



# A Refined Approach to Originality in EU Copyright Law in Light of the ECJ's Recent Copyright/Design Cumulation Case Law

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**Abstract** The effect of the *Cofemel* case is to render incompatible with European Union (EU) law any laws of the Member States that impose additional or more onerous criteria in the process of bestowing copyright protection on certain works, namely those of applied art and design. Underlying this ruling is the issue of cumulation of copyright and design rights. In particular, such cumulation may have adverse effects if it is absolute and unrestricted in such a way as to become the norm. Acknowledging this, the Opinion of Advocate General Szpunar suggests a strict application of copyright; however, it is still not clear what such an approach would entail. This article proposes a refined approach to applying the originality condition in EU copyright law which is methodological and true to the underlying justifications and objectives of copyright. As a corollary, notions of design law should be kept distinct from notions of copyright law. In particular, the exclusion from protection of ideas and the exclusion of works dictated by technical considerations should be applied as mere manifestations of the originality condition and not be defined by notions imported from other intellectual property rights. The article further reviews the validity of this proposed approach in light of the imminent developments in EU copyright law that are suggested by the *Brompton Bicycle* case.

**Keywords** Cumulation · Idea/expression dichotomy · Technical exclusion · C-683/17 *Cofemel–Sociedade de Vestuário v. G-Star Raw* · C-833/18 *SI/Brompton Bicycle v. Chedech/Get2Get*

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## 1 Introduction

The preliminary reference in *Cofemel*<sup>1</sup> relates to the standards that works of applied art should satisfy in order to be protected by copyright in view of Directive 2001/29/EC<sup>2</sup> on the harmonisation of copyright (hereinafter “InfoSoc Directive”). Specifically, the preliminary questions focus on the originality standard, that is, whether the Member States may apply different or stricter conditions for certain categories of works, namely works of applied art or industrial designs, than would ordinarily apply to other categories of works.<sup>3</sup> Central to this question is the issue of cumulation of copyright and design rights. In fact, the Opinion of Advocate General Szpunar rightfully observes, by way of introduction, that the *Cofemel* case is particularly concerned with cumulation.<sup>4</sup> The different standards applied by some Member States are often specifically devised to restrict the instances where copyright protection subsists in works of applied art or in designs. In fact, the judgment of the European Court of Justice (ECJ) in *Cofemel* is to the effect that “copyright protection simply arises upon fulfilment of the originality requirement ... this ‘throws out of the window’ those national approaches that have traditionally made copyright protection dependent on an artistic and aesthetic value”.<sup>5</sup> Indeed, the *Cofemel* case renders incompatible with EU law all those legal mechanisms that some Member States have until now employed to rein in cumulation without prohibiting it altogether.

For example, the Portuguese Copyright Code requires works of applied art and industrial designs to constitute artistic creation (“*constituam criação artística*”).<sup>6</sup> Similarly, the Spanish Supreme Court has required an added creativity (“*un plus de creatividad*”),<sup>7</sup> although Spanish copyright law does not

<sup>1</sup> Case C-683/17, *Cofemel–Sociedade de Vestuário v. G-Star Raw*, EU:C:2019:721; for a summary of the facts, see Rendas (2018), p. 440.

<sup>2</sup> Directive 2001/29/EC of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society, [2001] OJ L 167/10.

<sup>3</sup> Case C-683/17, *Cofemel*, para. 25. See also Rosati (2019).

<sup>4</sup> Opinion of AG Szpunar, Case C-683/17, *Cofemel – Sociedade de Vestuário v. G-Star Raw*, EU:C:2019:363, para. 2.

<sup>5</sup> Rosati (2019), p. 932. See also Case C-683/17, *Cofemel*, para. 35.

<sup>6</sup> Art. 1 para. 1 and Art. 2 para. 1(i), *Código do Direito de Autor e dos Direitos Conexos* (Code of Copyright and Related Rights), Decree-Law 63/85, of 14 March (amended by Decree-Law 100/2017, of 23 August). See how this criterion was applied to bathroom taps, judgment of the Court of Appeal (Tribunal da Relação) of Guimarães of 27 February 2012, Proc. 1607/10.3TBRRG.G1, Judge Manso Rainho. Available at: <http://www.dgsi.pt/jtrg.nsf/86c25a698e4e7cb7802579ec004d3832/0274c91f63164ca3802579f2004ea944?OpenDocument&Highlight=0,1607> (last visited 22 July 2020). See also Silva (2013a).

<sup>7</sup> See how this criterion was applied to lamp posts, judgment of the Supreme Court (Tribunal Supremo) 6196/2012 (Civil Hall, 1st Section), of 27 September 2012, ES:TS:2012:6196, paras. 45–46. Available at: <http://www.poderjudicial.es/search/openCDocument/f9caf3b37c843044a9f1f86dce7fdf5b730f13d014f791f5> (last visited 28 Dec. 2019). See also Silva (2013b).

expressly require anything other than originality.<sup>8</sup> Italian law also requires works of industrial design to exhibit in themselves creative character and artistic value (“*presentino di per sé carattere creativo e valore artistico*”).<sup>9</sup> In a similar vein, the Stormtrooper helmet and armour were denied copyright protection by the United Kingdom (UK) High Court since they are neither “works of artistic craftsmanship”,<sup>10</sup> given that their author had not intended them as art pieces but merely as film props,<sup>11</sup> nor “sculptures ... *irrespective of artistic quality*”,<sup>12</sup> given that sculptures must still be intended to be art and not just utilitarian objects.<sup>13</sup>

Such artistic criteria as well as other similar criteria – whether the object is of aesthetic or utilitarian destination; whether the designer of the object intended it to constitute art or not; whether the designer of the object is an artist or a craftsman; and others – may not be entirely missed. The predominant view seems to be that these criteria are “inadequate or unworkable”.<sup>14</sup> This is due to their very subjective nature which is the central justification of the *unité de l’art* doctrine (which argues for allowing total cumulation).<sup>15</sup> In the words of Eugène Pouillet, one of the most influential exponents of this doctrine: “*La loi érigeria-t-elle le juge en professeur d’esthétique, et le chargera-t-elle, comme un autre Paris, de décerner la pomme à la beauté? Mais, d’abord, qu’est-ce que la beauté? Où est-ce que commence le beau? Où est-ce qu’il finit?*” (“Will the law dress the judge as a professor of aesthetics, and will it charge him, like another Paris, to award the apple to beauty? But what is beauty in the first place? Where does beauty commence? Where does it end?”).<sup>16</sup>

The *Cofemel* judgment also dismisses any requirement that only a few copies of a work must be produced. For example, the UK had limited the copyright protection of works of applied art by limiting the term of the copyright to 25 years when more than 50 copies of the work had been made.<sup>17</sup> This had already been discarded by a

<sup>8</sup> See Art. 10(1)(e), Royal Legislative Decree 1/1996, of 12 April, *por el que se aprueba el texto refundido de la Ley de Propiedad Intelectual, regularizando, aclarando y armonizando las disposiciones legales vigentes sobre la materia* (which approves the revised text of the Intellectual Property Law, regularising, clarifying and harmonising the legal provisions in vigour on the subject), No. 97, of 22 April of 1996, BOE-A-1996-8930.

<sup>9</sup> Art. 2(10), Law of 22 April 1941, No. 633 *Protezione del diritto d’autore e di altri diritti connessi al suo esercizio* (Copyright protection and protection by other rights related to its exercise), published in Gazzetta Ufficiale No. 166 of 16 July 1941 (updated with the amendments introduced by the law of 3 May 2019, No. 37).

<sup>10</sup> Copyright, Designs and Patents Act 1988, s. 4(ii).

<sup>11</sup> *Lucasfilm Ltd v. Ainsworth* [2008] EWHC 1878 (Ch), [2009] FSR 2, para. 135.

<sup>12</sup> Copyright, Designs and Patents Act 1988, s. 4(i).

