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Volume 24 | Number 4

Article 3

8-1-2002

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Recommended Citation

Erica Pruetz, *Protecting Car Design Internationally: A Comparison of British and American Design Laws*, 24 Loy. L.A. Int'l & Comp. L. Rev. 475 (2002).

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NOTES AND COMMENTS

PROTECTING CAR DESIGN INTERNATIONALLY: A COMPARISON OF BRITISH AND AMERICAN DESIGN LAWS

I. INTRODUCTION

Designs affect all aspects of our daily lives from purely aesthetic designs of painting and sculpture to more functional designs of coffee filters, furniture and even automobiles.¹ Although it has never been precisely defined,² design is understood to mean “all creations which appeal to the eye.”³ Accordingly, only the visual aspects of a design can be legally protected.

Car design protection occurs nationally through patent, trademark and copyright laws and internationally through various conventions.⁴ Automobiles only receive design protection for parts visible during normal use.⁵ Automotive parts located “under the bonnet” cannot receive design protection.⁶ Thus, a carmaker can only protect a design’s exterior or features and not its internal components such as an engine transmission.

Furthermore, the legal protection of car design requires a “materialized, concrete” creation and not merely an idea.⁷ The law divides designs into two categories: purely artistic designs (“pure works of art”), and industrial designs (“applied art”), which

1. DENIS COHEN, *THE INTERNATIONAL PROTECTION OF DESIGNS* ix (Kluwer Law Int'l Ltd. 2000).

2. *Id.* at 1. Nevertheless, EC Directive 98/71, which has not yet been incorporated into any domestic law, provides that *design* means “the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, colours, shape, texture and/or materials of the product itself and/or its ornamentation.” *Id.* at 1 n.1.

3. *Id.*

4. *Id.* at ix.

5. *See id.* at 1, 7.

6. *See id.*

7. *Id.* at 2.

serve practical purposes.⁸ Automobile design falls under industrial design because cars serve the practical purpose of providing transportation. While other areas of intellectual and industrial property law benefit from well-established international conventions and treaties, substantive design protection has only recently been addressed at the international level.⁹

This comment evaluates European Union, United Kingdom, and United States car design protection and enforcement systems. Analysis reveals that the United States currently has a better overall system for protecting and enforcing recognized design rights. The United States, however, has diminished car design protection in recent years. U.S. judicial decisions¹⁰ and restrictive Design Patent requirements are making it more difficult for car designers to obtain protection in the United States. Conversely, the advent of new forms of intellectual property protection in the European Union, such as the Patent Law Treaty, Community Trademark Directive and Community Design, have increased the ways in which British car designers may protect their designs. British car designers will benefit from these faster and easier application processes for patent, copyright and trademark protection in the European Union. British car designers will also benefit from national long-term design protection for registered designs via the Copyright, Designs and Patents Act of 1988, the Registered Designs Act and specific laws.¹¹ In addition, British car designers may also take advantage of national short-term protection for both functional and nonfunctional unregistered designs.¹²

The United States has no direct parallel to Community Design laws in Europe or registered and unregistered design laws in the United Kingdom.¹³ For this reason, car designers may soon prefer to protect their designs in Europe and the United Kingdom instead of the United States. Although many of these European laws are recent, such as, Community Trademark and Community Design, it appears likely that the United Kingdom is poised to

8. *Id.*

9. MARIO FRANZOSI ET AL., EUROPEAN DESIGN PROTECTION 4 (Mario Franzosi ed., Kluwer Law Int'l 1996).

10. *See generally* *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001).

11. UMA SUTHERSANEN, DESIGN LAW IN EUROPE 232 n.72 (Sweet & Maxwell Ltd. 2000).

12. *Id.* at 303.

13. *Id.*

provide more comprehensive design protection than the United States in the near future. For this reason, those with an interest in car design are watching the United Kingdom to see whether new design and trademark laws will increase car design protection.

This Comment compares European Union, United Kingdom, and United States laws and rules regarding the protection of car designs. Section two discusses patent protection of car designs in the European Union, United Kingdom, and the United States. Section three analyzes car design protection under copyright law. Section four explores such protection through trademark law. Section five covers basic protection via design laws. A synthesis of these varied and yet complementary laws will show that despite recent European Court of Justice decisions,¹⁴ the United Kingdom is positioned to provide more comprehensive car design protection than any other country in Europe and may eventually surpass the United States in protecting car design.

II. PATENT PROTECTION OF CAR DESIGN

Car designers first look to patent law to protect their designs because patents provide the strongest form of intellectual property protection.¹⁵ For example, U.S. patents are issued for twenty years and the holder may exclude all others from “making, using, offering for sale, or selling... or importing the invention” throughout the United States.¹⁶ While patents provide stronger protection than copyright or trademark laws, they are also more difficult for car designers to obtain because both European and U.S. patent laws have strict requirements that may prove too difficult for car designers to meet.

Despite the fact that both U.S. and European patents are hard to obtain, there are several reasons why a car designer may choose to file in Europe. First, a European patent grants

14. Case C-299/99, Philips Elecs. NV v. Remington Consumer Prods. Ltd. [2001] R.P.C. 38 (2001).

15. Laurinda L. Hicks & James R. Holbein, *Convergence of National Intellectual Property Norms in International Trading Agreements*, 12 AM. U. J. INT'L L. & POL'Y. 769, 772 (1997).

16. SHELDON W. HALPERN ET AL., *FUNDAMENTALS OF UNITED STATES INTELLECTUAL PROPERTY LAW: COPYRIGHT, PATENT, AND TRADEMARK* 251–53 (Kluwer Law Int'l 1999).

protection over a wider area than the United States.¹⁷ Second, European patent applications are less expensive than U.S. patents.¹⁸ Third, U.S. patents take longer to process and many applicants are rejected.¹⁹ Furthermore, U.S. courts often invalidate U.S. Design Patents because they are too similar to existing designs.²⁰ In contrast, due to faster application processes as a result of the European Patent Convention (EPC) and the Patent Law Treaty, applying for a patent in Europe is faster and easier. Since the United Kingdom benefits from both these faster application processes and the common law system, British car designers stand to benefit. Their patents will be enforced by the UK courts and granted by the EPC. For these reasons, a car designer seeking patent protection should strongly consider seeking design protection in Europe and the United Kingdom as well as in the United States.

A. European Patent Protection

The European Union protects car design rights vigorously through the application of recent international treaties such as the Patent Law Treaty and the Trademark Law Treaty in conjunction with Community Trademark and Community Design laws. Upon harmonization and integration of these treaties and EU laws with national laws, the European Union will eventually surpass the United States in design protection. The result of Europe's achievement will be the most integrated and fastest application process for design protection in the world.²¹ In contrast, though the United States provided more protection for car design in the past, primarily via trade dress protection, recent U.S. Supreme Court decisions²² may decrease U.S. protection of car design in the future. The combination of such judicial decisions, and the fact that U.S. design patents are difficult and expensive to obtain and

17. See GUY TRITTON, *INTELLECTUAL PROPERTY IN EUROPE* 127-28 (Sweet & Maxwell Ltd. 1996). For example, many important European countries, such as the United Kingdom, Germany and France belong to the European Patent Convention. *Id.*

18. Richard G. Frenkel, Comment, *Intellectual Property in the Balance: Proposal for Improving Industrial Design in the Post-TRIPS Era*, 32 *LOY. L.A. L. REV.* 531, 554-55 (1999).

19. *Id.*

20. *Id.* at 556.

21. Bruce A. McDonald, *International Intellectual Property Rights*, *INT'L LAW.* 471 (2001).

22. See e.g., *Traffix Devices, Inc.*, 121 U.S. 1255 (2000).

may not survive in court, demonstrates that the United Kingdom is poised to surpass the United States in providing the most comprehensive car design protection.

