The Parody Exception in EU Design Law: A Catalyst for Creative Evolution, Innovation and Cultural Discourse

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Abstract

This article delves into the recent proposals put forward by the European Commission, presented on the 28th of November 2022, which aim to revise key EU instruments governing the protection of design rights. With design legislation largely remaining unaltered for over two decades, the Commission's objective is to modernise this legal framework, further harmonising the protection of industrial designs within the EU. A noteworthy aspect of the proposal is the introduction of a new exception for 'critique and parody,' which garners support from designers and users alike. This article scrutinises the intricate relationship shared by design and art, shedding light on their points of convergence and divergence. The existing design legal framework undergoes critique for its inherent imbalances and the limited scope of its exceptions, especially in instances concerning referential or illustrative uses. The proposed amendments are deemed essential in ensuring fair competition and tackling the intricate question of intellectual property rights cumulation. Considering designs becoming increasingly multifaceted, serving both functional and artistic purposes while elevating themselves to a cultural echelon, their legal treatment grows in complexity. This gives rise to fresh discussions surrounding the adequacy, efficacy, and comprehensiveness of the equilibrium to be established between the rights of right-holders and the interests of users. The article emphasises the imperative of maintaining a fair balance between the rights of right-holders and competing interests, with a particular focus on the newly proposed parody exception. Furthermore, it delves into the realm of critical design, often a form of design that challenges established assumptions concerning the roles of products, with the aim of stimulating discourse and provoking debate. Within this context, the article underlines the significance of the anticipated modifications in EU design instruments, presenting insights into how the new design parody exception should be interpreted to encourage innovation and creativity.

Introduction

On 28 November 2022, the European Commission put forth proposals for amending Council Regulation (EC) No 6/2002, on Community designs (hereafter 'Community Design Regulation') and Directive 98/71/EC, on the legal protection of designs (hereafter 'Design Directive').[1] These two legal instruments collectively constitute the foundation for the protection of designs within the European Union. Through these revisions, the Commission seeks to modernise a legal framework that has been in place for over two decades, with the objective of rendering the protection of industrial designs in

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[1] Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs OJ L 3, 5.1.2002, p. 1–24; Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs OJ L 289, 28.10.1998, pp. 28–35.

the EU more expeditious, cost-effective, and foreseeable.[2] Although an attempt at modernising the design regime is not surprising,[3] the proposal to introduce a new exception for the purposes of 'critique and parody' was certainly not expected by many but represents a welcomed initiative, reflecting changes in design creative processes, design objectives, and user habits.

If art is an important form of self-expression and catalyst for discourse, art uses creativity combined with technical proficiency to communicate ideas and emotions into a visual format. Design shares the same fundamental creative visual principles as art (e.g. colour, lines, balance etc), can also be as visually attractive and be a powerful visual communicator. There is something very democratic about design. Although design can be constrained by clients' needs, purpose, business goals or user needs, people are less intimidated to express how they feel towards a particular design compared to, for instance, fine arts, which primarily exists within the confines of connoisseurs' circles.[4] As people increasingly define themselves by the objects that surround them, design engages people in a more directly accessible way. In a nutshell, design and art differ primarily in the fact that design has always a purpose, solves a problem whereas art is unconstrained. As such, art can be created with no other purpose than enjoyment and display.

Throughout history, art and design have shared a close relationship, with boundaries that are continuously changing and blurring. Numerous examples of art influencing design can be found in the fashion industry. Here, we can think of 'The Mondrian dress' by Yves Saint Laurent in 1965,[5] the popular collaborations between Salvador Dali and Elsa Schiaparelli which resulted in her famous 'Shoe Hat'[6] inspired by a photograph the artist took of slippers balanced on his wife's head or Madeleine Vionnet's 'Bas-relief frieze dress' showing clear homage to Hellenistic art and the Greek goddess of victory.[7] But design has also influenced art. Modern and contemporary art movements such as Pop Art provide ample examples of this phenomenon. Here, Dali's use of the Coca-Cola bottle in the Poetry of America in 1943 to illustrate his premonition of forthcoming conflict in America between the races in a post-war context,[8] Andy Warhol's use of everyday items such as Brillo Soap pad box[9] or Claes Oldenburg's homages to commercial products in the creation of fine art sculptures are significant examples.[10]

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[2] COM(2022) 666 final 2022/0391 (COD).

[3] Back in 2014, the Commission initiated an assessment of the functionality of the design protection system. Subsequently, the Council urged the Commission to put forth proposals for modifying EU design protection in order to make the system more appealing to small and medium-sized enterprises (SMEs). This sequence of events led to the Commission's issuance of its initial communication in 2020, entitled 'Unlocking the Potential of Innovation in the EU - An Intellectual Property Action Plan to Support the EU's Economic Recovery and Resilience' (COM(2020) 760 final). Furthermore, the European Parliament has also expressed its support for reforming the design system, as evidenced in the report on an intellectual property action plan to bolster the EU's recovery and resilience, approved by the Legal Affairs Committee on September 30, 2021 (A9-0284/2021), paragraph 32.

[4] Recognition of designer's freedom is also found in the legal framework: Articles 5(2), 9(2) & Recital 13 Design directive; Articles 6(2), 10(2), and Recital 14 Community Design Regulation.

[5] See https://www.metmuseum.org/art/collection/search/83442 (last access 14/12/23).

[6] See https://www.metmuseum.org/art/collection/search/83437 (last access 14/12/23).

[7] See https://theartofdress.org/2018/11/05/bas-relief-by-vionnet-vogue-1931/ (last access 14/12/23).

[8] See https://larevolucionserapatrocinada.wordpress.com/2015/03/08/salvador-dali-poetry-of-america-1943/#:~:text=A%20remarkable%20detail%20in%20%E2%80%9CPoetry,American%20accoutrement%20%E2%80%93%20the%20ubiquitous%20telephone (last access 14/12/23).

[9] See https://www.warhol.org/lessons/brillo-is-it-art/ (last access 14/12/23).

[10] See https://www.theartstory.org/artist/oldenburg-claes/ (last access 14/12/23).

Since the 1970s, a new kind of design emerged, critical design.[11] Coined by Anthony Dunne, critical design challenges assumptions, preconceptions, and other givens about the role of products in everyday life. Its roots can be traced back to Italian Radical Design where design was highly critical of prevailing social values and design ideologies.[12] This non-industrial form of design can easily be found in the furniture world where product design is still heavily conservative and intertwined with the mass market. Here, the primary objective is to raise awareness, encourage discourse, expose assumptions, spark debate, or even simply entertain. It is therefore deeply anchored in the idea that whilst society evolves, design remains stagnant. Critical design becomes an effort to engage with complex and challenging issues of today's world. One of the main roles of critical design is to question the limited range of emotional and psychological experiences offered through designed products. There is an assumption that design is primarily about making things pleasant, almost as if all designers have silently taken an unspoken Hippocratic oath. This limitation hinders designers from fully engaging with and designing for the complexities of human nature, which, of course, are not always pleasant as illustrated by the 'Last Shift Office Chair' borrowing from Magritte's painting, *The Balcony*, in 1950 and commenting on the fact that prolonged hours sitting on a chair per day speeds up mortality and the overworking culture permeating in workplaces globally.

Figure 1 The Last Shift Office Chair – source Indepest: https://indipest.files.wordpress.com/2022/09/5a3ef796-4313-410d-8746-db2c03510da1.jpg

The current design legal framework is unbalanced. Characterised by a narrow catalogue of exceptions,[13] case law has highlighted issues arising from referential or other illustrative purposes.[14] Against this backdrop, the new proposals constitute an important development in focusing on ensuring an overarching objective of undistorted competition,[15] similar to trade mark law but also in approaching the cumulation of intellectual property rights since *Cofemel*.[16] The introduction of new

[11] Term coined by Anthony Dunne in his book, *Hertzian Tales* (MIT Press, 1999) and later in *Design Noir* (Bloomsbury Publishing, 2001).
[12] For more, see https://speculativeedu.eu/the-radical-design-movement/ (last access 14/12/23).
[13] Article 13 Design Directive and article 20 Community Design Regulation.
[14] As demonstrated in Joined Cases C-24/16 and C-25/16, *Nintendo*, ECLI:EU:C:2017:724.
[15] Article 14 Design Directive.
[16] CJEU C-683/17, *Cofemel — Sociedade de Vestuário SA v G-Star Raw CV*, ECLI:EU:C:2019:721.

design protection exceptions, must ensure a fair balance between the exclusive rights of right-holders and other conflicting interests. This article will focus on the role of a parody exception in design law and how it provides a means to reflect evolving design practices as well as enhancing citizen participation in public discourse.

