

**Opinion of the
European Copyright Society
in relation to the pending reference before the CJEU
*in Brompton Bicycle v Chedech / Get2Get, C-833/18***

Date: 12 December 2019

Introduction

The European Copyright Society (ECS) was founded in January 2012 with the aim of creating a platform for critical and independent scholarly thinking on European Copyright Law. Its members are renowned scholars and academics from various countries of the European Union, seeking to promote their views of the overall public interest. The Society is not funded, nor has been instructed, by any particular stakeholders.

This ECS opinion concerns a case pending before the Court of Justice of the European Union (CJEU) relating to the copyright protection of the shape of a utilitarian article (known as the “Brompton” bicycle). The question in essence is whether the exclusion from design protection adopted by the CJEU in *Doceram* applies also in connection with copyright protection.

The questions for preliminary ruling are as follows:

- Must EU law, in particular 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, which determines, inter alia, the various exclusive rights conferred on copyright holders, in Articles 2 to 5 thereof, be interpreted as excluding from copyright protection works whose shape is necessary to achieve a technical result?
- In order to assess whether a shape is necessary to achieve a technical result, must account be taken of the following criteria:
 - The existence of other possible shapes which allow the same technical result to be achieved?
 - The effectiveness of the shape in achieving that result?
 - The intention of the alleged infringer to achieve that result?
 - The existence of an earlier, now expired, patent on the process for achieving the technical result sought?



1. Background

1. The two questions are asked by the referring Court in connection with an action brought by the creator of the twice-foldable bicycle known as the “Brompton” and by his assignee to assert their copyright over the bicycle in question against a third party selling a comparable article. As the shape of the Brompton is arguably necessary to reach the technical result that characterizes the bicycle, the Court asks whether this feature excludes copyright protection for the article and which criteria are relevant to assess, in this connection, whether a shape is necessary to achieve a technical result.
2. The issue concerning specifically the exclusion from copyright protection of works the shape of which is necessary to achieve a technical result and, more generally, the requirements for the protection of utilitarian articles and their shape has come before Member States’ Courts several times. The Belgian referring Court mentions a fairly recent case, dealing with the shape of a baby bottle (biberon).¹ Also Italian Courts have recently held that the shape of an iconic car (the Ferrari 250 GTO)² and motorbike (the Vespa)³ are copyright protected; even the shape of after-ski boots was deemed copyrightable.⁴

¹ Tribunal Liège 8 September 2008 (further referred to as *Biberon*) IRDI 2008, 409.

² Bologna Tribunal 20 June 2019 (order), *Ferrari s.p.a. v Design Modena s.r.l.*, 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

³ App. Torino 12 dicembre 2018, *Zhejiang Zhongneng Industry Group and Taizhou Zhongneng Import and Export Co. v Piaggio s.p.a.*, Torino Tribunal 6 April 2017, *Zhejiang Zhongneng Industry Group and Taizhou Zhongneng Import and Export Co. v Piaggio s.p.a.*, in *Giur. ann. dir. ind.* 6528. The matter has been dealt with, from a different angle (a challenge to the validity of the later Community design based on prior Italian designs and trade marks, as well as copyright), by EU General Court 24 September 2019 (Sixth Chamber), Case T-219/18, *Piaggio & C. s.p.a. c. EUIPO e Zhejiang Zhongneng Industry Group Co. Ltd.*

⁴ Milano Tribunal 12 July 2016, *Tecnica Group s.p.a. v Gruppo Anniel s.n.c. di Simeoni Anna & C. and Gruppo Coin*

According to EU case law, the meaning and scope of the concept of a ‘work’ must be given an autonomous and uniform interpretation throughout the EU.⁵ Accordingly, the present referral frames the more specific issue concerning the exclusion from copyright protection of works the shapes of which are necessary to achieve a technical result in the context of the relevant EU norms and case law. The CJEU has dealt several times, directly and indirectly, both with the requirement of originality for the copyright protection of utilitarian articles and with the relevance for the corresponding assessment of the technical considerations, rules or constraints which may impact their features.⁶ The meaning and implication of provisions concerning exclusions from the protection of shapes depending on their technical necessity was dealt with by the CJEU also in other areas of intellectual property law and most recently in the specific context of Community designs with the *Doceram* ruling.⁷ This may explain why the referring Court chose to directly look at the recent CJEU judgment in *Doceram*, which concerned designs, in order to identify the criteria which may help in the assessment of the issue before it.

