

DESIGNS, PARODY AND ARTISTIC EXPRESSION — A COMPARATIVE PERSPECTIVE OF PLESNER v LOUIS VUITTON

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This article examines the legal issues raised in Plesner v Louis Vuitton through a comparative lens. It uses the case as a springboard to critically examine some important differences between the way that Australian and European design law responds to creative expression, some of which impact the Advisory Council on Intellectual Property's current review of the Designs Act 2003 (Cth). In 2008, Dutch artist Nadia Plesner, created a drawing, Simple Living, depicting a malnourished African child holding a Louis Vuitton 'Audra' handbag and a miniature Chihuahua. Plesner sold T-shirts depicting Simple Living to support a campaign to raise awareness of the atrocities then occurring in Darfur. Relying exclusively on its European Community registered design for the pattern of the bag shown in Simple Living, in May 2008 and again in 2010, Louis Vuitton obtained ex parte injunctions prohibiting Plesner from selling products infringing the registered design. In 2011, Plesner successfully appealed against the latest injunction on the basis that her human right to free expression should prevail over Louis Vuitton's property rights. This article poses the question: how would this case have unfolded under the very different Australian legal and human rights frameworks? As it responds to that question, the article explores the important differences between the European and Australian registered design systems, and discusses issues of broader significance than the specific facts of the Plesner cases, and which should be considered in the current reform inquiry. Of particular interest and focus is the novel question of whether Australian design rights, which are not balanced by an express defence of fair dealing nor any concept of 'design use' comparable to trade mark use, might be a forceful, if unintended, inhibitor of artistic, political or parodic expression which might otherwise be immune under copyright and trade mark law. These risks need to be considered in the current reform debates.

I INTRODUCTION

Nadia Plesner is a Danish artist. In 2008, she created a drawing entitled *Simple Living*.¹ The title alludes to the successful American reality TV show, *The Simple Life*, which aired between 2003 and 2007 and depicted heiress Paris Hilton and

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1 For an image of *Simple Living*, see Nadia Plesner, *Simple Living & Darfurnica* <<http://www.nadiaplesner.com/simple-living--darfurnica>>.

her privileged buddy Nicole Ritchie performing decidedly non-privileged tasks. Continuing the allusion, Plesner's drawing portrays a gaunt, malnourished African child holding a Louis Vuitton *Audra* handbag (Paris Hilton's favourite inanimate accessory) and a 'teacup' Chihuahua dog (Paris Hilton's favourite animate accessory). The *Audra* handbag was launched in 2005 and bears Louis Vuitton's 'Multicolore Canvas Design', authored by designer Takashi Murakami.² The bag, which at the time retailed for US\$1800, had proved a big success³ and no doubt contributed to Louis Vuitton's status as the world's most valuable luxury brand.⁴ Plesner conceived the drawing as a protest against what she regarded as the unacceptable difference in media attention between celebrities and real world crises, in particular the situation in Darfur (Sudan).⁵ She sought to draw attention to the poignant difference between the luxury and affluence symbolised by the Louis Vuitton handbag on the one hand and the poverty and famine symbolised by the Darfurian boy on the other. This case may have come to nought if Plesner had not begun (perhaps ironically) selling T-shirts depicting the *Simple Living* boy, the profits of which she directed to 'Divest for Darfur', an organisation that opposes financial investment indirectly supporting genocide.⁶ Louis Vuitton objected to Plesner's use of its European Community registered design, which depicts the *multicolore* pattern,⁷ while conceding that 'the campaign for Darfur [was] praiseworthy in itself'.⁸

Usually trade mark and design owners acquiesce when their trade marks or designs are used in art. Andy Warhol famously used Campbell's Soup cans in his work without complaint by Campbell's, and made a sculpture from a stack of Heinz tomato ketchup boxes without objection from Heinz. Belgian conceptual artist, Wim Delvoye, tattooed Disney characters onto live pigs and the Texaco sign illuminates Allan D'Arcangelo's painting 'US Highway 1, Number 5'. The two worlds of merchandising and art tend to co-exist happily and apart, each probably enjoying the reflective glow of the other. If *Simple Living* had been a

2 An image of the bag can be found through a web search of 'Louis Vuitton Audra handbag'.

3 *Louis Vuitton v Plesner*, Court of the Hague Civil Law Section, application number KG RK 10-214, 27 January 2011 [Kennedy van der Laan trans] <http://www.rechtundgerechtigkeit.de/2-4-gesellschaftsanktionen/berichte/vuitton-darfurnica/belege/Court_Order_Louis_Vuitton_vs_Plesner.pdf> [2] ('*Louis Vuitton v Plesner*').

4 Andrew Roberts, 'Louis Vuitton Tops Hermes as World's Most Valuable Luxury Brand', *Bloomberg Business* (online), 21 May 2012 <<http://www.bloomberg.com/news/2012-05-21/louis-vuitton-tops-hermes-as-world-s-most-valuable-luxury-brand.html>>.

5 Nadia Plesner, *Simple Living & Darfurnica* <<http://www.nadiaplesner.com/simple-living-darfurnica/>>.

6 Susan Scafi, *Copying for Charity* (27 April 2008) Counterfeit Chic <http://www.counterfeitchic.com/2008/04/copying_for_charity_1.php>.

7 The design is registration no. 84223-0001 (filed on 6 October 2003). The mandatory 'indication of the product' in the registered design is stated to be 'graphic symbols': Locarno Class 99 (miscellaneous), *International Classification for Industrial Designs* ('*Locarno Classification*'), under the *Locarno Agreement Establishing an International Classification for Industrial Designs*, signed 8 October 1968 ('*Locarno Agreement*'). The Vienna Class is 1.1.9 'Stars with four points'; 25.7.25 'Surfaces or backgrounds covered with other repeated figurative elements'; 27.5.19 'Letters overlapping'; 29.1.15 'Five colours and over': *International Classification of the Figurative Elements of Marks* under the *Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks*, signed 12 June 1973 (entered into force 9 August 1985).

8 *Louis Vuitton v Plesner* [9].

solitary piece at an exhibition this article would probably be unwritten. However, it was Plesner's move into commercial territory, through selling T-shirts and posters overtly connected to the Darfur divestment campaign, that vexed Louis Vuitton.

This article considers how the Plesner case would unfold under Australian intellectual property law. The initial motivation for the article was triggered by Louis Vuitton's exclusive reliance on its registered design right, and the fact that it was Plesner's express right to free expression which ultimately immunised her from design infringement liability. This prompted a reflection on the differences between the European and Australian designs and human rights regimes. In particular, given the absence of any express free speech right in Australia, it is interesting to consider whether there may be a lacuna in the Australian *Designs Act 2003* (Cth) if, through an uncalibrated design right, it constrains satirical or parodic commentary, or purely artistic or political expression.

The article applies the Australian *Designs Act 2003* (Cth) (*'Designs Act'*) to the Plesner facts and explains the significantly different outcome under European design law, as moderated by European human rights. This analysis facilitates the exploration of some under-examined design law issues, particularly how two-dimensional designs should be perceived, the identification of the 'informed user', and what factors can be considered by the informed user. It also raises important issues for the reform and development of Australian design law generally, particularly concerning the potential for Australian design law to chill artistic, critical or political expression. Given the dearth of scholarly commentary on Australian design law and the current review of the *Designs Act* by the Advisory Council on Intellectual Property ('ACIP'),⁹ the article is timely. In particular, some of the issues canvassed by ACIP could result in Australian design law moving closer to the European model, which may be undesirable.

Due to the paucity of judicial commentary on the issue, the article is speculative, and a number of assumptions are necessarily made. The article concludes that Plesner's position under the Australian *Designs Act* is unclear. Liability will depend on the nature of the comparison between the registered design and the allegedly infringing design, and the factors that may be taken into account by the notional informed user, whose perspective determines infringement. The article then considers the extent to which other examples of artistic and parodic design appropriation may potentially infringe registered design rights. It demonstrates that there is serious potential for the *Designs Act* to constrain artistic, political or parodic expression in a manner unintended by Parliament, inconsistent with other intellectual property rights, particularly trade marks and copyright, and contrary to the policy foundations of designs law.

9 ACIP, *Review of the Designs System* (5 May 2015) <<http://www.acip.gov.au/reviews/all-reviews/review-designs-system/>>.

II THE LITIGATION IN EUROPE

A *Tribunal de Grande Instance in Paris*

On 25 March 2008, Louis Vuitton successfully applied *ex parte*¹⁰ to the Tribunal de Grande Instance in Paris for orders granting an *ex parte* injunction restraining the infringement of its registered community design, which depicts the *multicolore* design. The court also awarded nominal damages of 1 Euro, and imposed a 5000 Euro fine for each day of non-compliance with the injunction.

The parties apparently conducted settlement negotiations, but ultimately, in June 2008, Plesner ceased selling the T-shirts bearing the *Simple Living* boy, citing an inability to fund an appeal against the injunction. That was not, however, the end of the matter.

