BY LUIS C. SCHMIDT

PARTNER

MANAGING INTELLECTUAL PROPERTY, AMERICAS IP FOCUS 2008

An intriguing question in intellectual property law has been to what extent copyright, industrial property or special rights should apply: i) when authored "pure" arts are incorporated in industrial products; ii) when industrial products display artistic elements or "aesthetic" design; or iii) when designed products do not display "artistic" or "aesthetic" elements.

In the first group are fine arts, graphic arts, photographic arts, popular arts, crafts or handicrafts applied to the surface, shape or configuration of products or articles. In the second group lies a whole spectrum of articles, where artistic or aesthetic design interact with industry to a greater or lesser degree, give expression to life or are everyday products that make life easier, more comfortable, more entertaining or more informative. In the third group are designed engineering objects, used in connection with science or technology.

In general terms, the international community has considered copyright as the best protection for pure arts applied to products, while patents apply for industrial engineering designs. The subject matter in between has signified a challenge for intellectual property rights systems.

A number of countries have adopted special rights formulae to avoid discussions as to whether copyright or industrial property rights are applicable in a cumulative or non-cumulative fashion. Other countries have sustained that copyright and patent laws provide sufficient means to protect the whole range of designed products. These countries believe that borderline issues will be inevitable, with or without a regime on special rights.

Issues concerning the legal treatment of arts and industry were developed a long time ago in Europe. The basic protection afforded was a right similar to that of patents. France adopted the theory of the unity of art, which contrasted with the separatist position of the UK. Hard debate was a common factor in the first years of the Berne Convention. The Berlin revision of Berne introduced the concept of applied arts, which has played an important role until present times. The revisions of Rome, Brussels and Stockholm were useful in achieving a

certain degree of consensus to draw a dividing line between copyright and other rights. Finally, the Paris revision stated that Union member countries could adopt copyright or special rights to protect applied art works.

Regarding industrial property, protection afforded to designs has been redefined. At first, the Paris Convention for the Protection of Industrial Property, in particular the Lisbon revision, imposed upon member countries an obligation to protect industrial designs, based on novelty and other patent forms such as registration or deposit. However, the TRIPs and Nafta softened the Paris Convention rule by imposing on member states an obligation to protect industrial designs, based on novelty or originality standards. Concerning textile designs (this should not necessarily be read as a restrictive criterion), the TRIPs and Nafta established that proceedings should not be so costly or complicated as to impair the chance of protection. Accordingly, said treaties presented the opportunity for industrial designs, and not only applied arts, to be protected by either design or copyright law.

Designers have distinguished between designs in arts and engineering. Art is to aesthetics what engineering is to science. While aesthetics is free artistic ideas expressed, science is ideas subordinated to the rigid function of an object or dictated by it. In keeping with this, applied arts has been defined as artistic or aesthetic design applied to utilitarian objects, which includes individual expressions of graphic design, textile design, fashion design, interior or decorative design, jewelry design, functional or industrial design and, to some extent, architecture and photography, although the latter have an independent character. Engineering utilizes design to enhance or emphasise the functional or scientific aspect of an object. Design in engineering is function emphasised, but not the function as such. The difference between applied arts and engineering design would ultimately rely on the opportunity or capacity designers have to employ a freer style to express ideas.

The more freedom that a designer has in designing and the more aesthetics she can imprint into the designed object, the more artist she will be. On the other hand, the more rigid or strict rules a designer has to follow in designing and the more emphasis she will give to the function of the designed object, the more engineer she will be. The foregoing differences also apply to industrial designs. The system of applied art has mostly been constructed over the definitions rendered by designers. In France, jurists imported the concept of applied arts from existing design treatises in order to use copyright to tackle the ever-growing issues posed by arts and industry.

Neither the Berne Convention nor the free trade agreements provided definitions. However, the World Intellectual Property Organisation has stated that applied arts are artistic works applied to objects for practical use, whether handicrafts or works produced on an industrial scale. Consistently, legal definitions have included arts applied to products and have excluded industrial engineering designs. However, they are unclear whether industrial products displaying aesthetic designs are applied arts.
Industrial property was initially conceived as the means to protect industrial designs in Mexico. The notion of industrial designs covered models or drawings that decorate manufactured articles. However, as the laws improved by inserting concepts like applied arts, protection started to shift gradually from industrial property to copyright law.

INDUSTRIAL PROPERTY

- The Law on Industrial Property (LIP) of 1943 conveyed patent protection for novel drawings that provide a peculiar and individual character to a product, when they are used to ornament products through “printing, drawing, embroidering, weaving, sewing, modeling, casting, engraving, mosaic, encrusting, dying or any other manual, mechanical or chemical technique”. Likewise, the LIP of 1943 conferred patent protection to the form of industrial products, machinery parts, tools, statues or high or low relief, in regard to their artistic disposition or disposition of materials, resulting in a novel and original article or product.

- The LIP of 1976 granted patent protection to industrial drawings or models. Industrial drawings were defined as the combination of figures, lines or colours that decorate an industrial product and that convey a peculiar and individual aspect to the same.

