



Reports of Cases

OPINION OF ADVOCATE GENERAL
M. CAMPOS SÁNCHEZ-BORDONA
delivered on 6 February 2020¹

Case C-833/18

SI,
Brompton Bicycle Ltd.
v
Chedech / Get2Get

(Request for a preliminary ruling from the Tribunal de l'entreprise de Liège (Companies Court, Liège, Belgium))

(Reference for a preliminary ruling — Intellectual and industrial property — Patent law — Designs — Regulation (EC) No 6/2002 — Harmonisation of certain aspects of copyright and related rights — Directive 2001/29/EC — Scope — Cumulation of rights — Utilitarian and functional object — Concept of 'work' — Appearance dictated by the technical function of the object — National court's assessment criteria — Conflicting interests — Proportionality — Folding bicycle)

1. The dispute before the referring court is between the creator of a folding system for bicycles (and the undertaking which manufactures the bicycles) and a Korean company which produces similar bicycles and which the former accuses of infringement of its copyright.
2. The referring court must determine whether a bicycle whose folding system was protected by a patent which has now expired can be classified as a work eligible for copyright protection. In particular, that court seeks to determine whether such protection is precluded where the shape of the object 'is necessary to achieve a technical result' and what criteria it must use when conducting that assessment.
3. Although the reference for a preliminary ruling is concerned with the European Union provisions on copyright, it has a bearing on a matter (the compatibility of typical copyright protection with the protection derived from industrial property) on which the Court of Justice has recently ruled.²

¹ Original: Spanish.

² Judgment of 12 September 2019, *Cofemel-Sociedade de Vestuário, S.A.*, C-683/17, EU:C:2019:721 ('judgment in *Cofemel*').

I. Legal framework

A. *International law*

1. *Berne Convention*³

4. In accordance with Article 2(1) and (7):

‘(1) The expression “literary and artistic works” shall include every production in the literary, scientific and artistic domain, whatever may be the mode or form of its expression, such as ... works of applied art ...

...

(7) Subject to the provisions of Article 7(4) of this Convention, it shall be a matter for legislation in the countries of the Union to determine the extent of the application of their laws to works of applied art and industrial designs and models, as well as the conditions under which such works, designs and models shall be protected. Works protected in the country of origin solely as designs and models shall be entitled in another country of the Union only to such special protection as is granted in that country to designs and models; however, if no such special protection is granted in that country, such works shall be protected as artistic work.’

2. *TRIPS Agreement*

5. Under Article 7:

‘The protection and enforcement of intellectual property rights should contribute to the promotion of technological innovation and to the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations’.

6. In accordance with Article 26:

‘1. The owner of a protected industrial design shall have the right to prevent third parties not having the owner’s consent from making, selling or importing articles bearing or embodying a design which is a copy, or substantially a copy, of the protected design, when such acts are undertaken for commercial purposes.

...’

7. Article 27 provides:

‘1. ... patents shall be available for any inventions, whether products or processes, in all fields of technology, provided that they are new, involve an inventive step and are capable of industrial application. ...

³ Convention for the Protection of Literary and Artistic Works, signed in Berne on 9 September 1886 (Paris Act of 24 July 1971), amended on 28 September 1979. The European Union is not a party to that Convention but it is a party to the Agreement on Trade-Related Aspects of Intellectual Property Rights in Annex 1C to the Marrakesh Agreement establishing the World Trade Organization, signed in Marrakesh on 15 April 1994 (‘TRIPS Agreement’), approved on behalf of the European Union by Council Decision 94/800/EC of 22 December 1994 concerning the conclusion on behalf of the European Community, as regards matters within its competence, of the agreements reached in the Uruguay Round multilateral negotiations (1986-1994) (OJ 1994 L 336, p. 1), Article 9(1) of which requires the contracting parties to comply with Articles 1 to 21 of the Berne Convention.

...'

8. Article 29 reads:

'1. Members shall require that an applicant for a patent shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art and may require the applicant to indicate the best mode for carrying out the invention known to the inventor at the filing date ...

...'

B. EU law

1. Directive 2001/29/EC⁴

9. Recital 60 states:

'The protection provided under this Directive should be without prejudice to national or Community legal provisions in other areas, such as industrial property, data protection, conditional access, access to public documents, and the rule of media exploitation chronology, which may affect the protection of copyright or related rights.'

10. Articles 2 to 4 require Member States, inter alia, to ensure that authors have exclusive rights to authorise or prohibit reproduction of their works (Article 2(a)), to authorise or prohibit communication to the public of their works (Article 3(1)) and to authorise or prohibit distribution of their works (Article 4(1)).

11. Article 9 ('Continued application of other legal provisions') provides:

'This Directive shall be without prejudice to provisions concerning in particular patent rights, trade marks, design rights ...'

2. Regulation (EC) No 6/2002⁵

12. Recital 10 is worded as follows:

'Technological innovation should not be hampered by granting design protection to features dictated solely by a technical function. ...'

13. Recital 32 reads:

'In the absence of the complete harmonisation of copyright law, it is important to establish the principle of cumulation of protection under the Community design and under copyright law, whilst leaving Member States free to establish the extent of copyright protection and the conditions under which such protection is conferred'.