Car design protection improved in June 2000, when forty-four countries, including the United States and the United Kingdom, adopted the Patent Law Treaty.²³ The treaty, developed by the World Intellectual Property Organization (WIPO), represents more than fifteen years of international efforts to harmonize domestic patent laws.²⁴ Initially, the treaty aimed to create uniform standards of patentability.²⁵ But when that goal proved impossible, it sought to harmonize administrative and procedural aspects of patent application and prosecution processes worldwide.²⁶ The treaty "provides uniform standards to simplify the filing and prosecution of patent applications in Member States."²⁷ The treaty minimizes the requirements for obtaining a filing date, eliminates many procedural difficulties with translations, certifications, and fee payments, and ensures adequate time limits for responses to office actions.²⁸

Additionally, the European Patent Convention (EPC) establishes the substantive laws governing European patents and patent applications.²⁹ The EPC has two main objectives: (1) to preserve the broad scope of European patent protection and (2) to limit protection to "strong patents" that are likely to withstand judicial scrutiny.³⁰ To receive a patent for car design in Europe, a designer must meet the requirements set forth by the EPC.³¹

The EPC grants patent protection for car designs that are susceptible to industrial application, are novel and involve an inventive step.³² The first criterion states that only inventions with a "technical character" may be patented.³³ Since the EPC does not precisely define "technical character,"³⁴ its meaning has been

23. McDonald, *supra* note 21, at 465.

24. *Id.*

25. *Id.*

26. *Id.*

27. *Id.*

28. *Id.*

29. DR. ROMUALD SINGER & MARGARETE SINGER, *THE EUROPEAN PATENT CONVENTION 107* (Ralph Lunzer ed., Sweet & Maxwell 1995).

30. *Id.*

31. *See id.*

32. *Id.* at 109.

33. *Id.* at 111.

34. *Id.* at 112.

the subject of numerous court decisions.³⁵ The second requirement is that an invention must be novel. In order to satisfy this requirement, the EPC must examine the "state of the art" or prior art to determine whether any similar inventions have been patented.³⁶ The third requirement is that the invention involves an inventive step.³⁷ The car design will include an inventive step if it is "not obvious to a person skilled in the art."³⁸ When a car designer meets these three qualifications the EPC will grant a twenty year patent.³⁹ Since the EPC requires infringements of European patents to be dealt with under national laws,⁴⁰ it is necessary to analyze the rights and remedies provided by a sample nation—the United Kingdom.

B. The United Kingdom and Patent Protection

In the United Kingdom, the Patents Act of 1977 (Act) is the main statute regulating patents.⁴¹ Each European patent granted for a British car designer must be treated as if it were a British-granted patent.⁴² In order to receive protection under Britain's Patent Act, an invention must satisfy four elements.⁴³ The invention must be novel, include an inventive step, be capable of industrial application and not be specifically excluded from the scope of protection.⁴⁴ Some examples of excluded inventions are discoveries, scientific methods, literary or artistic works, and inventions that perform mental acts, such as playing a game or doing business.⁴⁵ Industrial designs such as car design are not excluded subject matter. Therefore, car design may receive protection under the Act if it meets the following three requirements.

35. *Id.* at 112. For example, in 1965 the German Federal Patent Court defined technical as "the effect of harnessed natural forces and controlled utilization [sic] of natural phenomena." *Id.*

36. *See id.* at 129.

37. *Id.* at 176.

38. *Id.*

39. *See id.* at 232.

40. *Id.* at 234.

41. DOUGLAS CAMPBELL, EUROPEAN PATENT LITIGATION HANDBOOK 1 (Brian C. Reid ed., Sweet & Maxwell 1999).

42. *Id.* at 1-2.

43. *Id.* at 17.

44. *Id.*

45. *Id.*

First, patent protection will only be granted to car designs that are novel or non-anticipated.⁴⁶ Thus, the UK Patent Office reviews the state of the art⁴⁷ to determine whether the information was “anticipated” or available to the car designer prior to filing.⁴⁸ If the car design was non-anticipated by the state of the art, then it is novel and, therefore, eligible to receive patent protection.

Second, the car design must involve an inventive step.⁴⁹ In other words, the car designer must prove that his design goes beyond the state of the art and would not be obvious to one skilled in the art of car design.⁵⁰ Finally, the car designer must prove that his invention is capable of industrial application.⁵¹ This step is easily satisfied because car designs are used in the car industry.

Both the Comptroller or Patent Office and the Patents Court oversee patent protection in the United Kingdom.⁵² If a valid car design patent is infringed, the patent holder is entitled to receive an injunction, damages, or both.⁵³

C. United States Patent Protection

Patents provide the strongest form of protection for car design in the United States.⁵⁴ There are three basic types of patents: utility, design and plant patents.⁵⁵ Car design only receives protection through design patents, which are granted to new, original and ornamental designs.⁵⁶

Due to these requirements, design patents appear to be much more restrictive in the United States than in the United Kingdom. This restrictiveness presents several problems for design patents. First, a design patent must be non-obvious; that is, it must “represent a distinct inventive step in advance of the prior art in a

46. *Id.* at 18.

47. *Id.* “The state of the art includes all matter (whether a product, a process or information about either, or anything else)” which has been made available to the car designer applying for patent protection “in the UK or elsewhere by written or oral description.” *Id.* at 17.

48. *Id.*

49. *Id.* at 20.

50. *Id.*

51. *Id.* at 22.

52. *Id.* at 2.

53. *Id.* at 40–41.

54. Hicks et al., *supra* note 15, at 772.

55. *Id.*

56. *See id.*

particular field.”⁵⁷ In other words, the car design must not be obvious to a person skilled in the art of car design.⁵⁸ The non-obvious requirement imposes a large financial burden upon a car designer who must examine a wide array of prior designs to distinguish his or her own innovation.⁵⁹ This process is especially burdensome in light of the fact that the Patent and Trademark Office (PTO) rejects roughly half of all design patent applications.⁶⁰

Another problem with design patents is the length of time required to obtain one.⁶¹ As of 1995, the PTO took an average of eighteen months to process a design patent application.⁶² This time delay is often critical to the designer because the car design may no longer be in style by the time a design patent is granted.⁶³

A third major problem is that courts often invalidate design patents.⁶⁴ This is due to the U.S. patent law's strict requirements of originality.⁶⁵ As a result, once the court compares the applicant design to competing designs, the court often finds the patent too similar to meet the originality standard.⁶⁶

D. Comparison of United Kingdom and United States Patent Law

If a car designer is eligible to receive patent protection, he may want to file in the United Kingdom instead of the United States. This is because U.S. Design patents for car design are difficult and expensive to obtain and may subsequently be invalidated by the U.S. judicial system. Compared to the obstacles posed by patent law in the United States, patent laws in the European Union, and in particular the United Kingdom, are far less restrictive and provide a viable option for car designers desiring protection.

Furthermore, if a British car designer cannot meet the requirements for a European or a UK patent, he may be able to protect his design through registered and unregistered design

57. *Id.* at 554.

58. HALPERN ET AL., *supra* note 16, at 187.

59. *Id.* at 555-54.

60. *Id.* at 555.

61. *Id.*

62. *Id.*

63. *Id.*

64. *Id.*

65. *Id.* at 555-56.

66. *See id.* at 556.

rights as well as the new Community Design and Community Trademark laws (discussed in sections IV and V). In addition to patent protection, a car designer may receive protection through copyright law.

III. COPYRIGHT PROTECTION OF CAR DESIGN

A. *International Copyright Protection*

The Berne Convention⁶⁷ was ratified in 1886 to protect both artistic and industrial design.⁶⁸ Before Berne, industrial powers entered into a myriad of bilateral agreements to protect copyright.⁶⁹ Several countries, including the United Kingdom, recognized that an international convention would protect copyright more effectively than endless individual agreements.⁷⁰ The United Kingdom and other nations ratified Berne to ensure that: (1) Berne countries confer equal protection for domestic and foreign works rather than give preference to domestic artists and that (2) Member States harmonize their copyright laws.⁷¹

The United States refrained from Berne for a century, finally signing in 1989.⁷² The United States desired to retain formalities that were prohibited by the Berne Convention.⁷³ Most importantly, the United States did not need to ratify the convention because U.S. publishers could use the “back door to Berne” and secure Berne protection by simultaneously publishing a work in the United States and in a Berne Member State.⁷⁴ Thus, U.S. publishers were able to secure comprehensive copyright protection domestically as well as internationally.

