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CHAPTER 7 : THE COPYRIGHT/DESIGN INTERFACE IN AUSTRALIA

Chronological table of legislation and statistics

Period	Legislation	Amendments	Interpretation (ie by courts)	Further information	Design applications	Design registrations
1. 1852 - 1906	Copyright Act 1869 (Vic) Copyright Act 1878 (SA) Copyright Act 1879 (NSW) Patents, Designs and Trade Marks Act 1884 (Qld) Designs and Trade Marks Act 1884 (WA) Patents, Designs and Trade Marks Act 1893 (Tas)	Exhibitors Protection Act 1872 (Vic) Designs and Trade Marks 1884 and Patent Act Amendment Act 1886 (WA) Copyright Act 1890 (Vic)	Cumulation (Vic, NSW, SA, QLD) Partial demarcation (WA & Tas) – excluded sculptures	Some early colonial legislation dealt with designs and patents for inventions in the same acts: Letters of Registration for Inventions Act 1852 (NSW) Patent Act 1859 (SA)	No data	No data
2. 1907 - 1912	Copyright Act 1905 (Cth) Design Act 1906 (Cth)		Cumulation?		WIPO 1151 (192)	WIPO 988 (165)
3. 1913- 1968	Copyright Act 1912 (Cth) Design Act 1906 (Cth)		Demarcation, no copyright protection for acts within scope of design protection.		WIPO 51936 (944)*	WIPO 42459 (772)*
4. 1969- 1980	Copyright Act 1968 (Cth) Design Act 1906	Designs Act 1968 (Cth) Design Regulations 1969 (Cth)	As above, period 3		WIPO 29294 (2441) IP Australia (1972 – 1980) 6936 (771)**	WIPO 21239 (1770) IP Australia (1972 – 1980) 3156 (351)**
5. 1981- 1989	Copyright Act 1968 (Cth) Designs Act 1906 (Cth)	Designs Amendment Act 1981 (Cth)	As above, period 3		WIPO 35401 (3933) IP Australia 28394 (3155)	WIPO 24337 (2704) IP Australia 21531 (2392)
6. 1990 - 2003	Copyright Act 1968 (Cth) Designs Act 1906 (Cth)	Copyright Amendment Act 1989 (Cth)	Partial cumulation for 2 dimensional artistic works, demarcation for 3 dimensional works applied industrially, demarcation for works of artistic craftsmanship, buildings and models of buildings (copyright protection unless register a design)		WIPO 58575 (4184) IP Australia 58645 (4189)	WIPO 47804 (3415) IP Australia 47801 (3414)

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7. 2004 - 2015	Copyright Act 1968 (Cth) Design Act 2003	Designs (Consequential Amendments) Act (2002)	As above, period 6	Definition of 'building or model of building' altered so as not to include portable buildings, pre-constructed swimming pools and demountable buildings.	WIPO (to 2014) 66236 (6021) IP Australia (to 2015) 73496 (6125)	WIPO (to 2014) 64085 (5826) IP Australia (to 2015) 70639 (5887)
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*No data for 1941.

** The huge discrepancy between data from WIPO and data from IP Australia in the period prior to 1981 must raise serious doubts as to the accuracy of the data in this period. IP Australia suggests that the WIPO data is more likely to be accurate (personal communication with author).

Introduction

The law relating to designs in Australia has long been the subject of dissatisfaction. As long ago as 1936, Sir Owen Dixon referred to the Designs Act 1906 as 'rather peculiar'¹, while the interface between copyright and designs has garnered even more pointed criticism, being called 'troubled'², 'vexed'³ and an area of '(perennial) confusion'.⁴ At different times Australia has adopted different approaches to the overlap, moving from potential cumulation (or dual protection as it is more commonly known in Australia) to demarcation and then to partial cumulation (for two-dimensional works) combined with demarcation (for three-dimensional works). Legislative implementation of these policies, however, has been far from straightforward. At each stage, Australia looked to the United Kingdom to inform its legislative approach. While never simply slavishly copying the UK's legislative language, the tendency was at first to follow generally where the UK led. From 1968, however, the position of the two countries diverged, with Australia pursuing a stricter approach of demarcation until it adopted partial cumulation in 1989. Moreover, while the UK simplified its legislative provisions, Australia's approach was to add further detail – an approach that has not necessarily resulted in greater clarity.

The first section of this chapter examines the history of designs and the copyright/design interface in Australia from 1852 to the present, while the second section briefly looks at some of the ongoing problems in this area. Although issues also arise as to the interrelationship between patents and designs, and to a lesser extent between trade marks and designs, this chapter does not address these in any detail.

Part A History of the copyright/design interface in Australia

1. First period 1852 – 1906: Varying approaches in the colonies prior to Federation

* I am grateful to Eloise Chandler and Kosta Hountalas for research assistance and to Jill McKeough and Kimberlee Weatherall for reading this chapter in draft. All errors remain my own.

¹ *Macrae Knitting Mills Ltd v. Lowes Ltd* (1936) 55 CLR 725, p. 729; (1936) 10 ALJR 201; [1936] HCA 43.

² Jani McCutcheon, 'Too many stitches in time? The Polo Lauren case, non-infringing accessories and the copyright/design overlap defence' (2009) 20 *Australian Intellectual Property Journal* 39, 52.

³ Sam Ricketson, 'Towards a Rational Basis for the Protection of Industrial Design in Australia' (1994) 5 *Australian Intellectual Property Journal* 193, 194.

⁴ Advisory Council on Intellectual Property, *Review of the Designs System: Options Paper* (2014), 30.

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After many years of comparative neglect, recent years have seen growing levels of academic interest in the history of intellectual property in Australia.⁵ Design rights, however, have not yet seen the benefits of this emergent interest and the copyright/design interface still less so.⁶ This section thus briefly sketches the early years of intellectual property laws and the legal background against which they developed.

When the tall ships of the First Fleet arrived in Botany Bay in January 1788, they carried with them all English laws applicable to the conditions of the new colony. During the colony's infant years, few if any of the new arrivals – the majority of whom had not travelled there by choice but under Her Majesty's pleasure – would have considered England's panoply of intellectual property laws applicable or relevant to the situation in which they found themselves. However, as the settlement expanded, with new arrivals bringing valuable skills both technical and entrepreneurial, opportunities for commerce, industry and cultural production began to grow. Governors, and soon the Legislative Councils of the two colonies of New South Wales and Van Diemen's Land, had power to pass local laws, as long as they were not 'repugnant' to the Laws of England, and in 1828 the imperial Parliament enacted the Australian Courts Act 1828 (UK) which stated explicitly that English statutes and judicial decisions were operative in New South Wales and Van Diemen's Land.⁷ However, English Acts passed after 1828 were not operative unless they applied by paramount force – in other words, stated that they applied to the colony in question.⁸

The British statutes relating to copyright, patents and designs thus passed prior to those dates formed part of the colonies' law, and some later statutes were expressed to apply by paramount force.⁹ The colonial legislatures also had the power to enact local laws and this included the ability to issue patents by parliamentary act.¹⁰ However, it was soon realised that the UK statutes did not apply to books published or inventions first made in the colony in question.¹¹ Moreover, the Patent Law Amendment Act 1852 (UK) provided patents would not apply automatically to the colonies,¹² and the 1868 decision of *Routledge v Low*¹³ confirmed in the field of copyright that books published in the colonies would have protection in a colony, and only in that colony, if it had passed a copyright statute (which none of them had).¹⁴

⁵ See the references in Catherine Bond, "'Cabined, Cribbed, Confined, Bound In': Copyright in the Australian Colonies', in Isabella Alexander and H. Tomás Gómez-Arostegui (eds.), *Research Handbook on the History of Copyright Law* (Cheltenham: Edward Elgar Publishing, 2016), pp.374-81 and Kimberlee Weatherall, 'The Emergence and Development of Intellectual Property Laws in Australia and New Zealand' in Rochelle C. Dreyfuss and Justine Pila (eds) *The Oxford Handbook of Intellectual Property Law* (OUP, forthcoming 2016).

⁶ Weatherall, 'The Emergence and Development of Intellectual Property Laws', pp. []

⁷ Bruce Kercher, *Unruly Child: A History of Law in Australia* (St Leonards: Allen & Unwin, 1995), pp. 69 - 74.

⁸ *Ibid.*, p. 75. The 1828 Act also applied to Victoria, Queensland and the Australian Capital Territory, as they were carved out of New South Wales and thus took its law with them at the time of separation. Western Australia and South Australia were established separately and it was assumed that they took with them the laws of England in force at the time of settlement, 1829 and 1836 respectively.

⁹ The 1842 Copyright Act applied by paramount force but neither the 1942 Ornamental Designs Act nor the 1843 Utility Designs Act did so.

¹⁰ Jeremy Finn, 'Particularism versus Uniformity: Factors shaping the development of Australasian Intellectual Property Law in the Nineteenth Century' (2000) 6 *Australian Journal of Legal History* 113, 119.

¹¹ Bond, "'Cabined, Cribbed, Confined, Bound In'", pp.381-2.

¹² An Act for Amending the Law for Granting Patents for Inventions 1852, 15 & 16 Vict c. 83 (UK).

¹³ *Routledge v. Low* (1868) LR 3 HL 100.

¹⁴ Bond, "'Cabined, Cribbed, Confined, Bound In'", p.386.

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These developments spurred the colonies to a legislative response and patent law was the first area to command attention. It was the patents regime, broadly conceived, which encompassed designs. The first colony to act was New South Wales, which had the largest population and the greatest concentration of industrial activity,¹⁵ and it enacted the Letters of Registration for Inventions Act 1852.¹⁶ The Act empowered the NSW Governor General, acting with the advice of his Executive Council, to grant Letters of Registration 'for the exclusive enjoyment and advantage for a period of not less than seven nor more than fourteen years for all inventions and improvements in the Arts or Manufactures to the author or authors or designer or designers thereof.'¹⁷

In its focus on improvement of 'arts and manufactures', the Act demonstrates its influences lay not in the 1852 Patent Law Amendment Act recently enacted in the United Kingdom, but rather in earlier British proposals for a general law of arts and manufacture.¹⁸ It was concerns surrounding the applicability of English patent laws, combined with proposals for the first Australasian Industrial Exhibition, driving enactment of this first statute.¹⁹ The question of whether the colonial Legislature was competent to grant patents or pass a patent law occasioned some debate in the press,²⁰ but it was nonetheless passed.

The colony of Victoria was established in 1851 and three years later, with the gold rush well underway, it passed a Patent Act which allowed for the granting of letters patent to 'the originator or discoverer of any new invention or improvement in the arts or manufactures'.²¹ The language of arts and manufactures remained, but the reference to designers was gone.²² Tasmania largely copied the Victorian Act in its own statute in 1858²³ as did Western Australia in 1872.²⁴ South

¹⁵ In 1851, the population of NSW was 181,400: G. J. R. Linge, *Industrial Awakening: A Geography of Australian Manufacturing 1788 to 1890* (Canberra: Australian National University Press, 1979), p. 53.

¹⁶ An Act to authorize the Governor General with the advice of the Executive Council to grant Letters of Registration for all inventions and improvements in the Arts or Manufactures to have the same effect as Letters Patent in England so far as regards this Colony 1852, 16 Vic. 24.

¹⁷ *Ibid.*, s. 1.

¹⁸ The 1836 Select Committee on Arts and Manufactures was established to 'inquire into the best means of extending a knowledge of the Arts and of the Principles of Design among the People (especially the Manufacturing Population of the Country'. Select Committee on Arts and Manufactures, House of Commons; Report from the Select Committee on Arts and their Connexion with Manufactures with the minutes of evidence, appendix and index (1836 9 PP 1), 568, iii. Several bills following its recommendations were subsequently presented to Parliament in the late 1830s. Brad Sherman and Lionel Bently, *The Making of Modern Intellectual Property Law* (Cambridge: Cambridge University Press, 1999), pp.104-5.

¹⁹ Following the Australasian colonies' disappointing showing in the Great Exhibition of 1851, more concerted efforts were made to make the most of opportunities offered by international exhibitions and to organise local ones, with the first being held in Sydney and Melbourne in 1854. See Peter H. Hoffenberg, "'Nothing Very New or Very Showy to Exhibit'? Australia at the Great Exhibition and After', in Jeffrey A. Auerbach and Peter H. Hoffenberg (eds.), *Britain, the Empire and the World at the Great Exhibition of 1851* (Hampshire: Ashgate, 2013). The Maitland Mercury and Hunter River General Advertiser, 9 April 1851, p. 2; Sydney Morning Herald, 9 April 1851, p.3. Sydney Morning Herald, 11 April 1851, p. 3.