⁴ Directive of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society (OJ 2001 L 167, p. 10).

⁵ Council Regulation of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1).

14. Article 3(a) defines the term ‘design’ as:

‘the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation’.

15. Article 8 states:

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

...’

16. Article 96 (‘Relationship to other forms of protection under national law’) provides in paragraph (2):

‘A design protected by a Community design shall also be eligible for protection under the law of copyright of Member States as from the date on which the design was created or fixed in any form. The extent to which, and the conditions under which, such a protection is conferred, including the level of originality required, shall be determined by each Member State’.

3. *Directive 2006/116/EC*⁶

17. Article 1(1) (‘Duration of authors’ rights’) provides:

‘The rights of an author of a literary or artistic work within the meaning of Article 2 of the Berne Convention shall run for the life of the author and for 70 years after his death, irrespective of the date when the work is lawfully made available to the public.’

II. Background to the dispute and the questions referred for a preliminary ruling

18. In 1975, Mr SI created a design for a folding bicycle, which he named Brompton.

19. The following year, Mr SI founded Brompton Ltd. for the purpose of marketing his folding bicycle in collaboration with a larger undertaking which would deal with manufacturing and distributing the bicycle. Mr SI did not find any undertakings that were interested and therefore he continued to work alone.

20. In 1981, Mr SI received his first order for 30 Brompton bicycles, which he manufactured with an appearance that was slightly different from the original.

⁶ Directive of the European Parliament and of the Council of 12 December 2006 on the term of protection of copyright and certain related rights (OJ 2006 L 372, p. 12).

21. After that, Mr SI expanded his company's activities to increase awareness of his folding bicycle design which, since 1987, has been marketed in the following form:



22. Brompton Ltd. was the holder of a patent for its bicycle's folding mechanism (the main feature of which is that it has three positions: unfolded, stand-by and folded); that patent later fell into the public domain.⁷

23. Mr SI also asserts that he holds the economic rights arising from the copyright in the appearance of the Brompton bicycle.

24. The Korean company Get2Get, which specialises in the production of sports equipment, produces and markets a bicycle which also folds into three different positions (Chedech) and is similar in appearance to the Brompton bicycle:



25. Brompton Ltd. and Mr SI took the view that Get2Get had infringed their copyright in the Brompton bicycle and, therefore, they brought an action against that company before the referring

⁷ The patent application was filed on 3 October 1979 and the grant of the patent was published on 15 April 1981 with the number 00 26 800 (annex 12 to the observations of Mr SI and Brompton Ltd.).

court, from which they sought, in essence: (a) a ruling that Chedech bicycles, irrespective of the distinctive signs affixed to those bicycles, infringe Brompton Ltd.'s copyright and Mr SI's non-pecuniary rights in the Brompton bicycle, and (b) an order to cease the activities which breach their copyright and to withdraw the product from the market.⁸

26. Get2Get submitted that the appearance of its bicycle was dictated by the technical solution sought and that it deliberately adopted the folding technique (previously covered by Brompton Ltd.'s patent, which subsequently expired) because that was the most functional method. Get2Get maintains that that technical constraint dictates the appearance of the Chedech bicycle.

27. Brompton Ltd. and Mr SI countered that there are other bicycles on the market which fold into three positions and are different in appearance from their own, from which it follows that they have copyright over their bicycle. The appearance of the bicycle demonstrates the existence of creative choices on their part and, therefore, originality.

28. In those circumstances, the referring court has referred the following questions to the Court of Justice for a preliminary ruling:

- (1) 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?
- (2) 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?

III. Procedure before the Court of Justice

29. The order for reference was received at the Court of Justice on 14 June 2018.

⁸ Specifically, the application for cessation referred to the Chedech bicycles at issue and any folding bicycle which exhibits the following original features of the Brompton bicycle:

(i) In the unfolded position:

- the shape of the main frame, as characterised by a curved main tube and a rear triangular section; and/or
- the shape of the rear frame, as characterised by a slender, right-angled triangle curved at one of the lower corners and with a suspension component at the top corner; and/or
- the appearance of the chain tensioner mechanism; and/or
- the loose cables.

(ii) In the stand-by position:

- the position of the triangular rear frame folded under the main frame and of the rear wheel which follows the curve of the main frame; and/or
- the appearance of the folded chain tensioner which takes up the slack in the chain.

(iii) In the folded position:

- the appearance of the rear frame, in which the rear wheel is secured so that it touches the lower part of the curved main tube; and/or
- the appearance of the front wheel, which is parallel to the main frame and rests on the ground; and/or
- the handlebar, which folds downwards, away from the bicycle.

...'

30. Written observations were lodged by Mr SI and Brompton Ltd., Get2Get, the Belgian and Polish governments and the Commission. The Commission and the parties to the main proceedings attended the hearing, held on 14 November 2019.

IV. Assessment

A. Preliminary observations

31. The referring court frames its questions in relation to the protection of copyright in a work ‘whose shape is necessary to achieve a technical result’. The referring court only asks the Court of Justice for an interpretation of Directive 2001/29.

32. As explained above, the ‘work’ at issue in the dispute is a bicycle whose folding system was at one time protected by a patent right.

