

# International **Comparative** Legal Guides



## Copyright **2021**

A practical cross-border insight into copyright law

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# Expanding the Boundaries of Copyright Law

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## Introduction

The DSM Directive,<sup>1</sup> about which we have written in previous editions of this guide, came into force in June 2019 and is now in the process of implementation by Member States. The next EU reform to touch on the application of copyright to digital content (the proposed Digital Services Act, which is slated to include safe harbour reforms) will now take its turn on centre stage in Brussels, but in the meantime the CJEU continues, more quietly, to develop a number of fundamental aspects of copyright law as provided for in the InfoSoc Directive,<sup>2</sup> almost two decades earlier.

Of those developments, this chapter will focus on the recent decisions of the CJEU in *Cofemel*<sup>3</sup> and *Brompton*<sup>4</sup> and analyse the new (liberal) guidance which they offer as to the criteria for copyright protection to arise and in particular what amounts to a “work”. For the UK and EU Member States which have a closed list system of copyright protection (i.e. a system in which the categories of works are set out in an exhaustive list), the decision in *Cofemel* suggests that such systems are fundamentally incompatible with EU copyright law. The policy considerations behind both the *Cofemel* and *Brompton* decisions are also indicative of an increased flexibility as to the application of copyright law, which is set to offer opportunities for protection to be claimed in respect of subject matter where it was previously unavailable. Although this chapter will focus on works of artistic craftsmanship, which from an English law perspective is the type of copyright work most directly affected by the decisions in *Cofemel* and *Brompton*, the implications of the decisions are much broader, with the potential to impact all types of copyright work.

## Background

In order to understand the potential significance of the decision in *Cofemel* to English law, it is first necessary to recap some principles of English copyright law and where it differs from EU copyright law.

### What can be a work?

English copyright law is largely found in the Copyright, Designs and Patents Act 1988 (“CDPA”). The very first line of this Act states “Copyright is a property right which subsists ... in the following descriptions of work”.<sup>5</sup> There follows an exhaustive list of categories of copyright work which are afforded protection under English law. This includes original literary, dramatic, musical or artistic works (so called “LDMA” or “authorial” works), each of which are further defined. The CDPA defines artistic works as:

*“a graphic work, photograph, sculpture or collage, irrespective of artistic quality;*

- (a) a work of architecture being a building or a model for a building; or
- (b) a work of artistic craftsmanship.”<sup>6</sup>

If the work in question does not fall within the specified categories, copyright will not subsist.

The same is not necessarily true of other European countries. For example, in France, Germany and Italy (amongst others) there is no exhaustive list of categories of works. Generally, any creation with sufficient originality is capable of being a work and therefore eligible for protection. The result is that protection is afforded to a broader class of creative works, including, for example, the protection of the economic interests of the organisers of sports events and performances by way of a neighbouring right.

Legislative attempts to harmonise copyright in the EU have not tried to grapple with this divergence. Whilst the InfoSoc Directive refers to works, it makes no attempt to define what is (or is not) capable of being a work.

### Works of artistic craftsmanship

As might be expected, the UK’s closed category approach led to litigation regarding the outer limits of these categories and, in particular, the scope of a “work of artistic craftsmanship”.

The leading authority on this issue is the decision of the House of Lords in the 1970s in *Hensher* which concerned a suite of furniture.<sup>7</sup> Unfortunately, the principles flowing from this decision have proved difficult to follow because the defendant made a concession regarding the meaning of “craftsmanship” and because there was no consensus amongst the House of Lords as to the meaning of “artistic”.<sup>8</sup>

In the 1990s, the decision in *Hensher* was considered in a case before the New Zealand High Court called *Bonx Group*.<sup>9</sup> In that case the judge concluded that:

*“... [F]or a work to be regarded as one of artistic craftsmanship it must be possible fairly to say that the author was both a craftsman and an artist. A craftsman is a person who makes something in a skilful way and takes justified pride in their workmanship. An artist is a person with creative ability who produces something which has aesthetic appeal.”*

This interpretation has been considered favourably in subsequent decisions of the English Court. However, the requirement for “aesthetic appeal” is generally understood to set a fairly high threshold for qualification for copyright protection as a work of artistic craftsmanship.