²⁰ Sydney Morning Herald, 11 April 1851, p. 3.

²¹ An Act to regulate Grants of Patents for Inventions in the Colony of Victoria 1854, 17 Vic. c. 15.

²² This Act too was repealed and replaced in 1857 with a new Act, referring now only the need to 'promote and encourage the discovery of new manufactures'. An Act concerning Letters Patent for Inventions 1857, 20 Vic. c. 3, s. 1.

²³ An Act to regulate the granting of Letters Patent for Inventions 1858, 22 Vic. No. 22 (Tas).

²⁴ An Act to regulate Grants of Patents for Inventions in the Colony of Western Australia 1872, 36 Vic. No. 1 (WA).

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Australia drew on the New South Wales Act in its Patent Act of 1859²⁵ and thus adopted the same approach of a general law of arts and manufactures covering inventors and designers. Queensland adopted its own Patents Act in 1867 but although its title it referred to inventions and improvements in the arts and manufactures, its aim was limited to giving temporary protection to inventors more cheaply than the current cost of obtaining letters of registration by government petition.²⁶

At this stage, protection of designs shifted into the copyright sphere in some of the colonies. The first colonial copyright statute was passed in Victoria in 1869, at the urging of a deputation including designers,²⁷ and its very first operative section related to 'copyright of designs for articles or works of manufacture or art.'²⁸ While the provisions of this Act were clearly based on British legislation relating to designs, the Victorian legislature did not follow the British approach of splitting designs into ornamental and useful categories. The Act in fact was a blend of the 1842 Ornamental Designs Act²⁹ and the 1843 Utility Designs Act.³⁰ Section 3 of the Act protected 'the proprietor of any new and original design for any article or work of manufacture or art, and whether such article or work be for purposes of utility ornament or otherwise'.³¹ The Act also differed from its UK forebears in some reordering of words and sections and, more significantly, in the periods of protection.³² This Act was amended in 1872 and repealed and replaced in 1890 with a new copyright statute, in which the designs provisions were unchanged.³³

The next colony after Victoria to pass copyright legislation was South Australia, in 1878.³⁴ This Act was closely modelled on the Victorian Statute but South Australia did away with the notion of different classes in which designs should be registered, leaving it to the proprietor to determine

²⁵ An Act to authorize the Governor-in-Chief, with the advice of the Executive Council, to grant Letters of Registration for all Inventions and Improvements in the Arts or Manufactures, to have the same effect as Letters Patent in England, so far as regards the Province of South Australia 1859, 22 & 23 Vic. No. 18 (SA).

²⁶ An Act to Amend the Law relating to Letters of Registration for Inventions and Improvements in the Arts or Manufactures by granting Provisional Certificates of Registration for a Limited Period 1867, 31 Vic. No. 26 (Qld); *The Queenslander*, 30 November 1867, p. 6.

²⁷ *The Leader*, 17 April 1869, p. 12; Victoria, *Parliamentary Debates*, Legislative Assembly, 31 August 1868, pp. 1837-8 (G. Paton Smith).

²⁸ An Act to secure to Proprietors of Designs for Articles and Works of Manufacture and Art, and to Proprietors of Works of Literature and Fine Art, the Copyright of such Designs and Works for a limited period 1869, 33 Vic. No. 350, s. 3.

²⁹ An Act to Consolidate and Amend the Laws Relating to the Copyright of Designs for Ornamenting Articles of Manufacture 1842, 5 & 6 Vic. c. 100.

³⁰ An Act to Amend the Laws Relating to the Copyright of Designs 6 & 7 Vic. c. 65 (1843).

³¹ *Ibid.*, s. 3.

³² The 1842 British Ornamental Designs Act offered three different levels of protection: 3 years for goods in classes 1 to 6, 9 and 12, 12 months for articles in classes 13 and 14 and 9 months for articles in classes 8, 10 and 11. Moreover, the 1843 Utility Designs Act gave 3 years of protection for useful designs. By contrast, the Victorian Act gave 3 years of protection to articles registered in classes 1 to 5 and two years of protection to the remainder. The classes were almost identical to the British classes of the 1842 Ornamental Designs Act, with an additional class covering articles made of ivory, bone, papier-mache and other solid substances not already included.

³³ The 1872 Act provided that designs falling under s3 and fine art works falling under s36 of the Copyright Act 1869 would retain their protection under that Act even in the event they were publicly exhibited at an exhibition of works of industry and art: An Act to protect Exhibitors of New Inventions and Works of Industry and Art 1872, 36 Vic. No. 422 (Vic). See also An Act to consolidate the Law relating to Copyright 1890, 54 Vic. No. 1076 (Vic).

³⁴ An Act to regulate the Law of Copyright and for other purposes 1868, 41 & 42 Vic. No. 45 (SA).

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whether they would register for one, two or three years of protection.³⁵ New South Wales passed its Copyright Act the following year and the provisions on design copyright were effectively identical to those of Victoria.³⁶

Western Australia, Queensland and Tasmania, however, took a different approach. Rather than including designs in their copyright acts, they followed the more recent UK approach. The WA legislature provided protection for designs in its Designs and Trade Marks Act 1884.³⁷ In the same year, Queensland passed The Patents, Designs and Trade Marks Act 1884.³⁸ In 1893 Tasmania passed an act which repealed its existing patents and trade marks legislation.³⁹ All were closely modelled on the UK Act of 1883 (although Western Australia continued to treat patents separately). They thus covered 'new or original' designs, to be protected for a period of five years from registration. They also excluded protection for sculptures.⁴⁰

A final point to be made about the provisions on designs in every one of the colonies is that they contained penal provisions. Anyone who applied any designs, or fraudulent imitation of a design, for the purposes of sale, or who sold or exposed such designs knowing they did not have the consent of the proprietor, would be liable to a penalty of between five and 50 pounds.⁴¹ While civil actions were also available, it was the summary conviction that was used and appealed in the only officially reported case I am aware of involving colonial design rights. In *R v Radke, ex parte Dyke*, Radke appealed his conviction under the Copyright Act 1869 (Vic) for selling a safe to which a registered design had been applied, knowing that the proprietor Dyke did not consent.⁴² The judges quashed the conviction, accepting Radke's argument that an 'iron frame for a safe' was not an appropriate subject matter for copyright protection, but was more suited to a patent, commenting 'Shape and configuration are not the same as a combination of parts'.⁴³

At the end of the nineteenth century, protection of designs in what was yet to become Australia was subject to a confusing array of laws, both colonial and imperial.⁴⁴ This reflects the fact that the

³⁵ *Ibid.*, s. 3.

³⁶ An Act to secure to Proprietors of Works of Literature and Fine Art and to Proprietors of Designs for Articles and Works of Manufacture and Art the Copyright of such Works and Designs for a limited period 1879, 42 Vic. No. 20 (NSW).

³⁷ An Act to regulate the Registration of Designs and of Trade Marks in the Colony of Western Australia 1884, 48 Vic. No. 7, amended by An Act to alter the law relating to the procedure under 'The Designs and Trade Marks Act 1884 (Vic)' and 'An Act to regulate grants of Patents for Inventions in the Colony of Western Australia 1886, 50 Vic. No. 5.

³⁸ An Act to amend and consolidate the law relating to Patents for Inventions, and the Registration of Designs and Trade Marks 1884, (WA), No. 13 of 1884.

³⁹ An Act to amend the Law relating to Patents for Inventions, and the Registration of Designs and Trade Marks 1893, 57 Vic. No. 6 (Tas).

⁴⁰ Designs and Trade Marks Act 1884 (WA), s. 17; Patents, Designs and Trade Marks Act 1884 (Qld), s. 3; Patents, Designs and Trade Marks Act 1893 (Tas), s. 4.

⁴¹ Copyright Act 1869 (Vic) s. 10; Copyright Act 1879 (NSW) s. 41; Copyright Act 1878 (SA) s. 10; Designs and Trade Marks Act 1884 (WA) s. 15; Patents, Designs and Trade Marks Act 1884 (Qld), s. 58; Patents, Designs and Trade Marks Act 1893 (Tas) s. 66.

⁴² *R v. Radke, Ex parte Dyke* (1882) 8 VLR (L) 23.

⁴³ *Ibid.*, 25. A criminal prosecution was also pursued in *McLean v Wood*, *The Age*, 30 October 1877, p. 4, but a civil action was contemplated in *Rosenthal v Kaufman*, *The Argus*, 6 September 1893, p. 7.

⁴⁴ For more on the interaction of imperial law with colonial legislation in this field see Acland Giles, 'Literary and Artistic Copyright in the Commonwealth' (1905-6) 3 *Commonwealth Law Review*, 107, 113, Lionel Bently, 'The "Extraordinary Multiplicity" of Intellectual Property Laws in the British Colonies in the Nineteenth Century'

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colonies were introducing their laws at the time when, as Sherman and Bently have argued, intellectual property was shifting from its pre-modern to its modern form.⁴⁵ While they suggest that in Britain the new logic was emerging by the 1850s, the Australian colonies were still experimenting with different structures and categories, looking to the 'mother country' for guidance but also, at least in the case of the larger colonies, striking out with a few tentative steps on their own. While there was no explicit prohibition against protecting something using both copyright and design registration (except for sculpture in WA, Tasmania and Queensland), it seems that the general assumption was that different regimes applied to different types of subject matters and products, and that it was up to the relevant creator (whether they be author, inventor or designer) to decide which was the most appropriate path of protection.⁴⁶

2. Second Period 1907 - 1912: Cumulation?

In 1901, the six colonies joined together to form the Commonwealth of Australia. The new Constitution gave to the new Federal Parliament the power to legislate in relation to 'copyrights, patents of inventions and designs, and trade marks.'⁴⁷ Within five years, Parliament had exercised that power in relation to each of the intellectual property subject matters, passing the Patents Act in 1903⁴⁸, the Copyright Act⁴⁹ and the Trade Marks Act⁵⁰ in 1905, and the Designs Act⁵¹ in 1906. The Designs Act was, in a sense, the final piece of the intellectual property puzzle. Senator Keating, who introduced the bill into the Senate on 20 June 1906, informed the House that it was necessary to pass the bill because 'correspondence between the Governments of the Commonwealth and of the United Kingdom has revealed that we are not entitled to the measure of international protection which Britain obtained for herself and her Colonies by the Convention of 1894⁵² unless our legislation covers the whole field of patents, designs, and trade marks.'⁵³

The bill, which became the Designs Act 1906, did not echo the UK Patents, Designs and Trade Marks Act 1883 in the same way as the Western Australian and Tasmanian statutes had done. Rather, it sought to express those legislative principles alongside their judicial interpretation and development.⁵⁴ It was the places where the Australian Bill differed from the UK Act that occasioned most debate. One of the first objections related to the division of the different subject matters into separate legislative instruments, rather than in a single Act as in the UK. However, as Keating

(2011) 12 *Theoretical Inquiries in Law* 161, Sam Ricketson, 'The Imperial Copyright Act 1911 in Australia', in Uma Suthersanen and Ysolde Gendreau (eds.), *A Shifting Empire: 100 Years of the Copyright Act 1911* (Cheltenham: Edward Elgar Publishing Ltd, 2013), pp. 53-62; Bond, "'Cabined, Cribbed, Confined, Bound In'", Robert Burrell, 'Copyright Reform in the Early Twentieth Century: the View from Australia' (2006) 27 *The Journal of Legal History* 239, 240-46.

⁴⁵ Sherman and Bently, *Making of Modern IP Law*.

⁴⁶ A far from thorough perusal of the Victorian Copyright Register suggests that on several occasions designed products were registered as engravings – see for example the bamboo and rush chairs prototypes at A1719, 2746C and 2753C (National Archives of Australia).

⁴⁷ Commonwealth of Australia Constitution Act, s. 51(xviii).

⁴⁸ Patents Act 1903 (Cth).

⁴⁹ Copyright Act 1905 (Cth).

⁵⁰ Trade Marks Act 1905 (Cth).

⁵¹ Designs Act 1906 (Cth).

⁵² Presumably this is an error, and in fact the Paris Convention 1883 (which the United Kingdom acceded to in 1884) is intended.

