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## **Book Review: Research Handbook on Design Law**

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## **Book Review: [Research Handbook on Design Law](#)**

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Although recent US case law significantly increased the value of design patents, the European industry has long acknowledged the commercial value of product designs and developed EU-wide protection for the designs regardless of registration. According to recent statistics,<sup>1</sup> both US and EU design patents and community design rights outperform utility patents on validity and infringement. The result of the community design rights is particularly surprising because both registered and unregistered design rights issue without any examination of substantive requirements. Effective product design protection is a key to success for consumer goods manufacturers to compete in the global market. However, there have been only a few books to examine design protection by different types of intellectual property rights in multiple jurisdictions. The Research Handbook on Design Law addresses the need by collecting comparative studies of product designs authored by the world's leading practitioners and scholars. The book mainly focuses on the EU and the US, but various chapters cover the major jurisdictions including Japan, China, Australia, Brazil, South Africa, and Turkey. Topics are carefully selected by Dr. Henning Hartwig, a leading design law practitioner involved in the landmark decisions of the Court of Justice for European Union (CJEU), based on his extensive experience in litigating community and German design rights and other related rights for both German and US clients. Overall, it bridges academic theories and a practice strategy for procuring and enforcing multiple IP rights on product designs in the global market.

### **The content in a nutshell**

The book consists of five parts: (I) Foundations – Validity and protection scope of industrial design rights; (II) Methodological Perspective – Substantive and formality requirements for design applications at EUIPO and USPTO; (III) Establishing and Enforcing Protection – Unique aspects of unregistered community design rights and EU wide enforcement of community design rights; (IV) Critical Issues – Advanced topics for protecting spare parts and GUI and critiques on CJEU case law; and (V) Transnational and Comparative Dimensions – Hague Agreement, intersection with trademark and copyright protection, and use of empirical methodologies to improve infringement decision and damage calculation in US design patent litigation.

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<sup>1</sup> Tracy-Gene Dunkin, et al, *Design Patents Prove Successful on Enforcement, Defense*, Law 360 (May 4, 2020) [https://www.sternekessler.com/sites/default/files/2020-05/design\\_patents\\_prove\\_successful\\_on\\_enforcement\\_defense.pdf](https://www.sternekessler.com/sites/default/files/2020-05/design_patents_prove_successful_on_enforcement_defense.pdf) ; An Empirical Analysis of the Design Case Law of the EU Member States, 50 IIC 685 (2019) <https://link.springer.com/article/10.1007/s40319-019-00813-0>

Part I is particularly useful for understanding how basic requirements of design protection under Community Design Regulation (CDR), such as novelty and individual character, are implemented in the major jurisdictions and how much infringement tests differ among these jurisdictions. The explanations for these basic principles are easy for non-IP specialists, including law students, to understand. These principles are further discussed in Part II and Part III by examining key legal concepts and factors which are used for determining validity and infringement.

### **Valuable Information for US IP Lawyers**

The most valuable features of the book are an in-depth analysis of legal concepts unique to CDR. For example, CDR uses “individual character” for a requirement of protection as well as a measure to determine the scope of protection. Chapter 1 compares the concept with “nonobviousness” under US Patent Act as well as “creative difficulty” under the Japanese Industrial Design Act. “Freedom of designers” is a key concept to decide whether the design under examination involves individual character or is functional. However, the concept is not well known to non-EU IP lawyers. Thus, throughout chapters of the book, readers are guided through various considerations for making validity and infringement analysis in light of why the degree of designers’ freedom is considered and how the freedom is analyzed for validity and infringement citing views expressed in CJEU decisions.