<sup>13</sup> *Lucasfilm Ltd v. Ainsworth* [2008] EWHC 1878 (Ch), [2009] FSR 2, paras. 118–119 and 121–123. Confirmed by the Court of Appeal: *Lucasfilm Ltd v. Ainsworth* [2009] EWCA Civ 1328, [2010] Ch 503, para. 77 *et seq.*; and subsequently by the Supreme Court: *Lucasfilm Ltd v. Ainsworth* [2011] UKSC 39, [2012] 1 AC 208, paras. 43–49.

<sup>14</sup> Derclaye (2018), p. 439 *et seq.*

<sup>15</sup> Finniss (1964), p. 615; and Gasnier (2014), p. 18.

<sup>16</sup> Pouillet (1884), Introduction, p. x.

<sup>17</sup> Copyright, Designs and Patents Act 1988, s. 52 (repealed).

repeal of the relative provision in 2016<sup>18</sup> after the ECJ had made it clear in the *Flos* case that limiting the duration of copyright for certain works is incompatible with the Copyright Term Directive.<sup>19</sup> The *Cofemel* case now clarifies that denying copyright protection altogether on the ground of having produced a large amount of the same work is incompatible with the InfoSoc Directive.

Applying a restriction of copyright protection based on the amount of produced units does away with the *unité de l'art* problem. In fact, it is a very effective, though perhaps arbitrary, way of making the distinction between works that merit copyright protection and those that do not without burdening courts with difficult and often inconsistent criteria.<sup>20</sup> For this reason, attempts to find a balanced model to regulate cumulation seem to favour such a criterion,<sup>21</sup> though there are still some proposals which insist on an aesthetic criterion, albeit proposed in a more systematic framework.<sup>22</sup> Nonetheless, such attempts must be abandoned following the *Cofemel* ruling.

It is noteworthy that, despite discarding the above-mentioned mechanisms to limit cumulation, the *Cofemel* case also “makes it clear that the assessment of originality is to be a thorough one... In this sense, national courts will need to identify what makes a design an original work, also bearing in mind the ECJ’s considerations of technical features”.<sup>23</sup> The Opinion of AG Szpunar in particular acknowledges the adverse effects of cumulation and asserts that “*une application rigoureuse du droit d’auteur ... serait susceptible de remédier dans une large mesure aux inconvénients résultant du cumul*” (“a strict application of copyright would remedy to a large extent the adverse effects of cumulation”).<sup>24</sup> Implicit in its reasoning seems to be the assumption that cumulation should be the exception rather than the rule and this warrants a more restrictive approach to copyright. Certainly, the AG Opinion construes the condition of originality, especially the exclusion from protection of subject-matter dictated by technical considerations (hereinafter the “technical exclusion”), rather strictly.

Therefore, cumulation does indeed bear adverse effects (Sect. 2). This justifies that the condition of originality for copyright protection be applied more strictly, in the sense that it is methodologically and rationally applied rather than in the sense that it should necessarily be a more onerous condition, and just as importantly that originality should be kept distinct from notions that are often imported from design law, especially regarding the so-called technical exclusion (Sect. 3). This article thus proposes a refined approach to originality in EU copyright law along these lines

<sup>18</sup> Enterprise and Regulatory Reform Act 2013, s. 74(2).

<sup>19</sup> Case C-168/09, *Flos v. Semeraro Casa e Famiglia*, EU:C:2011:29, paras. 39–40.

<sup>20</sup> See Derclaye (2018), p. 442, footnote 92.

<sup>21</sup> E.g. Derclaye (2018), pp. 445–451; and Ricketson and Suthersanen (2012), paras. 8.87–8.90. Furthermore, such a criterion would not be a totally foreign notion to EU law, after all the artists’ resale right is conferred with respect to works of art with the caveat that such copies are limited in number; see Art. 2(2), Directive 2001/84/EC of 27 September 2001 on the resale right for the benefit of the author of an original work of art, [2001] OJ L 272/32.

<sup>22</sup> Hua (2017), pp. 681–682.

<sup>23</sup> Rosati (2019), p. 932.

<sup>24</sup> AG Opinion, Case C-683/17, *Cofemel*, para. 54.

and which is true to the underlying justifications and objectives of copyright protection, something that is all too often ignored (Sect. 4). The article also addresses the application of the technical exclusion in copyright law, as a manifestation of the originality condition, in light of the recent *Brompton Bicycle* case which deals with this subject specifically (Sect. 5).<sup>25</sup>

## 2 The Adverse Effects of Cumulation

Arguments against cumulation principally focus on three adverse effects, which are acknowledged in the *Cofemel* AG Opinion: that cumulation lends itself to overprotection;<sup>26</sup> that copyright tends to supplant the *sui generis* designs regime or, put differently, that unrestricted cumulation renders the designs regime useless;<sup>27</sup> and that cumulation belies the underlying justifications and objectives of the copyright and designs regimes.<sup>28</sup> None of these arguments warrant doing away with cumulation altogether. On the contrary, the predominant academic literature would seem to be in favour of the cumulation of copyright and design rights.<sup>29</sup> Nevertheless, it also seems to be aware of the need to restrict cumulation so as to curb overprotection.<sup>30</sup>

### 2.1 That Cumulation Lends Itself to Overprotection

Cumulation raises the issue of overprotection.<sup>31</sup> In particular, there is concern that design rights may be extended unduly by copyright protection, since the duration of the latter is much longer.<sup>32</sup> This is especially true for mass-produced works; the argument goes that works of applied art and designs do not merit the longer copyright protection since their author monetises the work on each sale of each reiteration of the work.<sup>33</sup> Contrarily, purely artistic works merit copyright protection since there is a more limited commercialisation opportunity given that they can only be sold by the author once.<sup>34</sup>

This, however, is countered by the fact that, in most cases, the industry itself renders the need for copyright protection obsolete after a short period of time. That is, it is improbable that an author would seek to enforce his copyright for a design which is more than 25 years old since, at that stage, it would no longer be that

<sup>25</sup> Case C-833/18, *SI/Brompton Bicycle v. Chedech/Get2Get*, EU:C:2020:461.

<sup>26</sup> AG Opinion, Case C-683/17, *Cofemel*, paras. 3 and 52.

<sup>27</sup> *Ibid.*, para. 52.

<sup>28</sup> *Ibid.*, paras. 53–54.

<sup>29</sup> For a list of references in this regard, see Derclaye (2018), p. 435, footnote 60.

<sup>30</sup> For a list of references in this regard, see *ibid.*, pp. 435–436, footnote 61.

<sup>31</sup> For a good summary of the argument against allowing unrestricted copyright protection for designs on the ground of overprotection, see Fabbio (2018), pp. 96–99.

<sup>32</sup> Ghidini (2018), pp. 218–221.

<sup>33</sup> Auteri et al. (2002), p. 272.

<sup>34</sup> *Ibid.*

valuable.<sup>35</sup> This may be due to the fact that there may be little to no market demand for it, or because there is much less willingness to pay. In this regard, one problem might be so-called “vintage” designs, such as classic, antique, and vintage cars.<sup>36</sup> These regain their value after a number of years, as demand and the willingness to pay increase. If a design has become so valuable, the supposition that granting copyright protection would constitute overprotection is, to say the least, questionable.

## 2.2 That Cumulation Renders the Designs Regime Useless

Another argument for restricting cumulation is that if designs are inadvertently copyright-protected, then obtaining design rights becomes rather useless.<sup>37</sup> In truth, design rights will always have some utility. For one thing they are generally more easily enforced. For copyright infringement to subsist it must be proven that the infringing work is a copy of the original work;<sup>38</sup> if the later work arises independently of the first work, there is no infringement even if the two works are identical (although in some jurisdictions mere similarity creates a presumption of infringement and it is then up to the defendant to prove independent creation).<sup>39</sup> Another advantage of design protection is that copyright law admits more exceptions. This, however, may differ among Member States.<sup>40</sup> Lastly, the registration of designs offers more legal certainty in terms of identifying the holder of the right and priority.

Of course, whether these uses of cumulative protection should be allowed may be questioned. In doing so, however, the issue again becomes one of overprotection.