To do so, Part 1 of this article provides a brief overview of design history and its developments before moving onto explaining the evolution of design law and protection cumulation (Part 2). Part 3 builds on these sections by reviewing the justifications for introducing a design parody exception. Following which, Part 4 provides interpretation guidance to ensure the objectives of the exception are realised whilst protecting the rights of right-holders before concluding.

1. Framing the 21st Century: The Evolution of Design as Social Commentary and Parody as its Communicative Tool

Industrial design can be traced back to the industrial revolution whereby design became a powerful catalyst for social change by providing consumers with affordable and functional objects in creative and innovative manners, [17] but constraining design to these roots neglects the more complex facets of design known today.[18] This section offers brief insights onto how design has morphed to endorse a more critical role in modern society as a cultural phenomenon as well as becoming a key facilitator for creativity and innovation in diverse contexts.

In the nineteenth century, a designer was conceived as being the person making the necessary decisions regarding the external appearance of a product. As such, designers decided the product's shape, colours as well as ways in which a particular product would be used or respond to use. With the twentieth century and the advent of postmodernism,[19] a certain emphasis is set on mass consumption and the role of advertisers and marketers to provide consumers with information enabling them to create unique identities through the products they own. Simultaneously, designers are increasingly considering themselves as artists creating artistic expression and distancing themselves with the world of industry and commercial business.[20] Against this backdrop, it is reasonable to wonder what the role of design in culture is.[21] Here, industrial design is seen to preserve the past and its traditions whilst becoming a tool for group self-determination. Instead of merely providing solutions through the creation and modification of artifacts, postmodernism requires

[17] Stephen Bayley, proponent of this theory, defined design as the intersection of art and industry, where individuals start shaping the aesthetics of mass-produced items. In doing so, he firmly roots his definition in the context of industrialisation and large-scale production—a notion that was prevalent during the 1930s when design was often referred to as 'industrial art'. Stephen Bailey, Ugly, the Aesthetics of Everything (Goodman Fiell, 2012).

[18] Penny Sparke, *An Introduction to Design and Culture: 1900 to the Present* (Routledge, 2019) Introduction; Roland Barthes, *Mythologies* (London, Jonathon Cape, 1983).

[19] This led to the development of pop design tying with the emergence of pop art as an art form.

[20] E.g. in 1975, the members of the Norwegian Design Centre changed their name to Norwegian Artisan Craft-workers, defining themselves as artists; Barbara Pasa, 'Industrial Design and Artistic Expression: the challenge of legal protection' (2019) 3.2 (3) *Art and Law*, p. 35.

[21] Critical design emerges as a movement with the works of Dunne and Raby being vanguard and shares commonalities with design activism, culture jamming and can stand separate to the market. See Dunne and Raby's project 'Is this our Future?' (2004) available at https://dunneandraby.co.uk/content/projects/68/0 (last access 14/12/2023). Here, the designers depict fictional situations relying on obscenity to suggest using child labour to produce energy. By employing known forms, shapes and lines, these designs suspend the user uncomfortably between reality and fiction. For more, Dunne, above n. 11.

conceptualising industrial design, considering its cultural symbolic dimension often through the use of satire.[22] Beyond its inherent utilitarian nature, design endorses a crucial role in influencing human behaviour which has the potential to shape society.[23] By bringing together the best elements of craftmanship, modern mass production techniques and fine arts, there is a need to reinterpret design to acknowledge that design generates new ways of creating products whilst simultaneously, becoming a communication tool sensitive to the social context of contemporary life.[24] As aptly put by Culebra:

> [T]hat objects are a channel of expression between individuals and societies through time; where designers have a pivotal role in the construction of the social fabric. Since the current approach that is given to Design is a tool for the materialization of an idea that is usually the search for a solution. A solution that can be tangible, virtual or discursive to a problem that can be social, economic, ecological, cultural and political.[25]

With the role of designers becoming more complex and abstract, scholars like Alexander express discomfort and the need to acknowledge the designers' limits emerging from the increasing complexity of the problems which designers are expected to solve, [26] putting the designer in a position where the political interpretation of the problem to be solved can prevail over the creation of an innovative solution to a problem.

Defining design and culture therefore remains a daunting task even for field experts. Drawing from the etymology of the term 'design', design can either be a process (as in the verb 'to design') or an end-result, the product, products manufactured using a design or the overall pattern of a product, not all of which is protected by design law. The multiple meanings of 'culture' makes it even more difficult to define and typically ranges from high-valued activities such as fine art to 'a way of life'. When 'design' and 'culture' are combined, their complexities are compounded. In other words, the interaction and interplay between design and culture become intricate and multifaceted. Design is not separate from culture but deeply intertwined with it.[27] Design influences and is influenced by various aspects of culture, from highbrow, intellectual, and artistic expressions to more mainstream, popular, and everyday cultural phenomena. Therefore, design, in its visual, material, and spatial forms, embodies and continues to embody this tension between modernist and postmodernist design philosophies. Design is not just a response to this tension but also a reflection of it, making it a significant aspect of cultural expression and discourse.[28] In the twenty-first century, there is no denying that a design can

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[22] Glenn Parsons, *The Philosophy of Design* (Polity, 2016), pp. 18-24.

[23] Ibid, pp. 56-57.

[24] Bourdieu also posits design within a sociocultural framework, challenging the modernist framework generally associated with designs and purports that the exercising of taste underpins both the shape and the dynamic of modern society and culture. Pierre Bourdieu, *Distinction: A Social Critique of the Judgement of Taste* (Routledge and Kegan Paul, 1986) p. 55.

[25] Fernanda Marquez Culebra, 'Design as a Tool of Communication and Creation of Reality' (Proceeding of the online conference DVHG Digest 2020) p. 30 available at https://www.researchgate.net/publication/351162341_Design_as_a_Tool_of_Communication_and_Creation_of_Reality_ISBN_-_978-952-64-9002-1 (last access 14/12/23).

[26] Christopher Alexander, *Notes on the Synthesis of Form* (Harvard University Press, 1964), p. 3.

[27] In 2006, Björn Franke and their project 'Traces of an Imaginary Affair' which introduced a device which replicated scratch marks made on the back by an imaginary lover. This project plays on the understanding that self-harm is wrong before challenging assumptions through incongruity to convey that harming might actually be valuable, incentivising a debate around the question of self-harm. See https://www.dezeen.com/2009/03/03/traces-of-an-imaginary-affair-by-bjorn-franke/ (last access 14/12/23).

[28] John A. Walker, *Design history and the history of design* (Pluto Press, 1990), p. 68 where the author speaks of 'design within society' rather than 'design and society'. See also p.70 for a comprehensive diagram on the social impact of design.

be both an agent and mirror of change within society and culture. In sum, designs can be the vehicles for complex messages. They are 'part of the dynamic process through which culture is actually constructed, not merely reflected.'[29]

Design practices have also profoundly changed.[30] If previously a car and a fashion designer would operate in distinct spheres, today boundaries are being eroded. There is no denying that design is powerful in both shaping and conveying identities, whether they are individual, political, or related to business. Additionally, design has the potential to create and represent the stereotypical features of various culturally defined groups, such as social classes, genders, and ethnicities. These characteristics are presented in a way that allows individuals to engage with and negotiate them within the marketplace. But also design at the end of the twentieth century becomes a way for individuals and groups to self-define (let's think of the Barbie doll or perfume bottles as examples). Design and branding were pivotal in shaping both national and brand identities. It also highlights the impact of these processes on individual consumer identities and how design represented various cultural categories in the marketplace. It becomes a reassertion of national and gender identities in response to changing cultural and global trends.

Taste, or personal preference, is a significant factor in how people navigate and make choices within this complex realm of design. Yet, there is no denying that design operates in various dimensions and contexts, often tied to consumption, and it can simultaneously convey ideas and bring tangible or virtual products and experiences into existence. As such, users are expected to experience some dilemma and carry the burden of interpretation of the design, engaging their imagination and intellect. Inherently dependent on context, designers see parody and satire as important tools for engagement.[31] Additionally, the embedded narrative in the design makes it a critical medium conveying cultural meaning whilst highlighting issues with current design practices thereby making design a drive for innovation.[32] Given that the boundaries between art, traditional craftmanship, design and mass media erode, it is not surprising that IP regimes overlap, requiring a more uniform and balanced approach to exceptions and limitations thereof.

2. Design Law Stuck in the Post-Industrial Landscape

Throughout history, design protection has undergone significant transformation, mirroring the shifts in societal and industrial landscapes. In the pre-modern era, artisans and craftsmen relied on personal

[29] Sparke, above n. 18, Introduction.

[30] Walker, above n. 28 which explains the difficulties in appreciating the relationship between art, industry, creativity and commerce, manufacturers, and consumers.