Today, 140 countries are currently members of the Berne Convention.⁷⁵ While Berne has been revised several times,⁷⁶ a car

67. COHEN, *supra* note 1, at 79–80.

68. *Id.* at 79–80.

69. TRITTON, *supra* note 17, at 186.

70. *Id.*

71. *Id.*

72. PAUL GOLDSTEIN, *INTERNATIONAL COPYRIGHT: PRINCIPLES, LAW, AND PRACTICE* 23 (Oxford Univ. Press 2001).

73. *Id.*

74. *Id.* The “back door” approach provoked the United Kingdom to propose a protocol permitting reprisal, which is now embodied in Article 6(1) of the 1971 Paris Act. *Id.*

75. *Id.* at 393.

designer currently seeking to obtain industrial design protection under Berne must complete either a national registration or an international registration under the Hague Agreement.⁷⁷ Furthermore, it is important to remember that Berne does not impose an obligation upon Member States to protect industrial designs by copyright. Instead, it allows Member States to determine the extent of copyright protection a design will receive.⁷⁸

In determining how much protection to grant a car design, Member States consider two elements: (1) the industrial aspect of a design, or its practical purpose and (2) the artistic aspect.⁷⁹ Finally, industrial designs only receive copyright protection if they can be admitted in two countries successively: the country where protection is sought and the country of origin.⁸⁰ In addition to the Berne Convention, the United Kingdom also affords national copyright protection for car design via the Copyright Designs and Patents Act of 1988.⁸¹

B. United Kingdom Copyright Protection

In the United Kingdom, the Copyright, Designs and Patents Act of 1988 (Act) also protects car design subject to two

76. For example, the Paris Act was added in 1896 and Berne was revised in Berlin in 1908, Rome in 1928, Brussels in 1948, Stockholm in 1967, and Paris in 1971. TRITTON, *supra* note 17, at 186.

77. COHEN, *supra* note 1, at 112.

78. *Id.* at 113. Many European countries, apart from the United Kingdom, have enacted strict legislation making it very difficult for industrial design to receive copyright protection. For example, France requires that a copyright be protected in its country of origin before it can be protected in France. *See id.* at 122; *see also* TGI Paris, 20 March 1986 (PIBD 1986, III, p. 282). In that case, a Swedish company named SKF could not prove that copyright protection existed in Sweden and, therefore, could not claim protection under French copyright law. *See id.* In Italy, registering a design automatically entails the loss of copyright. TRITTON, *supra* note 17, at 240. Unregistered designs may only receive copyright protection if the artistic aspects can be dissociated from the industrial aspects of the design. *See id.*

79. *Id.* at 114–15, 121. The United Kingdom adheres to the “separatist theory” of art and only applies protection based on specific national legislation. *Id.* at 121. Other Member States assert that every design is artistic and afford protection through both copyright law and specific legislation. *Id.* at 114. Others measure the artistic degree of an industrial design based on several criteria and afford the most protection to industrial designs. *Id.* Berne imposes a double qualification not required of purely artistic designs. *Id.* at 116.

80. COHEN, *supra* note 1, at 114–15.

81. *See* SUTHERSANEN, *supra* note 11, at 233.

requirements.⁸² First, the design must fit within one of nine specific categories of “works” enumerated by the Act.⁸³ Second, the car design must qualify as original.⁸⁴

Car design fits into the “graphic works” category, under the heading of “sculpture” because the Act stipulates, “artistic quality is irrelevant in determining whether a work qualifies as a sculpture.”⁸⁵ Courts, however, have not interpreted the Act in this way. For the most part, the courts have not extended copyright protection to three-dimensional products that are functional or industrial.⁸⁶ Instead, courts prefer that these designs be protected under registered and unregistered design laws⁸⁷ because they believe copyright law is not designed to protect artistic designs created for industrial or mass-produced markets.⁸⁸ Even so, courts have allowed some industrial designs, such as toasters and masks, to receive copyright protection under the term “sculpture.”⁸⁹ Thus, it is possible that the court may also grant copyright protection for car designs as sculpture under the graphic works category.

However, even if the car design were found to be sculpture, a car design must also be original in order to receive copyright protection. Again, while the Act does not prohibit the protection of purely functional designs, British courts have shown a reluctance to extend copyright protection to designs that are “commonplace or which manifest features which have become industry standards.”⁹⁰

Fortunately, the originality requirement is a *de minimus* rule.⁹¹ Hence, a car design is deemed original so long as “skill, judgment and labour” were expended by the designer in creating the design.⁹² In addition, the Act protects the “expression of

82. *Id.*

83. *Id.* The Act defines a “work” as artistic, graphic, work of architecture, work of artistic craftsmanship, computer-generated works, literary, typographical arrangement and layouts, and typefaces. *Id.* at 233–245.

84. *Id.*

85. *See id.* at 236.

86. *Id.* at 237.

87. *Id.*

88. *Id.* at 249.

89. *Id.* at n. 8, 237.

90. *Id.* at 249; *see also* Purefoy Engineering Co. Ltd. v. Sykes Boxall, [1954] 71 R.P.C. 227, 231–32.

91. *Id.* at 245.

92. *Id.*

thought” rather than ideas themselves,⁹³ and is not as concerned with the originality of an idea. A car design will be deemed “original” as long as the work has not been copied and originates from the author.⁹⁴ Thus, car design will only receive protection under the Act if it is more than functional and if it embodies something beyond commonplace industry standards.

Section 51(1) of the Act, however, states that it is not copyright infringement of a design document to “make an article to the design or to copy an article made to the design.”⁹⁵ Thus, it is not an infringement to copy, model or incorporate the industrial aspects of a design.⁹⁶ This section, which went into effect in August 1999, appears to reduce copyright protection for design documents of industrial designs.⁹⁷

Although section 51(1) may reduce car design document protection, the Act simultaneously creates another category of design protection through unregistered design rights.⁹⁸ These rights are much easier to obtain than copyright protection⁹⁹ because a car designer may automatically receive an unregistered design right while other forms of protection, such as trademark and registered designs, require registration.¹⁰⁰ So long as the car design is “novel,” it may receive an unregistered design right.¹⁰¹ Thus, car design can receive protection for up to fifteen years without registering.¹⁰² The United Kingdom is the only country that protects car design without requiring the designer to register.¹⁰³

93. *Id.*

94. *Id.* at 246.

95. Jason G. Ellis, *Industrial Design Protection After Philips Electronics NV v. Remington Consumer Products—The Shape of Things to Come?*, J. BUS. L. 167, 170 (1999).

96. *See id.* at 170.

97. *Id.* Section 51(1) appears to reduce copyright protection for industrial designs because of the way in which it defines “design.” Section 51(1) defines design as a “shape or configuration.” *See id.* at 173. Thus, design documents which depict three-dimensional designs, such as car design, and which also qualify as an artistic work will not qualify for protection under this section. *Id.* Since three-dimensional designs are classified as “sculpture” under the category of artistic work, it appears that section 51(1) reduces copyright protection for design documents of car design. *Id.*

98. *See id.* at 173.

99. *See id.*

100. *Id.*

101. *See id.*

102. TRITTON, *supra* note 17, at 240.

103. *Id.*

Thus, while unregistered designs do not receive the same degree of protection as copyrights or registered designs, they are much easier to obtain than copyright protection.¹⁰⁴ Therefore, unregistered designs are a viable form of protection for car designers who fail to apply for registered designs or who fail to meet the strict standards for copyright protection. The United Kingdom is the only country to offer design protection for unregistered designs.¹⁰⁵ For this reason, the United Kingdom may soon surpass the United States in car design protection. In addition to unregistered design laws, patent and copyright protection, the United Kingdom also offers car design protection through trademark law.

