

HARMONIZATION BETWEEN COPYRIGHT PROTECTION AND DESIGN PATENT PROTECTION IN CHINA

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Abstract: For a long time China has followed the policy of not providing copyright protection for protection for works of applied art in order not to provide industrial designs with overlapping protection as it provides design protection under the patent law. The traditional way to distinguish an artistic work from an industrial design is by the separability criterion. But this criterion is not a suitable solution when used for distinguishing the works of applied art and artistic works. The best way is to make an exception for industrial exploitation of artistic works, graphic works and model works is to follow the British copyright law, which grants only twenty-five years copyright protection for such industrially exploited works. If the duration of design patent protection can be extended to twenty-five years - which is the duration of copyright protection for works of applied art - it can not only minimize the negative effect that the overlapping protection may have on the industrial design system, but also save a lot of trouble in distinguishing between industrial designs and works of applied art, thus making China's intellectual property system much more harmonious.

Keywords: design; applied art; patent; copyright; duration of protection

1. INTRODUCTION

Works of applied art are usually protected by copyright law and industrial designs are protected by the industrial design law or patent law but these are overlapping concepts. Countries could protect applied art and industrial designs in two different ways. The first way is to accept the cumulative protection under both copyright law and design law, as most of the industrial designs can also be protected under copyright law. This is the case for example, in the French system. The second way is to avoid extending copyright protection to commercialized industrial designs. This is the case for example in the American, German and UK copyright laws. This paper will discuss the Chinese approach to minimize the overlap between copyright and industrial design.

2. MINIMIZING THE OVERLAP IN USA, GERMANY AND UK

Countries have used different approaches at different points in time to avoid the overlap in protection between copyright and industrial design.

2.1 US: Separability Criterion

The American Copyright Act generally did not, in the past, provide copyright protection for industrial designs. The standard for copyrighting applied art was whether "the shape of a utilitarian article incorporates features such as artistic sculpture, carving or pictorial representation, which can be identified separately and are capable of existing independently as a work of art."¹ This is the "separability" requirement that existed in the past in the American copyright law, which the Copyright Office used based on a then-current Italian approach.²

2.2 Germany: Individuality & Level of Creativity

Both works of applied art and illustrations of a scientific or technical nature can be protected under the German copyright law. The personal intellectual creation is required by Art. 2.2 of the German copyright law for all works. Thus, an individuality test is used in Germany, which means that a work is not merely protected because it represents the author's original effort but because it shows traits of his personality or individuality. The German law required a certain level of individuality or creativity, especially in the field of applied art. This level had traditionally been high with respect to aesthetic (not functional) design (the so-called "Geschmacksmuster"). German law until recently granted copyright protection to objects of design ("applied art") only if these objects were attributed artistic quality substantially above what the ordinary designer is able to produce. Mere design therefore received industrial design protection only.³

2.3 UK: Exception of Industrial designs exploited before 2016

The UK copyright law also protects works of applied art. But a work will only qualify as a work of artistic craftsmanship if it has an element of real artistic or aesthetic quality.⁴ It is important to note that a graphic work (including drawings or plans) is protected irrespective of artistic quality. This has been used to expand the types of subject matter (as distinct from the quality of subject matter) protected as artistic works. More problems arise when objects exclusively commercialized for industrial purpose are protected as artistic works. In recent years, however, the courts have been more willing to use a general sense of what is meant by art to limit the scope of protectable works. At the same time, the now repealed section 52 of the Copyright Designs and Patent Act (CDPA) 1988 was intended to limit the term of copyright protection to twenty-five years as regards artistic works which are

¹ 37 C. F. R. §202. 10 (c)(1959).

² J. H. Raeichman, Design Protection after the Copyright Act of 1976: A Comparative View of the Emerging Interim Model, 31 J. Copyright Soc'y U.S.A. 267, 350-65 (1983).

³ Karl—Nikolaus Peifer, 'Individuality or Originality? Core concepts in German copyright law', GRUN Int., 2014, 1100 at 1101, 1103. This standard has recently abandoned by the Federal Court in the case referring to a wooden children play set under the name "Birthday Train (Geburtstagszug)".

⁴ Cuisenaire v. Reed [1963] VR 719, 730.