For example, in the case of *Lucasfilm vs Ainsworth*, which concerned copyright claimed in Stormtrooper helmets from the Star Wars films, the High Court held that whilst Stormtrooper helmets were works of craftsmanship, they were not artistic because it was not part of their purpose to appeal as a piece of art, rather it was to give the correct impression of the character inside.<sup>10</sup>

### Originality

In addition to the requirement for there to be a work *per se*, for copyright to subsist in an authorial work (as opposed to a neighbouring rights works such as sound recordings or broadcasts), that work must be original.

Again, the InfoSoc Directive does not attempt to define originality. However, this concept is now relatively settled at an EU law level following the decision of the CJEU in *Infopaq* which states:

“... copyright within the meaning of Article 2(a) of [the InfoSoc Directive] is liable to apply only in relation to a subject-matter which is original in the sense that it is its author's own intellectual creation.”<sup>11</sup>

This is a different test from the historical test for originality under English law which required only that the work be the product of the author's skill, labour and judgment.

There remains a debate about whether the intellectual creation threshold is substantively different to the skill, labour and judgment threshold. However, the prevailing view is that, if there is a difference, the bar has been raised, rather than lowered.<sup>12</sup>

### Brexit

Given that this chapter discusses the potential impact of decisions of the CJEU on English law, it would be remiss not to mention Brexit.

The UK formally left the EU on 31 January 2020 and entered into a transition period which, at the time of writing, is due to expire on 31 December 2020. Under the European Union (Withdrawal) Act 2018, any direct EU legislation operative before the end of the transition period, as well as decisions of the CJEU rendered before that time, are deemed to form part of domestic law. This means that, for the time being, decisions of the CJEU are still binding on the UK Courts.

However, in due course the UK Courts will become free to depart from CJEU case law and it remains to be seen what effect this “freedom” might have on UK law. The decision of the UK not to implement the DSM Directive suggests that the policy of the current Government may be to diverge from EU copyright law, at least in some respects, post-Brexit. Much is likely to depend on the ultimate outcome of trade negotiations with the US and the EU, which are likely to impose conflicting and irreconcilable demands as to the UK's future copyright policy.

## A Harmonised Concept of a “Work”?

### Levola Hengelo

The question of what can be regarded as a work was the issue referred to the CJEU in the recent case of *Levola Hengelo*.<sup>13</sup> This case concerned whether the taste of a cheese could be capable of protection by copyright (i.e. could it be a work). The CJEU held that it could not. Some of the reasoning of the CJEU in *Levola Hengelo* is quite circular. The CJEU identifies two cumulative conditions which must be satisfied for subject matter to be classified as a work: first, the subject matter must be original; and secondly only something which is the expression of the author's intellectual creation may be classified as a work. The first requirement appears to introduce a requirement of originality into whether the subject matter was capable of being a work *per se*. The key to the second requirement appears to be in the word “expression” which distinguishes a protectable work from a mere idea. In this regard, the CJEU also states that:

“Accordingly, for there to be a ‘work’ as referred to in [the InfoSoc Directive] the subject matter protected by copyright must be expressed in a manner which makes it identifiable with sufficient precision and objectivity, even though that expression is not necessarily in permanent form.”<sup>14</sup>

It was on this basis that the CJEU held that the taste of a cheese was not capable of being a work.

Whilst the reasoning in *Levola Hengelo* is perhaps not as clear or convincing as it could be, an important principle is clear from the judgment. That is, the concept of a “work” should have a uniform interpretation within the EU:

“The [InfoSoc Directive] makes no express reference to the laws of the Member States for the purpose of determining the meaning and scope of the concept of a ‘work’. Accordingly, in view of the need for a uniform application of EU law and the principle of equality, that concept must normally be given an autonomous and uniform interpretation throughout the European Union.”<sup>15</sup>

This case provides the background for the decision in *Cofemel*.