## 2.3 That Cumulation Belies the Underlying Objectives of Copyright and Designs Regimes

The two regimes of copyright and designs have different justifications and underlying objectives. In terms of economic objectives, design rights are predicated on the fact that the shape or appearance of a product adds value to a product in the sense that consumers actively pursue attractive, novel, or distinguishable products. They are thus intended to promote innovation in a product’s “tactile or visual aspects”.<sup>41</sup> In this way, design rights also aim to protect a design’s marketing

<sup>35</sup> Cohen Jehoram (1994), para. 5.

<sup>36</sup> See Court of Bologna (Trib. Bologna), section IV, 20 June 2019, No. 3973/2019. Available at: [https://iusletter.com/wp-content/uploads/Ferrari-250-GTO\\_prima-automobile-nella-Storia-a-vedersi-garantita-la-tutela-autorale\\_Tribunale-di-Bologna-ordinanza-del-20-giugno-2019.pdf](https://iusletter.com/wp-content/uploads/Ferrari-250-GTO_prima-automobile-nella-Storia-a-vedersi-garantita-la-tutela-autorale_Tribunale-di-Bologna-ordinanza-del-20-giugno-2019.pdf) (last visited 22 July 2020).

<sup>37</sup> In respect of unregistered design rights, see Tischner (2018), pp. 312–313. See also Derclaye (2018), p. 446, footnote 107, claiming that the introduction of cumulative protection in the United Kingdom and in the Netherlands resulted in a reduction of design registrations.

<sup>38</sup> Kur (1993), p. 376.

<sup>39</sup> Cohen Jehoram (1994), para. 5.

<sup>40</sup> Art. 5(2), InfoSoc Directive.

<sup>41</sup> Recital 10, Designs Regulation; see also European Commission, “Legal review on industrial design protection in Europe” (MARKT2014/083/D), p. 13 para. 4.

value.<sup>42</sup> On the other hand, the economic rights within the copyright regime are intended to allow the economic exploitation of the product in itself. Without copyright protection, creative products would not be feasibly marketable since their fundamental feature is that they can be copied with ease as soon as they are put on the market.<sup>43</sup> The creation of original works is thus incentivised by the copyright regime. In more practical terms, the difference between the objectives of the two regimes boils down to this: “the design of a coffee machine serves to sell the coffee machine, while a painting certainly is not meant to serve the purpose of selling canvas”.<sup>44</sup> Thus it could be argued that cumulation should be restricted only to those instances where an object conforms to the objectives of both regimes.<sup>45</sup>

Disregarding the different economic objectives of copyright will likely result in conflating the two regimes and rendering cumulation automatic. For example, with respect to French law (the epitome of pro-cumulation legislation) it has been observed that “the criteria of protection for copyright (originality) and that of designs and models law (novelty and individual character since the Ordinance of 2001) have been considered as assimilable, which provokes not an overlay but a confusion between the two regimes”.<sup>46</sup> This concern is central to the *Cofemel* AG Opinion; in fact in its very concluding remark it warns that “*le juge national ne saurait appliquer à la protection par le droit d’auteur les critères spécifiques de la protection des dessins et modèles*” (“the national judge cannot apply to copyright protection the criteria specific to the protection of designs and models”).<sup>47</sup>

The two regimes also differ in terms of non-economic objectives. The purpose and justification for copyright protection is also partly to protect the moral rights of authors. The designs regime grants no such rights and thus, its purpose and justification is purely economic in nature. Cumulation of design and copyright protection is then justified at least in some instances, so much so that the justification for cumulation when the designs regime was being introduced was partly “the need to protect creativity in respect of industrial design seen as an expression of the designer’s creativity”.<sup>48</sup>

<sup>42</sup> Recital 15, Designs Directive, *see also* Joint Paper of the European Communities Trade Mark Association (ECTA), International Trademark Association (INTA) and MARQUES on the Legal Review on Industrial Design Protection in Europe (July 2018). Available at: <http://www.inta.org/Advocacy/Documents/2018/ECTA%20INTA%20MARQUES%20Joint%20Paper%20on%20Legal%20Review%20of%20EU%20Designs%20System%20-%20July2018.pdf> (last visited 28 Dec. 2019).

<sup>43</sup> Recitals 9–11, InfoSoc Directive; Opinion of AG Szpunar, Case C-476/17, *Pelham v. Hütter*, EU:C:2018:1002, para. 83; and Case T-873/16, *Groupe Canal + v. Commission*, EU:T:2018:904, para. 40.

<sup>44</sup> Kur (1992), p. 23.

<sup>45</sup> For an analogous argument made in terms of Canadian law, *see* Srikanth (2017), p. 11 *et seq.*

<sup>46</sup> Kahn (2018), p. 8.

<sup>47</sup> AG Opinion, Case C-683/17, *Cofemel*, para. 67.

<sup>48</sup> European Commission, “Green Paper on the Protection of Industrial Design” (Brussels, June 1991, III/F/5131/91-EN), para. 2.2.1.

### 3 A Strict Application of Copyright in Line with its Objectives

The *Cofemel* AG Opinion, aware of the adverse effects of cumulation, suggests a solution which is fully in line with the cumulation approach finally adopted in the judgment – “*une application rigoureuse du droit d’auteur ... serait susceptible de remédier dans une large mesure aux inconvénients résultant du cumul*” (“a strict application of copyright would remedy to a large extent the adverse effects of cumulation”).<sup>49</sup> But what exactly does a strict application entail?

In the first place, it means that copyright protection should only be conferred when this would meet the objectives of such protection. So much so that the AG Opinion adopts a twofold conclusion. Not only does it reject that certain categories of works may be subjected to additional criteria, but it also states that “*le juge national doit prendre en compte les objectifs et les mécanismes spécifiques de ce droit*” (“the national judge must take into consideration the objectives and mechanisms specific to the right”).<sup>50</sup> In particular, the mechanisms that are specific to copyright are the exclusion from protection of ideas and the technical exclusion, both of which are mere applications or manifestations of the condition of originality. The exclusions go hand in hand with the objectives of copyright protection since they serve to inhibit the extent of exclusivity which would stifle the creation of original works.<sup>51</sup>

#### 3.1 The Exclusion of Ideas and the Technical Exclusion

Deriving from the idea/expression dichotomy of copyright protection, the principle that copyright only protects expressions of ideas but not the ideas themselves is universally accepted; indeed, the principle is an old one and has always defined copyright.<sup>52</sup> Even so, there is an inherent fallacy in the principle. As one United States (US) scholar puts it – “[n]o ‘expressionless idea’ exists and, at least in any meaningful writing, it makes no sense to speak of an ‘idealess expression’”.<sup>53</sup> US case law has refined the exclusion of ideas by introducing two different modalities of its application, though both propagate the inherent fallacy.<sup>54</sup> The first is the “merger doctrine” which holds that “[w]hen the idea and the expression of the idea are inseparable, then the expression will not be copyrightable because it would necessarily give the author a monopoly on the expression of the underlying idea”.<sup>55</sup> The second, the “*scènes à faire* doctrine”, holds that “when discussing a certain topic, story-line, or genre, there are certain themes, scenes, incidents, character

<sup>49</sup> AG Opinion, Case C-683/17, *Cofemel*, para. 54.

<sup>50</sup> *Ibid.*, para. 67.

<sup>51</sup> *Ibid.*, paras. 56–58 *et seq.* See also Gordon (1993), explaining the rationale behind the exclusion of ideas by arguing that the exclusion “prohibits a creator from owning abstract ideas because such ownership harms later creators”, p. 1581.

<sup>52</sup> Jones (1990), p. 553. See also Rosati (2009), p. 5 *et seq.*

<sup>53</sup> Jones (1990), p. 553. See also Masiyakurima (2007), p. 550.

<sup>54</sup> Jones (1990), p. 578 and p. 597.

