

Response to WIPO Consultation on Issue 11 Designs: Authorship and Ownership¹

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WIPO, in recognition of the rapid development and deployment of AI technology, issued a public consultation to seek for measures to encourage technological innovation.²

Designs rights are to protect the visual appearance of products. Designs rights may overlap with other IP rights, such as Copyright.³ WIPO defines industrial designs as

‘In a legal sense, an industrial design constitutes the ornamental aspect of an article. An industrial design may consist of three dimensional features, such as the shape of an article, or two dimensional features, such as patterns, lines or color’.⁴

WIPO design rights are protected in each Contracting State. According to Paris Convention for the Protection of Industrial Property (1883), industrial designs protection ‘may not be forfeited on the ground that articles incorporating the design are not manufactured in that State’.⁵ Other international legislations, such as Hague Agreement Concerning the International Registration of Industrial Designs (1925) and Locarno Agreement Establishing an International Classification for Industrial Designs (1968), provide registration rules on design rights.

In 2018, the European Union also recognised the need for accessible, modern, effective and consistent legal protection for design rights in the EU. As a result, in order to encourage technological innovation through design protection, the European Commission (EC) conducted a public consultation on design protection between 18 December 2018 and 31 March 2019 in a view to assess the appropriateness of legislative measures for design rights protection in the EU.⁶ There are several areas that this consultation sought for comments:

Duration of designs rights protection: one of the purposes of this consultation was to review the adequacy of the current 3 years term protection for unregistered

¹ This work is prepared by Dr Faye. F. Wang, Senior Lecturer in Law, Brunel University London. This response is a further update for WIPO on Wang’s response to the EU Consultation on Designs Protection in 2019, which was published - ‘Consultation on Design Protection in the EU: Questionnaire Commentary’ (March 2019) Issue 115 *Journal of Intellectual Property Forum*, p.99-102. **I am making this submission personally.**

² ‘WIPO Begins Public Consultation Process on Artificial Intelligence and Intellectual Property Policy’, PR/2019/843, 13 December 2019, available at https://www.wipo.int/pressroom/en/articles/2019/article_0017.html (last accessed 6 February 2020).

³ Gannon Solicitors (2017) ‘Design Right’ 5 April 2017, available at <https://www.gannons.co.uk/insights/design-rights/> (last accessed 6 February 2020).

⁴ ‘Industrial Designs’, WIPO, available at <https://wipo.int/designs/en/> (last accessed 6 February 2020).

⁵ ‘Summary of the Paris Convention for the Protection of Industrial Property (1883)’, WIPO, available at https://www.wipo.int/treaties/en/ip/paris/summary_paris.html (last accessed 6 February 2020).

⁶ ‘Public Consultation: Evaluation of EU legislation on design protection’, European Commission, 18 December 2019, available at https://ec.europa.eu/info/law/better-regulation/initiatives/ares-2018-3527248/public-consultation_en (last accessed 6 February 2020).

Community design and 25 years term protection for registered Community or national design.

Spare parts designs protection: with regard to spare parts protection, it is known that spare parts are currently not protected by the Design Directive and Community Design Regulation, though the majority of Member States include spare parts protection in their national laws. The consultation questionnaire provides a definition of 'spare parts' as '...concern visible component parts used for the purpose of the repair of a complex product (such as a motorcar) so as to restore its original appearance (covering, in particular, body panels, integrated lighting and automotive glass).'⁷ It seeks for answers as to whether lack of harmonised rules concerning spare parts protection has caused any issues and that whether the rules on spare parts protection should be harmonised in the EU.

