

# **Designs and their Interface with the Copyright under French law**

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## Directive 98/71/EC on the legal protection of designs

(8) Whereas, in the absence of harmonisation of copyright law, it is important to establish ***the principle of cumulation of protection*** under specific registered design protection law and under copyright law, whilst leaving Member States free to establish ***the extent of copyright protection*** and ***the conditions*** under which such protection is conferred.

# Directive 98/71/EC on the legal protection of designs

## Article 17 Relationship to copyright

A design protected by a **design right registered** in or in respect of a Member State in accordance with this Directive **shall also be eligible for protection under the law of copyright of that State** as from the date on which the design was created or fixed in any form. The extent to which, and the conditions under which, such a protection is conferred, ***including the level of originality required***, shall be determined by each Member State.

# The Unity of Art Thesis in France

19<sup>th</sup> century – French courts and commentators strived to establish a strict line of demarcation between designs that deserved protection as works of art under the French copyright law and those that deserved only protection under special design law.

# The Unity of Art Thesis in France

French courts tried different criteria for distinguishing the subject matter of these two regimes:

- the method of reproduction;
- the purpose or end use of the design;
- the secondary or accessory character of the aesthetic features;
- the status of the creator;
- the relative artistic value of the candidate design.

# The Unity of Art Thesis in France

French **copyright law** was amended in 1902 and **extended protection to designers of ornaments, whatever may be the merit or the purpose of the work.**

**The design law of July 14, 1909** further confirmed the unity of art thesis and gave designers the opportunity to acquire protection under both regimes.

# The Unity of Art Thesis in France

The results produced by the unity of art thesis:

- France extended copyright protection to all industrial art.
- It led to gradual integration of copyright law and special design law into a regime of absolute (total) cumulation.

# Absolute (total) cumulation v. relative (partial) cumulation

Absolute cumulation - registered designs are automatically protected as copyright works.

Relative cumulation - valid registered designs may be protected by copyright, if they satisfy copyright protection requirements.



# Novelty

The novelty is **an objective requirement** (comparative approach) which leads to verification among the items already disclosed if one of them is identical or extremely close to the object of study, that is to say if there is ***a one to one anticipation of all parts (FR : antériorité de toutes pièces)*** destructive of novelty.

Article L511-3. A design or model shall be considered to be new if, on the date of the filing of the application for the registration or on the date of priority claimed, no identical design or model has been disclosed. Designs or models shall be deemed to be identical if their features differ only in immaterial details.

# Individual Character

Individual character requirement was introduced in French law in 2001 as an implementation of the Directive 98/71/EC.

Article L511-2. A design or model shall only be protected if it is new and has an individual character (caractère propre).

# Individual Character

participates in **an objective assessment** of the design protection threshold by going beyond the requirement of novelty and raising the threshold for design protection.

Article L511-4. A design or model has individual character (FR: caractère propre) if the overall visual impression it produces on the informed observer differs from that produced by any design or model disclosed before the date of the filing of the application for registration or before the date of priority claimed.

In assessing individual character, the degree of freedom of the creator in developing the design or the model shall be taken into consideration.

**CJEU jurisprudence:** *Infopaq, Premier League, Eva Maria Painer, Football Dataco.*

The author's right to authorise or prohibit reproduction applies to a **“work”**, i.e. **the author's own intellectual creation.**

# French Intellectual Property Code

Article L112-1. The provisions of this Code shall protect the rights of authors in **all works of the mind, whatever their kind, form of expression, merit or purpose.**

# Novelty and/or Originality?

Originality is a **subjective requirement** which determines whether the design reflects **the imprint of the personality of the creator**, the personal origin of creation, regardless of any prior art, thereby excluding the comparative approach.

