



Reports of Cases

OPINION OF ADVOCATE GENERAL
SZPUNAR
delivered on 2 May 2019¹

Case C-683/17

Cofemel – Sociedade de Vestuário SA
v
G-Star Raw CV

(Request for a preliminary ruling from the Supremo Tribunal de Justiça
(Supreme Court, Portugal))

(Reference for a preliminary ruling – Copyright and related rights – Legal protection of designs –
Right of reproduction – Clothes)

Introduction

1. The legal protection of works of applied art is virtually as old as the legal protection of intellectual property in general.² However, it still struggles to find its place within an intellectual property law system which covers three main areas: protecting inventions through patent law; protecting intellectual creations through copyright, and protecting reputation through trade mark law. On account of their decorative and practical character and artistic and industrial purpose, works of applied art lend themselves to those three forms of protection without, however, perfectly satisfying the objectives or mechanisms of any of them.³ Although *sui generis* protection regimes have been developed, in particular in Europe, that protection has never become exclusive: it can still be combined with other forms of protection.⁴

2. The present case concerns, in particular, the combination of protection of designs under the *sui generis* regime and their protection as works under copyright. The relationship between those two protection regimes has always been a source of indecision – both on the part of the legislature and in the case-law – and controversy.

3. On the one hand, the functional and practical character of works of applied art and the fact they are designed to be mass-produced raise doubts as to whether they may be properly protected by copyright and whether that protection is consistent with its axiological foundations (the personal link between authors and their works) and objectives (remuneration for the intellectual and creative effort involved). In particular, there are two dangers inherent in the copyright protection of designs:

¹ Original language: French.

² One of the first legislative acts in this area was the French Law of 18 March 1806 creating the Conseil des prud'hommes in Lyon (Labour Tribunal, Lyon) which granted protection to the designs of silk makers in Lyon.

³ See Fischman Afori, O., 'Reconceptualizing Property in Designs', *Cardozo Arts & Entertainment Law Journal*, No 3, 2008, pp. 1105 to 1178.

⁴ On the principle of cumulation of protection of designs under intellectual property law, see, inter alia, Derclaye, E., Leistner, M., *Intellectual Property Overlaps, A European Perspective*, Hart Publishing, Oxford, 2011, and Tischner, A., *Kumulatywna ochrona wzornictwa przemysłowego w prawie własności intelektualnej*, C.H.Beck, Warsaw, 2015.

over-extension of the scope of copyright protection and restrictions on economic competition.⁵ For that reason, many legal systems have developed rules to ensure that copyright protection is limited to designs of high artistic value. A good example is the doctrine of ‘*scindibilità*’ in Italian law, ‘*Stufentheorie*’ in German law, or the limitation of the term of protection for works produced on an industrial scale in the law of the United Kingdom.⁶

4. On the other hand, it is common ground that some works of applied art have a high degree of originality. One need only consider the styles developed in this area such as Art Deco or Bauhaus. The same is true in the sector of activity at issue in the present case – clothing – in which pieces of haute couture are more akin to works of art than items of clothing. It is not therefore justified to exclude a priori works of applied art from the scope of copyright protection on the sole basis of their (equally) functional character. In addition, other categories of works which undoubtedly fall within the scope of copyright protection may also have a practical purpose whilst, at the same time, being original intellectual creations. That is true of some literary, photographic or even musical works.

5. Accordingly, the option chosen by the EU legislature, in the spirit of the theory of unity of art developed in French legal theory,⁷ of concurrently protecting works of applied art under a *sui generis* regime and under copyright law, is not irrelevant.⁸ However, it is necessary to ensure the autonomy and the achievement of the respective goals of each protection regime.

6. It is against that background that the Court of Justice will be asked to determine the questions of law referred to it by the Supremo Tribunal de Justiça (Supreme Court, Portugal) in the context of the present reference for a preliminary ruling.

Legal context

International law

7. Article 2(1) and (7) of the Convention for the Protection of Literary and Artistic Works, signed at Berne on 9 September 1886 (Paris Act of 24 July 1971), as amended on 28 September 1979 (‘the Berne Convention’)⁹ provide:

‘(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 ...

...

⁵ On over-extending that protection to the detriment of competition under industrial copyright in English law, see, in particular, Bently, L., ‘The Return of Industrial Copyright?’, *European Intellectual Property Review*, 2012, pp. 654 to 672.

⁶ See, inter alia, Derclaye, E., Leistner, M., op.cit., pp. 200 and 283; Marzano, P., ‘Une protection mal conçue pour un produit bien conçu: l’Italie et sa protection des dessins et modèles industriels par le droit d’auteur’, *Revue internationale du droit d’auteur*, 2014, p. 118, and Tischner, A., op. cit., pp. 159 to 170.

⁷ See, inter alia, Pollaud-Dulian, F., *Propriété intellectuelle. Le droit d’auteur*, Economica, Paris, 2014, p. 190 to 194, and Vivant, M., Bruguière, J.-M., *Droit d’auteur et droits voisins*, Dalloz, Paris, 2016, pp. 255 to 257.