C. United States Copyright Protection

The 1976 Copyright Act may protect car design in the United States, even though it does not specifically address industrial design.¹⁰⁶ The Copyright Act states “pictorial, graphic [or] sculptural works are proper subject matter warranting copyright protection.”¹⁰⁷ The designs of useful articles such as cars, however, do not.¹⁰⁸ “The exception to this exception, otherwise known as the “question of separability,” is that useful articles enjoy copyright protection to the extent that pictorial, graphic, or sculptural features can exist independently of and separately from the utilitarian aspects of the article.”¹⁰⁹ For example, toy models and masks have been held to be copyrightable, while mannequins of human torsos have been deemed “useful articles.”¹¹⁰ Thus, excluding its utilitarian functions, car design is copyrightable.¹¹¹ As with UK copyright law, one of the crucial problems for U.S. car designers is the separation of the aesthetic from the functional

104. See Ellis, *supra* note 95, at 173.

105. TRITTON, *supra* note 17 at 240.

106. HALPERN ET AL., *supra* note 16, at 21.

107. Stephen Langs, *The Definitional Scope of an Intrinsic Utilitarian Function Under the 1976 Copyright Act: One Man's Use is Another Man's Art*, 20 W. NEW ENG. L. REV. 143 (1998).

108. *Id.*

109. *Id.* at 143–44.

110. HALPERN ET AL., *supra* note 16, at 21.

111. Langs, *supra* note 107, at 143–44.

aspects of their car design.¹¹² If form and function are inextricably entwined, then copyright protection will be denied.¹¹³

In 1995, the Copyright Act was revised to allow holders of design patents to claim copyright protection as well.¹¹⁴ Therefore, both design patent and copyright law can protect U.S. car design. For this reason, U.S. copyright protection remains stronger than that of Europe and the United Kingdom. However, in addition to patent and copyright protection, the United Kingdom provides car designers registered and unregistered design rights, rights that do not exist in the United States. These national design laws, along with the advent of Community Trademark and Community Design rights (which will be explained further in the next section), may enable Europe and the United Kingdom to provide more effective protection than the United States in the near future by offering car designers more legal options for protecting their designs. Because the Community Trademark and Community design laws are recent, it is unclear whether they will increase or decrease car design protection in the United Kingdom. If these new laws increase protection for car design, the United Kingdom will move to the forefront in car design protection.

IV. TRADEMARK PROTECTION

A. *International Trademark Protection*

1. The Paris Convention

The Paris Convention (Convention) provides international trademark protection for car design.¹¹⁵ As of January 1996, 136 countries were parties to the Convention, including the United Kingdom and the United States.¹¹⁶ The Convention's fundamental principle is to prevent Member States from favoring trademarks filed in their own countries over trademarks filed abroad.¹¹⁷ Thus, citizens of Member States enjoy the same rights, advantages and

112. HALPERN ET AL., *supra* note 16, at 23.

113. *Id.* at 24.

114. Frenkel, *supra* note 18, at 557-58.

115. INTERNATIONAL TREATIES ON INTELLECTUAL PROPERTY 17 (Marshall A. Leaffer ed., 1997).

116. *Id.* at 18.

117. TRITTON, *supra* note 17, at 133.

protections in all other Member States.¹¹⁸ The Convention establishes a legal entity under international law with administrative organs to carry out its mission.¹¹⁹ It is up to each Member State, however, to decide its force of law.¹²⁰ For instance, in the United Kingdom, an international convention has no effect until implemented by national legislation.¹²¹

The Convention also contains a series of smaller treaties called "special unions" that require separate membership.¹²² Two smaller treaties within the Paris Convention that warrant discussion are the Madrid Agreement of 1891 and the Madrid Protocol of 1989, both of which deal specifically with design protection.¹²³ The Agreement and the Protocol are designed to work "parallel but separately from each other."¹²⁴ The Madrid Agreement provides an international procedure for individuals or companies to register trademarks.¹²⁵ As of January 1996, thirty-one nations were parties to the Madrid Agreement, including the United Kingdom.¹²⁶

The Madrid Protocol was designed to run parallel to the Madrid Agreement.¹²⁷ The Madrid Protocol covers the same subject matter, and adopts much of the same wording and numbering as the Madrid Agreement.¹²⁸ The Convention enacted the Madrid Protocol because several common law countries refused to adopt the Madrid Agreement since it required less thorough examination of trademark agreements than their national trademark laws demanded.¹²⁹ The United States declined to sign the Madrid Agreement considering the dependency upon

118. *Id.*

119. INTERNATIONAL TREATIES ON INTELLECTUAL PROPERTY, *supra* note 115, at 17, 35.

120. *Id.* at 18.

121. *Id.* France, on the other hand, allows international conventions to automatically form part of its domestic law upon ratification. *Id.*

122. INTERNATIONAL TREATIES ON INTELLECTUAL PROPERTY, *supra* note 115, at 17.

123. *Id.*

124. *Id.* at 143.

125. TRITTON, *supra* note 17, at 135.

126. INTERNATIONAL TREATIES ON INTELLECTUAL PROPERTY, *supra* note 115, at 290.

127. TRITTON, *supra* note 17, at 141.

128. *Id.*

129. *Id.* at 140. For example, in countries like France, which only requires "registration by deposit," registration was much easier to obtain than in countries requiring a thorough examination. *Id.*

home registration for international marks to be inherently unfair.¹³⁰ The Madrid Agreement was problematic for countries with very strict application requirements, such as the United States, which were at a severe disadvantage because they required actual use of a trademark before registration.¹³¹ Another major problem with the Madrid Agreement was that French was the only official language for registering.¹³² English-speaking countries considered this requirement unacceptable.¹³³

Several fundamental differences distinguish the Madrid Agreement from the Madrid Protocol. Under the Madrid Agreement, applicants must register in their "home" country before international registration is made and granted.¹³⁴ Under the Protocol, international protection commences upon the filing of a home application.¹³⁵ Another distinction concerns the duration of trademark protection. The Protocol only allows trademark protection for ten years with the possibility to renew for an additional ten years, whereas the Agreement grants an initial twenty year period of protection with the potential to renew protection for an additional twenty years.¹³⁶ A final distinction is that while the Madrid Agreement allows a period of twelve months to refuse protection of an international application, the Madrid Protocol extends this refusal period for up to eighteen months.¹³⁷

Because the Agreement and the Protocol are designed to work parallel but separately from each other, states that have ratified the Protocol will only receive Protocol protection in states that have also ratified the Protocol.¹³⁸ Similarly, "home" applications in countries that ratified the Agreement can only designate other Agreement countries for protection.¹³⁹ In states that have ratified both the Agreement and the Protocol, the

130. *Id.*

131. *Id.*

132. *Id.* at 140.

133. *Id.*

134. *Id.* at 141.

135. *Id.*

136. *Id.* at 139.

137. *Id.* at 142. The time limit extension was due to pressure from countries such as the United Kingdom, Denmark, and Ireland, which conduct extensive examinations. *Id.* This extended eighteen-month time limit for refusal is designed to be an experiment because the Assembly retained the right to modify the system after ten years. *Id.*

138. *Id.*

139. *Id.*

Protocol will only apply to Protocol-only countries. However, the Agreement will apply to both Agreement-only countries and to countries that have signed the Agreement and the Protocol.¹⁴⁰

In 2000, the United States began the process of ratifying the Madrid Protocol.¹⁴¹ The main issue preventing U.S. accession had been a disagreement with the European Union over voting rights of intergovernmental organizations.¹⁴² The two sides have since resolved this dispute. The White House announced its support for the Madrid Protocol on May 31, 2000, in a press release issued during the United States/European Union Summit.¹⁴³ Thereafter, the U.S. State Department showed its support for the Protocol and began preparing ratification documents to submit to the Senate.¹⁴⁴ As of yet, the United States has not become a member of the Madrid Protocol. A bill proposing ratification of the Protocol, however, is now pending before the U.S. Senate.¹⁴⁵

2. The Trademark Law Treaty and TRIPS

Another form of international protection of car design is the Trademark Law Treaty, which was adopted in Geneva on October 27, 1994.¹⁴⁶ Initially, the Treaty aimed to cover all aspects of trademark protection.¹⁴⁷ The nations involved, however, could not agree on an acceptable solution.¹⁴⁸

Consequently, the Treaty was "limited to the goal of harmonizing and simplifying administrative procedures of national registration by streamlining the registration procedure."¹⁴⁹ The Treaty also abolished the old procedure of legalizing documents before certain national offices would accept them.¹⁵⁰ Moreover, the Treaty provides model forms and encourages national trademark offices to use them.¹⁵¹ Both the United States and the

140. *Id.* at 143–44.