This approach appears to have some merit, at least in principle. Indeed, the exclusion from protection of shapes necessary to achieve a technical result is a common feature of trade mark law⁸, of design law⁹ and of some Member States’ unfair competition laws.¹⁰ The existence of this common approach, which is sometimes described as “negative convergence”,¹¹ is hardly surprising, as the corresponding rules, different as they may be in their specifics, are generally viewed as serving two common purposes. On the one hand they police the boundaries between the different intellectual property rights (IPRs) and, on the other hand, they pursue the procompetitive goal of preventing an IP right not intended to protect technical contributions from being inappropriately resorted to in order to obtain exclusive rights, and thereby opening the way to the monopolization of technical solutions or functional features and discouraging technological innovation.¹²

⁵ Among the many Court of Justice 12 September 2019 (Third Chamber), Case C-683/17, *Cofemel – Sociedad de Vestuário SA v G-Star Raw CV* (further referred to as *Cofemel*), para. 29; 13 November 2018 (Grand Chamber), Case C-310/17, *Levola Hengelo BV v Smilde Foods BV*, ECLI:EU:C:2018:899 (further referred to as *Levola*), para. 33.

⁶ Court of Justice 12 September 2019 (Third Chamber), *Cofemel*, para. 31; 2 May 2012 (Grand Chamber), Case C-406/10, *SAS Institute Inc. v World Programming Ltd* EU:C:2012:259 (further referred to as *SAS Institute*), paras 39-46; 1 March 2012 (Third Chamber), Case C-604/10, *Football Dataco Ltd., Football Association Premier League et alii v Yahoo! UK Ltd et alii* EU:C:2012:115 (further referred to as *Football Dataco*), para. 39; 1 December 2011, Case C-145/10, *Eva Maria Painer v Standard Verlags GmbH, Axel Springer AG, Süddeutsche Zeitung GmbH, Spiegel-Verlag Rudolf Augstein GmbH & Co KG, Verlag M. DuMont Schauberg Expedition der Kölnischen Zeitung GmbH & Co KG*, ECLI:EU:C:2011:239 (further referred to as *Painer*), paras 85 et seq.; 22 December 2010 (Third Chamber), Case C-393/09, *Bezpečnosti softwarová asociace – Svaz softwarová ochrany v Ministerstvo kultury* EU:C:2016:816 (further referred to as *BSA*), para. 48; 4 October 2011 (Grand Chamber), joined Cases C-403/08 e C-429/08, *Football Association Premier League, NetMed Hellas SA and Multichoice Hellas SA v QC Leisure, David Richardson, AV Station plc, Malcolm Chamberlain, Michael Madden, SR Leisure Ltd, Philip George Charles Houghton, Derek Owen; Karen Murphy v Media Protection Services* ECLI:EU:C:2011:631 (further referred to as *FAPL*), para. 98.

⁷ Court of Justice 8 March 2018 (Second Chamber), Case C-395/16, *Doceram GmbH v CeramTec GmbH* ECLI:EU:C:2018:172 (further referred to as *Doceram*).

⁸ Artt. 7(1)(e), second indent, CTMR and 4(e), second indent, EUTMD.

⁹ Artt. 8(1) CRDR and 7(1) Design Directive n. 98/71.

¹⁰ E.g. Italian Courts interpret Art. 2598, n. 1, of the Italian Civil Code on the basis of the concept that no slavish imitation can be found in connection with product shapes which are dictated by their technical function: see Trib. Milano 17 ottobre 2014, *Moonway.it di Jonathan Piran v H&S qualità nel Software s.p.a.*, in *Giur. ann. dir. ind.* 6253.

¹¹ See A Quaedvlieg, ‘Concurrence and Convergence in Industrial Design: Three-Dimensional Shapes excluded by Trade Mark Law’, in W Grosheide and J Brinkhof (eds), *Intellectual Property Law, Articles on Crossing Borders between Traditional and Actual* (Antwerpen, Intersentia 2004) 23 and more recently E. Derclaye and m. Leistner, *Intellectual Property Overlaps, A European Perspective*, Hart, 2011, 4.