⁵³ Commonwealth, *Parliamentary Debates*, Senate, 20 June 1906, 392 (Senator John Keating).

⁵⁴ Commonwealth, *Parliamentary Debates*, Senate, 20 June 1906, 394 (Senator John Keating).

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pointed out, given that separate patents, copyright and trade marks statutes had already been enacted, 'the time for the consideration of that point has passed.'⁵⁵

A second significant change made in the Australian Act was to the definition of 'design'. The 1883 UK Act definition was as follows:

'Design' means any design applicable to any article of manufacture, or to any substance artificial or natural, or partly artificial and partly natural, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined, not being a design for a sculpture, or other thing within the protection of the Sculpture Copyright Act of the year 1814 (fifty-fourth George the Third, chapter fifty-six).⁵⁶

The Western Australian, Queensland and Tasmanian Acts had all adopted this definition, but the Federal Act adopted a much shorter one: "Design" means an industrial design applicable, in any way or by any means, to the purpose of the ornamentation, or pattern, or shape, or configuration, of an article, or to any two or more of those purposes.⁵⁷

The change to the definition occasioned some debate, mainly driven by Sir Josiah Symon, a lawyer and Senate leader of the Free Traders.⁵⁸ Symon's chief objection was not, however, removal of the distinction between sculptures and other articles, but the addition in the Australian Act of the word 'industrial' to 'industrial design' which he considered 'artificial, unnecessary and misleading'.⁵⁹ His concerns were echoed by Glynn in the House of Representatives.⁶⁰ Those objections were answered by Littleton Groom, pointing out that the word was expressly used in the International Convention, that it was used in the Tasmanian Act and that the definition was 'a decided improvement upon that contained in the English Act'.⁶¹ In fact, the word was only used in the title of the Tasmanian Act and not in the definition of 'design'. The definition was not amended and the term 'industrial design' remained.⁶²

The nature of the right, still referred to as the 'copyright in the design' was defined as meaning 'the exclusive right to apply the design, or to authorize another person to apply the design, to the articles in respect of which it is registered.'⁶³ This also differed slightly to the UK Act's definition, which

⁵⁵ Ibid.

⁵⁶ Patents, Designs and Trade Marks Act 1883 (UK) s. 60.

⁵⁷ Designs Act 1906 (Cth) s. 4.

⁵⁸ Symon had made a considerable contribution to the debates over the Copyright Act 1905 See Benedict Atkinson, *The True History of Copyright: The Australian Experience 1905-2005* (Sydney: Sydney University Press, 2007), pp. 18-19, 37-41.

⁵⁹ Commonwealth, *Parliamentary Debates*, Senate, 20 June 1906, 402 (Senator Sir Josiah Symon).

⁶⁰ Commonwealth, *Parliamentary Debates*, House of Representatives, 1 August 1906, 2163 (Patrick Glyn MP).

⁶¹ Commonwealth, *Parliamentary Debates*, House of Representatives, 1 August 1906, 2165 (Littleton Groom MP).

⁶² As Gummow J noted in *Hosokawa Micron International Inc v. Fortune* (1990) 19 IPR 531 at 553, 'the inclusion of the term "industrial" in the Australian definition appears to have been something of a drafting accident to which no great significance should be attached'.

⁶³ Designs Act 1906 (Cth) s. 12.

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referred to 'article of manufacture' and made no reference to authorisation.⁶⁴ Infringement of the design copyright was separately defined as applying the design 'or any fraudulent or obvious imitation of it' to any article in respect of which it is registered, or selling or offering for sale, such an article, without the licence or authority of the copyright owner.⁶⁵ The phrase 'fraudulent or obvious imitation' was taken from the UK Act; although the wording of the rest of the section differed, it essentially achieved the same effect. The author of the design would be the owner of that design and, where the design was made for valuable consideration, the person on whose behalf it was made would be considered the author and therefore the owner.⁶⁶

The Designs Act 1906 came into force on 1 January 1907 – the same day as the Copyright Act 1905, passed a year earlier. Neither statute contained any reference to any potential overlap between them. The Copyright Act 1905 provided for the protection of books, lectures, dramatic works, musical works and artistic works, which were defined to include paintings, drawings, sculptures, engravings, etchings, prints, lithographs, woodcuts, photographs, 'or other work of art produced by any process, mechanical or otherwise, by which impressions or representations of works of art can be taken or multiplied.'⁶⁷ The right granted to owners of artistic works extended to reproducing a work, 'or any material part of it, in any manner, form, or size, in any material, or by any process, or for any purpose.'⁶⁸ The interaction between copyright in designs and copyright in artistic works was not discussed during debates over the Copyright Bill. While a couple of members expressed concerns that passing the Copyright Act would nullify rights granted under the state acts, their fears were allayed by the assurance that design legislation was forthcoming.⁶⁹

The lack of attention paid to the potential for overlapping protection by designs and copyright legislation may seem odd in retrospect, but it must be remembered that copyright covered a much narrower field at that time. Sherman and Bently suggest that, prior to copyright protection arising automatically, copyright did not offer the same advantages over design protection. Copyright owners were required to register their works before they could bring an infringement action, except in the case of sculpture. However, sculptures were excluded from design protection under the 1883 Patents, Designs and Trade Marks Act (UK).⁷⁰ In the case of drawings, engravings and other two-dimensional works, it was generally thought that reproduction in three dimensions would not amount to infringement. There was thus little scope for overlap.⁷¹ A second explanation can be found in the Gorell Committee's 1909 view that any overlapping should be tolerated to the advantage of copyright and design owners.⁷² I have not located any judicial decisions dealing with the overlap during this period so no further assistance can be found there.

3. Third Period 1913 – 1968: Demarcation

⁶⁴ Patents, Designs and Trade Marks Act 1883 (UK) s. 60.

⁶⁵ Designs Act 1906 (Cth) s. 30.

⁶⁶ Designs Act 1906, s. 14.

⁶⁷ Copyright Act 1905 (Cth) s. 4.

⁶⁸ *Ibid.*, s. 34.

⁶⁹ Commonwealth, *Parliamentary Debates*, Senate, 30 August 1905, 1651.

⁷⁰ Patents, Designs and Trade Marks Act 1883 (UK) s. 60.

⁷¹ Sherman and Bently, *Making of Modern IP*, p. 164.

⁷² This explanation was offered by the High Court in *Burge v. Swarbrick* (2007) 232 CLR 336, 347, referring to *Report of the Committee on the Law of Copyright* (1909) Cd 4976, 10.

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The Copyright Act 1905 did not last long. In 1912, it was repealed and replaced by a statute which implemented the UK's Copyright Act 1911.⁷³ The UK, or Imperial, Act was annexed in the Schedule to the Copyright Act 1912. This statute specified that copyright subsisted in 'every original literary, dramatic, musical and artistic work' but introduced a different definition of 'artistic works', which was defined to include 'works of painting, drawing, sculpture and artistic craftsmanship, and architectural works of art and engravings and photographs.'⁷⁴ No criteria or standard of artistic or aesthetic merit was laid down. The statute also introduced a broader approach to the rights created in respect of works, to include the 'right to produce or reproduce the work or any substantial part thereof in any material form whatsoever'.⁷⁵ Having extended the rights and the subject matter, the statute did address the potential overlap between such copyright works and designs. Section 22 provided that the Act did not apply to 'designs capable of being registered under the [Designs Act 1906], except designs which, though capable of being so registered, are not used or intended to be used as models or patterns to be multiplied by any industrial process.'⁷⁶

The only member who queried the exclusion of registrable designs in the House of Representatives was Sir Robert Best.⁷⁷ He argued that the exclusion of designs under the Copyright Act was 'unjust to the enterprising men, who pay highly to secure the designs of great artists, because a design registered under the Designs and Patents Act is protected for five years only'.⁷⁸ However, he was assuaged when he was reminded that earlier in the week Parliament had passed legislation allowing registration to be extended for two further periods of five years each, following a similar amendment being made in the UK.⁷⁹

The interpretation of section 22 has given rise to considerable difficulty over the years.⁸⁰ Clearly, the intention behind it was to avoid dual protection under both copyright and designs law, forcing artistic works under the former head and industrially produced products under the latter head. However, it did not completely exclude the operation of copyright in relation to designs which can be registered under the Designs Act, but rather 'cut down its ambit'.⁸¹ Thus, a drawing which could also be a registrable design if applied to an article would not be protected by copyright law against being reproduced in three dimensions, and would have to be registered under the Designs Act to gain such protection. However, such a drawing would still be protected against reproduction in two dimensions under the Copyright Act (because in such a case it would not fulfil the criteria of a design under the Designs Act as being applied to an article). Moreover, even where such drawings were also potentially registrable as designs, copyright would continue to treat them as artistic works if there was no intention for such works to be used industrially ('as models or patterns to be multiplied by any industrial process') and they would be protected by the Copyright Act 1912.

⁷³ An Act relating to Copyright (No 12 of 1912) (Cth).

⁷⁴ Copyright Act 1 & 2 Geo 5 (1911) (UK) s. 35.

⁷⁵ Copyright Act 1912, Schedule, s. 2.

⁷⁶ Ibid s. 22. The Australian Act instructed that the Designs Act 1906 (Cth) would be read for the Patents and Designs Act 1907 (UK).

⁷⁷ Best had worked in a printing office as a young man before becoming a solicitor and then a politician.

⁷⁸ Commonwealth, *Parliamentary Debates*, House of Representatives, 30 October 1912, 4869 (Sir Robert Best MP).

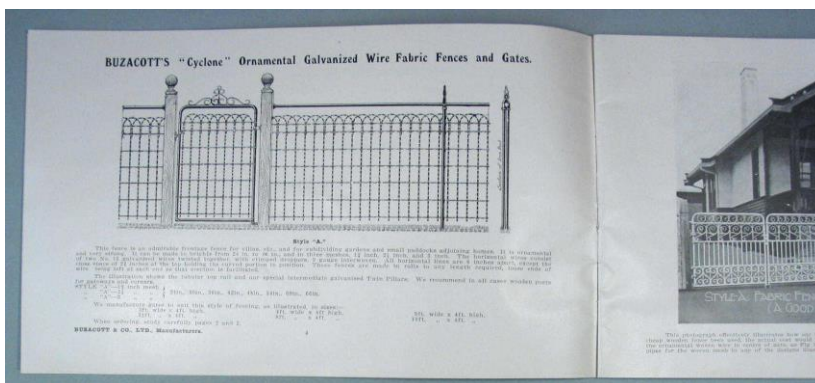
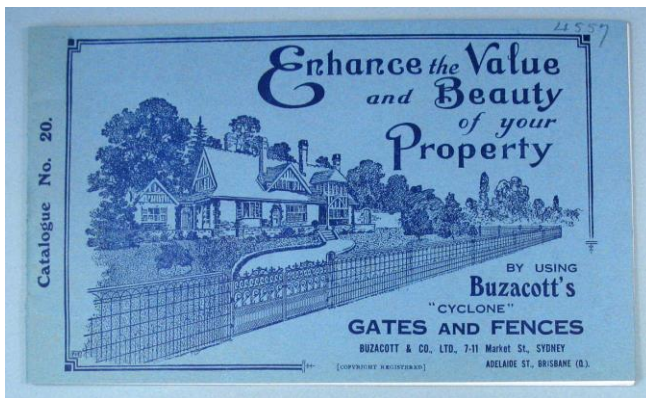
⁷⁹ An Act to amend the Designs Act 1906 No. 14 of 1912 (Cth) s. 3.

⁸⁰ See the discussion in *Interlego AG and Another v. Croner Trading Pty Ltd* (1992) 39 FCR 348, 355, 366-9.

⁸¹ *Interlego AG and Another v. Croner Trading Pty Ltd* (1992) 39 FCR 348, 355 per Gummow J, citing Blanco White, *Patents for Inventions* (4th ed, 1974), pp. 331-2.

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With only a few amendments of any significance in the 1930s,⁸² the Copyright Act 1912 continued in force for fifty six years. Despite the steadily rising number of design applications and registrations, only a handful of cases relating to designs came before the courts in the period up to 1968,⁸³ of which only one involved the operation of section 22 of the Copyright Act. In *Buzacott & Co v Dutch*,⁸⁴ the plaintiff failed in its action for infringement of copyright in its catalogue containing illustrations of its gates, fences, seats and articles in tube and wire. The NSW Supreme Court found that the illustrations of the articles were engravings under the Copyright Act, but also designs which were capable of registration under the Designs Act 1906 and were intended to be used as models or patterns to be multiplied by an industrial process. Thus, section 22 operated to exclude their protection under copyright law.