[31] Netta Iivari, Marianne Kinnula, Leena Kuure and Tiiina Keisanen, 'Arseing around was fun!' – Humor as a resource in design and making (CHI 2020, April 25-30 2020, Honolulu, HI, USA) available at https://www.researchgate.net/publication/341698854_Arseing_around_was_Fun_Humor_as_a_Resource_in_Design_and_Making/link/5eda150045851529453718dc/download?_tp=eyJjb250ZXh0Ijp7ImZpcnN0UGFnZSI6InB1YmxpY2F0aW9uIiwicGFnZSI6InB1YmxpY2F0aW9uIn19 (last access date 14/12/2023); Geke D. S. Ludden, Barry M. Kudrowitz, Hendrik N. J. Schifferstein and Paul Hekkert, 'Surprise and humor in product design' (2012) 25(3) *Humor*, 285-309.

[32] This is also referred to as 'associative design' in the field. Using Horatian satire, associative design borrows from known design, usually built for serious purpose, and infuses it with incongruity or ridicule. To illustrate this concept, we can think of Martino Gamper's project '100 chairs in 100 days' where the designer used burlesque and mash-up techniques to combine existing chair elements into new unique chairs. The aim of this project was to comment on obsolescence and the role that design plays in this realm, thereby challenging embedded assumptions in relation to seats. See https://www.martinogamper.com/project/a-100-chairs-in-a-100-days/ (last access 14/12/23).

reputation and guild systems to safeguard their creations. However, there were no formal legal mechanisms for protecting designs, with the emphasis placed on trade secrets and traditional craftsmanship. The turning point arrived with the Industrial Revolution in the 18th and 19th centuries. This period witnessed a surge in design creation and production, largely driven by the rise of industrialisation. As such, the primary objective of the design system was not to protect creators or advance technical progress but was mainly revolving around enhancing the marketability of design-related products.[33] As more innovations emerged, the need for protecting designs and inventions became increasingly apparent.

2.1. The rocky road of harmonisation

In the early 20th century, international cooperation took centre stage with the establishment of the Paris Convention for the Protection of Industrial Property in 1883[34] and the Hague Agreement Concerning the International Deposit of Industrial Designs in 1925,[35] paving the way for harmonisation of design protection laws across borders.[36] Some general principles for the protection of industrial designs can be found in article 5 quinquies of the Paris Convention which states that industrial design protection should be available in the Paris Union without specifying the form or minimum thresholds. Therefore, to meet their international commitments, legislators could choose to protect industrial designs through a sui generis design legislation, through copyright or unfair competition.

Although the initial 1886 Berne convention for the Protection of Literary and Artistic Works Act did not include the protection of works of applied art in its non-exhaustive list of protectable subject-matters,[37] this was remedied with 1908 Berlin Revision.[38] Yet, there was still no agreement as to the form of protection to prevail or any obligation on the part of Berne members to offer protection. And only with the 1948 Brussels Revision Conference protection became mandatory.[39] Article 2(5) of the Brussels Revision recognises that the protection of works of applied art and industrial designs sit somewhere between copyright protection and industrial property. Hence, article 2(5) grants Berne countries the discretion to protect designs using copyright laws, sui generis design legislation, or a combination of both.[40] Member countries of the Berne Union are likewise empowered to establish the specific conditions for protecting works of applied art and industrial designs. The sole stipulation regarding designs in the Berne Convention is that in cases where specific protection is not provided, these works must be protected as artistic works.[41] The TRIPs Agreement added little more through its articles 25

[33] Green Paper on the Legal Protection of Industrial Designs (working document of the services of the Commission), [1991] III/F/5131/91-EN.

[34] Paris Convention for the Protection of Industrial Property (as amended on September 28, 1979).

[35] See Hague System – The International Design System (wipo.int) (last access 14/12/2023)

[36] For more, see Pierre Maugué, 'The International Protection of Industrial Designs under the International Conventions' (1989) 19(1) *University of Baltimore Law Review*, Article 20

[37] The Berne Convention for the Protection of Literary and Artistic Works (as amended on September 28, 1979).

[38] See https://www.wipo.int/wipolex/en/treaties/textdetails/12805 (last access 14/12/23).

[39] See https://www.wipo.int/wipolex/en/treaties/textdetails/12802 (last access 14/12/23).

[40] Italy made attempts at making the two IP regimes mutually exclusive whilst France is a proponent of cumulation under the so-called 'unity of art' in its Loi du 11 mars 1902 à propos des sculptures et dessins d'ornement (for more, see P. Fabbio, 'Copyright Protection for Design Creations,' in A. Kur et al. (eds), *The EU Design Approach—A Global Perspective* (Edward Elgar, 2018), 81; Pasa, above n. 20, p. 28. The British position changed over the years, see Lionel Bently, 'The Design/Copyright Conflict in the United Kingdom: A History', in Estelle Derclaye (ed.), *The Copyright/Design Interface: Past, Present and Future* (CUP, 2018), ch. 6.

[41] Some explain this move by the focus on the use of decorative arts on three-dimensional objects such as painting on porcelain. Marianne Levin, 'The Cofemel revolution – originality, equality and neutrality' in E. Rosati (eds.), *The Routledge Handbook of EU Copyright Law* (Routledge, 2021) p. 89.

and 26 although this instrument paves the way both in terms of substantive requirements by subjecting design protection to new or original designs as well as allowing for exceptions if these are compliant with the three-step test.[42] The deliberate absence of positioning regarding the provision of a definition of what constitutes a protectable work is notable.

In response to significant variations in national design protection throughout Europe, the European Union contended with the issue of harmonising design laws.[43] In 1991, the European Commission proposed a "design approach", treating design protection as a distinct legal field, and advocated a three-pronged strategy that involved harmonising national registered design laws, establishing a Community-wide registered design system, and introducing an unregistered Community design law.[44] This led to two pieces of Community legislation: a directive to standardise national laws and a regulation for establishing Community-wide design rights.[45] Here, design is defined as the outward appearance of a product or part of it, resulting from the lines, contours, colours, shape, texture, materials, and/or its ornamentation, thereby protecting both two-dimensional and three-dimensional products.[46] Against this broad scope, the design framework excludes protection where the design results entirely from functional considerations or where the design is contrary to public policy or morality.[47] Constituting a full harmonisation, the directive evidently focuses on substantive requirements for protection, the rights granted, the term and grounds for invalidation. More importantly for our focus, the EU legislator upholds the principle of cumulation of a sui generis regime for protecting industrial designs with copyright protection whilst remaining silent on the extent of copyright protection and the conditions under which cumulation is granted such as the level of originality required thereby jeopardising the goals of the single market.[48]

Seizing the opportunity to further harmonise design law, the Court of Justice of the EU (CJEU) commenced the process of aligning the concept of originality across design and copyright protection in the *Flos v Semeraro* case.[49] This entailed mandating the coexistence of both copyright and design protection, even though the Italian court had not explicitly requested guidance on the standard of originality. [50] Recognising that the legal framework allowed significant latitude for member states in interpreting the interface between design and copyright, and considering the EU legislator's deliberate choice to ensure that registering a utilitarian object as a design should not automatically disqualify it from potential copyright protection, it is not surprising that member states' courts eventually sought

[42] The TRIPS Agreement is Annex 1C of the Marrakesh Agreement Establishing the World Trade Organization, signed in Marrakesh, Morocco on 15 April 1994.

[43] For a historical account on the EU commission's vision, see Annette Kur, 'The Green Paper's Design Approach – What's Wrong With it?' (1993) 15(10) *EIPR* 374, 377.

[44] European Commission, *Green Paper on the Legal Protection of Industrial Design* (June 1991), III/F/5131/91–EN

[45] Supra, note 1; For more on the debates surrounding the adoption of the Directive, see G. Dinwoodie, 'Federalized Functionalism: The Future of Design Protection in the European Union' (1996) 24 *AIPLA QJ* 611.

[46] Article 3(a) Community Design Regulation; article 1(a) design directive.

[47] Articles 8 and 9 Community Design Regulation; articles 7 and 8 Design Directive. Criticising the ability to separate a design from its functional aspects, Pasa notes that the current legal framework is not in line with design creative practices, requiring the law to better recognise the structural and functional relationships working as a unity in any design. Here, the author warns that the advent of tech and AI-driven design relinquishes this distinction to the past. See Pasaabove n. 20, pp.7&54.

[48] Article 17 and Recital 8 Design Directive; Recital 32 and article 96(2) Community Design Regulation. For more see, See also Estelle Derclaye & Matthias Leistner, *Intellectual Property overlaps: a European perspective*, (Oxford, 2011), p. 46; Antoon Quaedvlieg, 'The Copyright/Design Interface in the Netherlands', in E. Derclaye (ed.), *The Copyright/Design Interface: Past, Present, and Future*, (Cambridge, 2018), p. 50.

[49] CJEU C-168/09, *Flos SpA v. Semararo Case e Famiglia SpA*, [2011] ECR I–181.

