

"What You See Is What You Get"

The Art of Protecting Design in Intellectual Property Law

Teilmann-Lock, Stina

Document Version
Accepted author manuscript

Published in:
Grey Room

DOI:
[10.1162/grey_a_00393](https://doi.org/10.1162/grey_a_00393)

Publication date:
2024

License
Unspecified

Citation for published version (APA):
Teilmann-Lock, S. (2024). "What You See Is What You Get": The Art of Protecting Design in Intellectual Property Law. *Grey Room*, (94), 77-81. https://doi.org/10.1162/grey_a_00393

[Link to publication in CBS Research Portal](#)

General rights

Copyright and moral rights for the publications made accessible in the public portal are retained by the authors and/or other copyright owners and it is a condition of accessing publications that users recognise and abide by the legal requirements associated with these rights.

Take down policy

If you believe that this document breaches copyright please contact us (research.lib@cbs.dk) providing details, and we will remove access to the work immediately and investigate your claim.

Download date: 19. Sep. 2024



“What You See Is What You Get”: The Art of Protecting Design in Intellectual Property Law

Stina Teilmann-Lock

A general principle of European registered design law and U.S. design patent law is that “what you see is what you get.” This entails that only that which can be depicted visually—in a drawing or in a photograph and filed with a design or patent application—is protectible. This is a different approach from copyright law, which protects a design to the extent that it is a work of artistic craftsmanship (as in the United States and Australia) or a work of applied art (as in Scandinavian jurisdictions) and is the outcome of a designer’s “independent” and “creative” efforts, as required for copyright protection. In this article I consider some fundamentals in the definitions of design in European Union (EU) design law and in U.S. design patent law. Taking note of ways that intellectual property law defines and protects a design when it is specifically *not* classified as an artistic work reveals how statutes make distinctions between form and

This version is the author’s final version of the article, that has been accepted for publication in Grey Room.

function, utility and ornament (for the sake of preventing the creation of monopolies on, say, chairs with armrests, forks with a specific number of prongs and so forth, thereby balancing the rights of creators and the public's access to creative works). Distinctions in the law are legal constructs that have (often unrecognized) bearings on their, likewise historically constructed, counterparts in aesthetics.¹ The legal notion of design as “what you see” (which serves to legally define the object of design protection) suggests an often-unspoken expectation to art, in and outside of the law.

Ingrained in the international system of intellectual property law is a distinction between, on the one hand, industrial property and, on the other hand, literary and artistic property. Industrial property rights comprise patents, utility models, trademarks, geographical indicators, design, and more. Literary and artistic property is protected by copyright and applies to works of art, literature, music, movies, architecture, design, and more.

Intellectual property rights on both sides of this divide (industrial property as opposed to literary and artistic property) may apply to design. And since the major international conventions for intellectual property do not provide a specific definition of design as a category of subject matter, national legislators have been free to determine the extent and conditions under which design is protected.²

This is why national protection of design ranges from design patents and similar protection of “industrial designs and models” (where a design is perceived as the visual aspect of utilitarian products) to copyright protection of “works of applied art” or “works of artistic craftsmanship” (where design is perceived as a subcategory of visual art). The different legal approaches come with different frameworks for defining and protecting value in design. For

example, to obtain a design patent, one must file an application to an intellectual property office and pay registration fees; by contrast, copyright protection is conferred without formalities. If a design patent is granted, the intellectual property office verifies its validity. Copyright, ultimately, is validated by a court and only in the case of litigation. Terms of protection differ. Patents usually last for a maximum of twenty years, and European design rights last for up to twenty-five years, while copyright duration is the lifetime of the creator plus seventy years.

The Value of Artefacts

When a design is viewed as a subcategory of art, legal discourse highlights particular features that the law associates with visual art under copyright. This is reflected in the copyright approach to design: a design is protectible insofar as it represents the independent and creative choices of the designer. When a design is viewed as a form of industrial property, a different set of attributes is highlighted. In either case the rules have been put in place to protect what is deemed valuable in a design. The following exploration of the ways design is defined by U.S. patent law and by EU design law throws light on how design is ascribed value in patent and design law.

Looks Matter: U.S. Design Patents

Title 35 of the United States Code (U.S.C.) provides the legal basis for patent protection. Patent law protects *inventions*; “novelty” and “nonobviousness” are requirements for patentability.

Section 101 provides that “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”³ In addition, section 171 specifies that “Whoever invents any new, original, and ornamental design for an article of

manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.”⁴

Thus, U.S. patent law distinguishes between “utility patents” and “design patents,” another version of the long-standing aesthetic false dichotomy of function and form. The former protects the way a given article works and is *used*; the latter protects the way a given article *looks*. Both utility patents and design patents require examination and registration with the U.S. Intellectual Property Office to become valid. To apply for a patent, the claim for protection must be filed along with clear and complete drawings or photographs of the design. Submitted drawings or photographs constitute a complete disclosure of the appearance of the design: exactly what is depicted amounts to the claimed design, and nothing can be left to conjecture or deduction.

Design patent protection applies to (1) surface decoration applied to an article; (2) the configuration or shape of an article; and (3) a combination of the two.⁵ The “surface decoration” or “configuration” must be new and nonobvious if it is to qualify for a design patent. Finally, a design must fulfill the requirement of ornamentality; that is, it must have been created for the purpose of ornamenting (USPTO 1504.01(c)).

