by Luis Schmidt

Let us begin with a few definitions. Copyright law concerns the rights afforded to works used in media. Rights (patrimonial rights) can be exclusive or non-exclusive rights to use a work. Works are original expressions by authors that a final user can read, view or listen. However, reading, viewing or listening is not regarded as using the works. Broadly speaking, works are used when copied, distributed in copies, communicated to the public, transformed into a derivative work, or accessed by the public in digital networks. Copyright focuses on the interrelation between a work and the medium that communicates it. For example, the printing press and photocopier copy works and radio and televisión broadcast works. Using works in digital media includes copying, distributing, communicating to the public, transforming and giving access to the work. Issues concerning digital networks are often complex, but in essence, digital networks behave like any other medium, in terms of what copyright law represents. Works can also interrelate with the tangible médium embodying them. That medium could be paper, metal or another material traditionally used in connection with the classical arts, technology that is not functional as such (such as film) or technology that is intrinsically functional (like software or designs).

Copyright law supports principles of originality, the idea/expression dichotomy, absence of formalities and limited

protection terms. Originality is tantamount to subjective novelty, meaning that every work requires a minimum of

personal independent creativity. Under the theory of independent creation, accepted in a number of jurisdictions, a

work that is similar or even identical to a preexisting work, shall not be regarded as a copy if during the creative process the senior author had no access to the work of the junior author. Originality differs from objective novelty and other patent restrictions, such as inventive step or industrial application, or from the rights to make, sell and use, which look at the functional side of creativity. The so-called function of products is a field for patents, even if the product is also a

work. For example, software-related inventions (software applied to perform useful activities) have been patented. Copyrights exclude functionality and even non-functionality. It is irrelevant that works, or the object incorporating the work, can be end-used if one or the other is regarded to be functional or nonfunctional.

Instead, copyrights ask whether a work can be used. A theory has generally prevailed that works are non-functional because they are aesthetic, do not serve any functional purpose, and are unnecessary for performing useful

activities. This differs from the notion that works are non-functional, because they can be read, viewed or heard. The theory may be a little imprecise, as well as unimportant for copyright law.

Works and function: the software example

In principle, works have been classified as classical arts. In modern times, less traditional works have been added to the list, for example software, databases and videogames, despite the fact that they serve a function, and software has been regarded as useful or functional. Protecting functional works like software does not mean that protection shall be expanded to the function of software as a product. Software is authored expression, as classical works are. However, software is functional in the sense that software can ultimately do things like writing, calculating, collecting or playing. Software can be used for functional purposes in addition to or instead of the non-functional capacities of being read, viewed or heard. Someone is the end user of software works when reading, viewing or listening, and of software products when writing or calculating at the same time, but end-using, as explained, has no copyright effect.

Only using a software work by means of copying, distributing, and so on, has any copyright significance. The scope of copyright protection of a software work is quite narrow. It is restricted to literal codes expressed in writing under a program language, which instructs computers to perform functional activities or services. Software can represent words, sounds or images of writing, music, arts or audiovisuals. Experts have said that traditional copyright principles apply chiefly to software works despite their functional nature. Is it possible to extend

copyright law to ideas of functionality? The answer is no, copyrights cannot be extended to cover the functionality of works. This is true considering that end use, service, and function, are concepts clearly beyond the scope of copyright law.

Courts of different countries have rendered decisions addressing the look and feel of software. The question has been whether software can be copyrighted in virtue of the look and feel that it depicts. The answer has been yes, since look and feel are within the scope of copyright law. Viewing software, in particular video games, is like viewing or listening to other works that can be perceived by sight or ear. Video games have been a challenge, since the pattern is constantly changing as the game is played, but they have been protected without incurring copyright contradictions or disproportions.

Works and function: The artwork example

Artwork is another field where ideas of functionality and nonfunctionality converge. Legal issues have been triggered, not in regard to works of fine art, but in connection with works of design, architecture, folk arts and crafts that make objects the medium of the arts. Sometimes objects can either have a i) secondary functional purpose, as in the case of jewelry, interior design, folk art or crafts; ii) principally functional purpose; or iii) solely a functional purpose. Architecture and applied arts fall somewhere in between secondary and principal functionality, whereas industrial design is entirely functional. The concept of functionality is irrelevant to copyright law. Functionality is a concept which has a slightly different connotation for artworks than for software. Concerning artworks, it is the object embodying the work that is functional. However, the rules apply identically: the object incorporating the work can do things, as in is sitting for furniture, wearing for textiles or cooking for pottery. Objects can be end-used at the same time that the incorporated work is viewed for enjoyment or other reasons. A final user end-uses the work when viewing and enjoying an embodying object (sitting, wearing or cooking) at the same time, but end using, as explained, has no copyright effect. Only using an artwork by means of copying, distributing, for example, has a copyright value.