### Cofemel

Cofemel and G-Star were two companies who designed and produced clothing. G-Star brought proceedings in the Portuguese court against Cofemel alleging that some designs of jeans, sweatshirts and t-shirts produced by Cofemel infringed the copyright in G-Star's own designs. As part of its defence, Cofemel argued that such clothing designs could not be classified as works entitled to protection by copyright.

The case went to the Portuguese Supreme Court which referred the matter to the CJEU. The key question referred was whether the InfoSoc Directive prevents Member States from granting copyright protection to designs subject to requirements other than originality. For example, by requiring a high level of artistic value.

The decision of the CJEU was given in September 2019. The CJEU summarised the earlier decisions, including *Lenova Hengelo* and confirmed that:

“The concept of ‘work’ that is the subject of all those provisions constitutes, as is clear from the Court's settled case-law, an autonomous concept of EU law which must be interpreted and applied uniformly, requiring two cumulative conditions to be satisfied. First, that concept entails that there exist an original subject matter, in the sense of being the author's own intellectual creation. Second, classification as a work is reserved to the elements that are the expression of such creation.”<sup>16</sup>

Regarding the first limb of the test, as discussed above, at an EU level the requirement for originality, and the threshold to be applied in order to determine originality, is relatively settled law.

In relation to the second limb, the CJEU expanded upon the requirement for the work to be expressed in a sufficiently precise and objective manner. First, legal authorities and third parties must be able to identify clearly and precisely the subject matter which is protected. Secondly, there is a need to avoid an element of subjectivity in determining whether any given subject matter is protected. In this regard, the CJEU referred to the decision in *Levola Hengelo* in holding that the required precision and objectivity is not attained where an identification is essentially based on the sensations, which are intrinsically subjective, of an individual who perceives the subject matter at issue.

The CJEU then considered the Charter of Fundamental Rights of the European Union and noted that it is not a requirement that subject matter qualifying for intellectual property protection must all qualify for the same type of protection by virtue of the nature of that subject matter itself. That is to say, the same subject matter may qualify for both copyright and design right protection – the two are not mutually exclusive. The CJEU expressly recognised the principle of “cumulation”



of protection of designs, on the one hand, and copyright protection, on the other (discussed further below).

Finally, the CJEU confirmed that the effect of the InfoSoc Directive was to preclude national legislation which made copyright protection conditional upon a specific aesthetic value. The only requirement is that there is an original work.

### Brompton

The case of *Brompton* concerned whether copyright could subsist in the appearance of Brompton's well-known folding bicycles; i.e. whether Brompton could use copyright in order to prevent the sale of copycats of its iconic folding bicycles. The bicycles had been protected by a patent which had subsequently expired. The defendant argued that the appearance over which protection was claimed was dictated by the bicycle's technical function (namely to enable it to fold into three different positions) and therefore, by analogy with the law of design rights, copyright protection should be excluded. The Belgian court referred the question of whether the InfoSoc Directive should be interpreted as excluding works whose shapes are necessary to achieve a technical result from copyright protection.

In its judgment, delivered in June 2020, the CJEU held that there was no such restriction unless that technical result had prevented the author from expressing his creative choices:

*"...a subject matter satisfying the condition of originality may be eligible for copyright protection, even if its realisation has been dictated by technical considerations, provided that its being so dictated has not prevented the author from reflecting his personality in that subject matter, as an expression of free and creative choices."*<sup>17</sup>

In other words, provided there is still room for intellectual creation on the part of the author, the expression of that intellectual creation will be capable of copyright protection.

However, the CJEU also stated that:

*"Where the shape of the product is solely dictated by its technical function, that product cannot be covered by copyright protection."*<sup>18</sup>

This mirrors the limitation which applies to the protection of Community designs. Art 8(1) Reg 6/2002 (Community Design Regulation) provides that:

*"A Community design shall not subsist in features of appearance of a product which are solely dictated by its technical function."*

In other words, there is a question of fact in such cases as to the extent to which the author was able to express free and creative choices.

