

Preventing Copycats: WEAVING THROUGH THE LEGALS

By Sharon Givoni

Imagine you come up with a great new pattern for curtain fabric that strikes a chord with consumers, a window shutter design or a special weave that flies off the shelves – you just can't make enough! But what if you find out someone is copying you? Can you stop them? How? Melbourne-based Intellectual Property lawyer Sharon Givoni, and author of a new book called *Owning It: A Creative's Guide to Copyright, Contracts and the Law*, explores the issues in more detail.

Starting Point

You may be surprised to learn that if you apply a three-dimensional element to your window furnishing, such as woven design in a fabric curtain, an impressed element on a venetian blind or patterns worked into a window shutter, you could lose the benefit of copyright protection in certain circumstances.

One thing that many people in the window furnishing industry may not be aware is that while flat prints are protected by copyright law, once certain features are added and the design is woven into, impressed on or worked into the fabric of a curtain, blind or shutter, copyright protection can be compromised.

The key message in this article is that designers and window furnishing manufacturers need to be proactive rather than reactive in protecting their designs. Further, a flat two-dimensional design in the form of a print is protected under copyright law but if you do more with the design and apply it in other ways (see above) copyright protection can be lost. This is might not seem to be a problem to you until the day that it gets copied by a competitor in which case you could regret not reading this article.

How is copyright lost?

In order to break it down, consider the following two examples. They illustrate when copyright will step in to protect you and when it will be lost.

Example 1: A printed curtain

Imagine that you have a two-dimensional print on a curtain. It turns out to be popular and sells well. Printed curtains are becoming increasingly popular, featuring vibrant shades, irregular stripes and a variety of patterns inspired from countries around the world such as Turkey and Japan.

In this example, if someone else was to reproduce the design (or a similar one) on their own curtain without your permission, you could well have a legal case against them for copyright infringement. Certain factors will need to be met, including:

- Proving that you own the copyright in that design to start with (this may not be the case, for example if a freelancer drew it and did not assign the copyright to you);
- Showing the copied design is similar to your own in a substantial way (determined by reference to the quality not the quantity of what has been taken); and

- The other design was in fact copied (in other words, it needs to be shown that there was a link between your original design and the copied one. If they did not have access to your work in the first place they could argue that they independently created the design. Remember, copyright law is there to prevent copying).

Once the above requirements are met, your design is protected by copyright law as an artistic work. If anyone copies your design, they are infringing your intellectual property rights.

Case study 2: Designs with three-dimensional elements

What if you decide to take an extra step and introduce three-dimensional elements such as a woven design on a curtain or pattern impressed on a window shutter such that the design virtually becomes an inseparable part of the product itself?

This is where things can get a bit complicated. The reason for this is that if the design is woven, impressed or worked into a curtain, blind or shutter, then it can be considered to be a 'corresponding design' as opposed to a decorative feature applied to the surface of the material.

Under Australian copyright laws, where a corresponding design is "industrially applied" (i.e. mass produced), copyright

protection in the original artistic work is lost. This means that a printed image on a curtain may be protected by copyright law but an embroidered version of that very same image may have no protection at all unless you have registered it as a design in Australia.

This is sometimes referred to as the copyright/design overlap.

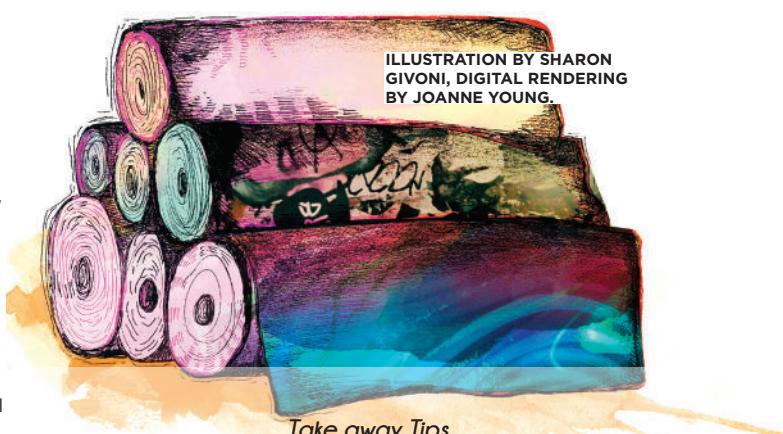
An exception to the rule - 'works of artistic craftsmanship'?

As with many legal areas, there is an exception to the rule.

A three-dimensional design may still be protected under copyright law if it can be classed as a 'work of artistic craftsmanship'.

