



Gamification Code:

TRADE



The Dual Shield

*Navigating the overlap of copyright
and design law and maximising
protection at the intersection
of IP Rights*





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Designs, Copyright and the Overlap in Europe

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September 2026

Navigating the intersection of IP rights to maximize protection and manage cross-border risks.



Product images courtesy of Flos S.p.A., Stokke AS, and USM Modular Furniture.

Design Rights vs. Copyright

Design Rights: (Outside)

- Protects Product Appearance
- Novelty, & Individual Character
- Requires Registration
- Maximum 25 Years from the filing date

Copyright: (Inside)

- Protects Works
- Originality (Author's own intellectual creation)
- Protection is Automatic
- Duration: Life of the author + 70 Years after death

Flos Confirmed the Value of Cumulation

- Can a product protected as a design also benefit from copyright protection?

The CJEU's Answer is Yes. 

→ **The Flos Principle (The Definite Answer):** The CJEU confirmed in 2011 (Flos, C-168/09) that registered design rights and copyright can legally coexist.

→ **Dual-Protection Strategy (Commercial Value):** Design rights provide immediate registered protection on day one, while copyright acts as a long-term fallback after registration expires.

→ **Enforcement Benefit (Multiple Legal Bases):** Rights holders can deploy multiple legal paths simultaneously to stop copycats and counterfeiters.



Source: CJEU, Case C-168/09, *Flos v Semeraro*, para. 34.

The Historical Problem

France & Benelux: L'unité de l'art (Unity of Art) – Low threshold; if it's original, it's protected.

Germany: High threshold (Gestaltungshöhe) – Strictly separated industrial goods from fine art.

Italy: Required distinct Artistic Value (scindibilità) separate from technical function.

Nordics: Historically cautious approach to granting copyright to utilitarian items.



The Mechanics of Harmonization: The Role of the CJEU vs. National Courts

- [National Dispute] →
- [Reference to CJEU (Art. 267 TFEU)] →
- [CJEU Interprets EU Law] →
- [National Court Applies Facts]



From *Flos* to *Cofemel*: Dismantling National Barriers

- *Flos* (2011): The CJEU ruled that EU Member States cannot deny copyright protection to designs (works of applied art) if they meet the general requirements for copyright.
- *Cofemel* (2019): Member states cannot require a special threshold of “aesthetic effect” or “artistic value”. The only requirement is **originality**.



Cofemel case (C-683/17)

Brompton and Mio/Konektra: The Modern Frontier

Brompton (2020): Technical functionality does not automatically kill copyright, provided the creator was able to express their personality by exercising “free and creative choices”.



Case C-833/18 (Brompton), ECLI:EU:C:2020:461

Mio / Konektra (2025): Copyright is independent of design rights, but originality cannot be abstract, it must be visible and clear in the final product. Proof of copying is required to win an infringement case.



Joined Cases C-580/23 and C-795/23 (Mio/Konektra), ECLI:EU:C:2025:941

The Trajectory vs. The Reality: Harmonized Law ≠ Harmonized Outcomes

- **2011 (Flos):** No Protection Gaps — Ruled that registered design rights and copyright can legally coexist. EU countries are strictly forbidden from blocking a product from getting copyright just because its registered design protection expired or because it is a mass-produced item.
- **2019 (Cofemel):** Originality Unified — Declared that "originality" is the *only* test for copyright; states cannot demand extra artistic or aesthetic value.
- **2020 (Brompton):** Functionality Unlocked — Confirmed that functional, technical shapes can still get copyright if the designer had creative freedom.
- **2025 (Mio/Konektra):** Burden of Proof — Clarified that originality cannot be proven by market popularity alone; creators must point to specific, visible creative choices in the final design.
- **Europe has created a single, uniform test, so the rule is unified, but the real-world outcomes remain deeply fractured by cultural and judicial biases.**



BIRKENSTOCK v. SCAPINO

Germany (BGH, Feb 2025)

- No copyright protection for Birkenstock sandal models.
- Court found insufficient artistic originality.
- Distinctive design alone does not qualify as a work of applied art.
- Functional and design constraints limited creative expression.

I ZR 16/24; I ZR 17/24; I ZR 18/24



VS.



Birkenstock

Scapino

Netherlands (Midden-Nederland, Nov 2025)

- Arizona, Madrid and Florida models held copyrightable.
- Court identified creative choices in footbed, contours, cork exposure and construction.
- The Dutch court expressly acknowledged but disagreed with the German decision.
- Copyright infringement found against Scapino.

ECLI:NL:RBMNE:2025:5837



Arizona (1973)



Madrid (1963)

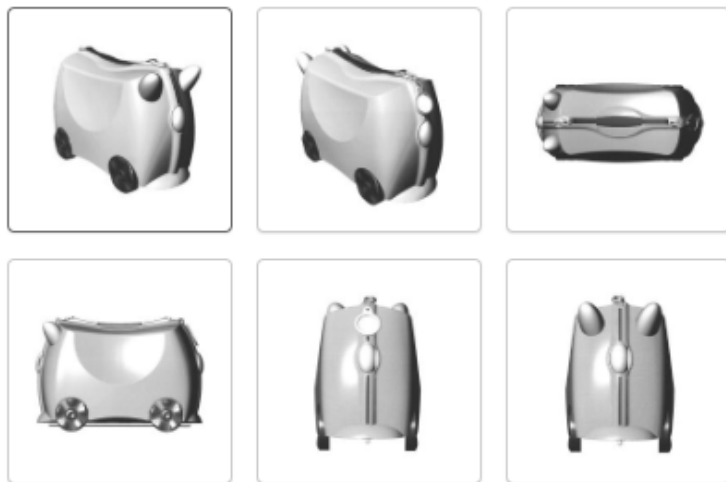


Florida (1982)





Could Trunki be protected by copyright in the EU?



EUD 000043427-0001



UKSC/2014/0147



Risk #1 – The Proof Gap

Can your client prove the creative process decades after market launch?

Evidence Dossier:

- **Design Progression (Substance):** Initial hand-drawn sketches and evolutionary drawings showing alternative design paths to prove active creative choice.
- **Visual evolution (Intent):** Early-stage mood boards, texture palettes, and style references showing the intended aesthetic direction before final production.
- **Technical Verification (Authenticity):** Metadata-stamped CAD files, engineering blueprints, and physical manufacturing prototypes.
- **Chain of Custody (Admissibility):** Historical product catalogs, dated corporate emails, and sales receipts proving the exact timeline of creation and market launch.



Risk #2 – The Chain of Title Trap

Who Owns the Copyright?

Ownership pitfalls:

Initial Vesting (Human vs. Corporate): Design registration does not equal automatic copyright ownership; copyright always begins with the individual human creator.