Today there is no doubt that architectural and applied artworks fall under the

umbrella of copyright law. In both cases

art is applied to functional objects of everyday use or to buildings or environments. Like software, applied arts and architecture blend the non-functional, where every work can be viewed, with the functional, where the object or building embodying art can provide a service. Again, functional and non-functional is ultimately irrelevant for copyright law. Patents can always take care of the functional side of applied arts and architecture. Copyright just prevents applied art and architectural works from being copied, the copies obtained from being distributed or communicated to the public, or the works becoming transformed.

Works and function: the industrial design example

Industrial design, involving products shaped by designers is in a similar situation. The link between design and product is almost impossible to dissolve. Theorists in both industrial design and IP law have worked to find a dividing line between design and product, without convincing results. Likewise, there have been vociferous discussions in order to find out if industrial design is an authored work. Experts have maintained that it is due to reasons of functionality, or because designers are not real artists. According to industrial design theories, the shape of products can be functional, affecting the technical performance of the product. Industrial designs may indicate how the product is materially used, but this can ultimately add complications. But if patents concentrated on the function, and copyrights on the artistic side of design, as any other functional artwork, issues deriving from convergence could be avoided.

Software and artworks are perfect examples that copyright can protect works being products or being incorporated into functional products. In a similar fashion, copyright has called software programmers, architects and artisans all authors. But more importantly, under copyrights, it does not matter whether products or their shapes are functional or non-functional. We may then ask why industrial design cannot be an artwork and industrial designers be called authors. Copyright law certainly can protect industrial design. Industrial design fits the description of copyright law, including the application of rights to

prevent works from being copied, distributed, communicated to the public, transformed or accessed by the public.

Industrial designs may be accommodated by novelty, and the rest of patent principles. However, patents should focus on the function that an industrial design can provide, without extending to non-functional elements. The best approach is to keep industrial designs exclusively protected under copyright law, and leave functionality to patent law. The benefit is enormous, as it is recognised that industrial designs are indeed works and that copyright is the best substantive protection available. Likewise, protecting becomes more practical and easy, to the extent that overlapping would not exist or at least would be reduced, avoiding double protection implications, without any of the complications arising from applying the different principles of copyrights and patents.

Industrial designs in Mexican law

The World Intellectual Property Organization (WIPO) has addressed in a document prepared by the secretariat, issues relating to industrial designs and their interrelation with works of applied art and three-dimensional marks. The objective has been identifying possible areas of interest for future work of WIPO, in connection with industrial designs. The paper explains the theory that surrounds industrial designs and the overlap with other creative expressions. It also provides a sample reference about the national laws of a number of countries. As the report explains, in many jurisdictions only aesthetic features of industrial designs are protected, but there is debate whether the technical and the aesthetic should be separated and the law split as a consequence. Copyright or parallel subjects like unregistered designs in the UK or the European Community would take care of the aesthetic or non-functional (using the general theory admitted in IP law), and patents or perhaps *sui generis* rights would take care of the technical or functional.

Ultimately, the path is free for such an idea, since there is nothing in the Paris Convention or Berne Convention or in other international treaties that could represent any restriction. In Mexico, industrial designs are protected by virtue of

registration under the Law on Industrial Property. The standard of protection is novelty and industrial application. Inventive step has been excluded. However, novelty is reduced to independent creation combined with a requirement that new designs differ significantly from designs that are known. The novelty factor applicable for industrial designs under the Mexican Law is almost the same as originality in copyrights, but incurrs contradictions. Independent creation would admit protection of a work similar or identical to a senior work, provided that the junior author had no access to the senior work. Likewise, under the Law on Industrial Property industrial designs protection is limited to the ornamental, and thereby excludes any functionality. As noted by WIPO, Mexico is one of the countries adopting the idea that patent law should only care how industrial designs look without protecting how they work.

Courts have not addressed issues regarding the nature of industrial designs, but have rendered criteria concerning Works of applied art. Specifically, in December 2010, a circuit court in Mexico City resolved that a work of applied art should require two conditions: aesthetic beauty and a practical and utilitarian objective to satisfy human needs. In the end, the court resolution did not reveal anything new and just confirmed what has been written in hundreds of copyright articles and books.

Needed: a joint venture

Certainly, there is under Mexican law nothing sufficiently consistent and systematic to give strength and power to industrial designs. The Copyright Law and Patent Law were not written in order target exactly the same subject matter whilst maintaining essentially different principles. Overlapping and double protection could have been avoided if from the start the legislature regarded industrial designs as copyrighted works, leaving the functionality issues for the Patent Law to address and resolve. It is hoped that one day that Mexican legislators will make copyrights and patents work jointly and in alignment to cover industrial designs, as they have done successfully with software. In this way they might shed some light into the dense and obscure seas of overlapping and double protection.

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