⁸² Copyright Act 1933 No. 68 of 1933 (Cth); Designs Act 1933 No. 26 of 1933 (Cth); Designs Act 1934 No. 42 of 1934 (Cth); Copyright Act 1935 (Cth) (no 17 of 1935).

⁸³ *Buzacott & Company Limited v. Cyclone Proprietary Limited* (1920) 27 CLR 286; *Buzacott & Co Ltd v. Dutch* (1929) 30 SR (NSW) 22, 46 WN (NSW) 210; *Macrae Knitting Mills Limited v. Lowes Limited* (1936) 50 CLR 725; *In re Wolanski* (1953) 88 CLR 278; *Inala Industries Pty Ltd v. Associated Enterprises Ltd* [1960] Qd R 562; *J W Tomlin Pty Ltd v. Malley's Ltd* [1960] NSW 454, 77 WN (NSW) 723, 2 FLR 142; *Malley's Limited v. J W Tomlin Pty Limited* (1961) 180 CLR 120; *D Sebel & Co Ltd v. National Art Metal Co Pty Ltd* (1965) 10 FLR 224; *Hella-Australia Pty Ltd v. Quinton Hazell (Aust) Pty Ltd* [1968] 1 NSW 235, 86 WN (Pt 1) (NSW) 243; 10 FLR 86.

⁸⁴ *Buzacott & Co Ltd v. Dutch* (1929) 30 SR (NSW) 22, 46 WN (NSW) 210.

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Pages from a 1915 Buzacott catalogue.⁸⁵

Although the judge in this case indicated some unhappiness with the decision he considered he was bound to make,⁸⁶ the very small number of cases being litigated means no great level of local dissatisfaction with section 22 is perceptible.⁸⁷ However, this was not the case in the UK, the jurisdiction to which the Australian courts repeatedly turned for precedent in the small number of decisions coming before them. In *King Features Syndicate v O & M Kleeman*⁸⁸ the House of Lords held that the copyright in 'Pop-Eye' cartoons was infringed by the unauthorised manufacture of 'Pop-Eye' dolls and brooches copied from those cartoons, notwithstanding section 22. Although the Pop-Eye merchandise was manufactured industrially, their Lordships found that copyright continued to operate because at the time the cartoons were made the artist had no intention to use them industrially. When the Gregory Committee was appointed ten years later to look into possible reform of copyright law in the UK, it paid particular attention to this case, stating it demonstrated the inequitable results that could flow from making the protection of copyright turn upon the intention of the artist, as mandated by section 22 of the Imperial Copyright Act. Moreover, the Committee also took the view that the case meant that dual protection would be available under both copyright and designs law, something it considered undesirable.⁸⁹

Five years after the Gregory Committee delivered its report, the UK amended its copyright law.⁹⁰ In Australia, this brought to an end the long period of stability which had followed the enactment of the Copyright Act 1912.⁹¹ In 1958 the Attorney-General appointed a Committee, chaired by a former attorney-general and judge J A Spicer, to consider whether any of those amendments should be incorporated into Australian law. The Spicer Committee devoted only 9 paragraphs to the question of industrial designs.⁹² It took the view that 'extensive inquiry into the revision of the Designs Act'⁹³ went beyond its terms of reference but did briefly note that a recent New Zealand Committee had recommended that all designs which were original artistic works should be protected as copyright

⁸⁵ Ernest Walter Buzacott and Albert Killear Garven, *Buzacott's Cyclone Gates and Fences*. Copyright Registration 1 Nov 1915. National Archives of Australia, A1336, 4557.

⁸⁶ Long Innes J stated, 'Although I am clearly of opinion that in its details the defendant's catalogue has been largely copied from those of the plaintiff, as is in fact not denied, I am unable to give the plaintiff the more extended relief which, but for the provisions of s.22, I would gladly give him.' *Buzacott & Co Ltd v. Dutch* (1929) 30 SR (NSW) 22, 25.

⁸⁷ In 1971, the case of *Koloszy v. K. Biro & Co. Pty Ltd* [1971] 2 NSWLR 444 also had to decide upon the operation of s. 22, as the works in question were made before the Copyright Act 1968 commenced. Hope J noted the difficulties associated with applying s. 22 in different relation to different kinds of works.

⁸⁸ *King Features Syndicate Inc. and Betts v. O & M Kleeman Ltd.* [1941] AC 417; (1941) 1B IPR 215; [1941] 2 All ER 403. See UK Chapter for more detail.

⁸⁹ Report of the Copyright Committee (1951) Cd 8662, 82-93. Although note that in his speech, Lord Wright stated: 'If the [relevant designs] had been registered and if the [Patents and Designs] Acts had been otherwise complied with, they would have acquired the rights under the Patents and Designs Act, which are much narrower than those given by the Copyright Act...Having these rights as designs, they were not to have any further or other rights under the Copyright Act.' *King Features v. Kleeman* [1941] AC 417, 439.

⁹⁰ Copyright Act 1956 4 & 5 Eliz. 2 c. 74 (UK).

⁹¹ A stability which Ricketson has noted as 'remarkable' in light of the large number of amendments and divisive conflicts generated following the enactment of the Copyright Act 1968: Ricketson, 'Imperial Copyright Act in Australia', 73.

⁹² Report of the Committee Appointed by the Attorney-General of the Commonwealth to Consider what Alterations are Desirable to The Copyright Law of the Commonwealth (Australian Government Printer, Canberra, 1959), 82-83.

⁹³ *ibid.*, 83.

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works. The Committee indicated that, had it been authorised to make recommendations regarding reform of design law, it might have taken a similar approach. In the end, however, it simply adopted the discussion of the UK Gregory Committee in relation to the overlap between designs and copyright.

To conclude, during this lengthy period of history, it appears that the approach in Australia was one of demarcation between copyright and designs (notwithstanding the decision in *King Features v Kleeman*). Which regime would apply would depend on the form in which the work was, or was intended, to be exploited. If it was exploited as a design and applied to articles, then it would fall under designs law; if, however, the work was exploited in two dimensions, such as a drawing or painting, it would be protected by copyright.

4. Fourth Period 1969 – 1980: Demarcation

After the Spicer Committee reported, it was to be another 7 years before the Australian Government took any legislative action. Eventually it passed the Copyright Act 1968, which made a number of changes to copyright law, including an attempt to re-shape the copyright/designs overlap. The Act continued to provide copyright for a closed list of 'works', being literary, artistic, dramatic and musical works. It remained the case that eligibility for copyright protection turned solely on 'skill, labour and judgment' rather than any artistic merit.⁹⁴ It also protected 'subject matter other than works', being films, sound recordings, broadcasts and published editions. As with the Copyright Act 1956 (UK), 'artistic works' were protected against reproduction in 'a material form'.⁹⁵ This was limited by section 71, which provided that making an object in three dimensions would not infringe copyright in a work in two dimensions, and vice versa, if the object in question 'would not appear to persons who are not experts in relation to objects of that kind to be a reproduction of the artistic work.'⁹⁶ These provisions meant there was potential for designs to be protected under both copyright law and design legislation. The overlap was to be managed in sections 74-77 of the Act which essentially reproduced the scheme of the 1956 UK Act with a few drafting amendments.

The scheme set up by these Acts operated so that the use of an artistic work as an industrial design would not affect any *subsistence* of copyright in that work. It would, however, affect whether certain acts would be found to be *infringements* of that copyright.⁹⁷ A new concept, the 'corresponding design', was introduced in an attempt to clarify the distinction between artistic works and designs. This 'corresponding design' was defined as: 'in relation to an artistic work...a design that, when applied to an article, results in a reproduction of that work.'⁹⁸ Two potential situations were addressed: one arising where copyright subsisted in an artistic work, and a 'corresponding design' was registered under the Designs Act 1906; the other arising where copyright subsisted in an artistic work, and a 'corresponding design' was applied industrially to articles which are sold, let for hire, offered or exposed for sale or hire, but that corresponding design was *not* registered under the

⁹⁴ *Sands and McDougall Pty Ltd v. Robinson* (1917) 23 CLR 49.

⁹⁵ Copyright Act 1968 s. 31

⁹⁶ Copyright Act 1968 s. 71.

⁹⁷ J. C. Lahore, 'Industrial Designs and the Copyright Act of 1968 – The problem of dual protection' (1969) 43 *Australian Law Journal*, 139, 144.

⁹⁸ Copyright Act 1968 s. 74.

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Designs Act in respect of those articles. The Copyright Regulations 1969 provided that a design would be deemed to be 'industrially applied' if it was applied to more than fifty articles.⁹⁹

In both situations, it would not be an infringement of copyright to do anything in relation to an article which would be within the scope of the protection of the Designs Act, whether the design was registered (section 75) or not registered but industrially applied (section 77) either during the 15 years of actual or putative protection, or thereafter. In relation to protection after the expiration of 15 years, it would not be an infringement of copyright to do anything within the scope of copyright in the design 'as extended to all associated designs and articles.'¹⁰⁰

Again, in both situations copyright would remain in the design/artistic work in question, but could only be infringed by doing some other act not covered by the protection granted under the Designs Act. This made more explicit the distinction between works in three-dimensions, or as applied to articles, and works in two-dimensions. As Attorney-General Bowen explained in his second reading speech: 'Thus, if a cartoon character is used to decorate children's plates, so as to use it after the expiration of 15 years from the time those plates came on the market will not infringe any rights in respect of the artistic copyright in the drawing of the character, but to reproduce it in a magazine would be an infringement of copyright.'¹⁰¹ Thus, an artistic work, such as a cartoon character, could be registered as a design and exploited industrially during the fifteen years, during which time the owner could use their design registration to control uses that fell within the scope of the registration and the copyright in an artistic work to control other uses; following the expiry of the registration period, copyright would continue to apply to the latter uses.

A further important amendment came in the form of regulations passed the following year. Again echoing the UK scheme to mediate overlaps, the Design Regulations 1969 provided that designs for articles in certain specified classes would be excluded from registration under the Designs Act 1906. These classes were: works of sculpture other than casts or models used or intended to be used as models or patterns to be multiplied by an industrial process; wall plaques; medals; and, 'articles that are primarily literary or artistic in character and on which there is printing', such as book jackets, calendars, certificate, dressmaking patterns, maps, plans and postcards.¹⁰² Such articles could not lose copyright protection, even if a corresponding design were to be applied industrially, by virtue of section 74 of the Copyright Act 1968.

Two years after the 1968 Act was passed, a Committee was appointed by the new Attorney-General to give a more thorough examination of the law relating to designs, to recommend whether any changes needed to be made to the law, and also to consider the introduction of a system of 'utility models', or petty patents.¹⁰³ This Committee was chaired by Justice Robert Franki and delivered two separate reports in 1973; the first report dealt with designs and the second with patents.

In relation to designs, the Franki Committee considered a number of problems or potential problems with the law as it then stood. Once again, the UK law was taken as the starting point and each

⁹⁹ Copyright Regulations 1969 r. 17.

¹⁰⁰ Copyright Act 1968 s. 75.

¹⁰¹ Commonwealth, *Parliamentary Debates*, House of Representatives, 16 May 1968, 1533 (Attorney-General Nigel Bowen).

¹⁰² Designs Regulations 1969 r. 2.

¹⁰³ Designs Law Review Committee, *Report on the Law Relating to Designs* (1973) ('Franki Report').

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section of both statutes was compared, with a discussion of relevant cases. Considerable attention was paid to the copyright-design overlap issues. The Franki Report had noted that since the passing of the Copyright Act 1968, which had adopted the UK position, there had been developments both legislative and judicial in the UK requiring consideration. Indeed, in 1968, the UK had passed an amending Act which altered the position there. The Design Copyright Act 1968 (UK) allowed dual protection lasting 15 years from the date on which the corresponding design was first published.¹⁰⁴ The Franki Committee made inquiries as to what had motivated such a change, and was informed that it responded to representations made by manufacturers of art metal work and jewellery.¹⁰⁵

The Franki Committee was not, however, persuaded of the value of such provision and declared it was opposed to dual protection, despite having received a number of submissions ('including some well-documented submissions from the Walt Disney Organisation'¹⁰⁶) in its favour. It stated firmly: 'It seems to us that a person should be able to make whatever use of an article he pleases if, in accordance with the usual practice in the industrial field, he finds on a proper examination of the records that the article is not covered by any patent or design protection in Australia.'¹⁰⁷ The Report referred to a number of recent UK cases which demonstrated the uncertainty that flowed from dual, or cumulative, protection.¹⁰⁸ It also considered whether it would be desirable from an international point of view to adopt dual protection, noting that some had argued before it that if dual protection were introduced Australian manufacturers would be able to obtain the benefit of copyright protection for works of applied art in other Berne Convention countries, without having to go to the trouble of registering designs. However, the Committee took the view that the breadth of the definition of 'artistic work' in Australia would mean that dual protection would open up copyright protection to a broader range of articles in Australia than would be protected by copyright in overseas countries. It further thought that the imprecise definition of 'works of applied art' would simply lead to greater uncertainty for manufacturers.¹⁰⁹ As a result, the Report recommended retaining sections 74 – 77 with certain modifications, as well as alterations to a number of other aspects of the Designs Act.