Contract Gaps (Freelancers & Employees): Standard employment or freelance contracts often fail to transfer international copyright or the right to sue.

Corporate Transfers (Chain of Title): Mergers or restructurings break the chain of title unless old copyright portfolios are explicitly assigned in writing.



Risk #3 – The Cross-Border Litigation Gamble

- **Fragmentation Barrier (Unitary Rights):** No single EU-wide copyright title exists, blocking a central lawsuit against pan-European counterfeiters.
- **The Single Market Paradox (Forum Shopping):** Conflicting local rulings allow competitors to exploit national differences—making a product illegal in the Netherlands but legal in Germany, forcing costly parallel lawsuits.



The Practitioner's Roadmap

File the Design First (Immediate Protection):

Secure immediate, clean, EU-wide registered protection.

Build the Copyright Dossier (Risk Mitigation):

Archive the R&D process during product creation to bridge the proof gap.

Lock Down Chain of Title (Ownership Security):

Execute explicit copyright assignments with all creators, freelancers, and employees.

Select Favorable Jurisdictions (Strategic Litigation): Map out enforcement actions based on local judicial tendencies to combat the single market paradox.

Audit Evidence Periodically (Portfolio Maintenance): Review historical design assets as registration limits approach expiration.



Case Study: The Irony of *Kwantum v Vitra* (C-227/23)

- **The Historical Shift (Material Reciprocity):** The CJEU outlawed the old reciprocity test previously used by national courts to deny copyright to foreign designs.
- **The Single Market Irony (Asymmetric Protection):** Foreign iconic designs can now enjoy stronger, longer copyright protection within the EU than they do in their own domestic home markets.



Source: vitra.com

Case C-227/23 (Vitra), ECLI:EU:C:2024:905; Berne Convention Article 2(7)

Final Takeaway: Stop Asking the Wrong Question

- **The Outdated Approach (Fine Art vs. Utility):**
Arguing whether a client's product is a work of pure art or a functional commercial good.
 - **The Modern Approach (Strategic Overlap):**
Focusing on how a product can exploit design law and copyright simultaneously to achieve market dominance.
- ➔ **Key Message:** Europe has legally embraced the overlap; our job as practitioners is to master the practical risks and opportunities it creates.



Source: fi.aarniooriginals.com



THANK YOU!

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Designs, Copyright and the Overlap in the UK

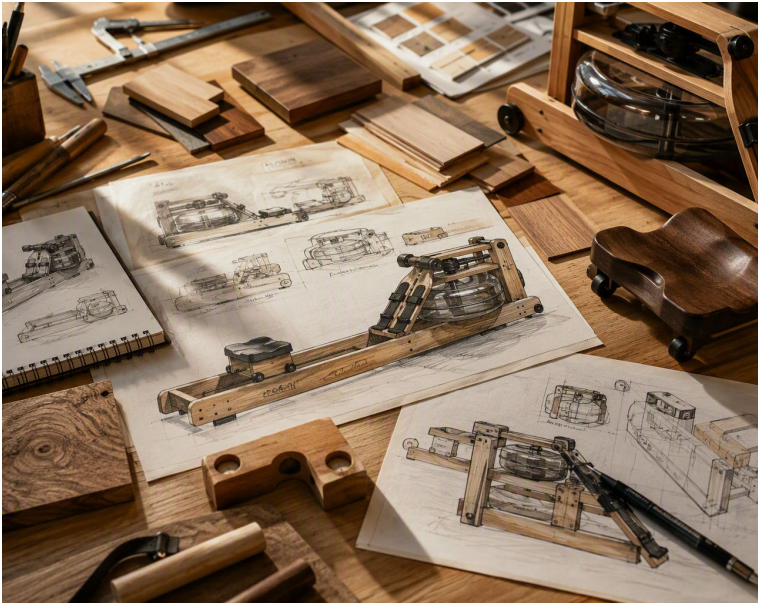
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September 2026

WaterRower – a beautifully designed legal problem



- 1985-87 Developed by former competitive rower John Duke
- Resistance intended to evoke rowing on open water
- A deliberate alternative to conventional metal exercises
- Iterative sketches, testing and prototype development

Assimilated CJEU case law remains binding

- *Flos* – cumulation of rights, availability of design protection does not preclude © protection
- *Infopaq* - Own intellectual creation, expression of free and creative choices
- *Cofemel* – Originality (in the *Infopaq* sense) is the only requirement, and national laws making protection conditional on aesthetic criteria are precluded
- *Brompton* – Even functional objects can be subject of copyright, provided that functional nature of subject matter “*has not prevented the author from reflecting his personality in that subject matter, as an expression of free and creative choice*”