B *The Court of The Hague, 2011*

Apparently encouraged by legal advice that pure art would be relatively immune from challenge,¹¹ and continuing her focus on Darfur, in 2010 Plesner created a large painting modelled on Picasso's *Guernica*, entitled *Darfurnica*.¹² The *Simple Living* boy is a small part of *Darfurnica*, which depicts numerous other celebrities, trade marks and luxury fashion items. *Darfurnica* was exhibited at an exhibition in Copenhagen in January 2011. Images of *Simple Living* were also used in the invitations to the exhibition. Within the exhibition, a number of *Simple Living* T-shirts were sold, and *Simple Living* posters were exhibited. A large poster of *Simple Living* also stood as an 'eye catcher' outside the entrance to the gallery hosting the exhibition. Louis Vuitton again successfully obtained an *ex parte* injunction restraining infringement of its registered design, this time in the court of The Hague.¹³ In its application, Louis Vuitton argued that in making unauthorised use of the 'basically identical'¹⁴ design, Plesner had been 'seeking publicity in an aggressive way, accusing Louis Vuitton of wanting to halt her campaign for Darfur' and that '[a]s a result of these acts Louis Vuitton has suffered great damage'.¹⁵ The company accused her of attracting public attention to her products by using its intellectual property rights and 'free riding' on its

10 This in itself is surprising, given that this was not a straightforward case of counterfeit designs, the usual fare of *ex parte* proceedings.

11 On her website, Plesner states '[t]he attorney who advised me through the legal dispute told me, that if only I had made a more classical art work, like an oil painting, I would have been able to paint whatever I liked': Nadia Plesner, *Simple Living & Darfurnica* <<http://www.nadiaplesner.com/simple-living--darfurnica/>>.

12 For an image of *Darfurnica*, see Nadia Plesner, *Simple Living & Darfurnica* <<http://www.nadiaplesner.com/simple-living--darfurnica/>>.

13 Apparently because Plesner was a resident there.

14 *Louis Vuitton v Plesner* [22].

15 *Ibid* [11].

public profile and the media coverage which the dispute between Louis Vuitton and Plesner generated in 2008.¹⁶

Louis Vuitton argued that any defence based on freedom of expression held ‘no water’¹⁷ because the strict requirements justifying the precedence of speech rights over intellectual property rights had not been satisfied. This was because the use of Louis Vuitton’s intellectual property was both unnecessary,¹⁸ since Plesner could deliver her message by other means, and ‘very damaging’¹⁹ to the rights, as well as the name and reputation of the company and its products. This was due to the link made between the company and its products on the one hand, and the situation in Darfur on the other hand, despite Louis Vuitton having nothing to do with the genocide in Darfur. Despite the obvious artistic or at least quasi-artistic use of the registered design, and the ex parte nature of the application, the court granted the injunction. The judgment makes no comment on Louis Vuitton’s substantive claims, holding that:

The Court in preliminary relief proceedings will not express an opinion on whether there was a ground for justification for the unauthorized use of the Design in 2008. In the present situation, and in view of the present use, it is unlikely that there is a ground for justification for the advertising and merchandising for the artist’s own work. This entails that the injunction will be granted as requested ...²⁰

C The Appeal

This time, an incensed Plesner successfully appealed. In the appeal, both parties relied on their rights as enunciated in the European Convention on Human Rights (*‘ECHR’*), Plesner citing article 10 and her right to freedom of expression,²¹ and Louis Vuitton citing article 1 of the first protocol to the ECHR concerning its

16 Ibid [18].

17 Ibid [29].

18 Ibid [31]–[32].

19 Ibid [34]. Also reported in Cat Weaver, *Blurring Luxury and Art: Nadia Plesner vs Louis Vuitton* (25 March 2011) Hyperallergic <<http://hyperallergic.com/21392/nadia-plesner-vs-louis-vuitton/>>.

20 *Louis Vuitton v Plesner* [2.4].

21 *Convention for the Protection of Human Rights and Fundamental Freedoms*, opened for signature 4 November 1950, 213 UNTS 221 (entered into force 3 September 1953), as amended by *Protocol No 14 to the Convention for the Protection of Human Rights and Fundamental Freedoms, amending the control system of the Convention*, opened for signature 13 May 2004, CETS No 194 (entered into force 1 June 2010) art 10 (*‘ECHR’*). For a text of the *ECHR*, see <http://www.echr.coe.int/Documents/Convention_ENG.pdf>. The principles enshrined in the *ECHR* are, by virtue of the *Treaty on European Union*, incorporated into European law as general principles: ‘Fundamental rights, as guaranteed by the European Convention for the Protection of Human Rights and Fundamental Freedoms and as they result from the constitutional traditions common to the Member States, shall constitute general principles of the Union’s law’: *Treaty on European Union*, opened for signature 7 February 1992, [2012] OJ C 326/1 (entered into force 1 November 1993) art 6(3).

right to protect property.²² The court noted that since these two ‘fundamental rights’ were ‘on equal footing but conflicting’, it was necessary to achieve a fair balance between the general interest of the community and the interests of the parties.²³

Notably, Louis Vuitton again relied exclusively on its registered design right. It made no claims under registered or unregistered trade marks or copyright. Perhaps those rights may have opened the door to broader defences than those available under European registered design law. However, the company’s primary concern appeared to be that Plesner’s conduct would create a negative association between the company and the tragic circumstances in Darfur, which would impact adversely on the company’s reputation. There is an issue of causation here. Somewhat ironically, the real damage to Louis Vuitton’s reputation was probably done, or at least seriously compounded, by the company itself taking legal action against Plesner. That, combined with the power of social media, gave oxygen to the publicity fire. Until that step was taken, most would have responded to the handbag in the manner intended by Plesner — as a symbol of affluence. As Plesner stated, ‘[t]he point was never originally about Louis Vuitton ... [it] was about celebrity obsession at the expense of things that matter. But it became about rights and artistic freedom’.²⁴ No doubt Louis Vuitton would be, to say the least, perturbed to know that *Simple Living* is now used by the United Nations as a logo in connection with work for the freedom of artistic expression and creation.²⁵ In this respect, the action taken by Louis Vuitton to protect its reputation was the very thing that harmed it. In any event, can a registered design right prevent the sort of reputational damage the company feared? The appeal court noted that while Louis Vuitton based its action on ‘damage to its reputation’,²⁶ the Community design right is mainly concerned with the exclusive right to ‘use the appearance of a product registered by [the rights holder]’.²⁷ The court refrained from deciding whether the design right extends to protection of reputation in the design or indeed in the rights holder, but decided in any case that protecting reputation was less essential than protecting Plesner’s freedom of speech.²⁸

The court referred to established European case law supporting the general principle that an artist’s right to express their opinions through their art is

22 ‘Every natural or legal person is entitled to the peaceful enjoyment of his possessions. No one shall be deprived of his possessions except in the public interest and subject to the conditions provided for by law and by the general principles of international law’, *Protocol to the Convention for the Protection of Human Rights and Fundamental Freedoms*, opened for signature 20 March 1952, ETS No 9 (entered into force 18 May 1954) art 1.

23 *Plesner v Louis Vuitton*, Court of the Hague Civil Law Section, Case number 389526/KG ZA 11-294, 11 May 2011 [4.3] [Kennedy van der Laan trans] <<http://www.nadiaplesner.com/upl/website/simple-living-darfurnical/VerdictEnglish.pdf>> (*Plesner v Louis Vuitton*).

24 Quoted in Rhymer Rigby, ‘The Struggle to Make Logos a No-go for Art’, *The Financial Times* (online) 21 July 2011 <<http://www.ft.com/cms/s/0/cb5b802c-b3c3-11e0-855b-00144feabdc0.html#axzz2ZwBBuKqj>>.

25 See Office of the High Commissioner for Human Rights, *The Right to Artistic Freedom*, <<http://www.ohchr.org/EN/Issues/CulturalRights/Pages/ArtisticFreedom.aspx>>.

26 *Plesner v Louis Vuitton* [4.7].

27 Ibid.

28 Ibid.

highly valued in a democratic society.²⁹ Plesner's use of the registered design was 'functional and proportional'³⁰ and was not intended to 'free ride' on Louis Vuitton's reputation in a commercial sense. Rather, she employed the famous design as social criticism. Nor did she (or any evidence) suggest that Louis Vuitton was itself involved in the circumstances in Darfur. Since Louis Vuitton is 'a very well-known company, the products of which enjoy a considerable reputation, which it also stimulates through advertising famous people', it must be more accepting of critical use than other rights holders.³¹ Using the *Simple Living* image as an eye-catcher to generate interest in the exhibition was also acceptable because that work occupied a central position in Plesner's oeuvre concerning Darfur.

III AUSTRALIAN DESIGN INFRINGEMENT?

A search of the Australian designs database reveals no registered designs in respect of the Audra bag, or the *multicolore* pattern. It is interesting to speculate on the outcome had such a design been registered in Australia, and to compare it to the outcome in Europe. This prompts an important reflection on whether the Australian registered design scheme accommodates artistic, political, or parodic expression to the same degree as copyright and trade marks. Plesner ultimately succeeded on the strength of her express human right to free speech under the European Convention on Human Rights. Australia lacks any equivalent.³² There is no express defence of parody in the *Designs Act* as there is in the *Copyright Act 1968* (Cth),³³ and no concept of 'design use' comparable to the doctrine of trade mark use in the *Trade Marks Act 1995* (Cth). Ostensibly then, the *Designs Act* could be a powerful speech inhibitor if the defendant exercises an exclusive right of the design owner in respect of a design that is substantially similar in overall impression to the registered design.