In very basic terms, a curtain or blind or shutter could potentially be considered a work of artistic craftsmanship if it possesses an overriding artistic quality. While being handmade is not a requirement, this can be a compelling factor. On the other hand, if a design is clearly intended for mass production or has a dominant functional purpose, it is unlikely to fall within this exception.

A work of artistic craftsmanship could therefore be an intricately crafted tapestry, or a hand-made woven item of fabric, which was created by someone who possesses the special skills of a craftsman. However, proving 'artistic craftsmanship' can be



Take away Tips

Flat printed two-dimensional patterns, are generally protected as artistic works under the Copyright Act 1968 (Cth).

If you engage contractors to create your designs, make sure that the copyright in those designs is assigned to you in writing – do not assume it will just happen.

Design elements that are woven into, impressed or worked into the product may need to be protected under the Designs Act 2003 (Cth) and need to be registered.

You could lose the ability to register your design if you have publicly used it in Australia or published it in a document anywhere in the world prior to registration, so always seek registration from the outset.

very difficult and there are no guarantees that a court would accept the argument. This is especially so in the context of a mass produced item, so it's generally best to seek design registration for commercially produced items. Let's move on to explore what this means.

Design Registration

Design registration protects the overall appearance of a product. This includes its visual shape, configuration, pattern and ornamentation. It can apply to all products including blinds, shutters, drapes, curtains and awnings.

A registered design gives the owner the exclusive right to use that design in the marketplace, and making it known that you have a design registration can deter others from copying your designs.

However, to be able to enforce a registered design, it must be new and distinctive when compared to a 'prior art base', which includes:

- Designs publicly used in Australia
- Designs published in a document anywhere in the world (including the Internet)

Bear in mind that the 'prior art base' can include the very own design that you are seeking to register, so if you have previously sold your curtain, blind or shutter

featuring that design in the marketplace prior to registration then it may well be too late to do so.

Therefore, the rule to remember is: design registration should always be sought from the outset. Do not wait!

How do you register a design?

Design registrations need to be filed with a government body known as 'IP Australia'. The application requires a number of formalities and it is best that a legal professional does this as there are some formal rules around doing it properly.

How can you enforce design registration against a "copycat"?

To obtain an enforceable right in addition to registration, the design must undergo a certification process which involves the design being examined by IP Australia to determine whether it satisfies the requirements of being 'new and distinctive', amongst other criteria.

In this sense, registration can be likened to a 'shield' whereas certification can be likened to a 'sword'. If someone does actually copy your design, it needs to have to have been both examined and certified by IP Australia. Registration in itself will not be enough.

What rights do I have once my design is registered?

Once your design is registered you can exclusively:

- Use your design;
- Apply the design to a product;
- Sell, use or import a product that embodies that design; and
- Authorise other people to use your design.

Design registration lasts for five years and you can usually renew your registration for a further five years, giving a total of 10 years of protection.

This can be contrasted to copyright for two dimensional prints which lasts for the life of the author plus seventy years.

Conclusion: Mental Gymnastics

This can be mental gymnastics for businesses that create and deal with designs every day. So, at the end of all this, what can



you take away from all this? Two things.

First, if your design is only going to be printed as a flat, two-dimensional print for example, a floral pattern on a curtain, then it will most likely be protected by copyright law as an artistic work.

On the other hand, if the design feature is:

- Woven into;
- Impressed on; or
- Worked into the article (sorry to be technical – it's the wording of law),

and the article is then "industrially applied" and copyright protection may be lost. In that case, design registration is recommended.

Final comment

If this article has you a little bit baffled, rest assured you are not alone.

This phenomenon called the copyright/design overlap is a vexing area that can be challenging, even for lawyers. The old adage that to be forewarned is to be forearmed however it applies here in the sense that you need to turn your mind to those things early.

While there are many benefits globalisation brings to the economy, for window furnishing businesses, it can equally lead to many problems, such as discovering that your products have been replicated overseas. Having a broad understanding of your legal rights in this area and taking steps to protect your design can make all the difference.

About the Writer

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**Disclaimer*

This article is intended to be a summary of the law. As each case is different, it must not be relied upon as a substitute for legal advice tailored to suit your own individual needs

'Owning It: A Creative's Guide to Copyright, Contracts and the Law'

If you found this article helpful, you may be interested in Sharon Givoni's book, 'Owning It: A Creative's Guide to Copyright, Contracts and the Law', which was released in April 2015. Packed with case studies, the book aims to demystify the law for creatives and small business owners regarding the protection of designs, trade marks, copyright, reputation, confidential information and other intellectual property. For more information about Owning It, visit

www.creativemindshq.com/owningit or www.sharongivoni.com.au