[50] Ibid, para 34.

interpretative guidance from the CJEU. Consequently, provided the design amounts to a work under the Information Society Directive[51], these must be protected under copyright as well.

In its *Levola Hengelo* ruling, [52] the CJEU made a clear assertion that the uniform application of EU law and a steadfast commitment to the principle of equality necessitate an autonomous and consistent interpretation of the term 'work' across the EU territory.[53] Consequently, the Court concluded that the taste of cheese could not be regarded as a 'work' due to its currently unidentifiable nature. The eagerly anticipated *Cofemel* decision marked a significant development, as legal scholars argue that the CJEU firmly established comprehensive cumulation between design and copyright protection.[54]

The case revolved around the reproduction of designs found in G-Star Raw jeans and t-shirts and explored the prerequisites for protecting industrial designs as works of applied art under copyright legislation. A key question in this context revolved around whether the *Infopaq* decision implied that certain criteria related to artistic or aesthetic quality could be upheld in national law. The CJEU provided a resolute response, stating that article 2(a) of the InfoSoc Directive must be interpreted as 'preventing national legislation from granting copyright protection to designs like the clothing designs in question, based on their capacity to produce a distinct and aesthetically significant visual impact beyond their practical utility'.[55] In other words, the only permissible criterion is 'the author's own intellectual creation', signifying a significant stride forward in modernising design law in line with the development of design history. [56] This principle was further solidified in the case of *SI and Brompton Bicycle Ltd v Chedech/Get2Get.* [57] In this case, the CJEU reiterated that, in line with copyright principles, when the creation of a subject is dictated by technical considerations, rules or constraints that leave no space for creative freedom, such circumstances cannot give rise to original works.[58] However, a product shape partly necessary to obtain a technical result does not automatically bar the product from copyright protection.[59]

In addition to these developments, the lack of flexibility in the design system became apparent in the *Nintendo* case.[60] The case centred around the use of images depicting the applicant's Nintendo designs

[51] Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society, O.J. L 167 , 22/06/2001, P. 10 – 19 (Here after Information Society Directive).
[52] CJEU C-310/17, *Levola Hengelo BV v Smilde Foods BV*, ECLI:EU:C:2018:899.
[53] Ibid, paras 33, 40,41.
[54] Annette Kur, 'Unité de l'art is Here to Stay − Cofemel and its Consequences' (2020) 15(4) *Journal of Intellectual Property Law & Practice*, pp. 290–300. Sharing some scepticism, see Marianne Levin, supra note 40, p. 97. Here, the author notes: 'Cofemel does not presuppose or prescribe that everything that is protectable under design law also enjoys copyright protection.' Instead, cumulation of IP rights are possible in certain situations. The author argues this based on *Cofemel* para 52. For an empirical study of IP overlaps and their implications in court, see Oliver Church, Estelle Derclaye & Gilles Stupfler, 'Design Litigation in the EU Member States: Are Overlaps with Other Intellectual Property Rights and Unfair Competition Problemat ic and are SMEs Benefitting from the EU Design Legal Framework' (2021) 46(1) *E. L. Rev*, pp. 37-60.
[55] Supra note 16, para 55.
[56] Agreeing with Advocate-General Spuznar, see Opinion on 2 May 2019, ECLI:EU:C:2019:363. Critiquing this choice for its absence of clear, practical directives regarding the harmonisation of these accumulated rights, which should ideally function in limited instances rather than serving as a general principle. (*Cofemel*, paras 51-58), seeKur, above n. 54, p. 292.
[57] CJEU, Case C-833/18, *SI and Brompton Bicycle Ltd v Chedech/Get2Get*, EU:C:2020:461.
[58] Therefore, building on *Painer*. CJEU C-145/10, *Eva-Maria Painer v Standard VerlagsGmbH and Others*, 1 December 2011, ECLI:EU:C:2011:798.
[59] *Brompton*, supra note 57, para 20 building on *Doceram*; CJEU C-395/16, *Doceram GmbH / CeramTec GmbH*, 8 March 2018, EU:C:2018:17.
[60] Nintendo above, n. 14.

in remote controls and the 'Balance Board' in their marketing of accessories for these products. The CJEU adopted a positive stance, underlining that restricting an entity from using visual representations of existing products when legitimately promoting their newly developed products for explanatory or demonstrative purposes could potentially hinder innovation. As a result, the citation right was broadly interpreted to encompass the alleged infringement, subject to the evaluation of additional criteria specified in the relevant provision.[61] While the *Nintendo* decision offers valuable guidance, it may not fully address the complexities that can arise in different scenarios where visual depictions of a design are employed for reference or illustrative purposes.

2.2. A new dawn: the Design package

The foundations of the European Union's design framework were laid three decades ago,[62]and while the system overall works well, there is a need to adapt design protection for the digital era and make it more accessible to designers. In 2022, the EU Commission responded by adopting two proposals for a new Regulation and recast Directive, aiming to modernise various aspects of design protection and its constraints. This call for reform has been a gradual process.[63] In 2014, the EU Commission initiated a 'Legal Review on Industrial Design Protection in Europe' as part of a comprehensive examination of European Design in Europe, published in 2015. This review determined that a 'desired level of harmonisation' had been achieved, and the internal market's functionality in relation to goods with designs had been facilitated, preferring further development through judicial interpretation.[64] In 2018, the EU Commission conducted its first public consultation, where two-thirds of respondents expressed overall satisfaction with the EU design system.[65] However, a subsequent 2020 report acknowledged room for improvement, citing a lack of clarity in the interaction between the design system and copyright law, especially in light of recent CJEU rulings.[66] This led to a second consultation held between April and July 2021, revealing that a majority of respondents supported changes that would eliminate Member States' discretion in determining conditions for copyright protection in relation to design. Additionally, a substantial minority (30%) advocated for the introduction of limitations related to commentary, critique, or parody, as opposed to 26% against and 44% without a clear stance.[67]

Considering the evolving legal landscape, the recast Directive and the new Regulation proposals not only expand the meaning of 'product' to make clear that digital designs are covered but they also introduce exemptions to facilitate acts of 'comment, critique, and parody,'[68] provided that these actions align with 'compatible with fair trade practices and do not unduly prejudice the normal

[61] Article 13(1)(c) Design Directive and Article 20(1)(c) Community Design Regulation.

[62] UNSPECIFIED (1991) *Green Paper on the Legal Protection of Industrial Design. Working document of the services of the Commission. III/F/5131/91-EN, June 1991.*

[63] A full review of the developments leading to the design Package, see Henning Hartwig, 'Evaluation of EU Legislation on Design Protection' (2022) 17(2) *JIPLP* 107-113.

[64] Available at https://op.europa.eu/en/publication-detail/-/publication/43fd4a5c-6c26-4639-ac9a-281ab57687de p. 11 (last access 14/12/23).

[65] DG for Internal Market, Industry, *Entrepreneurship and SMEs, Factual Summary report on the public consultation on the evaluation of EU legislation on design protection*, Ref. Ares(2019)4979430 - 30/07/2019

[66] EU Commission, *Executive summary of the evaluation of EU legislation on design protection*, SWD (2020) 265 final, p. 2.

[67] Intellectual property – review of EU rules on industrial design (Design Directive) (europa.eu); also see EU Commission Impact Assessment Report Accompanying the documents to the Proposal for a Regulation of the European Parliament and of the Council amending Council Regulation (EC) No 6/2002 on Community designs and repealing Commission Regulation (EC) No 2246/2002 and the Proposal for a Directive of the European Parliament and the Councilon the legal protection of designs (recast) SWD/2022/368 final

[68] New Design Regulation, article 20(1)(e); Recast directive, article 18(1)(e).

exploitation of the design'.[69] The accompanying recitals further clarify that uses for the purpose of artistic expression, provided they are in accordance with honest practices in industrial and commercial matters should be considered as fair. Ultimately, the application of EU design principles should be conducted in a manner that fully upholds fundamental rights and freedoms, with particular emphasis on the freedom of expression.

3. Protecting Creativity and Innovation: The Role of the Parody Exception in Design Law

The inclusion of a parody exception marks a significant and commendable development, with several compelling underpinnings. Foremost, it recognises the cumulation of intellectual property rights, stands in harmony with the recent jurisprudential strides taken by the CJEU[70] and continues the harmonisation of IP toward uniformity.[71] Equally noteworthy, it mirrors the evolution within the realm of design history where the design can hardly be differentiated from the product (three-dimensional designs especially)[72] and the conspicuous shift where designers are progressively disengaging from conventional industrial contexts, taking on roles as central contributors to the ongoing dialogues within society.[73] Furthermore, these new proposals acknowledge the democratisation of design, recognising that it no longer remains confined solely to professional designers but extends its reach to non-professionals engaging in activities such as personalising clothing or refurbishing furniture.