The CJEU were also asked by the referring court whether the following factors were relevant in determining whether a shape is necessary to achieve a technical result:

- the existence of other possible shapes able to achieve the same technical result;
- the intention of the alleged infringer to achieve the result;
- the effectiveness of the shape in achieving the result; and
- the existence of an earlier (now expired) patent on the process for achieving the technical result.

Its findings were:

- the existence of other possible shapes may make it possible to establish that there was a possibility of choice but was not decisive in influencing the choice made by the author;
- the intention of the alleged infringer is irrelevant; and
- as to the existence of an earlier patent and the effectiveness of the shape chosen, these factors should be taken into account only in so far as they make it possible to reveal what was taken into consideration in choosing the shape of the product concerned. The court should take into account all relevant aspects of the case when the claimed work was designed, but not factors external and subsequent to the creation of the product.

## National Applications of *Cofemel*

At the time of writing we are not aware of any national court decisions applying the judgment in *Brompton*. However, *Cofemel* has been considered on at least two occasions.

### Response Clothing Limited vs The Edinburgh Woollen Mill<sup>19</sup>

This was the first UK case to consider the implications of *Cofemel*. Following a trial in December 2019, the judgment of the Intellectual Property Enterprise Court was given in January 2020.

The case concerned a fabric pattern used in women's clothing (described as the "Wave Fabric"). Response claimed that the Wave Fabric was protected by copyright. The argument that a fabric could be a graphic work was rejected which led to an extensive discussion by the judge as to whether the fabric could be protected by copyright as a work of artistic craftsmanship.

The judge concluded that because, *inter alia*, the Wave Fabric was intended to be aesthetically pleasing to customers and was, in fact, a commercial success, it would fall within the definition of a work of artistic craftsmanship under *Bonzi Group* (discussed above).

This was clearly contrary to the approach of the House of Lords in *Hensher*, as the judge noted:

*"My impression is that none of their Lordships in Hensher would have concluded that the Wave Fabric is a work of artistic craftsmanship had that been the issue before them."*<sup>20</sup>

Even though in *Hensher* it was conceded that the furniture suite was a work of craftsmanship, some of the judges commented on how the term "craftsmanship" should be understood. The fact that Wave Fabric was not made by hand would have taken it outside the definition of "craftsmanship" (according to at least two of the House of Lords judges), and the judge in *Response Clothing* felt that the Wave Fabric would have failed to meet the requirement for the work to be "artistic" according to at least some of their Lordships.

The judge then considered the cases of *Levola Hengelo* and *Cofemel* and held that the fabric was the expression of the author's free and creative choices and therefore is entitled to copyright protection under the InfoSoc Directive.

This led the judge to consider whether it was possible to interpret the CDPA in conformity with the InfoSoc Directive such that the fabric in question did qualify for copyright protection (i.e. was a work of artistic craftsmanship). The judge held that such an interpretation was possible if the (less stringent) definition in *Bonzi Group* was followed (rather than that in *Hensher*). Following the definition in *Bonzi Group*, the fabric did in fact have aesthetic appeal and therefore satisfied the definition of a work of artistic craftsmanship.

However, the judge also commented that complete conformity of the CDPA with the InfoSoc Directive, as interpreted by *Cofemel*, would exclude any requirement for aesthetic appeal and thus would be inconsistent with that part of the decision in *Bonzi Group*. As this comment was made *obiter* and the judge was able to interpret the CDPA in conformity with the InfoSoc Directive in this instance, the court did not go so far as to state that the CDPA was incompatible with (and therefore a misimplementation of) the InfoSoc Directive.

### Wycon vs Kiko<sup>21</sup>

This was a case before the Italian court relating to whether the layout of Kiko's stores could be protected by copyright as

an architectural plan and, if so, whether that copyright was infringed by the defendant Wycon's stores. Kiko was successful at first instance and on appeal. The case was subsequently referred to the Supreme Court.

Applying the principles set out in *Cofemel*, the Supreme Court upheld the decisions of the lower courts and held that an interior design plan is protectable by copyright as an architectural work if it results from an original combination of elements which is not aimed at solving a technical-functional problem.<sup>22</sup> Any exclusive rights vest in the overall combination of elements (e.g. the colours of the walls, particular lighting effects, repetition of decorative elements, the use of certain materials, the size and the proportions).