<sup>55</sup> Murray (2006), p. 15.



types, or settings which as a practical matter must be used to properly treat the topic”.<sup>56</sup> Thus “the *scènes à faire* doctrine means that copyright protection is denied to common elements of work that are essential to the presentation of the subject matter of the work”.<sup>57</sup>

Driven by these doctrines, US courts can be said to take, at least in software disputes, a “reductionist” approach to the subsistence of copyright protection.<sup>58</sup> That is, rather than assessing whether an object is eligible for protection, the non-protectable elements of that object are first peeled away;<sup>59</sup> in other words, a process of “weeding out unprotectible expression”.<sup>60</sup> Indeed, “‘idea’ and ‘expression’ should not be taken literally, but rather as metaphors for a work’s unprotected elements respectively”.<sup>61</sup>

In the EU copyright *acquis*, the exclusion from protection of ideas is only expressly laid down as law in Directive 2009/24/EC on the protection of computer programs (hereinafter the “Software Directive”), for fear that the protection of computer programs would extend to such things as the logic, algorithms, programming languages and function of the program.<sup>62</sup> Even in ECJ case law the exclusion appears more prominently in software-related disputes, namely, the *Bezpečnostní softwarová*<sup>63</sup> and *SAS*<sup>64</sup> cases. Both cases tie the exclusion of ideas to the technical exclusion; another universally accepted rule which is inherent and obvious to copyright law.<sup>65</sup>

The *SAS* case submits that “to accept that the functionality of a computer program can be protected by copyright would amount to making it possible to monopolise ideas”.<sup>66</sup> The earlier *Bezpečnostní softwarová* case, which formally introduced the technical exclusion to EU copyright law, likewise provides that “where the expression of those components is dictated by their technical function, the criterion of originality is not met, since the different methods of implementing an idea are so limited that the idea and the expression become indissociable”.<sup>67</sup> The two quotations remain a staple in EU copyright law and the recent *Brompton*

<sup>56</sup> *Ibid.*, p. 22.

<sup>57</sup> *Ibid.*, p. 23.

<sup>58</sup> Murray (2006), p. 7 and p. 55 *et seq.*

<sup>59</sup> See in particular the “abstraction-filtration-comparison” test originally developed to assess copyright subsistence in non-literal elements of computer programs: *Computer Associates Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 705 (2d Cir. 1992), pp. 13–17.

<sup>60</sup> *Computer Associates Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 705 (2d Cir. 1992), p. 22.

<sup>61</sup> Rosati (2014), p. 61, citing Goldstein (1989), Vol. I, 2.3, p. 76.

<sup>62</sup> Recital 11 and Art. 1(2), Software Directive.

<sup>63</sup> Case C-393/09, *Bezpečnostní softwarová asociace – S vaz softwarové ochrany v. Ministerstvo kultury*, EU:C:2010:816. See also Shemtov (2017), p. 121.

<sup>64</sup> Case C-406/10, *SAS Institute v. World Programming*, EU:C:2012:259. See also Shemtov (2017), pp. 122–123.

<sup>65</sup> Quaedvlieg (2009), p. 492.

<sup>66</sup> *Ibid.*, para. 40.

<sup>67</sup> Case C-393/09, *Bezpečnostní softwarová*, para. 49.

*Bicycle* case restates them, thus applying them directly to the question of cumulation of copyright and design rights.<sup>68</sup>

The second part of the quotation in *Bezpečnostní softwarová* seems to be analogous to the merger doctrine in US law.<sup>69</sup> The later *Football Dataco* case suggests that the technical exclusion also closely resembles the *scènes à faire* doctrine – an object is not protected by copyright if its creation “is dictated by technical considerations, rules or constraints which leave no room for creative freedom”.<sup>70</sup> In consequence, like Russian dolls, the merger and the *scènes à faire* doctrines inhabit the exclusion of ideas, the latter inhabits the technical exclusion, and all these notions inhabit the “author’s own intellectual creation criterion”. A determination of originality requires an application of all these notions en masse.

### 3.2 The Technical Exclusion and Cumulation

The technical exclusion is also inherent in design law – a national or Community design “shall not subsist in features of appearance of a product which are solely dictated by its technical function”.<sup>71</sup> In this sense, the exclusion is also relevant to the question of cumulation of copyright and design rights. In its submissions in the *Bezpečnostní softwarová* case, the European Commission had argued that if design protection is excluded when the design of an object is dictated by its technical function, then copyright protection should *a fortiori* be excluded seeing as it is the superior form of protection.<sup>72</sup> While the assumption that copyright protection is superior to design protection is arguable, the Commission was right to point out the danger of conflating the two regimes. In view of the issues with cumulation, in particular the different justifications and objectives underlying the two regimes, the technical exclusion should not be identically applied in copyright and in design law.<sup>73</sup>

In the *Cofemel* case, the ECJ restates the technical exclusion in terms of the *Football Dataco* case, therefore clearly framing the technical exclusion within a copyright context, but it does not go beyond the specific questions referred to it.<sup>74</sup> How the exclusion is to be applied exactly, and how it is distinct from the technical

<sup>68</sup> Case C- 833/18, *Brompton Bicycle*, para. 27.

<sup>69</sup> Although, in EU copyright law, protection for technical subject matter is excluded because it is unoriginal, in US law the merger doctrine excludes protection in spite of originality, because conferring protection would mean conferring exclusive rights over ideas. See in this respect Shemtov (2017), p. 122, footnotes 72 and 73.

<sup>70</sup> Case C-604/10, *Football Dataco v. Yahoo! UK*, EU:C:2012:115, para. 39.

<sup>71</sup> Art. 8, Designs Regulation; and Art. 7, Designs Directive.

<sup>72</sup> JURM(2010) 4/PO (20 January 2010), *Observations écrites dans l’affaire C-393/09* (Written submissions in the Case C-393/09), para. 38.

<sup>73</sup> The European Copyright Society has also made the same argument. See European Copyright Society, “Opinion of the European Copyright Society in relation to the pending reference before the CJEU in *Brompton Bicycle v Chedech/Get2Get*, C-833/18” (12 December 2019), paras. 5–7 and paras. 12–14. Available at: <https://europeancopyrightsocietydotorg.files.wordpress.com/2019/12/ecs-opinion-brompton-final-12-12-2019-final-3.pdf> (last visited 7 March 2020).

<sup>74</sup> Case C-683/17, *Cofemel*, para. 31.

exclusion in design law, remains unclear. To the contrary, the AG Opinion devotes much more of its reasoning to applying the technical exclusion while being acutely aware of the issues presented by cumulation. It insists that even without the artistic/creative criterion applied in Portugal, the clothing in question is still not copyright-protected.

The AG Opinion undertakes a sort of “filtration” test, reminiscent of the second step of the “abstraction-filtration-comparison” test of the Second Circuit Court of Appeals of the US – “separating protectable expression from non-protectable material ... [b]y applying well developed doctrines [namely, the merger and *scènes à faire* doctrines] of copyright law, it may ultimately leave behind a ‘core of protectable material’”.<sup>75</sup> In fact, the AG Opinion assesses the various elements of the clothing that had allegedly been copied and concludes: “*les caractéristiques ... dont la reproduction est reprochée à Cofemel, devraient être analysées comme des idées susceptibles de différentes expressions, voire comme des solutions fonctionnelles*” (“the elements which Cofemel allegedly reproduced have to be assessed as ideas susceptible of different expressions, indeed as functional results”).<sup>76</sup> In doing so, the AG Opinion suggests that this exclusion is wider than the technical exclusion in design law, much like what the Commission had argued in the *Bezpečnostní softwarová* case, though not applying the same reasoning.

The *Brompton Bicycle* judgment posits a far more meaningful, though subtle, reading of the relationship between the technical exclusion in design law and the exclusion in copyright law. It states that “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>77</sup> Two consequences follow from such a statement.

The first is that the technical exclusion in copyright law is indeed a separate and distinct exclusion from that in design law. In particular, technical subject-matter is excluded from copyright protection because it is not original and not because there is an exclusion per se as in design law.<sup>78</sup> Therefore, notions in design law or in case law relating thereto cannot be automatically transposed to copyright law. The ECJ’s statement thus seems to reject the Opinion of Advocate General Campos Sánchez-Bordona in that case – “I do not believe there is any reason why the Court’s considerations concerning one of those fields [designs, trademarks, and copyright] should not be cautiously applied to the others where it is a case of interpreting a rule applicable, albeit with nuances, to all of them”.<sup>79</sup>

The second consequence is that it is not necessarily true that the exclusion is wider (excludes more subject-matter) in copyright law than it is in design law. That

<sup>75</sup> *Computer Associates Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 705 (2d Cir. 1992), pp. 13–14.