The concept of “reciprocity” is also unique to CJEU case law and is difficult to understand for non-EU IP lawyers. Chapter 4 gives a comprehensive explanation of reciprocity. Specifically, reciprocity is an interaction between the prior art and the validity of a later design and interaction between the scope of protection of a design and infringement by a later design. For validity, a later design can more easily avoid invalidity if the prior art includes multiple designs (i.e., the crowded prior art). Thus the freedom of the designer is limited, which results in individual character despite minor differences between the prior art and the later design. By contrast, it is easier for the later design to avoid infringement in the crowded prior art, which results in narrowing protections due to the limited freedom of the designer. US courts also examine the prior art in determining infringement of design patents<sup>2</sup> and discuss the interaction between the prior art and infringement of utility patents when infringement under the doctrine of equivalents is examined by taking account whether whether the patented invention is a pioneer invention or an invention in the crowded prior art.<sup>3</sup> US courts and scholars have done little analysis on the validity and infringement of design patents in light of the interactions. Such analysis using the concepts of the reciprocity and the freedom of the designer might be helpful for US IP lawyers to prepare persuasive arguments for validity and infringement in US courts.

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<sup>2</sup> *Egyptian Goddess, Inc. v. Swisa, Inc.* 543 F. 3d 665 (Fed. Cir. 2008).

<sup>3</sup> *Graver Tank & Mfg. V. Linde Air Prod. Co.*, 339 U.S. 605 (1950).

Moreover, US IP lawyers are unfamiliar with design protection based on use without registration under CDR. They are familiar with trademark protection based on use under Lanham Act but the nature of use necessary to secure protection is very different between trademarks and designs. Chapter 7 introduces unregistered community design rights under CDR as well as similar rights under national laws in U.K., Hong Kong, and South Korea. It gives details of evidence to establish the use for design protection under CDR. The protection given by unregistered community design rights is particularly useful for products with a short life, such as fashion designs. However, there are many ambiguities in interpreting the requirement of use under CDR: the first disclosure in the EU. CJEU gives guidance through its case law but many questions remain to be clarified. Thus, the chapter explains case law in national courts for additional guidance. A major difference between unregistered and registered community design rights is proof of copying necessary for enforcing the unregistered rights. The discussions of similarity between the protected and accused designs and the role of experts to show copying remind US IP lawyers of copyright case law for proving copying with circumstantial evidence.

Another topic unfamiliar for US lawyers involves challenges to enforcing community design rights against multinational infringement in the EU market. Chapter 9 gives an overview of the EU enforcement directive which harmonized infringement procedure and remedies throughout EU member states and jurisdictions over design infringement procedure. Selecting a court to file a case for cross-border infringement is not easy because different courts have jurisdiction depending on whether the case involves a national or community design right. Prof. Annette Kur, who was involved in developing the community design system, authored Chapter 9. She explains complex rules for jurisdiction, recognition and enforcement of decisions, and joinders of parties and acknowledges in her concluding remark that the lack of uniform sanctions against community designs continues to be a concern for those who want to enforce their rights against cross-border infringers.

### **Interaction with Trademarks, Copyrights, and other Neighboring Rights**

Like the US, many aspects of product designs are protected by EU trademark rights and copyrights in addition to community design rights. Thus, Chapter 7 includes a comparison of unregistered design right protection with protections under copyright, trademark, and unfair competition laws. US IP lawyers need to know these rights as fallback options for protecting their clients' designs if the designs were first disclosed outside the EU without filing a design application at the EUIPO during the one-year grace period under CDR and thus cannot rely on unregistered community design rights. As will be discussed further below, barriers for trademark and copyright protection in the EU are lower than those in the US and additional protection may be available under unfair competition laws of EU member states.

Chapter 14 is dedicated to explaining the parallel or cumulative protection for product designs as 3D trademarks (trade dress) and industrial designs. Unlike the US, product