To All Appearances: European Design Law

European design protection has its legal basis in the EU Design Directive and in the Regulation on Community Designs.⁶ The system of registered rights as laid out in the directive and the regulation shares some structural features with U.S. design protection. Among these is the “industrial property” approach to design. For a design to be protected by European design rights, it must be “new” and have “individual character.” And, if protection is to be granted, the design

must be registered with an EU intellectual property authority. In the filing of an application for design protection in Europe, what is visually depicted in a valid registration is the protected design, nothing more, nothing less. This is the principle of “what you see is what you get.”

One major difference separates European design law from U.S. design patents: EU law has no requirement of ornamentality. EU design law defines designs as “the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation.”⁷

Furthermore, the law stipulates that “a design right shall not subsist in features of appearance of a product which are solely dictated by its technical function.”⁸ In this way a distinction is made between features of appearance dictated by function, as opposed to design features that we might say are governed by the “function of design.” The cited rules provide for the European “neutral” definition of design in design law. In particular, design protection in the European system does not require a separate aesthetic appeal or intention in the design.⁹

If Value, Then Right

In both U.S. patent law and in EU design law, the protectable elements of design are defined in opposition to utility. That is, the value the law has been put in place to protect is for design to be something beyond useful, though in this case not for being artistic. Contrary to modernist orthodoxy, the implied aesthetic norm of design patents is that protectible form cannot follow function.

The requirements for novelty and individual character/nonobviousness are criteria for design protection on either side of the Atlantic. Yet the two jurisdictions differ on the issue of ornamentality. This disparity has practical implications for design protection and litigation in the

different regions. However, transcending the difference is the fact that in both legal frameworks rights are granted to a design in its capacity as *visible*. In design patents and in design law, the protectible value of design is that it can be seen, that it is visually distinguishable. This sets it apart from the value that copyright protects in visual art. Artistic copyright protects the visual artist's (or designer's) own creative effort as it manifests in a visual work. There is no requirement that it be visible. Thus, by implication, in design law and design patent law it is a protectible value of visual art that what you get is *more* than what you see.

¹ For brief critical summaries of these long-standing distinctions in aesthetics, see Arindam Dutta, *The Bureaucracy of Beauty: Design in the Age of its Global Reproducibility* (New York: Routledge, 2006); and Gülru Necipoğlu and Alina Payne, eds., *Histories of Ornament: From Global to Local* (Princeton, NJ: Princeton University Press, 2016). See also studies of the interrelatedness of legal and aesthetic concepts in Tobias Vogelsang, "Law, Design, and Market Value: Lessons from the Cantilever Chair, 1929–1936," *Enterprise and Society* 18, no. 3 (2017): 536–565; Stina Teilmann-Lock, "Industrial Property or Artistic Property? Design, Intellectual Property Law and the PH Lamp," *Journal of Design History* 30, no. 4 (2017): 408–419; Stina Teilmann-Lock, *The Object of Copyright: A Conceptual History of Originals and Copies in Literature, Art and Design* (London: Routledge, 2015); and Otakar Máčel, "Avant-Garde Design and the Law: Litigation over the Cantilever Chair," *Journal of Design History* 3, no. 2/3 (1990): 125–143.

² The major international conventions are the Berne Convention for the Protection of Literary and Artistic Works, the Paris Convention for the Protection of Industrial Property, and the Trade-Related Aspects of Intellectual Property Law Agreement. For recent contributions to the debate on the different approaches in design law, see Tsukasa Aso, Christoph Rademacher, and Jonathan Dobinson, eds., *History of Design and Design Law: An International and Interdisciplinary Perspective* (Singapore: Springer, 2022); Niklas Bruun et al., eds., *Transition and Coherence in Intellectual Property Law: Essays in Honour of Annette Kur* (Cambridge, UK: Cambridge University Press, 2021); Claudy Op Den Kamp and Dan Hunter, eds., *History of Intellectual Property in 50 Objects* (Cambridge, UK: Cambridge University Press, 2019); Estelle Derclaye, ed., *The Copyright/Design Interface: Past, Present and Future* (Cambridge, UK: Cambridge University Press, 2018); and Annette Kur, Marianne Levin, and

Jens Schovsbo, eds., *The EU Design Approach: A Global Appraisal* (Cheltenham, UK: Edward Elgar, 2018). See also Jerome H. Reichman, “Past and Current Trends in the Evolution of Design Protection Law: A Comment,” *Fordham Intellectual Property, Media and Entertainment Law Journal* 4, no. 1 (1993): 387–403.

³ 35 U.S.C. 101.

⁴ 35 U.S.C. 171.

⁵ Sarah Burstein, “Whole Designs,” *University of Colorado Law Review* 92 (2021): 181–254.

⁶ Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs, 1998; and Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Designs, 2002. The regulation provides for both registered and unregistered community design rights. The focus here is on registered rights.

⁷ Directive 98/71/EC, art. 1.

⁸ Directive 98/71/EC, art. 7.

⁹ Similarly, the 1970s pan-Nordic design acts were based on a neutral definition of design. See Jens Schovsbo and Stina Teilmann-Lock, “We Wanted More Arne Jacobsen but All We Got Was Boxes: Experiences from the Protection of Designs in Scandinavia from 1970 till the Directive,” *International Review of Industrial Property and Competition Law* 47, no. 4 (2016): 418–437.