⁸ Even if, according to some authors, the principle of cumulative protection highlights the impotence of the intellectual property system to control its own hypertrophy (Tischner, A., ‘The role of unregistered rights – a European perspective on design protection’, *Journal of Intellectual Property Law & Practice*, No 4, 2018, pp. 303 to 314).

⁹ The European Union is not party to the Berne Convention but is party to the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the World Trade Organization Agreement, signed in Marrakech on 15 April 1994 (‘the 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 members to comply with Articles 1 through 21 of the Berne Convention.

(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. [¹⁰] 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.

...'

8. According to Article 25 of the TRIPS Agreement:

'1. Members shall provide for the protection of independently created industrial designs that are new or original. ...

2. Each Member shall ensure that requirements for securing protection for textile designs, in particular in regard to any cost, examination or publication, do not unreasonably impair the opportunity to seek and obtain such protection. Members shall be free to meet this obligation through industrial design law or through copyright law.'

EU law

9. Article 17 of Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs¹¹ provides:

'A design protected by a design right registered in or in respect of a Member State in accordance with this Directive shall also be eligible for protection under the law of copyright of that State 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.'

10. Under Article 2(a) 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:¹²

'Member States shall provide for the exclusive right to authorise or prohibit direct or indirect, temporary or permanent reproduction by any means and in any form, in whole or in part:

(a) for authors, of their works;

...'

11. According to Article 9 of that directive:

'This Directive shall be without prejudice to provisions concerning in particular patent rights, trade marks, design rights, utility models, topographies of semi-conductor products, typefaces, conditional access, access to cable of broadcasting services, protection of national treasures, legal deposit requirements, laws on restrictive practices and unfair competition, trade secrets, security, confidentiality, data protection and privacy, access to public documents, the law of contract.'

¹⁰ Article 7(4) of the Berne Convention concerns the term of protection of industrial designs.

¹¹ OJ 1998 L 289, p. 28.

¹² OJ 2001 L 167, p. 10.

12. Article 96(2) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs¹³ provides:

‘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.’

Portuguese law

13. Directive 2001/29 is transposed into Portuguese law by the Código do Direito de Autor e dos Direitos Conexos (Code on Copyright and Related Rights) (‘CDADC’), Article 2(1) of which sets out a list of works protected by copyright as follows:

‘ 1. Intellectual creations in the literary, scientific and artistic fields, irrespective of their genre, form of expression, quality, mode of communication and objective, shall include, inter alia:

...

(i) works of applied art, industrial designs and works of design which constitute an artistic creation, irrespective of the protection relating to industrial property;

...’.

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

14. G-Star Raw CV (‘G-Star’), a company incorporated under Dutch law, is involved in the design, production and placing on the market of clothing. G-Star uses, as the proprietor of or under an exclusive licence agreement, the marks G-Star, G-Star Raw, G-Star Denim Raw, GS-Raw, G-Raw and Raw. The clothing marketed under those marks includes, inter alia, Arc jeans and Rowdy sweatshirts and t-shirts.

15. Cofemel – Sociedade de Vestuário, SA (‘Cofemel’), a company incorporated under Portuguese law, is involved in the design, production and placing on the market of jeans, sweatshirts and t-shirts under the Tiffosi mark.

16. On 30 August 2013 G-Star brought an action before a Portuguese court of first instance for a declaratory judgment that Cofemel be ordered to cease any acts constituting an infringement of its copyright and unfair competition in relation to the applicant, and to compensate it for the harm suffered in that regard and, in the event of continuing infringements, to pay it a penalty payment in respect of each day of duration of each of the acts until they cease. In support of its action, G-Star essentially argued that some of the jeans, sweatshirts and t-shirts marketed by Cofemel have an identical design to its Arc and Rowdy designs. G-Star also claimed that its designs constitute original intellectual creations and, as such, works of design protected by copyright.

17. The judgment given at first instance partly upheld the action brought by G-Star. Cofemel brought an appeal before the Tribunal da Relação de Lisboa (Court of Appeal, Lisbon, Portugal) which upheld that judgment.

¹³ OJ 2002 L 3, p. 1.

18. Hearing an appeal brought by Cofemel, the Supremo Tribunal de Justiça (Supreme Court) considered the following facts to be established: first, the items of G-Star clothing copied by Cofemel were designed either by designers employed by G-Star or by designers acting on its behalf who had assigned to G-Star their copyright in the designs. Second, those items of clothing are the result of designs and a manufacturing process recognised as being innovative within the world of fashion. Third, those items are characterised by a number of specific elements (3D effect, the positioning of various components, how they are assembled and the combination of colours etc.) allegedly partly copied by Cofemel in its clothing. Against that background, the Supremo Tribunal de Justiça (Supreme Court) is uncertain of the meaning of Article 2(1)(i) of the CDADC. In that regard, the referring court points out that, whilst that provision clearly includes works of applied art, industrial designs and works of design which constitute an artistic creation in the list of works protected by copyright, it does not specify the level of originality required for such works to be granted that protection.

