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## AG Campos Sanchez-Bordona's opinion in Brompton Bicycle – The good, the bad and the contradictory – Part I

Estelle Derclaye (The University of Nottingham) · Thursday, February 13th, 2020

This case concerned the famous Brompton bicycle which can be folded to carry away after use ([Case C-833/18, SI, Brompton Bicycle Ltd. v. Chedech / Get2Get](#)). The bike was once protected by a patent and, following its expiry, the defendant (Chedech/Get2Get) embarked on selling a



similar bike in Belgium (the designs of the two bikes are depicted in the AG Opinion linked above). Brompton then sued for copyright infringement. In Belgium, the multiplicity of shapes theory, according to which a shape is not considered necessary to achieve a technical result if there is proof that other possible shapes are available which allow the same technical result, applies in copyright law. Unsure whether this complied with EU law, the Tribunal de l'Entreprise of Liège referred the matter to the Court of Justice, asking the following questions:

“(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?”

After discussing these questions, Advocate General Campos Sanchez-Bordona ('the AG') suggests that the court answers the questions as follows:

“(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.”

The AG's opinion starts with rather long preliminary observations (paras 31-45). Even if the bicycle was never protected by a design but only by a patent, the AG considers design law to answer the national court's question. In essence, the AG repeats the caveats already stated by AG Szpunar and repeated by the court in *Cofemel v G-Star Raw*.<sup>[1]</sup> The AG stresses the differing goals of copyright on the one hand and patent/design protection on the other hand and emphasises that patents and designs both promote innovation and competition, have a short duration, must be new and are published and thus allow competitors to know the scope of protection (the last characteristic admittedly only for registered designs). If copyright (which has a longer term and subsists without registration) were allowed to cut across patent and design laws' goals of promoting technology and fostering competition, the careful balance of the latter protections would be disturbed. Thus, while cumulation is possible, its force is reduced by these caveats.

After these 25 paragraphs, the AG turns to the questions asked by the referring court.

On the first question, AG Campos again relies heavily on *Cofemel*. He summarises the court's case law on originality, repeating that aesthetic considerations should not be taken into account to judge a work's originality (para. 60) and referring to the court's case law on functionality, namely *BSA* and *Football Dataco v Yahoo! UK*. It follows from this case law 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” (para. 65, original emphases). That said, if “a design merely has a number of functional aspects, that does not deprive it of copyright protection” (para. 67) but “if the functional elements predominated over the artistic elements to the extent that the latter became irrelevant” then copyright should not subsist (para. 68). On this AG Campos refers later to *Lego Iuris v OHIM*, which he proposes to apply by analogy (para. 71-74). The AG explains that the rule he proposes, or that in fact arises implicitly from his analysis, which can be derived from the *BSA* and *Football Dataco* cases, is the same as that in both design and

trademark law (i.e. art. 8(1) design regulation and 7(1) trade mark regulation and corresponding articles in the design and trade mark directives), adopting therefore the principle of negative convergence between copyright, design and trade mark law on this point.<sup>[2]</sup> He concludes this part by stating that if the national court (as he understands to be the case) believes that the shape of the bicycle is necessary to achieve the technical result then it should not benefit from copyright protection.

The AG then moves on to the four sub-questions of the national court's second question. As to the existence of an earlier patent, the AG adopts a similar line of argument to that in paragraph 10 of the European Copyright Society's (ECS) opinion, namely that an expired patent is useful to determine the functionality of the work in question but in no way dictates that the shape is excluded – it will depend on the facts in each case. As to the existence of other possible shapes which allow the same technical result to be achieved, the AG recommends adopting the court's test in *Doceram*. He thus rejects the multiplicity of shapes theory and adopts the causality approach. According to this latter theory, the exclusion applies when the features of appearance of the shape in question are solely owed to technical considerations, without regard to other considerations, whether they are aesthetic or not.<sup>[3]</sup> However, he adds that “[i]n the case of designs where the intersection of art and design is particularly striking, there will be greater opportunities for creative freedom to shape the appearance of the product.” So 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” (para. 85, fn omitted). This confirms his answer to the first question. In view of the referring court's strange question about the intention of the infringer, the AG gives a straightforward answer (it is not relevant) but then moves on, obiter, to discuss the intention of the designer. The AG relies on *Doceram* to assert that this can be taken into account in the criteria to determine the copyrightability of the 3D work (paras 92-93). This is bizarre since the intention of the designer is clearly a subjective criterion and the court in *Doceram* only refers to objective considerations, without citing, as AG Saugmandsgaard Øe had done, this criterion. AG Campos then adds, even more obiter so to speak, that criteria such as the design's exhibition in museums or its recognition through awards are irrelevant. This is to be applauded but it contradicts the previous finding, as these are, like the designer's intention, subjective criteria. Lastly, as to the effectiveness of the shape in achieving a technical result, the AG does not add much as the referring court does not provide explanations as to this sub-question.

The opinion ends on two final remarks. First, AG Campos relies by analogy on AG Saugmandsgaard Øe's opinion in *Doceram*, stating that the four criteria given by the Liège court to determine whether a 3D work is copyrightable are not exhaustive. Second, he states that even if the shape of the bicycle was to be excluded from copyright protection, it could potentially be protected by parasitic or slavish imitation in some Member States, as this aspect of unfair competition law is not yet harmonised at EU level.

Overall, the opinion is a mixed result. It makes some good points but also some ill-judged ones. These will be discussed in more detail in Part II of this post.

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<sup>[1]</sup> See AG opinion in *Cofemel* at paras 50-52 and Court, paras 50-52.

<sup>[2]</sup> On negative convergence, see A. Quaedvlieg, ‘Concurrence and Convergence in Industrial

*Design: Three-Dimensional Shapes excluded by Trade Mark Law', in W. Grosheide and J. Brinkhof (eds), Intellectual Property Law, Articles on Crossing Borders between Traditional and Actual (Antwerpen, Intersentia 2004) 23.*

<sup>13)</sup> For a full illustration of the criterion and references, see the Opinion of AG Saugmandsgaard Øe, para. 21.

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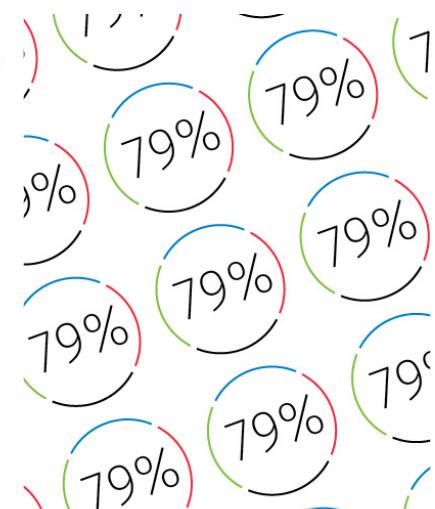
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