Reports of Cases

JUDGMENT OF THE COURT (Fifth Chamber)

11 June 2020*

(Reference for a preliminary ruling — Intellectual and industrial property — Copyright and related rights — Directive 2001/29/EC — Articles 2 to 5 — Scope — Utilitarian object — Concept of 'work' — Copyright protection of works — Conditions — Shape of a product which is necessary to obtain a technical result — Folding bicycle)

In Case C-833/18,

REQUEST for a preliminary ruling under Article 267 TFEU from the tribunal de l'entreprise de Liège (Companies Court, Liège, Belgium), made by decision of 18 December 2018, received at the Court on 31 December 2018, in the proceedings

SI,

Brompton Bicycle Ltd

v

Chedech/Get2Get,

THE COURT (Fifth Chamber),

composed of E. Regan, President of the Chamber, I. Jarukaitis, E. Juhász (Rapporteur), M. Ilešič and C. Lycourgos, Judges,

Advocate General: M. Campos Sánchez-Bordona,

Registrar: M. Longar, Administrator,

having regard to the written procedure and further to the hearing on 14 November 2019,

after considering the observations submitted on behalf of:

– SI and Brompton Bicycle Ltd, by B. Van Asbroeck, G. de Villegas and A. Schockaert, lawyers,

– Chedech/Get2Get, by A. Marín Melgar, abogado,

– the Belgian Government, by M. Jacobs, C. Pochet and J.-C. Halleux, acting as Agents,

– the Polish Government, by B. Majczyna, acting as Agent,

– the European Commission, by É. Gippini Fournier and J. Samnadda, acting as Agents,

* Language of the case: French.

after hearing the Opinion of the Advocate General at the sitting on 6 February 2020,

gives the following

Judgment

1 This request for a preliminary ruling concerns the interpretation 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 (OJ 2001 L 167, p. 10).

2 The request has been made in proceedings between SI and Brompton Bicycle Ltd ('Brompton'), on the one hand, and Chedech/Get2Get ('Get2Get'), on the other, concerning an action for copyright infringement brought against Get2Get.

Legal context

International law

Berne Convention for the Protection of Literary and Artistic Works

3 Article 2 of the Berne Convention for the Protection of Literary and Artistic Works (Paris Act of 24 July 1971), as amended on 28 September 1979 ('the Berne Convention'), states, in paragraphs 1 and 7 thereof:

'(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 drawing …; works of applied art; …

…

'(7) … it shall be a matter for legislation in the countries of the Union [for the protection of the rights of authors in their literary and artistic works established by the Berne Convention] 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 works.'

WIPO Copyright Treaty

4 On 20 December 1996 in Geneva, the World Intellectual Property Organisation (WIPO) adopted the WIPO Copyright Treaty, which was approved on behalf of the European Community by Council Decision 2000/278/EC of 16 March 2000 (OJ 2000 L 89, p. 6) and entered into force, as regards the European Union, on 14 March 2010 (OJ 2010 L 32, p. 1).

5 Article 1 of the WIPO Copyright Treaty, entitled 'Relation to the Berne Convention', provides in paragraph 4 thereof:

'Contracting Parties shall comply with Articles 1 to 21 and the Appendix of the Berne Convention.'

6 Article 2 of that treaty provides:

'Copyright protection extends to expressions and not to ideas, procedures, methods of operation or mathematical concepts as such.'

European Union law

Directive 2001/29

7 Articles 2 to 5 of Directive 2001/29 determine authors' exclusive rights as regards the reproduction, communication and distribution of their works.

8 Article 9 of that directive, entitled 'Continued application of other legal provisions', provides:

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

Regulation (EC) No 6/2002

9 Article 8 of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1), entitled 'Designs dictated by their technical function and designs of interconnections', states, in paragraph 1 thereof:

'A [European Union] design shall not subsist in features of appearance of a product which are solely dictated by its technical function.'

The dispute in the main proceedings and the questions referred for a preliminary ruling

10 Brompton, a company incorporated under English law whose founder is SI, markets a folding bicycle, sold in its current form since 1987 ('the Brompton bicycle').