33. It is clear from reading the observations of Mr SI and Brompton Ltd.⁹ that the original appearance of that bicycle differs from that for which copyright protection is now sought, although both bicycles use the folding system.¹⁰

34. There is no indication in the order for reference that the Brompton bicycle was protected as a design for industrial application. Nor does the referring court mention the national or EU provisions which govern (national or Community) designs.

35. Although in 1987 it was only possible to claim protection as a national design, there was nothing to preclude the Brompton bicycle from subsequently benefitting from protection under the legal provisions applicable to designs,¹¹ laid down in Directive 98/71/EC¹² or in Regulation No 6/2002. The latter also provides for ‘[Community] protection [as a] short-term unregistered design’.¹³

36. The response to the reference for a preliminary ruling cannot overlook the difficulties related to cumulative protection (as intellectual property, on the one hand, and as industrial property, on the other), which I shall now go on to discuss. I believe that it is therefore preferable to consider those difficulties in the event that only the folding system was protected by a patent and in the event that the appearance of the bicycle was protected as an industrial design.

37. Despite their different subject matter,¹⁴ both concepts (patents and designs) have certain features in common which it is useful to set out:

- Both have a practical application: protection as an industrial design is associated with the performance of acts for commercial purposes, whilst that of the inventive step inherent in a patent is linked to its capacity for industrial application.

⁹ Paragraphs 148 and 153 and annex 12 (documents for patent EP 00 26 800).

¹⁰ They confirmed at the hearing that they are not seeking to extend protection of the technical functionality of the folding mechanism, which was originally protected by the patent.

¹¹ The applicants acknowledged at the hearing that they were not seeking protection of the bicycle’s appearance as a design.

¹² Directive of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs (OJ 1998 L 289, p. 28).

¹³ Recital 17 and Article 11 of Regulation No 6/2002. The protection of unregistered designs was not harmonised in Directive 98/71, although Article 16 of that directive referred to national legal systems.

¹⁴ Whereas a patent right concerns the invention of a product or process, a design right covers ‘the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation’ (Article 3(a) of Regulation No 6/2002).

- Publication goes hand in hand with patents, which must be registered, and with designs. However, the latter are eligible for protection only if they are new, and protection is achieved by formal registration or, where a design has not been registered, when it has first been made available to the public (Article 5 of Regulation No 6/2002).
- Patents and designs have the common objective of promoting innovation,¹⁵ as is made clear by Regulation No 6/2002,¹⁶ in relation to designs, and Regulation (EU) No 1257/2012,¹⁷ in relation to patents.

38. The answers to the questions from the referring court must be placed in a more general context, which takes account of the different subject matter of, and the aims pursued by, industrial property protection and copyright protection, respectively, and the underlying interests of both.

39. The general-interest elements include the promotion of technology and the fostering of competition. The application of the principle of cumulation should not signify disproportionate protection of copyright, which would be detrimental to public interests by acting as a brake on the system for protection of industrial property rights.

40. The grant of a right of exclusive use to the holder of a patent right, or to the creator of a design, is aimed specifically at striking a balance between public and private interests:

- Inventors and designers are rewarded by the fact that they alone derive an economic benefit from their inventions and designs, for a specified period, which stimulates competition in the field of technology.¹⁸
- The public interest is offset by the fact that that creation becomes widely known so that other researchers can develop new inventions during the term of protection or, upon the expiry of that term, use that creation in their products.

41. That careful balance — which is most directly reflected in the short protection period granted to an inventor or designer — would be upset if the allotted term were simply extended to reach the generous periods afforded to copyright protection. Designers would lose the incentive to avail themselves of the industrial property system if, in return for lower costs and fewer procedural requirements (inter alia lack of registration), they were guaranteed copyright protection of their creations for a much longer term.¹⁹

42. The effect on legal certainty would also be far from negligible: the *official* publication required for industrial designs means that competitors know with certainty where the limits of their own industrial creations lie and how long their protection lasts.

¹⁵ Article 7 of the TRIPS Agreement provides that intellectual property rights should contribute ‘to the promotion of technological innovation and to the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations’.

¹⁶ Recital 7 states: ‘Enhanced protection for industrial design ... also encourages innovation and development of new products and investment in their production’.

¹⁷ Regulation of the European Parliament and of the Council of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection (OJ 2012 L 361, p. 1). According to recital 4 of that regulation, ‘unitary patent protection will foster scientific and technological advances and the functioning of the internal market ...’.

¹⁸ Without that exclusivity, the financial incentives to invest in applied research might be reduced.

¹⁹ At the hearing, the Commission argued that excessive copyright protection for industrial works would have the effect of ‘swallowing up’ the legal provisions governing designs which would, in fact, be rendered meaningless.

43. Leaving aside unregistered designs,²⁰ it is legitimate that the competitors of a person who has formally obtained an industrial property right should be able to rely on publication in the register in order to take advantage of the technical innovation recorded there once the rights of the registered holder have expired. Recital 21 of Regulation No 6/2002 acknowledges that ‘the exclusive nature of the right conferred by the registered Community design is consistent with its greater legal certainty’.²¹ On the contrary, if there is no registration at all, as occurs with copyright, economic operators lack certainty regarding the subject matter of intellectual creations for industrial purposes.

