

CHAPTER 12**SECTION 17A - COPYRIGHT****INDEX**

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INTRODUCTION

- 12.1 Section 17A is about designs based on artistic works. These designs are to be considered as new or original although the artistic works may have been used prior to the making of the design applications.
- 12.2 Stated another way, s17A operates to exclude certain documents from being used to establish an objection to registration under s17(1)(a). (See Chapter 13)
- 12.3 The examiner may find s17A being used to argue against an objection that the design is prior published in Australia before the priority date. In that situation the examiner should consult the example at paragraph 12.19 and the procedure in paragraphs 12.20 to 12.23.
- 12.4 Section 17A has also been tried as a defence against published information lodged under s27A(4) of the Designs Act. (See for example, *Baker and Priem's Application* (No.2) 15 IPR 660)

INTERPRETATION/CASELAW

- 12.5 The examiner must note that the meanings of some expressions in s17A are defined elsewhere.

The examiner must also note that some of the provisions of s17A have been considered by hearing officers or the courts.

Three expressions are defined elsewhere. They are:

- (a) artistic work
- (b) corresponding design
- (c) to be applied industrially

Expressions (a) and (b) are mentioned in s4(1) of the Act. Full definitions of the three expressions are found in the Copyright Act (1968). The definitions appear below.

DEFINITION OF "ARTISTIC WORK"

- 12.6 Section 10 of the Copyright Act (1968) defines an "artistic work" as meaning:
- (a) a painting, sculpture, drawing, engraving or photograph, whether the work is of artistic quality or not; or
 - (b) a building or a model of a building, whether the building is of artistic quality or not;
- or
- (c) a work of artistic craftsmanship to which neither (a) nor (b) applies.

A "sculpture" can be:

- . a cast made for sculpture purposes
- . a model made for sculpture purposes

A "drawing" can be:

- . a diagram
- . a map
- . a chart
- . a plan

An "engraving" can be:

- . an etching
- . a lithograph
- . a photogravure product

A "photograph" can be:

- . a product of photography
- . a product of xerography
- . a product of a process similar to photography

A "photograph" does not mean a cinematograph film.

An artistic work does not have to be of artistic quality. Engineering drawings fall within the definition of "artistic work". (See *Amalgamated Mining Services Pty Ltd v Warman International Ltd* 24 IPR 461 at 471.) In *Tefex Pty Ltd v Bowler* 40 ALR 326 drawings of a fibre glass swimming pool were considered to be an artistic work.

- 12.7 In *Baker and Priem's Application (No.2)* 15 IPR 660 the Hearing officer considered, at page 670, that a vehicle bull-bar was not a sculpture as defined by the Copyright Act (1968). Also he considered:

"Nor do I think that when Messrs Baker and Priem were assembling the original bull-bar, their main object was that it should have "substantial appeal to the aesthetic tastes of those who observe it", and thus I do not view it as being a work of artistic craftsmanship".

- 12.8 Works of "artistic craftsmanship" have included such articles as pottery, embroidery and silverware Articles such as a bicycle helmet, a baby's rain cape, a lady's frock, a set of mathematical teaching rods and a moving sand picture have been considered by the courts as to whether they are works of artistic craftsmanship.

12.9 Considering this in more detail; in *Merlet v Mothercare PLC* 2 IPR 456 the High Court of Justice held:

- (a) that a prototype of a cape to protect a baby from the weather was not "a work of artistic craftsmanship" as the plaintiff had not intended to create a work of art
- (b) that in deciding whether a prototype was a "work of artistic craftsmanship" the prototype must be judged on its own and not in the context in which it was used.

In *Safe Sport Australia Pty Ltd v Puma Australia Pty Ltd* 4 IPR 120 the court heard argument on the issue of whether a prototype of a sporting helmet was a "work of artistic craftsmanship". The issue was left undecided.

In *Ilona Komesaroff v John Mickle* 7 IPR 295 the action concerned "moving sand pictures" which consisted of two parallel panels of rectangular glass held together by aluminium channelling. A 1mm gap between the panels was filled with contrasting coloured sand, coloured liquid and a bubble producing substance. The picture could be inverted and the sands would trickle through the bubbles to form striking miniature landscapes of contrasting shades at the lower part of the picture. The court held the moving picture was not a work of artistic craftsmanship.

In *Cuisenaire v Reed* (1963) VR 719 in relation to a set of mathematical teaching rods it was held:

"As no special skill or training was required to cut the strips of wood in predetermined lengths, and to colour them, it could not be said that any craftsmanship was involved in their production and they were not therefore, works of "artistic craftsmanship"."

In *Burke v Spicer's Dress Designs* (1936) 1 All ER 99; Clauson J. held:

"..any artistic element in the craftsmanship in the making of the dress came from M. L. Burke's design, and the dress was not therefore an original work of artistic craftsmanship."

12.10 It has been considered that "artistic" has a narrower meaning in the phrase "artistic craftsmanship" than when it is used in the more general phrase "artistic work". (See *Cuisenaire v Reed* (1963) VR 719.)

DEFINITION OF "CORRESPONDING DESIGN"

12.11 A "corresponding design" is defined in s74(1) of the Copyright Act (1968). "Corresponding design", in relation to an artistic work, means a design that, when applied to an article, results in a reproduction of that work.

A corresponding design does not include a design consisting solely of features of two-dimensional pattern or ornament applicable to a surface of an article.

CAN THE "CORRESPONDING DESIGN" BE THE SAME AS THE "ARTISTIC WORK"?

- 12.13 A corresponding design of an artistic work can not be the artistic work itself. In *Water Recreations Pty Ltd v Fairmile Pty Ltd* (1982) 42 ALR 273 the artistic work was the drawings of waterslide components. The representations in the design applications were identical with some of the drawings of the waterslide components. The court held the design applications were not for registration of a corresponding design.