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used as the basis for designs which are put into mass production. By doing so, section 52 was intended to prevent copyright from providing a longer term of protection for industrially exploited designs than would be gained via registration as an industrial design. As such, its purpose was to regulate the boundary between the copyright system and the registered design regime.⁵ Thus the mechanism for minimizing the overlapping between copyright and designs was altered and the principle of non-accumulation was changed from a subject-matter exclusion to a defence (or exception).⁶ Prompted by an influential ruling of the Court of Justice of the European Union in 2011,⁷ the UK government felt that s52 was incompatible with the EU Copyright Term Directive and decided to repeal it. Accordingly, from 28 July 2016, all artistic works (whether industrially exploited or not) will have copyright protection for the life of the author plus 70 years.

3. DESIGN PATENT PROTECTION IN CHINA

Industrial design protection in China was initially stipulated in the patent law issued in 1983, according to which industrial designs can obtain protection through registration. In addition, they could also be protected under the copyright law. Though the copyright law issued in 1991 does not specifically provide that works of applied art can enjoy copyright protection, foreign works of applied art are entitled to such protection under international law. Besides, in Chinese court decisions, some works of applied art are often deemed fine arts and protected under copyright law. In general, industrial designs could obtain protection in China.

However, the protection accorded to industrial designs by the patent law and to artistic works by the copyright law overlap with one another. China's IP system tries to minimize the cumulative protection for the same subject matter, and especially tries to avoid copyright protection for industrial designs. On the one hand, China's copyright law does not list the works of applied art as copyrightable subject matter. Thus only the patent law provides protection for new designs of industrial products that are an aesthetic feature of those products. On the other hand, industrial design protection does not extend to mere images irrelevant to the product, which can only seek protection under copyright law, if they fall into the category of fine arts, calligraphy or photography.⁸

3.1 Subject matter for protection

"Design" as mentioned in the patent law means any new design of a product's shape, pattern or a combination thereof, as well as its combinations of colour and the shape or pattern of a product, which is aesthetic and is capable of industrial application.⁹

Industrial design involves such design elements as shape (usually three-dimensional), pattern (usually two-dimensional) and colour or a combination thereof. Shape refers to the design of the moulding of a product, namely the structure and appearance of a product. Pattern means the figure constituted on the surface of a product, but design protection does not extend to mere images irrelevant to the product, which can only seek protection under the copyright law, if they fall into the category of fine arts, calligraphy or photography.¹⁰ Generally speaking, the colour of a product alone cannot be called industrial design, unless it is combined with a shape and/or a pattern or the change per se has formed a pattern. For example, the arrangement of many coloured pieces may constitute a pattern as seen in the guidelines for examiners issued in 2010 (hereinafter Guidelines 2010).¹¹

Though not defined in the patent law, "products" such as handicraft items,¹² agricultural products, livestock products and natural products, which cannot be produced repeatedly, shall not be the carrier of designs,¹³ as the patent law requires all protectable designs be capable of industrial application. Thus, the "products" listed below are definitely excluded from the patent protection prescribed in the Guidelines 2010:

- (1) Any product that cannot be repeatedly made. For example, any fixed building, bridge and the like which depends on their specific geographic conditions and natural products as well.
- (2) Any product which has no fixed shape, pattern or colour because it contains the substance which has no fixed shape, such as gas, liquid or power.
- (3) any component part of the product which cannot be partitioned or sold and used independently, such as the heel of socks, the peak of a hat, the handle of a cup, and so on;

Guideline for Patent Examination 2010[Zhuan-li Shen-cha Zhi-nan], Beijing: Intellectual Property Publishing House, 2010.

⁹ The definition has remained unmodified since the Implementing Regulations of the Patent Law was published in No. 306 decree issued by the State Council on June 15th, 2001. Before 2001, "design" in the Patent Law means any new design of the shape, pattern, colour, or their combination, of a product, which creates an aesthetic feeling and is fit for industrial application.

¹⁰ The Guidelines 2010, section 7.4, chapter 3, part I, Chinese version Page 83, English version Page 99.

¹¹ The Guidelines 2010, section 7.2, chapter 3, part I, Chinese version Page 82, English version Page 98.

¹² Handcraft items which can be produced repeatedly are eligible for design protection.

¹³ The Guidelines 2010, section 7.1, chapter 3, part I, Chinese version Page 82, English version Page 98.