44. Those arguments are, in truth, simply variations on the same theme which was previously addressed by Advocate General Szpunar in his Opinion in *Cofemel*, to which I refer.²²

45. Lastly, a comparison of the aims and values pursued by two sets of legal provisions, namely, those governing industrial property and those governing copyright, must be conducted proportionately so as to prevent the excessive protection of the latter from leaving the former devoid of substance.

B. Cumulation of protection and its limits

46. Under EU law, legal protection as a design right may be enhanced by copyright protection. That was established, at the time, by Directive 98/71, Article 17 of which provides that designs (registered in each Member State) are also eligible for protection under the law of copyright. However, that article further provides that ‘the extent to which, and the conditions under which, such a protection is conferred, including the level of originality required, shall be determined by each Member State’.²³

47. The principle of ‘cumulation’ was then taken up in Article 96(2) of Regulation No 6/2002, which must be read in the light of recital 32 thereof as far as Community designs protected at EU level are concerned.

48. From the specific perspective of copyright protection, recital 60 of Directive 2001/29 states that ‘the protection provided under this Directive should be without prejudice to national or [EU] legal provisions in other areas’.

49. Therefore, ‘... Directive 2001/29 preserves the existence and scope of the provisions in force relating to designs, including the principle of “cumulation”’.²⁴

50. However, a number of doubts persisted with regard to the complementarity of those two protections. In particular, there was a debate about whether Member States could require industrial designs to fulfil more stringent originality criteria in order to be eligible for typical copyright protection.

51. The judgment in *Cofemel* confirmed, as a general rule, that ‘the protection of designs and the protection associated with copyright may ... be granted cumulatively to the same subject matter’.

52. However, that statement was followed by a number of clarifications which weaken, so to speak, or reduce the force of the principle of cumulation.

²⁰ I should point out that the rules laid down by Regulation No 6/2002, which covers unregistered designs, also require publication for the purposes of protection of such designs.

²¹ Recital 4 of Regulation No 1257/2012 explicitly uses the expression ‘legally secure’ when referring to the aims of unitary patent protection. Directive 2001/29 also refers to legal certainty in its preamble.

²² Case C-683/17, EU:C:2019:363.

²³ In that connection, see also recital 8 of Directive 98/71.

²⁴ Judgment in *Cofemel*, paragraph 47.

53. In the first place, ‘although the protection of designs and the protection associated with copyright may, under EU law, be granted cumulatively to the same subject matter, that concurrent protection can be envisaged only in certain situations’.²⁵

54. In the second place, the nature of the protection provided is different in each case. Whereas, in the case of designs, the aim is to prevent imitation by competitors, copyright has a different legal and financial function.²⁶

55. In the third place, the obtaining of copyright in subject matter which is already protected by a design right involves certain risks which should not be underestimated.²⁷ In particular, ‘the grant of protection, under copyright, to subject matter that is protected as a design must not have the consequence that the respective objectives and effectiveness of those two forms of protection are undermined’.²⁸

56. In the fourth place, it is for national courts to specify when one of the ‘certain situations’ which allow the cumulation of protections has actually arisen. Therefore, it is necessary in each case to define the balance between copyright protection and the general interest.

C. The first question referred for a preliminary ruling: the concept of ‘work’, the requirement of originality and the exclusion of copyright protection where the shape of a work is dictated by technical requirements

57. As a starting point, I refer again to the Opinion of Advocate General Spuznar in *Cofemel*, in which he examined both the Court’s case-law on the concept of work and the application of that case-law to designs.²⁹

58. I believe that that examination is sufficiently complete to ensure that no additional explanations on my part are needed. Furthermore, the judgment in *Cofemel* included that examination in its reasoning, defining the term ‘work’ as an autonomous concept of EU law.³⁰

59. From that case-law, I would like to draw attention now to the criterion of originality,³¹ to which the Court had already referred in earlier judgments,³² holding that it must reflect the personality of the work’s creator.³³

²⁵ Judgment in *Cofemel*, paragraph 52.

²⁶ Opinion of Advocate General Szpunar in *Cofemel* (C-683/17, EU:C:2019:363, point 55): ‘such protection against competition does not exist in the case of copyright. On the contrary, dialogue, inspiration and reformulation are inherent in intellectual creation and copyright is not intended to obstruct them. What copyright protects, in any event through economic rights, is the possibility of unfettered financial exploitation of the work as such’.

²⁷ *Ibid.*, point 52. The Advocate General drew attention to ‘the risk that the rules on copyright would exclude the *sui generis* rules intended to cover designs’. The Advocate General added that ‘that exclusion would have a number of negative effects: the devaluation of copyright, sought to protect everyday creations; the hindrance of competition as a result of the excessive duration of protection, and also legal uncertainty, in so far as competitors would not be able to anticipate whether a design whose *sui generis* protection had expired was not also protected by copyright’.

²⁸ Judgment in *Cofemel*, paragraph 51.

²⁹ Case C-683/17, EU:C:2019:363, points 23 to 32.

³⁰ Judgment in *Cofemel*, paragraphs 27 and 28.