19. In those circumstances, the Supremo Tribunal de Justiça (Supreme Court) decided to stay the proceedings and refer the following questions to the Court of Justice for a preliminary ruling:

- ‘(1) Does the interpretation by the Court of Article 2(a) of Directive 2001/29 preclude national legislation – in the present case, the provision in Article 2(1)(i) of the Code on Copyright and Related Rights – which confers copyright protection on works of applied art, industrial designs and works of design which, in addition to the utilitarian purpose they serve, create their own visual and distinctive effect from an aesthetic point of view, their originality being the fundamental criterion which governs the grant of protection in the area of copyright?
- (2) Does the interpretation by the Court of Article 2(a) of Directive 2001/29 preclude national legislation – in the present case, the provision in Article 2(1)(i) of the Code on Copyright and Related Rights – which confers copyright protection on works of applied art, industrial designs and works of design if, in the light of a particularly rigorous assessment of their artistic character, and taking account the dominant views in cultural and institutional circles, they qualify as an “artistic creation” or “work of art”?’

20. The request for a preliminary ruling was received at the Court on 6 December 2017. The Portuguese Government, the Czech Government, the Italian Government, the United Kingdom Government and the European Commission submitted written observations. The parties in the main proceedings, the Portuguese, Czech and United Kingdom Governments and the Commission were represented at the hearing, which took place on 12 December 2018.

Analysis

21. By its two questions referred for a preliminary ruling, which I believe should be analysed together, the referring court asks, in essence, whether Article 2(a) of Directive 2001/29, as interpreted by the Court, precludes industrial designs¹⁴ from being protected by copyright only if they have increased artistic character, exceeding what is normally required of other categories of works.

22. The answer to that question requires analysis of the Court’s case-law relating to the concept of a ‘work’ in EU copyright law, as well as analysis of the arguments put forward, in particular, by the Italian, Czech and United Kingdom Governments based on the alleged special status enjoyed by design rights under the regime established by EU law

¹⁴ The referring court refers in its questions to the wording of the Portuguese law: ‘works of applied art, industrial designs and works of design’. However, I take the view that those three expressions are, in essence, synonymous. In any event, I refer in this Opinion to subject matter which, like the subject matter at issue in the main proceedings, may be protected as designs within the meaning of Directive 98/71 or Regulation No 6/2002.

The Court's case-law relating to the concept of 'work'

23. Article 2(a) of Directive 2001/29, cited by the referring court, does not itself define what should be considered a work. That provision merely grants authors the exclusive right to authorise or prohibit any reproduction of their works. Moreover, no other provision of that directive defines the concept of 'work'. It is likely that, as argued by the Czech Government in its observations, the excessive disparities between the copyright regimes of the Member States precluded a unanimously accepted definition from being established. In that regard, it should be noted that, even at national level, it is extremely difficult, if not impossible, to conceive of an abstract definition covering the variety of very different subject matter which may be protected by copyright and, at the same time, excluding subject matter which is not. At most, it is possible to draw up a (necessarily non-exhaustive) list of areas of creation in which copyright may apply, in the same way as the list set out in Article 2(1) of the Berne Convention.

24. However, such a lacuna could not continue, because the concept of 'work' is the cornerstone of any copyright regime, in so far as it defines its substantive scope. A uniform interpretation of that concept is therefore necessary in the harmonisation of the copyright regime established by EU law. Indeed, it would be pointless to harmonise the various rights enjoyed by authors if the Member States were free to include in or exclude from that protection, whether by legislative means or through case-law, particular subject matter. Sooner or later, the Court was bound to be called on to fill that lacuna through questions referred for a preliminary ruling by courts questioning whether copyright directives are applicable in specific situations.

25. In so far as Directive 2001/29 does not define the concept of 'work' and makes no reference to the laws of the Member States for the purpose of defining that concept, it is an autonomous concept of EU law.¹⁵ According to the Court's case-law, if subject matter is to be classified as a 'work' within the meaning of copyright, it must be 'original in the sense that it is the author's own intellectual creation'.¹⁶ That condition governing the applicability of copyright, as harmonised in EU law, particularly by Directive 2001/29, was inferred by the Court from the scheme of that directive and of the Berne Convention. It was not, however, invented by EU law: it appears in most national copyright laws, at least in continental legal systems.¹⁷ It therefore forms part, in a sense, of the legal traditions of the Member States.

26. The concept of a work being 'its author's own intellectual creation' is the main component of the definition of a work. That definition was subsequently developed in the case-law of the Court, which explained that an intellectual creation is an author's own if it reflects the author's personality. That is the case if the author was able to express his creative abilities in the production of the work by making free and creative choices.¹⁸ However, where the expression of the components of the subject matter at issue 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. Such a situation does not permit the author to express his creativity in an original manner and achieve a result which is an intellectual creation of his own.¹⁹ Only the author's own intellectual creation, as defined above, has the status of work eligible for copyright protection.

¹⁵ See, most recently, judgment of 13 November 2018, *Levola Hengelo* (C-310/17, EU:C:2018:899, paragraph 33).