¹² See in the field of design (C-395/17) *Doceram*, paras 29-30 and the Opinion of the AG Saugmandsgaard Øe, paras 38-39; in the field of trade marks, among others, Court of Justice, June 18 2002, Case C-229/99, *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* ECLI:EU:C:2002:377 (further referred to as *Philips*), paras 78 et seq. (stating at para. 82 that the corresponding ground for refusal “reflects the legitimate aim of not allowing individuals

However, this does not mean that the criteria which are appropriate to identify the exclusion in one area can automatically be extended to other areas, as discussed below.

2. Proposed Answers to Referred Questions

3. It is submitted that the CJEU has two options to answer the questions posed by the Liège Court.

Option 1 – Assessment of the exclusion from copyright protection of shapes necessary to achieve a technical result, based on criteria comparable to the ones provided for in the field of design law.

4. As noted by the referring Court, one of the (several) criteria used for the purpose of assessing whether the shape of an article is protected as a design, i.e. the test of multiplicity of forms, was originally adopted in design law but has occasionally also been extended – or transposed – to copyright law.¹³

It is however submitted that this approach is subject to two sets of reservations, of both general and specific character.

5. At a general and preliminary level, under international and EU law, the purpose and general scheme of protection of designs and copyright-protected works are markedly different. It is well established in EU jurisprudence that the goal of design law is the protection of the investment incurred in creating a design against imitation by competitors, whereas copyright aims to encourage creativity, *inter alia* by reserving the economic exploitation of works to creators and their assignees.¹⁴ It is also common ground that from these different purposes derive diverging mechanisms and principles employed in determining the scope of protection.¹⁵ Thus, while the delineation of the entitlements protected by copyright aims to avoid the monopolisation of ideas and to preserve creative freedom, design law in turn precludes protection for those visual features which are solely dictated by technical or functional consideration in order to preserve the availability of technical solutions and to prevent the hampering of technological innovation by exclusivity over such solutions.¹⁶
6. More specifically, the corresponding divergence in goals is also reflected at the level of eligible subject matter and access requirements. While in EU design law the exclusion of visual features or shapes necessary to achieve a technical result is additional to the two initial and separate requirements of novelty and individual character,¹⁷ in copyright law the absence of technical considerations, rules or constraints which dictate the solution and leave no room for creative freedom is not a separate requirement; rather it is an integral part of the notion of work adopted by EU law.¹⁸ Indeed, copyright is liable to apply only in relation to an expression (not an idea) which is original in the sense that it is its author's own intellectual

to use registration of a mark in order to acquire or perpetuate exclusive rights relating to technical solutions”), followed by Court of Justice 14 September 2010 (Grand Chamber), Case C-48/09 P, *Lego Juris A/S v OHIM and Mega Brands Inc.* ECLI:EU:C:2010:516 (further referred to as *Lego*), paras 43 et seq.. The pro-competitive purpose of the specific design provision, Art. 8(1) of the CRDR, is noted also by the referring Court at 12. Court of Justice 18 September 2014, Case C-205/13 *Hauck v Stokke*,

¹³ As related by the Referring Court, 13.

¹⁴ (Case C-683/17) *Cofemel*, para. 50 and the Opinion of the AG Szpunar, para. 55; (C-395/16) *Doceram*, para. 28 (in specific connection with the aims of design protection).

¹⁵ (Case C-683/17) *Cofemel*, para. 51 and the Opinion of the AG Szpunar, paras 56-57.

¹⁶ Art. 9(2) TRIPs.

¹⁷ Artt. 5, 6 and 8(1) CRDR.

¹⁸ Among the many (Case C-683/17) *Cofemel*, para. 29 and (Case C-310/17) *Levola*, para. 33.

creation,¹⁹ reflecting her personality and expressing her free and creative choices in the production of the work.²⁰ Conversely, features of an article which are solely dictated by technical or functional considerations leave no room for free and creative choices and therefore by definition fall outside the perimeter which may encapsulate an author's intellectual creation reflecting his personality.