³¹ Judgment in *Cofemel*, paragraph 30. Originality is one of the two essential criteria for the classification of a creation as a work. The other is that there must be ‘a subject matter that is identifiable with sufficient precision and objectivity’ (paragraph 32).

³² Paragraph 29 of the judgment in *Cofemel* cites the judgments of 16 July 2009, *Infopaq International*, C-5/08, EU:C:2009:465, paragraphs 37 and 39, and of 13 November 2018, *Levola Hengelo*, C-310/17, EU:C:2018:899, paragraphs 33 and 35 to 37.

³³ Judgment in *Cofemel*, paragraph 30: ‘if a subject matter is to be capable of being regarded as original, it is both necessary and sufficient that the subject matter reflects the personality of its author, as an expression of his free and creative choices (see, to that effect, judgments of 1 December 2011, *Painer*, C-145/10, EU:C:2011:798, paragraphs 88, 89 and 94, and of 7 August 2018, *Renckhoff*, C-161/17, EU:C:2018:634, paragraph 14)’.

60. One of the important contributions of the judgment in *Cofemel* is that it does not allow the originality of the purported ‘work’ (in that case, clothing) to be linked to its aesthetic elements. The Court refused to allow reliance on aesthetic factors as a ground for protection of a design by copyright, stating that ‘Article 2(a) of Directive 2001/29 ... must be interpreted as precluding national legislation from conferring protection, under copyright, to designs ... on the ground that, over and above their practical purpose, they generate a specific and aesthetically significant visual effect’.³⁴

61. Having excluded aesthetic effects, the issue is whether, in the assessment of originality as the basis for the existence of an intellectual creation of the author,³⁵ the requirements derived from the criterion relating to the achievement of a technical or functional result can be relied on as a ground for refusal to protect a work by copyright. The referring court specifically refers to that issue.

62. The Court has previously addressed that issue in relation to the protection of copyright in computer programs.³⁶

63. The Court held, specifically, that where the expression of the components of a subject matter ‘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’.³⁷ That situation does not permit ‘the author to express his creativity in an original manner and achieve a result which is an intellectual creation of that author’.³⁸

64. On the same lines, the Court has held that an author’s original intellectual creation is capable of copyright protection but that will not be the case where it is dictated by ‘technical considerations, rules or constraints which leave no room for creative freedom’.³⁹

65. It can be inferred from those rulings that, as a general rule, works (objects) of applied arts whose shape is dictated by their function cannot be protected by copyright. If the appearance of a work of applied art is *exclusively dictated* by its technical function, as a *decisive* factor, it will not be eligible for copyright protection.⁴⁰

66. The application of that rule to copyright is in line with the rule governing designs and trade marks:

- As regards designs (governed by Directive 98/71 or by Regulation No 6/2002),⁴¹ neither Article 8(1) of Regulation No 6/2002 nor Article 7 of Directive 98/71 confer rights on ‘features of appearance of a product which are dictated by its technical function’.⁴²

34 Mr SI and Brompton Ltd. contend in their observations that it suffices that the choice of the shape was dictated, at least to a certain extent, by one or more reasons other than purely functional reasons, such as, for example, aesthetic reasons (paragraph 67). They also refer to aesthetics in paragraphs 3, 5, 69 and 155 of those observations and state that that was their aim, in addition to the technical grounds. In their submission, the shape of the Brompton bicycle was not dictated solely by technical reasons linked to the folding mechanism but rather by purely aesthetic reasons.

35 Judgment of 16 July 2009, *Infopaq International*, C-5/08, EU:C:2009:465, paragraph 37.

36 Judgment of 22 December 2010, *Bezpečnostní softwarová asociace*, C-393/09, EU:C:2010:816.

37 *Ibid.*, paragraph 49.

38 *Ibid.*, paragraph 50.

39 Judgment of 1 March 2012, *Football Dataco and Others*, C-604/10, EU:C:2012:115, paragraph 39.

40 The terms used to describe that relationship can vary. Appearances or shapes ‘predetermined’, ‘imposed’, ‘exclusively dictated’ or ‘conditioned’ by their technical function are those in which that technical function is absolutely predominant.

41 It is logical that the same criterion should be applied to both types of design because recital 9 of Regulation No 6/2002 states: ‘The substantive provisions of this Regulation on design law should be aligned with the respective provisions in Directive 98/71/EC’.

42 In that connection, recital 10 of Regulation No 6/2002 states: ‘Technological innovation should not be hampered by granting design protection to features dictated solely by a technical function’.

– As regards EU trade marks, Article 7(1) of Regulation (EC) No 40/94⁴³ prohibits the registration as a trade mark of any sign consisting of the shape of goods which is necessary to obtain a technical result.

67. In short, designs whose shape is dictated by technical considerations which do not leave room for the exercise of creative freedom are not eligible for copyright protection. Conversely, where a design merely has a number of functional aspects, that does not deprive it of copyright protection.

68. That rule does not present significant difficulties where those technical considerations nullify, in practical terms, any room for creativity. The difficulties arise, however, where designs combine functional and artistic features. There is no reason, a priori, why such *mixed* designs should be excluded from copyright protection but that is what would occur, however, if the functional elements predominated over the artistic elements to the extent that the latter became irrelevant.⁴⁴

69. An analysis of the Court’s case-law on shapes associated with functional elements in relation to industrial property and trade mark law can provide, by analogy, a number of valid interpretative approaches in respect of copyright.