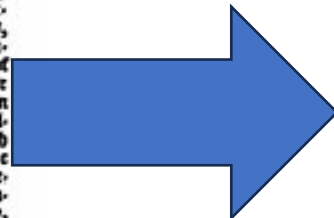
EU ORIGINALITY

PASSED

UK COPYRIGHT

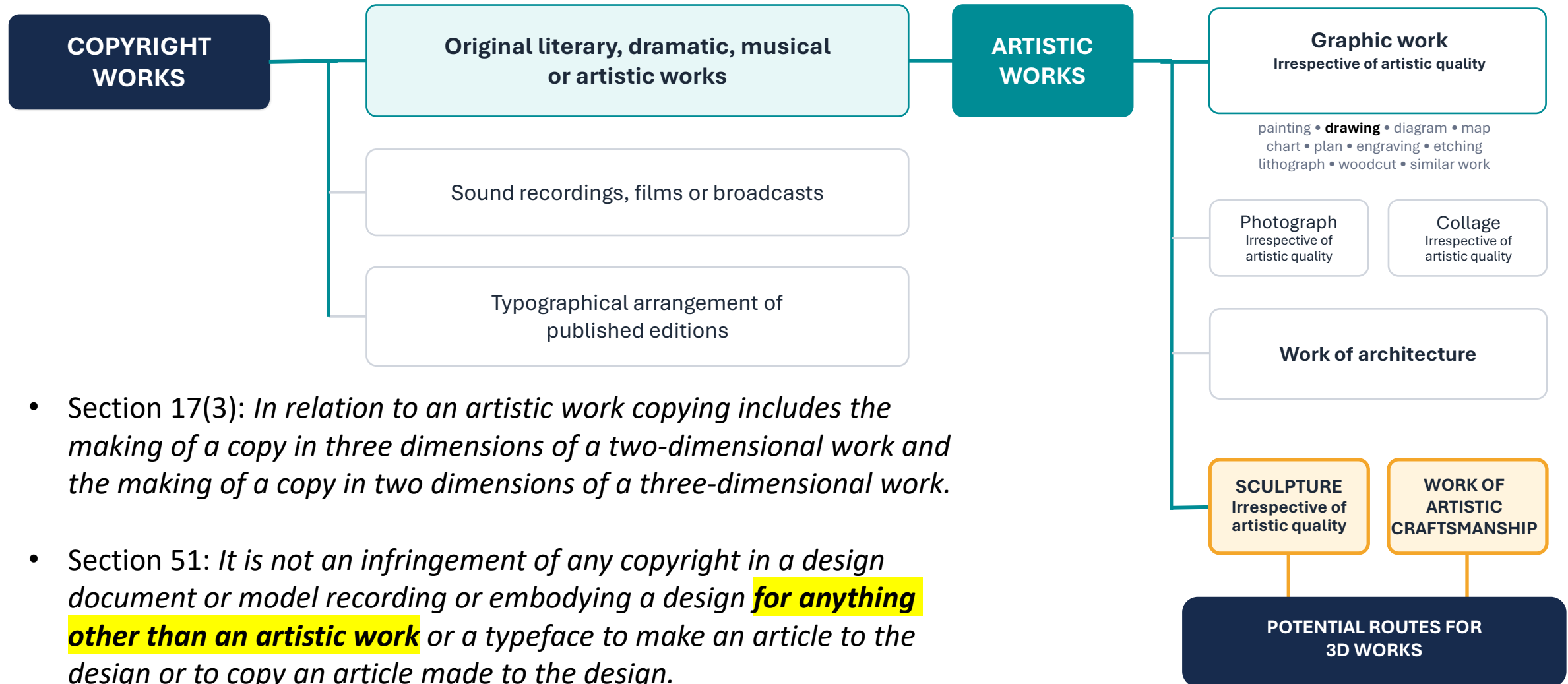
FAILED

The UK's closed categories, a history lesson



Books	1710
Engravings	1735
Sculpture	1814
Photographs	1862
Films	1911
Software	1992

The current state of play (s. 1 and 4 CDPA 1988)



Sculpture?



Image: Stormtrooper © Steven Miller, licensed under CC BY 2.0.

Artistic craftsmanship?

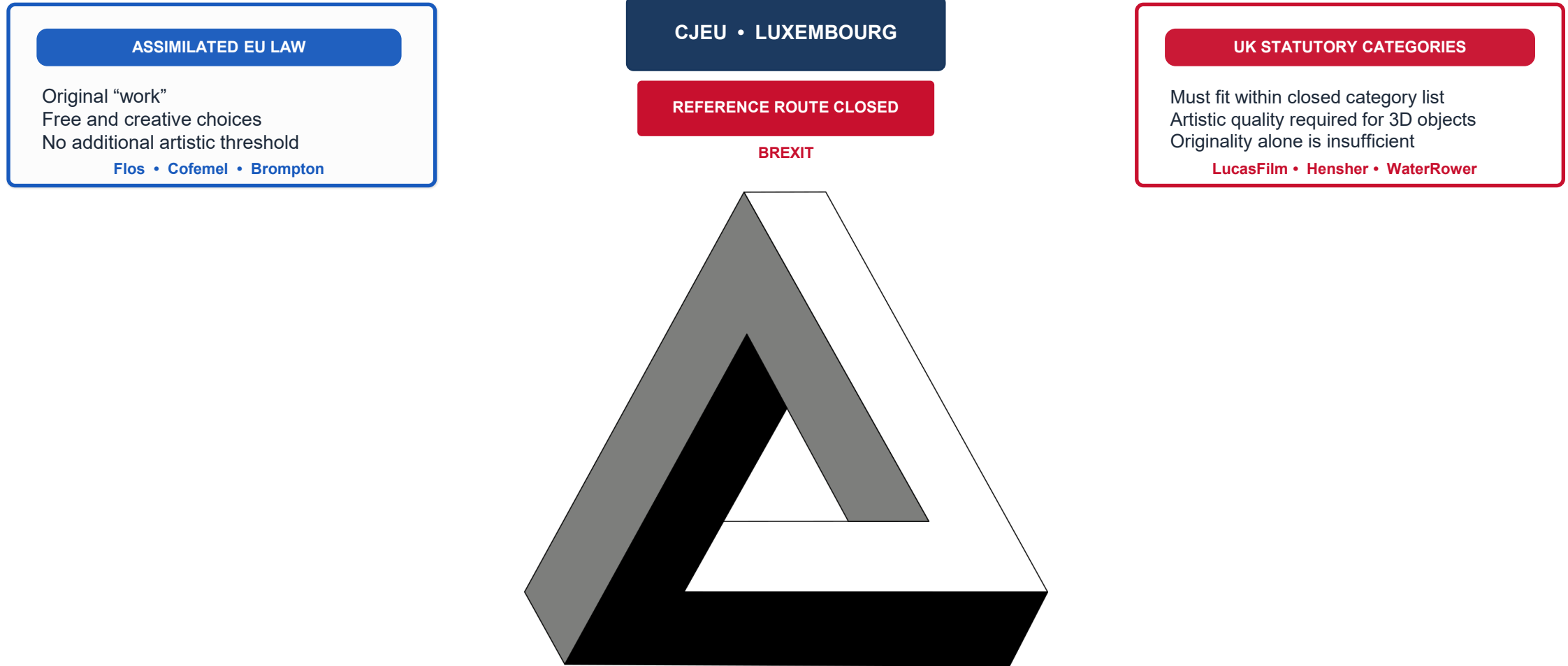


- A distinct and **higher threshold**
- Craftsmanship and artistic expression must **coincide**
- A **medium** worked with craftsmanship
- Artistic expression **not wholly constrained by function**



- Process and product are **interrelated**
- No assessment of artistic merit but **visual appeal alone is insufficient**
- Mass production or industrial exploitation **doesn't preclude** protection

An unresolved conflict, frozen by Brexit



Where does that leave the *Trunki* (and similar designs)?

Registered design*
2D/3D Appearance
Application required
Up to 25 years

UK unregistered design right*
Shape/configuration
Qualification requirements
Copying required
**10 years from first marketing /
15 years from creation**



**Supplementary unregistered
design right (mirrors EU)***
2D/ 3D appearance
First disclosed in the UK
Copying required
3 years

Trade mark?
Distinctive shape or get-up
Must function as an indication
of origin – acquired
distinctiveness
**Potentially renewable
indefinitely**



* Requires novelty

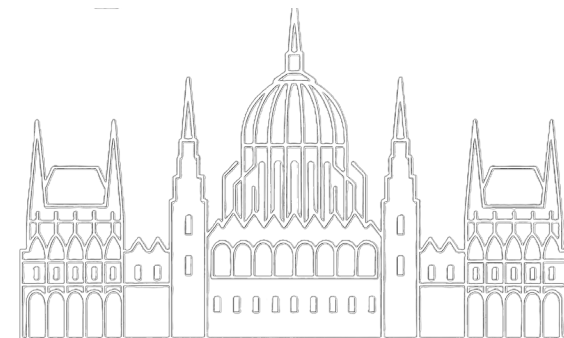


THANK YOU!