Further developments occurring in the UK in this period also required consideration by the Franki Committee. The first was the case of *Dorling v Honnor Marine Ltd*.¹¹⁰ In this case, the Court of Appeal had found that where the artistic copyright lay in two-dimensional plans for dinghies, which had been produced industrially in three dimensions, the owner of copyright in the plans retained full copyright because the corresponding design was unregistrable – the plans themselves being unregistrable according to the regulations, and the parts, kits and shape of the completed boat being unregistrable on the basis of functionality.¹¹¹ This case, and those which followed it, were said to

¹⁰⁴ Design Copyright Act 1968 c. 68 (UK), s. 1.

¹⁰⁵ Franki Report, 56.

¹⁰⁶ Franki Report, 52.

¹⁰⁷ Franki Report, 53, [255].

¹⁰⁸ The cases referred to were: *IMI Developments Ltd & Anor v. R. C. Harrison Ltd*. [1970] RPC 299; *Merchant-Adventurers Limited v. M. Grew & Company Ltd* (1971) 3 WLR 791; *Sifam Electrical Instrument Co. Ltd v. Sangamo Weston Ltd* [1971] FSR 337; [1971] 2 All ER 1074; *Antocks Lairn Ltd v. I. Bloohn Ltd*. [1972] RPC 219; *Temple Instruments Ltd v. Hollis Heels Ltd* [1971] FSR 634.

¹⁰⁹ Franki Report, 55 [259] – [260].

¹¹⁰ *Dorling v. Honnor Marine Ltd* [1965] 1 Ch 1; [1964] 2 WLR 195; [1964] 1 All ER 241.

¹¹¹ *Dorling v. Honnor Marine Ltd* [1956] 1 Ch 1, 19 (per Danckwerts LJ).

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lead to 'bizarre outcomes'¹¹² and to be 'illogical'¹¹³ in giving the more expansive protection offered by copyright to things found ineligible for the lesser protection of design rights.

The second development came when the House of Lords was called upon to determine the meaning of the final phrase of the definition of 'design' which excluded from protection features of shape or configuration 'dictated solely by the function which the article to be made in that shape or configuration has to perform'. In *Amp Inc v Utilux Pty Ltd*, Lord Reid held that: 'If the shape is not there to appeal to the eye but solely to make the article work then this provision excludes it from statutory protection.'¹¹⁴ The Franki Committee considered this approach should not be reflected in the Australian legislation, which should be as broad as practicable. While function itself should not be capable of protection through design legislation, it should not be a bar to registration.

In addition, a series of cases confirmed that not only were technical drawings considered artistic works, but that they could be infringed by indirect copying of a three-dimensional work produced from them,¹¹⁵ thereby expanding the remit of copyright for such works. This undermined the role of the 'non-expert' defence, which provided that the making of an object in three dimensions would not infringe copyright in the artistic work in two dimensions, and vice versa, if it did not appear to a non-expert to be a reproduction.

Notwithstanding these UK developments, there was no case law explicitly concerning the overlap between copyright and designs in Australia during this period. The regime of demarcation continued but the question of whether functional designs were excluded from design protection did divide opinions in the courts.¹¹⁶ Because UK developments revealed that such exclusions could re-enliven copyright protection in respect of functional designs, concerns were growing about the potential for over-broad protection for industrial products.

5. Fifth Period 1981 – 1990: Demarcation

Although both Franki Reports were delivered in 1973, the government first took action on the second one, which had found that there was a 'gap' in the law for functional inventions that were not inventive enough for patent protection. In 1979 Parliament passed legislation amending the Patents Act 1952 which created a system of petty patents – patents with the same inventiveness threshold as a standard patent but which were easier and cheaper to obtain and would last only six years.¹¹⁷

Two years later, Parliament turned its attention to amendments to the law relating to designs. The Designs Amendment Act 1981 enacted a number of the Committee's recommendations. As a matter of nomenclature, the title of the Designs Act was altered from 'Copyright in Industrial Designs' to

¹¹² Whitford Committee, Cmnd 6732 (1977), [97].

¹¹³ Franki Report, 59.

¹¹⁴ *AMP Inc. v. Utilux Pty Ltd* [1972] RPC 103, 110.

¹¹⁵ *Solar Thomson Engineering Co. Ltd v. Barton* [1977] RPC 537, *L. B. (Plastics) Ltd v. Swish Products Ltd* [1979] RPC 551.

¹¹⁶ See *Mangraviti v. Vardi* [1976] 2 NSWLR 225; *Clive Investments Pty Ltd v. Paul Segart Pty Ltd* (1966) 36 Australian Official Journal of Patents, Trade Marks and Designs 1577; *Malleys Ltd v. J. W. Tomlin Pty Ltd* (1961) 180 CLR 120; *D. Sebel & Co Ltd v. National Art Metal Co Pty Ltd* (1965) 10 FLR 224

¹¹⁷ Patents Amendment Act 1979 No. 9 of 1979 (Cth).

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simply 'designs'.¹¹⁸ The Franki Report had observed that the Act did not give merely a right against copying, but rather a monopoly in the design, meaning the use of the word 'copyright' was 'not only inappropriate but ...likely to be confusing'.¹¹⁹ The definition of 'design' was also amended and a path between the UK Act and the existing Australian Act was chosen. The UK definition, derived from the 1919 Act as amended in 1949, was as follows:

In this Act the expression 'design' means features of shape, configuration, pattern or ornament applied to an article by any industrial process or means, being features which in the finished article appeal to and are judged solely by the eye, but does not include a method or principle of construction or features of shape or configuration which are dictated solely by the function which the article to be made in that shape or configuration has to perform.¹²⁰

The definition adopted in the Designs Amendment Act was:

'Design' means features of shape, configuration, pattern or ornamentation applicable to an article, being features that, in the finished article, can be judged by the eye, but does not include a method or principle of construction.¹²¹

The Franki Report had approved of the phrase 'features of shape, configuration, pattern or ornamentation' on the basis its meaning was reasonably well established by the courts and a new form of words might lead to uncertainty in litigation. It did, however, make what it considered to be some improvements to the drafting.¹²² Responding to the developments noted above, in particular the decision in *Amp v Utilux*, the Australian Act also departed from the UK definition in relation to the exclusion of features of shape or configuration 'dictated solely by the function which the article to be made in that shape or configuration has to perform'. Not only was the UK phrase to be omitted from the definition, an additional section was added stating that 'An application for registration of a design shall not be refused, and a registered design is not invalid, by reason only that the design consists of, or includes, features of shape or configuration that serve, or serve only, a functional purpose.'¹²³

Two other alterations made in 1981 were to abolish the practice of registering designs in classes, as had already occurred in the UK, and to extend the period of protection from a maximum of fifteen years, to a maximum of sixteen years. No specific action was taken in relation to the overlap between copyright and designs at that time, but a new cause for concern was emerging. This was that the expansion of copyright to cover technical drawings, reproduced in both three and two dimensions, would lead to anti-competitive restriction of the spare parts market. Faced with this problem in the UK, the House of Lords created a 'spare parts exception' to copyright law in *British Leyland Motor Corp v Armstrong Patents Co Ltd*.¹²⁴ The exception was not applied in Australia by Wilcox J who referred to it in the Federal Court as 'remarkable' and 'a major qualification upon the

¹¹⁸ Designs Amendment Bill Act 1981 (Cth) s. 4.

¹¹⁹ Franki Report, 30, [133].

¹²⁰ Registered Designs Act 1949 c.88 (UK), s. 1.

¹²¹ Designs Amendment Act 1981 (Cth) s. 5.

¹²² Franki Report, 6-8.

¹²³ Designs Amendment Act 1981 (Cth) s. 18.

¹²⁴ *British Leyland Motor Corp v. Armstrong Patents Co Ltd* [1986] AC 577; (1986) 6 IPR 102.

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scheme laid out – wisely or unwisely – under the United Kingdom copyright and designs legislation.¹²⁵ He held that design drawings excluded from the definition of ‘design’ in the Designs Act 1906, by reason of being ‘a method or principle of construction’, retained copyright protection.¹²⁶

At the same time, several other cases before the courts demonstrated that the demarcation approach could operate to deny both copyright and design protection in cases where artistic works were registrable as corresponding designs, but had not been registered prior to being industrially applied – results which were perceived to lead to injustice in those particular cases.¹²⁷ Nevertheless, the policy of demarcation continued to be considered appropriate, despite the difficulties occasioned by negotiating its boundaries. As Deane J explained in the High Court decision of *Hart v Edwards Hot Water Systems*:

The present case falls in an area in which one should be conscious of the distinct functions performed by the law of copyright and the law of patents and industrial designs and of the desirability of maintaining at least the semblance of a boundary between their respective fields of operation. The convoluted path by which a three-dimensional object has been held to be an infringement of the copyright in a technical drawing which has been neither factually copied or even seen illustrates the incursions which copyright – with its extended life but more limited protection, its lack of requirement of novelty or true inventiveness and its minimal standards of originality – is capable of making into what would ordinarily be seen as the proper domains of the law of patents and the law of industrial designs.¹²⁸

6 The Sixth Period 1990 - 2003: Partial cumulation and demarcation

In light of the ongoing problems, the Government commissioned a further investigation by the Attorney-General’s Department, which published a discussion paper and received submissions in 1987.¹²⁹ In 1989 an amending Act was passed, altering a number of aspects of copyright law and commencing on 1 October 1990.¹³⁰ In terms of the copyright/design overlap, the Act repealed the much criticised section 71 (the ‘non-expert’ defence) in its entirety.¹³¹ Still more significantly, it introduced for the first time, partial cumulation of designs and copyright, by amending sections 74, 75 and 77 in order to ensure that three-dimensional industrial products could not receive copyright protection, but two-dimensional ones could.

¹²⁵ *Warman International Ltd and Ors v. Envirotech Australia Pty Ltd and Ors* (1986) 11 FCR 478, 499.

¹²⁶ *Ibid*, 496.

¹²⁷ *Glamagard Pty Ltd. v. Enderslea Productions Pty Ltd* (1985) 1 NSWLR 138; (1985) 59 ALR 740; *Hutchence and Ors v. South Seas Bubble Co. Pty Ltd and Ors* (1986) 64 ALR 330; *Flamingo Park Pty Ltd v. Dolly Dolly Creation Pty Ltd and Ors* (1985) 65 ALR 500.

¹²⁸ *S. W. Hart & Co. Pty Ltd. v. Edwards Hot Water Systems* (1985) 159 CLR 466, 495. See also *Kevlacat Pty Ltd v. Trailcraft Marine Pty Ltd* (1987) 79 ALR 534, 550-551.

¹²⁹ Attorney-General’s Department’s Discussion Paper, *Copyright Protection for Artistic Works Industrially Applied* (Canberra: Australian Government Publishing Service, 1987).

¹³⁰ Copyright Amendment Act 1989 No 32 1989 (Cth).

¹³¹ Copyright Act 1968 (Cth) s. 71, repealed in Copyright Amendment Act 1989 (Cth), Schedule s. 17. For criticism, see *S. W. Hart & Co. Pty Ltd. v. Edwards Hot Water Systems* (1985) 159 CLR 466, 475, where Gibbs CJ observed: ‘Although the object of the provisions is understandable, the form in which they are expressed, involving the use of a triple negative, is not altogether clear, and their application proves difficult in practice’; see also *Dorling v. Honnor Marine Ltd* (1956) 1 Ch 1, 19 and *L. B. (Plastics) Ltd v. Swish Products Ltd* [1979] RPC 551, 635-6.