During ongoing debates, it is prudent to examine the grounds opposing the introduction of this new exception. First and foremost, there is the concern that a parody exception could be perceived as detrimental to the exclusive rights of design owners, particularly apprehensive about potential depreciation of their design rights. Delving deeper, the possibility of individuals creating and disseminating parodies without the right-holder's consent could potentially disincentivise designers from pursuing innovative creations in the first place, thus diminishing the overall attractiveness of the design system. Secondly, while the copyright parody exception has a longer history, it remains afflicted by legal uncertainty and complexity. Primarily owing to a lack of clarity within the genre, one could contend that, given the resemblances between the two parody exceptions in copyright and design law, the challenges currently encountered in the realm of copyright may very well persist within the domain of design.[74] Consequently, considering the difficulties associated with distinguishing a legitimate parody from an infringing use, the introduction of a design parody exception could lead to increased expenses linked to a surge in litigation. Thirdly, there exists a legitimate concern that some individuals

[69] New Design Regulation, recital 15; Recast directive, recital 32.
[70] *Nintendo*, above n. 14.
[71] Indeed, some national courts such as in France and The Netherlands where courts have accepted arguments based on freedom of expression to protect artistic and satirical uses of registered designs.
[72] On whether form can express content when assessing a design product, see Judith Genova, 'The significance of style' (1979) 37(3) *Journal of Aesthetics and Art Criticism*, pp 315—324. In this piece, the author argues that the signification of style to express the personality of its designer depends on the product scrutinised e.g. fashion where there is more scope for expressive elements vs engineering where function primarily drives the form.
[73] This is acknowledged by some national courts like in Italy with the Panton chair – Milan Court (IP division) 18.01.2007, the Arco Lamp created by Achille and Pier Giacomo Castiglioni for the Flos company in the sixties or the chaise longue by Le Corbusier made in 1928.
[74] Estelle Derclaye, 'To What Extent is the Parody Exception Truly Harmonised?: An Empirical Analysis of the Member States' Case Law Post-Deckmyn' (2023) 2 *Intellectual Property Quarterly*, pp. 59-81 (demonstrating that changes are incremental); Sabine Jacques, 'On the wax or wane? The influence of fundamental rights in shaping exceptions and limitations' in E. Rosati (eds.), *The Routledge Handbook of EU Copyright Law* (Routledge, 2021) chapter 12 (demonstrating that the copyright parody exception remains misunderstood).

may exploit this legal uncertainty to disguise acts of copying through minimal alterations under the pretext of parody. Such misuse of the exception might potentially devalue the entire design system.

The new proposed exception intends to strike a fair balance between the prerogatives of right-holders (protected by article 17.2 EUCFR,[75] 1 Protocol No.1 to the ECHR,[76] 27.2 UDHR,[77] and 15.1(c) ICESCR[78]) and makes a stronger commitment to freedom of expression, freedom of art and science and the right to science and culture (as enshrined in articles 11 & 13 EUCFR, 10 ECHR,[79] 19 UDHR, 27.1 UDHR, 15(1)(a)-(b) ICESCR) than the current version of the directive and regulation.

Enabling the creation of parodic expressions plays a vital role in invigorating public discourse. In an era where design products increasingly encompass a cultural and symbolic dimension, the reworking of these designs for satirical and parodic purposes serves the dual function of eliciting laughter and fostering meaningful debate. This process contributes to diversifying the range of voices and perspectives heard in society, effectively challenging prevailing social, political, and cultural positions, unveiling inconsistencies, and stimulating critical thought and dialogue. To illustrate the impact of this practice, one can turn to the 2011 'Simple Living' case in which Louis Vuitton sued Nadia Plesner for replicating its handbag design – the Audra bag - on T-shirts and posters featuring an African child holding a Chihuahua dog and later, as part of a wider painting, 'Darfurnica'.[80] Simple Living aimed to draw attention to the Darfurian crisis, at a time when the media predominantly fixated on trivial matters such as Paris Hilton's legal issues. At first, Louis Vuitton's claim found support in *ex parte* proceedings held at the District Court of The Hague. On appeal before the District Court of Amsterdam, both parties invoked fundamental rights as enshrined in the ECHR. Plesner relied on Article 10 of the ECHR, which upholds the freedom of expression, while Louis Vuitton cited Article 1 of the First Protocol to the Convention,[81] concerned with property protection. The initial assessment by the Court of Amsterdam concluded that, within the specific context, the paramount importance of enabling Plesner to freely express her viewpoints through her use in 'Simple Living' outweighed the significance of safeguarding Louis Vuitton's enjoyment of her property rights by balancing conflicting fundamental rights of equal footing. Beyond the promotion of societal discourse, a design parody exception would give legitimacy to critical design movements, including associative and satirical designs where designs are 'less about problem solving and more about problem finding within disciplinary and societal discourse'[82], recognising that these are integral forms of product designs.

[75] Charter of Fundamental Rights of the European Union (18 December 2000) (2000/C 364/01).
[76] European Convention on Human Rights 1950.
[77] Universal Declaration of Human Rights 1948.
[78] International Covenant on Economic, Social and Cultural Rights 1966.
[79] The ECtHR emphasised on numerous occasions the broadness of this right which includes ideas and information which shock, disturb or offend to satisfy pluralism, tolerance and broadmindedness. See e.g. *Handyside v. United Kingdom* [1976] ECHR 5, (1976) 1 EHRR 737, para 49. Exceptions to this right must therefore be construed strictly and their need must be convincing (ECtHR, *Stoll v. Switzerland*, Application no. 69698/01, para 101. Finally, the ECtHR reiterated that States have a positive obligation in protecting the exercise of this right which includes ensuring that there are effective domestic mechanisms to create a favourable environment for facilitating public discourse (ECtHR, *Dink v. Turkey*, applications no. 2668/07, 6102/08, 30079/08, 7072/09 and 7124/09, para 137).
[80] For a more comprehensive discussion of this litigation, Lucie Guibault, 'The Netherlands: Darfurnica, Miffy and the Right to Parody' (2011) 2 *J. Intell. Prop. Info. Tech. & Elec. Com. L.*, p. 236.
[81] As confirmed by the ECtHR in *Anheuser v Bush*, 11 October 2005, IER 2007/46.
[82] Ramia Mazé, *Occupying Time: Design, Technology, and the Form of Interaction* (Axl Books, 2007), p. 211.

Moreover, the incorporation of the parody exception holds the potential to catalyse design innovation and creativity. Parody, pastiche, and related artistic forms serve as valuable tools for stretching the boundaries of traditional thinking, challenging established design norms, and potentially giving rise to entirely novel design products, services, and experiences. This, in turn, may pave the way for the emergence of fresh design movements. Indeed, there exist numerous instances within the industry where the act of caricaturing others' designs has yielded valuable insights into how to enhance one's own design endeavours. For instance, Michael Schrage, a research fellow at MIT, routinely encourages his teams to engage in caricatural design as an integral facet of the creative process, aiming to glean profound insights into the enhancement of user experiences, commonly referred to as UX designs. In one such exercise, Schrage tasked a design team with emulating the design principles of an entity such as Amazon for a new B2B web service. According to Schrage, this challenge prompted the team to perceive the user experience through a different lens, ultimately leading to innovative approaches in addressing information display trade-offs on these platforms. Schrage discerns the value of design parody not in merely drawing attention to the distinguishing features of a successful product design but rather in the amplification and exploitation of these successful attributes to unravel fundamental design truths. Thus, design parody stands as a potent and, in many respects, a quite serious force in the world of design.

The introduction of a design parody exception consequently holds significant economic advantages. Primarily, it upholds the fundamental principles of free market competition, ensuring the efficient exchange of ideas and products within the marketplace. Notably, design rights can sometimes stifle innovative entrepreneurial activities. As an illustration, the fashion industry is a sector that, paradoxically, thrives on emulation and copying whilst simultaneously endorses substantial communicative elements on par with verbal communication both at individual and collective levels.[83] Therefore, the incorporation of this exception plays a pivotal role in enhancing overall market efficiency whilst ensuring that right owners' legitimate interests are respected.[84]

Finally, as mentioned above, the introduction of a design parody exception tries to address IP overlaps issues facilitated by the cumulation of IP rights over expressions. By aligning the design parody exception on the copyright parody exception, harmonisation will be facilitated, and one IP regime is less likely to trump another. Returning to the *Simple Living* case, Louis Vuitton could have chosen to argue the case under copyright or trade mark laws to limit the sale of the t-shirts and posters featuring the African child wearing the bag and holding the chihuahua bag. However, they decided to pursue this case solely based on its registered community design for the 'multicolor canvas design' of the handbag. Given the existence of a copyright parody exception and due cause under trade mark law, it is arguable that Louis Vuitton chose this right for its lack of flexibility. Furthermore, this strengthening of defences should decrease strategic litigation such as in the *Simple Living* case, especially considering

[83] As acknowledged in *Cohen v. California*, 403 U.S. 15 (1971) ('wearing a jacket with the lettering "Fuck the draft. Stop the war"'); *Tinker v. Des Moines Independent Community School District* 393 U.S. 503 (1969), (wearing black armbands to protest the Vietnam war is protected as 'closely akin to pure speech') see also Malcolm Barnard, *Fashion as Communication* (Routledge, 1996). Arguing that the cumulation of IP rights damages the fashion industry, see Lucrezia Palandri, 'Fashion as art: rights and remedies in the age of social media' (2020) 9(9) *Laws*, p. 12.

