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TITLE

**Methods for Securing Authors' Rights to their Works of Art: Copyright v.
Industrial Design**

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INTRODUCTION

In 1841 in the United States the copyright law extended protection solely to intellectual products, for example: writings, musical compositions, pictorial or sculptural works, while patent law protected new and useful machines, manufacturers. Therefore, it seems that designs of the products fit somewhere between industrial design (design patent) and copyright law protection systems. The question is: where is the place of design in intellectual property law?¹

The term “industrial design” is used in the EU countries and in the RA while the term “design patent” is used in the USA. These two terms are used for the same concept. In this Paper the term “industrial design” will mostly be used, and the term “design patent” will be used in cases applicable to the United States.

Patent protection is a very strong form of intellectual property protection, because it gives the author the opportunity to exclude others from making, using, selling the object of design without permission. Copyright protection is also a qualified type of protection. Copyright is intended to protect the artistic expression and it can protect designs to the extent that designer need those incentives.²

Under the US law, pictorial, graphic and sculptural works can be protected by copyright. Design patent protection can be provided for new, original and ornamental designs of articles of manufacture. There are several criteria that should be met for a design to be protected by design patent. The French law provides copyright protection for original designs fixed in material form. Industrial design protection can be provided for designs that are new and have individual character.

All investigated legislations – Armenian, US and French – provide the possibility of overlap between copyright and industrial design. It means that some works can be protected both by copyright and by industrial design. According to WIPO interpretations, considering that there is an overlap between the protection types, three protection regimes are possible: cumulative protection, protection regimes separation and partial overlap of protection regimes

¹ Daniel H. Brean, *Enough is Enough: Time to Eliminate Design Patents and Rely on More Appropriate Copyright and Trademark Protection for Product Designs*, 16 Texas I.P. Law Journal, 327 (2008)

² *Id.* at 328

To understand what kind of works can be protected by copyright and by industrial design, the US law provides the principle of separability of the artistic features from the utilitarian aspects of the article. According to the principle of separability, only those artistic features of the design can be protected by copyright, which can exist independently of the utilitarian aspects of the design and can be identified separately from them.

Under the Armenian legislation, there is no such regulation. That is why the place of design in intellectual property law system under the Armenian legislation is not defined and is broader than in the international intellectual property protection practice.

In practice, Armenian authors protect their intellectual property in this or that way. Some authors protect the design by copyright, others by industrial design. There are several practical differences that will be examined in this Paper, which may have influence on authors' choice of protection type. For example, registering the industrial design is more costly, but it provides certificate of intellectual property ownership. Design protected by copyright cannot be registered, but it provides protection from the moment of creation.

As there is a practice to protect design, particularly jewellery design, in both ways, considering that these two types of protection provide different conditions for the authors, the thesis problem appears. The thesis question is the following: **which type of intellectual property protection is more effective for the jewellery design?**

The paper literature is based on a comprehensive study of the Armenian, US, French legislation and practice, as well as WIPO policies on copyright, industrial design, overlaps between them, as well as protection and registration practice. The US, French legislations and WIPO policies were investigated and presented in this Paper as international best practice. After the investigation, a comparative analysis was made in order to answer the thesis question and other questions arising during the legal research.

The significance of the problem question is mentioned below. The intellectual property protection is developing in RA nowadays, and authors start to register their intellectual property and protect their rights over copyrightable or patentable designs. As it is already mentioned, Armenian authors protect their design in two different ways. The important thing is to be informed which type of protection will be the most effective one for the authors with respect to jewellery design. The protection of authors' rights over their works of art will benefit, if authors are aware of types of protections and their effect.

An effective intellectual property protection system will be useful also for consumers and the public as it provides fair competition and fair trade, as well as promotes creativity and attracts consumers' attention to aesthetic products. The protection of the design as subject of intellectual property contributes to the development of the economy, encouraging creative activity in the fields of industrial and home production, as well as in traditional arts and crafts. These, in their turn, contribute to the expansion of commercial activity and the export of national products.

Besides, in this Paper practical recommendations will be made for Armenian authors, and that will result in better protection of rights over their intellectual property. The Paper will also draft an amendment to the current Armenian legislation on intellectual property.

The object of this Paper will be limited to the design of jewellery.

CHAPTER 1

COPYRIGHT AND INDUSTRIAL DESIGN IN ARMENIA

First of all, it is important to answer to the following question: what types of work are considered objects of copyright and what types are considered objects of industrial design, under the legislation of the Republic of Armenia.

According to Section 1 of Article 3 of the Law of the Republic of Armenia on Copyright and Related Rights: *“The object of copyright is considered the exclusive result of the work performed by the author independently or in cooperation with other authors in the field of literature, science and art (hereinafter referred to as "creation") expressed in oral, written or other objective form, including permanent or temporarily preserved electronic forms, regardless of the scope, significance, virtues, or purpose of the creation.”*³

According to Section 3 of the same Article, both published and non-published works can be protected by copyright.⁴

According to Subsection (b) of Section 4 of the same Article: *“Objects of copyright are: b) works of painting, sculpture, graphics, design and other fine arts...”*⁵

The abovementioned Article provides the list of works that can be protected by copyright, and works of painting, sculpture, graphics, design and other fine arts are part of it. Now the mentioned works can be compared to the works that are protected by industrial design under the legislation of the Republic of Armenia.

