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# Henning Hartwig (ed.), *Research Handbook on Design Law* (Edward Elgar, 2021) 584 pp

Marc D. Mimler

PhD (London) & LL.M. (London)

Senior Lecturer in Law, City Law School; City, University of London

Design law and the academic discourse surrounding this area of Intellectual Property (IP) Law has often stood in the shadows of the trinity of patents, copyright, and trade mark law. Furthermore, many modules on intellectual property law focus largely on teaching the “big three”, while design law is often only taught as an appendix to these. But the ever-increasing importance of designs from a practical side and the value which design objects commercially, aesthetically, and culturally possess, coupled with its intrinsic complexity, has led to ever increasing academic and practical interest. Consequently, it is timely that this volume on design law is added to Edward Elgar’s Research Handbook Series on Intellectual Property that entails fundamental works on the research of intellectual property law. The editor, Henning Hartwig, has been able to assemble a team of leading experts from academia and practice in the field of design law. In his introductory remarks, Hartwig sets the scene by underlining the intrinsic tensions that designs, and design law, embody: Designs are a fusion of practicality and function with artistic expression in design objects. Translating this into the legal sphere, this fusion leads to a crossover of patents, copyright, and branding. The complexity is heightened due to the divergent approaches that countries have taken in devising protection for designs which is well exemplified in the different doctrinal, terminological and practical approaches taken.

Chapter 1 authored by Bernard Volken introduces the subject matter of design rights by horizontally analysing the features of design protection globally. The chapter provides an overview of the elements of design protection, starting from the involved interests of stake holders, over the subject matter of protection, to the scope of protection and procedural matters. In doing so, the author incorporates examples and approaches from Germany, the EU, the US, the UK, New Zealand, Canada and Japan and other jurisdictions by highlighting commonalities and divergent approaches. Particularly interesting was the discussion on the European/EU approach regarding individual character contrasted with that of other jurisdictions where this criterion is “rather unknown”<sup>1</sup> while the US and Japan provide for similar hurdles for design protection in their laws. Additionally, the chapter outlines the *registration versus use* and the *copyright versus patent* approaches that help to understand the conceptual differences of design law on both sides of the pond. The comparative approach taken by Volken’s chapter is a great basis for the other contributions that discuss and analyse more specific issues.

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<sup>1</sup> Bernard Volken, “Requirements for design protection: global commonalities” in Henning Hartwig (ed.), *Research Handbook on Design Law*, (Edward Elgar, 2021) 2-29, 15.

Annette Kur and Ádám György have authored the first chapter within the “Critical Issues” part of this Research Handbook. The topic of spare parts could not be a more suitable starting point for this particular part as it contrasts the divergent interests of the involved stakeholders, i.e., producers, competitors and consumers. The chapter provides a comparative analysis and starts with a discussion on the lack of harmonisation of EU design law regarding spare parts protection. While the Community Design Regulation provides for a repair clause,<sup>2</sup> the Directive only provides for a freeze-plus rule which postpones harmonisation of national laws to a later stage and only requiring EU Member States to “maintain in force their existing legal provisions relating to the use of the design of a component part used for the purpose of the repair of a complex product so as to restore its original appearance.”<sup>3</sup> The chapter mentions recent updates on this matter in countries that have not yet had a repair clause - mostly due to the rejection by the automobile industry. Germany has recently introduced a repair clause in January 2021<sup>4</sup> and the introduction of the proposed repair clause in France is being delayed by a decision of the French Constitutional Court. The authors consequently find that these latest developments in these countries - formerly the two main opponents to the introduction of a repair clause in design law of EU member states – may mean that the overall blockade of the remaining opposing states will “most likely collapse.”<sup>5</sup> The remainder of the chapter outlines the issue in the laws of the United States, Brazil, South Africa, Japan, Turkey, and Australia which provides interesting comparative aspects. The chapter also briefly outlines an assessment of repair clauses under World Trade Organization (WTO) law and discusses their compatibility with the three-step test.<sup>6</sup> A comparative summary critically evaluates the different approaches.

Tracy-Gene G. Durkin’s chapter discusses the increasingly relevant issue of design protection for graphic user interfaces (GUIs). The evolution of the internet of things would mean that GUIs would become more commonplace. Design registrations for GUIs at the European Union Intellectual Property Office (EUIPO) and the United States Patent- and Trademark Office (USPTO) have also increased in the last years. Durkin’s chapter discusses the design protection of GUIs in 4 jurisdictions, namely the United States, China, Japan, and Australia. As to the USA, where protection is also available under copyright, trade mark and trade dress, the chapter focuses on design patent protection and its features and discusses the notorious case of *Apple v. Samsung* in relation to the infringement of the menu page of an iPhone.<sup>7</sup> In China GUIs became protectable as designs/design patents in 2014. Protection is currently limited to those GUIs incorporated within tangible products. This would reduce the scope of protection though a recent amendment permitting to show the GUI on a display screen rather than on the entire product or listing the physical objects on which they can be displayed would alleviate this. Japan has recently amended its design law and now allows protection of

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<sup>2</sup> Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs OJ L 3, 5.1.2002, p. 1–24; Article 110 Nr. 1.

<sup>3</sup> Article 14.

<sup>4</sup> § 40a Gesetz über den rechtlichen Schutz von Design (Designgesetz - DesignG).

<sup>5</sup> Annette Kur and Ádám György, “Protection of Spare Parts in Design Law: A Comparative Law Analysis” in Henning Hartwig (ed.), *Research Handbook on Design Law*, (Edward Elgar, 2021) 304-344, 316

<sup>6</sup> Article 26 (2) Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS).

<sup>7</sup> *Apple v. Samsung*, 909 F. Supp. 2d 1147 (N.D. Cal.2012).

GUIs as a “stand alone”, i.e., without reference to a physical product. Thus, it is now possible to protect GUIs that are displayed on roads or walls. Finally, GUI protection as industrial designs is dubious in Australia as the visual features of a product ought to be assessed at rest, thus rendering GUIs which would not be visible in an unpowered state unregistrable, though some legislative change may come as the author hints. The analysis of these jurisdictions shows a trend towards increased protection of GUIs by design rights. However, there is a different pace between jurisdictions as to whether they could be protected independently from a product or not. The author hopes that this trend continues as new forms of uses in relation to virtual and augmented reality would become more ubiquitous and suggests following the example of Singapore.<sup>8</sup>

In conclusion, Hennig Hartwig’s edited collection is a timely, highly informative, and fundamental contribution to the academic debate on design rights in general, and their surrounding policies and divergent approaches taken in jurisdictions, in particular. In addition to the chapters briefly

outlined here, the collection also discusses other pertinent issues, such as functionality, enforcement, as well as the impact of neuroscience on design law. This breadth of topics and jurisdictions discussed, and its depth of analysis makes the *Research Handbook on Design Law* an invaluable addition to Elgar’s series and IP scholarship at large. It is an indispensable read for all those interested in gaining more and deeper understanding on all pertinent issues of design law and provides a springboard for further research and policy discussions into this exciting field of IP law.

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<sup>8</sup> Tracy-Gene G. Durkin, “Design Protection for Graphical User Interfaces” in Henning Hartwig (ed.), *Research Handbook on Design Law*, (Edward Elgar, 2021) 345-377, 375.