

# Swedish copyright evergreens Mini-Maglite?

By Hans Henrik Lidgard\*

In April 2009 the Swedish Supreme Court awarded copyright protection to the Mini-Maglite® torch as “artware” without any requirement for a special level of expression. The overall impression made by the well known Mini-Maglite torch was held to be different from that of other similar torches. The Court held that it displayed a sufficient degree of independence and originality despite the fact that the functional design properties of the torch are neither new nor original. This article investigates the intersection of the different IPR rules in Sweden and those of certain other European countries and the possible extent of copyright legislation. It concludes that the Swedish position is untenable and that this demonstrates that there is a need for European harmonization of substantive copyright legislation



“The distinctive shapes, styles and overall appearances of all Mag® flashlights, and the circumferential inscriptions extending around the heads of all Mag® flashlights are trademarks of Mag Instrument, Inc. The circumferential inscription on the head of every flashlight signifies that it is an original Mag® flashlight and part of the Mag® family of flashlights. U.S. Trademark Registrations for the shape, style and overall appearance trademarks of Mag® flashlights and for circumferential inscription trademarks of Mag® flashlights include Nos. 1,808,998; 2,074,795; 2,687,693; 2,745,460; 2,765,978 and 2,765,979.”<sup>1</sup>

On April 9, 2009 the Swedish Supreme Court gave its judgement in the protracted infringement battle between the U.S. Mag Instrument (“Mag”) and

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\* Professor of law at Lund University ([hhl@jur.lu.se](mailto:hhl@jur.lu.se)). The papers can also be accessed on the Social Science Research Network (SSRN): The author like to thank L.L.M. Robert Schwartz Esq, (New York) for valuable assistance and comments.

<sup>1</sup> <http://www.maglite.com/productline.asp>.

Sweden's IKEA regarding alleged copyright protection for the Mini-Maglite® torch.<sup>2</sup> The Court determined that Swedish copyright legislation protects artware without any special expression level requirements.

The Court held that the overall impression made by the well known Mini-Maglite torch is still different from that of other similar torches and displays enough independence and originality despite the fact that the functional design properties of the torch are neither new nor original. The Court held that the design is more than trivial and not just an expression of the functionality of the different parts. It is rather an example of a consistent and balanced design, deserving of copyright protection. The Court emphasised that this was a borderline case, and that the reach of the copyright protection was limited.

Once again, Mag's strategic protection efforts on behalf of its mini-torch had been successful.<sup>3</sup> A hesitant Court could find no support from inconsistent Swedish doctrine. Undoubtedly, the judgement raises questions as to how far intellectual copyright legislation, protecting the expression of what has been termed "the seven fine arts," can also be used to protect items of design and handicraft. How should copyright be balanced against other industrial property rights? Are there competition concerns that must be considered?

### ***A problematic area***

Approaching the crossroads of intellectual and industrial property rights is in itself a difficult task involving issues of subjective aesthetic considerations. What is an artistic work? When is art merely design or handicraft, and when do elegant and functional individual creations become mass-produced industrial goods?

It is even difficult to decide which notions are to be used. This article will turn on the concept of useful art and the use of the term "artware". If products are characterized by a certain level of creativity and originality they will have reached what will be referred to as the "required expression level"<sup>4</sup> and can be protected by copyright. This notion does not cover the core of creativity, such as its subject, idea or factual content.<sup>5</sup> How this expression level should be defined is, of course, the crux of the paper. Does the protection only apply to identical products, or are similar products included – a problem referred to as the "scope of the protection".

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<sup>2</sup> Högsta domstolen (Swedish Supreme Court), Case T 1421-07, *Mag Instrument, Inc v. IKEA Svenska Försäljnings Aktiebolag ("IKEA")*, n.y.p, in the official court report. The case is available on [www.domstol.se/.../2009-04-09%20T%201421-07%20Dom.pdf](http://www.domstol.se/.../2009-04-09%20T%201421-07%20Dom.pdf)

<sup>3</sup> Mag Instruments have been active over the years in a number of cases in different jurisdictions aiming at defending its products. The outcome differs as will be further explained. An important judgment, where the outcome was less happy for Mag, was when the EFTA Court in Case E-2/97, *Mag Instruments Inc. v California Trading Company Norway*, [1997] EFTA Ct. Rep. 129 opted for "international" exhaustion and thus indirectly allowed parallel importation of the Mini-Maglite from USA to Norway. This case preceded ECJ, Case C-355/96 *Silhouette v Hartlauer*, ECR[1998] I-4799. The EFTA court has now altered its position in Joined Cases E-9/07 and E-10/07, *L'Oreal Norge AS v Per Aarskog AS*, 7 July 2008, [2008] E.T.M.R. 60.

<sup>4</sup> In German "Werkshöhe" and in Swedish "Verkshöjd".

<sup>5</sup> SOU 1956:25, Upphovsmannarätt till litterära och konstnärliga verk, s. 68.

The discussion does not end with pitting copyright law and design law against each other. Design, form and shape can also attract patent and trade mark protection. Furthermore, the “passing off” rules under common law and general unfair trade laws or marketing laws also affect the final outcome and must therefore be addressed.

## **Copyright development**

As the European Court of Justice often puts it, “in the present state of Community law and in the absence of community standardization or of a harmonization of laws” the determination of the conditions and procedures under which copyright protection is granted is a matter for national rules.<sup>6</sup> Harmonization on the European level at present primarily relates to information technology<sup>7</sup> and the core of copyright law remains a national prerogative.<sup>8</sup>

### **A revolutionary idea**

Roman law did not prevent copying. In England, a society more driven by technological development, copyright protection had its roots in privileges granted by the 1662 Act for the Encouragement of Learning and the 1710 Statute of Anne.<sup>9</sup> Initially only publishers were protected from having their books copied, but with the Statute of Anne the focus was on the author, whose work was

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<sup>6</sup> See e.g. ECJ, Case 144/81, *Keurkoop BV v Nancy Kean Gifts BV*, 14 September 1982, [1982] ECR 2853, paragraph 18.

<sup>7</sup> See, Council Directive 91/250/EEC of 14 May 1991 on the legal protection of computer programs, OJ 1991 L 122/42 (as amended by Directive 93/98/EEC); Council Directive 92/100/EEC of 19 November 1992 on rental right and lending right and on certain rights related to copyright in the field of intellectual property, OJ 1992 L 346/61 (as amended by Directive 93/98/EEC); Council Directive 93/83/EEC of 27 September 1993 on the coordination of certain rules concerning copyright and rights related to copyright applicable to satellite broadcasting and cable retransmission, OJ 1993 L 248/15; Council Directive 93/98/EEC of 29 October 1993 harmonising the term of protection of copyright and certain related rights, OJ 1993 L 290/9; Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases, OJ 1996 L 77/20; Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the internal market (‘Directive on electronic commerce’), OJ 2000 L 178/1; Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society, OJ 2001 L 167/10.

<sup>8</sup> Once harmonization has occurred, the need for uniform application of Community law and the principle of equality require that where provisions of Community law make no express reference to the law of the Member States for the purpose of determining their meaning and scope, they must normally be given an autonomous and uniform interpretation throughout the Community. See ECJ, Case C-5/08, *Infopaq International A/S v Danske Dagblades Forening*, 16 July 2009, n.y.p. Reference for a preliminary ruling under Article 234 EC from Højesteret regarding Directive 2001/29/EC and reproduction of short extracts of literary works.