According to Section 1 of Article 22 of the Law of the Republic of Armenia on Inventions, Utility models and Industrial designs: *“A new and unique solution defining the appearance of an article is protected as an industrial design in the manner prescribed by this law.”*⁶

According to Section 2 of the same Article: *“In terms of the meaning of this law, the “design” is the appearance of an article in whole or in part, which is the result of its*

³ 20-142-Ն Law of RA on Copyright and Related Rights §3(1) (Jul. 21, 2006), available at <http://www.arlis.am>”

⁴ Law of RA on Copyright and Related Rights §3(3)

⁵ Law of RA on Copyright and Related Rights §3(4(b))

⁶ 20-111-Ն Law RA on Inventions, Utility models and Industrial designs §22(1) (Jan. 1, 2009), available at <http://www.arlis.am>”

characteristic features, in particular contours, colours, shapes, forms, as well as materials and / or its trim."⁷

According to Section 1 of Article 23 of the same Legal act: *"The industrial design is new if an identical design has not been established, that has become publicly available before the application filing date to the State authorized body or, if the priority is requested, before the date of priority, moreover, industrial designs shall be considered identical, if all of their features coincide, or differ not essentially."*⁸ According to Section 2 of the same Article: *"The industrial design is unique if the general impression that it leaves to the informed consumer differs from the overall impression left on any such consumer by any other industrial design that has become publicly available before the application filing date to the State authorized body or, if the priority is requested, before the date of the priority."*⁹ So, no design that is publicly available and identical to the given industrial design shall be established, and the general impression that the design leaves on consumer shall differ from the overall impression left by any other publicly available industrial design before the application filing date, for the industrial design to be protected.

According to Section 2 of Article 28 of the same Legal act: *"An industrial design may not be preserved in the manner prescribed by this law and may be protected as a copyright subject matter from the date of its creation or fixation in any form."*¹⁰

Hereby, the objects of industrial design can also be protected by copyright, certainly, if the design meets the copyright protection requirements, prescribed by the RA legislation. As prescribed by Article 3 of the Law of the Republic of Armenia on Copyright and Related Rights, works of painting, sculpture, graphics, design and other fine arts are objects of copyright. If the mentioned works are new and unique, as prescribed by Article 22 of the Law of the Republic of Armenia on Inventions, Utility models and Industrial designs, then they can be protected by industrial design as well. Thus, there is an overlap between copyright and industrial design protection: new and unique designs can be both protected by copyright and industrial design.

⁷ Law RA on Inventions, Utility models and Industrial designs §22(2)

⁸ Law RA on Inventions, Utility models and Industrial designs §23(1)

⁹ Law RA on Inventions, Utility models and Industrial designs §23(2)

¹⁰ Law RA on Inventions, Utility models and Industrial designs §28(2)

In these two intellectual property protection types the place of jewellery design is not precisely defined under the Armenian legislation. A question arises, whether the design shall be protected by copyright or by industrial design. We can assume that jewellery design can be protected both by copyright and by industrial design, if it complies with the regulations provided by the law for each protection type.

According to Section 1 Article 9 of the Law of the Republic of Armenia on Copyright and Related Rights: *“Copyright to a work derives from the fact of creation of the work. The work shall be deemed created if it is expressed in an objective form allowing perception and does not depend on the official certification of that right, registering the work, or any other action.”*¹¹ Hereby, copyright to a work can be protected from the moment of creation.

According to Section 1 of Article 26 of the Law of the Republic of Armenia on Inventions, Utility models and Industrial designs: *“On the basis of the registration of an industrial design, the creator gets an exclusive right to use the industrial design and to prohibit third parties from using the design without the creator's consent.”*¹² To register an industrial design one shall file an application to the State authorized body for the registration and the appropriate certificate.

Summarizing the above, no copyright registration is stipulated by the Armenian legislation, and only industrial design can be registered. Copyright to a work arises from the moment of creation itself.

So, after registering an industrial design, the author gets a certificate of intellectual property ownership. This is a legal document that can be represented in court, in case the intellectual property rights are infringed, and the author sues the infringer. The certificate of intellectual property is a proof of the fact that the rights over the industrial design belong to the author. In this case the infringement will be very easy to prove. On the other hand, filing an application to the State authorized body, registering the industrial design and getting a certificate of intellectual property ownership is quite costly.

Unlike the industrial design, there is no procedure for copyright registration at any state body, stipulated by the Armenian legislation. Copyright over a work cannot be registered, but the rights arise from the moment of creation. That is to say, there aren't any

¹¹ Law of RA on Copyright and Related Rights §9(1)

¹² Law RA on Inventions, Utility models and Industrial designs §26(1)

expenses for copyright protection. Moreover, the presumption of authorship is stipulated by the Law of the Republic of Armenia on Copyright and Related Rights. According to Section 1 Article 8 of the mentioned legal act, if the name of a person is mentioned on the work, in the publication of the work, or in other cases, prescribed by this article, that person is recognized as the author of the work, as long as the opposite is not proven.¹³ It is necessary to mention, that there is no burden of proof on the author of the work regarding the authorship.

There is practice of authors protecting their jewellery design both by copyright, and industrial design in the Republic of Armenia. Some authors use industrial design protection type, others use copyright.