There is considerable similarity between the *multicolore* pattern and the pattern depicted on the *handbag* of the African boy in *Simple Living*. It seems infringement was effectively conceded in *Plesner v Louis Vuitton*, since the allegations of design infringement were not challenged. Instead, Plesner's human right was relied on as a defence. The situation in Australia is less straightforward. There are a number

29 Ibid.

30 Ibid [4.8].

31 Ibid.

32 An Australian would need to rely on the implied right to political communication, discussed further below. While the *Charter of Human Rights and Responsibilities Act 2006* (Vic) s 15 ('*Charter*') includes the right to freedom of expression, as a State law it has no application to the *Designs Act*. The *Charter* 'requires the Victorian Government, public servants, local councils, Victoria Police and other public authorities to act compatibly with human rights, and to consider human rights when developing policies, making laws, delivering services and making decisions': Victorian Equal Opportunity and Human Rights Commission, *Victoria's Charter of Human Rights and Responsibilities* <<http://www.humanrightscmission.vic.gov.au/index.php/2012-10-18-02-34-08/the-charter>>. The *Human Rights Act 2004* (ACT) has a similar scope and operation within the Australian Capital Territory.

33 See *Copyright Act 1968* (Cth) ss 41A, 103AA.

of unresolved questions in relation to whether Plesner's conduct would constitute design infringement under the Australian regime.

A The Scope of Louis Vuitton's European Design Rights Compared to the Australian Regime

Louis Vuitton relied exclusively on its European Community design registration no. 84223-0001 (filed on 6 October 2003), which depicts the *multicolore* pattern. The mandatory 'indication of the product'³⁴ in the registered design is stated to be 'graphic symbols', Locarno Class 99 (miscellaneous).³⁵ However, under the *Regulation*, the indication of the product does not affect the scope of protection of the design,³⁶ and protection is therefore not limited to the design in relation to any particular product. This is a major point of difference between the Australian and European systems. The Australian system requires a clear depiction of the design *in relation to a product*,³⁷ including where the design is a two-dimensional pattern. A product is a 'thing that is manufactured or hand made'.³⁸ Under the Australian regime, a two-dimensional design in the abstract cannot be a 'product' in itself. For example, IP Australia (the government agency that administers intellectual property rights and legislation) does not consider screen icons to be a registrable product.³⁹ The situation is fundamentally different under the European *Regulation*. While 'design' is similarly defined,⁴⁰ the definition of 'product' significantly includes 'graphic symbols'.⁴¹

With design protection conferred on 'graphic symbols' in the abstract, and unrelated to any particular product, European registered design rights are significantly broader than Australian rights. Indeed, the protection of a graphic symbol *as a product* applied to miscellaneous items is comparable to protection of a copyright artistic work. Such a design is also comparable to a registered trade

34 *Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Designs* [2002] OJ L 3/1, art 36(2), ('*Regulation*'). The provisions of the *Regulation* correspond to *Directive 98/71/EC of the European Parliament and of the Council on the Legal Protection of Designs* [1998] OJ L 289/28 ('*Designs Directive*').

35 As noted at n 7, the *Vienna Class* is 1.1.9 'Stars with four points'; 25.7.25 'Surfaces or backgrounds covered with other repeated figurative elements'; 27.5.19 'Letters overlapping'; and 29.1.15 'Five colours and over'.

36 *Regulation* art 36(6).

37 The *Designs Act* defines a design as follows: 'design, *in relation to a product*, means the overall appearance of the product resulting from one or more visual features of the product' (s 5); '[i]n this Act, a reference to a design is a reference to a design *in relation to a product*' (s 8) (emphases added). Infringement is dependent on making or offering to make a product, 'in relation to which the design is registered': at s 71(1)(a). See also IP Australia, *Designs Examiners' Manual of Practice and Procedure (2003 Act)*, 12 February 2015 [14.2]: 'The representations must show a product. They cannot simply show, for example, the two-dimensional design applicable to a T-Shirt without showing the T-Shirt to which it is applied.'

38 *Designs Act* s 6(1).

39 ACIP, 'Review of the Designs System' (Issues Paper, September 2013) 26 [3.11.2].

40 *Regulation* art 3(a) defines 'design' as 'the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation'.

41 *Regulation* art 3(b).

mark, except that trade marks must be registered in relation to particular goods or services.

Since March 2014, Member states who have signed the *Locarno Agreement* utilise the 10th edition of the *Locarno Classification* to classify designs, and since early 2014 IP Australia has also been using the 10th edition of the *Locarno Classification*.⁴² Recent editions of the classification introduced a new class no. 32 to include ‘graphic symbols, logos, surface patterns, and ornamentation’. The ACIP issues paper identifies some difficulties with product classification, in particular registrations of designs in respect of products which IP Australia does not consider a product, such as graphical user interfaces.⁴³ There may then be a tension between utilising the *Locarno Classification*, which includes ‘graphic symbols, logos, surface patterns, and ornamentation’ as *products*, and the Australian statutory provisions suggesting such things cannot (and should not) be products.

B A Hypothetical Australian Registration

In order to test how the Plesner case would unfold in Australia, I will imagine that the *multicolore* pattern was registered in Australia in Locarno Class 2 in respect of, inter alia, T-shirts.⁴⁴ As mentioned, in Australia the scope of a registered design is always considered *in relation to a product*.⁴⁵ The boundaries of the design monopoly would therefore depend on how the design was applied to the product, and the design application should clarify this.⁴⁶ In Europe, as mentioned, this is not the case. What then would the representation of Louis Vuitton’s T-shirt design under the Australian regime look like? It is possible to apply the *multicolore* pattern in various ways to the surface of a T-shirt. It may occupy most of the surface area, run as a column down one side of the shirt, be impressed on the collar only, or be

42 The ACIP Issues Paper notes that, while not a member of the *Locarno Agreement*, IP Australia uses the 8th edition of the *Locarno Classification*: ACIP, Issues Paper, above n 39, 26 [3.11.2]. However, the author was advised by an email from IP Australia dated 7 July 2014 that the 10th edition has been utilised since the beginning of 2014.

43 ACIP, Issues Paper, above n 39, 25–6 [3.11.2].

44 A common design may be registered in relation to more than one product, each classified in accordance with the *Locarno Agreement*, above n 7. Clearly, the list of hypothetical products would include handbags (Class 3), and probably other clothing in Class 2. Infringement will only occur in Australia if the defendant is exercising an exclusive right in respect of a product ‘in relation to which the design is registered’: *Designs Act* s 71(1)(a). Therefore, for the purposes of this exercise, it is necessary to imagine a registration which at least includes T-shirts.

45 Recall *Designs Act* ss 5, 8.

46 *Design Regulations 2004* (Cth) reg 3.01(c) requires the design application to include a ‘representation ... of each design’. The definition of ‘design’ in *Designs Act* s 5 requires this to depict the product in relation to which the design is registered. See also *Review 2 Pty Ltd (in liq) v Redberry Enterprise Pty Ltd* (2008) 173 FCR 450, 462 [49] (Kenny J): ‘[d]esign registration protects the overall visual appearance of the product ... as it appears on the design register’ (*Review 2*); *Keller v LED Technologies Pty Ltd* (2010) 185 FCR 449, 460 [35] (Emmett J): ‘In order to be valid, a registered design must be reasonably clear and succinct. That is to say, the design must appear with reasonable clarity, and without necessity for unreasonably prolonged or complicated series of deductions, from the registered representation.’

a small coin-sized icon on a plain T-shirt.⁴⁷ Louis Vuitton's European registration theoretically extends to all of these possible manifestations, whereas in Australia, the design application should indicate the particular application of the design *to the product*. A Google image search of 'Louis Vuitton T-shirts'⁴⁸ demonstrates that the Vuitton patterns are generally applied to the entire surface of the T-shirt, or as background to the 'LV' trademark, and importantly, my search revealed no T-shirts that reproduced images of Louis Vuitton handbags. I will assume Vuitton's T-shirt was depicted in a similar manner in the hypothetical Australian design application, ie to the entire surface of the T-shirt.

C The Infringement Test

Plesner will infringe the hypothetical Australian design if she exercises any of Louis Vuitton's exclusive rights in respect of 'a product, in relation to which the design is registered, which embodies a design that is identical to, or substantially similar in overall impression to, the registered design'.⁴⁹ When assessing overall similarity, the factors specified in s 19 must be considered.⁵⁰ These include 'the state of development of the prior art base for the design',⁵¹ and 'the freedom of the creator of the design to innovate'.⁵² The person making the decision must 'give more weight to similarities between the designs than to differences between them',⁵³ and if only part of the design is substantially similar to another design, the decision-maker must 'have regard to the amount, quality and importance of that part in the context of the design as a whole'.⁵⁴ In applying these factors, the decision-maker 'must apply the standard of a person who is familiar with the product to which the design relates, or products similar to the product to which the design relates (the *standard of the informed user*)'.⁵⁵

47 It may even appear in the background to other images, or in bands around other images. However if this was the case, the design is in truth something quite different, being the pattern *and other visual elements combined*. If the design owner wanted to protect that combination of design elements, it would need to register a separate design.