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It achieved this by amending the definition of ‘corresponding design’ to add the phrase ‘but does not include a design consisting solely of features of two-dimensional pattern or ornament applicable to a surface of an article.’¹³² Limiting the exclusion of copyright to three-dimensional works meant that the two-stage process which dealt with the situation during and after registration was no longer necessary. Thus, the sections limiting the operation of copyright where a corresponding design had, and had not, been registered could be simplified.¹³³ Further language was added to avoid the outcome in *Dorling v Honnor Marine Ltd*¹³⁴ and subsequent cases holding that designs which were unregistrable because they were functional, nor not new and original, or could not be ‘judged by the eye’ retained copyright protection.¹³⁵ Thus, section 77(3) was added in an attempt to make it clear that it was only where the corresponding design was unregistrable through the operation of the Regulations excluding certain designs from registrability that copyright in an artistic work would remain in force.¹³⁶

Copyright protection was not, however, removed for all three dimensional artistic works that had been industrialised. Section 77 was altered to carve out an exception for buildings, models of buildings and works of artistic craftsmanship. Copyright would therefore continue to subsist in such works unless they were registered as designs, whereupon they would lose copyright and rely solely on the protection given by registration. This was not a recommendation of the Franki Committee nor covered in the Attorney-General’s discussion paper. According to the Explanatory Memorandum, the reason for introducing this exception was because it was considered that such works are ‘more appropriately protected under the [Copyright] Act whether industrially applied or not.’¹³⁷

The 1989 Act had only passed upon the assurance that the Attorney-General’s Department would conduct an urgent review of designs law. A Committee was subsequently appointed under Professor James Lahore to carry out an Inquiry into Intellectual Property Protection for Industrial Designs.¹³⁸ The Lahore Committee was deeply critical of a number of aspects of the amendments just passed.

First, it considered that the Government’s policy decision to deny copyright protection to three dimensional works could not be successfully implemented unless the definitions of both ‘design’ and ‘corresponding design’ were changed.¹³⁹ The problem with the definition of ‘corresponding design’ was that it referred back to the definition of ‘design’, itself to be found in the Designs Act 1906 rather than the Copyright Act. Designs that did not fall within that definition would likewise also not be ‘corresponding designs’ and thus would not be affected by the changes in the Copyright Amendment Act designed to deprive them of copyright protection. To take the example given by the Committee, in the case of *Warman International v Envirotech* the drawings in question were held not to be designs within the definition of the Designs Act because they constituted a method or

¹³² Copyright Act 1968 (Cth) s. 74, amended by Copyright Amendment Act 1989 (Cth) s. 10.

¹³³ Copyright Act 1968 (Cth) ss. 75, 77, amended by Copyright Amendment Act 1989 (Cth) ss. 10, 11.

¹³⁴ *Dorling v. Honnor Marine Ltd* [1965] 1 Ch 1.

¹³⁵ Copyright Amendment Bill 1988 (Cth) Explanatory Memorandum, cl. 10.

¹³⁶ Copyright Act 1968 (Cth) s. 77, amended by Copyright Amendment Act 1989 (Cth) s. 11.

¹³⁷ Copyright Amendment Bill 1988 (Cth) Explanatory Memorandum, cl. 10.

¹³⁸ James Lahore, ‘Inquiry into Intellectual Property Protection for Industrial Designs’ (Presented to Senator the Hon John Button, Minister for Industry, Technology and Commerce Canberra, September 1991) (‘Lahore Report’), 1.

¹³⁹ *Ibid.* iii.

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principle of construction; therefore they were entitled to copyright protection.¹⁴⁰ This would be unchanged under the amendments, a result the Committee called ‘astonishing’, given that a principal reason for amending the Act was to deny copyright protection to utilitarian three-dimensional articles.¹⁴¹ A second problem with the definition of ‘corresponding design’ was the exclusion of designs consisting solely of features of two-dimensional pattern or ornamentation applicable to the surface of an article. The Committee pointed out it was not clear how this definition would apply to woven or embossed designs, or where the pattern lay in the thickness of the material.¹⁴²

Turning to the new definition of ‘design’, as amended in 1981, the Committee’s discussion focussed on the explicit exclusion found in the words ‘does not include a method or principle of construction.’ Recent court decisions interpreting the words had given rise to some dissatisfaction.¹⁴³ In *Warman v Envirotech*, an interlocutory hearing, Wilcox J found that design drawings which contained information as to data and tolerances necessary to manufacture the parts in question were excluded from the definition of design because they were ‘a method of principle or construction’.¹⁴⁴ Similarly, in *Firmagroup Australia Pty Ltd v Byrne & Davidson Doors (Vic) Pty Ltd*,¹⁴⁵ the High Court upheld lower court decisions which had found there was no infringement of registered designs for handles and locks for shutter (garage) doors because what was copied were general functional features rather than features which ‘convey[ed] an idea of unique shape or configuration’.¹⁴⁶ These decisions gave rise to the perception that the Designs Act inadequately protected functional articles, while copyright over-protected them.¹⁴⁷

The Committee considered that a method or principle of construction was more appropriately protected by patent law than by design law, but it also found that specifically excluding methods or principles of construction from the definition of design had not led to an improvement in designs protection and that, in fact, recent decisions were detrimental to it. It thus recommended changing the definition of design to remove the explicit exclusion and to place more emphasis on the form of an article as being the subject matter of protection.¹⁴⁸ It considered that the chief problem with giving broad protection to functional designs lay in the definition of infringement and that existing case law gave insufficient guidance on the concept of fraudulent or obvious imitation. The Report recommended abandoning that approach completely, as had already occurred in the UK back in 1949. Instead, it recommended adopting a test of ‘substantial reproduction’ although it added that since design registration was a monopoly rather than a right to prevent copying, it would be important to ensure that reproduction was not interpreted to require proof of copying.¹⁴⁹

¹⁴⁰ *Warman v. Envirotech* (1986) 11 FCR 478.

¹⁴¹ Lahore Report, 15.

¹⁴² *Ibid.*, 17.

¹⁴³ Lahore Report, 31.

¹⁴⁴ *Warman v. Envirotech* (1986) 11 FCR 478, 496.

¹⁴⁵ (1987) 180 CLR 483; 61 ALJR 495; 73 ALR 321.

¹⁴⁶ (1987) CLR 483, 488-9.

¹⁴⁷ See Janice Luck, ‘The *Firmagroup* case: trigger for designs law reform’ in Andrew T. Kenyon, Megan Richardson, Sam Ricketson (eds), *Landmarks in Australian Intellectual Property Law* (Port Melbourne: Cambridge University Press, 2009).

¹⁴⁸ Lahore Report 32, 35.

¹⁴⁹ *Ibid.* 39-41.

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The Lahore Committee was not alone in considering that the amended provisions of the Copyright Act created as many, if not more, problems than they resolved.¹⁵⁰ And so, shortly after it submitted its report, a reference was made to the Australian Law Reform Commission (ALRC) to review the law of designs.¹⁵¹ The ALRC carried out the widest-ranging inquiry to date on Australian designs law, consulting with designers, manufacturers, patent attorneys, lawyers and interest groups, as well as the Australian Intellectual Property Office and relevant government departments and agencies. It also conducted a survey of the design industry which involved about 1000 individual designers and manufacturers around Australia and considered recent developments in the European Community, as well as New Zealand, North America, Asia and Africa.

The ALRC Report stated that 'the law has not kept up with changes in the scope of what designers are doing. Design is an integral part of manufacturing and marketing but designs law tends to treat it as a minor cosmetic aspect of a product. For designers and manufacturers this mismatch and the outdated legal concept of design have been the source of much dissatisfaction over many years.'¹⁵² The Report noted that while modern design encompassed a broad range of activities, concepts and philosophies, the legal concept of design was far narrower and did not extend to non-visual features considered by designers to be important, such as functionality, safety considerations, feel, weight, ergonomics and so on. The ALRC pointed out that some of these aspects would fall to be protected under other areas of intellectual property law, such as trade marks (which now extended to cover shapes, colours, sound and scent), patents, passing off or breach of confidence.¹⁵³

The submissions and the survey revealed to the ALRC that there were a number of perceived problems with the operation of design law in Australia. These included an impression that design law was not regarded highly by those who sought to benefit commercially from their designs, the lack of protection for function, the narrow interpretation of visual appearance, the feeling that registration took too long, was too costly and granted too easily to non-novel designs, that litigation was too costly and victory too uncertain.¹⁵⁴ The ALRC concluded that Australia should continue to provide protection for industrial designs, but that the system was in need of reform. Many of the concerns expressed by stakeholders and others could be addressed within the existing system. However, it also considered that other concerns could not be addressed within the registered design right and that broader review and reform was necessary.

Although many of the submissions to the ALRC identified a gap in protection for functional designs, and called for design protection to be expanded to protect function directly, the ALRC concluded that design legislation should continue to focus narrowly on the visual appearance of a product and that any gap opening up as a result of the failure to protect function was more properly addressed by reforming Australia's petty patent system and not by extending design law.¹⁵⁵ In addition, the ALRC was drawn to arguments in favour of supplementing the current design protection with an

¹⁵⁰ See Wayne M. Condon, 'The Copyright Amendment Act 1989 and the Copyright/Design Overlap in Australia' (1990) 12 *European Intellectual Property Review* 84; Ricketson, 'Towards a Rational Basis'.

¹⁵¹ Australian Law Reform Commission, *Designs Report*, Terms of Reference, No 74 (1995) ('ALRC Report').

¹⁵² ALRC Report, [2.1].

¹⁵³ ALRC Report, [2.20] – [2.27].

¹⁵⁴ ALRC Report, [2.42] – [2.48].

¹⁵⁵ ALRC Report, [3.42] – [3.53].

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unregistered, anti-copying design right. However, as this went beyond its terms of reference, the Commission recommended a separate review should be commissioned to investigate this.¹⁵⁶

To sum up, the 1989 amendments introduced a new policy of cumulative protection for two-dimensional artistic works, while retaining demarcation for three dimensional works. The change in the definition of ‘corresponding design’ made it clear that when applied to a product also in two dimensions (ie as pattern or ornamentation) such works could acquire both design registration and copyright protection. A less strict form of demarcation applied to buildings, models of buildings and works of artistic craftsmanship, in that they could receive either copyright or design protection but not both, while other three-dimensional works were subject to strict demarcation and unable to be protected by copyright if applied industrially. Dissatisfaction continued, however, with the way the boundary was drawn and in particular questions were raised as to whether the language of the legislation adequately implemented its intention.

7. Seventh Period 2004 – present: Partial cumulation and demarcation

The ALRC delivered its report in 1995 but it was not until 2002 that the Government introduced an entirely new design law bill into Parliament – the first in almost one hundred years. In his second reading speech, Warren Entsch MP explained that ‘This Bill is intended to provide a simple to use, cost effective designs system that provides designers with enforceable rights.’¹⁵⁷ The new Act, which received assent on 17 December 2003, implemented many, although not all, of the ALRC’s recommendations.

First, the Act introduced a new definition of ‘design’ as follows: ‘design, in relation to a product, means the overall appearance of the product resulting from one or more visual features of the product.’¹⁵⁸ ‘Visual features’ was in turn defined in section 7 as including ‘the shape, configuration, pattern and ornamentation of the product’.¹⁵⁹ The section excluded the feel of a product, the materials used in the product and, in relation to products with one or more indefinite dimensions, the indefinite dimension and more than one repeat of any pattern.¹⁶⁰ The ALRC had recommended changing the word ‘article’ to the word ‘product’ as being more ‘contemporary’ and removing any reference to a design being ‘applied to’ a product, on the basis it often required stretching of language to suggest that something like a shape is ‘applied to’ and article.¹⁶¹ The ALRC had further recommended including surface and colour to the list of visual features protected but these words were not added to the definition.¹⁶² The removal of the phrase ‘judged by the eye’ followed the ALRC’s finding that it was unnecessary, and similarly the ALRC had considered that any reference to consumer or eye appeal, as was found in the UK legislation at that time was unnecessarily complex.¹⁶³

¹⁵⁶ ALRC Report, [3.59] – [3.71]. To date, no such review has been commissioned.

¹⁵⁷ Commonwealth, *Parliamentary Debates*, House of Representatives, 11 December 2002, 10080 (Warren Entsch MP).

¹⁵⁸ Designs Act 2003 s. 5.

¹⁵⁹ Designs Act 2003 s. 7(1).