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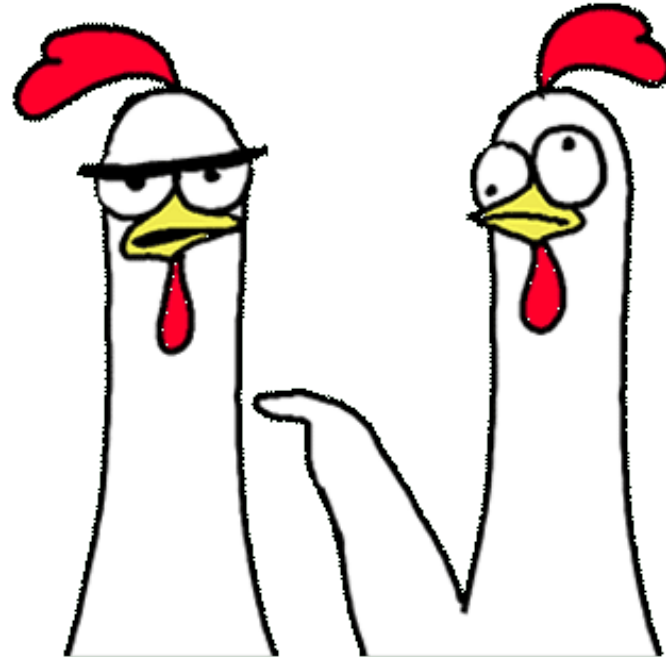
Mavin IP



Designs, Copyright and the Overlap in New Zealand

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September 2026





Registered Design Rights

- Protects product's appearance
- Applies to an **article of manufacture, or set of articles**
- Article(s) must have a functional purpose other than to bear the design (e.g. photographs excluded)
- Excludes *solely* functional features and methods and principles of construction
- Must have **local** novelty and be original (independently created by the designer)
- Scope of protection defined by shape/configuration and/or pattern/ornamentation and extent of difference from the prior art
- **Owner = author, employer, or commissioner.** Can be assigned and licensed. Cannot assign rights in future designs
- Designs of addition available
- Designs for replacement parts allowed (**no must match/must fit limitations**)
- Exclusive legal rights to: **make or import** for sale or use for the purposes of any trade or business, **or to sell, hire, or offer for sale or hire** the design registered or a substantially similar design
- Infringement question: is the alleged infringement the same or substantially similar in appearance from the registered design?
The eye is that of the informed consumer
- **Parallel imports are prohibited**
- Maximum **15 Years** from the **priority** date





Copyright Overview – Industrial Designs



- Automatic, free protection for artistic works according to degree of originality
 - **Low threshold**
- Protects against **copying** of drawings, models/prototypes, moulds and **possessing** and **dealing with copies commercially**
- Intended to protect the expression of an idea, not the idea itself
- Requires originality (author's own intellectual creation)
 - Scope of protection depends on extent of originality – **you get out what you put in.**
- **Owner is the author, employer, or commissioner of the design.** Co-ownership (distinct contribution) or joint ownership (indistinct contribution) where there are multiple authors
- Legal rights (to be assigned and licensed in writing; can assign future rights) and moral rights for the author only (can be waived but not assigned)
- Copying from the drawings of a lapsed or expired design registration or patent is allowed, but only during the period of lapse
- **Parallel imports are allowed**
- Infringement **decisions made by Tribunal or Court** – not by jury. **Three-point test for infringement**
- Duration: **16 years** from date of industrial application (generally: making more than 50 copies for sale or hire, or extruded in 3D)



Copyright Infringement

Step 1 – assess whether there is a copyright work

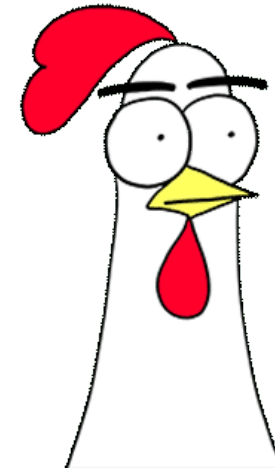
Step 2 - assess whether copyright has been infringed





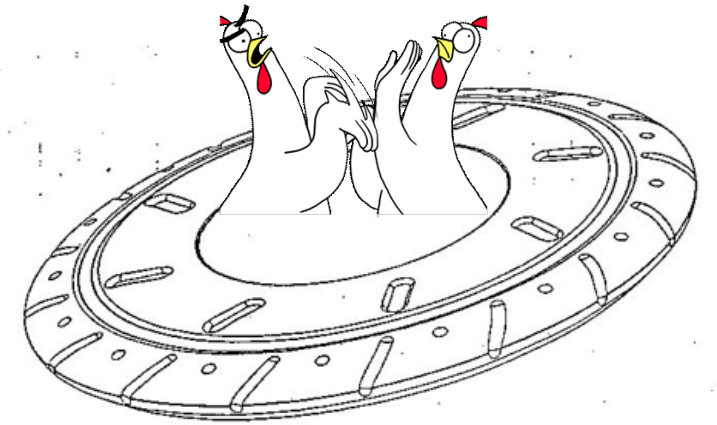
Step 1 - Is there Copyright in the Work?

- Is the work original (not copied) and has the author exercised sufficient skill and judgment when creating the work – it must be the product of more than minimal skill and labour.
- Copyright can derive from an original arrangement of features that are not original in themselves. *Henkel KGaA v Holdfast NZ Limited* [2006] SC 43/2006
- The threshold for originality is low.





Step 2 – Has Copyright been Infringed?



Three-Point test for copyright to be infringed:

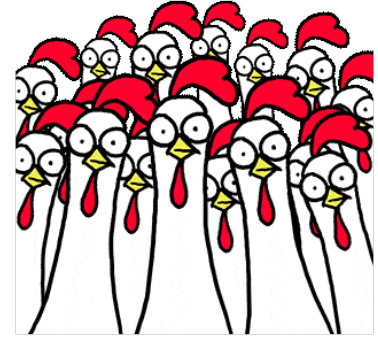
- i. there must be sufficient *objective similarity* between the infringing work and the copyright work, or a substantial part of it;
- ii. there must be some *causal connection* between the copyright work and the infringing work, i.e. the copyright work must be the source from which the infringing work is derived; and
- iii. the reproduction must be either of the *entire* copyright work or of a *substantial part* of it.