48 Some of which may have been counterfeit.

49 See *Designs Act* ss 10(1), 71(1). Making, or offering to make a product, in relation to which the design is registered, which embodies a design that is identical to, or substantially similar in overall impression to, the registered design, is the primary act of infringement: s 71(1)(a). Secondary acts of infringement occur when the defendant: imports such a product into Australia for sale, or for use for the purposes of any trade or business (s 71(1)(b)); sells, hires or otherwise disposes of, or offers to sell, hire or otherwise dispose of, such a product (s 71(1)(c)); uses such a product in any way for the purposes of any trade or business (s 71(1)(d)); or keeps such a product for the purpose of doing any of the things mentioned in ss 71(1)(c) or (d) (s 71(1)(e)).

50 *Designs Act* s 71(3).

51 *Ibid* s 19(2)(a).

52 *Ibid* s 19(2)(d).

53 *Ibid* s 19(1).

54 *Ibid* s 19(2)(c). I will assume no statement of newness or distinctiveness was filed: s 19(2)(b).

55 *Ibid* s 19(4).

D ‘Embodying’ Two-Dimensional Designs

A preliminary point is that Plesner’s products must *embody* a substantially similar design. It is perhaps awkward to construe the two-dimensional representation of a print on a T-shirt as an *embodiment* of the registered design. Ricketson and Creswell note that ‘embodied’ is a new concept in the *Designs Act 2003*, which replaced the expressions ‘applied’ and ‘applicable’ used in the 1906 Act, and was apparently the invention of the parliamentary draftsman.⁵⁶ They correctly note that the expression, with its suggestion of three-dimensional shape and configuration,⁵⁷ apparently neglects two-dimensional designs such as the *multicolore* pattern. For that reason, they argue that ‘embody’ must carry the same meaning as the expressions ‘incorporated in or applied to’⁵⁸ or ‘made according to’.⁵⁹ While perhaps an awkward construct, it is a necessary one in order to give full protection to two-dimensional designs. It is also worth noting that ‘embody’ has been defined broadly as to ‘give a material or discernible form to an abstract principle or concept’,⁶⁰ which can apply to both two-dimensional and three-dimensional manifestations.

E Clarifying Plesner’s Design

In most cases, the definition of the defendant’s design would be uncontentious. However, questions arise when the defendant uses the registered design as part of a more complex design, as Plesner does here. The court’s conception of the defendant’s design is therefore critical.⁶¹ Is the total creative composition of *Simple Living* compared to the registered pattern, or do we only compare the two respective patterns in isolation? If the latter, clearly there is substantial similarity in overall impression; if the former, an overall impression of similarity is unlikely. It is therefore a critically important point.

In *Plesner v Louis Vuitton*, all parties, and the court, apparently proceeded on the assumption that the relevant comparison is between the registered design and the substantially similar design utilised by Plesner on the handbag *in isolation*. The European approach of comparing ‘like with like’⁶² reflects that of copyright law,

56 Staniforth Ricketson and Christopher Creswell, *The Law Of Intellectual Property: Copyright, Designs & Confidential Information*, (Lawbook Co, 2nd ed, 2002) [23.0].

57 Which is the relevant meaning of ‘embody’ in the context of the design-copyright overlap defence in the *Copyright Act 1968* (Cth) ss 74–7, which provisions only concern three-dimensional designs. See *Polo/Lauren Co LP v Ziliani Holdings Pty Ltd* (2008) 173 FCR 266, 282 [56].

58 The European model, outlined above.

59 The wording suggested by the Australian Law Reform Commission (‘ALRC’), *Designs*, Report No 74 (1995) app A [10]. See Ricketson and Creswell, above n 56, [23.0].

60 *Polo/Lauren Co LP v Ziliani Holdings Pty Ltd* (2008) 173 FCR 266, 282 [56].

61 ‘It is for the Court to determine the meaning of a design in a proceeding under the *Designs Act*: *Keller v LED Technologies Pty Ltd* (2010) 185 FCR 449, 460 [36] (Emmett J).

62 See *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2006] EWHC 3154 (Ch) [46].

where the use of an entire copyright work in a larger work with additional elements is irrelevant to the question of whether that copyright work has been infringed.⁶³

The justification for the European approach is that otherwise, third parties could employ the registered design as a significant, but secondary, design element and avoid liability:

It would, in my judgment, be surprising if someone who found that a significant part of his design had been copied was debarred from claiming that his unregistered Community design had been infringed merely because the infringer had added material of his own.⁶⁴

Further, designers cannot defensively register, *ex ante*, all myriad combinations of the registered design and other elements that potential infringers may employ. The question is whether the same approach must necessarily be followed in Australia. As a matter of policy, there may be no compelling reason to do so, since with respect to two-dimensional designs at least, designers can rely on copyright to protect the design,⁶⁵ (although this is no doubt also the case in Europe). However, this question has not yet been considered by an Australian court.

Under the Australian regime, if s 71(1)(a) of the *Designs Act* was the only applicable provision, then infringement could follow, since Plesner's substantially similar pattern is 'embodied' in the T-shirt, which is all that is required by s 71(1)(a).⁶⁶ However, all references to 'designs' in the Act are 'a reference to a design in relation to a product'.⁶⁷ Therefore all designs — including the defendant's — are considered in relation to a product. Even this may result in infringement, consistent with the approach in *Louis Vuitton v Plesner*, since a 'relation to a product' may simply demand some *connection* between the design and a product. In this case that would be satisfied since the pattern is applied to Plesner's T-shirts.

It is the definition of 'design' which distinguishes the Australian system from the approach taken in *Plesner v Louis Vuitton*. A design is the *overall appearance of the product* resulting from one or more visual features of the product.⁶⁸ It is not the isolated appearance of an *aspect* of the design applied to that product. Therefore, at least in Australia, the true comparison must be made between the overall appearance of the Louis Vuitton T-shirts bearing the registered pattern, and the overall appearance of the Plesner T-shirts bearing her design. The overall appearance of her product is the entire construct of *Simple Living* — it is not the registered pattern in isolation. In other words, the question in Australia is the overall appearance of the *product*, not the overall appearance of the *design*.

63 Absent any applicable exception.

64 *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2006] EWHC 3154 (Ch) [46].

65 Noting that the design-copyright overlap defence would not apply to two-dimensional artistic works. See generally *Copyright Act 1968* (Cth) ss 74–7. This also assumes that the designer is also the copyright owner or licensee.

66 Within the broad meaning of 'embodied' discussed above.

67 *Designs Act* s 8.

68 *Ibid* s 5.

F Particular Issues with Respect to Two-dimensional Designs

The focus on the overall appearance of *products* is incongruous with respect to two-dimensional designs. This is because the product to which most two-dimensional patterns are applied would be unoriginal and not the true focus of the design. In this respect, the European treatment of a graphic symbol as the product itself is understandable. For example, in this case, most fundamental T-shirt shapes have long existed in the prior art base. Therefore, the true design monopoly is the design itself, as it appears on the nominated product, rather than the product bearing the design. The situation is clearly different with respect to three-dimensional designs, because the design is the three-dimensional shape of the product.

The statute nevertheless mandates a consideration of the overall appearance of the product bearing the design. Notwithstanding this, there are a number of statutory factors which could result in the European approach of ‘like being compared to like’ being followed in Australia. Each statutory factor is considered from the perspective of the ‘informed user’, so some discussion of that hypothetical person is required.

G The Standard of the Informed User

While the standard of the informed user in the Australian *Designs Act* was said to be borrowed or inspired from European design law,⁶⁹ there are some notable differences between the European and Australian approaches. The European Regulation provides that both the novelty and infringement of designs is determined by ‘the overall impression produced on an informed user viewing the design’.⁷⁰ The informed user is not defined, although the phrase clearly contemplates that the fictional person is, to state the obvious, both informed, and a user.

In contrast, the Australian provision mentions the phrase ‘informed user’ only as an expression defining the preceding words in s 19(4), namely ‘a person who is familiar with the product to which the design relates, or products similar to the product to which the design relates’. A recent Federal Court decision articulates the difference:

[While] the informed user is the touchstone specifically provided by [the European directive] ... [s]ection 19(4) uses the expression ‘the standard of the informed user’ ... merely as a tag [and] it is not a statement of the content of the test. The expression ‘the standard of the informed user’ is defined by the preceding words of the provision. So viewed, the expression cannot colour the meaning of the express words of the test.⁷¹

69 ALRC, above n 59, [5.18], [6.12]; *Review 2* (2008) 173 FCR 450, 455 [20]; *Multisteps Pty Limited v Source and Sell Pty Ltd* (2013) 214 FCR 323, 337 [64] (*‘Multisteps’*).

70 *Regulation* recital 14. See also arts 6(1), 10(1).

71 *Multisteps* (2013) 214 FCR 323, 337 [63].

Despite the reference to ‘user’ in the expression in s 19(4), the content of s 19(4) makes no reference to use, only familiarity. The Federal Court of Australia has recently held that the hypothetical informed user is not merely, or inevitably, a *user* of the product: ‘the necessary and only qualification is that the person be familiar with [the product].’⁷² Familiarity may be developed by use, but not necessarily. In contrast, as mentioned, the European system revolves around an informed *user*.