7. Correspondingly, the test appropriate for assessing copyright eligibility must markedly differ from the tests adopted in design law. This is true in the case of the first criterion considered by the referring Court, known under the label of “multiplicity of forms” or of “alternative designs”, according to which a shape is not considered necessary to achieve a technical result if there is proof that other possible shapes are available which allow the same technical result.²¹ Now, asking whether a multiplicity of forms is available to enable a given technical result may, at least hypothetically, be a relevant question to establish whether the grant of exclusivity may lead to the monopolization *via* design law of technical solutions and to the hampering of technological innovation;²² but the reply to this query is never sufficient to supply an answer to the further and separate question whether the selection of that specific shape reflects an author's personality and expresses free and creative choices which may make that shape an author's intellectual creation. Indeed, while we may safely assume that if multiple forms are not available, this by definition rules out the possibility of free and creative choices, the obverse is not true. Even though multiple forms are available, there is no way to establish *a priori* that the selection between two or more alternative forms, each of which is technically conditioned, even though not altogether dictated, may be the result of free and creative choices and amount to the creation of a work.²³
8. As the criterion of multiplicity of forms would have arguably been satisfied in the case before the referring Court, due to the presence of alternative models of foldable bicycles,²⁴ the Belgian judges extended their inquiry to three other criteria listed in the second Question. In the domain of design law, a second approach suggests the adoption of a criterion sometimes referred to as the criterion of “causality”, or of the “only factor test” that, in the second Question, is described as “effectiveness of the shape”.²⁵ According to this criterion the exclusion from protection applies when the features of appearance of the shape in question are solely due to technical considerations, without regard to other considerations, be they of aesthetic character or otherwise.²⁶ This is again an approach which may be relevant in terms of monopolization of technical solutions and of adverse impact on technological innovation; and in fact was adopted in *Doceram*.²⁷ It appears however that also a solution based on causality is inappropriate when copyright eligibility is in question: once more, while a finding that the technical outcome was the only reason for the adoption of that shape may well be

¹⁹ Among the many (Case C-683/17) *Cofemel*, para. 29; (Case C-145/10) *Painer*, para. 87; Court of Justice 16 July 2009 (Fourth Chamber), Case C-5/08, *Infopaq International v Danske Dagblades Forening*, ECLI:EU:C:2009:465 (further referred to as *Infopaq I*), para. 37.

²⁰ Among the many also Court of Justice 7 August 2012 (Second Chamber), Case C-161/17, *Land Nordrhein-Westphalen v Dirk Renckhoff*, ECLI:EU:C:2018:634 (further referred to as *Renckhoff*), para. 14

²¹ The adoption of the criterion of the multiplicity of forms had been supported in connection with shapes necessary to achieve a technical result in the domain of design law, but not of trade mark law, by the Opinion of AG Ruiz-Jarabo Colomer in *Philips* (Case C-229/99), paras 32 et seq. (on the ground that protection *via* the latter, rather than the former, of technical solutions poses greater risks in view of the potentially infinite term of trade mark protection and of the marked dis-homogeneity in subject matters).

²² Except, of course, that the criterion of the multiplicity of forms was rejected by the CJEU (Case C-395/16) *Doceram*, para. 30, as it had been rejected in the domain of trade marks by (Case C-299/99) *Philips*, para. 81 and (Case C-48/09 P) *Lego*, paras 54 et seq.

²³ But for the opposite solution, in the specific circumstances of that case, *see* Tribunal Liège 8 September 2008, *Biberon*.

²⁴ As acknowledged by Referring Court, 13.

²⁵ The Referring Court is clearer at 12, referring there to “le critère de la causalité de la forme”.

²⁶ For a full illustration of the criterion and references *see* the Opinion of the AG Saugmandsgaard Øe, para. 21.

²⁷ CJEU (Case C-395/16) *Doceram*, paras 26 et seq.

conclusive in ruling out protection also in the copyright domain, the reverse does not hold true. Indeed, even though the solution was not exclusively dictated by a technical factor, it remains necessary to identify whether the technical constraints still enabled the designer to express her creative abilities by making free and creative choices in the selection of the shape. Moreover, an inquiry as to the subjective intent of the designer cannot be of any assistance on two grounds. First, it is difficult to imagine that such an inquiry may go a long way towards an assessment of eligibility for copyright protection, as an *ex post* inquiry as to the prevalence of technical or non-technical motivations and considerations is apt to raise more questions than it may answer; second, the corresponding approach is ruled out by the EU case law,²⁸ to which we turn now in the next §.