Wham-O MFG Co v Lincoln Industries Ltd [1984] 1 NZLR 641 (CA)

Oraka Technologies Limited v Geostel Vision Limited [2013] NZCA 111



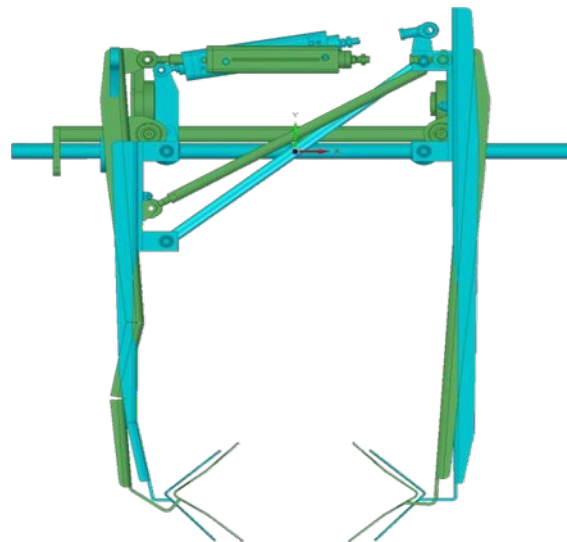
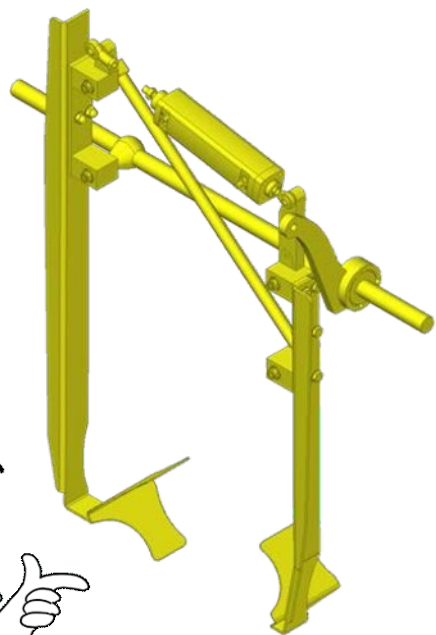
Copyright Infringement – Objective Similarity



- There must be sufficient *objective similarity* between the infringing work and the copyright work, or a substantial part of it
 - If the claimant's copyright work/design is very ordinary given the manufacturing or functional constraints of the product, then the originality of the claimant's work might be non-existent or so low that the defendant can easily avoid infringement by adding one or more small differences.
 - Visual similarity is assessed by the person to whom the work would normally be addressed – be sure to include evidence from this person.



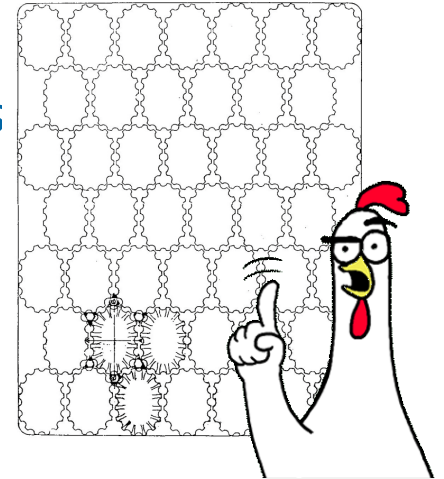
Technopak Ltd v Monzeal Ltd [2024] NZHC 1420

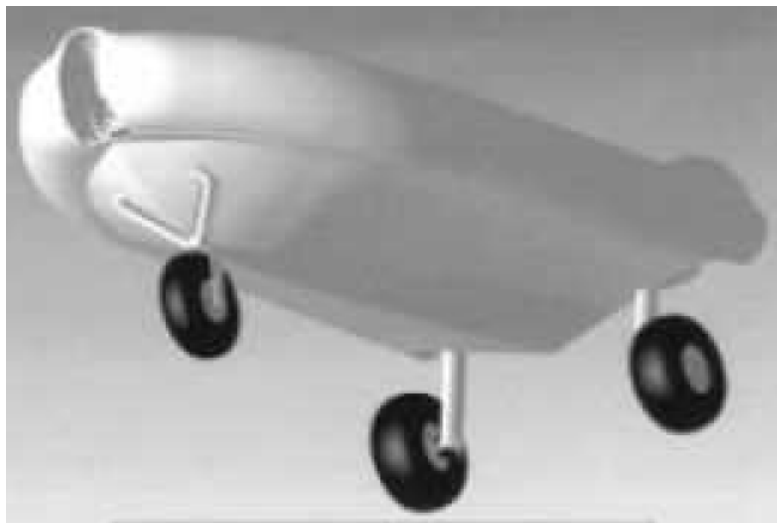




Copyright Overview – Causal Connection

- There must be a causal connection between the copyright work and the infringing work, in the sense that the copyright work is the source from which the infringing work is derived.
 - Unconscious or unintended copying is not a defence: *Plix Products* – tainting through the person commissioning the product
 - Prior employment by copyright owner infers copying, but can be rebutted with evidence of independent development
Technopak v Monzeal
 - USB with all details of the plaintiff's product, including financial details, found by a member of the public on a remote beach and handed to the defendant was not a causal connection as the plaintiff did not present evidence to this effect. *Sealegs International Ltd v Yun Zhang & Ors* [2018] NZHC 1724





NZ Design Reg. No. 403199

Article: A Boat

The design is to be applied to a boat and the novelty resides in the features of shape and configuration of the boat as shown in the accompanying representations. The boat has a retractable undercarriage system, and the accompanying representations show the appearance of the boat with its wheels up, and the appearance of the same boat with its wheels down.



Zhang & Ors v Sealegs International Limited [2020] NZCA 389





Copyright Overview – Substantial Part



- The reproduction must be either of the *entire* copyright work or of a *substantial part* of it.

- Qualitative visual impression, not a quantitative analysis.

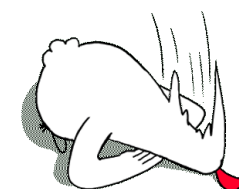
Henkel KGaA v Holdfast NZ Limited

- Courts commonly consider: the “starting point” of the defendant’s work; the extent of the defendant’s alteration (i.e. whether a substantial part of the plaintiff’s work survived in the defendant’s so as to appear to be a copy of the original work); and the way in which the defendant has taken advantage of the plaintiff’s work.

Steelbro NZ Ltd v Tidd Ross Todd Ltd [2007] NZCA 486



Trunki – Reimagined





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Rob S. Katz

Banner & Witcoff



Designs, Copyright and the Overlap in U.S.