DEFINITION OF "TO BE APPLIED INDUSTRIALLY"

- 12.14 Regulation 17 of the Copyright Regulations provides a design is taken to be applied industrially:

- (a) if it is applied to more than 50 articles;
- or
- (b) to one or more articles (other than hand-made articles) manufactured in lengths or pieces. An article can include a set of articles.

Regulation 17 also provides that a design shall be taken to be applied to an article if:

- (a) the design is applied to the article by a process (whether a process of printing, embossing or otherwise); or
- (b) the design is reproduced on or in the article in the course of the production of the article.

- 12.15 Regulation 17 is a deeming provision. (In its legal sense "deem" means to assume something to be a fact which may or may not be one.)

Sometimes the courts have applied reg.17 literally. For example, in *Coonan and Denlay v Superstar Australia Pty Ltd* 37 ALR 155 the Federal Court required the number of articles to be counted. This seems to ignore the fact that some industrial designs are applied to fewer than 50 items, e.g. large machines.

On the other hand in *Safe Sport Australia Pty Ltd v Puma Australia Pty Ltd* 3 IPR 120 King J. considered:

"I think that there is nothing incongruous in leaving it to be decided as a question of fact whether there is industrial application of a design in a case where less than 50 applications of the design have taken place. However, if one reaches the point of this question of fact in this case, Mrs Ashmore's evidence establishes, for present purposes, that on 7 March 1983 only three prototypes of the plaintiff's helmets had

been made and that no manufactured helmets were received by the plaintiff until after that date. On the face of it the making of prototypes is not the industrial application of a design...".

A recent decision exploring the question of industrial application is *Press-Form Pty Ltd v Henderson's* (1993) AIPC 90-964 Gummow J. held:

"There is no absolute proposition that the production of a prototype takes any particular case outside the scope of industrial application; nor, while it is a matter to be taken into account, it is particularly significant that the method of production of the prototype differed from the more expensive procedures which would be necessary to produce the final commercial product if the contract were in fact obtained."

12.16 The examiner should also note that s17A does not restrict industrial application of the design to Australia. (The Designs Law Review Committee Report on the Law Relating to Designs said of s17A:

"...We consider that design protection should not be available for the corresponding design where industrialisation has taken place and the corresponding design is published in Australia before the priority date of an application for registration. We recommend, accordingly, that a provision be inserted in any new designs legislation to the effect that where copyright subsists in an artistic work; a corresponding designs applied industrially in a place other than Australia by, or with the licence of, the owner of the copyright in that place and articles made to the corresponding design are sold in a place other than Australia; and the corresponding design has been published in Australia before the priority date of an application for the registration of the corresponding design, the corresponding design shall not be deemed to be new or original".)

12.17 The prior use must be prior use of the artistic work and not prior use of the corresponding design. (See *Skedleski v Underwood* 17 IPR 161.)

12.18 The claim by an applicant that there has been no industrial application must be considered by the examiner in the light of the evidence provided by the applicant.

EXAMPLE

12.19 A design application was made for a tap handle. The design related to the shape and configuration of the handle.

The examiner found a picture of a substantially identical tap handle in a magazine published in Australia before the priority date of the design application.

The examiner objected that the application was not for a new or original design in view of the prior publication.

The attorney for the applicant responded by invoking s17A. In a statutory declaration the company secretary of the applicant company declared:

- . an existing tap had been modified to make a prototype
- . the prototype had been photographed to produce copy for the magazine advertisement
- . some tap handles of non-commercial quality had been manufactured but no orders had been accepted and there had been no approval for sale granted
- . at the date of lodgement of the design application the design had not been industrially applied.

The examiner maintained the objection. The applicant requested a hearing. At the hearing the hearing officer decided:

- . either the prototype or the photograph of the prototype was the artistic work. The prototype could be considered a "sculpture". Alternatively the prototype could be considered a "work of artistic craftsmanship" since in crafting the object the aesthetic appeal of the final object was no doubt a factor (tap handles apart from their functionality must have some aesthetic appeal given the wide style range produced by the industry)
- . the drawings of a tap handle in the design application were the corresponding design which when they were applied to an article or substance would result in a reproduction of the artistic work
- . the handles produced could be considered as production prototypes and given that none of these prototypes were available for sale or hire, their production did not constitute industrial application
- . the design was new and original due to the application of s17A.

(See unreported decision on registered design no. 105872.) *Dorf Industries Pty Ltd.*

PROCEDURE

12.20 Suppose the examiner took an objection of prior publication during examination. The applicant seeks to argue against the objection by using s17A as a defence. What matters should the examiner look for in the argument? How should the applicant present the argument?

12.21 *Bissell AG's Design* (1964) RPC 125, was similar to the above Example. An objection on the grounds of prior publication was overcome by use of s6(4) of the Registered Designs Act (UK). Section 6(4) parallels s17A of the Australian Act. The UK Designs Registry required the applicant to lodge a statutory declaration.

12.22 The argument against an objection of prior publication is to be made by the applicant lodging a statutory declaration. The statutory declaration must set out all facts relevant to s17A.

12.23 The statutory declaration should provide the following:

- . details of the artistic work
- . the name of the owner of the copyright in the artistic work. (If the owner of the copyright and the applicant for the design registration are not the same the consent of the owner of the copyright should be provided.)
- . details of any use previously made of the artistic work.

If the examiner is of the opinion that the design application is:

- (a) an application for a corresponding design

and,

- (b) the artistic work has not been industrially applied before the priority date of the design application,

then the objection of prior publication is not to be maintained.

When the examiner forms a contrary opinion, the objection of prior publication is to be maintained.