According to Section 1 of Article 37 of the Law of the Republic of Armenia on Copyright and Related Rights: *“Property rights of the author over their creation are valid during the lifetime of the author and continue to be valid for seventy years after their death.”*

¹⁴ According to Section 1 of Article 29 of the Law of the Republic of Armenia on Inventions, Utility models and Industrial designs: *“The registered industrial design can be protected during five years from the application filing date with an opportunity to extend the period of protection.”*¹⁵ According to Section 2 of the same Article, it is possible to extend the period of protection by five years each time, but the overall protection period shall not be longer than twenty-five years from the application filing date.¹⁶

According to Article 2(7) of Berne Convention for the Protection of Literary and Artistic Works: *“Subject to the provisions of Article 7(4) of this Convention, it shall be a matter for legislation in the countries of the Union to determine the extent of the application of their laws to works of applied art and industrial designs and models, as well as the conditions under which such works, designs and models shall be protected.”*¹⁷

According to Article 7(4) of the same Convention: *“It shall be a matter for legislation in the countries of the Union to determine the term of protection of photographic works and that of works of applied art in so far as they are protected as artistic works; however, this*

¹³ Law of RA on Copyright and Related Rights §8(1)

¹⁴ Law of RA on Copyright and Related Rights §37(1)

¹⁵ Law RA on Inventions, Utility models and Industrial designs §29(1)

¹⁶ Law RA on Inventions, Utility models and Industrial designs §29(2)

¹⁷ Berne Convention for the Protection of Literary and Artistic Works, art. 2(7), Sep. 9, 1886, available at file:///E:/AUA/MP/trt_berne_001en.pdf

term shall last at least until the end of a period of twenty-five years from the making of such a work.”¹⁸

Hereby, it is the matter of the RA national legislation to determine the extent of the application of the RA laws to works of applied art and industrial designs so far as they are protected as artistic works. However, the duration of intellectual property protection must be at least twenty-five years from the date the work was made.

¹⁸ Berne Convention for the Protection of Literary and Artistic Works, art. 7(4)

CHAPTER 2

INTERNATIONAL BEST PRACTISE

§1. COPYRIGHT AND DESIGN PATENT IN THE USA

Copyright grants exclusive rights to the author of a work of art, generally for a specific period of time. These exclusive rights are as follows: the right to copy the work, the right to be credited for it, as well as the right to decide who can perform or adapt the work, or benefit from it financially.¹⁹

Economic rights of an author over their work of art are protected by the Federal Copyright Act of 1976. According to Section 102 of Federal Copyright Act of 1976:

“(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

*... (5) pictorial, graphic, and sculptural works... ”*²⁰

Hereby, the work of art must belong to one of the abovementioned categories to be protected by copyright in the USA.

As for design patent, this type of protection can be used for new, original and ornamental designs of articles of manufacture. A design patent gives the creator the right to prevent others from using, making and selling the design in the USA and in international transactions.²¹

There are five criteria for design patent to be implemented as protection for the design: article of manufacture, originality, novelty, non-obviousness, ornamentality.²²

Firstly, to be protected by design patent, the design must be created for an article of manufacture. That is to say, the design must be connected with or applied to some other object to be protected by design patent. An abstract design standing alone cannot be patented.

¹⁹ Sebastián M. Torres Rodríguez, *The Convergence of Design Patent Law, Trademark Law, and Copyright Law for Better Protection of Intellectual Property for Commercial Designs*, 2 U.P.R. Business Law Journal 126 (2015)

²⁰ Copyright Act of 1976, Pub. L. No. 94-553 §102(a), 90 Stat. 2541 (Oct. 19, 1976)

²¹ Sebastián M. Torres Rodríguez, *supra* at 136

²² *Id.* at 136

Secondly, the patentable design must be original. The originality requirement for the design patent is in the following: the design must not be derived from any source or any person, except the creator itself. In other words, any simulation of well-known objects and persons cannot be protected by design patent. However, “reassembling or grouping of familiar forms” is still acceptable for the design to be considered original.

Third criterion for the design to be patented is novelty. The average observer test is used to determine the novelty of the design. It is important, how an average observer perceives the design. According to this criterion, the appearance of the claimed design for an ordinary observer must differ from the appearance of any other design perceived before. It is important to mention, that the novelty of a design patent and that of a utility patent are different. The novelty of the design patent is connected with the appearance of the design, and the novelty of the utility patent is connected with the technical aspects of the design. So, an object can be protected by design patent based on the ornamentation, and the same object can be protected by utility patent based on the technical characteristics it has.²³

The next criterion is non-obviousness. *“The courts have held that the proper standard to evaluate a design's non-obviousness is whether "a designer of ordinary skill of the articles involved" would have found the design as a whole obvious at the time the design was invented.”*²⁴ The non-obviousness analysis for a design patent is quite similar to the non-obviousness analysis for a utility patent. If there is evidence, that the designer combined the known elements of a prior art and used them in creation of the design claimed, the design will be considered obvious. Otherwise, the design is presumed non-obvious.

Finally, the design must be ornamental to be protected by design patent. To accomplish this criterion, the design must have independent appearance and must not be governed by the function of the object. That is to say, the shape or configuration of the object to be protected by design patent must not be conditioned only by the function of that object.²⁵

Different subject matters were used to be covered by copyright and design patent. New and useful articles of manufacture were protected by design patent, and original expressive works were protected by copyright. Thus, the overlap between these two types of protection was theoretically impossible, because useful articles are not copyrightable, and

²³ James Hamilton et al., *U.S. Design Patents: an Underdog that Bites*, 2002 *Managing I.P.* 3 (2002)

²⁴ *Id.* at 3

²⁵ *Id.* at 4

copyright cannot be applied to solely utilitarian designs without separable artistic elements.²⁶ According to Section 102 of Federal Copyright Act of 1976: *“In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”*²⁷

The case of Aqua Creations USA, Inc. v. Hilton Worldwide, Inc. is significant case in understanding the difference between copyright and design patent. The plaintiff brought suit against the defendant, alleging copyright infringement and unjust enrichment. The plaintiff designed a light fixture and presented it for the defendant’s use. As the parties did not reach an agreement over the price of the product, the defendant decided to copy the design made by the plaintiff.²⁸

According to Section 101 of Federal Copyright Act of 1976: *“Pictorial, graphic, and sculptural works include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”*²⁹

Based on this definition, the court dismissed the claim. The court held that the light fixture created by the plaintiff is a useful article and it does not have creative components that can be separated from the utilitarian aspects of the light fixture neither physically, nor conceptually.³⁰

However, on the other hand, there can be a significant overlap between designs protected by copyright and design patent. Both types protect the aesthetic qualities of an object. To be protected by both copyright and design patent, the work must meet the requirements of both types of protection: the work must be new and ornamental, as well as have expressive characteristics. In such cases, the design can be protected by copyright as a

²⁶ Sebastián M. Torres Rodríguez, *supra* at 139

²⁷ Copyright Act of 1976 §102(b)

²⁸ Sebastián M. Torres Rodríguez, *supra* at 139

²⁹ Copyright Act of 1976 §101

³⁰ Sebastián M. Torres Rodríguez, *supra* at 139

work of art and can be the subject matter of a design patent as well. In the scope of infringement demonstration both copyright and design patent has its benefits.