Similarly, industrial models were defined as any aesthetic pattern serving as a

mould that provides a special appearance to industrial products, as long as the mould does not render a technical effect. Artistic creations were excluded from patent protection.

- The LIP of 1991, which is still in force, considers that industrial designs can be registered when novelty and industrial application standards – not inventive step or activity standards – are fulfilled. The LIP divides industrial designs into industrial models – defined as moulds that purport a special appearance to a product of manufacture without producing a technical effect – and industrial drawings – defined as a combination of figures, lines and colour used as ornament and that imprint peculiarity and individuality on the product.

Artistic works were again excluded from patent protection together with aesthetic creations, which is evidently limiting. As a matter of fact, the legislator of 1991 seems to have understood special appearance or ornament as something unrelated to art and aesthetics.

COPYRIGHT

- The Copyright Law of 1947 was express in excluding from copyright protection “works of arts that would solely have industrial application”. On the other hand, the Copyright Law of 1956 stated that works of art would be protected “regardless of their destiny”.

- The Copyright Law of 1996, now in force, listed applied arts as a category of works that includes graphic or textile design. The Copyright Law did

not impose restrictions on works of applied arts and did not impose differences on other categories of works. In keeping with this, works of applied art were subject to the same level of rights or limitations and to the same duration terms. Similarly, foreign authors of works of applied arts enjoyed same rights as Mexicans, regardless of whether their national laws were not reciprocal in protecting applied arts by copyright or special rights.

Mexico has relied on either industrial property or copyright law to protect designs of industrial articles. Neither law recognises special forms such as unregistered designs. The Mexican response to border issues has turned around the figure of applied arts, which has become a reference to protect designs of industrial articles. As mentioned above, copyright laws transitioned from the exclusion of works of art having industrial application to the insertion of applied arts as a category of works. In contrast to this, the scope of industrial property rights has been reduced, although not eliminated.

Industrial designs still play a role in protecting designs, so long that they are non-artistic or are not characterised as aesthetic creations.

The Copyright Law legislator of 1996 seems to have been inspired by the doctrine of applied arts and the French theory of the unity of art. Like France, Mexico has enhanced the artistic side of design, regardless of whether art is obvious or hidden or is regarded a major or minor part thereof. Art cannot be physically or conceptually separated from the corpus embodying it.

International treaties have been a source of inspiration as well. The TRIPs and Nafta have been fundamental to making it clear that copyright protects applied arts (arts displayed in products, products displaying arts and products displaying aesthetic designs) in general and not only textile designs, and that industrial property protects industrial designs not regarded as arts or aesthetic creations, and is restricted to what designers call engineering design, as long as the designed object still possesses a special or ornamental appearance.

In principle, it would appear that the two rights can combine in a consistent fashion and that boundaries can be set out easily. However, in practice things can be rather different, as designers sometimes wish to accumulate protection, looking for the broadest protection available.

In Mexico, double or cumulative protection is a permitted activity that derives

from overlapping, which is a muddy area where patent and copyright principles confront. While patent is supported by novelty and inventiveness, copyright is supported by originality. Novelty and originality are different in various respects, but are not necessarily exclusive.

Inventions or industrial designs can be patented or registered in the absence of prior art and works can be copyrighted when personal ideas are artistically expressed. Novel works can exist when unique but cannot be patented given their non-industrial nature. By contrast, industrial designs can be copyrighted if conceived as personal artistic expressions, regardless of whether or not they are objectively novel at the same time.

Overlapping will not occur when pure arts are applied to products or when design clearly has an engineering purpose. Overlapping and the resulting accumulation can happen when artistic or aesthetic designs are made in fabric, metal, stone, leather, glass or any other materials, that are used in fashion, jewelry or containers for perfumes or beverages. Most often, designers imprint their own personal artistic expression or character and stamp their names as a symbol of artistic creativity. Mexican Copyright Law supports the idea that fashion, jewelry or glass designers are authors of artistic works. As a matter of fact, the Mexican Copyright Office has granted numerous copyright registrations to designs and the courts have enforced rights resulting of copyrighted designs.

In parallel to copyright or in lieu of it, designers can also register their designs as industrial designs. However, the process is stricter, longer and more expensive as registration implies the fulfillment of higher standards and requirements. Promptness is only one reason why designers prefer the copyright alternative, in addition to others such as the recognition of the designer as an author who enjoys full patrimonial and moral rights and a longer protection term. In general, designers consider copyright a very useful right, since it can not only be invoked against unauthorized parties making copies of the artwork itself but also against any picture or photograph that unauthorized parties take for reproduction in books or publications, distribution in copies, public performance by broadcasting or digital network transmission, public display in exhibitions or altered forms representing a modification of the artwork. Copyright law was structured to prevent activities such as these, which is not necessarily the case for industrial design law. Accordingly, in Mexico copyright is definitively a tool used to protect and enforce rights resulting from designed industrial products.