9. Indeed, the same reasoning may assist also in considering the third criterion mentioned by the referring Court. Actually, the third bullet point in Question 2 refers to the intent of the infringer. However, the context suggests that the query does not truly concern the intent of the infringer, which may be a factor for awarding damages, but should normally be irrelevant for a finding of infringement²⁹ and for deciding the eligibility for protection. This is even more so considering that the reasoning of the referring Court in its preliminary remarks, before framing the Questions, refers to the intent of the designer (rather than of the infringer) in connection with its discussion of causality. To the extent that it is held that the question concerns, as suggested here, the identification of the intent of the designer in view of establishing the technical or non-technical nature of the motivations or considerations which suggested the adoption of a given feature, the conclusion is the same as suggested above: the subjective intention of the designer is not a workable criterion as it is extremely hard to detect and decipher *ex post*. This is even more so if we consider that reference to a subjective criterion such as the intent of a designer does not possess the certainty and objectivity required for the purpose of establishing the existence of a “work”.³⁰ Therefore, it would appear that also this third criterion is not of any assistance.
10. The fourth and final criterion may be of some help, but only occasionally. The existence of a prior, now expired, patent on the process for achieving the technical result sought, may, but need not be relevant to rule out creativity. It all depends on the relationship between the patent and the relevant features of the shape necessary to achieve a technical result. The practice has repeatedly dealt with situations where the patent concerned details crucial for the functioning of a product which did not affect its overall shape.³¹ So this criterion may at best play an auxiliary role.
11. Therefore, on the whole resort to Option 1 does not seem to provide satisfactory and comprehensive replies to the Questions posed by the referring Court.

²⁸ (Case C-683/17) *Cofemel*, paras 32-34 and 53; (Case C-310/17) *Levola*, paras. 41-42.

²⁹ Which is normally based on strict liability except in exceptional circumstances, as shown in Court of Justice 8 September 2016 (Second Chamber), case C-160/15, *GeenStyl Media v Sanoma Media Netherlands BV, Playboy Enterprises International Inc., Britt Geertruida Dekker*, paras. 47 et seq. and, under Canadian patent law, *Monsanto Canada Inc v Schmeiser* [2004] 1 S.C.R. 902, 2004 SCC 34.

³⁰ (Case C-683/17) *Cofemel*, paras 32-34 and 53; (Case C-310/17) *Levola*, paras. 41-42.

³¹ App. Milano 30 November 2012, *Perfetti van Melle s.p.a. and Enrique Bernat v Haribo Italia s.p.a.*, in *Giur. ann. dir. ind.* 6011. This approach is consistently applied throughout EU case law: see (Case C-310/17) *Levola* the party unsuccessfully claiming copyright protection held patents; but the occurrence was only mentioned in passing by the Court (at para. 15); (Case C-48/09 P) *Lego*, paras 84-85; General Court 24 October 2019 (Tenth Chamber), case T-601/17, *Rubik's Brand Ltd. v EUIPO and Simba Toys*, para. 52; in EUIPO design case law see *Nintendo v Compatinet (R 1772/2012-3 — game cartridges)*, 14 April 2014 at [30] and EUIPO invalidity decision No ICD 10 735, *Dinopol Sp. z o.o., v Brødrene Hartmann A/S*.

Option 2 – Resort to a copyright-specific test based on the EU law notion of work

12. After exploring Option 1 and finding it on the whole scarcely helpful and acceptable, we now turn to consider whether a more apt solution may be found by resorting to the principles and criteria which are specifically provided by copyright law to assess utilitarian articles, such the foldable bicycle in question, when their shape happens to be necessary to achieve a technical result (Option 2). We find this latter, copyright-specific approach much more promising than the previous one.
13. The specificity of the copyright approach in providing replies to the two Questions raised by the referring Court links back to the preliminary notions discussed above (in §§ 5-7), when contrasting the respective purpose and general schemes of copyright and design laws. Accordingly, the reply is to be found in a rule that is a direct and plain consequence of the autonomous EU notion of “work”, which requires an expression which is original in the sense that, to be such, the work must be its author’s own intellectual creation.³² In this perspective, shapes necessary to achieve a technical result are not eligible for copyright protection if and when the necessity of achieving a given technical result does not leave enough room for sufficiently free and creative choices of the person deciding the features of the article³³ and therefore does not put that person in a position to express his creative abilities in making the relevant choices.³⁴
14. It may be noted that the rule proposed here also has a clear pro-competitive rationale, which is aligned with the rationales underlying the comparable rules to be found in trade mark, design and unfair competition laws. However, even in this regard copyright law exhibits a clear specificity *vis-à-vis* design law and the other rules which embody what has been called “negative convergence”.