(copyright protection for designs for useful articles)

Robert S. Kats

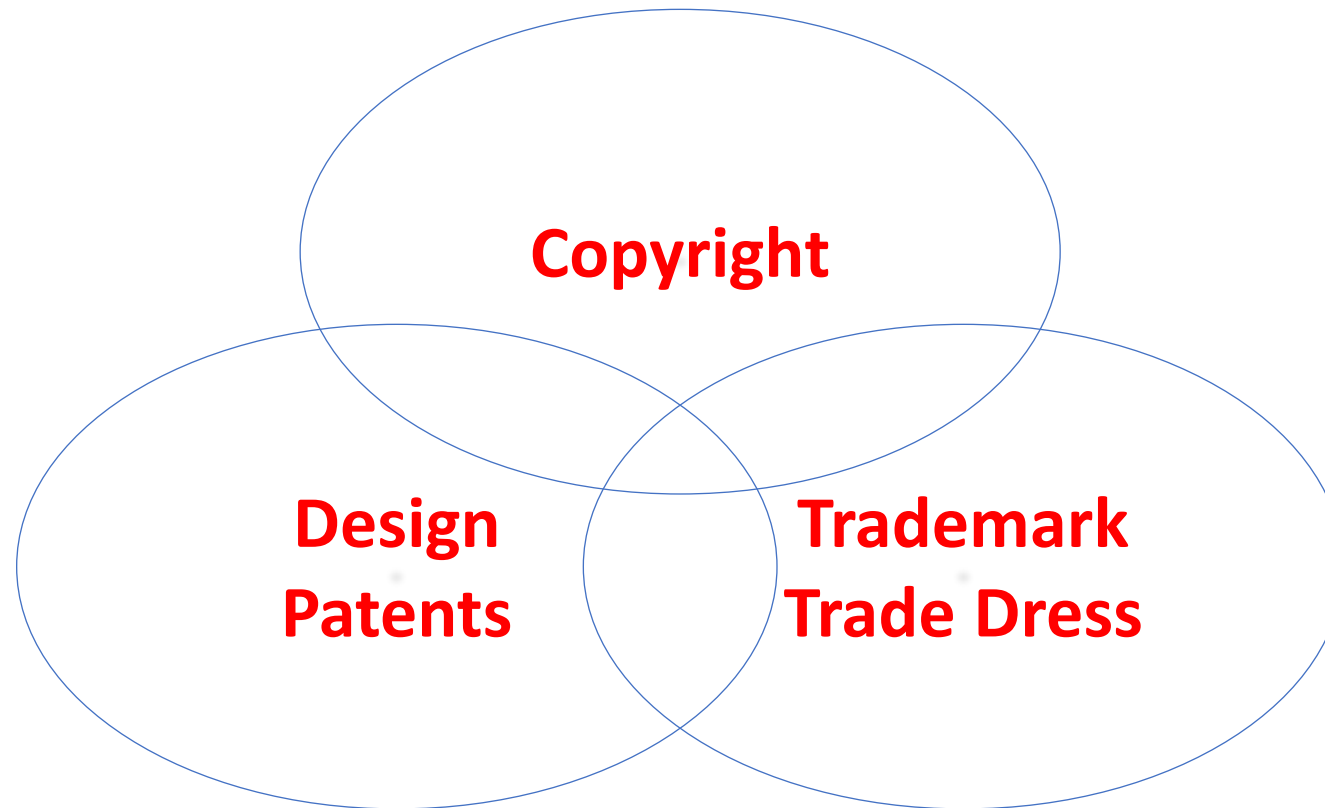
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September 2026

IP Right Relationships

- Complimentary
- Generally adverse to utility patents (non-functionality)



Design Patent vs. Copyright (for Articles): Overview

Design Patent:

- Protects designs for articles of manufacture against substantially similar designs
- Requires procuring a design patent
- Novelty & Non-Obviousness
- Term: 15 years from grant

Copyright:

- Protects works (PGS) from unauthorized copying
- Protection is automatic BUT registration still needed
- Original
- Term: Life of the author + 70 years OR 95 years from publication