11 The Brompton bicycle, the particular feature of which is that it can have three different positions (a folded position, an unfolded position and a stand-by position enabling the bicycle to stay balanced on the ground), was protected by a patent which has now expired.

12 For its part, Get2Get markets a bicycle ('the Chedech bicycle') which is visually very similar to the Brompton bicycle and which may fold into the three positions mentioned in the preceding paragraph.

13 On 21 November 2017, SI and Brompton brought an action before the tribunal de l'entreprise de Liège (Companies Court, Liège, Belgium) seeking a ruling that Chedech bicycles infringe Brompton's copyright and SI's non-pecuniary rights and, consequently, an order that Get2Get cease its activities which infringe their rights and withdraw the product from all sales outlets.

14 In its defence, Get2Get contends that the appearance of the Chedech bicycle is dictated by the technical solution sought, which is to ensure that the bicycle can fold into three different positions. In those circumstances, such appearance could be protected only under patent law, not under copyright law.

15 The applicants in the main proceedings claim that the three positions of the Brompton bicycle can be obtained by shapes other than those given to that bicycle by its creator, which means that its shape may be protected by copyright.

16 The tribunal de l'entreprise de Liège (Companies Court, Liège) observes that, under Belgian law, any creation is protected by copyright when it is expressed in a particular shape and is original, which means that a utilitarian object, such as a bicycle, may be protected by copyright. In that regard, although shapes necessary to obtain a technical result are excluded from copyright protection, the fact remains that doubt arises when such a result can be obtained by means of other shapes.

17 The referring court states that, in the judgment of 8 March 2018, *DOCERAM* (C-395/16, EU:C:2018:172), which was delivered in the field of design law, the Court interpreted Article 8(1) of Regulation No 6/2002 as meaning that, 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.

18 It asks, therefore, whether a similar solution should be adopted in the field of copyright when the appearance of the product in respect of which copyright protection is sought under Directive 2001/29 is necessary in order to achieve a particular technical effect.

19 In those circumstances, the tribunal de l'entreprise de Liège (Companies Court, Liège) decided to stay the proceedings and to refer the following questions to the Court of Justice for a preliminary ruling:

'(1) Must EU law, in particular Directive [2001/29], 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?'

Consideration of the questions referred

20 By its two questions, which it is appropriate to examine together, the referring court asks, in essence, whether Articles 2 to 5 of Directive 2001/29 must be interpreted as meaning that the copyright protection provided for therein applies to a product whose shape is, at least in part, necessary to obtain a technical result.

21 In accordance with Articles 2 to 5 of Directive 2001/29, authors are protected against the reproduction, communication to the public and distribution to the public of their works without their authorisation.

22 According to the Court's settled case-law, the concept of 'work' has two conditions. First, it entails an original subject matter which is the author's own intellectual creation and, second, it requires the expression of that creation (see, to that effect, judgment of 12 September 2019, *Cofemel*, C-683/17, EU:C:2019:721, paragraphs 29 and 32 and the case-law cited).

23 As regards the first of those conditions, it follows from the Court's settled case-law that, 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 (judgment of 12 September 2019, *Cofemel*, C-683/17, EU:C:2019:721, paragraph 30 and the case-law cited).

24 In that regard, it must be borne in mind that, according to settled case-law, where the realisation of a subject matter has been dictated by technical considerations, rules or other constraints which have left no room for creative freedom, that subject matter cannot be regarded as possessing the originality required for it to constitute a work and, consequently, to be eligible for the protection conferred by copyright (see, to that effect, judgment of 12 September 2019, *Cofemel*, C-683/17, EU:C:2019:721, paragraph 31 and the case-law cited).

25 As regards the second condition referred to in paragraph 22 of the present judgment, the Court has stated that the concept of 'work' that is the subject of Directive 2001/29 necessarily entails the existence of a subject matter that is identifiable with sufficient precision and objectivity (judgment of 12 September 2019, *Cofemel*, C-683/17, EU:C:2019:721, paragraph 32 and the case-law cited).