Finally, there may be a discernible difference between the Australian standard of ‘familiarity’ with the product to which the design relates, and the European standard of an *informed* user, with the latter suggesting a deeper knowledge than familiarity confers.⁷³ A standard of familiarity may also amplify the number of people who could be the informed user, since it will include people both familiar with, and users of, the product.

H The Informed User of What?

The Australian provisions clarify that the informed user is familiar with ‘the *product* to which the design relates’.⁷⁴ The European provisions speak of the ‘overall impression produced on an informed user viewing the *design*’.⁷⁵ Although this suggests that the European informed user is a user of the *design*, they are more accurately a user of the particular product to which the design is applied. First, the *Regulation* defines ‘design’ to mean ‘the appearance of the whole or part of a product’.⁷⁶ Further, an informed user must use something, and use of a design per se would be limited to those acts preceding commercial exploitation of a useable product, such as the process of applying a design to a product. European jurisprudence clarifies that the informed user is neither the notional consumer of trade mark law, nor the niche expert of patent law, but someone in between.⁷⁷ All these people use more than the design per se. Recital 14 of the *Regulation* assists in clarifying that the informed user takes ‘into consideration the nature of the product to which the design is applied or in which it is incorporated, and in particular the industrial sector to which it belongs’. However, recalling that the product in this case is the graphic symbol itself, and the potential universal

72 Ibid 338 [70]. Cf decisions under the UK *Designs Act* and the *Regulation* which ‘stress the dual character of the notional person — who must not only be informed, but be a user’: ibid 335 [59]; and other Federal Court decisions, including *Review 2* (2008) 173 FCR 450, 455 [19]: ‘the informed user must be a *user* of the class of product in question’.

73 Although note Kenny J’s description of the informed user as having ‘particular *knowledge* of, and familiarity with’ the registered product (emphases added), which may inflate the provision past the boundary intended by Parliament: *Review 2* (2008) 173 FCR 450, 457 [27].

74 *Designs Act* s 19(4) (emphasis added).

75 *Regulation* recital 14 (emphasis added). See also art 6(1): ‘[a] *design* shall be considered to have individual character if the overall impression *it* produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public’ (emphasis added); art 10(1): ‘[t]he scope of the protection conferred by a Community design shall include any *design* which does not produce on the informed user a different overall impression’ (emphasis added).

76 Art 3(a).

77 See, eg, *PepsiCo Inc v Grupo Promer Mon Graphic SA* (C-281/10 P) [2011] ECR I-10153, I-10195–6 [53].

application of a graphic symbol to miscellaneous products, recital 14 is of limited assistance, and the relevant product is still theoretically limitless. In contrast, the Australian system compels a nomination of a particular product and thus permits a workable application of the informed user standard.

A separate issue is: whose product should be contemplated by the informed user? In all of the references to the ‘design’ in s 19 of the *Designs Act* and in the *Regulation*,⁷⁸ it is unclear *which* product is considered — the plaintiff’s or the defendant’s.⁷⁹ The references in s 71 of the *Designs Act* perhaps more clearly suggest that the reference is to the *registered* design. At least one European case also suggests that the notional user is a user of the class of products indicated in the registration.⁸⁰ However, as mentioned, where that class is a miscellany of products, no particular product can be fixed on. Thus in Europe, it is suggested that the better approach in such cases would be to use the defendant’s actual use to define the product used by the informed user.

I The Informed User and Product Definitions

Based on our hypothetical Australian design, the relevant product is a T-shirt. But the T-shirt market is at least as broad as the fashion market, its spectrum often determined by the value of the brands displayed on the shirts. Therefore, to define the informed user simply as someone familiar with ‘T-shirts’ is unhelpful. There are likely to be several separate t-shirt markets, or at least submarkets, including luxury T-shirts and standard T-shirts, and possibly even unbranded and branded T-shirts. A luxury T-shirt user is likely to have very different perspectives and responses to the visual features of luxury T-shirts than someone familiar with chain store T-shirts. If we include informed users familiar with Plesner’s design, then political or satirical T-shirts may form another market category altogether. However, this further complicates the definition of the relevant informed user. Plesner’s T-shirts occupy a distinctly different market to the Louis Vuitton T-shirts, and luxury T-shirt enthusiasts are unlikely to have the same degree of familiarity with political or satirical T-shirts. Do we employ different standards for each of these markets? How do we reconcile them if they conflict? And within each of these markets, or submarkets, will be varying degrees of familiarity with

78 Matters to be taken into account in assessing whether a design produces a different overall impression include the degree of freedom of the designer in developing the design, the nature of the product to which the design is applied, and the industrial sector to which it belongs: see *Regulation* arts 6(2), 10(2); recital 14.

79 Nothing in the *Designs Act* expressly demands that the informed user be defined by reference to the particular depiction of the product as utilised by the design owner. See Toby Headdon, ‘Community Design Right Infringement: An Emerging Consensus or a Different Overall Impression?’ (2007) 29 *European Intellectual Property Review* 336, 337: ‘one could easily argue that the informed user should be identified by reference to the industrial sector of the allegedly infringing design’.

80 See *The Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2007] EWCA Civ 936; *Svedbergs i Dalstorp AB v Gofab Design AB* (European Union Office for Harmonization in the Internal Market (Trade Marks and Designs), Board of Appeal, R91/2010-3, 24 January 2011) [5]: ‘[t]he informed user is familiar with the basic features of the products to which the contested RCD relates’.

the relevant products. Only one *familiar* with the relevant products will be an informed user.⁸¹

The Australian Law Reform Commission recognised that a design may be aimed at different market segments. Two minority members recommended a stricter test of distinctiveness and suggested that '[t]o make the test workable the product market must be treated as a single market', and '[a] single "informed user" assessment is made by considering the perspectives of all significant user groups in the aggregate and weighing up any differences in those perspectives according to the significance of that group to the product market'.⁸² The view that 'a notional informed user is a melding of the (probably divergent) views of those who exemplify a range of informed users' has been rejected, with a preference for the court to 'postulate the view of a typical member of a sample of informed users'.⁸³ Either alternative is awkward in this instance, particularly if the informed user includes a person familiar with the defendant's design. When the informed user spectrum ranges from luxury T-shirt enthusiasts to political T-shirt devotees, who is the 'typical member' of a sample derived from such disparate areas of familiarity? The process of aggregating informed users across both the plaintiff and defendant's product markets would be very difficult.

Another issue is the product-design dichotomy, which, as mentioned above, assumes special importance in relation to two-dimensional designs. The informed user has particular familiarity with the *product* to which the design relates,⁸⁴ not the design itself. This is not problematic with respect to three-dimensional designs, because the design is the shape of the product. In contrast, a two-dimensional design may be applied to any number of products. The design itself is usually the integral consideration; the fact that it is applied to a T-shirt, hat, coffee mug or scarf may be comparatively immaterial. In the context of the informed user, this design-product dichotomy raises two distinct notions of familiarity: familiarity with the products to which the design is applied, and familiarity with the designs themselves. The Australian statutory scheme apparently ignores the latter informed user,⁸⁵ notwithstanding that in this instance, the informed user is likely to be someone particularly familiar with luxury brands and patterns per se. To speak in terms of familiarity with T-shirts ignores the reality that such an informed user would probably focus on the Louis Vuitton *design*.

On balance, assuming the informed user is someone familiar with the registered goods, rather than the defendant's goods, the user is likely to be someone familiar with luxury branded T-shirts.

81 Thus, in *Review 2* (2008) 173 FCR 450, 457 [27], Kenny J included in the standard of the informed user 'women who subscribe to fashion magazines ... and have particular knowledge of, and familiarity with, fashion trends', and excluded 'women who lack such knowledge and familiarity'.

82 ALRC, above n 59, [5.29].

83 *Icon Plastics Pty Ltd* [2007] ADO 2 (5 July 2007) [19].

84 *Designs Act* s 19(4).

85 Although it is quite conceivable that some informed users may be familiar with both the design and the product to which it is applied.

J The Amount, Quality and Importance of the Part

If ‘only part of the design is substantially similar to another design’, as is the case here, the decision-maker, using the standard of the informed user, must ‘have regard to the amount, quality and importance of that part in the context of the design as a whole’.⁸⁶ This reflects the European approach, and suggests the substantiality test in copyright law (although in the context of the defendant’s use rather than the plaintiff’s work).⁸⁷ The amount, quality and importance of the handbag pattern in Plesner’s composition are significant. Visually, the bag occupies perhaps one third of the image, and it is an important component of the overall design, which is comprised of only three main elements.⁸⁸ While this reflects the European approach, it does not necessarily codify it. The informed user is required to ‘have regard to’ the amount, quality and importance of the handbag pattern in a balancing exercise. It does not follow that the informed user *disregards* everything else, as would appear to be the case in Europe.

K The Relevance of Conceptual Factors

The difficulty with this case is that the primary *importance* of the hypothetical Australian Louis Vuitton registered design lies in the message of affluent excess conveyed by the reputation subsisting in the pattern. But to what extent can such conceptual and reputational factors be considered in the *visual* territory of designs? To these factors we might add the context, purpose and meaning of the defendant’s use. Whether the Australian regime can insulate from liability designs which convey critical commentary may in large part depend on whether such factors can be taken into account.

