



Article for *Copyright World*

Ian McDonald and Virginia Morrison, Australian Copyright Council, 20 December 2002

Changes to designs/copyright overlap

A Bill for new designs legislation, the Designs Bill 2002, was introduced into Parliament on 11 December 2002. Another Bill, the Designs (Consequential Amendments) Bill 2002, that amends the designs/copyright overlap provisions of the Copyright Act 1968 was introduced at the same time.

The area of designs/copyright overlap has always been complex and somewhat problematic. Drawings and prototypes of functional items may be both “artistic works” for the purposes of the Copyright Act and “designs” for the purposes of the current Designs Act. The broad policy adopted in Australia is that the Designs Act is the more appropriate form of legal protection for the shape and appearance of functional articles. For this reason, there are provisions in the Copyright Act which limit copyright protection for a functional article if:

- articles have been made and sold (in which case there may be no legal protection for the appearance of the articles); or
- the design for the article has been registered under the Designs Act (in which case the design has the legal protection given by the Designs Act).

At different stages, the Copyright Act has been amended to remove some unfair consequences of previous provisions. Until the Act was amended in 1990, for example, articles with artistic works printed on them, such as fabric and T shirts, could be denied copyright protection. However, there remain some areas of legal and practical uncertainty and difficulty.

In August 1992, the Attorney-General referred the Designs Act to the Australian Law Reform Commission for inquiry and report. The Commission released its final report in June 1995, recommending several amendments to the Copyright Act regarding the design/copyright overlap. These included recommendations that:

- the incidental reproduction of two-dimensional artistic works in the course of or for the purpose of industrial application should be deemed not to infringe copyright;
- the Copyright Act should be amended to make it clear that a “work of artistic craftsmanship” can also be something which falls into the other definitions of “artistic work” under that Act;

- buildings and models of buildings should continue to be protected by copyright even if they are reproduced "industrially", but structural articles, such as small portable buildings and swimming pools registrable under the Designs Act, should not receive copyright protection.

Recommendations were also made in relation to the definition of "corresponding design", the loss of copyright in situations when there is industrial application of a design overseas, and transitional provisions.

The Government accepted these and other recommendations of the ALRC. The Designs (Consequential Amendments) Bill 2002 gives effect to these recommendations. Thus there are amendments aimed at clarifying:

- when industrial application occurs for the purpose of the provisions;
- the definition of "artistic work"; and
- the definition of "corresponding design" so that copyright is preserved in two dimensional designs even if the design is embodied in the product, rather than applied to its surface (this would include designs are woven into, impressed on or worked into a product and not merely applicable to a surface of an article).

The Bill also contains amendments aimed at allowing incidental reproductions and communications of artistic works that have been applied industrially for the purpose of making, advertising, selling and letting non-infringing products.

Debate on both bills has been adjourned until the next parliamentary sitting in February 2003. Both Bills and related documents are available from the Parliament's website (www.aph.gov.au).