⁵ Lionel Bently & Brad Sherman, *Intellectual Property Law*, Oxford, 1st edition, 2001, p.63, 67, 629.

⁶ Lionel Bently, *The return of Industrial Copyright?* University of Cambridge Faculty of Law Legal Studies Research Paper Series, Paper No. 19/2012, July 2012.

⁷ In Case C-168/09, JUDGMENT OF THE COURT (Second Chamber), 27 January 2011.

⁸ the Guidelines 2010, section 7.4, chapter 3, part I, Chinese version Page 83, English version Page 99, in SIPO of PRC:

(4) in the case of any product consisting of several component parts which have different shape or pattern, if each component part itself cannot be sold and used independently, such component part is not the subject matter under protection of the patent for design. For example, a jigsaw toy consisting of plug-in pieces of varied shape is a patentable subject matter only when one application relating to all the pieces is filed;

(5) Any product which cannot be perceived by the visual sense or be determined with the naked eye, and the shape, pattern or colour of which has to be distinguished by means of specific instruments, for example, a product whose pattern is only visible under an ultraviolet lamp.¹⁴

According to the Guidelines 2010, “the pattern shown when the product is electrified” is ineligible for design patent right so that the pattern on the electronic watch dial, the pattern on the screen of the mobile phone, software interface and the like are not the subject of design protection.¹⁵

However, on March 12th, 2014, the SIPO issued the Decision on Amending the Guidelines for Patent Examination, allowing a product design, e.g. a GUI/Icon, either a stationary pattern or a dynamic pattern, to be registered as design patent. This removed obstacles to granting design patents to software interfaces. The amended Guidelines have, nevertheless, barred patterns shown in game interfaces, as well as product display devices that have nothing to do with the human-computer interaction or realization of a product function, from being registered as design patent. Therefore, graphic layouts of electronic screen wall-paper, start up and shutdown animations, and web pages and the like are still excluded from design protection.¹⁶

It should be noted that in the Guidelines 2010 a GUI/Icon is deemed as a partial design i.e. design of a portion of a product, rather than an independent product. Thus, an applicant, while filing an application for design patent, is required to submit the drawing or photograph of the whole product, because China’s patent law does not provide for the granting of patent protection for partial designs.¹⁷ In this case, partial designs can only seek

protection by adhering to the whole product incorporating it. Hence, the act of partial copying of a design may not be found to be an infringement easily, unless this part of a design occupies a prominent position in the whole product.

This deficiency makes it difficult to seek legal protection for the improvement of partial designs. In order to avoid this problem, the patent law 2008, though insisting on not offering protection to partial designs when it was amended, tried to get a remedy this deficiency by making some modifications in two aspects. First, where an application for a patent for design is filed, a brief description of the design,¹⁸ used for interpreting the design incorporated in the product as shown in the drawings and photos,¹⁹ must be submitted so that the characteristic features of the design, as shown in the drawings or photos, can be illuminated and determined. Thus, in the trial of a design infringement case, the court can focus its attention on the essence or key points of the design. Those who have copied these key points will find it hard to avoid infringement liability. Second, a patent application for two or more similar designs, ten at most, of the same product may be filed as one application,²⁰ so that the applicant may resolve some innovations in the design of the product into several designs which may obtain protection at the same time. In this way, infringement can be effectively prohibited.²¹

Pursuant to the Guidelines 2010, as far as a design with a three-dimensional product is concerned, if the essential features of the design incorporated in the product involve the view of one side or several sides only, with the view of the other sides omitted, the applicant shall submit orthographic projection view and space diagram of the side/sides concerned. Besides, it is still necessary to submit a three-dimensional picture of the design incorporated in the whole product and indicate the reason of the omission of the view in the brief explanation.²²

In this regard, Yin Xintian, former Director General of the Department of Legal Affairs of the SIPO, holds that the above-mentioned stipulations in current patent law are adequate to meet the need for partial design protection and in order to avoid pushing it to the extreme, we need to think carefully about whether to grant protection to partial designs.²³

Pursuant to Article 2 of Draft Amendment to the Patent Law for Review, released by the SIPO on December 2

¹⁴ The Guidelines 2010, section 7.4, chapter 3, part I, Chinese version Page 83, English version Page 99.

