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**COPYRIGHT /DESIGN OVERLAP**

The High Court recently considered the interplay between copyright and design when two dimensional plans (artistic works) become three dimensional objects. In this case the objects related to yacht construction, specifically the “plug”, which was a hand-crafted full scale model of the hull and deck sections and the deck and hull mouldings. These objects corresponded to the two dimensional drawings of which they were a reproduction: s 21(3) of the *Copyright Act 1968* (Cth), in respect of a yacht design known as the JS 9000.

*Background*

The ‘overlap provisions’ generally represent a policy consideration of the government. Copyright protection in relation to artistic works (life of the author plus 70 years – see s 33), far exceeds design protection under the *Designs Act 2003* (Cth) (10 years: s 46). In the case of a drawing which becomes a corresponding design applied to an object, such as the hull of a yacht, the industrial application of that corresponding design will give the author of the drawings a protection in the commercialisation of the product which is undesirable.

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The result is the loss of copyright protection upon the application of a corresponding design to an object which is industrially applied, which is in essence where more than 50 are made: Reg 17 *Copyright Regulations 1969*.

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The effect is to push copyright owners to register the design under the *Designs Act* for protection. The plug and mouldings were not registered as designs, however the defence is not available to a ‘work of artistic craftsmanship’: s 77(1)(a).

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*Facts*

The Respondent manufactured the JS 9000 yacht in Australia and in other parts of the world. In 2003, the second appellant (Mr Rogers) and the third appellant (Mr Warren), who had previously been employed by Swarbrick Yachts, were employed at the factory of the fourth appellant (Boldgold).

Their employment with Boldgold related to the yacht construction of a JS9000, utilising a hull and deck moulding which Boldgold had acquired from Mr Rogers. The moulding had been given to Mr Rogers in late 2002 by SwarbrickYachts.

In September 2003, a judge of the court granted *ex parte* injunctive relief preventing the reproduction in material form of the object known as “the Plug” and “from manufacturing or procuring the manufacture of any mould using the JS 9000 hull and deck mouldings”: the reasons at [14].

#### *The question*

Broadly, the question was whether the Plug, the hull and deck mouldings were works of artistic craftsmanship, thereby not being caught by the overlap provisions.

It is noted that the questions arose and were determined according to the *Copyright Act 1968* (Cth), before the amendments to the relevant provisions introduced by the *Designs (Consequential Amendments) Act 2003* (Cth).

#### *Decision*

The appeal against the decision of the Full Court of the Federal Court of Australia, was allowed

#### *Reasons*

Their Honours in their joint reasons considered that an important element in determining whether a work is a work of artistic craftsmanship, was the level of constraint upon the author/designer by the necessary functionality and utility of the object. Relevantly at [83]:

However, determining whether a work is "a work of artistic craftsmanship" does not turn on assessing the beauty or aesthetic appeal of work or on assessing any harmony between its visual appeal and its utility. The determination turns on assessing the extent to which the particular work's artistic expression, in its form, is unconstrained by functional considerations.

This issue had to be considered objectively: the reasons at [63] and regard to the designer's aspirations did not play a role, even though it was admissible. The Court considered a number of factors, particularly the following passage from an article:

The designer cannot follow wherever aesthetic interests might lead. Utilitarian concerns influence, and at times dictate, available choices. Indeed, aesthetic success is often measured in terms of the harmony achieved between competing interests.”[91]

The Court found that the visual and aesthetic considerations were “subordinated to the truly functional required of a ‘sports boat’ (the reasons at [73]). It followed that as the Plug was not a work of artistic craftsmanship, the deck and the hull mouldings which were made from the Plug, could not be of that character. In addition, at the trial, the hull and the deck moulds were not put forward as independent works of artistic craftsmanship from the Plug.

*Burge v Swarbrick* [2007] HCA 17 (Gleeson CJ, Gummow, Kirby, Heydon and Crennan JJ, 26 April 2007)