Act.

ALAI is also a valuable source of documentation on copyrights and related matters as they not only publish the acts of their conferences but also studies and works on specific topics, a list of which is available on their international website (www.alai.org) or on the website of the national groups (links available at <http://www.alai.org/en/members/national-groups>).

Before the conference the national groups have been requested to answer a questionnaire about the protection given to “Applied Arts” in their respective countries, and their answers actually constitutes a state of the art document on the topic [3].

2. The agenda

The program of the first day included an opening session with a general report on the international framework, a session where some regional or national approaches were explained, and a final panel discussing the other forms of protection for applied arts.

The second day started with the theme of business strategies and industry perspectives, then relationships with technology issues, particularly the 3D reproduction, were analyzed, and eventually legal analysis of challenges and possible solutions were discussed.

3. The conference – day 1

The conference began with the welcome addresses of the new president of ALAI International Frank Gotzen and of the Italian group Stefania Ercolani, who reminded that “beauty and usefulness” have been historically linked, it will be suffice to think at the Renaissance period when art and science were often embodied by a single person like Leonardo da Vinci: painter and sculptor, but also architect and engineer.

The introductory report given by Sam Ricketson, Professor of Law, Melbourne Law School, Australia, has well presented the existing issues, at once philosophical and practical, affecting the matter.

Questions like “What is meant by the expression “works of applied art”?”, “Why should they be protected”, and “What kind

of legal regime is best suited for this?” are to be considered, as well as the question of the possible coexistence of overlapping forms of protection on a same work.

The international framework consists of the Berne Convention for the Protection of Literary and Artistic Works, the Paris Convention for the Protection of Industrial Property [4] and the provisions of the TRIPs Agreement [5], but Ricketson has well outlined how only national caselaw and doctrine have been able to give a clearer meaning to the usual assumption of “works of art applied to industrial purposes”.

The requirement of “industrial purpose” does not mean that works of fine arts cannot have an “industrial” application, like eg. technical manuals or the software itself. We need only consider typical examples of products or manufactures intended to perform a technical function but having a special shape or ornamentation, like a design for fabrics, a racing yacht, a piece of furniture or even the famous Trevi fountain, originally built to bring water to the zone!

In all these kind of products it is sometime hard to separate utilitarian aspects from aesthetics, in most cases in fact there is a continuum from beauty and function where both ends are easily identifiable while in a more or less broad middle area it can be very difficult to determine which element prevails over the other.

Hence the different possible form of protections, from that focused on pure artistic elements (typically copyright), to that which usually concerns the work of industrial design (registered or unregistered designs), to those which consider the distinctive function (trademarks), the business behaviors (unfair competition) or the functional character (patents and utility models).

Moreover, when a work has many aspects deserving protection, it must be decided whether the cumulative protection of more than one juridical tool can be applied.

There are, historically, two schools of thought in this view, usually regarded as the French and the British one: the former has been in favour of the cumulative protection of applied arts through, primarily copyright and design law (the so-called “unity of art” theory), while the latter has considered that a product must be given alternatively one or the other kind of protection.

The developments of the Berne Convention as well as the Paris Convention have been heavily affected by this dichotomy, trying to find a satisfactory compromise.

The Paris Convention has included designs and industrial models in the Lisbon Revision of 1958, but article 5 quinquies only stated that “Industrial designs shall be protected in all countries of the Union”, giving no indication of the means to do that, so leaving the door open to both copyright and design law.

Then TRIPs articles 25 and 26 introduced the requirement of “independent creation” coupled with that a design should be “new or original”.

Ricketson’s conclusions were therefore that “the treatment of works of applied art remains one of the large gaping holes in the international framework ...”.

Uma Suthersanen, professor of International Intellectual Property Law at the University of London has talked about the design IP regulations in the European Union starting from the recently published survey “Legal review on industrial design protection in Europe” [6].

Fifteen countries participated to this survey, which was addressed to understand which are the current issues and how to improve the system, considering both the national and EU approach in regard to:

- 1 Scope of design & criteria of protection, including the visibility and disclosure criteria
- 2 Functionality

- 3 Spare parts
- 4 3-D printing
- 5 Relationship between design law and copyright

The European Union law is based on the Design Directive 98/71/EC [7], which brought to a substantial harmonization amongst the territory, with few but important exceptions:

- Art. 14 (the spare parts clause) has not been implemented in many countries including Germany and France
- Art. 17 (the copyright/design overlap) not executable in UK, Germany and other countries.

The speech has touched many aspects concerning the design protection, like the individual character and the product sector identification, the “visibility” requirement, the exclusion of the technical function from the protection, and the possible approaches to analyze this function.

European caselaw was cited, who provided interesting definitions of the several elements, even if they do not clarify definitely the situation. For example the decision of 2011 of the UK Supreme Court in the case *Ainsworth v Lucasfilm* [8] under the Section 52 CDA which stated that the Star Wars “Stormtrooper helmet” was not protected by copyright (as subject of “sculpture” or anyhow as “works of artistic craftsmanship”) but only by a registered design in consideration of its utilitarian function in the context of the film it was used [Fig. 1](#).

Another important decision was that of January 27, 2011 in the *Flos vs Semeraro* case on the “Arco” lamp (C-168/09) [9] where the European Court of Justice interpreted Article 17 of the Directive 98/71/EC on the legal protection of designs in the sense that a national law cannot refuse copyright protection to designs that, even if entered into the public domain (due to lack or lapse of protection as registered designs), are eligible to this protection [Fig. 2](#).

Following this trend, the UK Section 52 has been repealed in 2016 and now industrially manufactured works which have fallen out of protection by registered designs could have copyright revived.

The choice between one law and the other is very important considering the duration of the registered design (25 years) versus the copyright (the life of the creator plus 70 years), the costs and difficulties required to obtain the design registrations while copyright does not require any filing procedure, the territorial limits of the registrations compared with the international extension of the rights under the Berne Convention.

The situation in France, Italy, USA and Latin America has been then explained by other speakers, with richness of caselaw examples.

In the last session of the day possible other forms of protection of designs were examined: (un)registered designs, patents and utility models, trademarks and unfair competition.

4. The conference – day 2

The second day was focused on the industry perspectives, with an introductory speech of the director of the Italian Patents and Trademarks Office Ms. **Loredana Gulino**, followed by presentations regarding the companies strategy in protecting their designs in Germany, Turkey and Australia, also in consideration of practical issues, procedures, costs, etc.

Pierre Sirinelli, Professor of Private Law at the University Paris-1, presented the scenario of legal protection of 3D printing, which is a work in progress, and involves a number of players, from the author of the design and of the software or the digitalisation maker up to the private user, who usually downloads the software from

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