¹⁵ The Guidelines 2010, section 7.4, chapter 3, part I, Chinese version Page 83, English version Page 99.

¹⁶ SIPO: *the Decision on Amending the Guidelines for Patent Examination (No. 68)*, available at: <http://www.sipo.gov.cn/zwgg/il/201403/t20140314916952.html>.

¹⁷ The Guidelines 2010, section 7.4, chapter 3, part I, Chinese version Page 83, English version Page 99-100. In accordance with the Guidelines 2010, the designs listed as follows are ineligible for design patent protection: (1) any component part of a product which cannot be partitioned or sold and used independently; (2) in case of any product consisting of several component parts in different shape or pattern, if each component part itself cannot be sold and used independently,

such component part is not the subject matter under protection of design patent.

¹⁸ Article 27 of the Patent Law 2008.

¹⁹ Article 59 of the Patent Law 2008.

²⁰ Article 31.2 of the Patent Law 2008, Article 35.1 of the Implementing Regulations of the Patent Law.

²¹ Yin Xintian: *Introduction to the Patent Law of China* [Zhong-guo Zhuan-li-fa Xiang-jie], Beijing Intellectual Property Publishing House, 2011, Page 653-4.

²² The Guidelines 2010, section 4.2, Chapter 3, Part 1, Chinese version Page 74, English version Page 88-9.

²³ See n. 21, 654-6

2015, the definition of design has covered the design of a portion of a product,²⁴ the purpose of which is mainly to curb the act of copying partial designs of a product or products by simple combination and substitution.²⁵ Once the proposed modification is adopted in the patent law, Item 3 and Item 4 in Article 7.4 of the Guidelines 2010²⁶ will be subjected to omission or modification accordingly. Hence, the scope of protection can be extended to a product or component parts of a product that cannot be sold or used independently. However, according to Item 5 in Article 7.4 of the Guidelines,²⁷ component parts of a product shall not obtain design patent protection unless it can be perceived by the visual sense of the user in ordinary use.

The SIPO takes a negative attitude to granting design protection to typefaces. Though the Guidelines 2010 do not explicitly exclude the appearance or typefaces of words and numbers²⁸ from design protection, in practice, the SIPO has never deemed typographic typefaces patentable. So far there have not been any examples of granting design protection to typographic typefaces. The main reason lies in the fact that though the Chinese character “产品” (Chan-Ping) has been translated into a “product”²⁹ in the official English version of the Guidelines, it does not mean that “product” is different from “article” in meaning. Hence, in practice, according to China’s patent law, a patentable subject matter must be the design of an article. Since a

typographic typeface does not look like an independent article, the design thereof cannot qualify for design patent protection but can turn to copyright law for copyright protection as a work of calligraphy or fine arts, as it is aesthetically creative.

Irrespective of its shape, any two-dimensional product shall be deemed to be a design of patterns, colours or the combinations thereof. Where two-dimensional products refer to printed goods, for example, wine bottle labels or food wrapping paper, not serving merely as ornamental design, but mainly as indicators of the source of goods, no design patent right can be granted largely in order to avoid overlapping protection of two-dimensional designs. So printed goods indicating the source of goods can be protected under Trademark Law or Anti-Competition Law, whereas designs of wall paper and textile patterns can still be granted patent rights.³⁰

3.2 Duration of Protection

Since the Paris Convention does not prescribe the duration of design protection, in China’s patent law 1984 it is provided that the duration of patent right for designs shall be 5 years and patentees can be expected to prolong its duration by another 3 years by filing an application before the expiration of its duration. Thus, the duration amounts to 8 years.³¹ During the amendment of the patent law, considering that in the TRIPS Agreement, negotiated at the end of the Uruguay Round of multilateral trade negotiations under the GATT, the duration of industrial design protection available must amount to at least 10 years,³² it was provided that the duration of patent right for designs shall be 10 years in Article 45 of China’s patent law 1992. However, there was no provision for further prolongation.