141. McDonald, *supra* note 21, at 471.

142. *Id.*

143. *Id.*

144. *Id.*; see also Press Release, White House (May 31, 2000).

145. Madrid Protocol Implementation S.407, 107th Cong. (2001).

146. Joanna Schmidt-Szalewski, *The International Protection of Trademarks after the TRIPS Agreement*, 9 DUKE J. COMP. & INT'L L. 189, 205 (1998).

147. *Id.*

148. *See id.*

149. *Id.*

150. *Id.*

151. *Id.* at 205–06.

United Kingdom are parties to the Treaty.¹⁵² The Treaty is best understood in light of its relationship to the Trade Related Intellectual Property Rights Agreement (TRIPS).

TRIPS is "the most comprehensive international instrument on intellectual property rights."¹⁵³ TRIPS was created by the Uruguay Round Agreements which began in 1986.¹⁵⁴ These Agreements established the World Trade Organization (WTO).¹⁵⁵ One of the WTO's main functions is to ensure that WTO member nations implement and comply with TRIPS provisions.¹⁵⁶ Both the United States and the United Kingdom are WTO members and parties to the TRIPS Agreement.¹⁵⁷ TRIPS is "the most significant advance in international protection of intellectual property since the adoption of the Berne and Paris Conventions. Its purpose is to establish universal minimum standards of protection for several areas of intellectual property law, including industrial design, trademarks, copyrights and patents."¹⁵⁸ TRIPS lays out three main substantive provisions on industrial design.¹⁵⁹ First, new or original designs should receive protection.¹⁶⁰ Second, TRIPS allows exclusive rights to be exercised against commercial acts such as importation.¹⁶¹ Third, designs should receive protection for a minimum of ten years.¹⁶²

TRIPS is not a fully independent convention; rather, it adds new protections for design to already existing obligations under the Berne and Paris Conventions.¹⁶³ The difference between TRIPS and other conventions is that TRIPS regulates "public international law," whereas the Paris and Berne Conventions

152. INTELLECTUAL PROPERTY LAWS AND TREATIES, 30 (WIPO, 1998). The United Kingdom became a party to the treaty on August 1, 1996. *Id.* The Treaty was ratified by the United States on May 12, 2000 and went into effect in the United States on August 12, 2000. *Id.*, at 52.

153. CARLOS M. CORREA, INTELLECTUAL PROPERTY RIGHTS, THE WTO AND DEVELOPING COUNTRIES: THE TRIPS AGREEMENT AND POLICY OPTIONS 1 (Zed Books, Ltd. 2000).

154. DANIEL GERVAIS, THE TRIPS AGREEMENT: DRAFTING HISTORY AND ANALYSIS 10 (Sweet & Maxwell, 1998).

155. Hicks et al., *supra* note 15, at 783.

156. *Id.*

157. GERVAIS, *supra* note 154, at 439-440.

158. CORREA, *supra* note 153, at 1.

159. *Id.* at 16.

160. *Id.*

161. *Id.*

162. *Id.*

163. *Id.* at 2.

regulate "private international law."¹⁶⁴ While the main objective of TRIPS was to universalize intellectual property standards in developing countries, several developed countries, such as the United States, have enacted special laws intended to incorporate TRIPS into domestic legislation.¹⁶⁵ Similarly, the European Union modified preexisting Community regulations on trademarks.¹⁶⁶ Thus, even though TRIPS was not intended to modify the legal situation for private parties, it has done so through these changes in national legislation.¹⁶⁷ Thus, TRIPS provides an additional layer of protection for car design.

Although the provisions of the Trademark Law Treaty are not incorporated into TRIPS, there are some similarities between the two.¹⁶⁸ The Treaty harmonizes the national registration of trademarks internationally, which allows manufacturers to register their designs much faster.¹⁶⁹ Article 62 of TRIPS recognizes the same aim, although it applies to all types of intellectual property and not solely to trademarks.¹⁷⁰ Since the United Kingdom and the United States are members of TRIPS and the Trademark Law Treaty, car designers in both nations benefit equally from these additional ways to protect car design internationally.

B. The United Kingdom and Trademark Protection

1. Community Trademark

In 1993, protection of car design through trademark in Europe became much easier when the European Commission established a Community Trademark.¹⁷¹ The Community Trademark Office is located in Alicante, Spain and its purpose is to establish a single market for industrial property.¹⁷²

164. *Id.* at 103. Public international law refers to disputes between WTO members. *Id.* at 104; see also Paul Edward Geller, *Intellectual Property in the Global Marketplace: Impact of TRIPS Dispute Settlements?*, INT'L LAW. 103-04 (1995).

165. CORREA, *supra* note 153, at 3, 104.

166. *Id.* at 104.

167. *Id.*

168. Schmidt-Szalweski, *supra* note 146, at 206.

169. *Id.*

170. *Id.*

171. INTERNATIONAL TREATIES ON INTELLECTUAL PROPERTY, *supra* note 115, at 800.

172. *Id.*

If the Community Trademark succeeds it will unify and integrate trademark registration for car design in the world's largest regionally integrated market, Europe.¹⁷³ As a result, the cost of registering a car design will be reduced due to a centralized application process, which will extinguish the need to hire local agents in each country of the European Union.¹⁷⁴ Moreover, Community Trademark will significantly impact international protection of car designs both within and outside of the European Union because registrants do not have to be citizens of the European Union to register for a trademark.¹⁷⁵ For example, applicants from WTO countries and Paris Convention countries are eligible to apply for Community Trademarks.¹⁷⁶

While the Community Trademark appears to grant greater trademark protection for car design, it may actually decrease protection overall.¹⁷⁷ Opponents of the Community Trademark fear that the large size of the system will make it very difficult to obtain a Community Trademark altogether because a single prior right in any Community country defeats the overall application.¹⁷⁸ Worried prospective users of the Community Trademark, however, may still file under the Madrid Agreement or Madrid Protocol.¹⁷⁹ The Madrid Protocol is most advantageous for car design protection because if a prior right exists in a Member State, registration can be obtained in all other designated countries.¹⁸⁰ In comparison, due to the unitary nature of the Community Trademark, a prior right will completely defeat an application for a Community Trademark.¹⁸¹

As the Community Trademark is relatively new, it is unclear at this point whether the centralized system will aid or hinder the protection of car design through trademark. If a car designer succeeds in protecting his car design through Community Trademark, his design will be protected in the largest unified regional market: Europe. If denied protection through

173. Marshall A. Leaffer, *The New World of International Trademark Law*, 2 MARQ. INTELL. PROP. L. REV. 1, 27 (1998).

174. *Id.* at 27-28.

175. *Id.* at 26.

176. *Id.*

177. *Id.*

178. *Id.*

179. *Id.*

180. *Id.*

181. *Id.*

Community Trademark, a designer can still register the trademark in Europe through systems such as the Madrid Protocol. While trademark protection of car design in the United States appears to be diminishing due to a recent judicial decision,¹⁸² trademark protection in Europe may be increasing, notwithstanding the recent European Court of Justice (ECJ) decision in *Philips Electronics NV v. Remington Consumer Products Limited*,¹⁸³ where the court interpreted the newly implemented Community Trademark Act. If the ECJ's interpretation of the Act is followed in future cases, it may limit the ability for car designers to obtain protection in Europe and the United Kingdom via the Community Trademark.

