

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

Kluwer Copyright Blog  
February 18, 2020

Estelle Derclaye (The University of Nottingham)

Please refer to this post as: Estelle Derclaye, 'AG Campos Sanchez-Bordona's opinion in Brompton Bicycle - The good, the bad and the contradictory - Part II', Kluwer Copyright Blog, February 18 2020, <http://copyrightblog.kluweriplaw.com/2020/02/18/ag-campos-sanchez-bordona-opinion-in-brompton-bicycle-the-good-the-bad-and-the-contradictory-part-ii/>

Part I of this post provided an overview of the facts of the case and the recent opinion of AG Campos Sanchez-Bordona. Overall, the opinion is a mixed result. It makes some good points but also some ill-judged ones, and these will be explored in more detail in this post.



Let us start with the positive aspects. These are, namely, the rejection of the recognition of the design via awards of museum exhibitions and the like, the application of the causality approach and the corresponding rejection of the multiplicity of shapes theory, and the reflections on the protection of the work by an earlier patent. The court should follow them.

Let us look now at the problematic aspects of the opinion. The main criticism is that the opinion is in part contradictory. It relies on the court's case law relating to originality (referring to *Infopaq*, *Levola* and *Cofemel*) and thus states that aesthetic considerations should not be taken into account. However, it then includes the designer's intention as one criterion to judge whether a 3D work is copyrightable, which is clearly subjective, while the court in *Levola* rejects subjectivity. It cannot be stressed enough that the court should not follow the argument that the designer's intention is a relevant consideration in determining copyright protection of 3D works, as it is a subjective criterion. Even if AG Saugsmangaard Oe included it as one of the criteria in his opinion in *Doceram*, the court did not mention it - on the contrary it only mentioned objective criteria. It is clear that such a criterion is subjective and cannot form part of the objective circumstances to which the court in *Doceram* refers. If the court did follow the AG opinion on this point, it would in effect reverse its *Doceram*, *Cofemel* and *Levola* decisions.<sup>[1]</sup>

Another criticism of the opinion is that it only pays lip service to the very important precedents of *BSA*, *Football Dataco* and *Painer*. While relying on them, the AG does not develop their specificity compared to the trade mark and design case law on functionality. The court should rely on them more forcefully and especially clarify the obscure statement it made in paras. 97-98 of *Painer*. As the ECS opinion on *Brompton* states in its paras. 20-22, even if the questions asked by the referring court only refer to eligibility for protection and not scope, the former implies the latter: there is a direct link between the delineation of what is protectable and what is not, and the scope of the exclusive right conferred. In *Painer*, arguably the court did not rule out the possibility that differences in the degree of creative freedom due to the presence of constraints (here: technological) should also be taken into account in determining the scope of protection, besides eligibility. Accordingly, this goal may be easily reached by pointing out that features of the shape of a utilitarian article which are functional and directly conditioned by the technical result to be achieved will be given no weight or, depending on the circumstances, at least less weight for a finding of infringement than those which are the result of free choices of the creator and that reflect his personality. The *Brompton* case is an ideal opportunity for the court to state this clearly.

Another problematic aspect of the AG's opinion is the application by analogy of the trade mark exclusion (art. 4(1)(e)(ii) of the trade mark directive). There are hidden risks of relying on other intellectual property rights by analogy.<sup>[2]</sup> The AG rightly says that if this is to be done, it needs to be done cautiously. However, in this specific case, a much more thorough analysis of the consequences of applying the criteria for the functionality exclusions of trade mark and design law should have been done. This is because the court quasi never reverses itself (the *Café Hag I* and *II* decisions are very old examples of such reversals<sup>[3]</sup>), so if it embarks on this, it will be stuck with it forever. If the court is minded to adopt the result of the AG's argumentation on the first question, it should be very wary of doing so by referring to a so-called negative convergence between copyright, trade mark and designs of functional shapes. Preferably, as it did in *Levola*, it should apply the solution but not refer to the AG's reliance on trade mark law.

The last point of the opinion (para. 100) creates further confusion because, arguably, if the shape cannot be protected by copyright, trade mark or patent, it should not be protectable at all by parasitic or slavish imitation, as this would defeat the exclusion carved in the intellectual property laws and allow an indefinite protection of the shape. Only if an act distinct from such slavish copying (such as risk of confusion or denigration) exists, should it be possible to use unfair competition law. Many Member States do not have (e.g. Germany) or no longer have (e.g. France) slavish or parasitic imitation in their unfair competition laws for that very reason. Again, the AG contradicts his preliminary remarks on the differing goals of the patent, copyright and design laws as the rationale is the same: allowing claimants to win on slavish or parasitic competition cuts across those goals and makes the intellectual property rights 'devoid of substance', to borrow his own words (para. 45). In sum, the court should follow the correct aspects of AG Campos's opinion and disregard the other, ill-judged, ones.

<sup>[1]</sup> *Doceram*, paras 37-38; *Case C-683/17, Cofemel*, paras 32-34 and 53; *Case C-310/17, Levola*, paras 41-42 and, as the ECS opinion suggested: "the subjective intention of the designer is not a workable criterion as it is extremely hard to detect and decipher ex post. This is even more so if we consider that reference to a subjective criterion such as the intent of a designer does not possess the certainty and objectivity required for the purpose of establishing the existence of a "work", which the court has specifically imposed in his recent copyright case law."

<sup>[2]</sup> E. Derclaye, "Right and wrong analogies. The CJEU's use of trade mark concepts in copyright and design law" (2020) *European Intellectual Property Review* 78-83.

<sup>[3]</sup> *Judgment of the Court of 3 July 1974, Case 192-73, Van Zuylen frères v Hag AG, ECLI:EU:C:1974:72* and *judgment of the court, case C-10/89, SA CNL Suca v. Hag GF AG, 17 October 1990, ECLI:EU:C:1990:359.*