On the other hand, during the amendment of the patent law in 1992, one fact was missed that the copyright law 1991 did not grant copyright protection to works of applied art. Therefore, if works of applied art were granted protection only under the patent law, 10 years was still far from enough, because, as provided in the Berne Convention, the duration of protection should be at least twenty-five years. Besides, questions arose as to how works of applied art would be protected if they were not registered as design patents. This, in particular, did not conform to the requirement regarding works of applied art in the Berne Convention, namely that *if no such special protection is granted in that country, such works shall be protected as artistic works* (emphasis added).³³

²⁴ Legislative Affairs Office of the State Council: *Soliciting Public Opinions on the Draft Amendment to the Patent Law for Review*, available at: http://www.sipo.gov.cn/ztl/ywzt/zlfgqssxzdsxcg/xylzlfhg/201512/t20151202_1211994.html

²⁵ SIPO: *Explanations of Opinions on the Draft Amendment to the Implementing Regulations of the Patent Law of the People’s Republic of China*, http://www.sipo.gov.cn/ztl/ywzt/zlfgqssxzdsxcg/201504/t20151401_1095942.html, April 1st, 2015

²⁶ The Guidelines 2010, section 7.4, Chapter 3, Part 1, Chinese version Page 83, English version Page 100; 7.4 Non-patentable Situations for Design Patent According to Article 2.4, the following situations are ineligible for patent protection for design:

(3) any component part of the product which cannot be partitioned or sold and used independently, such as the heel of socks, the peak of a hat, the handle of a cup, and so on; (4) in the case of any product consisting of several component parts which have different shape or pattern, if each component part itself cannot be sold and used independently, such component part is not the subject matter under protection of the patent for design. For example, a jigsaw toy consisting of plugin pieces of varied shape is a patentable subject matter only when one application relating to all the pieces is filed.

²⁷ The Guidelines 2010, section 7.4, Chapter 3, Part 1, Chinese version Page 83, English version Page 100; Non-patentable Situations for Design Patent (5) any product which cannot be perceived by the visual sense or be determined with the naked eye, and the shape, pattern or colour of which has to be distinguished by means of specific instruments.

²⁸ The Guidelines 2010, Section 7.4.10, Chapter 3, Part 1, the pronunciations or meanings of the words and numerals shall not be the contents of design protection.

²⁹ The Guidelines 2010, section 7.1, Chapter 3, Part 1, Chinese version Page 82, English version Page 98.

³⁰ The Guidelines 2010, section 6.2, Chapter 3, Part 1, Chinese version Page 81-82, English version Page 97;

³¹ Tang, Zongshun : *Textbook of Patent Law*, Beijing: Law Publishing House, 2003, p. 193.

³² TRIPS, Article 26.3.

³³ Article 2(7) of Bern Convention : Subject to the provisions of Article 7(4) of this Convention, it shall be a matter for legislation in the countries of the Union to determine the extent of the application of their laws to works of applied art and industrial designs and models, as well as the conditions under

Therefore, in December 1992, the State Council issued a decree on the "Implementation of International Copyright Treaties" to give copyright protection to foreign owners of works of applied art so that they could be protected under the copyright law even if they were not registered as a design patent. In this way, the requirement concerning works of applied art in the Berne Convention was fulfilled insofar as foreign owners. According to the decree, the term of such copyright protection shall last until the end of a period of the twenty-five years from the making of the work, which is the minimum term as required in the Berne Convention.³⁴

There is evidently some bias against Chinese nationals who create works of applied art and industrial designs in such a system. First, some of the two-dimensional and three-dimensional industrial designs created by Chinese nationals are not entitled to copyright protection if they were not registered as a design patent. Second, where the Chinese nationals' works of applied art and industrial designs obtained design protection, the term would only last 10 years, while the term of copyright protection for foreign works of applied art lasts twenty-five years even if they are not registered as design patents.

With this in mind, an amendment to China's copyright law was drafted in 2014 that gave a comprehensive prescription for granting copyright protection to works of applied art to deal with this problem concerning lack of copyright protection for some Chinese national industrial designs in absence of registration as design patents. Besides, the amendment adopted some ideas prescribed in the decree of Implementation of International Copyright Treaties by making some specific stipulations for the duration of the protection for works of applied art: for example that the term of copyright protection for works of applied art shall last until the end of a period of the twenty-five years from the first making of a work. Though such legislative proposals regarding protection for works of applied art have eliminated bias against Chinese national works of applied art and industrial designs, deeper problems remain.