[84] Although, the authors acknowledge that this should not be the only element of consideration and that legal considerations of justice mandate that a goal of merely producing economically valuable goods should not be a legal concern.

the expansion of the notion of 'use' under the proposed Design Package or where the design is the product (three-dimensional items as the design and the product are inseparable).[85]

In sum, it is undeniable that the introduction of the parody exception contributes to the preservation and advancement of the fundamental right to freedom of expression. It provides a necessary avenue for designers to offer critical commentary on diverse subjects such as designs, conventions, ideas, and societal matters. Nevertheless, the incorporation of such an exception must be coupled with reasonable limitations. The internationally recognised three-step test underscores that this exception should not conflict with the normal exploitation of the work and should not unreasonably prejudice the legitimate interests of right-holders, while still respecting the legitimate interests of third parties.[86] Consequently, to strike the delicate equilibrium between fulfilling international obligations, including those devoted to the freedom of the arts and sciences, and simultaneously addressing the concerns of rights holders as outlined earlier, the precise framing and interpretation of this exception remain of paramount significance.

4. Shaping the Design Parody exception

In the current versions of the proposal, the design parody exception seems to broadly align with its copyright law counterpart. However, as discussed below, although the exception's stated purpose exclusively references 'parody,' this article argues that it should also encompass other related genres such as satire, caricature, and pastiche. The proposed language also aims to limit the exception's scope by making its application contingent on adhering to 'fair trade practices' and ensuring it does not 'unduly prejudice the normal exploitation of the design'. This section initiates by examining the proposed structure of the exception and provides recommendations for refining its language. Additionally, given the significant parallels between the copyright and design parody exceptions, it is reasonable to anticipate that the challenges encountered in applying the former will persist in the latter's application. Following this, the section provides practical guidance for judicial interpretation, emphasising compliance with the human rights framework and the importance of respecting cultural sensitivities.

4.1. The form of the design parody exception

The proposed design parody exception is articulated as follows: 'The rights conferred by a design right upon registration shall not be exercised in respect of [...] (e) acts carried out for the purposes of comment, critique, or parody.'[87] Additionally, this exception is subject to the condition that 'the acts are compatible with fair trade practices and do not unduly prejudice the normal exploitation of the design.'[88] Furthermore, this provision does not mandate the inclusion of an indication of the source.[89]

In comparison with copyright where the parody exception is clearly distinct from the quotation exception,[90] the proposed text amalgamates the purposes of 'comment, critique, or parody' under the same cluster. However, it is a misconception to consider these purposes as belonging to the same genre. Quotation, understood here to encompass criticism or review, entails the reproduction of the

[85] Recital 11, article 19(d) New Design Regulation; recital 28, article 16 recast Design Directive.
[86] Article 26.2 TRIPS.
[87] Proposed new article 18 recast Design Directive; article 20 new Design Regulation.
[88] Article 18(2) recast Design Directive; article 20(2) new Design Regulation.
[89] Ibid.
[90] Article 5(3)(d) for quotation and article 5(3)(k) for parody in the Information Society Directive.

source material to convey the same expression as the original. This creates an expectation of accuracy on the part of the public. Conversely, parody is a form of expression that frequently employs incongruity or irony to comment on the source, its creator, or external subjects such as conventions, institutions, or societal issues. While it would be advantageous if the parody exception were distinct from critique and comment, the current text should be interpreted as accommodating at least two distinct exceptions with separate conditions, namely, quotation and parody, due to their contrasting nature and purpose.[91] Indeed, in copyright law, the conditions for parody on the one hand and quotation, criticism and review on the other hand are different.[92] If the exceptions are not aligned on this point in both systems, again we will see litigants use the least favourable system (here copyright law's quotation, criticism or review exceptions) instead of design law to 'game' the system, like Louis Vuitton did in the Simple Living case. Our proposed interpretation not only supports the formulation of judicial criteria that align with the objectives of the proposed design reform but also addresses issues related to the interaction between copyright and design rights.

Furthermore, it is important to highlight the absence of the purposes of caricature and pastiche within the proposed text of the design parody exception. While this omission may be a response to existing challenges in copyright law, it is imperative to acknowledge that related genres such as caricature, satire, burlesque, and pastiche should also be encompassed by this exception. These genres share close connections and represent diverse forms of creative expression that utilise humour to varying degrees. Given the intricate and multifaceted nature of parody, it is impractical to define it without encompassing other related genres such as satire, caricature, and pastiche.[93] It is not the role of judges to evaluate the aesthetic qualities of a work or design, nor is it appropriate for them to dictate the permissible artistic genres, as this would infringe upon artistic freedom as protected by the Charter. Including these related genres is not only in line with the human rights framework, which has consistently recognised the significance of satire in democratic societies,[94] but it also acknowledges the importance of satirical design and other forms of critical design as valid design movements. This, in turn, contributes to fostering innovation and disrupting the conventional patterns of design creativity. The interpretative guidance of the CJEU on whether pastiche requires bespoke requirements for its application is in this respect eagerly awaited.[95]

The existing text of the draft parody exception is supplemented with safeguards to protect the rights of original designers and align with international obligations established by the three-step test. The requirement that the exception should not conflict with the normal exploitation of the design should be readily met in the case of genuine parodies. Indeed, this form of expression involves copying the source material with the intention of transforming the original expression, utilising humour to give rise to a novel and distinct expression. Parody, as a form of expression, generates new designs or expressions by imbuing the source material with a unique and separate purpose. For instance, consider

[91] More on this in the next section when discussing *Deckmyn* and the two main characteristics of parody.
[92] The work must have been made available to the public and there must be a sufficient acknowledgment for the exceptions of criticism, review and quotation in copyright law.
[93] Sabine Jacques, *The Parody Exception in Copyright Law* (OUP, 2019) Chapter 1.
[94] *Welsh and Silva Canha v. Portugal*, application n. 16812/11, para 29; *Eon v. France*, application n. 26118/10, para 60; *Alvesda Silva v. Portugal*, application n. 41665/07, para 27; *Vereinigung Bildender Künstler v. Austria*, application n. 68354/01, para 33; *Tuşalp v. Turkey*, application numbers 32131/08 & 41617/08, para 48; *Ziembiński v. Poland*(no. 2), application n. 1799/07, para 45; *Handzhiyski v. Bulgaria*, application n. 10783/14, para 5; *Gachechiladze v. Georgia*, application n. 2591/19 , para 55.

[95] Case C-590/23 (Pelham 2).

the work of Katerina Kamprani in her 2017 project 'The Uncomfortable,' which involves reimagining everyday objects to render them functionally absurd, exemplified by the 'engagement mug'.

Figure 2 Engagement Mugs by Kamprani available at https://www.theuncomfortable.com/portfolio/engagement-mugs-2/#open

Another notable example is the work of Ralph Ball and Maxine Naylor, titled '24 Star Generic Office Chair,' created between 2003 and 2004.[96] In this instance, the designers sought to address the issues of product obsolescence and consumption. To do so, they replicated the Johnson secretarial chair, originally designed by Frank Lloyd Wright for the Johnson Wax Company building. Notably, the historical office chair was initially designed with three legs to encourage good posture (failing to sit correctly would make the user tip over and learn the hard way) and later modified to a four-legged chair by consideration for the Johnson Building visitors who were more prone to fall. However, over time, design improvements led to the adoption of a five-legged base for enhanced safety, rendering the older three-legged chairs obsolete. Ball and Naylor's innovative approach involves preserving an original chair's design by incorporating a five-legged base, thereby making a statement on the disposable nature of consumer products.

Figure 3Figure 3 Frank Lloyd Wright's office chair, source: https://static.dezeen.com/uploads/2023/01/racine-collection-frank-lloyd-wright-steelcase_dezeen_2364_hero-1704x959.jpg

[96] See http://studioball.co.uk/index.php/archaeology/ (last access 14/12/2023).