<sup>9</sup> Deazley, Ronan. *On The Origin Of The Right To Copy: Charting the Movement of Copyright Law in Eighteenth Century Britain*, (Hart Publishing, 2004) Found at <http://books.google.se/books?id=BUFx8BeDMIAC&dq>.

protected for a period of 14 to 20 years.<sup>10</sup> The legislation regulated the marketplace where booksellers and publishers operated, but gradually evolved into an instrument that recognised ownership in an author's intellectual labour. In 1787 a revolutionary American development found expression in the U.S. Constitution.<sup>11</sup> U.S. courts have frequently noted that the purpose of U.S. copyright legislation is to promote the interest of the public, rather than to follow the author-centred moral rights view expressed by the Europeans.<sup>12</sup> France followed suit in 1791 with protection that went beyond just economic reward and underlined a work's moral aspects.

In the mid 1700s Sweden granted privileges to printers. Inspired by the French and U.S. developments, an 1810 constitutional enactment (also with a revolutionary origin) protected authors.<sup>13</sup> A general author's legislation was introduced in 1877 and protection was granted for the life of the author plus 50 years, (later reduced to 30 years.) Separate legislation was gradually introduced to protect other artistic efforts, but it was only with the Swedish copyright law of 1919 that a unified copyright legislation came about.<sup>14</sup>

### **1886 Berne Convention**

National copyright protection only applies to works created within the country in question. Consequently, a work published in one country could be copied elsewhere by anyone and sold there. The 1886 Berne Convention<sup>15</sup> internationalized copyright protection for the benefit of the author in the same way as industrial property rights had been addressed in the Paris Convention.

Article 2 of the Berne Convention protects the “expression” of literary and artistic works. This includes every production in the literary, scientific and artistic

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<sup>10</sup> The term of protection was prolonged in 1814 to 20 years or the life of the author if longer. Copyright Act 1814, 54 Geo. III, c. 156 (Eng.).

<sup>11</sup> U.S. Const., art. I, §8, cl. 8: “Congress shall have the power to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” The 1790 Federal copyright statute protected maps, charts and books. Later amendments granted protection to historical or other print or prints, musical compositions and photographs. In 1870 the list was completed by the addition of paintings, drawings, chromos, statues, statuaries and models and designs “intended to perfect the work of fine art”. See Zimmerman, Dianne Leenheer, *It's An Original! (?): In Pursuit Of Copyright's Elusive Essence*, 28 Colum. J.L. & Arts 187, 200 fn. 87 (2005) (and references therein.)

<sup>12</sup> See, e.g., *Sony Corp. of America v. Universal City Studios*, 464 U.S. 417, 429 (1984). (Reward to owner is secondary to benefit to public.)

<sup>13</sup> 1810 Tryckfrihetsförordningen (Constitutional regulation of freedom to print/freedom of the press) § 1 section 8 stipulated that every printing belongs to the author. (Varje skrift vare författarens eller dess laglige rättsinnehavares egendom”.

<sup>14</sup> Lagar den 30 maj 1919 om rätt till litterära och musikaliska verk, om rätt till verk av bildande konst samt om rätt till fotografiska bilder. See SOU 1956:25, Upphovsmannarätt till litterära och konstnärliga verk, page 35 ff.

<sup>15</sup> Berne Convention for the Protection of Literary and Artistic Works of September 9, 1886, completed at Paris on May 4, 1896, revised at Berlin on November 13, 1908, completed at Berne on March 20, 1914, revised at Rome on June 2, 1928, at Brussels on June 26, 1948, at Stockholm on July 14, 1967, and at Paris on July 24, 1971, and amended on September 28, 1979. Available at [http://www.wipo.int/treaties/en/ip/berne/pdf/trtdocs\\_wo001.pdf](http://www.wipo.int/treaties/en/ip/berne/pdf/trtdocs_wo001.pdf).

domain, whatever may be the mode or form of its expression. Article 2 also covers writings, lectures, musical works, choreography and cinematography. Drawings, paintings, architecture, sculpture, engraving and lithography and photographic works are also protected. Of special interest is that the same provision now also covers works of applied art.<sup>16</sup> The Member States, now some 160 countries, may prescribe that works in general or any specified categories of works will not be protected unless they have been fixed in some material form.

### ***Industrial designs & Works of applied art – “artware”***

The Berne Convention left it to national legislation to determine the extent of the application of the law with respect to works of applied art and industrial design, as well as the conditions under which they would be protected.

The Swedish history in this area is less than consistent and hardly glorious in so far as concerns the protection of industrial designs and artware.

#### **Swedish Design protection**

The 1899 Swedish Design Act<sup>17</sup> created five-year protection for new, registered ornamental designs in the metal industry. In spite of numerous regulatory attempts,<sup>18</sup> modern, general, legislation was only introduced in 1970 when protection was granted to industrial designs for a period of 15 years from their registration.<sup>19</sup>

Under the law a "design" is a prototype for the shape of a product or for an ornament. The person who has created a design may obtain, through registration, an exclusive right to exploit it. Designs may be registered only if they substantially differ from what has become known before the date of filing. Everything that has been made generally available anywhere in the world is considered as "known". The right applies only to the goods for which the design has been registered, or for similar goods.

The term of Swedish design protection has now, in line with the EU Directive on Design Protection<sup>20</sup> been extended to cover a period of 25 years from registration. Likewise inspired by EU developments, Sweden has also introduced an abbreviated protection for unregistered designs.

#### **Swedish Copyright legislation**

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<sup>16</sup> *Id.*, Article 2. The initial Bern Convention did not contain any rules on artware. It was only with the 1908 revision that Article 2 of the Convention stated that it was left to national law to decide on the extent of protection for industrial designs and applied art.

<sup>17</sup> 1899 års lag om skydd för vissa mönster och modeller, SFS 1899:59.

<sup>18</sup> See SOU 1965:61, Mönsterskydd, page 34 ff.

<sup>19</sup> 1970 års Mönsterskyddslag (Swedish Design Protection Act) SFS 1970:485 of June 29, 1970, available at <http://www.wipo.int/clea/en/details.jsp?id=3630>

<sup>20</sup> Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs OJ 1998 L 289/28. Amendment of the Swedish design law in 2002. See, Prop. 2001/2002:121, Genomförande av Europaparlamentets och rådets direktiv om mönsterskydd m.m..

The 1960 Swedish Copyright Act<sup>21</sup> provides that anyone who has created a literary or artistic work shall have copyright in that work, regardless of whether it is a fictional or descriptive representation in writing or speech. Works of fine arts, architecture or applied art are also protected.

Before the 1960 Copyright Act, protection for artware only lasted for 10 years from publication.<sup>22</sup> This protection was provisionally maintained in the new legislation in anticipation of the contemplated design legislation.<sup>23</sup> With the 1970 Design Act the specific treatment of artware in the Copyright Act was eliminated and copyrightable artware became protected for the life of the creator plus 50 (now 70)<sup>24</sup> years.

Unsurprisingly, the preparatory work for the legislation required that the extended protection for artware should be balanced by stiffer expression level requirements.<sup>25</sup> To qualify for copyright protection a work had to be personal, with an artistic presentation<sup>26</sup> in order to eliminate the risk of independent double creation.<sup>27</sup> A certain generosity towards artware with limited expression alternatives was indicated.<sup>28</sup>

The case-law development after 1970 gives limited guidance as to the extent of the protection of artware. Protection has been granted certain textile products with ornamental elements. A special design for a ladies' tunic was protected as an independent and original design with an individualised and artistic presentation.<sup>29</sup> Protection was accorded to forms or configuration preventing passing off relating

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<sup>21</sup> Swedish Copyright, Act, 30 December 1960, SFS 1960:729.

<sup>22</sup> The 1919 Copyright Act did not contain any provisions regarding artware. Revisions in 1926 provided 10 year protection from the date of publication, but did not cover clothing and woven materials as Sweden wanted to benefit from freedom in this area and sought an influx of such material from the European continent

<sup>23</sup> The proposal for the 1960 Copyright Act, SOU 1965:61, did not contain provisions regarding applied art, but rather suggested that the area be covered by reformed design legislation and not by extending the reach of the copyright legislation. However, in the final legislation a provisional 10 year protection for artware was retained in anticipation of a planned reform of the design legislation.