Consideration of the meaning, reputation and purpose of the design is not necessarily prevented by the *Designs Act*’s mandate to give more weight to ‘similarities between the designs than to differences between them’.⁸⁹ Perhaps importantly, this statutory wording is not limited to the purely sensory effect of visual similarities and differences, and the s 19 factors, while mandatory, are not exhaustive. Further, infringement hinges on the ‘overall impression’ left by the design, and impressions may include conceptual factors. For example, in *Neuman v Jose Manuel Baena Grupo SA*, the Court of Justice of the European Union accepted the conclusion of the lower court that the informed user may pay ‘particular attention to the *feelings* expressed by each character appearing on a sticker’.⁹⁰ The Australian Law Reform Commission recognised that the informed user may be a person particularly familiar with, *inter alia*, ‘the nature’⁹¹ of the

86 *Designs Act* s 19(2)(c).

87 Note that there is nothing in s 19(2)(c) of the *Designs Act* which limits consideration to the amount, quality and importance of the part in the context of the *registered* design. Section 19(4) is coloured by s 19(1), which states ‘[i]f a person is required by this Act to decide whether a *design* is substantially similar in overall impression to *another design*’ (emphasis added).

88 The boy, the bag and the Chihuahua.

89 *Designs Act* s 19(1).

90 *Neuman v Jose Manuel Baena Grupo SA* (Court of Justice of the European Union (Sixth Chamber) C-101/11 P, 18 October 2012) [22] (emphasis added).

91 ALRC, above n 59, [5.17].

product, which could include its function as a political commentary. Further, '[t]he characteristics of the informed user are not defined'.⁹²

However, other statutory provisions, particularly the definition of 'design', stipulate that a design is the overall *appearance* of the product, which results from its *visual features*. The definition of design conditions all reference to 'designs' in the *Designs Act*, including the references in s 19. This suggests the overwhelming dominance of visual factors would leave non-visual impressions with only a vestige of relevance to the informed user, and case law to date bears that out.⁹³ In contrast to *Neuman*, the Landgericht Düsseldorf has held in respect to words displayed in a design, that only their appearance, not their conceptual meaning, is relevant.⁹⁴

While the appearance of things may 'matter most',⁹⁵ where an informed user would, as an aspect of their familiarity with the product, contemplate non-visual factors, those factors must be relevant. This recognises the reality that some visual features convey meaning, and to ignore that meaning is artificial. In this case, Plesner's design is more than a combination of lines and colours; it is more than a mere pattern. It is a composition conveying meaning. Whether the reputation per se inherent in the design should be considered by the informed user may be as contentious as it is in the context of registered trade mark law.⁹⁶ However, unlike registered trade mark law, the question in the designs context is determined by a

92 *Multisteps* (2013) 214 FCR 323, 335 [58].

93 '[O]ne must not forget that we are in the territory of designs and thus what matters most is the appearance of things' (*Woodhouse UK plc v Architectural Lighting Systems* [2006] RPC 1, 17–18 [50]); '[t]he focus for consideration is on eye appeal and not on internal or less visible manufacturing features' (*Review 2* (2008) 173 FCR 450, 457 [26]); '[t]here may be others whose *perceptions* could be taken as representing the standard' (*Multisteps* (2013) 214 FCR 323, 338 [70] (emphasis added)); 'he or she will have an awareness and appreciation of the *visual features* of a [product] that serve its functional as well as its aesthetic purposes' (*Multisteps* (2013) 214 FCR 323, 338 [70] (emphasis added)); 'I do not regard the *perceptions* of the general body of consumers [to be relevant]' (*Multisteps* (2013) 214 FCR 323, 338 [71] (emphasis added)). And note the Court's query in *Plesner v Louis Vuitton* whether the reputation of a registered design is a relevant consideration (see above n 23).

94 Case 14 c O 44/07 *Liebe deine Stadt* (Landgericht Düsseldorf, 18 May 2007), noted in Henning Hartwig (ed), *Designschutz in Europa (vol 3)* (Carl Heymanns Verlag, 2009) 362, cited in David Stone, *European Union Design Law: A Practitioners' Guide* (Oxford University Press, 2012) 172 n 143.

95 *Woodhouse UK plc v Architectural Lighting Systems* [2006] RPC 1, 18 [50].

96 In *Registrar of Trade Marks v Woolworths Ltd* (1999) 93 FCR 365, a majority of the Full Court of the Federal Court held that WOOLWORTHS METRO would not infringe METRO due to the fame of the Woolworths supermarket chain (although this was a case concerned with deceptive similarity grant, not an infringement case). In *Coca-Cola Co v All-Fect Distributors Ltd* (1999) 96 FCR 107, 123 [42] the Full Court of the Federal Court took into account, in relation to an infringement claim under s 120(2) of the *Trade Marks Act 1995* (Cth), that the plaintiff's mark was 'extremely well-known'. In *CA Henschke & Co v Rosemount Estates Pty Ltd* (2000) 52 IPR 42, 66 [52] ('*Henschke*'), the majority of Full Court of the Federal Court held that the reputation of a mark was relevant *only* where a mark or an element of a mark is 'notoriously so ubiquitous and of such long standing that consumers generally must be taken to be familiar with it and with its use in relation to particular goods or services'. In *Pfizer Products Inc v Karam* (2006) 219 FCR 585, 598–9 [50], Gyles J acknowledged support for the use of reputation in connection with infringement could be found in *Henschke* at [51] and in *Caterpillar Loader Hire (Holdings) Pty Ltd v Caterpillar Tractor Co* (1983) 77 FLR 139, 151 (Lockhart J), 141 (Franki J), and 163 (Neaves J), but did not comment on whether this was a correct approach, and thought reputation was irrelevant when assessing deceptive similarity in the context of s 44 of the *Trade Marks Act 1995* (Cth). See also *Mars Australia Pty Ltd v Sweet Rewards Pty Ltd* (2009) 84 IPR 12, where the notoriety of the reputation in the MALTESERS mark was a factor pointing against deceptive similarity to MALT BALLS.

person *familiar* with the products to which the design relates. If such a person, due to their familiarity, would immediately recognise the reputational value inherent in the Louis Vuitton pattern, that can hardly be ignored. The consideration of non-visual factors should not, however, be boundless. For example, Plesner's extraneous purpose of aiding the Darfur divestment campaign would not be a factor considered by the informed user in this instance. In contrast, her purpose in calling attention to the disparity between rich and poor, or satirising the Vuitton brand, which inheres in the composition itself, should be taken into account.

The relevance of non-visual factors also impacts on other s 19 criteria. For example, if we disregard Plesner's purpose, she has considerable freedom to innovate away from the registered pattern.⁹⁷ However, a parodist's freedom to innovate is curtailed; they must use enough of the parodied design to evoke it.

L Giving Similarities Greater Weight than Differences

Despite the objective differences between the *multicolore* pattern in isolation, and Plesner's composition, s 19 of the *Designs Act* requires more weight to be given to similarities than differences.⁹⁸ Again, this reflects the European approach of comparing like with like, while not codifying it. The notional informed user, and their assumed familiarity with branded T-shirts, appears critical here. How would the informed user perceive Plesner's design? What weight would they give to the *multicolore* pattern, being the only similarity to the registered design?

If the informed user is familiar with *luxury* branded T-shirts, they would immediately notice the recognisable *multicolore* pattern, and may focus on that, rather than perceive the design more holistically. Whereas if the informed user is familiar with chain store T-shirts and ignorant of Louis Vuitton handbag designs, the *multicolore* pattern would merely be an element in a composition.

The informed user's focus on the substantially similar pattern is consistent with the requirement to give more weight to similarities rather than differences. However, it is one thing to favour the similarities; it is another thing to ignore significant differences. Even if the informed user fixes on the pattern, the other elements of *Simple Living* could hardly be disregarded, in which case *Simple Living* could not be considered substantially similar in overall impression to the pattern in isolation. Some cases have suggested that even objectively very similar looking products may not be substantially similar in overall impression due to one or more proportionally minor features which assume particular significance through the lens of the relevant informed user.⁹⁹ However, there are no examples of the converse, that is, where only one element is objectively similar but the majority of design elements are very different.

97 *Designs Act* s 19(2)(d).

98 *Ibid* s 19(1).

99 See *Astra/Zeneca AB* [2007] ADO 4 (5 June 2007), where the dosage indicator face on otherwise close-to-identical asthma puffers adequately distinguished the design.

Therefore, the significance of the competing design elements relative to the substantially similar pattern ought to prevent an *overall impression* of similarity. In particular, the informed user engages in a ‘studied comparison’, rather than a ‘casual comparison’ of the designs, and there is no confusion requirement in the substantial similarity test. ‘[T]he notion of “imperfect recollection” — familiar in trade mark law — has no application when determining design similarity’.¹⁰⁰ Further, *Review 2* makes it clear that differences in pattern (including colour), may result in a different overall impression of the design:¹⁰¹

How much weight is to be given to pattern and colour will depend on the nature of the product and the relative importance of the different visual features of the registered design, as viewed by the informed user ... [P]attern, including colour, is a feature that an informed user would consider has some significance in creating the overall impression of the [design].¹⁰²

The *Review 2* case concerned a comparison of two dress designs, and the Court held that differences in the pattern and colour of the dress designs were relevant, in addition to differences in the cut and design of the dresses.¹⁰³ In this case, where the underlying unoriginal design of the T-shirt itself can be ignored, the *only* thing of importance is the comparison of the ‘patterns’¹⁰⁴ on each T-shirt. It therefore becomes more difficult to ignore the universal impression left by all of the elements of Plesner’s design.