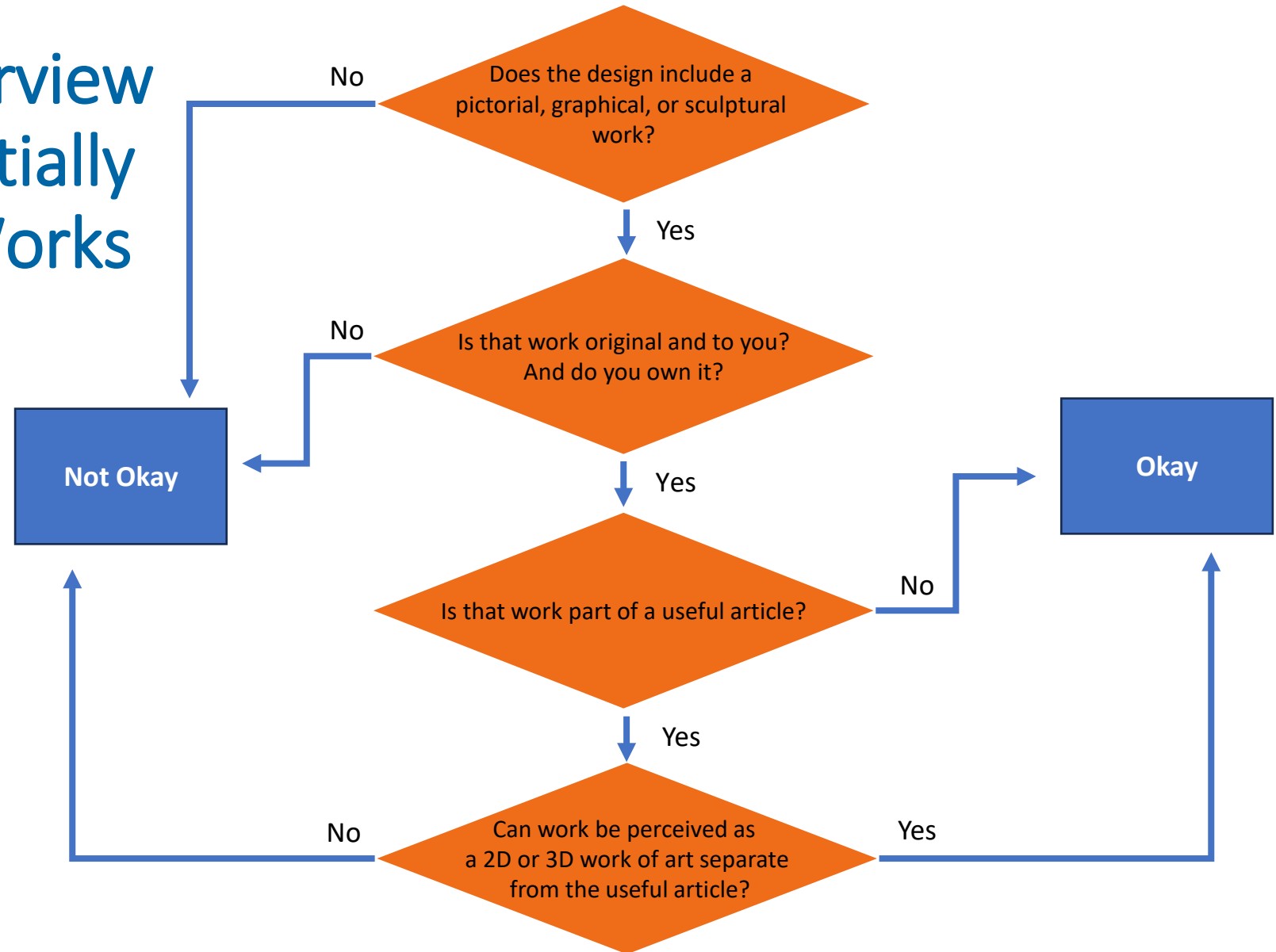
US Copyright - The Basics

- Original works of authorship
- Fixed in tangible medium of expression
- Protects many category types. Relevant here (PGS)
 - Pictorial
 - Graphic
 - Sculptural
- Default owner is the creator
 - Employer owns in a “work made for hire”
 - Can be assigned

US Copyright - The Basics

- Bundle of rights. Remedies differ from design patents
- Protects against copying of the work
- Registration
 - Must register to enforce
 - If registration within 3 months of publication
 - Statutory damages
 - Attorney fees
 - If created outside the US, publication not needed to enforce
 - But you should if you want for statutory damages and attorney fees
- Term
 - Life of the author + 70 years (last to die for joint works)
 - Work made for hire: shorter of 95 years from publication or 120 years from creation

US Copyright Overview for Designs Potentially Containing PGS Works



Do you own it? & Work original to you?



- Party asserting must prove ownership
 - Default right to creator, work made for hire, assignment...
- Work original to you/creator must be a person
 - To qualify as a work of 'authorship' a work must be created by a human being" and that it "will not register works produced by a machine or mere mechanical process that operates randomly or automatically without any creative input or intervention from a human author." (US Copyright Office Guidelines (March 16, 2023))

Original to You? (AI)

- Separate human contribution from non-human contribution
 - History in filtration
 - Does human contribution meet threshold
- Applicants using AI have a duty to:
 - Provide statement describing the human authorship
 - Disclaim AI-generated content
- Duty is retroactive
 - Pending applications, notify the Copyright Office.
 - Registered applications, submit a supplementary registration correcting the public record
- Failure to comply this can lead to cancelation/invalidation

Original to You? (AI)

- Works with AI-generated material may be copyrighted to the extent that they contain sufficient human authorship, such as:
 - Selecting or arranging AI-generated material in a sufficiently creative way, or
 - Modifying material originally generated by AI technology to such a degree that the modifications meet the standard for copyright protection.
- AI-generated material is not the product of human authorship in cases where:
 - User does not exercise ultimate creative control over how the AI system interprets prompts and generates material; and
 - AI technology determines the expressive elements of its output

Part of a “Useful Article”?

- A "useful article" is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a "useful article"
- If not, no separability analysis is needed



Useful Article → NO



Useful Article → YES

Perceived as Separate from the Useful Article

- A feature incorporated into the design of a useful article is eligible for copyright protection only if the feature:
 1. Can be perceived as a 2 or 3-dimensional work of art separate from the useful article, and
 2. Would qualify as a protectable pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which it is incorporated
- Result not always clear
- Nothing to do with PERSONALITY OF THE AUTHOR!!!
 - Test in the U.S. is objective and not subjective