<sup>24</sup> Long copyright protection has no reasonably explicable explanation when compared to other IPRs. The TRIPs Agreement requires at least lifetime protection plus 50 years. The extension to 70 years was inspired by the 1998 US Copyright Term Extension Act also referred to as the "Mickey Mouse Protection Act" aimed at protecting some of the most valuable Disney products. The act was introduced after heavy industry lobbying.

<sup>25</sup> Prop 1969:168 page 135 and SOU 1965:61, *Mönsterskydd*, page 210 ff.

<sup>26</sup> In NJA 1962:750 – *String*, the Swedish Supreme Court recognised copyright protection for the functional "String" bookshelf. A holistic approach should be taken – that included functional details. The String shelf was aesthetically sufficiently original to be regarded as artware. This specific case is cited as an example in the 1965 preparatory legislative work of what should not be copyright protected in the future. See SOU 1965:61, *Mönsterskydd*, page 211.

<sup>27</sup> Determining whether or not there is a risk of double creation is a supporting rule used to establish copyright protection and the reach of the protection. This notion does not, however, clarify whether the object has reached the required expression level. See, Swedish Supreme Court, NJA 2004:149, - *Pergo*.

<sup>28</sup> Prop 1969:168 page 134-136 and SOU 1965:61 page 211.

<sup>29</sup> Swedish Supreme Court, NJA 1995:164 - *Stickad Tunika*.

to the specific form under review. Thus the Court also underlined the independence and uniqueness of the design in a textile fabric case, where the ornament consisted of a wild strawberry but a similar design consisting of ordinary strawberries was regarded as outside the area of protection even if the new ornament had been inspired by the commercial success of the earlier design.<sup>30</sup> The general impression is, however, that the Swedish courts, in spite of the fairly clear language in the preparatory work, have been reluctant to deny copyright protection. The courts, rather, seem to reach the conclusion that protection applies, but that the scope of protection is limited and confined to the precise configuration.

### ***Copyright versus other forms of protection***

Can copyright be used as a tool-box to create protection for ownership interests where that interest is already protected by other, perhaps more appropriate, legal regimes?

#### **Design and copyright**

As a consequence of the Swedish case law, artware may very well be protected as both copyright and as a registered design. This is in line with § 10 of the Copyright Law, which expressly states that copyright may subsist in a work even if it has been registered as a design.

This double protection has been the subject of discussions throughout the history of the Copyright Law. One view was that the creator had to make an election. If she wanted to benefit from the more precise design protection, copyright protection would then be excluded. This would lead to increased predictability through registration, and the scope of protection would be similar to the scope of patent protection. In general such predictability would facilitate trade and establish a fair trade-off between the public interest and the reward to the designer. This view was, however, not accepted.

The fact that Swedish law opted for a double protection rule was based on several premises. First, there was no reason not to grant the same protection for artware protected by design protection as for those artistic efforts, which could not be subject of design protection. Second, the moral rights of an artist were only protected by copyright law, and the serious designer had an equal right to benefit from this element of the law.<sup>31</sup> A less clearly enunciated reason for not limiting the protection of artware to design protection may be found in Article 2(7) of the Berne Convention.<sup>32</sup> Without double protection in Sweden, Swedish designs would not be protected under copyright law in a foreign country even if double protection were available in that country. Lacking international agreements

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<sup>30</sup> Swedish Supreme Court, NJA 1994:74 - *Smultron*.

<sup>31</sup> See, SOU 1965:61 *Mönsterskydd*, page 224 ff.

<sup>32</sup> 1886 Berne Convention for the Protection of Literary and Artistic Works, Article 2(7): "... Works protected in the country of origin solely as designs and models shall be entitled in another country of the Union only to such special protection as is granted in that country to designs and models; however, if no such special protection is granted in that country, such works shall be protected as artistic works."

regarding the precise protection to be offered to artware, Swedish exports needed to be able to draw the benefit of strong protection on their home turf.

### **Patents and trademarks**

Can an item be both patent protected and copyrightable? The law is silent on this issue, but does specify that copyright does not subsist in layout designs in semiconductor products. Special provisions apply to rights in such designs.

Patents protect ideas/inventions, which are functional solutions to problems, whereas copyright protects the expression rather than the idea as such. The functional elements expressed in the claims of a patent are not protectable under copyright (or any other IPR).<sup>33</sup> The fact that a patent has been applied for, is an indication of the fact that the item is not copyright protectable.<sup>34</sup> If a patent protected product embodies a form or shape, which in spite of this reservation has reached copyrightable expression level, the functional elements must then be disregarded.

The underlying logic is that the legislator has struck a balance by granting a 20 year protection for patentable functional elements. It is carefully designed to strike a balance between the need to promote innovation and the requirements of free access, further improvements being the lifeblood of the economy.

Trademarks are indications of origin. A trademark can be a single word or a phrase. It can also take the form of a shape of a product. Nothing prevents a slogan or shape from reaching an expression level conferring copyright protection. A trademark, which is initially not inherently distinctive may acquire distinctiveness through use. Functional elements can never acquire protectable distinctiveness.<sup>35</sup> It should be noted that trademarks and copyright serve totally different functions – a trademark is intended to prevent consumers from being misled as to the origin of the product, whereas copyright protection is focused on the rights of the creator.

### **Marketing law prevents “passing off”**

A further question is whether protection under unfair trade/competition laws, common law passing off rules, or other marketing laws can coexist with copyright protection and thereby increase the scope of protection for distinctive products.

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<sup>33</sup> The Swedish Supreme Court has confirmed that drawings in a patent application in principle can be protected by copyright even if the protection did not apply in the specific instance. *See* NJA 2004:149 - *Välinge*. *Cf.* NJA 1998:563 - *Finnbohus*.

<sup>34</sup> *Cf.* U.S Supreme Court, *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 29 (2001) (where the Court held that “a utility patent is strong evidence that the features therein claimed are functional. ... one who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional.”)

<sup>35</sup> Article 7(3) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, OJ 1994 L 11/1 does not refer to Article 7(1) e of the same Regulation, which excludes acquired distinctiveness for signs which consist exclusively of: “(i) the shape which results from the nature of the goods themselves; or (ii) the shape of goods which is necessary to obtain a technical result; or (iii) the shape which gives substantial value to the goods.” *Cf.* ECJ, Case C-299/99, *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd.*, 18 June 2002, [2002], ECR. I-5475, para 57.

Conversely should the copyright holder who sees his copyrights infringed be limited to the consequences established by the law governing his property rights?

In general this type of legislation, like trademark legislation, has as its prime object . the prevention of marketing activities that mislead end customers. Therefore, an item may very well benefit both from intellectual property rights and these unfair trade rules.<sup>36</sup>

### **Evergreen conclusion**

The overall conclusion of this brief comparative survey is that Swedish law provides the artist with a whole battery of rules that may be used to fend off competition. The clever artist will probably consider whether anything in his creation may be patent protected. Are there elements meeting the requirements of the design law? May the entire creation reach such a standard that the creator may claim copyright protection? If the form developed is not inherently distinctive, has it acquired distinctiveness at a later stage, which would allow trademark protection? Are competitors infringing unfair competition laws by marketing products which may mislead the public?

To make use of the entire spectrum of protection is a fine legal exercise and if the job is done well, product protection is maintained on an evergreen basis and, accordingly, competition will be restricted.