Novelty examination: the consultation seeks for views on whether the EUIPO should conduct novelty examination even though there are complexity and technical constraints in searching for prior existence on designs (both registered and unregistered) worldwide.⁸

Measures to new emerging technologies: the consultation seeks to evaluate three key elements in the legislation and its application by industrial property offices and in courts. They are: a) the definition of a "design", a "product" and a "complex product"; b) the requirements for protection (e.g. related to the need of being "visible"); and c) the scope of design protection (e.g. as to how to determine the individual character of a design).⁹ The consultation tries to establish whether the current design protection legislation is sufficient to cover new emerging technologies such as 3D printing.¹⁰ It also looks into whether the scope of design rights should interfere with prevention of transiting counterfeit design goods through the Union territory.¹¹ Furthermore, the consultation continues looking into the impact on new technologies on the representation of designs, i.e. whether the current legislation is appropriate in terms of the requirements for representation of designs for both tangible products and non-tangible products (e.g. animated designs and graphical user interfaces).¹²

WIPO public consultation particularly asks for comments on authorship and ownership in AI-generated designs.¹³ It is understood that some AI applications can generate designs independently, which are to be considered as 'AI-generated designs'; whereas other AI

⁷ Public Consultation: Evaluation of EU legislation on design protection - Questionnaire, p.14.

⁸ Public Consultation: Evaluation of EU legislation on design protection - Questionnaire, Q.31.

⁹ Public Consultation: Evaluation of EU legislation on design protection - Questionnaire, Q.39.

¹⁰ Public Consultation: Evaluation of EU legislation on design protection - Questionnaire, Q.40.

¹¹ Public Consultation: Evaluation of EU legislation on design protection - Questionnaire, Q.41.

¹² Public Consultation: Evaluation of EU legislation on design protection - Questionnaire, Q.43. Related questions are Q.44-47.

¹³ 'Draft Issues Papers on Intellectual Property Policy and Artificial Intelligence' prepared by the WIPO Secretariat, WIPO/IP/AI/2/GE/20/1, 13 December 2019, available at https://www.wipo.int/edocs/mdocs/mdocs/en/wipo_ip_ai_ge_20/wipo_ip_ai_2_ge_20_1.pdf (last accessed 6 February 2020).

applications can only assist in generating designs, which are to be considered as AI-assisted designs, a variant of computer-aided design.¹⁴ The roles and functionality of an AI application for generating designs, either as a human assistant or as an independent generator, need to be further clarified. Presuming that for the purposes of this consultation, an 'AI application' means stakeholders' deploying AI technology to create and invent designs for their products partly or solely. In this regard, WIPO did not anticipate any legal complications for AI-assisted designs, but it mainly raises concerns over legal challenges over AI-generated designs: a) whether AI-generated design can be automatically granted design protection; b) whether there is need for special regulations if a human contributes to AI-generated design process; c) whether there is need for specific legal provisions to regulate the authorship and ownership for AI-generated designs.¹⁵

AI-generated designs protection may share similar challenges as 3D replica designs protection. The creation and distribution to the public of a 3D replica may be at risk of infringing design rights.¹⁶ 3D printing's digital design protection may relate to protection of printed objects with different textures or functions as to the original objects. Such printed objects may be newly designed with individual character which was produced by designers in 3D files. Such designed objects are not simple 3D replicas. It raises legal concerns as to whether the creation of new 3D files replicating an existing third-party design can be deemed as an infringement of design rights.¹⁷ The same situation may apply to any AI-generated designs. The creation of AI-generated designs involves a great number of stakeholders, such as AI machine owner and producer, as well as AI software owner and writer. The ownership and authorship of AI-generated designs cannot be determined automatically but should be assessed on a case-to-case basis.

In addition, there are two types of designs rights protection, registered and unregistered. Regarding registration of designs, it may not be feasible for the law to grant AI-generated designs automated registration due to the complexity of determination and attribution of authorship and ownership for AI-generated designs.

Regarding whether AI-generated design can be granted design protection, it has to be considered whether a **skilled, intentional act** was required to generate the design. For example, a design created from a carefully constructed AI algorithm, fed with appropriate data for a specific purpose, might qualify for design protection. However, if there is an AI application publicly available and accessible, users may be able to input requests (such as shapes and materials) into the AI application, so that the AI application will be able to

¹⁴ 'Draft Issues Papers on Intellectual Property Policy and Artificial Intelligence' prepared by the WIPO Secretariat, WIPO/IP/AI/2/GE/20/1, 13 December 2019, available at https://www.wipo.int/edocs/mdocs/mdocs/en/wipo_ip_ai_2_ge_20/wipo_ip_ai_2_ge_20_1.pdf (last accessed 6 February 2020).