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

¹⁷ That is particularly true in the case of German law: Paragraph 2(2) of the Gesetz über Urheberrecht und verwandte Schutzrechte – Urheberrechtsgesetz (law on copyright and related rights), of 9 September 1965 provides that 'only personal intellectual creations shall be regarded as works within the meaning of this law'. That concept is also found in the notion of originality under French copyright law (judgment of the Cour de cassation (Court of Cassation, France), full court, of 7 March 1986, *Babolat v Pachot*, No 83-10477, published in the Official Gazette), under Polish law (Article 1(1) of the ustawa o prawie autorskim i prawach pokrewnych (Law on copyright and related rights) of 4 February 1994) and under Spanish law (Article 10 of the Ley de Propiedad Intelectual (Law on intellectual property) of 24 April 1996). The situation is different in the copyright systems of English-speaking countries.

¹⁸ Judgment of 1 December 2011, *Painer* (C-145/10, EU:C:2011:798, paragraphs 88 and 89).

¹⁹ Judgment of 22 December 2010, *Bezpečnostní softwarová asociace* (C-393/09, EU:C:2010:816, paragraphs 49 and 50).

Elements such as the intellectual work and the skill of the author cannot, as such, justify the protection of the subject matter at issue by copyright, if such work and skill do not express any originality.²⁰ Lastly, the subject matter protected by copyright must be identifiable with sufficient precision and objectivity.^{21 22}

The application of that case-law to designs

27. Contrary to what the Czech Government argues in its written observations, the definition of a ‘work’ as the author’s own intellectual creation is not limited to the areas subject to specific EU rules in which that criterion is expressly provided for, namely databases, photographs and computer programmes.²³

28. The Court’s first application of that criterion concerned a literary work, protected under Directive 2001/29. As I have already stated, that criterion was inferred by the Court from the general scheme of copyright at international and European Union level. Although the Court applied that criterion to subject matter falling within the scope of specific EU rules, such as photographs, that application was based on earlier case-law rather than those rules.²⁴

29. I take the view that it is apparent that the criterion of the author’s own intellectual creation, as set out in the Court’s case-law, is intended to apply to all categories of works. That also follows from the uniformity required in the application of Directive 2001/29 throughout the European Union. Any disparity between the national laws of the Member States in the scope of copyright protection would undermine that uniform application.²⁵ I therefore see no reason not to apply that criterion, at least in principle, to industrial designs with regard to their protection by copyright.

30. Moreover, I am not convinced by the argument put forward by the Czech Government at the hearing that the criterion of the author’s own intellectual creation is inherent in all works or that it does not preclude stricter requirements than those imposed by national law on certain categories of works, such as works of applied art.

31. Admittedly, the criterion of the author’s own intellectual creation makes it possible to distinguish between subject matter which may be protected by copyright from subject matter which falls outside the scope of that protection.²⁶ However, that criterion, which the Court also refers to as the criterion of originality,²⁷ also constitutes the maximum requirement that Member States may impose on qualification for copyright protection, irrespective of the level of artistic creation of the subject matter in question. The Court made it very clear in its judgment in *Painer*, that, as regards a portrait photograph, the protection conferred by Article 2(a) of Directive 2001/29 cannot be inferior to that enjoyed by other works, including other photographic works.²⁸ Indeed, nothing in Directive 2001/29

20 Judgment of 1 March 2012, *Football Dataco and Others* (C-604/10, EU:C:2012:115, paragraph 33).

21 Judgment of 13 November 2018, *Levola Hengelo* (C-310/17, EU:C:2018:899, paragraph 40).

22 For the description of that case-law, I have drawn heavily on points 17 and 18 of my Opinion in *Funke Medien NRW* (C-469/17, EU:C:2018:870).

23 That is to say Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases (OJ 1996 L 77, p. 20), Article 3(1); Directive 2006/116/EC 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), Article 6; and Directive 2009/24/EC of the European Parliament and of the Council of 23 April 2009 on the legal protection of computer programs (OJ 2009 L 111, p. 16), Article 1(3).

24 See judgments of 1 December 2011, *Painer* (C-145/10, EU:C:2011:798, paragraph 87), and of 7 August 2018, *Renckhoff* (C-161/17, EU:C:2018:634, paragraph 14).

25 See, to that effect, judgment of 13 November 2018, *Levola Hengelo* (C-310/17, EU:C:2018:899, paragraph 45).

26 See, inter alia, judgment of 22 December 2010, *Bezpečnostní softwarová asociace* (C-393/09, EU:C:2010:816, paragraphs 46 to 48).

27 Judgment of 22 December 2010, *Bezpečnostní softwarová asociace* (C-393/09, EU:C:2010:816, paragraphs 48 and 49).

28 Judgment of 1 December 2011, *Painer* (C-145/10, EU:C:2011:798, paragraph 98).

or in any other directive applicable in this field supports 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.²⁹ If the scope of protection cannot be limited on that basis, *a fortiori* it cannot be considered that such protection is completely excluded thereby.