The purpose behind the rule proposed here in assessing copyright eligibility is primarily *to avoid the monopolisation of an idea*,³⁵ rather than of a technical solution. As the case law of the CJEU put it in *SAS*, to accept that a functional feature is eligible for copyright protection “would amount to making it possible to monopolise ideas”.³⁶ This outcome is contrary to the fundamental principle supporting the dichotomy between ideas and expression which is at the basis of international (article 9(2) of the TRIPs agreement) and EU copyright law: copyright covers only individual expression of the work precisely in order “to leave other authors the desired latitude” to create alternative works.³⁷ Of course, refusal to grant copyright protection to functional features, such as shapes necessary to achieve a technical result, which do not leave sufficient room for free and creative choices, may also serve at the same time an ancillary purpose: to prevent copyright protection from serving as a backdoor for design protection or other technical protections such as patent or utility models. Welcome as this result may be, this amounts to a positive, but incidental, by-product of the application of the rule. Nevertheless, this outcome is not the primary purpose of the overarching principle whereby the criterion of originality is not met when the different methods of implementing an idea are so limited that the idea and the expression become indissociable.³⁸

³² Among the many (Case C-310/17) *Levola*, paras 36-37; (Case C-683/17) *Cofemel*, para. 29; (Case C-145/10) *Painer*, para. 87; (Case C-5/08), *Infopaq I*, para. 37.

³³ (Case C-604/10) *Football Dataco*, para. 39; (joined Cases C-403/08 e C-429/08) *FAPL* para. 98.

³⁴ (Case C-145/10) *Painer*, para. 89.

³⁵ (Case C-406/10) *SAS*, para. 40; the point was made in specific connection with computer programs, but is liable to apply across the board.

³⁶ (Case C-406/10) *SAS*, para. 40.

³⁷ (Case C-406/10) *SAS*, para. 41.

³⁸ (Case C-393/09) *BSA*, para. 49; see also Court of Justice 29 July 2019 (Grand Chamber), case C-469/17, *Funke Medien NRW GmbH v Bundesrepublik Deutschland*, paras 23-24.

15. It should not be feared that the adoption of the rule proposed under Option 2 might lead to discrimination against authors of utilitarian articles. As discussed at some length on previous occasions,³⁹ utilitarian products – and the shapes and other features of articles – may well reflect their authors’ personalities, even though they may at the same time serve functional purposes (as emphasized by the CJEU in *Painer* in connection with photographs);⁴⁰ but this is so only to the extent the pursuit of the desired technical result still leaves enough room for free and creative choices and as long as expression and idea do not merge.
16. It is suggested that some operational guidance might be useful for the situation in which Member States’ Courts are called to determine the conditions under which shapes which, while not strictly necessary to achieve a technical result, still contribute to achieving a technical result are eligible for copyright protection. The starting point for the corresponding assessment is that even in connection with utilitarian works the level of originality required to qualify as a “work” and to trigger copyright protection is as a rule quite low.⁴¹ However, copyright law exhibits a few characteristic features which have to be taken into account when its protection is applied to utilitarian articles and their shapes. To begin with, the term of protection of copyright is much longer than all other IP-based exclusive rights, with the sole exception of trade marks, the protection of which is potentially perpetual. Further, third parties are not given any notice, as the system – as yet – does not provide any form of registration or publicity for protected works, even though exclusivity extends for a long period. These twin features – long term protection and lack of publicity – may on the whole be welcome or at least acceptable for traditional copyright protected artifacts; but they may raise significant challenges when copyright protection applies to mass-produced articles manufactured industrially, as it is in the case of utilitarian articles.
17. It would therefore appear that a necessary implication of adopting the rule proposed under Option 2 is that a special degree of caution is to be used when assessing the eligibility for copyright protection of utilitarian articles, including those the shapes of which may contribute to a technical result or may be necessary to achieve it.⁴² Once more, this special degree of caution should in no way amount to discrimination against utilitarian articles and the shapes thereof; rather it is required in order to surmount the challenges referred to in the previous paragraph. Even more to the point, this special degree of caution is a necessary implication of the different purposes and schemes of protection which respectively characterize copyright and design law.
18. It is suggested that this special and enhanced degree of caution should be employed both in the positive and in the negative part of the exercise which deals with copyright eligibility of shapes of articles which may contribute to achieve a technical result.