2. ECJ Interpretation of the Community Trademark Act

In 2001, the ECJ interpreted the meaning of several sections of the Community Trademark Act in *Philips*,¹⁸⁴ one of the first cases to interpret the new Act. In *Philips*, the court was asked to decide whether the shape of functional designs could receive Community Trademark protection.¹⁸⁵ The case involved a shaver developed and trademarked by Philips that comprised "three rotary heads arranged in the shape of an equilateral triangle."¹⁸⁶ Philips marketed and sold the shavers extensively in the United Kingdom.¹⁸⁷ In 1995, the defendant, Remington, began to manufacture and sell razors with three rotary heads arranged in an equilateral triangle.¹⁸⁸

Philips brought a trademark infringement claim against Remington and the trial court revoked Philips' trademark on the grounds that the shaver was "devoid of any distinctive character."¹⁸⁹ The trial court held that the trademark was invalid because the shape of the razor's design was "necessary to obtain a technical result."¹⁹⁰

182. *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 121 U.S. 1255 (2001).

183. Case 299/99, *Philips Electronics NV v. Remington Consumer Products Limited*, 5 E.T.M.R. 509 (2001).

184. *Id.*

185. *See id.*

186. *Id.* at 745.

187. *Id.* at 748.

188. *Id.*

189. *Id.*

190. *Id.*

The ECJ upheld the lower court's decision holding that the shaver's design was merely functional and, therefore, not eligible for trademark protection.¹⁹¹ Philips argued that while the shape of the razor achieved a technical result, the same result could have been reached through other design shapes.¹⁹² Therefore, Philips argued, their design was also non-functional because it did more than merely achieve a technical result. The ECJ disagreed with Philips and held that providing trademark protection on these grounds would allow companies such as Philips to obtain a permanent monopoly over certain technical solutions.¹⁹³

The ECJ's decision to revoke Philips' trademark based on design shape may negatively impact the ability of car designers to obtain similar protection via the Community Trademark in the United Kingdom. The holding in *Phillips* sets a high threshold for design shapes to receive protection via the Act because choosing one of a variety of design shapes is not enough to prove non-functionality under the Act. Thus, after *Phillips*, a British car designer will have to prove that its design goes well beyond technical necessity. While *Phillips* seems to set a high standard for design shape protection, it is important to remember that it is one of the ECJ's first attempts to decipher the newly created Community Trademark. Therefore, it is presently unclear whether future decisions by the ECJ concerning the Community Trademark will further restrict or seek to increase design shape protection for cars.

C. U.S. Trademark Protection

1. The Lanham Act

Enacted in 1946, the U.S. Lanham Act provides trademark protection for car design.¹⁹⁴ The Act has two main objectives.¹⁹⁵ First, the Lanham Act provides for "the distinguishability of goods and services for the protection of the public as well as business."¹⁹⁶ Second, the Lanham Act protects the investment of a car

191. *Id.* at 754.

192. *Id.* at 753.

193. *Id.*

194. See Judith Beth Prowda, *The Trouble with Trade Dress Protection of Product Design*, 61 ALB. L. REV. 1309, 1319 (1998).

195. *Id.*

196. *Id.*

designer's "energy, time and money" from "misappropriation by pirates and cheats."¹⁹⁷

The strongest trademark protection afforded to car designs is provided by trade dress protection under section 43(a) of the Lanham Act.¹⁹⁸ Section 43(a) protects both registered and unregistered marks.¹⁹⁹ Car manufacturers have increasingly invoked section 43(a) to protect the design of their automobiles.²⁰⁰ The Lanham Act provides more protection than patent law because, while patents for car design only receive protection for up to twenty years, a trademark for car design may be protected for a "potentially infinite duration."²⁰¹

To be eligible for trade dress protection, three elements must be satisfied. First, a car design must be "inherently distinctive" or have attained a secondary meaning.²⁰² In other words, the design must be so distinct that the shape of the car alone makes it instantly recognizable to consumers. Second, it must be "nonfunctional."²⁰³ Third, to establish a violation under section 43(a), there must be a "likelihood of confusion as to the origin or sponsorship of the infringer's goods or services."²⁰⁴ The following cases highlight how trade dress protection has been used to enforce and protect car design in the United States.

2. U.S. Case Law

Ferrari S.P.A. Esercizio v. Roberts, Chrysler Corp. v. Silva and Traffix Devices, Inc. v. Marketing Displays, Inc. provide the working framework of trade dress protection for car design under the Lanham Act.

Car design acquires secondary meaning when a consumer can identify the manufacturer of a car through the shape of the car's design.²⁰⁵ Secondary meaning was at issue in *Ferrari* where the defendant manufactured and marketed replica fiberglass Ferrari bodies without the identifying marks. The district court found that the replicas were virtually identical in appearance to the Ferrari.

197. *Id.*

198. *See id.*

199. *Id.*

200. *See id.* at 1320–21 n.51.

201. *See id.* at 1321 n.52.

202. *Id.* at 1322–23.

203. *Id.* at 1323.

204. *Id.*

205. *See id.* at 1322–23.

A survey showed that seventy-three percent of respondents recognized a photograph without the identifying Ferrari mark as a Ferrari.²⁰⁶ The court held that the "unique exterior design and shape of the Ferrari vehicles are their 'mark' or 'trade dress' which distinguish the vehicles' exterior shapes not simply as distinctively attractive designs, but as Ferrari creations."²⁰⁷ Thus, the court ruled that the body design itself was protected under the Lanham Act because it had acquired secondary meaning since people could look at the body and say, "I want that car because it is a Ferrari," and not, "Who makes that car?"²⁰⁸

In *Chrysler*, the court went a step further and held that the body design of a "Viper" was non-functional.²⁰⁹ In 1989, at an International Automobile Show in Detroit, Chrysler debuted the "Viper," an updated version of a 1960's style roadster.²¹⁰ Earlier that year, the defendant built a Mongoose for a customer who wanted a "new look" for his 1979 Chevrolet Corvette.²¹¹ After seeing a prototype of the Viper, the defendant contacted Chrysler and mentioned the Mongoose.²¹² In response, Chrysler demanded that the defendant stop work on the car and destroy it immediately.²¹³ When the defendant refused to comply with Chrysler's demand, Chrysler brought suit.²¹⁴

Pursuant to section 43(a) of the Lanham Act, the district court held that the Viper had acquired "inherent distinctiveness through secondary meaning" and that the trade dress was non-functional and, therefore, entitled to trade dress protection.²¹⁵ Despite this conclusion, the district court dismissed Chrysler's claim because the plaintiff failed to prove the likelihood of confusion between the Viper and the Mongoose.²¹⁶

The appellate court reversed and ordered a new trial because there was substantial evidence of likelihood of confusion between the vehicles, which precluded ruling in the defendant's favor as a

206. *Id.* at 1240.

207. *Ferrari S.P.A. Escercizio v. Roberts*, 944 F.2d 1235, 1240 (6th Cir. 1991).

208. *Id.* at 1240-41.

209. *Chrysler Corp. v. Silva*, 188 F.3d 56, 58 (1997).

210. *Id.* at 57.

211. *Id.* at 58.

212. *Id.*

213. *Id.*

214. *Id.*

215. *Id.*

216. *Id.* at 59.

matter of law.²¹⁷ Both *Chrysler* and *Ferrari* demonstrate that U.S. courts are willing to protect and enforce car design via the Lanham Act where the car's shape is non-functional or has acquired secondary meaning.