<sup>76</sup> AG Opinion, Case C-683/17, *Cofemel*, para. 60.

<sup>77</sup> Case C-833/18, *Brompton Bicycle*, para. 26.

<sup>78</sup> *Ibid.*, para. 24.

<sup>79</sup> Opinion of AG Campos Sánchez-Bordona, Case C-833/18, *SI/Brompton Bicycle v. Chedech/Get2Get*, EU:C:2020:79, para. 70.

is not to say that the inverse is true. Rather, which exclusion is wider is irrelevant as long as the two are kept independent of each other, their definition being influenced solely by the underlying justifications and objectives of each respective intellectual property right.

#### 4 A Refined Approach to Originality

Thus, the *Brompton Bicycle* decision renders irrelevant any discussion as to whether copyright protection is superior or more burdensome on competition than design protection, at least in so far as restricting cumulation through the technical exclusion goes. More importantly, it liberates copyright doctrine on the technical exclusion from the confines of the exclusion's definition in design law, thus carving a way for the independent development of the concept in copyright law. At present, there is still too great a lack of clarity as to how the exclusion is to be applied and, specifically, how the technical exclusion in copyright is to distinguish itself from the mere application of the exclusion in design law.

Furthermore, and as has been discussed above, the technical exclusion cannot be disassociated from the exclusion of ideas and from the merger and the *scènes à faire* doctrines. All these notions relate and find their true sense when read as manifestations of the condition of originality defined as the “author's own intellectual creation criterion”. In this context it is here posited that the assessment of originality should follow three principles.

##### 4.1 Adopt a Method of “Filtration” by a “Main Factor” Test

The subsistence of copyright protection, or indeed infringement, should be established by an exclusion of unoriginal subject matter. That is to say, rather than shooting in the dark to determine the subsistence of originality, it is easier and more reliable to identify what elements of the object in question are *not* original. This is also in line with ECJ case law which holds that “the various parts of a work thus enjoy protection ... provided that they contain elements which are the expression of the intellectual creation of the author of the work”.<sup>80</sup> This “filtration” should be done by applying the technical exclusion to those elements as done by the AG Opinion in the *Cofemel* case incorporating the merger and *scènes à faire* doctrines (or at least their analogies) as laid down in the *Bezpečnostní softwarová* and *Football Dataco* cases respectively.

This filtration test should be differentiated from the test that is to be applied in design law adopted by the ECJ in the *DOCERAM* case in favour of the “multiplicity of forms” test.<sup>81</sup> That is, the technical exclusion applies “for features of appearance of a product where considerations other than the need for that product to fulfil its technical function, in particular those related to the visual aspect, have not played any role in the choice of those features, even if other designs fulfilling the same

<sup>80</sup> Case C-5/08, *Infopaq International v. Danske Dagblades Forening*, EU:C:2009:465, para. 39.

<sup>81</sup> Suthersanen (2019), p. 159.

function exist”.<sup>82</sup> This test may be referred to as the “only factor” test in the sense that if the technical function of the design is the only factor of consideration then the design is not eligible for protection.<sup>83</sup> The test is also referred to by two other appellations but these are not very precise; it is important that this is clarified even for the purposes of comparing the test in design law with the exclusion that should apply in copyright law.

Firstly, that test is commonly referred to as the “no-aesthetic-consideration” test in the sense that if there is any aesthetic consideration then the design is not excluded.<sup>84</sup> The word “aesthetic” may be taken to mean merely “of appearance” or “visual” and not any standard of beauty or artistry. Nonetheless, from the perspective of comparing design and copyright law, such appellation is disagreeable since it evokes confusion with the aesthetic/artistic criterion used in the copyright laws of some Member States, for example Portugal. Also, it is not clear in the *DOCERAM* case that there are only *technical* or *aesthetic* considerations of a design to the exclusion of any other consideration of a different nature.<sup>85</sup> The judgment states that considerations other than those which are technical include “those related to the visual aspect” but there is no exclusivity.<sup>86</sup>

Secondly, the test is also referred to as “causative” in the sense that if the design was caused by technical considerations then it is not eligible for design protection.<sup>87</sup> However, it is not that a design is caused by technical considerations but that it is *solely* caused by technical considerations that makes it ineligible for protection.<sup>88</sup> For these reasons, calling the test in the *DOCERAM* case the “only factor” test is more apt.

Contrary to this, the ECJ case law on copyright suggests that for the exclusion in copyright law to be triggered it is not required that the *only* factor of consideration is technical. It is enough if technical considerations are the *main* factor for the author’s creative choices. This is the case where the different methods of implementing an idea (and thereby, the creative freedom) are so limited due to technical considerations, rules or constraints that the idea and the expression become indissociable (merger doctrine) or that the expression is not resultant of creative choices of the author but rather of those technical considerations, rules or constraints (*scènes à faire* doctrine).

<sup>82</sup> Case C-395/16, *DOCERAM v. CeramTec*, EU:C:2018:172, para. 31.

<sup>83</sup> Endrich (2019), p. 157.

<sup>84</sup> Stone (2016), para. 6.13.

<sup>85</sup> Suthersanen (2019), p. 158.

<sup>86</sup> Case C-395/16, *DOCERAM*, para 31. See also European Commission, “Amended proposal for a European Parliament and Council Directive on the legal protection of designs” (Brussels, 21 February 1996, COM(96) 66 final), p. 7, commentary on Art. 7(1) of the Designs Directive.

<sup>87</sup> Bently and Sherman (2004), p. 618; and Dinwoodie (1994), p. 670.

<sup>88</sup> Art. 8(1), Designs Regulation; and Art. 7(1), Designs Directive.

#### 4.2 Exclude “Subject-Matter Dictated by Technical Considerations” not only “Subject-Matter Dictated by Considerations as to Technical Function”

The term “technical” has been described as a “legal minefield” since it is difficult to define with any precision.<sup>89</sup> This said, technical subject-matter is generally understood to mean “a shape with a technical *result*” (original emphasis).<sup>90</sup> This makes sense in design law. In fact, in this context there is a tendency to equate technical subject-matter with patentable subject-matter.<sup>91</sup> After all, in design law the exclusion is of “features of appearance of a product which are solely dictated by its technical function”.<sup>92</sup> In design law, the phrase “technical considerations” means considerations as to “the need for that product to fulfil its technical function”.<sup>93</sup>

This is not so in copyright law where “technical considerations” mean considerations, rules or constraints which are themselves of a technical nature and not considerations as to the technical function or result which the subject-matter is to perform. In other words, the technical function of the subject-matter may be relevant to determine whether the exclusion is to apply but is by no means a necessary factor or even the principal factor to take into account. Accordingly, the famous *Football Dataco* mantra asserts that an object is not protected by copyright if its creation “is dictated by technical considerations, rules or constraints which leave no room for creative freedom”.<sup>94</sup> The mantra is derived, by the ECJ’s own admission, from the *FAPL* case where football matches were excluded from copyright protection on the ground that they “are subject to the rules of the game, leaving no room for creative freedom”<sup>95</sup> – a technical consideration in the “creation” of the subject-matter in question. Football matches themselves cannot be said to have a “technical function or result” unless this phrase is so absurdly and widely construed as to cover their function to provide entertainment.

The AG Opinion in the *Cofemel* case nonetheless restricts itself to applying the technical exclusion by assessing the clothing in question against its technical result and therefore seems to apply the exclusion as it is defined in design law. In fact the AG Opinion points out that a pocket placed on the back does not have a lot of utility as opposed to the pocket placed on the abdomen in the case of the clothing in question.<sup>96</sup> Regrettably, after having clearly delineated between the copyright exclusion and the design rights exclusion, the *Brompton Bicycle* decision states just a few paragraphs down that “[w]here the shape of the product is solely dictated by

<sup>89</sup> Quaedvlieg (2009), p. 494.

<sup>90</sup> *Ibid.*

<sup>91</sup> Schlötelburg (2006).