In *Litchfield v. Spielberg*, 736 F.2d 1352 (9th Cir. 1984) case the court held, that to prove indirectly the copyright infringement, the author of the copyrighted work need to prove simultaneously the following:

- that they are the owner of the copyrighted work,
- that the possible infringer had access to the work,
- that the work of art of the author and the alleged infringer's work are substantially similar.³¹

In other words, while claiming an infringement, the burden of proof is on the author of a copyrighted work. In case with design patent the burden of proof is not so demanding: the plaintiff will not be required to proof the access and copying of the work.

The problem of overlap between copyright and design patent is illustrated in the case of *Baby Buddies, Inc. v. Toys "R" Us, Inc.* Baby Buddies created a pacifier holder, that can be connected to the clothes of a baby and baby's pacifier. This device can prevent the pacifier from falling to the ground and getting dirty if the baby suddenly drops it.³² Baby Buddies design the pacifier holder using a decorative plastic bear. In 1991 the design of the pacifier holder was registered with the United States Copyright Office. Several years later Toys "R" Us began carrying the pacifier holder by Baby Buddies. "The pacifier holder sold well – Baby Buddies has sold more than a million units, with more than half a million of those sales coming through Toys "R" Us."³³ In 2003 Toys "R" Us created another pacifier holder for its own stores and started gradually refusing to buy pacifier holders from Baby Buddies. The design of the pacifier holder also had a bear. Baby Buddies then sued Toys R Us for copyright infringement.³⁴

The Court held that the pacifier holder is a useful article and can be protected by design patent. The bear that is a part of both pacifier holders created by the parties is separable from the whole pacifier holder. As a separable artistic element of a useful article the bear can be protected by copyright.³⁵ The Court analysed whether there is substantial

³¹ *Id.* at 128

³² *Baby Buddies, Inc. v. Toys "R" US, Inc.*, July 22, 2010, U.S. court of appeals for the 11th Cir. at 2

³³ *Id.* at 4

³⁴ *Id.* at 6

³⁵ *Id.* at 16-17

similarity between the two bear designs in both pacifier holders, and determined that there is almost no substantial similarities between the two artistic designs. Since ideas are not protected by copyright, only artistic expression is copyrightable, the Court dismissed the claim.³⁶ But if the design of the pacifier holder was protected by both copyright and design patent, the situation will be different. The pacifier holder alone can be protected by design patent, and the element of it – the design of the bear – can be protected by copyright.

An important question appears, deriving from this case, whether copyright and design patent protection can coexist. In the case *In re Yardley* “election doctrine” was proposed as a solution to this problem. According to this doctrine, the author has to elect between the two types of protection of the design as intellectual property. But the Court of Customs and Patent Appeals disregarded the doctrine, because according to the Court, the author may use both copyright and design patent protection.³⁷ In the case *Mazer v. Stein* the United States Supreme Court held: *“Though other courts have passed upon the issue as to whether allowance by the election of the author or patentee of one bars a grant of the other, we do not. We do hold that the patentability of the statuettes, fitted as lamps or unfitted, does not bar copyright as works of art. Neither the Copyright Statute nor any other says that because a thing is patentable it may not be copyrighted. We should not so hold.”*³⁸ Hereby, patentability and copyrightability are not mutually exclusive.

As it was already mentioned above, to prove the copyright infringement an author need to prove simultaneously the following: they are the owner of the copyrighted work, the possible infringer had access to the work, and the original work and the work of the infringer are substantially similar. The best way to prove that the author is the copyright owner of the work is showing that the work is registered in the United States Copyright Office. However, in order to protect the copyrightable work, filing a copyright registration in the United States Copyright Office is not required by the law. In reality, the law protects the copyright of the work from the moment when it is materially expressed. According to the United States Copyright Office the copyright registration is a legal formality that makes a public record concerning the primary facts of a specific copyrighted work. However, the copyright registration has the following advantages:

³⁶ *Id.* at 23

³⁷ Sebastián M. Torres Rodríguez, *supra* at 141

³⁸ *Mazer et al. v. Stein*, March 8, 1954, U.S. Supreme Court

- Registration creates a public record of the specific copyright;
- Copyright registration is necessary before applying to the court with copyright infringement claims;
- If the copyright is registered before the infringement occurs, or within three months after the first publication of the work, it will be possible for the author to collect statutory damages and attorney’s fees in court etc.³⁹

Hereby, copyright registration in the United States Copyright Office is of great significance, though, it is optional since 1989.⁴⁰

The duration of copyright protection of a work of art in the United States is the lifetime of the author and seventy years after their death.⁴¹

As for design patents, they are exclusively regulated by the federal legislation, and no other statutes grant patent rights. The federal agency that examines applications and grants patents is the United States Patent and Trademark Office. Preparing the application for design patent registration and overcoming the proceedings in the United States Patent and Trademark Office requires strong knowledge of patent law and rules. *“Design patents are granted for a period of fourteen years, from the date of grant.”*⁴²