Of the three elements of trade dress protection—secondary meaning, non-functionality and likelihood of confusion—defining non-functionality has been the most problematic.²¹⁸ The non-functionality requirement is intended to promote free competition by preventing monopolies of non-patented functional features of products.²¹⁹ These public policy considerations have led U.S. courts to carefully weigh the functionality doctrine of trade dress law against the strict requirements of patent law on functional features.²²⁰ The U.S. Supreme Court addressed the issue of functionality in the landmark decision of *Traffix Devices, Inc. v. Marketing Displays, Inc.*²²¹

In 2000, the U.S. Supreme Court decided *Traffix*, which has helped to clarify the meaning of functionality. In *Traffix*, Marketing Displays, Inc. (MDI) had an expired utility patent on a dual-spring device to keep outdoor signs upright.²²² The utility patent allowed MDI's road signs to remain standing despite heavy winds and was named the "WindMaster."²²³ MDI sued Traffix for trademark infringement for marketing a similar device under the name "WindBuster."²²⁴ MDI also claimed trade dress infringement because the Traffix road signs copied MDI's dual-spring design.²²⁵ The Supreme Court held that the utility patent created a strong evidentiary inference of the design's functionality.²²⁶ MDI was unable to overcome the inference of functionality and did not convince the Court that the design was merely ornamental, incidental or arbitrary.²²⁷ For these reasons, the Court held that the design could not be protected under

217. *Id.* at 58–60

218. Prowda, *supra* note 194, at 1323.

219. *Id.* at 1324.

220. *Id.* at 1325.

221. *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 121 U.S. 1255–63 (2000).

222. *Id.* at 1258.

223. *Id.*

224. *Id.*

225. *Id.*

226. *Id.* at 1260.

227. *Id.* at 1260–62.

section 43(a) of the Lanham Act.²²⁸ Thus, the *Traffix* decision demonstrates the Court's unwillingness to grant both patent and trade dress protection for the same design.

The holding in *Traffix* may ultimately lessen the ability of car designers to obtain trademark protection for their designs in the United States. Until now, the Lanham Act has been the primary basis for granting car design protection.²²⁹ The decision in *Traffix* has reduced the ability of design shapes, such as car design, to receive trademark protection. As a result, the United States appears to be headed in the direction of decreasing protections for car design. Conversely, Europe and the United Kingdom appear to be increasing car design protection, through directives such as Community Trademark and Community Design.

Without knowing the full fallout from *Philips* and its progeny, it is difficult to predict the future of car design protection via trademark in the United Kingdom. Nonetheless, it appears that the United Kingdom provides more ready access to trademark protection than the United States and greater protection than the rest of Europe. In addition, the United Kingdom offers short-term protection for both functional and non-functional unregistered designs.²³⁰ Thus, despite *Phillips*,²³¹ the United Kingdom provides more comprehensive car design protection than the United States. This increased protection is due to new Community Design laws as well as nationally registered and unregistered design protection.

V. PROTECTING CAR DESIGN THROUGH DESIGN LAWS

A. *International Design Laws: The Hague Agreement*

The Hague Agreement protects car design internationally through specific design laws.²³² The Agreement was amended in 1960 to allow for industrial design protection.²³³ This amendment replaced the previous process in which a car design applicant had

228. *Id.* at 1262.

229. *See* Warner Bros. v. Gay Toys, Inc., 658 F.2d 76, 78 (2d Cir. 1981); Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 822 (9th Cir. 1974); Chrysler Corp. v. Silva, 118 F.3d 56 (1st Cir. 1997).

230. *Id.* at 303.

231. Case 299/99, Philips Electronics NV v. Remington Consumer Products Limited, 5 E.T.M.R. 509 (2001).

232. COHEN, *supra* note 1, at 7. Greece is the only Member State that does not have sui generis laws. TRITTON, *supra* note 17, at 239.

233. COHEN, *supra* note 1, at 43.

to file separately with each national office in order to receive multinational protection.²³⁴ Now car design protection is created through a single international application that can be used to file up to 100 different car designs.²³⁵

All designs included in a single application must belong to the same international classification, or *mono-class* as defined by the Locarno Agreement.²³⁶ For example, Class 12 of the Locarno Agreement pertains to vehicles, whereas Class 29 deals with safety and protective devices and equipment for human beings.²³⁷ Thus, a carmaker may not be able to apply for body design and airbag design of a single car in the same application.

The Geneva Act of 1999 is the latest amendment to the Hague Agreement. The Geneva Act initially appears to decrease protection of car design. A closer examination of the new restrictions, however, reveals that car designers will not be affected. First, it adds the additional requirement that applicants habitually reside in the Member State, as well as have nationality, domicile, and real and effective commercial establishment there.²³⁸ Car designers will not have trouble meeting this requirement because automotive companies, such as Rolls-Royce and Jaguar, already have well-established domicile in the United Kingdom.

Second, the Geneva Act requires that in order to apply for several designs in a single application, a "unity of design" must exist.²³⁹ In other words, each separate design must relate to the same creative concept.²⁴⁰

Third, the Geneva Act adds an "optional prohibition for self-designation."²⁴¹ This option allows an applicant who has the ability to file in two or more Member States the right to prohibit one Member State from examining his application.²⁴² This

234. *Id.* at 29.

235. *Id.* at 10.

236. *Id.* The Locarno Agreement, signed on October 8, 1968, establishes international classifications for industrial designs. It is one of the "special unions" of the Paris Convention. See INTERNATIONAL TREATIES ON INTELLECTUAL PROPERTY, *supra* note 115, at 521.

237. *Id.* at 534.

238. *Id.*

239. *Id.* at 52.

240. *Id.* at 66.

241. *Id.*

242. *Id.* The rule was created because Japan receives over 40,000 design patents yearly and if all Japanese applicants had to file in English, the Japanese office would be

amendment gives car designers discretion to limit how many countries examine their application. Thus, this amendment may actually expedite the time it takes to procure protection under the Hague Agreement because car designers will not only be able to select the easiest country to file in but will also be able to exclude examination by countries with lengthier application processes. In addition to international treaties, such as the Hague Agreement, Europe and the United Kingdom also have registered and unregistered design laws that offer British car designers the best form of protection for their designs.

B. *The United Kingdom and Design Law*

1. Statutory Law

In contrast to waning design protection in the United States, Europe has recently proposed Community Design Regulations 93/342 and 93/344 which may increase protection of both registered and unregistered car designs. First, unregistered Community Design will not be subject to registration formalities and will receive protection for three years,²⁴³ whereas registered Community Design of cars may receive protection for up to twenty-five years.²⁴⁴

In addition, car design may receive protection so long as it is "new" and has an "individual character."²⁴⁵ A car design is "new" if no identical design has been made available to the public before the "date of reference."²⁴⁶ A car design is not "new" if its features differ from existing designs by immaterial details.²⁴⁷ For example, unique design shape such as that of the Rolls-Royce or the Chrysler Viper is protectible;²⁴⁸ whereas models like the Honda

overwhelmed and might fail to conduct requisite examinations due to the limited number of examiners proficient in English. *Id.*

243. *Id.*

244. *Id.*

245. *Id.*

246. *Id.* at 243-44. The date of reference for an unregistered Community Design is the date on which protection is claimed or the date on which the design is first made available to the public. *Id.* at 244. The date of reference for a registered Community Design is the date on which the application was filed or the date on which priority is claimed. *Id.* The Paris Convention allows a six-month grace period for persons applying for an industrial design. *Id.*

247. *Id.* at 243.

248. See *Rolls Royce v. Dodd*, 7 F.S.R. 517 (1981).

Accord appear too similar to other cars to receive design protection. Therefore, car design will possess "individual character" if the overall impression it produces on the "informed user" differs significantly from the overall impression produced on such a user by similar designs.²⁴⁹ In assessing individual character the informed user should compare the new design to pre-existing designs to determine the degree of similarity between them.²⁵⁰

The proposed regulations also state that no design protection will be granted for a "technical function [that] leaves no freedom as regards arbitrary features or appearances."²⁵¹ It is unclear at this point whether this clause makes it more or less difficult for car designers to protect features of the design that were chosen arbitrarily, rather than to achieve a desired function.²⁵² As discussed earlier, *Philips* appears to have set a very high standard for designs with a technical function to receive Community Trademark protection. Thus, car designers will have to prove that their designs go well beyond technical necessity in order to receive Community Trademark protection. It is presently unclear, however, whether the new Community Design regulations will set similarly high standards for technical function designs.