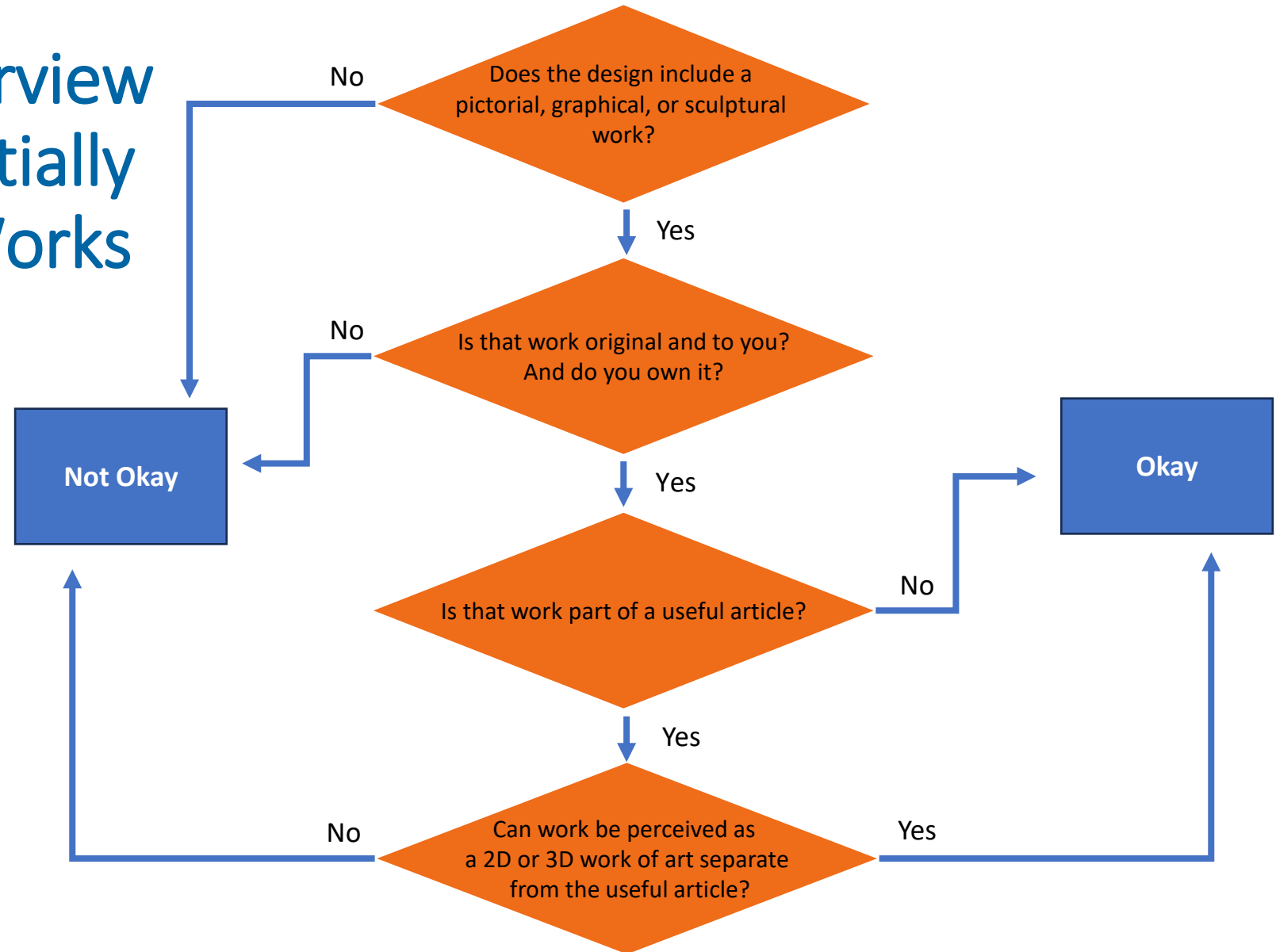


Design 299B
Registration No. VA 1-319-226



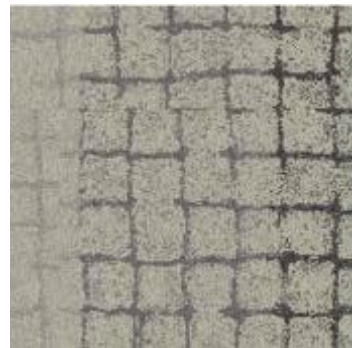
Star Athletica

US Copyright Overview for Designs Potentially Containing PGS Works



Copyright Protected in the US? - Examples

YES



NO



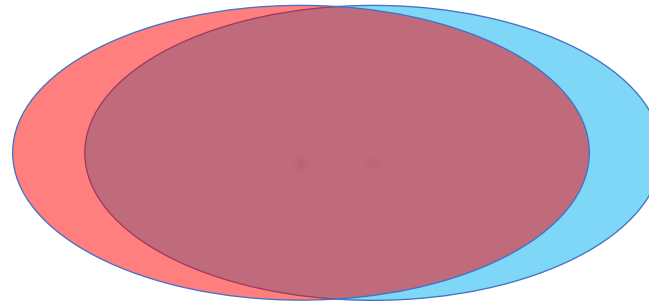
STRENGTHENING THE PRACTICE OF THE INDEPENDENT IP ATTORNEY

www.ficpi.org

Copyright of Useful Articles US/EU

**What we normally
want (close to
harmonization)**

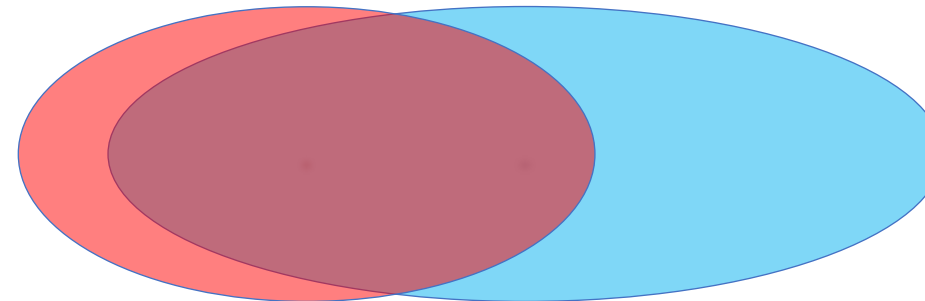
Copyright US



Copyright EU/UK

**What we
likely have**

Copyright US

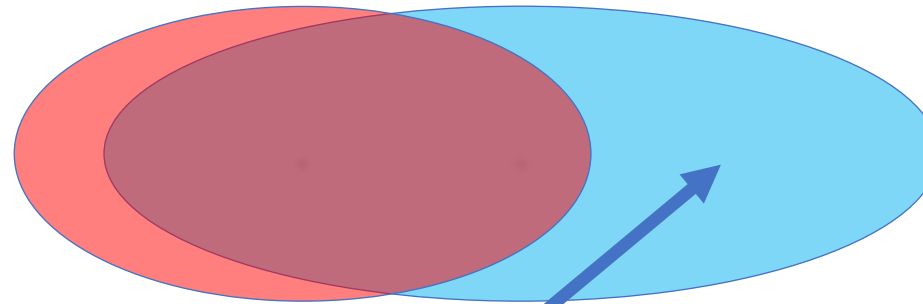


Copyright EU/UK

Copyright of Useful Articles US/EU – What we have

What we
likely have

Copyright US



Copyright EU/UK

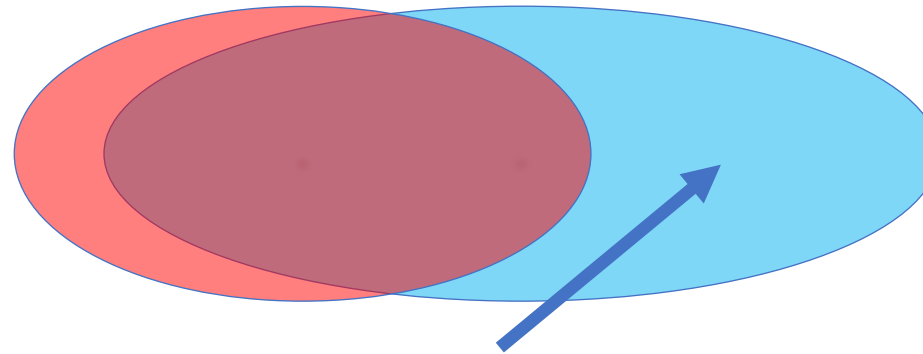
Where “work” is not imaginable separate from the useful article



Copyright of Useful Articles US/EU – What we have

What we
likely have

Copyright US



Copyright EU/UK

Where “work” is not imaginable
separate from the useful article

NOT OK in the U.S.

OK in the EU



Trunki – Copyright Protectible in the US?



EUD 000043427-0001



UKSC/2014/0147



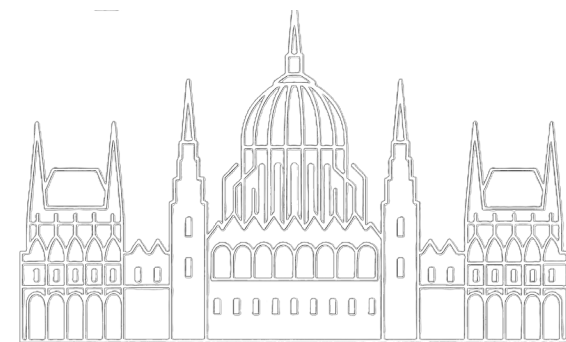


THANK YOU!

Robert Katz

Banner Witcoff

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Gamification Code:

TRADE



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