In summary then, Plesner ought to avoid liability for design infringement in Australia, although the above discussion demonstrates that the outcome is certainly not clear-cut. A number of statutory factors support the European approach of comparing the similar features of the designs in isolation, and courts may favour this approach as a means of preventing defendants from avoiding infringement by simply adding other material to the registered design. However, the binary relationship between products and designs in the *Designs Act* compels a comparison of products, rather than designs. This may result in much narrower protection for Australian registered design patterns relative to their European counterparts,¹⁰⁵ and means that infringement may be avoided by surrounding a registered design pattern with other design elements. It also results in a lack of international harmonisation in designs law, which may rankle proponents of

100 *Multisteps* (2013) 214 FCR 323, 334 [55]. See ALRC, above n 59, [6.34] (citations omitted):

The Commission recommends that market confusion should not be included in the list of factors to be considered. Generally market confusion relates to consumer issues that are more efficiently and appropriately dealt with under trade practices, trade marks, passing off or fair trading law. There is usually some degree of subjective assessment required. The infringement test should focus on the objective similarity of designs rather than subjective notions as to whether the designs may be confused.

Of course, there may be many cases where an overall impression of similarity does indeed cause confusion.

101 *Review 2* (2008) 173 FCR 450, 461 [45].

102 *Ibid* 462 [52].

103 Note that the registered design was for a coloured representation of the dress.

104 The word ‘composition’ is more accurate in the case of Plesner’s design, than the word ‘pattern’.

105 And may explain Louis Vuitton’s failure to register the patterns under the Australian *Designs Act*.

greater synchronisation. However, the inextricable connection between designs and products in the existing Australian scheme necessitates that outcome. On balance, should ACIP's review of designs law disturb the existing design-product dichotomy, it should proceed carefully, since that dichotomy provides a natural control against the blunt enforcement of design rights against critical design appropriation.

IV A LACUNA IN AUSTRALIAN DESIGNS LAW?

The above discussion applied, inter alia, Australian designs law to the particular facts in *Plesner v Louis Vuitton*. It is interesting to ponder other examples of artistic or parodic design appropriation, and consider how they would fare in the context of Australian and European designs law.

A Other Examples of Derivative Designs — Artistic Expression

An interesting example is Damian Hirst's giant sculpture *Hymn*, which he sold for a reported £1m to the collector Charles Saatchi. The sculpture was a 20ft bronze sculpture of a male anatomy. It was also a faithful copy of a plastic anatomy model made by an English toy company that sold for £14.99.¹⁰⁶ Similar examples are the Dutch artist Florentijn Hofman's enlarged floating versions of the 'original' rubber duckie,¹⁰⁷ and Simon McGrath's giant tap sculpture.¹⁰⁸ If the anatomical toy, rubber duck and taps were registered designs, it is doubtful that the significant difference in the *scale* of the corresponding sculptures alone would prevent overall substantial similarity. In Europe, it has been accepted that design rights extend to the design in all dimensions, and the size of the defendant's allegedly infringing design is irrelevant.¹⁰⁹ In the context of these examples, in a somewhat prescient fashion, one court has hypothesised that a design 'a hundred times the size' of the registered design would infringe.¹¹⁰

In Australia, most examples of appropriation art should avoid design infringement. Mere *use* of a genuine product in an artistic context would not infringe any

106 See the sculpture at Damien Hirst, *Hymn, 1999 – 2005* <<http://www.damienhirst.com/hymn>>. For a brief report on the dispute see Clare Dyer, 'Hirst Pays Up for Hymn that Wasn't His', *The Guardian* (online), 19 May 2000 <<http://www.theguardian.com/uk/2000/may/19/claredyer1>>.

107 See Alicia Eler, *How Pop Art Got 'Ripped Off'* (9 July 2013) Hyperallergic <<http://hyperallergic.com/75107/how-pop-art-got-ripped-off/>>.

108 See Sallie Don, 'Tapping Creativity for Great Sculpture by the Sea', *The Australian* (online), 4 November 2011 <<http://www.theaustralian.com.au/arts/visual-arts/tapping-great-sculpture-by-the-sea/story-fn9d3avm-1226185420093>>.

109 *Green Lane Products Ltd v PMS International Group Ltd* [2008] Bus LR 338, 341 [12].

110 *Ibid.*

exclusive design right,¹¹¹ because secondary infringement relies on primary infringement.¹¹² Therefore Tom Forsyth's use of genuine Barbie dolls in a variety of bizarre and provocative poses would be immune from challenge under the *Designs Act*.¹¹³ While Forsyth may have used the Barbie dolls for the purposes of trade or business,¹¹⁴ he did not make the dolls himself, nor was he dealing in infringing dolls. Similar considerations would apply to appropriation art such as Duchamp's 'readymade' urinal.¹¹⁵

This highlights another example of the comparative breadth of the European Community registered design right, and its divergence from the Australian model. In contrast to the exhaustive rights conferred under the Australian *Designs Act*, the *Regulation* confers an inclusive right to 'use' the registered design without any purposive qualification. A clarifying provision stipulates that '[t]he aforementioned use shall cover, *in particular*, the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes.'¹¹⁶

An additional limitation not shared by the European system is that the Australian defendant can only infringe in respect of products 'in relation to which the design is registered'.¹¹⁷ The European right *includes* (but does not oblige) using a product in which the design is 'incorporated or to which it is applied', whereas the Australian right *requires* embodiment of the registered design.

B Other Examples of Derivative Designs — Parody

There are numerous examples of two- and three-dimensional products parodying familiar trade marks and designs. For example, 'Teen Pregnancy Barbie' is a pregnant version of the iconic doll,¹¹⁸ and the 'Chewy Vuitton' dog toys mimic

111 Which includes, under s 10(1) of the *Designs Act*, the right to make, or offer to make a product, in relation to which the design is registered, which embodies the design (s 10(1)(a)); to import such a product into Australia for sale, or for use for the purposes of any trade or business (s 10(1)(b)); to sell, hire or otherwise dispose of, or offer to sell, hire or otherwise dispose of, such a product (s 10(1)(c)); to use such a product in any way for the purposes of any trade or business (s 10(1)(d)); to keep such a product for the purpose of doing any of the things mentioned in paragraph 10(1)(c) or (d) (s 10(1)(e)); and to authorise another person to do any of the above(s 10(1)(f)).

112 In the *Designs Act*, the exclusive rights listed below the primary right to make or offer to make a product embodying the registered design all relate back to that primary right (see the reference in each of ss 10(1)((b)–(e) to 'such a product', being the product made in contravention of s 10(1)(a)).

113 See *Mattel Inc v Walking Mountain Productions*, 353 F 3d 792, 812 (9th Cir, 2003). A similar example is Susanne Pitt, who painted and costumed Barbie dolls for resale as sadomasochistic 'Dungeon Dolls' (see *Mattel Inc v Pitt*, 229 F Supp 2d 315, 318–19 (SD NY, 2001)).

114 *Designs Act* s 71(1)(d). It is clearly arguable that a conceptual artist, in using the Barbies for the purposes of an artistic exhibition, is using them for the purposes of that artist's business.

115 Entitled *Fountain*, Duchamp's work consisted of a porcelain urinal that was propped atop a pedestal. He submitted it to the Society of Independent Artists Exhibition in 1917 under the pseudonym, R. Mutt. See, for example, Jonathan Jones, 'Reinventing the Wheel', *The Guardian* (online), 9 February 2008 <<http://www.theguardian.com/books/2008/feb/09/art>>.

116 *Regulation* art 19 (emphasis added). See also *Designs Directive* art 12.

117 *Designs Act* s 71(1)(a).

118 'Teen Pregnancy Barbie' or 'Pregnant Barbie' (10 September 2013) BabyCenter <http://community.babycenter.com/post/a23872103/teen_pregnancy_barbie_or_pregnant_barbie>.

a Louis Vuitton bag.¹¹⁹ A sculptor has parodied Batman in ‘Fat Batman’, his obese version of the character.¹²⁰ Assuming a corresponding registered design, many examples may lack substantial similarity in overall impression, but others may be virtually identical, with perhaps just one powerful difference triggering the parody. Hence ‘Teen Pregnancy Barbie’, despite the rounded belly, may be substantially similar in overall appearance to any registered design for the doll.