70. It is true that each of those three fields (designs, trade mark law and copyright) have their own features which mean that the legal provisions governing them cannot be treated identically. However, I do not believe there is any reason why the Court’s considerations concerning one of those fields 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.⁴⁵

71. In my view, the judgment of the Grand Chamber of 14 September 2010, *Lego Juris v OHIM*,⁴⁶ which interpreted the prohibition on registration as a trade mark of any sign consisting of the shape of goods which is necessary to obtain a technical result, stands out from that case-law.⁴⁷

72. The Court held that that prohibition ‘ensures that undertakings may not use trade mark law in order to perpetuate, indefinitely, exclusive rights relating to technical solutions’.⁴⁸

73. The Court further reasoned that ‘by restricting the ground for refusal set out in Article 7(1)(e)(ii) of Regulation No 40/94 to signs which consist “exclusively” of the shape of goods which is “necessary” to obtain a technical result, the legislature duly took into account that any shape of goods is, to a certain extent, functional and that it would therefore be inappropriate to refuse to register a shape of goods as a trade mark solely on the ground that it has functional characteristics. By the terms “exclusively” and “necessary”, that provision ensures that solely shapes of goods which only incorporate a technical solution, and whose registration as a trade mark would therefore actually impede the use of that technical solution by other undertakings, are not to be registered’.⁴⁹

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

44 Judgment of 8 March 2018, *DOCERAM*, C-395/16, EU:C:2018:172.

45 In his Opinion in *DOCERAM* (C-395/16, EU:C:2017:779), Advocate General Saugmandsgaard Øe proposed that very method in connection with the rule applicable to designs and the prohibition on registering as trade marks any signs consisting of the shape of goods which is necessary to obtain a technical result.

46 Case C-48/09 P, EU:C:2010:516 (‘judgment in *Lego Juris*’).

47 Ground for refusal laid down in Article 7(1)(e)(ii) of Regulation No 40/94.

48 Judgment in *Lego Juris*, paragraph 45.

49 *Ibid.*, paragraph 48.

74. Having set down that premiss, the Court made a number of important observations concerning ‘the presence of one or more minor arbitrary elements in a three-dimensional sign, all of whose essential characteristics are dictated by the technical solution to which that sign gives effect’:

- First, that factor ‘does not alter the conclusion that the sign consists exclusively of the shape of goods which is necessary to obtain a technical result’.⁵⁰
- Secondly, ‘... such a sign cannot be refused registration as a trade mark under that provision if the shape of the goods at issue incorporates a major non-functional element, such as a decorative or imaginative element which plays an important role in the shape’.⁵¹

75. As regards the concept of a shape necessary to obtain the technical result intended, the Court upheld the General Court’s view that ‘that condition does not mean that the shape at issue must be the only one capable of obtaining that result’.⁵² The Court added that ‘the existence of other shapes which could achieve the same technical result is not ... such as to exclude the ground for refusal of registration’.⁵³

76. In the light of those arguments, which I believe it is appropriate to apply by analogy to these proceedings, it is possible to respond to the referring court. That court appears to state that the appearance of the bicycle at issue was *necessary* to achieve the technical result,⁵⁴ which is a finding of fact that it alone can make. If, by that assertion, the referring court means that the relationship of exclusivity between appearance and functionality, to which I referred above, exists, the answer to the first question must be that it is not possible to grant copyright protection.

D. The second question referred for a preliminary ruling

77. The referring court seeks to determine, in particular, the possible effect, for the purposes of assessing the relationship between the conception of the shape of the object and the attainment of the technical result intended, of four specific factors, which it lists.

1. The existence of an earlier patent

78. Altering the order of those factors as they are set out in the order for reference, I will begin by examining what effect the existence of an earlier, subsequently expired, patent may have had.

79. In view of the application of the principle of cumulation, that factor by itself should not mean that the industrial property right takes precedence (especially if its effectiveness has come to an end) to the extent that it precludes copyright protection. The considerations I set out on the close relationship between patents and industrial designs, in relation to this matter,⁵⁵ suggest that that principle should also apply to objects protected by a patent.

⁵⁰ Ibid., paragraph 52.

⁵¹ Ibid., paragraph 52.

⁵² Ibid., paragraph 53.

⁵³ Ibid., paragraph 83.

⁵⁴ It states at the end of the order for reference that ‘the outcome of the present dispute depends on whether the existence of copyright ... is excluded where the appearance for which protection is sought is necessary in order to achieve a particular technical effect’.

⁵⁵ Point 37 of this Opinion.

80. However, from the perspective of the assessment criteria, I believe that the referring court is right to draw attention to that factor, which may have a twofold effect:

- First, a registered patent may serve to determine whether there were technical constraints which dictated the shape of the product. It is natural for the description of the design and its functionality to be set out in as much detail as possible in the registration documents for the patent (which, by definition, is intended for industrial application) because the scope of protection depends upon it.
- Secondly, the choice of a patent as the tool for protecting the activity of the person registering that patent permits the assumption that there is a close relationship between the shape patented and the result intended: to be exact, the shape is that which the inventor decided was effective to obtain the desired functionality.