32. Likewise, I do not see anything in Directive 2001/29 to justify a distinction in the level of protection conferred on works of applied art on the basis of their artistic value. However, the Italian, Czech and United Kingdom Governments, which have submitted observations in the present case, consider that there is something in other provisions of EU law, namely Article 17 of Directive 98/71 and Article 96(2) of Regulation No 6/2002. Accordingly, I will now examine that point.

The contribution of Article 17 of Directive 98/71 and Article 96(2) of Regulation No 6/2002

33. By way of reminder, Article 17 of Directive 98/71 enshrines the principle of cumulative protection of designs under design law and under copyright law. The second sentence of that article provides that the extent to which, and the conditions under which, such protection by copyright is conferred, including the level of originality required, is determined by each Member State. Similar wording is found in Article 96(2) of Regulation No 6/2002.

34. According to the Italian, Czech and United Kingdom Governments, those provisions leave it to the Member States to establish the conditions under which copyright protection is conferred on designs, notwithstanding the adoption of Directive 2001/29. Those Governments also claim that Article 17 of Directive 98/71 constitutes *lex specialis* in relation to the provisions of Directive 2001/29 as interpreted by the Court. A similar position is advocated in academic writing.³⁰

35. I do not share that position and I will analyse the various arguments raised to support it – which I find unconvincing – below.

36. First of all, as is apparent from its first sentence, Article 17 of Directive 98/71 only concerns registered designs. The freedom given to Member States thus concerns only that category of designs. However, the majority of designs within the EU have not been registered.³¹ As is clear from the information given in the order for reference in the present case, that is notably true of the designs at issue in the main proceedings. I therefore take the view that it is more appropriate to discuss Article 96(2) of Regulation No 6/2002. That regulation confers protection, limited to three years, on any design in the EU, provided that it is new and original, without the need for registration.

37. It is true that, in the light of its wording, Article 96(2) of Regulation No 6/2002 appears to give Member States a wide margin of discretion in the conditions for conferring copyright protection on designs. However, that margin of discretion is given subject to the harmonisation of copyright at EU level, which is confirmed by recital 32 of that regulation according to which ‘in the absence of the complete harmonisation of copyright law, it is important to establish the principle of cumulative 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’.³² It is even clearer from the explanatory memorandum to Regulation No 6/2002³³ that the solution adopted in Article 96(2) of Regulation No 6/2002 is intended to be provisional, pending the harmonisation of copyright.

²⁹ Judgment of 1 December 2011, *Painer* (C-145/10, EU:C:2011:798, paragraph 97).

³⁰ See Bently, L., *op. cit.*

³¹ See Tischner, A., ‘The role of unregistered rights – a European perspective on design protection’, *Journal of Intellectual Property Law & Practice*, No 4, 2018 and the works cited.

³² Similar wording appears in recital 8 of Directive 98/71.

³³ COM(93) 342 final of 3 December 1993, pp. 53 to 55.

38. In my opinion, it is therefore clear that once harmonisation has been achieved, by means of, *inter alia*, Directive 2001/29, as interpreted by the Court, the margin of discretion given to the Member States under Article 96(2) of Regulation No 6/2002 is limited by their obligations under that directive. It would be a surprising position to take, that any reference in a provision of EU law to the national law of the Member States amounts to releasing those States from their obligations arising, in the field covered by that reference, from other acts of EU law, whether earlier or later. Such a reference necessarily refers to the national law as framed by the positive and negative obligations arising under EU law.

39. In that regard, I am not convinced by the argument put forward by the United Kingdom Government that Regulation No 6/2002 was adopted later than Directive 2001/29. It is true that Regulation No 6/2002 was adopted only on 12 December 2001, whereas Directive 2001/29 was adopted on 22 May 2001. First of all, however, the text which corresponds to Article 96(2) of Regulation No 6/2002, although worded differently, was already included in the Commission's first proposal for that regulation of 3 December 1993, well before the first proposal for Directive 2001/29.³⁴ Subsequently, the legislative work for those two acts took place simultaneously. Second, the deadline for transposition of Directive 2001/29 expired only on 22 December 2002, whereas Regulation No 6/2002 entered into force at the beginning of March that same year. At the time of the entry into force of that regulation, the harmonisation of copyright under Directive 2001/29 was not yet complete because the Member States were not yet required to transpose the provisions of that directive. The fact that Regulation No 6/2002 was adopted later than Directive 2001/29 thus has no bearing on the analysis of the relationship between those two acts: the discretion given to Member States under Article 96(2) of that regulation is limited by their obligations under Directive 2001/29.

40. Nor am I convinced by the argument relating to the *travaux préparatoires* for Directive 98/71 or Regulation No 6/2002.³⁵ Although the Commission had more ambitious objectives and although it was eventually decided that, at the time, it was not appropriate to harmonise the laws of copyright in the Member States by means of legislative acts relating to designs, this does not mean that the protection of such designs by copyright should remain an exception once harmonisation has been achieved. Whilst the *travaux préparatoires* of acts of EU law certainly provide valuable information on the reasons guiding the choices of the EU legislature, what can be learnt from the *travaux préparatoires* cannot, however, outweigh the wording and scheme of the provisions in question. In particular, it is not appropriate to draw from the *travaux préparatoires* of one text (Directive 98/71 or Regulation No 6/2002) conclusions relating to the interpretation or scope of another text (Directive 2001/29).