### ***Protecting Maglite***

The Mini-Maglite is a barrel-shaped aluminium flashlight designed to use AA-cell batteries. Similar flashlights for C- and D-cell batteries have been on the market since the early 1970s. The Mini-Maglite was first introduced in January 1984. Earlier larger torches were also produced in aluminium with a cylindrical barrel with a knurled grip and a tail cap. The lenses had a greater diameter than the barrel as well as a separate headpiece with knurling and a face cap. It has therefore been suggested that the Mini-Maglite was primarily a scaled-down version of the larger flashlights.<sup>37</sup> The Mini-Maglite, however, also lacked an external switch.

The Mini-Maglite was an instant market success and achieved substantial sales in its U.S. home market and abroad. The primary market consisted of sales to professionals such as the police and other security forces.<sup>38</sup> It was also sold as an

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<sup>36</sup> See e.g. the treatment of the liqueur Galliano in the Swedish Supreme Court (NJA:1995:635-*Galliano*), and in the Swedish Marketing Court (MD 1996:3 *Galliano*).

<sup>37</sup> Statement by Meinhardt, Mag's expert witness in the U.S. Trade Commission, Investigation, fn. 41 below.

<sup>38</sup> It is interesting to note that a number of U.S. cases concern policemen applying Maglite products directly to criminal offenders. See e.g., *Baker v. Holcomb*, 2008 WL 4914439 (D.Neb. Nov. 12, 2008) ("Here, the plaintiff alleges defendants ...carried him by his hair and "repeatedly" hit him with a "maglite." ... "The plaintiff alleges these defendants "lacerated [his] right eye," caused "abrasions on his abdomen," and "aggravat[ed] ... [his] pre-existing knee fracture."), *Thorne v. Steubenville Police Officer*, 463 F.Supp.2d 760, 764. (S.D.Ohio,2006.) ("Danny asserts that while they waited for Thorne, Sr. to open the side door to the house, Officer Karovic hit Danny three times above his right eye with an approximately eighteen or twenty-inch Maglite

accessory e.g. to the sporting goods and aircraft supply markets. In its own early marketing the company claimed that the “beautiful, functional design is their hallmark”. The Mini-Maglite “is a study in simplicity”, “the size makes it the ideal professional or personal light” and it easily fits into a pocket or a purse. Its durability including the “aircraft grade aluminium” and “anodized finish” preventing corrosion. The knurling on the flashlight provides a “sure grip” just enough to minimize abrasiveness. Furthermore the shape of the head was convenient for one-handed operations. The absence of an external switch prevents the torch from accidentally turning on while not in use.<sup>39</sup> The marketing success was, as is often the case, a mixed blessing: by 1987 competitors importing mini flashlights had acquired some 57% of the market and it was obvious that Mag had to take action if it wanted to protect itself from these inroads into the mini torch market.

By 1984 Mag had already applied for and received utility patent protection under U.S. Letters Patent No. 4,577,263. In a continuation-in-part application Mag claimed “A flashlight ... wherein the head assembly includes an outer surface shaped in a gradual taper towards the tail cap and over an extent substantially greater than half the length of the head assembly.” The features thus claimed were the actual configuration of the torch.

Mag subsequently also applied for three-dimensional trademark protection for the torch. The company has relied on both its patent protection and its trademarks in legal proceedings and has also invoked the misappropriation of trade dress and acts of unfair competition when protecting the Mini-Maglite.

### **Questionable patent protection**

Starting in 1987 Mag has consistently invoked its presumed legal rights to its elegant design. The first major case concerned the importation of a number of mini flashlights considered by Mag to infringe on its patent as well as its trade dress protection. The U.S. International Trade Commission determined<sup>40</sup> by way of adopting a more than 200 page long opinion by the Administrative Law Judge,<sup>41</sup> that the patents were unenforceable as the invention had been made public more than one year before the registration application. The ITC went as far as to conclude that Mag’s failure to disclose prior art was inequitable conduct by gross negligence, at the very least.<sup>42</sup>

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flashlight”) *aff’d in part rev’d in part sub nom Thorne v. Lelles*, 243 Fed.Appx. 157, 2007 WL 2781151 (C.A.6 (Ohio), *Yarnall v. Mendez*, 433 F.Supp.2d 432 (D.Del. 2006) (“[P]laintiff alleges that, pursuant to an arrest and after being handcuffed, Mendez struck him twice on the head with a “Maglite” flashlight.”)

<sup>39</sup> The advertising claims are summarized from findings from the ITC Decision 337-TA-254, fn. 41, page 111 f.

<sup>40</sup> The U.S. International Trade Commission (the “ITC”) handles customs matters.

<sup>41</sup> *In The Matter of Certain Small Aluminium Flashlights and Components thereof*. U.S. Trade Commission, Investigation No. 337-TA-254, (Initial Determination of [date\*]) (Mathias ALJ) page 109, point 484,(unreported) (adopted by the ITC) (the “ITC Decision”). (A copy of the ITC Decision is on file with the author.)

<sup>42</sup> This finding of gross negligence and inequitable conduct was overturned by the Federal Circuit in an unpublished decision, *Mag Instruments, Inc., v. ITC*, 868 F.2d 1278 (Fed. Cir. 1989)

### **A functional trade dress**

With respect to the trade dress claim,<sup>43</sup> the ITC concluded that Mag had failed to prove that the overall shape, style and appearance of Mini-Maglite was not primarily functional; that it had acquired a secondary meaning; or was likely to lead to customer confusion.<sup>44</sup> The ITC concluded that “the Mini-Maglite does indeed have a sleek design, but each and every component of its design is fully functional; and certainly the overall configuration of the flashlight is, in terms of utility, the best or one of the best designs available.”<sup>45</sup> The features were “obviously utilitarian”. The sum of the components added up to the total configuration, which determined the functionality. Furthermore, the ITC held that configuration claimed in a utility patent was strong evidence that the configuration was functional.<sup>46</sup> The only design feature that was potentially non-functional was the tapering of the head from the lens to the barrel. This feature was, however, also claimed in the utility patent application.

### **No inherently distinguishable trademark**

The ITC considered whether or not trademark protection applied to the mini-torch product itself. Under U.S. law a configuration is inherently distinctive if it can be presumed that the average consumer will recognize it to be a trademark.<sup>47</sup> However, the evidence was against Mag. No customer survey confirmed any such distinctiveness while the fact that others copied the product could not as such support trademark protection. Mag had not demonstrated by a preponderance of evidence, that the overall shape and appearance of the Mini-Maglite flashlight enjoys such secondary meaning as to be protected by trademark<sup>48</sup>.

In 1996 Mag also unsuccessfully advanced trademark protection claims for the three-dimensional torch in Europe under the EC Trademark Regulation<sup>49</sup>. The examiner at OHIM refused the application made under Article 38 of the Trademark Regulation<sup>50</sup> on the ground that the trademarks were devoid of

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(remanded on rehearing to hear intervenor’s patent invalidity claims.) 878 F.2d 1443, 1989 WL 49202 (Fed. Cir. March 21 1989) (unpublished).

<sup>43</sup> For a discussion of the U.S. position on the interface between trade dress and design see Groff, Bradley, K., *Bare-Fisted Competition or Palming off? Protection of Product Design as Trade Dress under the Lanham Act*, 23 AIPLA Q.J. 65, 97.

<sup>44</sup> ITC Decision, fn. 41, point 607.

<sup>45</sup> *Id.*, page 181.

<sup>46</sup> *Id.*, page 184 with reference to *New England Butt Co., v. ITC* 756 F.2d 874, 878 (Fed. Cir. 1985); *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 U.S.P.Q. ,15 (C.C.P.A. 1982), and *Best Lock Corp. v. Schlage Lock Company* 413 F.2d 1195 (C.C.P.A. 1969)

<sup>47</sup> *Seabrook Foods, Inc., v. Bar-Well Foods, Inc.*, 568 F.2d 1342, 196 U.S.P.Q. 289,291 (C.C.P.A. 1977).

<sup>48</sup> ITC Decision, fn. 41, point \*.