In the case *Egyptian Goddess, Inc. v. Swisa, Inc.* the Federal Circuit held that the “ordinary observer” test must be used to determine whether there is design patent infringement.⁴³ The design must be examined from the perspective of an individual who is familiar with the prior work of art. Two designs are substantially the same, if the similarity can deceive an ordinary observer. If an ordinary observer supposes the one design to be the other, then that design that was patented the first is infringed by the creation of the other.⁴⁴

§2. COPYRIGHT AND INDUSTRIAL DESIGN IN FRANCE

According to Article L.112-1 of Intellectual Property Code of the French Republic, *“the rights of authors in all works of the mind”* shall be protected by copyright.⁴⁵ The

³⁹ Sebastián M. Torres Rodríguez, *supra* at 128-129

⁴⁰ *Id.* at 130

⁴¹ *Id.* at 126

⁴² *Id.* at 138

⁴³ Steve Kim, *Egyptian Goddess, Inc. v. Swisa, Inc.* 543 F.3D 665 (Fed. Cir. 2008), 19 DePaul Journal of Art, Tech. and IP Law 173 (2008)

⁴⁴ Sebastián M. Torres Rodríguez, *supra* at 138

⁴⁵ Intellectual Property Code §L.112-1 (Sep. 15, 2003)

protection shall be implemented notwithstanding the purpose, merit or form of expression.⁴⁶ “Works of drawing, painting, architecture, sculpture, engraving and lithography” shall be considered works of the mind, according to Article L112-2 of the same Code.⁴⁷ The design must be fixed in material form and be original to be protected by copyright.

Concerning the originality criterion, the work of art is considered to be original if reflects the personality of the author.⁴⁸ On the one hand, to prove the originality of the work, the author must show the characteristics of the work, which they claim are original. If there are no original characteristics in the work, and the work is only a result of technical skills, the French Court will probably refuse the copyright protection. Nevertheless, on the other hand, the French law defines, that the work must reflect the personality of the author to be original. The French law emphasizes creativity more than intellectual input. “*The focus in French jurisprudence tends to be on an analysis of the item itself, and how it compares with other contemporaneous fashion items: does it combine elements in a creative way or does it just adopt trending elements in a manner that is relatively banal? The focus is less on actual evidence of authorial input...*”⁴⁹

According to the French law, the protection requirements for industrial designs are the following: the design must be new and it must have individual character.⁵⁰ According to Article L.511-1 of Intellectual Property Code of the French Republic: “*The appearance of the whole or a part of the product, resulting from the features of, and in particular its lines, contours, colors, shape, texture or materials, is eligible for protection as a design or model. These features can be those of the product itself or its ornamentation.*”⁵¹

So, to determine whether the design can be protected under the French law, two criteria must be met: novelty and individual character. To test the novelty criterion one needs to determine, whether the same figure existed before among prior works. If such work does not exist the next criteria should be tested.

The work is of individual character, if it differs from compared prior design in such a way, that the new design actually merits protection. And if the characteristics of designs

⁴⁶ Violet Atkinson et al., *Comparative Study of Fashion and IP: Copyright and Designs in France, Europe and Australia*, 11 Journal of I.P. Law and Practice 519 (2016)

⁴⁷ Intellectual Property Code §L112-2

⁴⁸ Atkinson, *supra* at 517

⁴⁹ *Id.* at 521

⁵⁰ *Id.* at 523

⁵¹ Intellectual Property Code §L.511-1

differ only in insignificant details, they are considered identical. Individual character criterion is different from the originality criteria used in copyright in the following: in case of industrial design protection, the design does not need to carry the stamp the personality of the author. Industrial design protection does not comprise presumption of originality. *“A design has individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any relevant design, which has been made available to the public.”*⁵²

The French law gives the author the freedom to choose whether to protect the design by copyright or by industrial design. Moreover, authors can choose both types of protection.⁵³ So, there are at least three types of protection under the French law: copyright, registered design and unregistered design. *“In France, claimants almost always rely on both protections and the Courts have to determine when the requirements for each of the types of protection are fulfilled.”*⁵⁴

Certainly, the good point of this kind of regulation is that it gives election freedom to authors. However, some difficulties may occur concerning calculation of damages. A claimant may obtain certain amount of compensation of damages on the basis of industrial design, and certain amount of compensation on the basis of copyright. This may result in double compensation. In such cases the infringements of copyright and industrial design rights in respect of compensation of damages should be assessed separately.⁵⁵

Copyright registration is neither required nor possible in the French Republic. In this respect, copyright is different from industrial design registration, which makes copyright more difficult to determine.⁵⁶ In 1993 the French Supreme Court created the concept of a presumption of copyright ownership. According to the concept, if the author of the work has no contrary claims, the person is presumed to be the copyright owner of the work with respect to third parties against whom an infringement was brought, if that person exploits the work under his or her name.⁵⁷

⁵² Atkinson, *supra* at 525

⁵³ *Id.* at 517

⁵⁴ *Id.* at 530

⁵⁵ *Id.* at 530-531

⁵⁶ *Id.* at 518

⁵⁷ *Id.* at 521-522

The duration of copyright protection of a work of art in the French Republic is the lifetime of the author and seventy years after their death. According to the presumption of copyright ownership, the author is not required to manifest the date of creation of the work.⁵⁸

Under European Council Regulation, which entered into force on 06.03.2002, design protection is provided both for registered and unregistered design.⁵⁹ Those unregistered designs, that are new and have individual character, are protected automatically and immediately. As for registered designs, an application must be filed to the European Union Intellectual Property Office or to the French National Institute of Intellectual Property. The registration procedure includes a formal examination.