This decision therefore seems to accord with the UK court's reading of *Cofemel* in *Response Clothing*.

## Comment

There are a number of interesting issues which arise from the above cases both from a UK and a wider EU perspective.

### Works of artistic craftsmanship

Following the decision in *Response Clothing* it is likely that a lower threshold will apply to the qualification of a work for protection as a work of artistic craftsmanship in the UK. This is likely to see producers of three-dimensional objects which would perhaps not previously be considered to be works of artistic craftsmanship (such as the clothes in issue in *Cofemel* and the furniture in *Hensher*) seeking to rely on copyright protection under this category.

Given the requirement to comply with the InfoSoc Directive (at least for the time being) the Court would seem to have limited scope to row back from the position in *Response Clothing* without risking a declaration of incompatibility with EU law (as to which, see below).

### Other works

Although *Cofemel* applied to a clothing design, the general principle regarding qualification as a copyright work may well have implications for other categories of work.

Provided the requirements for originality and a sufficiently clear expression of the author's intellectual creation are met then copyright protection should be available.

This is likely to lead to an attempt to expand the outer limits of copyright protection in relation to other types of work. For example, rights owners have long sought copyright protection for sports events and television show formats, with limited success to date. In light of *Cofemel*, we would expect to see renewed attempts to obtain protection for these sorts of content (for example as dramatic works), particularly where the elements of the claimed work are clearly and objectively defined.

### Evidence

The potential for the scope of copyright protection to be broadened into previously uncharted territory is also likely to lead to a change in the nature of the evidence that parties claiming copyright might be expected to produce.

In the case of traditional copyright works, such as a painting or a book, there is rarely a dispute regarding originality. However, where copyright begins to tread into mass produced products, such as clothing, it is likely that originality will be

looked at more closely due to prevalence of similar, earlier designs. In *Response Clothing*, the Defendant made enquiries to search out similar fabrics available earlier than the date the Wave Fabric was created. Searching for what might be termed "prior art" is a strategy more familiar to design right or patent cases. Nonetheless, it was considered to be relevant by the Court (although in the end counted against the Defendant because no such fabrics were identified).

Similarly, in *Brompton* the CJEU suggested that while the existence of other possible shapes capable of achieving the same technical result was not decisive, it could be relevant in assessing the choice made by the author.

In *Brompton*, the CJEU also said that the assessment as to whether the bicycle was an original creation (i.e. not solely dictated by technical function) required consideration to be taken of all relevant aspects of the case. Therefore it may be expected that future claimants will seek to submit detailed evidence of fact regarding the design process and choices to establish that a free and creative choice was made.

### Closed Lists

If it was not already the case, it seems fairly clear following *Cofemel* that countries with closed lists of copyright works, such as the UK, are vulnerable to a challenge that the InfoSoc Directive has not been properly implemented.

In the first instance national courts should seek to interpret national law in such a way as to be consistent with EU law (as was the case in *Response Clothing*). However, there is a limit to the extent to which this may be possible and there may be certain "works" in which copyright is claimed which cannot be interpreted as falling within any of the closed categories.

This could ultimately lead to claims against Member States and/or amendments to national legislation.

## Cumulation of Rights

In addition to the specific issues identified above, a recurring theme in the decisions discussed is the interrelationship between different IP rights. The potential for multiple rights, with different criteria for subsistence/registration, to protect the same underlying product is known as the cumulation of rights.

This issue was considered recently in the context of a trade mark application in the CJEU decision in *Gömböc*.<sup>23</sup> In that case the CJEU held that:

"...the rules of EU law concerning the registration of designs and those applicable to the registration of trade marks are independent, without any hierarchy existing as between those rules."

In *Cofemel*, the CJEU expressly recognised that designs are capable of classification as copyright works (regardless of whether or not they are protected by design right). In the UK this would seem to open up the potential for original designs to be protected by copyright where perhaps they would fall short of UK registered design right protection. To qualify for UK registered design protection, designs must not only be new but also to create a different overall impression on the informed user (i.e. have individual character). This is generally considered to require more than merely the expression of the designer's individual creation.