<sup>49</sup> Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, OJ 1994 L 11, p. 1.

<sup>50</sup> Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, OJ (1994) L 11/1.

distinctive character. The Board of Appeal<sup>51</sup> agreed and held that for the shape of the goods alone to constitute a distinctive indication of origin the shape must display features sufficiently different from the usual shape of the goods for potential buyers to perceive it as an indication of the origin rather than a representation of the goods themselves. The Board stated that the fact that Mini-Maglite was attractively designed does not by itself make its features inherently distinctive.

In its appeal to the CFI,<sup>52</sup> Mag submitted that even a small degree of distinctiveness suffices to overcome the bar to registration. The Mini-Maglite was, according to Mag, “a striking example of goods of high technical quality whose aesthetically pleasing shape, as the main feature, embodies their semantic function, one of their leading features.”. The torch had been so displayed in various books, in museums and had won international awards. Copying created confusion and copiers exploited the “cult Mag Lite torch design.”. Trademark protection had also been granted in several EU Member States.<sup>53</sup>

The CFI held that regard must be had to the presumed expectations of an average consumer, who is reasonably well informed and reasonably observant and circumspect. Mini-Maglite is cylindrical and opens out at the end where the bulb is. The application corresponds to shapes commonly used by other manufacturers and only provides the consumer with an indication of the nature of the product without distinguishing it from the shapes of similar products. The attractiveness does not draw the consumer’s attention to the good’s commercial origin.<sup>54</sup>

On appeal<sup>55</sup> the ECJ basically agreed with the CFI, but added that it may be more difficult for the average consumer to assess three-dimensional marks.

In those circumstances, the more closely the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater the likelihood of the shape being devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation 40/94. Only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin, is not devoid of any distinctive character for the purposes of that provision.<sup>56</sup>

A mere variant of a common shape is not sufficient to establish distinctiveness. The procedure established that in spite of certain aesthetic features claimed by Mag, the Mini-Maglite did not possess an “inherently” distinctive character. This did not prevent Mag from demonstrating that the *use* made of the aesthetic, non-

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<sup>51</sup> Second Board of Appeal of the OHIM, Cases R-237/1999-2 to R-241/1999-2 of 14 February 2000, [http://oami.europa.eu/legaldocs/boa/1999/EN/R0237\\_1999-2.pdf](http://oami.europa.eu/legaldocs/boa/1999/EN/R0237_1999-2.pdf).

<sup>52</sup> CFI, Case T-88/00, *Mag Instruments Inc., v Office for Harmonization in the Internal Market* (“OHIM”), 7 February 2002, [2002] ECR II-467.

<sup>53</sup> *Id.*, para. 16-23.

<sup>54</sup> *Id.*, para. 35-40.

<sup>55</sup> ECJ, Case C-136/02 P, *Mag Instruments Inc., v OHIM*, 7 October 2004, [2004] ECR I-9165.

<sup>56</sup> *Id.*, at para. 31 citing ECJ, Joined Cases C-456/01P and C-457/01P), *Henkel KgaA v. OHIM*, [2004] ECR I-5089, para. 39.

functional features could lead to an “acquired” distinctiveness. This was, however, not Mag’s intention in the case. Mag wanted to show that the excellence of the design of the torches and their aesthetic and functional qualities were sufficient to create a distinctive trademark. Mag has subsequently obtained trademark protection for the configurations based on the use made of them.<sup>57</sup>



### Unfair commercial methods

Mag also alleged before the ITC that importation and sales of foreign products constituted unfair acts and unfair methods of competition in violation of Section 337 of the 1930 Tariffs Act. Such activities may not seek to destroy or substantially injure an industry, that is efficiently and economically operated in the United States. On this basis, could Mag prevent competitors from directly copying the Mini-Maglite?

The ITC did not accept the allegation. It emphasised the basic rule that “It must not be forgotten that there is absolutely nothing legally or morally reprehensible about exact copying of things in the public domain.”<sup>58</sup> It is only when the copier is trying to deceive the public by inferring that the product comes from another manufacturer that rules on unlawful “passing off” may be invoked.

Mag introduced the Mini-Maglite in Sweden in 1984 and more-or-less identical imitations were introduced on the Swedish market during the 1990s. In 1999 Mag instigated proceedings under the Swedish Marketing Act against Libro – a Swedish marketing company selling an unmarked mini torch produced in Taiwan.<sup>59</sup> Mag relied on Section 8 of the Marketing Act, which prohibits deceptive and misleading marketing.<sup>60</sup>

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<sup>57</sup> Trademark number CTM 002351831, [http://oami.europa.eu/CTMOnline/RequestManager/en\\_DetailCTM\\_NoReg](http://oami.europa.eu/CTMOnline/RequestManager/en_DetailCTM_NoReg). The Mini-Maglite was also the first 3D mark to be protected in Japan in spite of considerable resistance. See, [http://www.jonesday.com/pubs/pubs\\_detail.aspx?pubID=S4538](http://www.jonesday.com/pubs/pubs_detail.aspx?pubID=S4538).

<sup>58</sup> ITC Decision, fn 37, page 191.

<sup>59</sup> Stockholms Tingsrätt (Stockholm District Court), Case T 17705-99, *Mag Instrument, Inc. v. Libro Invest Aktiebolag*, 29 October 2003.

<sup>60</sup> Section 8 of the Swedish Marketing Act, (SFS 1995:450), regarding misleading imitations, provides: “When marketing a businessman may not use imitations which are misleading as they can easily be confused for another businessman’s known and characteristic products. However,

Mag claimed that each of its torches has an individual character, while still fitting into the Maglite family. They are produced to meet professional requirements and have been used in spaceships and the Iraq war. Mini-Maglite's design was not just a reduction in size, but characterised by elegance and the lack of any interruption in its external configuration. The aesthetic features had no equivalents. Mini-Maglite together with the Volkswagen Beetle and Levi's 501-jeans were the most sold consumables. The torch is easily recognized due to its inherent distinctiveness and considerable worldwide marketing efforts. The design reflects the designer, Mr. Maglica's personality. It has been designed from the outside towards the inside. It is not the result of functional requirements, but rather of aesthetic and artistic considerations, which had been endorsed by Föreningen Svensk Forms Opinionsnämnd – a private institution, which provides advice on design. In 1996 it was one of the most copied consumables and copies did not have to use the word or the mark Mini-Maglite<sup>®</sup>. The form was enough to mislead consumers.

The district court found that Mini-Maglite was known to Swedish consumers. It determined that the product was characteristic in a non-functional way as suggested by Svensk Forms Opinionsnämnd and that there were infinite ways of designing mini torches. The Libro torch demonstrated substantial resemblance to the Mini-Maglite (even if there were differences) and it was incumbent on Libro to prove that it was not an imitation. As to the likelihood of confusion, the court underlined that the test was a “quick-look” one. If the quick-look provides the same impression to the consumer when he sees the original and the copy there is a likelihood of confusion. Minor deviations did not prevent the risk of confusion. Accordingly, the court established there was infringement. On appeal the Swedish Market Court<sup>61</sup> only increased the damages payable by Libro.

The outcome, however, in earlier German procedures was quite different. Mag brought proceedings against the importation of mini flashlights under the trademark TopShop<sup>62</sup> alleging that the Mini-Maglite's design was characteristic (“eigentümlich”) and different. The design was elegant and light, emphasising the slim barrel, which opens out at the end in a tulip-shaped head and which is underlined by the selection of production material. Mini-Maglite had become a status symbol and the TopShop product was, in conflict with the German Unfair Competition Law,<sup>63</sup> and, Mag alleged, an out-and-out copy.<sup>64</sup>

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this does not apply to imitations of the design which primarily serve to make the product functional.“ In the alternative reference was made to the general stipulation in section 4 of the Act, which provides that “Marketing must be compatible with good marketing practice and also in other respects be fair towards consumers and businessmen. When marketing businessmen must provide such information as is of particular importance from the consumer perspective.”