¹⁶⁰ Designs Act 2003 s. 7(3).

¹⁶¹ ALRC Report, [4.9], [4.10].

¹⁶² ALRC Report, [4.6], [4.7].

¹⁶³ ALRC Report, [4.34] – [4.42].

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Finally, the Act attempted once again to ensure that a functional design could fall within the definition of design and would therefore not be excluded from the operation of the copyright exceptions to infringement found in sections 74–77 of the Copyright Act. The 1981 Amendments had proven ineffectual to counter the earlier lines of authority.¹⁶⁴ Section 7 thus provided that a visual feature ‘may, but need not, serve a functional purpose’.¹⁶⁵ The exclusion from the definition of design of ‘methods and principles of construction’ was also removed. The ALRC Report noted that the Federal Court had not been able to identify a clear meaning of the concept dictated solely by function¹⁶⁶ and that the courts had interpreted the exclusion in such a way that design protection was too narrow to cover useful products like locks and pumps.¹⁶⁷

The second key change made by the 2003 Act was to change the threshold for registration from ‘new or original’ (which had remained unchanged since 1906) to ‘new and distinctive when compared with the prior art base’.¹⁶⁸ This responded to the ALRC’s findings that the novelty test was seen as unacceptable by designers and manufacturers, and that the perception was that anything could be registered as long as it was not identical to another registered design. The Act defined a design as being ‘new’ unless it was ‘identical to a design that forms part of the prior art base’ and as being ‘distinctive’ unless it was ‘substantially similar in overall impression to a design that forms part of the prior art base’.¹⁶⁹ When assessing substantial similarity, the standard to be applied was to be that of the ‘informed user’. The ALRC had drawn this concept from the EC’s proposed Council Regulation on designs.¹⁷⁰

A third change also related to the scope of protection was to alter the definition of infringement. The ALRC’s consultations and submissions had revealed high levels of dissatisfaction with the courts’ narrow interpretation of design protection, particularly following the High Court decision in *Firmagroup*.¹⁷¹ The ALRC had proposed that the test for infringement should be one of ‘substantial similarity in overall impression’ to be assessed by an informed user. It also recommended that the test of ‘fraudulent imitation’ be removed and a non-exclusive list of factors be provided in the legislation for consideration in cases of infringement.¹⁷² These recommendations were followed in the 2003 Act.¹⁷³

The 2003 Act made a number of other significant changes in relation to the registration process and also reduced the term of protection from a maximum of 16 years under the 1906 Act to a maximum of 10 years – an initial period of five years with a renewal period of five years.¹⁷⁴ The ALRC had in fact

¹⁶⁴ *Compagnie Industrielle de Precontrainte et d’Equipment des Constructions SA v. First Melbourne Securities Pty Ltd and Others* (1999) 44 IPR 512.

¹⁶⁵ Designs Act 2003 s. 7(2).

¹⁶⁶ *Hosokawa Micron International Inc. v. Fortune* (1990) 26 FCR 393; (1990) 19 IPR 531.

¹⁶⁷ ALRC Report, [4.15]. Relevant cases are: *Firmagroup Australia Pty Ltd v. Byrne and Davidson Doors (Vic) Pty Ltd* (1987) 180 CLR 483; (1987) 73 ALR 321; *Warman v. Envirotech* (1986) 11 FCR 478; *Malleys Ltd v. J. W. Tomlin Pty Ltd* (1961) 180 CLR 120; (1961) 35 ALJR 353; *Stenor Ltd v. Whitesides (Clitheroe) Ltd* [1948] AC 107; *Kestos Ltd v Kempat Ltd & Kemp* (1935) 53 RPC 139.

¹⁶⁸ Designs Act 2003 s. 15(1).

¹⁶⁹ Designs Act 2003 s. 16.

¹⁷⁰ ALRC Report, [5.18].

¹⁷¹ *Firmagroup v. Byrne and Davidson Doors* (1987) 180 CLR 483.

¹⁷² ALRC Report, [6.6] – [6.13], [6.28] – [6.32].

¹⁷³ Designs Act 2003, ss. 19, 71.

¹⁷⁴ Designs Act 2003, s. 46.

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recommended reducing protection to fifteen years as this is recommended under the Hague Convention (should Australia decide in future to join), while conceding that 'None of the suggested rationales for design protection provide any persuasive argument for any particular period of protection.'¹⁷⁵ The Explanatory Memorandum to the Designs Bill stated it would not be in Australia's interests to provide a period of protection in excess of its international obligations (under TRIPS), as Australia is a net importer of intellectual property.¹⁷⁶

In relation to ownership, the Act continued to provide, as it had since 1906, that the designer would be the first owner unless the design were created in the course of employment or pursuant to a contract, in which case the employer or other contracting party would be the owner.¹⁷⁷ This echoed the position under the Copyright Act 1968, except in relation to commissioned works, which are owned by the author rather than the commissioner (with some exceptions relating to certain photographs, portraits and engravings).¹⁷⁸

Another innovation in the 2003 Act was to introduce a spare parts exclusion from design protection.¹⁷⁹ This was not a recommendation of the ALRC, which had examined the issue of spare parts but concluded the best approach would be to include a procedure for referral of potentially competitive designs to the Trade Practices Commission (now the Australian Competition and Consumer Commission). The Government, however, considered such an exception was necessary to ensure effective competition, particularly in the motor vehicle market.¹⁸⁰

At the same time as the Designs Bill was introduced, a second bill was introduced to amend the sections 74 – 77 of the Copyright Act. The first amendments made were to the definition of 'corresponding design'. As both the ALRC and the Lahore Report had noted, this definition gave rise to several problems. As noted above, the first problem was that if the work in question did not fall within the definition of 'design' in the Design Act, it could not be a corresponding design and would therefore retain copyright protection, contrary to the intention of the legislation. The second problem arose because s17A of the Designs Act provided that in the case where copyright subsisted in an artistic work and an application were sought for registration of a corresponding design, that design would not be treated as being other than new or original by reason of any previous use of publication of the artistic work. However, since 'corresponding design' was defined not to include two-dimensional features of pattern or ornament, such aspects would not be rescued by the provision and would be unable to be registered. For example, a published drawing for a fabric design could not be registered prior to manufacturing it because it would no longer be new.¹⁸¹ A third problem lay in the use of the word 'applicable', which was unclear in relation to designs which are not applied to a surface but form part of an article, such as embroidery, knits, weaves and other textured designs.

¹⁷⁵ ALRC Report, [10.7].

¹⁷⁶ Kathy Bowrey, Michel Handler, Dianne Nicol and Kimberlee Weatherall, *Australian Intellectual Property: Commentary, Law and Practice* 2nd ed. (South Melbourne: Oxford University Press, 2010), p. 356.

¹⁷⁷ Designs Act 2003, s. 13.

¹⁷⁸ Copyright Act 1968, s. 35.

¹⁷⁹ Designs Act 2003, s. 72.

¹⁸⁰ Commonwealth, *Parliamentary Debates*, House of Representatives, 11 December 2002, 10080 (Warren Entsch MP).

¹⁸¹ ALRC Report, [17.31].

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The definition was thus altered in the 2003 Act to read

Corresponding design, in relation to a design, means visual features of shape or configuration which, when embodied in a product, result in a reproduction of that work, whether or not the visual features constitute a design which is capable of being registered under the *Designs Act 2003*.¹⁸²

Further, 'embodied in' was defined to include 'woven into, impressed on, or worked into' a product.¹⁸³ By limiting the definition of 'corresponding design' to 'visual features of shape or configuration', the statute continued the policy of ensuring that two dimensional features would fall outside the definition and thus outside the exclusion of copyright protection in section 77. They could therefore be protected by both designs law and copyright.

A second change sought to clarify the status of works of artistic craftsmanship. The problem with excluding works of artistic craftsmanship lay in the uncertainty of the category and the Lahore Committee had noted that the courts in both the UK and Australia had experienced difficulty in determining whether a work was a work of artistic craftsmanship.¹⁸⁴ Under section 10 of the Copyright Act 1968, it was also ambiguous as to whether a work could be simultaneously a work of artistic craftsmanship and another kind of artistic works (such as a painting, sculpture or building). The 2003 Amending Act altered the wording of section 10 to make it clear that this was possible.¹⁸⁵ A related amendment was to add a provision to s77 that explicitly provided that for the purposes of that section 'building or model of a building does not include a portable building such as a shed, a pre-constructed swimming pool, a demountable building or similar portable building.'¹⁸⁶ This implemented the conclusion of the ALRC and the Lahore Committee that small portable buildings and pools were not suitable for copyright protection.¹⁸⁷ A further amendment to section 77 added a new section 77(1A) which operated to ensure that the manufacture of products reproducing such a specification or representation would not be a copyright infringement.¹⁸⁸

The problem of 'plan-to-plan' copying was also addressed. This was the issue which arose when engineering drawings were copied (either directly or indirectly), leading to a finding of copyright infringement.¹⁸⁹ Because the immunity in section 77 related only to applying a corresponding design to an article and not to copying in two dimensions as preparatory to making a product, the new section 77A extended the immunity from copyright infringement to cover reproductions of artistic works made in the course of or incidental to making a product where such reproductions were

¹⁸² Designs (Consequential Amendments) Act 2003 s. 2.

¹⁸³ *Ibid.*, s. 3.

¹⁸⁴ *Ibid.*, 18-19. See also *Cuisenaire v. Reed* [1963] VR 719, *Federal Commissioner of Taxation v. Murray* (1990) 21 FCR 436; (1990) 92 ALR 671; *George Hensher Ltd v. Restawhile Upholstery (Lancs) Ltd* [1976] AC 64; [1975] RPC 31.

¹⁸⁵ Designs (Consequential Amendments) Act 2003 s. 1.

¹⁸⁶ *Ibid.*, s. 13.

¹⁸⁷ Lahore Report, 17-18. See also *Tefex Pty Ltd v. Bowler* (1981) 40 ALR 326.

¹⁸⁸ *Ibid.*, ss. 8, 9.

¹⁸⁹ See *Warman International v. Envirotech Australia Pty Ltd* (1986) 11 FCR 478; 67 ALR 253, *Amalgamated Mining Services Pty Ltd v. Warman International Ltd and Ors* (1992) 111 ALR 269; (1992) 24 IPR 461, *Compagnie Industrielle de Precontrainte et d'Equipment des Constructions SA v. First Melbourne Securities Pty Ltd and Others* (1999) 44 IPR 512.

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produced by copying the three-dimensional product. However, direct copying of plans remained a copyright infringement.¹⁹⁰

The amendments made in 2003 therefore did not change the underlying policy of demarcation and partial cumulation, but simply shifted a few of the borders. The dual protection of two dimensional designs was clarified, works of artistic craftsmanship and architectural works continued to be given the choice of regimes, and other three dimensional works exploited industrially remained in the design regime. Small portable buildings and pre-fabricated swimming pools were moved from the category of copyright to being required to rely on design protection, as were two dimensional design drawings.

Part B Analysis / Assessment

Since the mid-nineteenth century, Australia has moved through different approaches to the design/copyright overlap. For a short period after Federation it had a system of dual or cumulative protection, although this appears to be largely because nobody turned their mind to a potential overlap. For almost eighty years between 1913 and 1990 the system was one of demarcation. After 1990, this developed into a policy that explicitly tolerated dual protection for two dimensional designs but required three dimensional designs being exploited industrially to find their protection in design rights. As the ALRC explained, the distinction between two and three dimensional works serves a 'rough justice' because designs applied to a surface usually fulfil an aesthetic purpose, while designs applied as shapes usually served an industrial purpose.¹⁹¹

Whether the changes in regime have had any effect on design applications and registrations is difficult to establish. Certainly, there seems to have been a decline in the number of applications around the time that dual protection for two dimensional designs was introduced, but this is from an unusual high point in 1987 and correlates to a period of recession in the economy. Numbers still remained well above those of earlier decades. A bigger increase in registrations can be seen after the introduction of the new Designs Act 2003, which made only minor changes to the overlap provisions.¹⁹² However, analysis by the Advisory Council on Intellectual Property (ACIP)¹⁹³ reveals that this increase is due to a strong rise in use by foreign companies. Use by Australian companies remains largely unchanged while use by Australian individuals has declined steeply.¹⁹⁴

A key challenge over the years has been how to formulate the policy of demarcation in sufficiently clear statutory language, and how to deal with works falling on the border between aesthetics and industry. It is probably fair to say that efforts have met with only partial success. In 1995, the ALRC Report had found that there was 'an unacceptable degree of confusion surrounding the designs/copyright overlap.'¹⁹⁵ Since the enactment of the Designs Act 2003, there have been a handful of court decisions interpreting the new provisions. Some of these have clarified the law, while others have revealed ongoing complexity and uncertainty.