According to Articles 11 and 12 of EC Regulation No 6/2002 of 12 December 2001 on Community designs, the protection of unregistered design is automatic, starts immediately from the date when the design was first publicly available within the EU and lasts three years.⁶⁰ The protection of registered design starts from the date when the registration application was filed and lasts five years. The protection can be extended for a period of five years several times but not longer than twenty-five years from the date when the application was filed.⁶¹

§3. COPYRIGHT AND INDUSTRIAL DESIGN ACCORDING TO WIPO

The expression of the author's personality is significant in the WIPO interpretations as well. According to WIPO Standing Committee on the Law of trademarks, industrial designs and geographical indications, if the work can be treated as original expression of the creator's personality, then it can be considered a work of art.⁶² Nonetheless, even if the work is treated as an artistic expression, if it is incarnated in a useful article, a question appears: whether the functional or the artistic aspect of the work should be protected, and also: whether both of the aspects should be protected cumulatively or separately.⁶³ Hereby, depending on the applicability of the two protection types, three protection regimes are possible: cumulative protection, protection regimes separation and partial overlap of protection regimes.⁶⁴

⁵⁸ *Id.* at 523

⁵⁹ *Id.* at 524

⁶⁰ 6/2002 E.C.R. on Community Designs §11.1 (2001 through Dec. 12)

⁶¹ 6/2002 E.C.R. on Community Designs §12

⁶² WIPO S.C. on the Law of Trademarks, Industrial Designs and Geographical Indications § 20 (2002)

⁶³ WIPO S.C. § 21

⁶⁴ WIPO S.C. § 22

Under cumulative protection, a design can be protected by both copyright and industrial design, if it complies with the rules and conditions of each protection type.⁶⁵ In case of cumulative protection, an industrial design can also be protected by copyright, as a work of art. At the same time, the design can also be protected as an industrial design and benefit.⁶⁶ There are non-preemption clauses in the laws on intellectual property rights. According to the non-preemption clauses, if the design is protected under applicable law, it does not mean, that the protection is preempted to the same design under other applicable laws.⁶⁷

In case of separate protection regime, industrial design can only be protected under the law applicable for industrial design. In other words, industrial design cannot be protected by copyright.⁶⁸ It means that copyright protection covers works of art exclusively, and the design of utilitarian or consumer products cannot be protected by copyright. The aim of this kind of separation is the prevention of functional creations from escaping stricter requirements, stipulated by legislation on patent or utility model.⁶⁹ One of the features of this regime is the separability, when only those artistic features of the design can be protected by copyright, which can exist independently of the utilitarian aspects of the design and can be identified separately from them.⁷⁰

Partial overlap combines cumulative protection and separate protection regimes. The cumulative protection in this case provides protection both by copyright and by industrial design. At the same time, regimes separation provides industrial design protection for the design of articles that have utility, and if the design can also be regarded as work of art, partial overlap provides copyright protection as well. This system is used in Germany, Denmark, Finland, Norway, Sweden, and Switzerland.⁷¹

In partial overlap of protection regimes it is important, whether the design of a useful article is considered to be more an artistic work, or pure utilitarian design. Under the US copyright law works of artistic craftsmanship that are part of useful articles (tableware and jewelry) are protected by copyright, even if they can be protected by design patent, according

⁶⁵ WIPO S.C. § 23

⁶⁶ WIPO S.C. § 25

⁶⁷ WIPO S.C. § 26

⁶⁸ WIPO S.C. § 27

⁶⁹ WIPO S.C. § 28

⁷⁰ WIPO S.C. § 29

⁷¹ WIPO S.C. § 31

to the US legislation. With regard to this analysis, protection overlap between copyright and industrial design is becoming possible in practice.⁷²

To be protected by copyright, the form in which the work is expressed must be an original creation. The origin of the work must only be the labor of the author. However, copyright protection must be granted notwithstanding the quality, value or the purpose of the work, as well as the protection must not depend on whether the work is considered to be good or bad.⁷³

Protection is provided for “*artistic works: whether two-dimensional (drawings, paintings, etchings, lithographs, etc.) or three-dimensional (sculptures, architectural works), irrespective of content (representational or abstract) and destination (“pure” art, for advertisement, etc.)*.”⁷⁴

Many national laws of WIPO Member States on copyright protect also works of applied art, for example: artistic jewellery, furniture, lamps, wallpaper.⁷⁵

⁷² WIPO S.C. § 34

⁷³ WIPO Intellectual Property Handbook: Policy, Law and Use, §2.174, 2004, reprinted in 2008, available at http://www.wipo.int/edocs/pubdocs/en/intproperty/489/wipo_pub_489.pdf

⁷⁴ WIPO Intellectual Property Handbook: Policy, Law and Use, §2.176

⁷⁵ WIPO Intellectual Property Handbook: Policy, Law and Use, §2.177

CHAPTER 3

COMPARATIVE ANALYSIS BETWEEN COPYRIGHT AND INDUSTRIAL DESIGN APPLIED TO THE JEWELLERY DESIGN PROTECTION

According to the legal research made on the Armenian, French and US legislations, as well as the WIPO policies, we are going to answer the thesis question and other actual sub questions emerged during the legal research. To answer the questions comparative analysis is done between the mentioned legislations on copyright and industrial design.

Firstly, it is important to refer to the comparison of the copyright and industrial design objects under each legislation. Works of painting, sculpture, graphics, design and other fine arts are among copyright objects under the RA legislation.⁷⁶ Pictorial, graphic, and sculptural works are covered by copyright under the US legislation as well.⁷⁷ As for the French legislation, copyright covers works of drawing, painting, architecture, sculpture, engraving and lithography.⁷⁸ Hereby, object of copyright is quite similar under the investigated legislations.