In its positive part, the exercise should make sure that, when making that assessment in connection with shapes which contribute to achieving a technical result or may be necessary for it, due account is taken of the specific arrangement or configuration of all components which go into the relevant shape of the utilitarian article in order to evaluate whether and to which extent they meet the criterion of originality.⁴³ In that regard, it should be kept in mind

³⁹ This point is further discussed, with additional references, in *Opinion of the European Copyright Society in relation to the pending reference before the CJEU in Cofemel v G-Star*, C-683/17, 2018 (hereafter referred to as *ECS Opinion in re Cofemel*) available at https://europeancopyrightsocietydotorg.files.wordpress.com/2018/11/ecs-opinion-cofemel_final_signed.pdf and https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3309665

⁴⁰ (Case C-145/10) *Painer*, paras 88, 89.

⁴¹ (Case C-683/17) Opinion of the AG Szpunar, para. 57; (Case C-604/10) *Football Dataco*, para. 33; further references in *ECS Opinion in re Cofemel*, para. 2. Under one reading of *Cofemel* (Case C-683/17), the possibility for Member States to set an additional – and higher – threshold for utilitarian articles has been rejected by the Court; it may be possible, however, to read the judgement as rejecting an alternative, rather than additional, criterion. Be it as it may, the current uncertainty makes the need for guidance (and caution) suggested in the text even more compelling.

⁴² Following the suggestion made by Opinion of the AG Szpunar in *Cofemel* (Case C-683/17), para. 54.

⁴³ As held, almost literally, except for the variations depending on context, in (Case C-393/09) *BSA*, para. 48.

that that criterion cannot be met by components or arrangements or configurations which are differentiated only by their technical function,⁴⁴ which, in this context, means they are dictated by the technical result to be achieved. In a copyright perspective, this implies that the expression of those components, or arrangements and selection of components, which is dictated by their technical function, or by the technical result to be achieved, cannot meet the criterion of originality required for copyright eligibility, since the difference in the methods of implementing an idea are so limited that the idea and expression turn out to be indissociable.⁴⁵

In its negative part, the exercise should be directed towards identifying features which are *not* individual expression and which cannot be protected to ensure that *ideas*, rather than expressions, are not appropriated or monopolized.⁴⁶ This is necessary, as the reason for which copyright covers only the expression is to be found in the fundamental objective of copyright law that “other authors” are to be left “the desired latitude” to create other expressions.⁴⁷ This side of the exercise may also help in clarifying once more one of the major differences between the respective rationales of copyright and design law: while the exclusion provided in the latter in connection with shapes necessary to achieve a technical result is intended to prevent the appropriation of technical solutions, the assessment of the eligibility of functionalities under copyright is intended to prevent the appropriation of ideas.

19. It is also submitted that the suggested exercise for assessing copyright eligibility of shapes which contribute to achieving a technical result, or are necessary for the result, may be formalized as a two-step test. The first step in the test should be directed towards asking whether the criterion of originality is met in accordance with the various requirements discussed above.⁴⁸ While this first step risks remaining a little too vague and “verbal”, e.g. because it is not so easy to establish when in the specific circumstances of the case the choices are in fact free and creative, the second would appear to have much sharper teeth. The question whether granting copyright protection to the entities for which it is claimed would leave other creators “the desired latitude” in coming up with alternative shapes or, in the alternative, would monopolize one whole range of expressions, is precise enough. Such a test may, it is also submitted, be further clarified – and sharpened – if one keeps in mind the simple, but at the same time very significant, concept, discussed in the previous paragraph: that in copyright law the issue is not so much whether the technical solution is monopolized, but whether an *idea* is exclusively appropriated.
20. There is a final strand which should be picked up before concluding, which again is suggested when comparing design and copyright law. In design law, the degree of freedom available to the designer of shapes of a product is taken into account not only to determine whether the features in question are protectable under Art. 8(1) CRDR, but also to establish the scope of protection under Art. 10(2) CRDR. According to this provision, “In assessing the scope of protection, the degree of freedom of the designer in developing his design shall be taken into consideration”. Thus, the relevance of the degree of freedom of the designer is not only binary, leading to a “Yes or No” finding on the issue of eligibility; rather the evaluation whether the technical result to be achieved influences to a greater or lesser degree the ability of the designer to make free choices is also taken into account at the infringement stage. This means that as far as design law is concerned, even when protection has been found to be available, its scope may be adjusted by a process of weighing the creative contribution offered by the design. Thus, some features, which are more functional and directly conditioned by the