The European Parliament recently passed regulations based on these proposals.²⁵³ The new laws provide that registration for Community Design provides protection for five years from the date of application and is renewable at five-year intervals for a maximum of twenty-five years.²⁵⁴ The design right will be administered by the EU Office for Harmonization of the Internal Markets in Alicante, Spain, which also handles Community Trademarks.²⁵⁵ This design right will be integrated into UK law and will soon be available to British car designers seeking protection.²⁵⁶ UK courts have already used copyright, unfair competition, and trademark laws to protect both functional and

249. TRITTON, *supra* note 17, at 244. The Explanatory Memorandum to Community Design Regulation 93/42 specifically states that an informed user is not a design expert. *Id.*

250. *Id.* at 245. Art. 6(3) states "if there is no degree of freedom in the design of a functional item then no Community Design right can subsist." *Id.*

251. *Id.* at 243.

252. *Id.* at 243-44.

253. See McDonald, *supra* note 21, at 470.

254. *Id.* at 470-71.

255. *Id.* at 471.

256. See *id.* at 470-71.

stylistic car design. At this point, it is not clear whether the UK courts will use the new Community Design laws to increase or decrease car design protection.

2. United Kingdom Case Law

In the United Kingdom, copyright and unfair competition laws protect parts of auto designs that cannot be registered. For example, in *British Leyland Motor Corporation Ltd. v. Armstrong Patents Co. Ltd.*,²⁵⁷ the court granted copyright protection for designs pertaining to the spare parts of cars.²⁵⁸ The court held that although exhaust pipes are purely functional articles, which cannot receive patent or registration protection, the replacement parts produced by the defendants were clearly recognizable as copies of the plaintiff's copyrighted drawings.²⁵⁹ Thus, the court used copyright law to protect the design right of spare parts, even though spare parts are purely functional and excluded from registered design protection.²⁶⁰

In *Rolls-Royce Motors Ltd. v. Dodd*,²⁶¹ the defendant attempted to pass off his home-made car as a Rolls-Royce without the manufacturer's consent.²⁶² The defendant constructed the car himself and then adorned it with well-known Rolls-Royce trademarks, such as the Rolls-Royce hood statuette known as the "Spirit of Ecstasy," the words Rolls-Royce, the "RR" monogram, and a Rolls-Royce radiator.²⁶³ The defendant argued that he had never represented the car as being a Rolls-Royce and had built the car in order to advertise his business.²⁶⁴ The court fined the defendant 500 pounds for the fraudulent misrepresentation of his custom-made car as an actual Rolls-Royce and enjoined him from displaying Rolls-Royce trademarks.²⁶⁵

In *Volvo v. Veng*,²⁶⁶ the ECJ held that there was no abuse of a dominant position where the owners of UK registered designs

257. *British Leyland Motor Corp. Ltd. v. Armstrong Patent Co. Ltd.* 1 All E.R. 850 (H.L. 1986).

258. *Id.*

259. *Id.* at 851.

260. *Id.* at 850-51.

261. *Rolls Royce*, 7 F.S.R. at 517.

262. *Id.*

263. *Id.*

264. *Id.*

265. *Id.*

266. Case 238/87, *Volvo A B v. Veng*, 1988 E.C.R. I-6211-13 4 C.M.L.R. 122 (1989).

used them to prevent others from making replacement parts.²⁶⁷ In this case, the manufacturer, Volvo, accused the defendant of infringing its registered design for the front wing body panels of the 200 series Volvo.²⁶⁸ The court determined that Volvo did not abuse its dominant market position by refusing to grant licenses to companies selling spare Volvo parts.²⁶⁹ Thus, the court held that refusing to grant a license to a third party is a valid exercise of the rights granted to the holder of a registered design even though the holder has a dominant position in the market.²⁷⁰

These cases demonstrate that the United Kingdom provides unambiguous protection for registered, trademarked and copyrighted car designs, regardless of whether the designs are functional or stylistic.

C. The United States and Design Law

At present, the United States does not have any laws that deal directly with industrial design protection, apart from design patents.²⁷¹ As previously mentioned, design patents are very restrictive and thus difficult for car designers to obtain because design patents are examined by the U.S. Patent Office and often undergo the same rigorous analysis as normal patents.²⁷² In addition, the U.S. examiner often seeks to invalidate design patents because they are too similar to protected designs.²⁷³ Moreover, prosecuting designs in the United States is generally more costly than in the United Kingdom.²⁷⁴ Thus, design patents are more difficult to obtain than registered and unregistered design protection in the United Kingdom and Europe. The United States has no direct parallel to Community Design laws in Europe or registered and unregistered design laws in the United Kingdom.²⁷⁵ For these reasons, car designers may want to protect their designs in Europe and the United Kingdom rather than in the United States.

267. *Id.*

268. *Id.* at 6213.

269. *Id.* at 6230-31.

270. *Id.*

271. HALPERN ET AL., *supra* note 16, at 21.

272. RICHARD G. GALLAFENT, *INTELLECTUAL PROPERTY LAW AND TAXATION* 31 (1998).

273. *Id.*

274. *Id.*

275. *Id.*

In the past, U.S. car designers have received protection for their work mostly through trade dress laws. Decisions such as *Traffix*, however, appear to have substantially decreased trade dress protection. Meanwhile, the United Kingdom is increasing car design protection by adding registered and unregistered design laws to the list of legal protections already in place, such as trademark and copyright. As mentioned earlier, it is unclear at this point whether decisions such as *Philips* will reduce or increase car design protection through the use of Community Trademark. Nevertheless, it appears that the United Kingdom is emerging as the European country most serious about protecting car design.

VI. CONCLUSION

As the aforementioned case law and summation of U.S. and UK laws demonstrate, car design may be protected more than ever in both Europe and the United States. While section 43(a) of the Lanham Act provides more protection than its European counterparts, Europe's design protection has improved tremendously. Specifically, the newly enacted Community Design and Community Trademark will bolster design protection throughout the European Union. Both directives have greatly expedited the application process by allowing designers to file a single application with the Community Trademark and Community Design headquarters in Alicante, Spain. Also, both allow citizens outside of the European system to file in Europe as long as they are members of WTO countries.

These methods for protecting car design are very recent. European Court of Justice decisions²⁷⁶ may decrease the ability for car designers to receive protection under Community Design. Europe, however, is still fine-tuning these systems and harmonizing them with national laws. As such, it is unclear whether future decisions will increase or decrease car design protection.

As it stands today, Europe still does not provide the degree of design protection afforded by the United States. This is mostly due to the U.S. common law system, which enables the United States to provide design protection on a case-by-case basis. It is

276. E.g., *Philips Electronics NV v. Remington Consumer Products Ltd.*, 38 R.P.C. 745 (2001).

also due to the broad trade dress protection U.S. courts grant under the Lanham Act.

The United Kingdom stands to benefit from both U.S. and European design protection systems. Like the United States, the United Kingdom has a common law system and protects and enforces design rights on an individual basis. Likewise, the United Kingdom benefits from the expedited application systems of the European Union. Furthermore, the United Kingdom offers both registered and unregistered design rights, legal rights that do not presently exist in the United States. Until now, more car manufacturers have used the U.S. judicial system rather than the UK system to protect their designs. The United Kingdom, however, is moving to the forefront and providing more ways than ever to protect car design. Through Community Trademark and Community Design, as well as national protections such as registered and unregistered design right, copyright, trademark and patent, the United Kingdom is poised to provide the most comprehensive design protection in the future.

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* J.D. Candidate, Loyola Law School, 2003; B.A. University of California, Berkeley, 1999. I dedicate this comment to my parents and best friends, Rick and Adrian, whose unconditional love and support have allowed me to reach my dreams. I also want to thank my brother, Jay, and my dear friends, Renata, Mei, Linda and Terry for always believing in me. A special thanks to Michael Zeller for inspiring me to choose this topic, as well as to Professor Andrea Biondi for his insight and advice. I also want to thank the Journal staff and editors, especially Orousha Brocius, for all their hard work and dedication.