2. *The existence of other possible shapes which allow the same technical result to be achieved*

81. The referring court asks what effects the existence of other possible shapes which allow the same technical result to be achieved may have. The referring court refers specifically to two opposing approaches, based on the so-called ‘multiplicity of forms theory’ and the ‘causality theory’.

82. Advocate General Saugmandsgaard Øe recently undertook a full examination of those two theories, as applied to designs, in his Opinion in *DOCERAM*.⁵⁶ I agree with the points he made and I therefore refer to them.

83. The judgment in *DOCERAM*, which accepted, in essence, the Advocate General’s Opinion (the referring court cites that judgment and the Opinion of the Advocate General),⁵⁷ ruled on the matter in the following terms:

- ‘In order to determine whether the features of appearance of a product are *exclusively* dictated by its technical function, it must be established that the technical function is the *only* factor which determined those features, *the existence of alternative designs not being decisive* in that regard’.⁵⁸
- However, there is nothing to prevent the court from taking into account the possible ‘existence of alternative designs which fulfil the same technical function’.⁵⁹ The latter is not, therefore, a conclusive factor but merely an additional assessment criterion.

84. A reading of that judgment emphasises, therefore, the fact that alternative solutions are *not decisive* when it comes to assessing the relationship of exclusivity between the features of appearance and the technical function of a product. However, that does not mean that any effect of such alternative solutions may be dismissed as a factor capable of affording room for intellectual creativity which leads to the same technical outcome.

⁵⁶ Opinion of 19 October 2017 in Case C-395/16, EU:C:2017:779.

⁵⁷ Even though the Court did not use, by analogy, the criteria applicable to the prohibition on the registration of trade marks and confined itself to the interpretation of Regulation No 6/2002, its considerations on the substance are, in fact, the same as those set out in the judgment in *Lego Juris*.

⁵⁸ Judgment in *DOCERAM*, paragraph 32 and operative part (no italics in the original).

⁵⁹ *Ibid.*, paragraph 37.

85. In the case of designs where the intersection of art and design is particularly striking, there will be greater opportunities for creative freedom⁶⁰ to shape the appearance of the product. As the Commission submitted at the hearing, the integration of formal and functional aspects in works of applied art should be examined in detail in order to determine whether the appearance of such works is wholly dictated by technical constraints. In certain cases, it will be possible to separate, at least in theory, aspects which reflect functional considerations from those which simply reflect the free (original) choices of the creator, which may be protected by copyright.⁶¹

86. I understand that these considerations may be considered rather theoretical and are perhaps not particularly helpful to the referring court, which is faced with the difficult task of determining which creative elements it is possible to protect in a bicycle whose functionality requires the presence of wheels, chain, frame and handlebars, whatever its shape may be.⁶²

87. In any event, from a perspective linked to the interpretation of the rule, rather than its application to a given situation, what matters is to recall that, for the Court of Justice, the answer to this part of the second question can be deduced from the judgment in *DOCERAM*.

88. The 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 whose creators seek to protect them by copyright.

3. *The intention of the alleged infringer to achieve that technical result*

89. In order for a court to assess whether, objectively, there has been an infringement, the *intention* of a person who places on the market, without authorisation, an object protected by copyright is not, in principle, relevant.

90. The fact that the *intention* of achieving a technical result can be assessed by evaluating the relationship between shape and functionality is a different matter. Logically, the producer of an object protected by a patent which has fallen into the public domain would have no aim other than obtaining the desired technical outcome.⁶³

91. However, in the light of the assertion that the shape of the design stems from a purely aesthetic, rather than a functional, decision, there is nothing to preclude someone who claims otherwise (that is, someone who has used that shape because it was dictated by strictly technical or functional constraints) from proving it.⁶⁴

92. When examining whether or not there is a right for the object to be protected as a work, the court is entitled to explore the inventor or designer’s original intention rather than that of the person who reproduces his invention or design.

60 The extent of copyright protection does not depend on the degree of creative freedom exercised by the author (paragraph 35 of the judgment in *Cofemel*).

61 In principle, the originality of a work is sufficient for that work to be eligible for copyright protection, without the need for additional criteria. The discretion of Member States to determine the ‘level of originality required’ (Article 17 of Directive 98/71) can be categorised as very limited or non-existent, in the light of the Court’s case-law, most recently the judgment in *Cofemel*.

62 The applicants have provided in their written observations three judgments given by three different courts (Groningen, of 24 May 2006; Bruges, of 10 June 2009; and Madrid, of 10 February 2010), which recognised the Brompton bicycle as being protected by copyright and disagreed that its appearance was dictated exclusively by its technical function.

63 Unregistered designs present more difficulties in that respect because the description that is part of the application for registration is not available.

64 In this case, it would be necessary to establish that the bicycle frame’s curved crossbar enables the wheels to fold more compactly or that it makes it tougher. That line of reasoning may be inferred from section III.A(3), fourth paragraph, of Get2Get’s observations.