¹⁵ *Ibid.*

¹⁶ Wang, F. (2019), 'Consultation on Design Protection in the EU: Questionnaire Commentary', (March 2019) Issue 115 *Journal of Intellectual Property Forum*, p.101.

¹⁷ "3D bio-printing for medical and enhancement purposes: Legal and ethical aspects", European Parliament, 07.2018, p. 9, available at [http://www.europarl.europa.eu/RegData/etudes/IDAN/2018/614571/EPRS_IDA\(2018\)614571\(ANN2\)_EN.pdf](http://www.europarl.europa.eu/RegData/etudes/IDAN/2018/614571/EPRS_IDA(2018)614571(ANN2)_EN.pdf) (last accessed 6 February 2019).

autonomously generate a design in response to the request. The ownership of such AI-generated design will be debatable and should be assessed individually.

As such, specific legal provisions to regulate the ownership of independently (autonomously) generated AI designs appear to be most sensible to increase legal certainty, though such legal provisions should allow private agreements concerning the attribution of authorship and ownership.

Furthermore, specific legal provisions for AI-generated designs and AI-assisted designs should take into consideration designs involving technical functions. The rigid requirement of non-functionality in designs law may not be appropriate in a digital world where most designs purposefully and skilfully merge functional and aesthetic elements to display new and individual characters. There is need to have a balanced assessment of non-technical functions in design protection requirements to prevent technological monopolies through design rights in the current legislation without jeopardising innovation of modern designs. Take the current EU legislation as an example, currently, Recital (10) of the Community Design Regulation provides [with emphasis]:

*Technological innovation should not be hampered by granting design protection to features dictated solely by a technical function. It is understood that this does **not** entail that a design must have an **aesthetic quality**. Likewise, the interoperability of products of different makes should not be hindered by extending protection to the design of mechanical fittings. Consequently, those features of a design which are excluded from protection for those reasons should not be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection.*

According to Article 8(1) of the Community Design Regulation, a Community design shall not subsist in features of appearance of a product which are solely dictated by its technical function.¹⁸ In the light of the recent case of *Doceram GmbH v CeramTec GmbH*, Article 8(1) of the Community Design Regulation together with its Recital (10) intends to “prevent technological innovation from being hampered by granting design protection to features dictated solely by a technical function of a product”.¹⁹ It was held that Article 8(1) of the Community Regulation 2002 on Community designs must be interpreted as:

*in order to determine whether the features of appearance of a product are **exclusively** dictated by its technical function, it must be established that the technical function is the **only** factor which determined those features, the existence of alternative designs not being decisive in that regard.*

In the light of the above judgment, it appears that the relationship between the appearance/aesthetic consideration and technical function needs to be exclusively and solely linked to each other to be excluded by design protection, regardless of whether there is an existing alternative design to fulfil that function. It can be considered as an exclusive

¹⁸ Community Design Regulation 2002, Article 8(1).

¹⁹ CJEU Case C-395/16, *Doceram GmbH v CeramTec GmbH*, Judgment of the Court (Second Chamber), 8 March 2018, para. 29.

test for technical function design. However, this may contradict with the definition of 'design' within the meaning of the Community Design Regulation, which states:

*'design' means the appearance of the **whole** or a **part** of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation.*²⁰

According to the above definition of 'design', appearance or ornamental aspect is the decisive factor of a design,²¹ and that any design is unlikely to connect with technical function exclusively, solely and completely as a design involves a wide range of features. This definition also seems to contradict with the wording of its Recital (10) that '...this does not entail that a design must have an aesthetic quality...'. There appears to need clarification for these subject matters from the European Commission and WIPO.

²⁰ Community Design Regulation 2002, Article 3(a).

²¹ CJEU Joined Cases C-361/15 P and C-405/15 P, *Easy Sanitary Solutions and EUIPO v Group Nivelles*, Judgment of the Court (Fourth Chamber) 21 September 2017, para. 62.