<sup>92</sup> Art. 8(1), Designs Regulation; and Art. 7(1), Designs Directive.

<sup>93</sup> Case C-395/16, *DOCERAM*, para. 31.

<sup>94</sup> Case C-604/10, *Football Dataco*, para. 39.

<sup>95</sup> Joined Cases C-403/08 and C-429/08, *Football Association Premier League v. QC Leisure*, EU:C:2011:631, para. 98.

<sup>96</sup> AG Opinion, Case C-683/17, *Cofemel*, para. 60, footnote 48.

its technical function, that product cannot be covered by copyright protection”.<sup>97</sup> Considering the technical function or result of the subject-matter is well in line with the “*Bezpečnostní softwarová merger doctrine*”; however, surely in copyright law the technical exclusion warrants not only an assessment of the constraints that result from the utilitarian purpose of the object but also an assessment of other technical or rule-based constraints in line with the “*Football Dataco scènes à faire doctrine*”.

When dealing with three-dimensional objects, three such other technical or rule-based constraints come to mind. Firstly, this assessment should consider constraints imposed by industry rules, for example manufacturing standards. Secondly, the assessment should consider the *scènes à faire stricto sensu*, that is, the particular features, concepts or motifs which are omnipresent in the industry or product in question. Thirdly, the assessment should also consider technical considerations of a circumstantial nature. For instance, the larger the quantity of production, the more the creative choices of the author are restricted in terms of sourcing material which meets the demand of that large production. It also has an impact on choosing forms which are easily replicated or manufactured at a quick pace, as well as choosing materials and shapes which can easily and safely be transported; the wider the consumer base (a corollary of larger numbers of production), the more the creative choices are subservient to mainstream tastes; the more the process of manufacture is automated, the more the creative choices are subservient to fitting within that automation; and so on.

#### 4.3 Adopt an “Objective Observer” Assessment

The determination of the “only factor” test in design law is done by taking into account the objective circumstances of the case at issue without the need to adopt the point of view of any “objective observer”, that is, a hypothetical person whose perspective would be used as the point of reference.<sup>98</sup> According to the ECJ those objective circumstances may be “the design at issue, the objective circumstances indicative of the reasons which dictated the choice of features of appearance of the product concerned, or information on its use or the existence of alternative designs which fulfil the same technical function”.<sup>99</sup> In light of the above, especially in view of the determination of subject-matter dictated by technical considerations, rules or constraints (a much wider ambit than “designs dictated by their technical function”), an objective circumstantial test does not seem to be appropriate in the context of copyright law. The filtration of unoriginal elements in an object by a “main factor” test, that is, by determining whether technical considerations were the main factor for the author’s creative choices, demands more sensitivity to the author’s point of view. In any case, adopting the point of view of some “observer” would tend to make the application of this “refined approach” to originality more consistent and reliable.

<sup>97</sup> Case C-833/18, *Brompton Bicycle*, para. 33.

<sup>98</sup> Case C-395/16, *DOCERAM*, paras. 33–38. See also Opinion of AG Saugmandsgaard Øe, Case C-395/16, *DOCERAM v. CeramTec*, EU:C:2017:779, para. 55.

<sup>99</sup> Case C-395/16, *DOCERAM*, para. 37.

Certainly, a subjective determination, that is, taking the author as the point of reference, is not possible. As for the function or purpose of the product or work, a subjective point of view is self-evidently inappropriate. The *DOCERAM* case discarded any subjective test, due to the fact that statements of the designer in question are questionable evidence of his intent; the same remark would apply to the author in copyright law.<sup>100</sup> In any case, the author's intentions or state of mind would necessarily focus on whether the work is of a technical nature and, for the large part, ignore whether its creation was dictated by technical considerations. A subjective point of view would be inherently incorrect since the condition of originality is already an objective test in terms of the case law of the ECJ.<sup>101</sup> That is, that an object is the result of the author's free and creative choices must result from the object itself. Being part and parcel of originality, the technical exclusion in copyright law should entail that by simply looking at the object, one could determine whether it is dictated by technical considerations. In other words, that these were the main factors of consideration in the author's creative choices, and *not* that the author intended to favour above all else artistic or aesthetic considerations. In this sense, there is no other option than to adopt an "objective observer" assessment. But whose perspective should be used as the point of reference?

One option is to adopt the perspective of an art expert. This would presumably require too high a threshold in view of the "*Bezpečnostní softwarová* merger doctrine". That is to say, an art expert might require some high artistic/aesthetic quality to exclude that the expression is dissociable from the idea, thus making the technical exclusion too wide.<sup>102</sup> This would also make the exclusion similar to the criterion used by the Portuguese appellate court to deny copyright protection to bathroom taps.<sup>103</sup> All mundane objects with an obvious utilitarian function will, in the vast majority of cases, be found not to be copyright-protected if a too widely construed merger doctrine is applied. Even if a work of applied art should satisfy the merger doctrine, an art expert might still construe the "*Football Dataco scènes à faire* doctrine" too widely and deny copyright protection on this ground. In particular, the perspective of an art expert does not lend itself to a careful juxtaposition of the work at issue with current industry practice or with the prior art. In short, an art expert would be hard-pressed to find any creative difference between various designs of a utilitarian object, invariably denying copyright protection in almost all cases.

Adopting the perspective of a consumer is also problematic in view of the merger and *scènes à faire* doctrines. If the measure is the average consumer, then the exclusion might be too wide and the functionality of the product might overwhelm any other consideration. If the measure is the cultivated consumer, the issue crops up as to whether this means a frequent consumer of artworks in general or a

<sup>100</sup> AG Opinion, Case C-395/16, *DOCERAM*, paras. 52–53.

<sup>101</sup> Rahmatian (2013), pp. 21 and 25.

<sup>102</sup> Case C-393/09, *Bezpečnostní softwarová*, para. 49.

<sup>103</sup> Judgment of the Court of Appeal (Tribunal da Relação) of Guimarães of 27 February 2012, Proc. 1607/10.3TBBRG.G1, Judge Manso Rainho, *op. cit.*



consumer of pieces that are considered to be designer objects, presuming in the first place that there is any difference between artworks and designer objects.

In this light, the perspective of the design expert seems the most appropriate measure to take in an objective determination of the “main factor” test being proposed.<sup>104</sup> The design expert would likely be sensitive to the room for creativity amidst the technical nature of an object or the technical considerations in its manufacture or design. In particular, the design expert would have knowledge of the *scènes à faire* influencing the design of the object in question, whether these are industry rules, motifs, or technical considerations of a circumstantial nature, such as the quantity of production, necessary materials and so on. This perspective then tends to assess most precisely the creative berth that the author has availed himself of and, therefore, whether technical considerations were the main factor guiding the creation of the work or not. If not, the work is original and copyright-protected.

Of course, this is not to say that the adjudication process should be dominated by designers or that relevant disputes must be submitted to some specialised court of experts. What is being suggested here is merely that a judge, when confronted with the issue of copyright and design cumulation, should adopt the perspective of the design expert rather than that of an art expert or of the consumer. Opinions of design experts would be relevant evidence to the determination of originality but in no way conclusive thereof.

## 5 The *Brompton Bicycle* Case

The recent *Brompton Bicycle* case concerns precisely the application of the technical exclusion in copyright law with respect to a foldable bicycle.<sup>105</sup> The first question of the referring Belgian court was whether works whose shape is necessary to achieve a technical result are excluded from copyright protection. The second question referred concerned the criteria to be used to determine the operability of the technical exclusion in a given case. The referring court pointed out four criteria in particular: 1) the existence of other possible shapes which achieve the same technical result; 2) the effectiveness of the shape in achieving that result; 3) the intention of the alleged infringer to achieve that result; and 4) the existence of an earlier, now expired, patent on the process for achieving the technical result sought.