**The requirement of creative effort** is not listed in the article L511-2 IPC. It is in fact a requirement **appropriate for copyrights** and different from requirements applicable for designs (High Court of Paris, 7 avr. 2015, n° 14/07503)



The Court of Cassation, ch. com., February 10, 2015,  
n° 13-27.225





The Court of Cassation, ch. com., February 10, 2015,  
n° 13-27.225

**A combination of choices, even arbitrary, made by a designer will not confer originality, thereby allowing copyright protection, if this combination does not convey his personal aesthetic bias.**

Appeal Court of Paris, Pole 5, Ch. 1, April 12, 2016,  
SANDRO ANDY SAS / DIRAMODE SA



Appeal Court of Paris, Pole 5, Ch. 1, April 12, 2016,  
SANDRO ANDY SAS / DIRAMODE SA

The concept of “prior art” (antériorité) is immaterial in copyright law, which requires from the claimant copyright protection to prove that the work has ***an individual character which conveys an aesthetic bias of the author and reflects an imprint of the author’s personality.***

Appeal Court of Paris, Pole 5, Ch. 1, April 12, 2016,  
SANDRO ANDY SAS / DIRAMODE SA

***The trial court considered that the claimed model***, which appears as the paradoxical combination of classic features of a straight cut coat, three quarters, plain, wool, feminine, and more elements such as the type of biker collar with silver snap fasteners at its ends, leather tabs on his shoulders, asymmetrical silver zipper and zippered sleeves, giving it a hybrid character, male and female both reinforced by the use of two materials wool and leather, ***shows known elements but in an innovative combination and thus reflects the author's personality, and therefore can benefit from copyright protection.*** None of the models cited by the company DIRAMODE contain all the cited characteristics in the same combination.

High Court of Paris, ch. 3, March 25, 2016,  
ISABEL MARANT DIFFUSION SAS / MANGO FRANCE SARL.

*Splurge v Save  
For Life or For Now*



*Isabel Marant*



*Mango*

High Court of Paris, Ch. 3, March 25, 2016, ISABEL  
MARANT DIFFUSION SAS / MANGO FRANCE SARL.

An original shape may result from the original combination of known elements. The originality of the work stems from ***aesthetic biases and arbitrary choices*** that give it a ***particular look*** (FR : *physionomie propre*) and ***so it reflects the author's personality.***

High Court of Paris, Ch. 3, March 25, 2016, ISABEL  
MARANT DIFFUSION SAS / MANGO FRANCE SARL.

Also the use of several materials with sophisticated appearance on a wedge heel boot with a slim and narrow heel, narrow toe and slightly rounded, constitutes an elegant evening shoe and contrasts with the three wide flanges on the front inspired by sportswear and professional shoes universe, all giving the boots in question a ***particular look*** that cannot be found in any of the prior art models presented by the defender, ***so this shoe reflects the author's personality and is original.***

Court of Cassation, civ. ch. 1, April 5, 2012,  
JM WESTON / MANBOW Sas et FIMAN Sa





Court of Cassation, civ. ch. 1, April 5, 2012,  
JM WESTON / MANBOW Sas et FIMAN Sa

The court estimated that the model reproduced in a catalog presented by the defendant as a prior art state evidence, had all the characteristics of the shoes in dispute and deprived it of originality, therefore, the model invoked did not qualify for protection under the copyright but, ***since it was not a one to one anticipation of all parts (FR : ant riorit  de toutes pi ces), the applicant was nevertheless entitled to act on the basis of his design rights.***

# Copyright

- **A single (subjective) requirement : originality,** which is defined by jurisprudence as the imprint of the author's personality
  - the personal origin of creation, regardless of any prior art, therefore regardless of any comparative approach. There is no such defined preexisting heritage of forms as for novelty.
- **Proof of ownership.**
- **Infringement is determined by similarities.**

# Designs

- **Two (objective) requirements : novelty and individual character** which lead to verification among the items already disclosed if one of them is identical or extremely close to the object of study (comparative approach).
- **Presumption of ownership.**
- Infringement - **visual overall impression** on an informed user, taking into account not only differences but also similarities.
- Not just a complementary regime, but a new regime of specific protection with its own limitations.