In the RA legislation, the essential part for copyright protection is that the creation must be an exclusive result of the author's work.⁷⁹ In the French law, the significant part is the originality criteria. Originality criterion is considered to be met, if the author's personality is expressed in the work.⁸⁰ Based on this, it can be concluded, that the French law gives more requirements for copyright protection.

In the Armenian law it is stipulated that the appearance of the article that has characteristic features can be protected by industrial design. The Armenian law has two requirements: the design must be new and unique to be protected as industrial design.⁸¹ The US law, in its turn, provides more requirements for the work to be protected by industrial design: the design must be an article of manufacture, original, novel, non-obvious and ornamental.⁸² These requirements make the scope of protected articles narrower. The French law provides two requirements in this respect: the design must be new and have individual

⁷⁶ Law of RA on Copyright and Related Rights §3(4(b))

⁷⁷ Copyright Act of 1976 §102(a)

⁷⁸ Intellectual Property Code §L112-2

⁷⁹ Law of RA on Copyright and Related Rights §3(1)

⁸⁰ Atkinson, *supra* at 517

⁸¹ Law RA on Inventions, Utility models and Industrial designs §22(1)

⁸² Sebastián M. Torres Rodríguez, *supra* at 136

character.⁸³ These two criteria are similar to the two criteria stipulated by the Armenian legislation.

As it is already provided in Chapter 1 of this Paper, it can be concluded from the Armenian law, that there is an overlap between copyright and industrial design protection. According to Section 2 of Article 28 of the Law of the Republic of Armenia on Inventions, Utility models and Industrial designs, design that are protected by industrial design can also be protected by copyright.⁸⁴ Hereby, some designs can be both protected by industrial design and by copyright under the Armenian law.

As for the US legislation, copyright and industrial design also can coexist. In the case *Mazer v. Stein* the United States Supreme Court held that the patentable work can also be copyrightable.⁸⁵ So, copyright and design patent do not mutually exclude each other. According to the French law, overlap between these two types of protection also exists. Authors can choose to protect their intellectual property both by copyright and by design patent.⁸⁶

One of the most important questions for this Paper is the following: what is the place of jewellery design in intellectual property protection? According to the Law of the Republic of Armenia on Copyright and Related Rights, design is an object of copyright. If the jewellery design is an exclusive result of the work performed by the author independently or in cooperation with other authors, it can be protected by copyright.

On the other hand, analysing the Law of the Republic of Armenia on Inventions, Utility models and Industrial designs, the appearance of the jewellery, if it is the result of its characteristics features and is new and unique, it can be protected by industrial design. In case of jewellery, the characteristic features are the shape and the materials. So, there are two requirements: the design must be new and unique. For the first requirement to be met, no identical design must be established before the application filing date, that is to say, no jewellery design must be established, all characteristic features of which coincide with those of the jewellery design in question. For the second requirement to be met, the general impression left on the consumer must differ from the general impression left on any such

⁸³ Atkinson, *supra* at 523

⁸⁴ Law RA on Inventions, Utility models and Industrial designs §28(2)

⁸⁵ *Mazer et al. v. Stein*, U.S. Supreme Court

⁸⁶ Atkinson, *supra* at 517

consumer by any other industrial design that has become publicly available before the application filing date.

According to Section 2 of Article 28 of the Law of the Republic of Armenia on Inventions, Utility models and Industrial designs, industrial design can be protected as copyright as well from the date of its creation or fixation in any form.⁸⁷ Based on the abovementioned, as well as considering the overlap between copyright and industrial design protection, it can be concluded that jewellery design can be protected both by copyright and industrial design in the Armenian legislation.

It can be concluded from the above, that the place of jewellery design in intellectual property protection is not precisely defined under the Armenian law. Because of this, authors in Armenia do protect their jewellery design by both protection types. Some authors protect it by copyright, others protect by industrial design.

In many WIPO Member States, for example, jewellery design is considered a work of applied art, and it is protected by copyright under their national laws.⁸⁸ In this case there is a precise definition of the place of jewellery design in intellectual property protection system.

In Armenia only industrial design is subject to registration at the State authorized body. Copyright cannot be registered and is protected from the moment of creation. In the USA, unlike Armenia, both design patent and copyright are being registered by the authors. In France authors have freedom to choose whether to protect the design by copyright or by industrial design, they also can choose both types of protection. Like in Armenia, copyright in France cannot be registered. Concerning industrial design, it can be both registered, and unregistered, providing protection for both of them.

According to the RA legislation, the copyright of the author is protected throughout the lifetime of the author and seventy years after his death.⁸⁹ In the US legislation the duration of copyright protection is the lifetime of the author and seventy years after their death.⁹⁰ In the French Republic the duration of copyright protection is the same as in the USA, which is the lifetime of the author and seventy years after their death.⁹¹

⁸⁷ Law RA on Inventions, Utility models and Industrial designs §28(2)

⁸⁸ WIPO Intellectual Property Handbook: Policy, Law and Use, §2.177

⁸⁹ Law of RA on Copyright and Related Rights §37(1)

⁹⁰ Sebastián M. Torres Rodríguez, *supra* at 126

⁹¹ Atkinson, *supra* at 523

In the Armenian legislation the registered industrial design is protected throughout five years from the application filing date, with an opportunity to extend the period of protection by five years each time, but not longer than overall twenty-five years from the filing date.⁹² In the US legislation, the situation is a little different: the protection is granted for fourteen years.⁹³ Finally, in the French legislation unregistered industrial design is protected for a period of three years.⁹⁴ As for registered design, the duration of the first protection, the opportunity to extend and the maximum overall protection period is the same as in the Armenian legislation. Obviously, copyright provides much more durable protection than industrial design in each legislation investigated.