The AG Opinion in the *Brompton Bicycle* case recognises the issues with cumulation which the AG Opinion in *Cofemel* had raised.<sup>106</sup> Yet the approach taken in the *Brompton Bicycle* AG Opinion tends to dismiss the fundamental differences between copyright protection and design protection. Whether the judgment endorses this approach is unclear since the judgment is rather sparsely motivated. Whether or

<sup>104</sup> See in this respect a similar test for originality used in judgment of the Barcelona District Court (Audiencia Provincial de Barcelona) 764/2019 (Civil, 15th Section), of 26 April 2019, ES:APB:2019:4105, para. 25. Available at: <http://www.poderjudicial.es/search/indexAN.jsp> (last visited 22 July 2020).

<sup>105</sup> Request for a preliminary ruling from the Tribunal de l'entreprise de Liège (Belgium), Case C-833/18, *SI/Brompton Bicycle v. Chedech/Get2Get*, OJ L 167/10.

<sup>106</sup> AG Opinion, Case C-833/18, *Brompton Bicycle*, paras. 51–56.

not the answers proposed by the ECJ in its judgment depart from the reasoning motivating the AG Opinion, they nevertheless allow a reading of the technical exclusion in copyright law which conforms with the refined approach to originality that is proposed in this article.

### 5.1 The First Question – Whether Works Whose Shape Is Necessary to Achieve a Technical Result Are Excluded from Copyright Protection

With regard to the first question, both the ECJ judgment and the AG Opinion reply that if the appearance of the bicycle was necessary to achieve the technical result in the sense that it is the only shape which achieves that result, then copyright protection is to be excluded.<sup>107</sup> The AG Opinion explicitly conflates the exclusion in design law and that in copyright law, firmly holding that a spill-over of notions that regulate different intellectual property rights is an adequate interpretative tool.<sup>108</sup> The ECJ judgment is silent on whether it adopts this approach or not; however, its answer to the first question is clearly extracted from the field of design protection – “[w]here the shape of the product is solely dictated by its technical function, that product cannot be covered by copyright protection”.<sup>109</sup>

While the reply (though not the reasoning) presented in the AG Opinion and in the ECJ judgment is valid, even in terms of the refined approach to originality argued for herein, stopping at that fails to consider the technical exclusion in light of the exclusion of ideas from copyright protection. As has been argued in Sect. 4.2 of this article, excluding “subject-matter dictated by considerations as to its technical function” is not the same as excluding “subject-matter dictated by technical considerations” (such that there is no room for creative freedom).<sup>110</sup> In this respect the ECJ has already ruled that the condition of originality is not satisfied where the shape of work is necessary to achieve a technical result inasmuch as the expression and the idea become indissociable (merger doctrine).<sup>111</sup> But the ECJ has also ruled that where the main factor of consideration consists of technical considerations other than the work’s technical function, copyright protection is still excluded (*scènes à faire* doctrine).<sup>112</sup> The consideration as to a technical result might be the most obvious, even the most important, factor to consider when assessing the originality of objects having a utilitarian purpose but it is by no means the only factor to consider. Indeed, the same notion of originality is to be applied indiscriminately to all subject-matter even that which does not have any utilitarian purpose; in that case considerations as to technical results become irrelevant and other technical considerations take prominence. The *Brompton Bicycle* judgment fails to make this point.

<sup>107</sup> Case C-833/18, *Brompton Bicycle*, para. 33; and AG Opinion, Case C-833/18, *Brompton Bicycle*, para. 76.

<sup>108</sup> AG Opinion, Case C-833/18, *Brompton Bicycle*, paras. 69–71.

<sup>109</sup> Case C-833/18, *Brompton Bicycle*, para. 33.

<sup>110</sup> Also making a similar argument, see European Copyright Society (2019), *op. cit.*

<sup>111</sup> Case C-393/09, *Bezpečnostní softwarová*, para. 49.

<sup>112</sup> Case C-604/10, *Football Dataco*, para. 39; and Case C-683/17, *Cofemel*, para. 31.

That said, the judgment is bound by the terms of the preliminary reference itself which rigidly casts the questions in terms of the technical result of the bicycle.<sup>113</sup> Its ruling then does not prejudice the proposition that it is not only “subject-matter dictated by considerations as to technical function” which is to be excluded from copyright protection, but also “subject-matter dictated by technical considerations”. Furthermore, it could so be that assessing whether a design is dictated by considerations as to its technical function is exhaustive and sufficient in itself to make a determination as to its originality (or lack thereof) without the need to proceed to assess other technical considerations. For these reasons, the ECJ did not have to elaborate further, although it might have done well to have done so.

This interpretation of the consequences of the judgment’s reply to the first question is further substantiated by the fact that it clearly held the exclusions in the respective protection regimes to be distinct just a few paragraphs beforehand.<sup>114</sup> In this sense, in its treatment of the second question referred, and the four criteria contained therein, it recast the discussion in terms of notions of copyright law by requiring that considerations as to the technical result of the foldable bicycle are not to be taken as decisive in themselves but as factors which influenced the free and creative choices of the author.<sup>115</sup> Consequently, that the work is the author’s own intellectual creation, as expressed through his free and creative choices, remains the overarching criterion for originality.

## 5.2 The Second Question – the Criteria that Are to Be Used to Determine the Operability of the Technical Exclusion

The AG Opinion’s conflation of the two intellectual property rights is also pervasive in its treatment of the second question. This is especially true in the case of the first criterion – the existence of other possible shapes which achieve the same technical result. The AG Opinion very clearly claims that “[t]he approach set out in relation to designs can be applied, *mutatis mutandis*, for the purpose of determining the level of originality of ‘works’ with an industrial application”.<sup>116</sup> It therefore adopts the answer that was proposed by the Opinion of Advocate General Saugmandsgaard Øe in the *DOCERAM* case with respect to design law.<sup>117</sup> That is, that the existence of alternative designs may be taken into account but is not decisive of the fact that the technical function was the *only factor* which determined the appearance of the object.<sup>118</sup> It should be pointed out here that the Belgian court also presumed in its request that the “only factor test” is to be used for the application of the technical exclusion in copyright law.<sup>119</sup>

<sup>113</sup> Case C-833/18, *Brompton Bicycle*, para. 19.

<sup>114</sup> *Ibid.*, para. 26.

<sup>115</sup> *Ibid.*, paras. 34–37.

<sup>116</sup> AG Opinion, Case C-833/18, *Brompton Bicycle*, para. 88.

<sup>117</sup> *Ibid.*, para. 83.

<sup>118</sup> *Ibid.*

<sup>119</sup> Request for a preliminary ruling (31 December 2018), Case C-833/18, *Brompton Bicycle*, p. 12.

If the approach to originality proposed in this article (specifically, Sect. 4.1) is to be taken up, the existence of other shapes achieving the same result is also not decisive. But the reasoning behind that answer bears a nuanced difference. The answer would rather be that the existence of alternative designs is only relevant in so far as it shows, from a design expert's perspective, that the design of the product at issue does or does not exhibit the personality of its author as a result of his free creative choices, these being the *main factor* of consideration. In this respect, the answer given in the ECJ's judgment is far more satisfactory than that suggested by the AG Opinion and by the referring court itself – “even though the existence of other possible shapes which can achieve the same technical result makes it possible to establish that there is a possibility of choice, it is not decisive in assessing the factors which influenced the choice made by the creator”.<sup>120</sup> Indeed, the fewer the number of possible shapes, the likelier it is that technical considerations were the main factor of consideration in the work's creation and the creative choices of the author suppressed.

With respect to the second criterion – the effectiveness of the shape – the AG Opinion only states that “[i]t must be assumed ... that the proposed shape is effective for that purpose (in this case, for manufacturing a bicycle which can be ridden and be folded)” otherwise it would not have any industrial applicability.<sup>121</sup> AG Campos Sánchez-Bordona seems to have been fazed by such an obvious question.<sup>122</sup> This may be so since he views the question in the context of the “only factor test”. In that context, a utilitarian object will always be effective in achieving a technical result; what is relevant is whether there are any other considerations, in which case the design of the object cannot be said to have been solely dictated by its technical function. In such a determination, effectiveness is irrelevant.