Figure 4 Ball and Naylor Archaeology of the Invisible source: http://studioball.co.uk/wp-content/uploads/2013/10/24Star.jpg

In the digital domain, Soren Iverson's work involves replicating features from popular apps to offer commentary on our interactions with technology. This includes instances like encountering ChatGPT within Apple iMessages, witnessing an Instagram feature that permits users to pay a fee to retract 'deep likes', or experiencing a Tinder review system reminiscent of Lyft-style ratings.

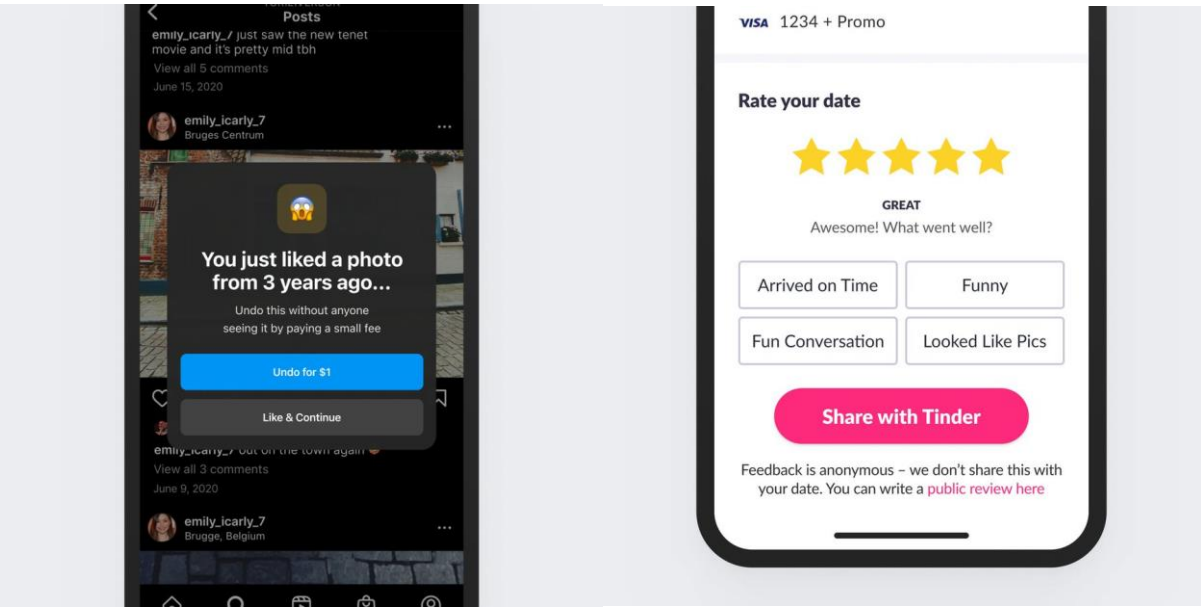

Figure 5 Soren Iverson Can You Imagine? Source: https://twitter.com/soren_iverson

Expanding upon the examples provided above, it is important to note that these parodic instances, while not exhaustive and presented in a somewhat hypothetical context, further demonstrate the distinct nature of these expressions and their lack of conflict with the normal exploitation of registered designs. However, it is plausible that right-holders may attempt at raising objections to such uses due to concerns about potential damage to their reputation, unless a specific defence is available.[97] In summary, the act of reproducing a design for parodic purposes results in an evolution of the original design that caters to a different market, driven by its distinct purpose and objectives. This shift in

[97] As exemplified in the Simple Living case. Arguing that reputation should not be a reason for a designer to seek the enforcement of design rights successfully, see Lucie Guibault, 'The Netherlands: Darfurnica, Miffy and the Right to Parody' (2011) 2 *J. Intell. Prop. Info. Tech. & Elec. Com. L.*, p. 236.

purpose and market orientation ensures that parodic uses do not unduly interfere with the normal exploitation of the registered design.

Subjecting the exception to fair trade practices is more problematic.[98] Directly bringing in mind the notion of 'honest practices in industrial and commercial matters' in a trade mark context, such requirement finds its origins in the provisions of the Paris Convention and the obligation for member states to prevent unfair competition.[99] In other words, if parodic and satirical designs are permitted it is only to the extent that these uses do no legitimise unfair competitive practices by others. In a trade mark context, this has evolved into a 'duty to act fairly' towards the trade mark owner.[100] This involves an objective test where a thorough assessment of all relevant factors prevails.[101] Although this provision is theoretically broad in its concept of fairness, subsequent developments mandated by the CJEU introduce specific requirements for a defence to be applicable. These requirements are likely to pose challenges in the context of parodic designs. The Court has stipulated that a use will not be in line with honest practices if it creates the impression of a commercial connection between the reseller and the trademark proprietor, if it adversely impacts the value of the trademark by taking unfair advantage of its distinctive character or reputation, if it discredits or denigrates the mark, or if it presents its product as an imitation or replica of the product bearing the trademark.[102] This more stringent interpretation of fairness places parodists in a challenging position.

While some aspects of the honest practices in trade mark law should not normally create problems for parodies of designs (as in many cases, there will not be an impression of commercial connection given the incongruity created), other aspects would be bound to make the defence fail most of the time. Firstly, it raises a peculiar conundrum to demand that the defendant proves a point they have already failed to establish during the infringement assessment – namely, that the original design has not been copied. This requirement seems somewhat contradictory, given that the essence of parodic design is rooted in the transformation and reinterpretation of the source material. If the informed user, regular user of articles of the same sort as the registered design, could not reasonably have conceived the parodic design based on the original, it becomes paradoxical to subsequently subject the parodic work to the prevailing behavioural norms and industry standards within the commercial sector.[103] There may be also valid reasons why some of these requirements cannot be met, such as a use that negatively affects the value of the protected design due to a legitimate criticism or shifts in consumer preferences.

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[98] Annette Kur, Tobias Endrich-Laimböck, Marc Huckschlag, Position Statement of the Max Planck Institute for Innovation and Competition of 23 January 2023 on the 'Design Package' (Amendment of the Design Regulation and Recast of the Design Directive) (24 January 2023) p. 10, available at https://www.ip.mpg.de/fileadmin/ipmpg/content/stellungnahmen/MPI_Position_Statement_on_the_Design_Package_01-25.pdf (last access 14/12/2023).

[99] Paris, Article 10bis(2). Additionally, in *Anheuser-Busch v. Budvar*, Case C-245/02 [2004] ECR I–10989 (Grand Chamber) the Court referred to article 17 TRIPS which requires considering the legitimate interests of the right-holder. By analogy, the legislator intends to use this honest practices proviso as a way to satisfy part of article 13 TRIPS.

[100] CJEU C-63/97, *BMW v. Deenik*, [1999] ECLI:EU:C:1999:82, [61]; C-17/06, *Céline Sàrl v. Céline SA*, [2007] ECLI:EU:C:2007:497, [32]; C-100/02, *Gerolsteiner Brunnen v. Putsch* [2004] ECLI:EU:C:2004:11, [24]; C-245/02, *Anheuser-Busch v. Budvar*, [2004] ECLI:EU:C:2004:717, [82]; Case C-228/03, *Gillette v. L.A–Laboratories*, [2005] ECLI:EU:C:2005:177, [41]; Case C-558/08, *Portakabin v. Primakabin*, [2010] ECLI:EU:C:2010:416, [67].

[101] 'An overall assessment of all relevant circumstances' in Case C-228/03, *Gillette v. L.A–Laboratories*, [2005] ECLI:EU:C:2005:177 [46]; 'a global assessment of all the relevant circumstances' in Case C-93/16, *Ornua Co-operative v. Tindale & Stanton*, EU:C:2017:571, [44].

[102] Case C-228/03, above n. 100, [42]–[45], [49]

[103] Lotte Anemaet, 'Which Honesty Test for Trademark Law? Why Traders' Efforts to Avoid Trademark Harm Should Matter When Assessing Honest Business Practices' (2021) 70(11), *GRUR International*, pp. 1025–1042.

Secondly, as argued by Senftleben in a trademark context, the alignment of the fairness rule with industry and commerce behavioural standards is problematic.[104] Parodists are unlikely to be well-versed in such standards, and subjecting artistic genres like parody, satire, and related forms to industrial to commercial assessment standards influences the creative process by requiring parodists to consider commercial fairness standards in their work from the outset.

In addition, the notion of honest practices is not a notion which should be imported in design law.[105] A strong commitment to artistic autonomy necessitates the removal of the honest practices provision during the negotiation process. This approach should be complemented by a robust safeguard to ensure that freedom of expression remains protected throughout. It is noteworthy that recital 15 in the proposed regulation and its corresponding recital 32 in the Recast Directive explicitly subject the honest practices provision to the full framework of fundamental rights, with particular emphasis on the right to freedom of expression. As the forthcoming section will expound, this objective can be effectively realised through customised judicial guidance tailored to parodic uses.