designs can be inherently distinctive and registerable without secondary meaning under EU Trademark Regulation (EUTMR) if the shape of the product is significantly different from the norm or customs of the sector. The author, Dr. von Muehlendahl, a founder of the EU trademark system, explains the absolute and relative requirements of trademark registration in contrast to requirements of design registration. Among the absolute requirements, functionality is most frequently disputed for the registrability and validity of 3D marks. The author highlights different tests used for examining three types of marks excluded for functionality under EUTMR by using examples in CJEU decisions. The last half of the chapter examines conflicts between earlier designs and later 3D trademarks as well as between earlier 3D marks and later design rights owned by different parties. Interestingly, the scope of community design rights is not limited by the product that the design is applied. This is in contrast to a recent Federal Circuit Decision where the scope of a product design was limited to the product for which the design was applied.<sup>4</sup> Because community design rights cover disembodied designs, an earlier design is infringed by a later 3D mark when the design and the mark give the informed user the same overall impression. In other words, the scope of community designs is broader than the scope of US design patents if the rights issued to protect the same designs.

Chapter 15 deals with two competing approaches on copyright protection for designs developed in EU member states (1) multiple or cumulative protection by copyrights and design rights and (2) exclusive protection by either copyrights or design rights. The three landmark CJEU decisions adopted the first approach and required EU member states to grant copyright protection for product designs if the author's creative ability is originally expressed in the design. These decisions had a great impact on national legislation and case law in member states which have long adopted the second approach. In the UK the barriers to copyright protection on designs remain high despite the minimum threshold announced by CJEU. In contrast, German courts eliminated the barriers when the German Supreme Court changed its case law and stopped discriminating works of applied art to apply a higher threshold of originality than works of fine arts. Italy and France also fully embraced the first approach in applying the originality threshold in the CJEU decisions to product designs. It is interesting to note that CJEU rejected the separability requirement under Italian copyright law,<sup>5</sup> which reminds US lawyers of the separability requirement that the US Supreme Court applied for finding product designs copyright eligible.<sup>6</sup>

## Unique Aspects

This book is not a simple practice guide for design protection. Part II includes a chapter dealing with design ownership and designship under CDR by contrast to these

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<sup>4</sup> *Curver Luxembourg, SARL v. Home Expressions Inc.*, 2018 U.S. Dist. LEXIS 112507, 2018 WL 3339526

<sup>5</sup> C-168/09, *Flos v. Sameraro*, Jan. 27 2011,

<sup>6</sup> *Star Athletica L.L.C. v. Varsity Brands, Inc.* 137 S. Ct. 1002 (2017).

concepts under national laws of EU member states. Non-harmonized moral right aspects of community design result in challenges for multinational firms to manage their design rights developed by designers in different EU member states. The chapter also discusses the standard to decide sole and joint designers and ownership rules for employee designs under CDR, which might also differ from rules under national laws. The chapter provides in-house counsels of multinational firms essential knowledge to secure design rights from employee-designers and to avoid future disputes by using contracts.

The book concludes with its most advanced topic—applying data-driven decision-making to US design patent litigation. The last chapter discusses neuroaesthetics resulting from the most advanced neuroscience-based research to examine aesthetic experience in human brain and proposes to use a consumer survey for helping fact finders in US litigation to examine the substantial similarity between the patented and accused designs from the ordinary observer perspective. It also suggests benefits resulting from the application of Neuroaesthetics to improve the four-factor damage calculation test and the methodology quantifying the design value to the total product in *Apple v. Samsung*. The discussions of the interdisciplinary approach and the state of the art technology are insightful for legal scholars who look for innovative research topics.

### **Who should read this book?**

The book is useful for all IP lawyers as a concise treatise on EU design protection because it cites all key provisions in international and national design laws and leading CJEU and national court decisions. For US IP lawyers, it gives a comparative analysis of frequently disputed legal issues in design patent prosecution and litigation between US and EU. The extensive discussions on German case law are particularly useful for non-German speaking readers as the availability of English resources is limited despite the importance of design enforcement in German courts.

### **Conclusion**

It is a good starting point for law students, IP lawyers, and academics who want to learn the basics of design protection and research on most current issues in product design protection. Readers can study advanced topics and details of practicing design law when they read selected chapters depending on their needs. The physical version of the book is relatively expensive, more than \$300 but eBook versions are available from the publisher's website with only 1/5 of the price for its physical version.