To the contrary, if one were to apply the “main factor test” as proposed in this article, then, the assessment is slightly more nuanced. Namely, the central question is not whether there were any considerations other than the effectiveness of the object to meet its technical function but whether consideration as to the said effectiveness was the main factor of consideration. As the *Brompton Bicycle* judgment states, the effectiveness should be taken into account in so far as it makes it possible “to reveal what was taken into consideration in choosing the shape of the product concerned”.<sup>123</sup> The refined approach suggested in this article is also more nuanced in that the filtration method proposed would require such an assessment to be applied to the various relevant features of the object. For example, it is not sufficient to consider the shape of the Brompton bicycle as a whole against its technical function as a foldable bicycle. The effectiveness of each of the distinctive features of the bicycle (such as its handlebars, frame, dimensions, and the way the bicycle folds, etc.) in achieving that technical function has to be considered in turn. Some features may be original and warrant copyright protection while others may not.<sup>124</sup>

<sup>120</sup> Case C-833/18, *Brompton Bicycle*, para. 35.

<sup>121</sup> AG Opinion, Case C-833/18, *Brompton Bicycle*, para. 97.

<sup>122</sup> *Ibid.*, paras. 95–97.

<sup>123</sup> Case C-833/18, *Brompton Bicycle*, para. 36.

<sup>124</sup> Case C-5/08, *Infopaq*, para. 39.

The third criterion of assessment, the intention of the alleged infringer to achieve the same technical result, is discarded by both the AG Opinion and the ECJ, and rightfully so.<sup>125</sup> Irrespective of the infringer's intentions to merely achieve the same technical function, infringement subsists if the work is copyright-protected. The AG Opinion expressly states that the intention of the author rather "to achieve his own intellectual creation" or "only to protect an idea applicable to the development of an original industrial product" may be taken into account.<sup>126</sup> This is problematic in that it seems to adopt a subjective method of assessing originality and any intention subjective to the author is very difficult to prove or, indeed, to rebut. For this principal reason this article proposes an "objective observer" assessment from the perspective of the design expert (Sect. 4.3). Such an objective determination of originality, by definition, discards any consideration as to the intentions of the putative author. Nevertheless, the AG Opinion does not rule out such an objective approach, despite also admitting of a subjective one. When considering the assessment criterion of the effectiveness of the shape, it declares that this factor should be analysed by the national court "in the light of the evidence (particularly the expert evidence) presented to it".<sup>127</sup> That said, it does not elaborate on what this expert evidence might be, and less so on what expert should be taken as the point of reference.

Turning now to the fourth and last criterion, the AG Opinion rightly points out that it would be a dangerous precedent to deduce that a product is not copyright-protected from the mere fact that there exist other registered rights in its regard.<sup>128</sup> This would do away with the principle of available cumulative protection. Nonetheless, it holds that taking into account the existence of a registered patent may be helpful in two ways: first, the patent registration documents may be used "to determine whether there were technical constraints which dictated the shape of the product"; and, second, it can be assumed from the existence of a patent that "the shape is that which the inventor decided was effective to obtain the desired functionality".<sup>129</sup>

Both points are relevant to the refined approach to originality as proposed by this article. In particular, the first point suggests that technical considerations which dictate the design of the object, other than considerations as to its technical result, are also to be given importance. The existence of a registered patent right indicates, at most, that the design of a product adheres too closely to a *scène à faire* or that it achieves some technical result, but this does not in itself mean that these technical considerations were the main factor influencing the design of the object in question. The AG Opinion only diverges from this position in so far as it seems to apply, even here, the "only factor test" which is used in design law as per the *DOCERAM* case law rather than a "main factor test". Again, the judgment is more true to the real

<sup>125</sup> AG Opinion, Case C-833/18, *Brompton Bicycle*, paras. 90–91; and Case C-833/18, *Brompton Bicycle*, para. 36.

<sup>126</sup> AG Opinion, Case C-833/18, *Brompton Bicycle*, paras. 92–93.

<sup>127</sup> *Ibid.*, para. 98.

<sup>128</sup> *Ibid.*, para. 79.

<sup>129</sup> *Ibid.*, para. 80.

question at issue, that is, whether the bicycle is original or not, and suggests that pre-existing registered rights may be taken into account in so far as it makes it possible “to reveal what was taken into consideration in choosing the shape of the product concerned”.<sup>130</sup>

## 6 Conclusion

“*Une application rigoureuse du droit d’auteur ... serait susceptible de remédier dans une large mesure aux inconvénients résultant du cumul*” (“a strict application of copyright would remedy to a large extent the adverse effects of cumulation”) – Opinion of AG Szpunar in the *Cofemel* case.<sup>131</sup>

The adverse effects of cumulation as have been presented in this article are namely three: that cumulation lends itself to overprotection; that cumulation renders the designs regime useless; and that cumulation belies the underlying objectives of the copyright and designs regimes. Arguably, the latter is the more truthful and concerning of the three. On the one hand, the adverse effects of cumulation have been acknowledged by the recent case law of the ECJ on the cumulation of copyright and design rights, namely in the *Cofemel* judgment itself<sup>132</sup> and in the Opinion of AG Campos Sánchez-Bordona in the *Brompton Bicycle* case.<sup>133</sup> Indeed, the *Cofemel* judgment even draws the conclusion that “concurrent protection can be envisaged only in certain situations”.<sup>134</sup> On the other hand, how a strict application of copyright law might remedy the adverse effects of cumulation has not been elaborated upon.

This article has attempted to fill that void by arguing that copyright law ought to be applied strictly in the sense that copyright protection should remain faithful to its underlying objectives, these being distinct from the objectives of design protection. In particular, the concept of originality, as a condition for the conferral of copyright protection, not only defines when subject-matter is original and should be copyright-protected but, through the mechanisms of the exclusion of ideas and the technical exclusion, it also defines when subject-matter is unoriginal and not protected as such. But these exclusions are an inherent part of the originality test which must be taken into consideration whenever a claim as to the originality of subject-matter is invoked. Especially with respect to the technical exclusion, they are to be defined holistically and within the confines of originality and not by importing notions from different intellectual property rights, including design rights. Therefore, ideas are excluded from protection because they are unoriginal. Subject-matter dictated by considerations as to the technical function is excluded from protection because it is unoriginal, since the author’s expression and the idea of the technical function become indissociable in such a case, according to the merger doctrine developed in

<sup>130</sup> Case C-833/18, *Brompton Bicycle*, para. 36.

<sup>131</sup> AG Opinion, Case C-683/17, *Cofemel*, para. 54.

<sup>132</sup> Case C-683/17, *Cofemel*, paras. 50–52.

<sup>133</sup> AG Opinion, Case C-833/18, *Brompton Bicycle*, paras. 39–44.

<sup>134</sup> Case C-683/17, *Cofemel*, para. 52.

EU law. Subject-matter dictated by other technical considerations, rules or constraints is also excluded from protection because it is unoriginal in that such technical considerations leave no room for the expression of the author; according to the *scènes à faire* doctrine developed in EU law.

For these reasons this article has proposed a refined approach to dealing with the originality condition, and specifically the technical exclusion within that condition, which is guided by three propositions:

- (i) Adopting a filtration method whereby the question to be asked by a court seized of a copyright case is not whether a work is original but whether it has features which are unoriginal and determining this “unoriginality” by applying the technical exclusion using a “main factor” test, that is, if the main factor of consideration is “technical”, the feature is excluded from protection;
- (ii) Interpreting “technical” widely so that the technical exclusion in copyright also encompasses the exclusion of ideas, particularly the merger doctrine as it emerges from the *Bezpečnostní softwarová* case,<sup>135</sup> and the *scènes à faire* doctrine as it emerges from the *Football Dataco* case;<sup>136</sup> and
- (iii) That, in cases where cumulation of protection is a possibility, this determination of originality is done objectively, taking the perspective of the designer of the product in question as a point of reference.

Regrettably the Opinion of AG Campos Sánchez-Bordona in the *Brompton Bicycle* case takes a different approach and conflates copyright protection and design protection, as well as their respective conditions. Nonetheless, the article has also argued that the judgment of the ECJ in that case leaves room for the proposed approach to originality to take root in future case law of the ECJ, as well as in European copyright doctrine.

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<sup>135</sup> Case C-393/09, *Bezpečnostní softwarová*, para. 49.

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