⁴⁴ As held, almost literally, except for the variations depending on context, in (Case C-393/09) *BSA*, para. 48

⁴⁵ As held, almost literally, except for the variations depending on context, in (Case C-393/09) *BSA*, para. 49

⁴⁶ (Case C-406/10) *SAS*, para. 40; this reasoning is implicit also in Opinion of the AG Szpunar in *Cofemel* (Case C-683/17), para. 60.

⁴⁷ (Case C-406/10) *SAS*, para. 41.

⁴⁸ See above §§ 2, 5-7 and 13-14.

technical result, must be given less weight for a finding of infringement, while others will be given more weight as expression of personal choices of the designer rather than the direct or indirect consequence of technical constraints. The same principle applies in all the other areas of IP. It is suggested that a clarification to the same effect is needed also in connection with copyright-protected works. It is true that at first glance, the Questions asked by the referring Court explicitly refer to eligibility for protection, not to scope. However, it would appear that the former implies the latter: there is a direct link between the delineation of what is protectable and what is not, on the one hand, and the scope of the exclusive right conferred. Indeed, the idea/expression dichotomy affects both eligibility and scope of protection. After all the referring Court asks questions about the “criteria” which are broad enough to encompass scope of the protection to be granted.

21. Moreover, a clarification would turn out to be especially welcome, as parts of the *Painer* holding leave open the possibility of a misunderstanding. There the Court rejected the view that “the extent of such protection should depend on possible differences in the degree of creative freedom in the production of various categories of works”;⁴⁹ but, contrary to a widely held belief, it did not rule out the possibility that differences in the degree of creative freedom depending on the presence of constraints (here: technological) should be taken into account also in determining the scope of protection, besides eligibility. It is therefore suggested that the Court also addresses this area which in previous cases may have remained in a sort of penumbra. This goal may be easily reached by pointing out that features of the shape of an utilitarian article, which are functional and directly conditioned by the technical result to be achieved, will be given no weight or, depending on the circumstances, at least less weight for a finding of infringement than those which are the result of free choices of the creator and reflect his personality.
22. It is true that, as acknowledged on a previous occasion,⁵⁰ the delineation of the scope of protection may, in practice, turn out to entail a difficult task. Indeed, it may be somewhat problematic to restrict protection to non-functional and non-technical features at the infringement stage. However, it would appear that copyright law cannot abdicate from that task. Once more a comparison between copyright and design law may help to underline the significance of this point. In design law the controlling notion for a finding of infringement is given by the concept of general impression. Indeed, according to Art. 10(1) CRDR “The scope of the protection conferred by a Community design shall include any design which does not produce on the informed user a different overall impression.” As recently stressed, this notion is foreign to copyright.⁵¹ In EU copyright, infringement does not require that the entire work is taken; infringement is already triggered by the taking of “parts” of a work. This is however the case only if, when and to the extent these parts embody elements or components which are the expression of free and creative choices which reflect the personality of their author.⁵² This is the reason why scope particularly matters in connection with shapes of an utilitarian article which may serve to achieve a technical result: it is only the parts which are individual expression of the author’s personality which matter in a finding of infringement; and even then only if the “parts” in question are “taken” rather than used as a source of inspiration.⁵³ This may entail, as said, a quite daunting task; which makes it even more appropriate for the Court to give adequate guidance to the Member States’ Courts, which will ultimately be called to rule on the specifics of the case.

⁴⁹ (Case C-145/10) *Painer*, para. 97.

⁵⁰ ECS *Opinion in re Cofemel* para. 17.

⁵¹ Opinion of the AG Szpunar in *Cofemel* (Case C-683/17), para. 63.

⁵² In accordance with Case C-5/08 (*Infopaq I*), para. 38.

⁵³ As indicated in para. 62 of the Opinion of the AG Szpunar in *Cofemel* (Case C-683/17).

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