<sup>61</sup> The Swedish Market Court, Case 2005:6 Dnr C 29/03, *Mag Instrument, Inc., v. Libro Invest Aktiebolag*, 2 October 2005.

<sup>62</sup> Judgement of Landgerichts München, in *Mag Instrument Inc., v. Eduscho GmbH & Co. KG*, 24 July 1996. Mag appears to have been involved in several disputes in Germany with different outcomes regarding its Mini-Maglite. See e.g. Landgericht Köln, case 81 O 117/99 *Firma Mag Instrument Inc., v. Firma Ampercell Vertriebsgesellschaft für elektronische Erzeugnisse mbh*, 29 September 2000.

<sup>63</sup> The German Unfair Competition Law (Gesetz gegen den unlauteren Wettbewerb), 7 June 1909 as last amended by the Law of June 22, 1998. Consolidated text by WIPO at [http://www.wipo.int/clea/en/text\\_html.jsp?lang=EN&id=1034](http://www.wipo.int/clea/en/text_html.jsp?lang=EN&id=1034).

Both the Landesgerichts München and the Oberlandsgericht München<sup>65</sup> disagreed with Mag and only required that the TopShop torch be marked to avoid consumer confusion. The matter was unsuccessfully appealed to the German Bundesgerichtshof,<sup>66</sup> which carefully considered all the elements of the torches from both an unfair trade and a copyright perspective. In order to be protected by the rules on unfair competition the lamp had to have characteristics, which consumers identify as indications of origin.<sup>67</sup> The Court found that all the elements of the Mini-Maglite were functional in a way that could not be monopolised and that the TopShop lamp, in any event, differed sufficiently from the Mini-Maglite on points where such a distinction could be made. Accordingly, the law on unfair competition could not be invoked against the sale of the competing product.

The Bundesgerichtshof determined that the German Marketing Law<sup>68</sup> was inapplicable as there was no customer confusion and that Mag could not invoke the German three-dimensional trademark protection it had received for the torch configuration. The functional elements prevented legal protection applying, but other elements could still indicate origin as they had been made known through consistent marketing efforts. However, several other similar products had also been brought to the market and the configuration of the mini torch was no longer unique to Mag.

### **Copyright protection denied in Germany**

In the TopShop case<sup>69</sup> Mag also invoked the German copyright legislation.<sup>70</sup> According to the Bundesgerichtshof the Mini-Maglite could not be protected as a

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§ 1 UWG states: “Any person who, in the course of trade and for the purposes of competition, commits acts contrary to honest practice may be enjoined from such acts and held liable for damages.”

<sup>64</sup> Id., § 3: Any person who, in the course of trade and for the purposes of competition, makes misleading statements concerning business circumstances, in particular the nature, the origin, the manner of manufacture or the pricing of individual goods or commercial services or of the offer as a whole, price lists, the manner or the source of acquisition of goods, the possession of awards, the occasion or purpose of the sale or the size of the available stock, may be enjoined from making such statements.

<sup>65</sup> 29 Zivilsenats des Oberlandesgerichts München, Case 29 U 4906/96, *Mag Instrument Inc., v. Eduscho GmbH & Co. KG*, 17 April 1997, an appeal from a judgment by the Landesgerichts München, 24 July 1996.

<sup>66</sup> Bundesgerichtshof, Case I ZR 142/97, *Mag Instrument Inc., v. Eduscho GmbH & Co. KG*, 7 May 1998.

<sup>67</sup> *Id.*, Entscheidungsgründe 1.1: Eine danach erforderliche wettbewerbliche Eigenart kommt den Erzeugnissen der Klägerin nur dann zu, wenn deren konkrete Ausgestaltung geeignet ist, für die interessierten Verkehrskreise auf die betriebliche Herkunft oder auf Besonderheiten des Erzeugnisses hinzuweisen. ... Eine solche Eignung kann allgemein üblichen Gestaltungen die sich am bekannten und zugänglichen Formenschatz anlehnen, nicht zukommen.”

<sup>68</sup> Act Against Unfair Competition of June 7, 1909 amended on June 22, 1998. (Gesetz gegen den unlauteren Wettbewerb), <http://www.wipo.int/clea/en/details.jsp?id=1013>.

<sup>69</sup> Bundesgerichtshof, Case I ZR 142/97, fn. 66.

<sup>70</sup> Law on Copyright and Neighboring Rights (Copyright Law) of September 9, 1965. (Gesetz über Urheberrecht und verwandte Schutzrechte –Urheberrechtsgesetzes). Consolidated text by WIPO at [http://www.wipo.int/clea/en/text\\_html.jsp?lang=EN&id=1034](http://www.wipo.int/clea/en/text_html.jsp?lang=EN&id=1034).

copyrightable “work” under the law.<sup>71</sup> The lamp is “artware” and copyright protection will be awarded only if the result is a personal design expression, which reaches a level of art according to the opinion of experts. The court expressly emphasized that these aesthetic requirements are clearly higher than for items protected by design legislation.<sup>72</sup> The court, noting the smooth tapering of the head from the lens to the barrel, agreed that the Mini-Maglite expressed a compact and elegant design. This did, however, not satisfy copyright protection requirements.<sup>73</sup>

### ***Mini-Maglite in Swedish copyright trial***

While proceedings were still pending in the Swedish Market Court<sup>74</sup> under the Marketing Act,<sup>75</sup> Mag initiated proceedings against IKEA in the Stockholm District Court<sup>76</sup> in 2004 under Swedish copyright legislation.<sup>77</sup> Here, Mag alleged that it had, in accordance with section 1 paragraph 1 of the law, created a work of architecture or applied art. Under section 2 (1), it had the exclusive right to control the Mini-Maglite torch by reproducing it and by making it available to the

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<sup>71</sup> *Id.*, §2 Abs. 2: “Protected literary, scientific and artistic works shall include, in particular,  
1. works of language, such as writings, speeches and computer programs;  
2. musical works;  
3. works of pantomime, including choreographic works;  
4. works of fine art, including works of architecture and of applied art and plans for such works;  
5. photographic works, including works produced by processes similar to photography;  
6. cinematographic works, including works produced by processes similar to cinematography;  
7. illustrations of a scientific or technical nature, such as drawings, plans, maps, sketches, tables and three-dimensional representations.

(2) Personal intellectual creations alone shall constitute works within the meaning of this Law.

<sup>72</sup> Bundesgerichtshof, Case I ZR 142/97, fn. 66, Entscheidungsgründe 3: Die Taschenlampen der Klägerin (Mini-Maglite) sind Gebrauchsgegenstände. Als solche können sie im Werk der angewandten Kunst darstellen, bei dem andere Maßstäbe als bei einem Werk der Zweckfreien Kunst bei Prüfung der Werksqualität nach §2 Abs. 2 UrhG anzuwenden sind. ... Von einem Werk der angewandten Kunst kann danach nur ausgegangen werden, wenn es eine eigenpersönliche Schöpfung darstellt, die mit den Darstellungsmitteln der Kunst durch formgebende Tätigkeit hervorgebracht ist. Dabei muss der ästhetische Gehalt des Werkes einen solchen Grad erreichen, dass nach Auffassung der für Kunst empfänglichen und mit Kunstanschauungen einigermaßen vertrauten Kreise von einer kunstlicheren Leistung gesprochen werden kann. Der erforderliche Grad ästhetischen Gehalts ist ein höherer, als er bei nur geschmacksmusterfähigen Gegenständen verlangt wird, da sich bereits die geschmacksmusterschutzfähige Gestaltung von der nicht geschützten Durchschnittsgestaltung, dem rein Handwerksmäßigen und Alltäglichen abheben muss. Die zwischen urheberrechtlichem Schutz und Geschmacksmusterschutz bestehende Grenze darf nicht zu niedrig abgesteckt werden.“

<sup>73</sup> Similarly, Landgericht Köln, fn. 62, denied Mini-Maglite copyright protection as the torch was regarded as a everyday use object, which could only be copyright protected if the presentation substantially exceeded the average, which was not the case. The court emphasized that the competing torch differed in essential non-functional elements.