41. Next, the United Kingdom Government relies, in support of its position, on Article 9 of Directive 2001/29, according to which that directive has no bearing on provisions of EU law concerning, *inter alia*, designs, including Article 17 of Directive 98/71.³⁶ I take the view that the United Kingdom Government cannot base its argument on that provision of Directive 2001/29. It is clear that Directive 2001/29, which concerns copyright, has no bearing on provisions in other areas, such as design rights. However, Article 17 of Directive 98/71, like Article 96(2) of Regulation No 6/2002, concerns copyright not design rights. A different interpretation would mean that the protection of works of applied art by copyright depends on design rights, whereas those two areas are autonomous. Article 9 of Directive 2001/29 cannot therefore be interpreted as basing the exclusion of designs on the harmonisation achieved under Directive 2001/29.

42. In any event, if the EU legislature had intended to provide for such an important exception to harmonised copyright, it would not have done so implicitly in various acts of EU law, but rather clearly and expressly, for example in Article 1 of Directive 2001/29 defining its scope.

³⁴ COM(97) 628 final of 21 January 1998.

³⁵ That argument is put forward in academic writing, see, *inter alia*, Bently, L., *op. cit.*

³⁶ As well as, in my view, Article 96(2) of Regulation No 6/2002.

43. The Czech Government adds that, as its title indicates, Directive 2001/29 harmonises only ‘certain aspects of copyright’ and ‘in the information society’. However, I do not see how that observation is consistent with the argument it puts forward relating to the protection of works of applied art.

44. It is true that important aspects of copyright fall outside the scope of Directive 2001/29: moral rights, the collective management of rights, the defence of those rights (except the general provisions of Article 8) etc. However, in the main proceedings, G-star relied on the exclusive right of authors to authorise or prohibit any reproduction of their works. That right has been comprehensively harmonised by Directive 2001/29. It is also true that, particularly in English-language literature, Directive 2001/29 is often referred to as the Information Society Directive. I am of the opinion that some authors draw inappropriate and mistaken conclusions from that informal title. Indeed, whilst Article 1(1) of Directive 2001/29 places ‘particular emphasis on the information society’, the fact remains that the provisions of that directive are intended to apply equally in all areas, whether or not they come under ‘the information society’. Accordingly, the fact that designs are usually incorporated in tangible objects belonging to the ‘real’³⁷ world, does not justify their exclusion from the protection conferred by that directive.

45. Moreover, the arguments put forward by those Governments have no basis in international law. It is true that Article 2(7) of the Berne Convention leaves to the discretion of the State parties the application of copyright to designs. However, that convention applies without prejudice to the obligations of Member States under EU law. Therefore, if EU law limits the freedom of choice of Member States, an optional provision of the Berne Convention cannot countermand that limitation. A different conclusion would be contrary to the second subparagraph of Article 351 TFEU. The same considerations apply to Article 25 of the TRIPS Agreement.

46. Furthermore, if Article 2(7) of the Berne Convention were to be regarded as a derogation from the obligations of Member States under Directive 2001/29, the second sentence of Article 2(7) which enshrines the principle of reciprocity between State parties in the protection of design rights, must also be applied. According to that provision, subject matter protected in the country of origin solely as designs is entitled in another country of the Union only to such special protection as is granted in that country to designs; however, if no such special protection is granted in that country, such works are protected by copyright. However, the removal of the principle of reciprocity – a source of discrimination which is contrary to the rules of the internal market – in relations between Member States was precisely one of the objectives of Article 96(2) of Regulation No 6/2002.³⁸

47. Last, the argument that Article 17 of Directive 98/71 allows Member States to derogate from EU copyright law is undermined by the Court’s case-law relating to the interpretation of that provision. In the *Flos* judgment,³⁹ concerning the duration of protection of designs by copyright, the Court held that the fact that the Member States are entitled to determine the extent of that protection and the conditions under which it is conferred cannot affect the duration of that protection, since the duration of protection has already been harmonised at EU level by Directive 93/98/EEC.⁴⁰ The same line of reasoning can be followed with regard to Directive 2001/29: since that directive, as interpreted by the Court, has harmonised the author’s economic rights, including the concept of ‘work’, which is essential for the uniform application of those rights, those matters fall outside the discretion given to Member States under Article 17 of Directive 98/71 and, by analogy, Article 96(2) of Regulation No 6/2002. I agree in that regard with the views put forward by the Commission in its observations.

³⁷ As opposed to the virtual world.

³⁸ See the explanatory memorandum to that regulation (COM(93) 342 final, p. 56).

³⁹ Judgment of 27 January 2011 (C-168/09, EU:C:2011:29, paragraphs 39).