What if works of applied art officially become the subject matter protected under China's copyright law? Will China, like France, put the same works of applied art or designs under the overlapping protection both of copyright law and of design patent? Or will China, like the US did in the past, make a strict differentiation between the subject matter of copyright protection and

that of the design patent protection? In the case of the former, perhaps the term of design patent protection – that now lasts only 10 years – could be extended by another 15 years to a total of twenty-five years, in line with the objective of China joining the Hague Agreement Concerning the International Registration of Industrial Designs in the future.³⁵ However, if those works that are not registered as design patents in China can nevertheless enjoy copyright protection for twenty-five years automatically, the system of design patent would be devalued a great deal. In the case of the latter, it will be a tough problem for courts to distinguish works of applied art from design effectively. In addition, in China's copyright law, there is a difference between the term of protection for works of applied art, which is twenty-five years, and that for artistic works, which is 50 years after the death of the author. Chinese judges will have to work out standards to distinguish designs, works of applied art and artistic works, which is probably a demanding and challenging task that the judges in other countries have not needed to do.

In any case, after works of applied art officially become the subject matter of protection under China's copyright law, it is necessary to eliminate the difference between the term of protection for works of applied art and that for industrial designs. If the duration of design patent protection can be extended to twenty-five years as the duration of copyright protection for works of applied art, it will save a lot of trouble in distinguishing industrial designs and works of applied art, thus making the system of China's intellectual property much more harmonious.

4. COPYRIGHT PROTECTION FOR APPLIED ART IN CHINA

4.1 Development of protection for applied art

As noted earlier, Art. 5(9) of the draft of third amendment of China's copyright law has added works of applied art as a copyrightable subject matter in China whether it is from a domestic or from a foreign creator.³⁶ It seems that the Chinese law has given up the non-accumulation policy of protection and changed to a system where artistic designs may be protected both in copyright law and in patent law. But the most important point is that, according to paragraph 3 of Article 29 of the draft Act, the term of protection accorded to works of applied art is only twenty-five years, which is the same as that described in the decree of "Implementation of International Copyright Treaties" for foreign creators. This means that even if artistic designs are protected

which such works, designs and models shall be protected.

Works protected in the country of origin solely as designs and models shall be entitled in another country of the Union only to such special protection as is granted in that country to designs and models; however, if no such special protection is granted in that country, such works shall be protected as artistic works.

³⁴ Article 7(4) of Bern Convention : It shall be a matter for legislation in the countries of the Union to determine the term of protection of photographic works and that of works of applied art in so far as they are protected as artistic works; however, this term shall last at least until the end of a period of twenty-five years from the making of such a work.

³⁵The Legal Affairs Office of State Council: Invite public opinions on the drafted amendment of the Patent Law, 2015, available at :

http://www.sipo.gov.cn/ztl/ywzt/zlfjqssxzdsxg/xylzfxg/201512/t20151202_1211994.html

³⁶ Art. 5 (9) of the drafting 3rd amendment of China's copyright law, published in June, 2014, http://www.chinalaw.gov.cn/article/cazjgg/201406/201406003_96188.shtml

under China's copyright law in the near future, they still enjoy a different level of protection from that of the works of fine art.

It is correct that the artistic designs are protected as a work of applied art in the copyright law. The shorter term of copyright protection is also a better choice for commercial industrial designs, even though they have aesthetic or artistic significance. Therefore, the draft of the third amendment of China's copyright law likely finds a good approach to minimize the cumulative protection for the applied arts and designs and models. But there are still some deep-seated and unresolved problems in such an approach.

4.2 Separability criterion

The draft of the third amendment gives a broad definition of works of applied art. It refers to two or three dimensional shapes of artistic works with both utility features and aesthetic significance such as toys, furniture and jewellery and so on. This definition combined with the separability criterion may give rise to some problems.

Chinese courts have traditionally protected applied art as a work of fine art if its aesthetic significance can be separated from the utility feature (for example, beautifully designed wall paper³⁷). It is not clear whether such applied art can still be protected as an artistic work and enjoy the longer-term protection under the new draft copyright law. If the answer is yes, while another work of applied art that does not meet the requirement of separability (for example, vases with beautiful shape³⁸) can only be protected as a work of applied art and thus enjoy the shorter-term of protection, it will result in different terms of copyright protection in China for works of applied art. This does not appear to be reasonable.