<sup>74</sup> See Swedish Market Court, Case 2005:6, fn. 61.

<sup>75</sup> The Swedish Marketing Act, (SFS 1995:450).

<sup>76</sup> Helsingborgs Tingsrätt (District Court), Case T 1696-99, *Mag Instrument, Inc. v. IKEA Svenska Försäljnings Aktiebolag*, judgment 11 March 2005.

<sup>77</sup> Swedish Copyright, Act, 30/12/1960, SFS 1960:729.

public, be it in the original or an altered form, in translation or adaptation, in another literary or artistic form, or by other technical means. IKEA had infringed Mag's exclusive rights by introducing an almost identical torch – even if marked “Design and Quality IKEA of Sweden, Made in Taiwan” . The matter was tried in the district court, appealed to Hovrätten<sup>78</sup> and subsequently to the Swedish Supreme Court<sup>79</sup>.

Mag in all three instances argued that the torch was copyright protectable by referring to the artistic efforts of Mr. Maglica who was called as a witness in the proceedings.. He testified that the design development had lasted for several years. The torch had been created from “outside and in” – i.e. the form was not dictated by functional or ergonomic requirements but out of artistic and aesthetic considerations. Mr. Maglica had aimed at a configuration, which was visually unique, reflecting his own personality – “A Work of Art that Works”. The result was an unmatched elegant form, perfectly balanced, soft fleeting unbroken contours between the barrel and head undisturbed by exterior switches. Nothing in the configuration was self-evident or functionally mandated. It had changed the torch industry, had obtained design rewards, and been displayed in design publications and museums. Svensk Forms Opinionsnämnd had on two occasions also determined that the Mini-Maglite was copyrightable.<sup>80</sup>

IKEA, on the other hand, argued that the Mini-Maglite configuration was too trivial to meet the requirements of originality and independence required for copyright protection. The Mini-Maglite lacked the required expression level in comparison with earlier torches and the risk of independent double creation was due to the functionality of the torch. All essential elements of the torch were functional. If functionality could be copyright protected then competition requirements could be disregarded.

Both parties referred to expert opinions from a divided Swedish academic copyright elite as to whether “a certain level of independence and originality”<sup>81</sup> was required and how high this level had to be. The three judgments are also related to this notion:

**Helsingborgs Tingsrätt**<sup>82</sup> (the district court) held that the configuration of the Mini-Maglite, disregarding its functional elements, had reached the required level for copyright protection. It was unlikely that another designer would

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<sup>78</sup> Hovrätten över Skåne och Blekinge (Appellate Court), Case T 916-05, 16 February 2007.

<sup>79</sup> Högsta domstolen, Case T 1421-07, fn. 2.

<sup>80</sup> Svensk Forms Opinionsnämnd is a private (impartial) institution organized by the Swedish Society of Crafts and Design, which provides design opinions on request. The opinions are non-binding, but often carry a persuasive effect in Swedish courts. Opinion 166 in case 11/1993 established that the torch was copyrightable. In the second opinion, requested by Helsingborgs Tingsrätt, the prior decision was confirmed. Mini-Maglite had an artistic independent and original configuration. The institute underlined that functional considerations did not prevent copyright. With respect to a torch the possible forms are infinite.

<sup>81</sup> The law only refers to words like “create” and “works”. The preparatory works (SOU 1956:25 page 66) adds as a fundamental criteria “a certain level of independence and originality”. As a rule of thumb it should be considered whether it was conceivable that the same work would be produced by two persons independently – “a double-creation-test”.

<sup>82</sup> Helsingborgs Tingsrätt (District Court), Case T 1696-99, fn. 76.

independently arrive at the same “tulip-like” form. The scope of the protection, however, was narrow.

**Hovrätten**<sup>83</sup> (the appellate court) came to the opposite conclusion. Based on the preparatory discussions related to the introduction of the 1970 Design Law and a reading of the expert opinions, the court reached the conclusion that the evaluation of the artistic efforts should be rather stringent in order to confer copyright protection. Prior art indicates the existence of torches with a similar configuration to the Mini-Maglite. Even if Mini-Maglite conferred a pleasant total impression, this was not enough to satisfy the rather stringent requirements necessary to protect a work of artware.

**Högsta domstolen**<sup>84</sup> (the Swedish Supreme Court) reversed Hovrätten. It held that before 1970 the required expression level for copyright protection was low. With the introduction of the design legislation and the elimination of the specific 10 year protection for artware under the Copyright Act, artistic requirements had increased. The same requirements should apply as they did to other artistic works. The copyright protectable work had to be personal and involve an artistic presentation and the risk for independent double-creation must be limited. The court underlined the need for “generosity” for artware since configuration alternatives were often limited<sup>85</sup> and balanced increased protection against a limited scope.<sup>86</sup>

According to the Court, past case law had allowed copyright for designs since design protection has not been sufficient to protect certain works. Copyright should give incentives to competent and serious designers and at the same time create an obstacle to far-reaching passing off and copying. The protection did not just cover outright imitations but also other configurations which were strikingly similar.

The Court agreed that liberal application of copyright protection might affect the competitive climate. This was, however, the aim and anticipated result of the exclusivity copyright. Protection should cover the right to produce copies and make available to the general public the protected work in its original, or an altered form. A work should be worthy of protection, based on its originality, independence and uniqueness. The Court concluded that the required expression level had been lowered over time. When a product satisfies these requirements without expressing any higher level of originality the scope of protection is limited to pure copy protection.

The Mini-Maglite design was held by the Court to be new, but a new barrel-shaped lamp could not be protected as such. None of the elements could independently be regarded as new or original. It resembled earlier bigger torches. In spite of this, the Mini-Maglite gave a different over all impression, which was a sufficient expression of independence in relation to its prior art. The configuration was more than trivial and not the result of routine efforts. It was more than a

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<sup>83</sup> Hovrätten över Skåne och Blekinge (Appellate Court), Case T 916-05, fn. 78.

<sup>84</sup> Högsta domstolen, Case T 1421-07, fn. 2.

<sup>85</sup> Ref. to preparatory works: Prop 1969:168 page 134 ff. and SOU 1965:61 page 210 f.

<sup>86</sup> The Supreme Court also referred to the fact that computer programs, photographs and databases were covered by copyright if the result was original and a personal creation.

functional object and had acquired its own identity with a consistent and balanced design. The Mini-Maglite deserved copyright protection – even if it was a borderline case.

## ***Discussion***

Intellectual and industrial property rights are exceptions to the fundamental freedom to trade in an unrestricted and competitive market. Like all exceptions they should be narrowly interpreted.

No one denies that Mr. Maglica, with his Mini-Maglite, has created a uniquely elegant and highly functional mini torch. This torch has unquestionably won consumer acceptance and become a worldwide market success sold in the millions. Mr. Maglica's design development is, as the Swedish Supreme Court puts it, worthy of protection.

The question is, however, what type of protection? Is it an invention that should be the subject of the 20 year patent protection; is it rather, a shape that should be design protected for some 20 to 25 years; or is the shape a sign, which identifies the origin of the product and should thus be trademark protected for renewable periods of 10 years at a time. Yet again, is it an expression of a personal idea subject to copyright protection during Mr. Maglica's lifetime plus another 70 years? Can Mini-Maglite benefit from unfair competition laws, including marketing laws or common law rules on passing off, to prevent imitations? Or is it, as Mag seems to infer, possible to use all of these rules to make the protection evergreen and fend off competition for a basically unlimited period?