In *Brompton*, copyright protection was held to be available (in principle) to a product which had previously been protected by a patent (i.e. where a prior IP right had expired).

In 2016, the EUIPO First Board of Appeal upheld the examiner's decision to refuse an application by Kiko to register its store layout (depicted as a graphic image with specified colours) as a trade mark on the grounds that it lacked inherent distinctive

character (and had not acquired such character through use).<sup>24</sup> Nonetheless, in the *Wycan* case discussed above it was held that copyright could still subsist in essentially the same subject matter.

When it comes to the cumulation of rights, copyright could be said to be in a unique position. As the cases above demonstrate, copyright has the potential to overlap with each of designs, trade marks and patents. However, whilst not a monopoly right, copyright has a number of advantages over these other rights. In particular: copyright is unregistered; it has what is generally considered to be a lower threshold for protection; and it offers a longer form of protection than that available for patents or designs.

Furthermore, in light of the cases discussed in this chapter it is clear that the range of “products” (used in the widest possible sense) which could be subject to copyright protection is extremely broad. This means that for many industries copyright could have the potential to “fill the gaps” where effective IP protection was previously lacking.

## Conclusion

The partial and sometimes theoretical nature of CJEU references means that they do not always provide completely clear guidance to national Courts, but the *Cofemel* and *Brompton* cases do not suffer from that defect; as *Response Clothing* shows, the rules have clearly changed. The implications are not, however, entirely satisfactory. It is inevitable that the development in isolation of jurisprudence concerning separate intellectual property rights will, on occasion, lead to some surprising or conflicting outcomes. In the field discussed above, it now appears that, in at least some cases, the bar for obtaining copyright protection is set at a lower level than that for protecting exactly the same work as a registered design. This is illogical, not least as copyright endures for a significantly longer period than registered designs, and provides a broader penumbra of protection. There do not appear, however, to be any significant calls for this to be considered at a legislative level. In the meantime, creators and other rightsholders will be able to explore opportunities to find new ways to protect their investments, something which may be particularly appreciated at a time when many forms of exploitation (and hence revenue generation) are circumscribed.

## Endnotes

1. Directive (EU) 2019/790 on copyright and related rights in the Digital Single Market.
2. 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.
3. C-683-17.
4. C833/18.
5. S1(1) CDPA.
6. S(4)(1) CDPA.
7. *Hensher (George) Ltd v Restawile Upholstery (Lancs) Ltd* [1975] RPC 31.
8. *Ibid.* See Lord Kilbrandon at page 98: “Your Lordships’ House has been offered “definitions” of the word “artistic” framed by each of Graham J., the Court of Appeal, counsel for the appellant, together with two by counsel for the respondent, and has rejected them all. In addition, I rather gather that there is no definition framed by a member of the Appellate Committee which is altogether acceptable to any other member; this means that each of their Lordships has rejected, or at least refrained from adopting, nine solutions of the problem.”
9. *Bonz Group (Pty) Ltd v Cooke* [1994] 3 N.Z.L.R. 216.
10. *Lucasfilm Ltd v Ainsworth* [2008] EWHC 1878 (Ch) at para 134. This finding was not challenged on appeal.
11. C-5/08 at [37].
12. See, for example, *SAS Institute Inc v World Programming Limited* [2013] EWCA Civ 1482 (at paragraph 37).
13. C-310/17.
14. C-310/17 at [40].
15. C-310/17 at [40].
16. C-683/17 at [29].
17. C-833/18 at [26].
18. C-833/18 at [33].
19. [2020] EWHC 148 (IPEC).
20. *Ibid.* at [42].
21. Italian Supreme Court Decision 780/2020, with thanks to Dr Eleonora Rosati for her English summary of the effect of the decision.
22. This decision came before the decision of the CJEU in *Brompton*.
23. C833/18.
24. Case R 1135/2015-1.



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