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

27 In that regard, it should be noted that the criterion of originality cannot be met by the components of a subject matter which are differentiated only by their technical function. It follows in particular from Article 2 of the WIPO Copyright Treaty that copyright protection does not extend to ideas. Protecting ideas by copyright would amount to making it possible to monopolise ideas, to the detriment, in particular, of technical progress and industrial development (see, to that effect, judgment of 2 May 2012, *SAS Institute*, C-406/10, EU:C:2012:259, paragraphs 33 and 40). Where the expression of those components is dictated by their technical function, the different methods of implementing an idea are so limited that the idea and the expression become indissociable (see, to that effect, judgment of 22 December 2010, *Bezpečnostní softwarová asociace*, C-393/09, EU:C:2010:816, paragraphs 48 and 49).

28 It is therefore necessary to examine whether the folding bicycle at issue in the main proceedings is capable of constituting a work eligible for the protection provided for in Directive 2001/29, it being noted that the referring court's questions do not refer to the second condition mentioned in paragraph 22 of the present judgment, because the bicycle appears to be identifiable with sufficient precision and objectivity, but the first condition.

29 In the present case, it is true that the shape of the Brompton bicycle appears necessary to obtain a certain technical result, namely that the bicycle may be folded into three positions, one of which allows it to be kept balanced on the ground.

30 However, it is for the referring court to ascertain whether, in spite of that fact, that bicycle is an original work resulting from intellectual creation.

31 In that regard, as recalled in paragraphs 24, 26 and 27 of the present judgment, that cannot be the case where the realisation of a subject matter has been dictated by technical considerations, rules or other constraints which have left no room for creative freedom or room so limited that the idea and its expression become indissociable.

32 Even though there remains a possibility of choice as to the shape of a subject matter, it cannot be concluded that the subject matter is necessarily covered by the concept of 'work' within the meaning of Directive 2001/29. In order to determine whether the subject matter is actually covered, it is for the referring court to verify that the conditions referred to in paragraphs 22 to 27 of the present judgment are met.

33 Where the shape of the product is solely dictated by its technical function, that product cannot be covered by copyright protection.

34 Therefore, in order to establish whether the product concerned falls within the scope of copyright protection, it is for the referring court to determine whether, through that choice of the shape of the product, its author has expressed his creative ability in an original manner by making free and creative choices and has designed the product in such a way that it reflects his personality.

35 In that context, and in so far as only the originality of the product concerned needs to be assessed, even though the existence of other possible shapes which can achieve the same technical result makes it possible to establish that there is a possibility of choice, it is not decisive in assessing the factors which influenced the choice made by the creator. Likewise, the intention of the alleged infringer is irrelevant in such an assessment.

36 As regards the existence of an earlier, now expired, patent in the case in the main proceedings and the effectiveness of the shape in achieving the same technical result, they should be taken into account only in so far as those factors make it possible to reveal what was taken into consideration in choosing the shape of the product concerned.

37 In any event, it must be noted that, in order to assess whether the folding bicycle at issue in the main proceedings is an original creation and is thus protected by copyright, it is for the referring court to take account of all the relevant aspects of the present case, as they existed when that subject matter was designed, irrespective of the factors external to and subsequent to the creation of the product.

38 Consequently, the answer to the questions referred for a preliminary ruling is that Articles 2 to 5 of Directive 2001/29 must be interpreted as meaning that the copyright protection provided for therein applies to a product whose shape is, at least in part, necessary to obtain a technical result, where that product is an original work resulting from intellectual creation, in that, through that shape, its author expresses his creative ability in an original manner by making free and creative choices in such a way that that shape reflects his personality, which it is for the national court to verify, bearing in mind all the relevant aspects of the dispute in the main proceedings.

Costs

39 Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national court, the decision on costs is a matter for that court. Costs incurred in submitting observations to the Court, other than the costs of those parties, are not recoverable.

On those grounds, the Court (Fifth Chamber) hereby rules:

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 must be interpreted as meaning that the copyright protection provided for therein applies to a product whose shape is, at least in part, necessary to obtain a technical result, where that product is an original work resulting from intellectual creation, in that, through that

shape, its author expresses his creative ability in an original manner by making free and creative choices in such a way that that shape reflects his personality, which it is for the national court to verify, bearing in mind all the relevant aspects of the dispute in the main proceedings.

[Signatures]