⁴⁰ Council Directive of 29 October 1993 harmonising the term of protection of copyright and certain related rights (OJ 1993 L 290, p. 9), replaced by Directive 2006/116.

48. Accordingly, Article 17 of Directive 98/71 and Article 96(2) of Regulation No 6/2002 must be interpreted as an assertion of the principle of cumulative protection: a work of applied art should not be excluded from copyright protection on the ground that it enjoys *sui generis* protection as a design. By contrast, those provisions cannot be interpreted as derogating from the provisions of Directive 2001/29 or any other EU legislation concerning copyright.

Interim conclusion

49. At this stage, I therefore consider that the answer to the questions referred is that Article 2(a) of Directive 2001/29, as interpreted by the Court, precludes industrial designs from being protected by copyright only if they have increased artistic character, exceeding what is normally required of other categories of works.

Closing remarks on the protection of designs by copyright

50. That said, I do not wish to ignore or underestimate the concerns expressed by the Governments which have submitted observations in the present case, and by some authors in academic writing⁴¹ regarding the harmful consequences of overprotection of designs by copyright.

51. *Sui generis* protection of designs, such as that provided by Regulation No 6/2002, is well adapted to the specific characteristics of the protected subject matter, that is to say ordinary, practical and mass-produced goods which can nevertheless also possess original aesthetic characteristics worthy of protection. That protection is of sufficient duration to allow a return on the investment in developing the design,⁴² without however placing an excessive restriction on competition. Likewise, the conditions under which that protection is conferred, based on originality and novelty, as well as the criterion used to determine an act of infringement – the overall visual impression⁴³ – are adapted to the conditions of the market for that subject matter.

52. However, if it is too easy to obtain, for the same subject matter, protection by copyright, which is free from any formalities, which applies from the moment of creation of the subject matter and without any requirement of novelty and the duration of which is virtually limitless in the light of the benefit of the design for its proprietor,⁴⁴ there is a risk that the copyright regime would supplant the *sui generis* regime intended to protect designs. This would have several negative effects: the devaluation of copyright, sought to protect everyday creations, restriction of competition on account of the excessive duration of protection and even legal uncertainty, in that competitors are not able to predict whether a design whose *sui generis* protection has expired is also protected by copyright.

53. Those concerns explain the various limitations on the copyright protection of works of applied art under the national intellectual property rights regimes referred to in the introduction to this Opinion. However, as I pointed out in the answer to the questions referred, there is no legal basis allowing for that limitation under the EU copyright regime, since works of applied art are protected as the intellectual creations of their authors, in the same way as other categories of works.

41 See, inter alia, Bently, L., op. cit., and Tischner, A., 'The role of unregistered rights – a European perspective on design protection' *Journal of Intellectual Property Law & Practice*, No 4, 2018.

42 According to Regulation No 6/2002, that term of protection is three years for unregistered designs and five years renewable up to a total term of 25 years for registered designs, which is sufficient, in so far as an average design has commercial value for only four years and even less (one or two seasons) in the clothing sector (see Tischner, A., 'The role of unregistered rights – a European perspective on design protection', and Van Keymeulen, E., 'Copyrighting couture or counterfeit chic? Protecting fashion design: a comparative EU-US perspective', *Journal of Intellectual Property Law & Practice*, No 10, 2012, p. 728 to 737).

43 See Articles 4 and 10 of Regulation No 6/2002.

44 The term of copyright protection covers the lifetime of the author and 70 years after his death.

54. Nevertheless, I take the view that the strict application of copyright by national courts could, to a large extent, overcome the disadvantages resulting from the combination of copyright protection with the *sui generis* protection of designs. It is not a question of extending, through copyright, the protection conferred on designs up to 70 years after the death of the author but rather of achieving, with regard to works of applied art, the specific objectives of copyright using the rules specific to it.

55. Copyright and design law have different objectives. The latter protects the investment in creating designs from imitation by competitors. In contrast, copyright disregards that protection against competition. Indeed, on the contrary, dialogue, inspiration and reformulation are inherent in intellectual creation and copyright is not meant to hinder them.⁴⁵ What copyright protects, at least through economic rights, is the possibility of unhindered economic exploitation of that work as such.

56. Those different objectives go hand in hand with different mechanisms and principles of protection.

57. First, although the threshold of originality adopted in copyright is not normally very high, it is not non-existent. In order to benefit from protection, the effort made by the author must be free and creative. Outcomes dictated only by the technical result cannot be protected,⁴⁶ nor can work devoid of any creativity.⁴⁷ In that line, it is not necessary for practical objects to display a particularly high artistic level in comparison with other categories of works, it is sufficient to apply the criterion of *the author's own intellectual creation*. Any practical object has a visual aspect, the result of the effort made by its designer. However, any visual aspect will not be protected by copyright.

58. Second, copyright is based on a distinction between the idea and its expression, with only the expression being protected. With regard to works of applied art, that dichotomy is, in my opinion, likely to mitigate the anti-competitive effects of their protection by copyright. By way of example, I refer to the subject matter at issue in the main proceedings to illustrate my point.