Worse still, the standard of the separability test is not actually clear enough to decide what a work of applied art is. The American scholars often criticize the "separability" criterion as being unclear, impossible to carry out, arbitrary, and subject to manipulation.³⁹ While the physical separation test reflects a narrow, literal interpretation of the statute, the conceptual separation test is broader and it has enabled the courts to circumvent the legislative intent and to withhold the copyright protection given for artistic works (fine art) from industrial designs. The separability criterion is problematic from both a practical and theoretical point of view. For example, can a vase with beautiful shape be conceptually separated from the object? According to the explanation of the National People's Congress (NPC), if it is not capable of being separated, it can only be

applied art. Thus it cannot be protected as artistic works (fine art) and enjoy the longer-term protection. But some courts may think that it can be conceptually separated and may be protected as artistic works. Such contradictions may arise in interpreting the amended law.

In fact, even applying the separability criterion as learned from past US practice, it has a different function in China. The American courts used it as a standard to decide whether a design can be protected under the Copyright Act, while the Chinese courts use it as a standard to decide whether a design is an artistic work or a work of applied art. A design not meeting the requirement of the separability criterion would have been excluded from copyright protection altogether in the US. Though it sounds reasonable, when China's copyright law does not protect the works of applied art, it has the same result as under the past American law. This means in effect, "no separability, no copyright protection". But the answer will not be the same as in the past American Law even after China's copyright law protects works of applied art as it means that both the separable artistic works and the un-separable works of applied art enjoy copyright protection in China. If the works of applied art (not meeting the requirement of separability) will also be protected in the copyright law, avoiding the overlap between copyright law and patent law will become a problem. Maybe the requirement of artistic quality or level of creativity has to be added to the works of applied art in order to exclude the design without artistic quality or creativity to enjoy the copyright protection.

4.3 The requirement of artistic quality or level of creativity

In practice, even when China's copyright law excluded the protection to applied art which does not meet the requirement of separability, some Chinese courts still tried to protect such designs as artistic works if, in their judgement, it met the requirement of originality. For example, in the case *JIN-YING Furniture Company v. CHANGFENG Furniture Company*, GUILIN Intermediate Court held that the furniture with a unique shape designed by the plaintiff could be protected as an artistic work as it was an original design.⁴⁰

In the above case, neither the separability criterion nor the level of creativity or artistic quality was considered. If this judgment is followed by other courts in China, there will be no difference in protection between artistic works and works of applied art. Thus the shorter-term protection for the applied art will be meaningless in China. Though we agree that the separability should not be a requirement to protect artistic designs under copyright law, such protection should not extend to any industrial design and therefore new requirements, such

³⁷ NPC : Explanation of the copyright law of the People's Republic of China, http://www.npc.gov.cn/npc/flsywd/minshang/2002-07/15/content_297588.htm.

³⁸ *id.*

³⁹ Paul Goldstein, Copyright, Principle, Law and Practice, Little Brown and Co., 1989, §2.5.3(b)-(C)

⁴⁰ GUILIN Intermediate Court supported the copyright protection to furniture, at SIPO Website : http://www.sipo.gov.cn/albd/2012/201203/t20120308_649006.html, 8 March, 2012.

as artistic quality (like in British Law) and level of creativity (like in German Law), should also be added to consistently realize the shorter-term protection for the works of applied art in China.

In the case of *LEGO AG. v Xiao-Bai-Long Co.*⁴¹, the Supreme Court ruled that, “This design does not give the toy building blocks involved enough aesthetic uniqueness, accordingly, the toy building blocks do not meet the requirements of originality for copyright protection to the artistic work”. From this ruling, we can conclude that the work of applied art must meet the requirement of artistic or aesthetic quality to enjoy the copyright protection. While the Chinese Supreme Court did not use the separability criterion but required aesthetic quality in the LEGO case, the meaning of aesthetic quality is not clear. We find that neither artistic quality nor level of creativity are clear standards to separate works of applied art from industrial designs in China.

4.4 Protection for a graphic work

Copyright was permitted to subsist in drawings even though those works had been, or could be, registered as designs. China’s copyright law also protects “Graphic works such as diagrams of project design, drawings of product design, maps and sketches as well as works of their model”⁴² without the requirement of artistic quality. Thus, some designs cannot enjoy protection as artistic works but can enjoy the protection as graphic works or model works in China.