93. For that purpose, account must be taken of the time when the invention or design was initially conceived⁶⁵ in order to assess whether its author was really seeking to achieve his own intellectual creation or whether, instead, he was seeking only to protect an idea applicable to the development of an original industrial product with a view to the mass production and sale of that product on the market. The fact that there has been an industrial application of the invention or design or that a commercial benefit has been obtained from it may provide evidence worthy of attention.

94. From that perspective, the fact that subsequent recognition of the design may also warrant its exhibition in museums does not appear to me to be relevant. That factor or others like it, such as the receipt of awards in the sphere of industrial design, confirms, rather, that its nature is that of an industrial object deserving of praise, or even admiration, in its own sphere, or that it has a number of important aesthetic components.

4. The effectiveness of the shape in achieving a technical result

95. The referring court does not provide enough information to understand the exact meaning of this part of the second question, about which that court provides no explanation.

96. Therefore, and because I believe that the above arguments are sufficient to describe the relationship between the shape of the product and its function or technical result, I have little more to add.

97. Logically, if the shape which the designer of the product (in this case, a bicycle) planned were not suitable for attaining the desired functionality, the requirement of future industrial application would not be satisfied. It must be assumed, therefore, that the proposed shape is effective for that purpose (in this case, for manufacturing a bicycle which can be ridden and be folded).

98. In any event, it is for the referring court to analyse that factor in the light of the evidence (particularly the expert evidence) presented to it.

E. Closing remark

99. The criteria for assessment of the relationship of exclusivity between the appearance of a product and its technical result are probably not confined to the four examined above. However, as Advocate General Saugmandsgaard Øe argued in his Opinion in *DOCERAM*,⁶⁶ it would not be appropriate to make an exhaustive or non-exhaustive list of those criteria in the abstract when, in reality, that assessment (which is factual in nature) is connected to a set of circumstances which are difficult to recognise a priori.

⁶⁵ The applicants in the main proceedings are of that view when they indicate the years 1975 and 1987 as temporal references (paragraph 89 of their observations). That is also the approach in the judgment in *DOCERAM*, which refers to ‘the objective circumstances indicative of the reasons which dictated the choice of features of appearance of the product concerned’ (paragraph 37).

⁶⁶ Opinion of 19 October 2017 in Case C-395/16, EU:C:2017:779, point 65: ‘There is no need ... to make a list of the relevant criteria, even a non-exhaustive one, given that the EU legislature did not envisage recourse to this method and that it would seem that the Court did not consider this appropriate in respect of the assessment, including of the facts, which must, moreover, be conducted’.

100. Lastly, I should add that the possible refusal to grant copyright protection would not preclude reliance on other provisions laid down to combat slavish or parasitic imitations. As the Commission stated at the hearing, although the legislation on unfair competition has not been fully harmonised at EU level,⁶⁷ it is capable of offering remedies for that undesirable situation.⁶⁸

101. By making that point, as I stated on a different occasion, ‘I am not seeking to prejudge the options which the referring court may find in its national law for the purposes of defining the conduct at issue. I am simply broadening, beyond the scope of trade mark law, the perspective from which to approach the procedural response to conduct which may be unlawful’.⁶⁹

V. Conclusion

102. In the light of the foregoing considerations, I propose that the Court of Justice should reply to the Tribunal de l’entreprise de Liège (Companies Court, Liège, Belgium) in the following terms:

- ‘(1) Articles 2 to 5 of 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 do not provide for copyright protection of creations of products with an industrial application whose shape is exclusively dictated by their technical function.
- (2) In order to determine whether the specific features of the shape of a product are exclusively dictated by its technical function, the competent court must take into account all the relevant objective factors in each case, including the existence of an earlier patent or design right in the same product, the effectiveness of the shape in achieving the technical result and the intention to achieve that result.
- (3) Where the technical function is the only factor which determines the appearance of the product, the fact that other alternative shapes exist is not relevant. On the other hand, the fact that the shape chosen incorporates important non-functional elements which were freely chosen by its creator may be relevant.’

⁶⁷ EU law has partially harmonised the legal provisions on unfair competition only in relation to the commercial practices of undertakings in their dealings with consumers. See Directive 2005/29/EC of the European Parliament and of the Council of 11 May 2005 concerning unfair business-to-consumer commercial practices in the internal market and amending Council Directive 84/450/EEC, Directives 97/7/EC, 98/27/EC and 2002/65/EC of the European Parliament and of the Council and Regulation (EC) No 2006/2004 of the European Parliament and of the Council (‘Unfair Commercial Practices Directive’) (OJ 2005 L 149, p. 22).

⁶⁸ I referred to that possibility in the Opinion in *Mitsubishi Shoji Kaisha* (C-129/17, EU:C:2018:292), points 90 to 95. The Court also referred to it, by way of an *obiter dictum*, in paragraph 61 of the judgment in *Lego Juris*: ‘the position of an undertaking which has developed a technical solution cannot be protected — with regard to competitors placing on the market slavish copies of the product shape incorporating exactly the same solution — by conferring a monopoly on that undertaking through registering as a trade mark the three-dimensional sign consisting of that shape, but can, where appropriate, be examined in the light of rules on unfair competition. Such an examination is, however, outside the scope of these proceedings’.

⁶⁹ Opinion in *Mitsubishi Shoji Kaisha* (C-129/17, EU:C:2018:292), point 95.