Another challenging aspect of incorporating trademark notions into the evaluation of the parody exception (as well as for quotation and criticism, given the current language of the recast directive and new regulation) is that it introduces a 'polluting' element. This occurs as an attempt is made to exclude from trademark law shapes that confer substantial value to a product, mainly because such shapes are typically already protected by design and/or copyright laws. Although article 4(1)(e)(iii) of the trademark directive and 7(1)(e)(iii) of the trademark regulation generally prevent an overlap between trademark law and design/copyright laws, the concept of honest practices resurfaces, creating complications for design law through the parody exception.

4.2. Judicial interpretative guidance

The ways in which a legitimate parody can be distinguished from illegitimate use of a registered design begins with transposing the teachings from *Deckmyn* into a design context.[106] In *Deckmyn*, the CJEU interpreted the copyright parody exception for the first time. Dealing with a modified version of a famous Belgian comic book cover, Suske en Wiske, by a Belgian political party, the Vlaams Belang, in one of their campaigns to comment on the public spending of the mayor of the city of Ghent, the CJEU established that parody constitutes an independent concept of EU law, without defining parody. The CJEU nevertheless outlined two characteristics that all parodies must meet: they must express humour or mockery and evoke a copyright-protected work while being noticeably distinct from it. Furthermore, the CJEU mandated national courts to conduct a proportionality test, balancing conflicting fundamental rights.[107]

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[104] Martin Senftleben, Robustness Check: Evaluating and Strengthening Artistic Use Defences in EU Trademark Law (2022) 53 IIC, 567-603; The author speaks of 'corrosive effect' of the development of honest practices in relation to defences. This leads the author to argue that there should be a presumption that fairness is present, and the burden of proof lies on the right-holder to prove the use unfair.

[105] Estelle Derclaye, Right and Wrong Analogies. The CJEU's Use of Trade Mark Concepts in Copyright and Design Law (2020) *European Intellectual Property Review* pp. 73-83; David Musker, 'Making citations'—mystery or mistranslation? The Opinion of Advocate General Bot in *Nintendo v BigBen* (2017) 12(10) *Journal of Intellectual Property Law & Practice*, pp. 834–836 and David Stone, Design law misplayed in Nintendo AG Opinion (2017) 12(7) *Journal of Intellectual Property Law & Practice*, pp. 558–564 (both noting that the exception for acts of reproduction for the purposes of making citations or of teaching in the design directive is derived from copyright law).

[106] C-201/13, *Johan Deckmyn, Vrijheidsfonds VZW v Helena Vandersteen and Others*, 2014, ECLI:EU:C:2014:2132.

[107] Ibid, at 25.

While the CJEU's ruling in the *Deckmyn* case provided important clarifications, it left certain aspects open to interpretation. These include determining the range of humorous expressions that qualify as parodies, whether the evaluation of humour should consider the intent of the parodist or its impact on the audience, the extent of permissible copying for parody, a change of context as a parodic use, and the precise application of the proportionality test.

Considering these questions, it is advisable to prioritise the factors of *intent* of the speaker and *context* in which an argument is made, a stance aligned with the European Court of Human Rights (ECtHR) jurisprudence. In a case involving political satire intertwined with unlawful sexist hate speech, which centred on a series of cartoons published on a blog, the ECtHR rendered a unanimous decision. [108] The cartoons primarily addressed an ongoing political discourse, offering critiques of the municipal leadership. Although one female member of the municipal board was subjected to sexual stereotyping in the caricatures, the ECtHR's verdict affirmed that these depictions remained within the boundaries of exaggeration and provocation characteristic of satirical expression.

Evaluating the humorous element based on the intent of the user or designer is a sound approach that allows for the broad spectrum of humour to thrive. Given the inherent versatility and elusive nature of humour, it is posited that humour should be construed as a permissive requirement. In essence, if the boundaries of freedom of expression are upheld and provided that the public is able to detect the humorous intent of the parodist often through the level of incongruity present,[109] this requirement would be deemed met. Nevertheless, should a parodic use exceed these boundaries, resulting in undue harm to the original right-holders or their creations, the full force of the law should come into play. This approach, while accommodating all facets of humour also ensures that the judiciary is not compelled to render decisions on artistic processes or genres.

Recurring discussions underscore the significance of considering context in interpreting humour, particularly in relation to political, socio-cultural, and historical circumstances surrounding the expression in question. A notable example is the *Leroy v. France* case,[110] where the ECtHR upheld the conviction due to the cartoon being published in a politically sensitive region of France only two days after the terrorist attack on the World Trade Centre. Here, courts must take into consideration all circumstances of the use. Therefore, whether the use contributes to a public debate, the standing of the target of the comment made through the parodic use, the standing of the speaker, the speaker's prior conduct, the place of communications etc. all contribute to appraising the context in which the humorous expression was made.[111]

In cases where this is not self-evident, the parodist must employ sufficient contextual cues to ensure that any lingering confusion is dispelled. In design history, this would be often the case in Juvenalian satire whereby the public may be less familiar with the registered design and requires more contextualisation through supporting information for the public to understand the references made.[112] This approach entails a flexible, contextual evaluation, allowing the courts to consider factors such as the nature of the expression, its content, the identity of the speaker, and other pertinent circumstances. This multifaceted assessment safeguards against potential abuses of the parody

[108] ECtHR, *Monteiro Patrício Monteiro Telo de Abreu v Portugal*, (7th June 2022) RG n°42713/15, at 44.
[109] See Alberto Godioli & Jennifer Young, *A Comparative Analysis of Global Case Law* (Global Freedom of Expression Report – Columbia University, June 2023) p. 34.
[110] ECtHR, Leroy v France, 2/10/2008, n. 36109/03.
[111] Godioli & Young, above n. 107, p. 36.
[112] Therefore, in compliance with the *Abreu* ruling (above n. 106), assessing whether the disputed product use to an established genre of critical design can also help in appreciating the context of the use and facilitate the application of the parody exception.

exception under the pretext of humour, rendering a mere 'just joking' defence insufficient whilst simultaneously facilitating innovation and creativity and making a strong commitment to freedom of expression. Under such conceptualisation, commercial use of the parody design is possible. Yet, it also provides safeguards for the right-holders by giving the courts the means to investigate what is being commercially exploited; if the object of commercialisation is the new expression, then this should be fair.[113]

Importing the *Deckmyn* decision into design law is far less dubious and dangerous than using trade mark notions and will achieve the same goal. As we said earlier, the exceptions in the design directive and regulation are inspired from copyright and patent law. And while the EU took a bespoke design approach, it is clear that designs sit at the junction between these regimes. Because the parodist must make the parody noticeably different from the original design, there should not be any confusion. There is therefore no need to import trade mark notions including the trade mark honest practices concept into the exception.

5. Conclusion

The inclusion of a parody exception within EU design law is a laudable development. In an era where parody was once primarily associated with literary and theatrical forms, its scope has significantly expanded to encompass a wide array of objects and artistic forms. The facilitation of design parody serves a multifaceted purpose. It not only acknowledges the significant creative merit inherent in these expressions but also extends the boundaries of creative expression in the realms of design and the arts. This expansion leads to diversification and innovation in these creative domains.

Moreover, by accommodating design parody, the new provision effectively disrupts established patterns of artistic creation. This disruption is instrumental in cultivating a dynamic and ever-evolving creative environment. In essence, the introduction of the parody exception brings forth a progressive transformation within the creative landscape, offering new dimensions of expression and artistic exploration. In a cultural economy, design parody is crucial to facilitate the dissemination of meaning and alternative viewpoints. As a cultural artifact, parodies not only activate the public's memory of the copied registered design or work of applied art, but elicits an emotional response ranging from amusement, critical thinking, empathy, discomfort, indignation to reflection. These emotional responses can therefore vary greatly and are interdependent on the content, the personal experiences of the public as well as the context in which these are presented. These responses contribute to the effectiveness and impact of parodic works in conveying messages and initiating discussions on important issues.

We therefore recommend amending the text of the new provision as follows:

- delete the reference to honest and fair practices,
- separate comment and critique from parody and require the same conditions to each of them as in the Information Society Directive,
- include caricature and pastiche alongside parody.

Beyond this, we regret that there is not a fuller alignment with copyright exceptions as now that the directive and regulation have embraced the CJEU's case law in *Cofemel* and *Brompton*, more designs

[113] ECtHR, *Gachechiladze v. Georgia*, 22/07/2021, n. 2591/19.

will attract copyright protection in countries where they could not in the past and thus more strategic litigation (using one law instead of the other) could occur.[114]

[114] Although many of these countries' courts are still 'resisting' the CJEU case law. See. E. Derclaye, 'The status of three-dimensional functional works post-Cofemel. An empirical analysis of the Member States' case law', forthcoming 2024 available on SSRN at https://papers.ssrn.com/sol3/papers.cfm?abstract_id=4300926 (last access 14/12/2023).