For example, in case of *JIAN-SHI Fighter*⁴³, the Beijing High Court ruled that the design of the shape of JIAN-SHI fighter is not an artistic work (fine art) because it did not meeting the requirement of separability, but it was found to be a copyrightable three-dimension representation of the fighter because it was original.⁴⁴ According to this judgment, even such designs that merely serve as a blueprint for construction purposes, are protected under copyright. This will lead to cumulative protection of copyright and design patents.

Problems arise when objects exclusively used for an industrial purpose to achieve commercial ends are protected as artistic works for more than 50 years. Even

a work of applied art only enjoys twenty-five years copyright protection; more than 50 years of copyright protection for a technical drawing or product shape may be too long.

However, UK copyright law found a solution to minimize this overlap. As noted earlier, section 52 of the CDPA 1988, now deleted, continued the policy - until recently - of one that was introduced in 1956 of providing a defence where a copyright work had been “applied industrially”. That is to say, where copies of an artistic work, with due authorization, have been industrially made (i.e. more than 50 copies have been made) and then marketed, protection ends after the end of twenty-five years in which the licensed copies were first marketed. Thus it is not an infringement to copy such an artistic work so as to “make articles of any description” and indeed, “anything may be done in relation to articles so made, without infringing copyright in the work. Section 52 is, in substance, a limitation on the term of protection for copyright (only twenty-five years’ protection). After that term lapses, the remaining copyright can only be asserted against copyright other than on the articles.

Although China’s copyright law also tried to limit the term of protection for works of applied art to twenty-five years, it is very difficult to judge what kind of design belongs to a work of applied art but not to an artistic work. The now deleted section 52 of CDPA 1988 may be a better way to limit the term of protection for industrial design, although it can also be protected as a work of applied art because it is easy to find out that whether a work has been industrially applied to an article or not.

5. CONCLUSIONS & SUGGESTIONS

For a long time China had followed a policy avoiding copyright protection to industrial designs as it did not protect works of applied art and most creators of designs would seek design (patent) protection. Even if the copyright law will now protect both foreign and domestic works of applied art, the legislators do not want to provide the same term of protection as for other artistic works, but only twenty-five years to meet the minimum requirements of the Berne Convention. This policy is generally reasonable and acceptable.

But the specificities of this Chinese policy have also brought to the fore some difficult problems in rule making and in implementation. Since China’s copyright law only gives works of applied art a shorter term of protection relative to other artistic works, it is important to distinguish the works of applied art and artistic work clearly. Certainly it is also important to distinguish the works of applied art and industrial design. The traditional way to distinguish applied art and industrial design is the separability criterion, which was earlier applied in the US. Even after works of applied art are protected by China’s copyright law, this criterion would not help distinguishing between these two types of works. The requirement of artistic quality in British law, or the level of creativity should also be considered in the

⁴¹ Min-Shen-Zi (2013) No.1345, The Supreme People’s Court of China, available at: http://ipr.court.gov.cn/zgrmfy/zzqhlq/201312/t20131226_186079.html

⁴² Art. 10 (9) of China’s copyright law.

⁴³ Gao-Min-Zhi-Zhong-Zi (2014) No.3451, Beijing High People’s Court, Feb. 5, 2015, available at : http://toutiao.com/a6190686910367564034/?app=news_article#6649976-tsina-1-11500-4471e2b057b5019ad452c722f04bba39

⁴⁴ In German Law, such design must meet the requirement of own creative achievement (or “own intellectual creation”). This means that technical drawings etc. which do not bear the “stamp of the author’s personality”, but merely conform to the necessity of representing an article so that it can serve as a blueprint for construction purposes, are not protected under copyright.

copyright protection for applied works of art in order to exclude copyright protection for the works without artistic quality or certain level of creativity. As to the technical drawings or models for a product, the so-called graphic or model works in China, it is impossible to only give them twenty-five years protection like the applied art which is allowed by the Berne Convention; it is also not reasonable to say that three-dimensional copying of the technical drawing is not an infringement of the exclusive right of reproduction.⁴⁵ The best way is to make an exception to copyright protection for industrial exploitation of the graphic works and model works, like the British law did until recently, where only twenty-five years copyright protection is given for such industrially exploited works.

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⁴⁵ It is a popular idea within the Chinese scholars.