Mag Instrument has been active in different fora and invoked one or the other sets of legislation based on the specific situation and the circumstances of the case. The overall impression is that much effort has been put into creating an evergreening strategy and it is noteworthy that Mr. Maglica himself spends considerable time in courts as a witness testifying to the personal artistic efforts that he has put into the design of his mini torch.

From a legal perspective it seems clear that some of the Mini-Maglite functional elements satisfied patent requirements and such protection has been available and granted in the USA.<sup>87</sup> In addition, there is little doubt that the shape of the torch is such that it could have been protected by design legislation if that option were to have been chosen. The combination of these two sets of protections would have granted Mini-Maglite strong protection, (also covering equivalent or similar products), during a 20-25 year period and allowed Mag to capitalize from its original and creative work. Thereafter both the creative invention and the original shape would have been open to future competitors. That is the trade off created by industrial property rights.

In addition, the Mini-Maglite today also most likely benefits from acquired trademark protection for its overall appearance. Functional features are not

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<sup>87</sup> As stated above, the ITC Decision originally invalidated the patent, but the decision was reversed. Rumour has it, that there were a number of other problems involved with the patent, but they have not been verified.

included and considering the design alternatives for a barrel-shaped mini torch, not too much should be required to come outside the trademark protected area. It is not the product, a small torch that is protected, but the specific form – perhaps the tulip-shaped head - which should be subject to protection. The protection should, in theory, be very restricted, only covering direct copying of the non-functional form elements.

Can an idea or a form, which has been protected by patents or designs, also invoke unfair trade rules after the expiration of this protection? The argument could at least be made that he/she should be entitled to benefit from form protection under other laws only if the creator has forgone patent and design protection. Conceptually, the matter that was protected by IPR during a defined period of time should thereafter be free and open to everyone – even for exact copies. Like trademark protection, the potential protection granted by unfair trade laws must also be very narrow, only covering intentional direct copying of all the formal elements with the intention of deceiving customers. The general test, that it is the informed customer's quick look that determines if the customer has been misled, appears to be much too general to be workable. It is only the precise, slavish imitation of the product that should be subject to protection – if anything is - once patents or design protections have expired otherwise the scope of the protection would be too far-reaching. Thus customer protection may sometimes have to yield to the fundamental interest of unfettered competition and free access.

Mag never applied for patent or design protection in Sweden. The Swedish Supreme Court, however, provided Mag with far-reaching protection for the overall configuration based on Swedish copyright legislation. According to the Court, serious designers are entitled to protection not always granted by design legislation. The Supreme Court emphasised that it was a borderline case and that none of the individual elements were protectable. It, however, emphasized that the overall impression created by the torch merited protection. The wisdom of this approach can be questioned. Of course, serious designers are entitled to the protection provided by the design legislation. If the effort is not serious it is probably not protectable. The design legislation has struck a reasonable balance and providing additional protection by reference to copyright seems misplaced. Furthermore, the overall impression of Mini-Maglite is that of a small torch and chances are that other mini-torches will, at a glance, give the same overall impression in spite of the fact that there are differences in the detail. Indeed the Bundesgerichtshof did not accept this view and the detailed differences were what prevented copyright protection in Germany.

There is much to be said in favour of the German approach. It is odd to protect a functional torch as an artistic item. It is an industrially mass-produced item and should be protected as such for a reasonable period of time. It is more natural to reserve copyright protection for artistic efforts of an individualized character and not subject to mass production. The artistic expression requirements should be substantially higher than for design protection. Can a functional mini torch, however elegantly designed, pass such a test?

It is interesting to note that a number of Swedish academics have provided conflicting views on how high the expression requirements for independence, originality and creativity should be set. Swedish case law during the last century also leads to diverging results. Uncertainties create obstacles for further

development and also to the trade in products. It is the long term potentials for copyright protection that cause problems.<sup>88</sup> On this view, unregistered copyright protection should only apply in restrictive circumstances for individualised products, which have not been subject of mass production and where there is little doubt that both subjective and objective elements confirm an artistic expression. Mass production could even be fixed numerically.<sup>89</sup>

Mini-Maglite has been mass-produced. A product like the Mini-Maglite should be entitled to the exclusivity provided by industrial property rights for a period of 20-25 years, but this ought to disqualify it from copyright protection. It also appears reasonable to protect the Mini-Maglite from slavish imitation where competitors' use of the precise form and other marketing activities would mislead the public. Trademark protection in combination with unfair trade laws provides this protection, but it is important that the focus then be on whether the circumspsect customer is misled, rather than on protecting an intellectual or artistic effort. Usually some clear marking of the product, like "Design and Quality IKEA of Sweden, Made in Taiwan", should be sufficient to avoid consumer confusion.

### **A proposal**

Uncertainties and conflicting European judgments are of major concern and create obstacles for trade in a single European market. Maglite amply demonstrates the problem. In Sweden Maglite benefits from what may appear as an evergreen protection against copying where the copy would present the same overall impression. In other countries the protection may be non-existent or very narrow. If a near copy of the well-known U.S. mini-torch is advertised over the internet for sale in the Community and the case brought in Sweden, should the Swedish Court apply 27 sets of copyright legislation to determine the lawfulness of the sale?<sup>90</sup> The task is overwhelming. As we have seen, the problems arising from applying the different relevant laws in one Member State are already challenging enough.<sup>91</sup> The litigation tangle becomes exorbitant if copyright claims

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<sup>88</sup> These uncertainties also pose problems for music, information technology, telecommunications and biotechnology.

<sup>89</sup> This solution was considered in Sweden but refused in the end as the 50 piece figure chosen was arbitrary; the solution did not fit Swedish tradition; and would deny copyright protection in certain clearly protectable situations. *See* SOU 1965:61 at page 204.

<sup>90</sup> Council regulation 44/2001/EC of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, OJ 2001 L 12/1, Art. 2(1) (Persons domiciled in a Member State shall be sued in the courts of that Member State.) *Cf.* Regulation 864/2007 of the European Parliament and the Council of 11 July 2007 on the law applicable to non-contractual obligations, OJ 2007 L 199/40 ("Rome II"). Art. 8 (2) states that: "In the case of a non-contractual obligation arising from an infringement of a unitary Community intellectual property right, the law applicable shall, for any question that is not governed by the relevant Community instrument, be the law of the country in which the act of infringement was committed."

<sup>91</sup> As indicated earlier, different courts in Sweden handle IPR infringements and unfair trade rules and may very well end up with conflicting outcomes. Patent cases regarding infringement and patent cases regarding invalidity are also initiated and tried in separate courts in many countries.

must also be litigated along with patent, design and trademark infringement claims.<sup>92</sup>

It is therefore natural as one piece of the puzzle to propose that the core of copyright law must be harmonized on a European level. It is likely that more countries than Sweden have had an eye on the Berne Convention and the fact that copyright protection in one country will not be extended to another if the originating country does not grant the same protection for artware. It is only through a coordinated joint effort that a reasonable result can be achieved.

Fundamental rules on competition and free movement of goods require that the same protection be available in different countries. It should not be possible to utilise inequalities in national intellectual property legislation to upset competition rules or to prevent the free circulation of products in the European market.

It may be possible to achieve a coordinated result where outstanding artware and design would receive protection against copying similar to that granted for other creative intellectual efforts. The lifetime plus seventy year rule should – if at all applicable – be reserved for cultural features with limited commercial impact.

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<sup>92</sup> European harmonization efforts as found in Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights, OJ 2004 L 157/45 are not sufficient to address the problems. The directive basically satisfies TRIPS enforcement requirements, but offers little assistance where the substantive laws of the Member States differ.