¹⁹⁰ See discussion in David Brennan, 'The luckless plan-to-plan infringer' (2016) 26 AIPJ 131.

¹⁹¹ ALRC Report, [17.7].

¹⁹² See WIPO IP Statistics Data Center, at <http://ipstats.wipo.int/ipstatv2/index.htm?tab=industrial>, data for Australia, 1980-2014.

¹⁹³ ACIP was an independent, government-appointed body that has now been abolished.

¹⁹⁴ Advisory Council on Intellectual Property, *Review of the Designs System, Final Report* (March 2015), p.57

¹⁹⁵ ALRC Report, [17.3].

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In 2007, the High Court gave some useful guidance on the category of ‘works of artistic craftsmanship’ in the decision of *Burge v Swarbrick*.¹⁹⁶ The central issue in this case was whether a ‘Plug’ for a racing yacht (that is, ‘a hand-crafted full scale model of the hull and deck sections’¹⁹⁷ of the yacht) was a work of artistic craftsmanship, and thus exempt from the limitation on copyright infringement under section 77 of the Copyright Act 1968. The Court concluded that while it might be ‘impossible, and certainly would be unwise to attempt any exhaustive and fully predictive identification of what can and cannot amount to a work of artistic craftsmanship’ the determination turns not on assessing beauty, aesthetic appeal or harmony between visual appeal and utility, but rather on ‘assessing the extent to which the particular work’s artistic expression, in its form, is unconstrained by functional considerations.’¹⁹⁸ Based on this approach, the Plug was not a work of artistic craftsmanship because matters of visual and aesthetic appeal were subordinated to purely functional aspects, and the work of Mr Swarbrick in designing it was not that of an ‘artist-craftsman’.¹⁹⁹ In 2008, the Federal Court confirmed in *Digga Australia v Norm Engineering* that the 2003 amendments to section 77 had the effect that the copyright exception would apply to functional designs created after that date.²⁰⁰

Two cases have considered the new definition of ‘corresponding design’ in section 74 of the Copyright Act, both of them turning on technical discussions of whether certain treatments of fabric can be considered two or three-dimensional. In *Polo/Lauren Company L P v Ziliani Holdings Pty Ltd*,²⁰¹ the court was called upon to decide whether the embroidered polo player logo on Polo Ralph Lauren garments was a ‘corresponding design’ under the Act. The trial judge considered that it was because the logo was made up of at least 784 stitches, which altered the fabric and meant it was not a ‘mere’ surface design of pattern or ornamentation.²⁰² On appeal, however, the Full Court disagreed, appearing to decide (although not altogether clearly) that it would only consider features of shape or configuration to be embodied in three dimensions where the product is made in that shape or configuration in its entirety.

The Court did not, however, explicitly consider how one would decide whether something was three or two dimensional, and so questions remain as to where the line will be drawn.²⁰³ Indeed, the issue arose again in the recent case of *Seafolly v Fewstone*.²⁰⁴ This case involved copying of swimwear and the section 77 defence was raised in relation to an artwork depicting a diamond style smocking pattern placed onto Shirred fabric. The judge, Dodds-Streeton J, noted that the Full Court’s reasoning in *Polo/Lauren* was ‘not consistently explicit, but must be inferred, in some instances, from the

¹⁹⁶ (2007) 232 CLR 336. The case arose under the Copyright Act 1968 prior to the amendments of 2003, but there is no reason why the discussion of the meaning of ‘works of artistic craftsmanship’ would not continue to apply under the new section 77.

¹⁹⁷ Ibid. 344.

¹⁹⁸ (2007) 232 CLR 336, 364.

¹⁹⁹ Ibid. 362, 365.

²⁰⁰ *Digga Australia v. Norm Engineering* (2008) 166 FCR 268; 245 ALR 407; [2008] FCAFC 33.

²⁰¹ *Polo/Lauren Co. LP v. Ziliani Holdings Pty Ltd* [2008] FCA 49.

²⁰² *Polo/Lauren Co. LP v. Ziliani Holdings Pty Ltd* [2008] FCA 49 at [84].

²⁰³ See discussion in McCutcheon, ‘Too many stitches in time?’, 45-48, and Janice Luck, ‘Section 18 of the Designs Act 2003: The neglected copyright/design overlap provision’ (2013) 23 *Australian Intellectual Property Journal* 68, 82-84.

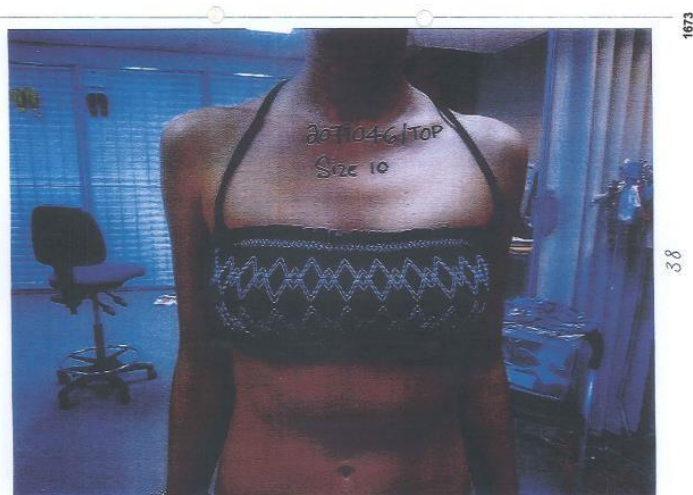
²⁰⁴ *Seafolly Pty Ltd v. Fewstone Pty Ltd* (2014) 313 ALR 41; (2014) 106 IPR 85.

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materials it cites or extracts.²⁰⁵ However, despite conceding that some of its statements could be read in more than one way, Dodds-Streeton J was able to conclude that the Full Court's reasons indicated that it is the features of shape or configuration that must be embodied in a product 'which will occur when the product (in the present case a garment) is made in the shape or configuration of the artwork.'²⁰⁶ She concluded that in this case the smocking could not be considered three-dimensional because it was only part of a product not itself made in the shape or configuration of the design. She stated that although the fabric was not flat, '[a]ny protrusion of the smocking from the surface is minimal and probably significantly less than that in *Polo/Lauren* itself.'²⁰⁷



The plaintiff's *Senorita* artwork.²⁰⁸



The defendant's bandeau-shaped garment.²⁰⁹

²⁰⁵ Ibid. 153.

²⁰⁶ Ibid. 153.

²⁰⁷ Ibid. 155.

²⁰⁸ © Seafolly Pty Limited. Image reproduced with permission.

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In 2012, ACIP was asked by the government to review the operation and effectiveness of the Designs Act 2003. ACIP delivered its report in March 2015, having carried out surveys, received submissions and analysed data from IP Australia. It made a number of recommendations for reform of the designs system, ranging from increasing the term of protection to fifteen years, to changing the terminology for registered but uncertified designs to make it clear that such designs do not confer registrable rights and introducing a grace period.²¹⁰ It recommended against introducing an unregistered design right, on the basis that there was very little support for it.²¹¹

In its consideration of the copyright/design overlap provisions, ACIP observed that the rules continued to be 'contentious and unsatisfactory'.²¹² Its survey of users of the design system revealed that two thirds of respondents admitted to some level of confusion as to whether their designs were covered by copyright or designs and similar levels of confusion were displayed in relation to whether or not to apply for an innovation patent or a design right.²¹³ ACIP received submissions for the Arts Law Centre of Australia, the National Association of Visual Artists (NAVA) and the Australian Copyright Council, contending that the provisions operated unfairly in respect of artists as compared to all other kinds of copyright owners and proposed reform that would improve the position of artists in relation to industrially applied artistic works.²¹⁴ By contrast, the Law Council of Australia suggested removing entirely the distinction between two-dimensional and three-dimensional embodiments so that that the provisions would apply to limit copyright irrespective of whether the artistic work was exploited in two- or three-dimensional form. The Law Council recognised this would reduce the protection of artists but considered removing the uncertainty to be more important. It also argued that the exclusion for works of artistic craftsmanship should apply only where the final products sold were themselves works of artistic craftsmanship, to reduce arguments over prototypes and models for industrial production.²¹⁵ Another concern raised in the ACIP review related to the loss of copyright protection for sculptures where 50 or more are made, on the basis it may be in breach of the Berne Convention.²¹⁶

A final problem identified by ACIP and earlier by Janice Luck²¹⁷ relates to ongoing inconsistency between section 18 of the Designs Act and section 77 of the Copyright Act. Luck points out that the amendments to the definition of 'corresponding design' in section 74 of the Copyright Act in 1989 and in 2003 were intended to exclude artistic works exploited or registered as two-dimensional designs applied to the surface of articles from the copyright limitations in sections 75 and 77 of the Copyright Act. Section 18 of the Designs Act is intended to allow artistic works to be registered as designs, even though they might otherwise not be considered 'new and distinctive' by reason of

²⁰⁹ © Fewstone Pty Ltd. Image reproduced in *Seafolly Pty Limited v Fewstone Pty Ltd* [2014] FCA 321, [13], [14].

²¹⁰ Advisory Council on Intellectual Property, *Review of the Designs System: Final Report* (2015) ('Final Report'). See full list of recommendations at pp. 10-12.

²¹¹ *Ibid.*, recommendation 22; Advisory Council on Intellectual Property, *Review of the Designs System: Options Paper* (2014) ('Options Paper'), 52-56.

²¹² Final Report, p.33.

²¹³ Options Paper, p. 32-33.

²¹⁴ Final Report, p. 34.

²¹⁵ Final Report, p. 35.

²¹⁶ Options Paper, p. 34.

²¹⁷ Luck, 'Section 18 of the Designs Act 2003'.

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having been used as artistic works (unless that use involved the sale or hire of products to which the design had been applied industrially). However, because section 18 refers to an application for a corresponding design in relation to that artistic work, and because 'corresponding design' is said to have the same meaning as in the Copyright Act,²¹⁸ the owner of the registered design can only rely on section 18 where the design consists of visual features of shape and configuration. However, as Luck argues, 'there appears to be no reason why corresponding design for the purposes of designs legislation should not have continued to be defined as a design that reproduces an artistic work regardless of whether the design consists of two-dimensional features of pattern or ornament or three-dimensional figures of shape or configuration.'²¹⁹

In its Options Paper, ACIP had canvassed three alternatives to address the ongoing problems in this field: (1) clarifying areas of uncertainty in particular the concept of when a design is 'embodied', especially in cases at the boundary of two and three dimensions, and limiting the exclusion for works of artistic craftsmanship to cases where the final marketed product is itself a work of artistic craftsmanship; (2) adopting a limited copyright term for industrially applied artistic works, in a manner similar to an unregistered design right; and (3) allowing full dual protection of designs and copyright works. Its instinct in the Options Paper was to adopt the first option. In relation to the third option, full dual protection, ACIP noted it had received no evidence that copyright protection was needed to provide sufficient incentives for such designs and that it was reluctant to extend copyright to cover mundane items of machinery. Third, it cautioned against using other jurisdictions as an example in favour of dual protection as such jurisdictions often applied a higher standard of originality to objects of applied art or exclude or give thin protection to functional visual features. Given the ease of acquiring copyright protection for artistic works in Australia, ACIP considered that 'although there are some suggestions in the copyright cases that protection may be limited where the creator's choices are limited, it would be a bold move to assume that these suggestions will be sufficient to ensure that copyright does not entirely take over the field of design and the protection of visual features of products.'²²⁰

In its Final Report, however, ACIP had changed its position and now considered that a review of the overlap provisions was largely beyond its remit, which was the Designs Act 2003. Its sole recommendation was therefore that steps be taken to make section 18 of the Designs Act consistent with the overlap provisions of the Copyright Act.²²¹ It seems likely, therefore, that Australia will continue to tinker with the provisions regulating the copyright/design interface without any dramatic change of policy in the foreseeable future.

²¹⁸ Designs Act 2003, s. 5.

²¹⁹ Luck, 'Section 18 of the Designs Act 2003', 80.

²²⁰ Options Paper, p. 35.

²²¹ Final Report, p. 35.