According to Berne Convention for the Protection of Literary and Artistic Works, which is ratified by the RA, if works of applied art and industrial designs are protected as artistic works, the RA legislation should determine the extent and term of application of the RA laws to such works. However, according to Article 7(4) of the same Convention, the duration of such protection shall last at least twenty-five years from the date such work was made.⁹⁵

Based on the mentioned articles of Berne Convention, industrial designs can be protected as artistic works. If we apply this legal act to the case of jewellery design, it can be concluded, that if jewellery is considered industrial design, it can be protected as artistic work, and the minimum duration of the copyright protection will be twenty-five years from the date the work was made.

⁹² Law RA on Inventions, Utility models and Industrial designs §29(1), (2)

⁹³ Sebastián M. Torres Rodríguez, *supra* at 138

⁹⁴ 6/2002 E.C.R. on Community Designs §12

⁹⁵ Berne Convention for the Protection of Literary and Artistic Works, art. 7(4)

CONCLUSION

Based on the legal research of the Armenian legislation on copyright and industrial design protection, we can come to conclusion, that the place of the jewellery design in the field of intellectual property protection is not precisely defined under the Armenian law. It appears that the jewellery design can be protected by copyright as an artistic work, which is an exclusive result of the author's work. And at the same time the jewellery design can be protected by industrial design as an article with its new and unique characteristic features.

Unlike the US legislation, in the Armenian law there is no such criteria as “article of manufacture” for industrial designs. There is no regulation, that the design must necessarily have utility to be protected by industrial design. Moreover, unlike the US legislation, in the Armenian law there is no principle of separability of the artistic features of the design from its utilitarian aspects. Under the US legislation the situation is much clearer: the artistic features separable from the utilitarian aspects can be protected by copyright, and those that cannot be separated cannot be protected by copyright as well. So the jewellery design cannot be protected by design patent under the US legislation, but can be protected by copyright if it meets the copyright requirements.

In the Armenian law the situation is not clear. It appears that the jewellery design can be both protected by copyright and industrial design. That is why authors have different practice in protecting the jewellery design as intellectual property. Authors do protect the design in both ways, and many of them register the jewellery design as industrial design. If the place of the jewellery design were more precise in copyright and industrial design protection, the authors would be able to protect their intellectual property rights over the jewellery design in more effective way, by choosing more relevant type of protection. We are going to solve this issue by suggesting more precise distinction of the two protection types in the Armenian legislation, which will be presented in the Recommendations.

We assume that the authors' choice of industrial design as the protection type for the jewellery design arises from the following: unlike copyright, industrial design can be registered at the Intellectual Property Agency. After the registration the author gets a certificate of intellectual property ownership. Such certificate is a legal document that can be introduced in court as an evidence of intellectual property rights ownership. Certainly, it is

safer for the author to have a legal document as evidence in court. On the other hand, the procedure of registering the industrial design is time consuming and has more expenses, unlike copyright that provides protection from the date of the creation of the design.

Nevertheless, it is obvious that copyright is more effective protection type for the jewellery design. Copyright protection lasts during the lifetime of the author and seventy years after their death. Meanwhile, the duration of industrial design protection can be extended to twenty-five years maximum. As it is possible by force of the Law of the Republic of Armenia on Inventions, Utility models and Industrial designs, as well as the Berne Convention to protect industrial design also as copyright, the most effective solution for the jewellery design protection as intellectual property will be protection by copyright.

To sum up, it is important to mention the following advantages of protecting jewellery design by copyright:

- There is no procedure for copyright registration at any state body, stipulated by the Armenian legislation. This means that, unlike industrial design protection, there aren't any expenses for copyright protection, and the rights arise from the moment of creation.
- Copyright protection in the Republic of Armenia is valid during the lifetime of the author and continue to be valid for seventy years after their death. So the duration of copyright protection is much longer than that of industrial design protection.
- There is presumption of authorship stipulated by the Armenian legislation. The person is recognized as the author of the work, if their name is mentioned on the work, as long as the opposite is not proven. Unlike industrial design protection, there is no burden of proof on the author of the work regarding the authorship.

The mentioned points make copyright protection more effective for jewellery design than industrial design protection. That is why we would recommend Armenian authors to protect their jewellery design by copyright.

RECOMMENDATIONS

PRACTICAL RECOMMENDATION FOR AUTHORS

Based on the conducted legal research and comparative analysis, we are making practical recommendation for authors of jewellery designs. Particularly, we would recommend the authors to protect their works by copyright rather than by industrial design. That is to say, we would recommend Armenian authors not to register their jewellery design as industrial design. The copyrightable design of the jewellery will be protected from the moment of creation, and presumption of authorship will apply, by force of the Law of the Republic of Armenia on Copyright and Related Rights.

DRAFT LAW

We are suggesting an amendment in the current Armenian legislation concerning the object of intellectual property.

Particularly, we suggest that industrial design provides protection necessarily for the design of useful articles.

Draft law. Phrase Section 1 of Article 22 of the Law of the Republic of Armenia on Inventions, Utility models and Industrial designs as follows: *“A new and unique solution defining the appearance of a **useful** article is protected as an industrial design in the manner prescribed by this law.”*

Also we suggest having the principle of separability of artistic features from the utilitarian ones of the design in the Armenian legislation.

Draft law. Add Section 5 in the Article 4 of the Law of the Republic of Armenia on Copyright and Related Rights and phrase as follows: *“Only those artistic features of the design can be protected by copyright, which can exist independently of the utilitarian aspects of the design and can be identified separately from them.”*

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