There is considerable potential for two-dimensional parodies to infringe, such as a parody of the Nike ‘swoosh’ design applied to clothing.¹²¹ Such parodies will frequently be closer to the registered design than Plesner’s composition, and therefore substantially similar in overall impression. This may lead to design infringement when comparable intellectual property regimes would likely immunise the parodic use from liability. Copyright law permits a fair parodic dealing.¹²² If the use is overtly commercial, this may diminish the fairness of the dealing, since the commercial sphere is, after all, the trade mark proprietor’s world, even if art is not. However, commercial use should not be presumptively unfair, but just one factor to be weighed in the overall assessment of fairness.¹²³ Similarly, a comparable registered trade mark may not be infringed. A commercial parody product may use the registered mark as a trade mark to distinguish the defendant’s goods from those of other traders.¹²⁴ However, a sufficiently robust parody is likely to prevent the confusion necessary for infringement under trade mark law,¹²⁵ which requires the observer to be caused to wonder whether the infringing product originates from the registered owner.¹²⁶

C Design Rights and Freedom of Expression

The above examples demonstrate the potential disparity in the treatment of parody under the trade marks and copyright regimes, compared to the Australian designs regime. The strength of the parody will often prevent the confusion essential to most trade mark infringement, and a fair parody is a recognised exception to copyright infringement. Where is the comparable latitude in designs law? If there are sufficient policy reasons for exempting parodic expression from copyright and trade mark infringement, it seems anomalous to leave parodic design exposed. It is highly likely that this was simply not seen as an issue.¹²⁷ However, with many designs simultaneously qualifying as a trade mark, copyright artistic work, and

119 *Louis Vuitton Malletier SA v Haute Diggity Dog, LLC* 507 F 3d 252 (4th Cir, 2007).

120 Joshua Hayes, *Fat Batman is the Best Batman Ever!* (4 September 2010) Tomopop <<http://www.tomopop.com/fat-batman-is-the-best-batman-ever--11950.phtml>>.

121 See, for example, Nike Sweatshops, *About This Site* <<http://www.toolness.com/nike/about.html>>.

122 See *Copyright Act 1968* (Cth) ss 41A and 103AA.

123 This is the approach taken in the United States. See the US Supreme Court decision *Campbell v Acuff-Rose Music Inc*, 510 US 569 (1994).

124 *E & J Gallo Winery v Lion Nathan Australia Pty Ltd* (2010) 241 CLR 144, 162–3 [42]–[43].

125 And passing off, for that matter.

126 *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd* (1954) 91 CLR 592, 595 (Kitto J), affirmed on appeal to the Full Court at 608.

127 For example, the issue was never raised in the ALRC *Designs* report (above n 59).

registrable design, the risk of inconsistent immunity is significant. Designs law may therefore prohibit creative expression which is tolerated by its intellectual property cousins, in a surprising, and clearly unintended, overreach.

In Australia, which enjoys no express right to free speech, this suggests the need for legislative reform. There are at least two possible inherent controls in the *Designs Act*. However, as discussed below, one merely narrows the risk of overreach, and the other is uncertain and may not prevent the overreach. The implied right to political communication may also insulate design appropriation for political purposes, but that is also uncertain and is unlikely to prevent the overreach.

D Infringement Limited to Registered Products

The first control is that, as mentioned above, infringement will only occur where the defendant makes a product¹²⁸ ‘in relation to which the design is registered’.¹²⁹ This will at least confine the overreach to ‘same product’ uses. In particular, it may prevent infringement in cases involving substantially identical three-dimensional artistic appropriations. For example, the anatomical toy in the Damian Hirst example would presumably be registered with respect to toys, whereas Hirst would be using the design in respect of ‘artworks’. However, this will clearly still leave ‘same-product’ appropriation (for example the Batman toy and two-dimensional parody products), as potentially infringing.

E The Significance of the Standard of the Informed User

The other possible control is the standard of the ‘informed user’, a person ‘familiar with the product to which the design relates’.¹³⁰ Again, in the case of ‘same-product’ parodies, this control will be far less effectual, since the informed user will be familiar with the product to which the design relates. This control will be most effective in the case of appropriation art. Where the registered products are radically different from ‘art’, the person familiar with the registered products will be *more* sensitive to differences between the registered design and the defendant’s product. The message and purpose of the derivative design will likely also be fundamentally different to the registered design, but the discussion above questioned whether such factors can be appreciated by the hypothetical informed user. Much also depends on whether the allegedly infringing design would be viewed in context by the informed user. Any relevant message or purpose may only be apparent if the derivative design is evaluated in its appropriate context. For example, would duplicates of a registered design used in a conceptual art installation infringe?¹³¹ As comparable products, they

128 Or does any other impugned act mentioned in ss 71(1)(b)–(c) in relation to such a product.

129 *Designs Act* s 71(1)(a).

130 *Ibid* s 19(4).

131 Say, a pile of Lego-like bricks in a gallery, reminiscent of Carl Andre’s ‘pile of bricks’ *Equivalent VIII*, exhibited at the Tate Gallery in London. See *The Bricks Controversy* (2003) Tate <http://www2.tate.org.uk/archive/journeys/historyhtml/people_public.htm>.

may be virtually identical, but may fulfil extremely different cultural purposes. The perception of the derivative design as art may only be possible if it is viewed by the hypothetical user in a gallery. The contextual relevance of designs to the informed user is not foreign to European design law,¹³² at least to appreciate visual differences. A similar approach expanding to conceptual differences would need to be followed in Australia to avoid design overreach. However, as the above discussion suggested, whether these conceptual differences can be considered by the informed user is uncertain.

F Implied Freedom of Political Communication

Australians enjoy an implied constitutional freedom of political expression.¹³³ Whether this freedom would have assisted Plesner is a difficult question, mainly due to the uncertainty of its scope and application. A detailed consideration is beyond the scope of this paper. However, many commentators have described the limited scope of this ‘negative’ freedom, which relies on the invalidation of laws unjustifiably burdening political communication to create an area of immunity.¹³⁴ The freedom is limited to ‘political’ communication necessary for the Australian system of representative government. While intellectual property laws undoubtedly have the capacity to burden political expression, it is likely that they would be categorised analogously to defamation law, as a ‘law reasonably appropriate and adapted to serve a legitimate end [in a manner] which is compatible with the maintenance of the constitutionally prescribed system of representative and responsible government’.¹³⁵ The High Court is unlikely to read down provisions of the *Designs Act* to insulate political expression. Political expression and design rights are not necessarily in conflict, since one could seek the licence of the design owner to use the design for political commentary. There may also be circumstances where a design is being used for both political commentary and commercial gain, which constitutes a more objectionable encroachment on design rights.

V CONCLUSION

Conclusions based on hypothetical musings are inherently weak, particularly when many important factual assumptions have been made. Plesner’s liability under designs law is unclear, since it depends on how her design is defined when comparing it to the registered design, and on the factors considered by an

132 See *Woodhouse UK plc v Architectural Lighting Systems* [2006] RPC 1, 18 [52], where the infringing design was evaluated in situ.

133 See, eg, *Nationwide News Pty Ltd v Willis* (1992) 177 CLR 1; *Australian Capital Television Pty Ltd v Commonwealth* (1992) 177 CLR 106.

134 See, eg, Adrienne Stone, ‘“Insult and Emotion, Calumny and Invective”: Twenty Years of Freedom of Political Communication’ (2011) 30 *University of Queensland Law Journal* 79. In respect of the negative nature of the freedom, see Brennan J in *Cunliffe v Commonwealth* (1994) 182 CLR 272, 327.

135 *Coleman v Power* (2004) 220 CLR 1, 50 [93].

informed user. The article highlights significant differences between European design law and Australian law, but suggests that the latter's insistence on a strict relationship between the designs and the products to which they are applied provides the strongest source of protection to Plesner.

Outside the specific facts of the Plesner case, the article indicates that a number of derivative designs created for the purposes of artistic, political or parodic expression may be substantially similar in overall impression to a corresponding registered design. In the absence of any right to free speech or specific exception for parody or satire, the only filter against infringement is a broad approach to the standard of the informed user which admits non-visual criteria, or disparity between the registered goods and the derivative design. Should those filters fail, the Australian design right could be a potent restraint on political and artistic expression which would probably be permitted under the more apposite rights of copyright, trade marks and moral rights.

The above discussion also highlights a number of important differences between the Australian and European design systems, and the free speech frameworks in which those systems operate. The questions raised above are incongruous in the context of the registered design system, which was never intended to prevent artistic or political appropriation of designs.¹³⁶ Hopefully, most courts, if confronted with a case like Plesner's, would keep the policy foundation of designs law firmly in mind and avoid an overly literal interpretation of the *Designs Act*. However, some courts may be reluctant to stray too far from the plain meaning of the statute, which emphasises the visual aspects of designs law, and question the relevance of conceptual and reputational factors. They may be persuaded to follow the European approach of comparing like with like, particularly to avoid licensing defendants to avoid liability by surrounding the infringing design with other material. With the number of registered designs likely to increase,¹³⁷ there are enough troubling questions to suggest the need for some judicial, and probably legislative, clarification. In particular, the use of a registered design which would be an exception to infringement under copyright and trade marks legislation should enjoy the same exemption under the designs regime. As ACIP's review of the *Designs Act* proceeds,¹³⁸ any undermining of the existing controls on the scope of design rights which permit broader creative expression must be compensated by more extensive exceptions to infringement.

136 'Design registration is intended to protect designs which have an industrial or commercial use': ACIP, Issues Paper, above n 39, 8 [2.1].

137 Filings for registered designs have increased since the commencement of the *Designs Act* (ACIP, Issues Paper, above n 39, 10 [2.3]), and ACIP's mandate to consider 'new opportunities for enhancing the Act's effectiveness and efficiency; and any deficiencies and unintended consequences arising from the Act's implementation' (ACIP, Issues Paper, above n 39, 6 [1.3]), suggests an implicit objective to increase the number of registered designs.

138 ACIP, *Review of the Designs System*, above n 9.