59. According to the order for reference, the applicant in the main proceedings seeks protection for:

‘designs [of] sweatshirts and t-shirts, ... compris[ing] a number of elements, inter alia, an image embossed on the front of the sweatshirt, a combination of colours, placement of the pocket on the stomach, and pocket insertions ...’ and

‘[the jeans] design ... characterised by the way in which each of the three different pieces are cut and put together. Using pieces of different lengths and shapes creates a trouser leg with ... three-dimensional (3D) effect, which bends inwards and backwards and which wraps around the wearer’s leg (corkscrew effect). Other aspects which contribute to the “corkscrew effect” are the darts on the knees of the trousers, one on each leg’.

60. The classification of the subject matter at issue as works capable of protection and the finding of a possible infringement, matters of pure fact, fall, of course, within the jurisdiction of the national court. However, I take the view that characteristics such as the ‘specific composition based on shapes, colours, words and numbers’, the ‘combination of colours’, the ‘placement of the pocket on the stomach’ or even ‘the way the jeans are made by assembling the three pieces’, which Cofemel is alleged to have copied, should be analysed as ideas capable of being expressed differently, or even as practical solutions,⁴⁸ and should not be protected by copyright.

⁴⁵ It may be different with regard to some related rights, for example with respect to phonograms, in relation to which it is difficult to talk about inspiration (see my Opinion in *Pelham and Others* (C-476/17, EU:C:2018:1002).

⁴⁶ Judgment of 22 December 2010, *Bezpečnostní softwarová asociace* (C-393/09, EU:C:2010:816, paragraphs 49 and 50).

⁴⁷ Judgment of 1 March 2012, *Football Dataco and Others* (C-604/10, EU:C:2012:115, paragraph 33).

⁴⁸ A pocket placed on the back of a sweatshirt is not of much use.

61. Moreover, by relying on the innovative and unique (at the time) character of its G-Star Elwood design, introduced in 1996, it would appear that G-Star is seeking copyright protection for its reputation and the distinctive character of its goods which are normally protected by trade mark law.

62. It is true that infringement of copyright need not, in any case, consist in the complete reproduction of the work. The various parts of a work also enjoy protection, provided that they contain elements which are the expression of the intellectual creation of the author of the work.⁴⁹ They must not be elements merely inspired by the ideas expressed by the work but parts drawn from that work. The assessment in that regard should be carried out by the court adjudicating on the substance on a case-by-case basis. In the context of that assessment, that court must also ensure that the subject matter in respect of which protection is sought is sufficiently identifiable.⁵⁰

63. Third and last, copyright differs from the law relating to designs in the assessment of the infringement of protected exclusive rights. In line with the wording of Article 10(1) of Regulation No 6/2002, the scope of the protection conferred by the law relating to designs includes ‘any design which does not produce on the informed user a different overall [visual] impression’. That concept of the overall [visual] impression is completely alien to copyright.

64. Copyright protects a specific work, as opposed to a work which has such a visual aspect.⁵¹ Two photographers capturing the same scene at the same time may get images which do not produce a different overall [visual] impression. In terms of the law relating to designs, whoever publishes his photograph first may oppose the publication of the other photograph. That is not the case under copyright, where parallel creation, provided that it is original, is both lawful and enjoys full protection as a separate work. The same is true of a creation inspired by earlier works. To the extent that that creation does not constitute an unauthorised reproduction of original elements of another’s work, the question of copyright infringement does not arise, irrespective of whether the overall [visual] impression is different.

65. Copyright thus allows the author of a design to oppose the publication and use of a design which does not produce a different overall [visual] impression only to the extent that it is possible to establish the reproduction of original elements of his design.

66. In evaluating an application for the protection of a design by copyright, a court must take those elements into account in order to distinguish between what may fall within the scope of the *sui generis* protection of designs and what may fall within the scope of copyright protection, thus avoiding any confusion between those two protection regimes.

Conclusion

67. In the light of all the foregoing, I propose that the Court answer the questions referred by the Supremo Tribunal de Justiça (Supreme Court, Portugal) as follows:

- (1) Article 2(a) 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, as interpreted by the Court, precludes industrial designs from being protected by copyright only if they have increased artistic character, exceeding what is normally required of other categories of works.

⁴⁹ Judgment of 16 July 2009, *Infopaq International* (C-5/08, EU:C:2009:465, paragraph 39).

⁵⁰ See judgment of 13 November 2018, *Levola Hengelo* (C-310/17, EU:C:2018:899, paragraph 40).

⁵¹ Markiewicz, R., *Ilustrowane prawo autorskie*, Wolters Kluwer, Warsaw, 2018, p. 79.

- (2) In evaluating an application for the protection of an industrial design by copyright, a national court must take account of the objectives and mechanisms specific to copyright, such as the protection not of ideas but of expressions and the criteria for assessing an infringement of exclusive rights. By contrast, the national court cannot apply to protection by copyright the specific criteria of the protection of designs.