Kluwer Copyright Blog

Fabrics can be works of artistic craftsmanship in the UK: Response Clothing Ltd v The Edinburgh Woollen Mill Ltd

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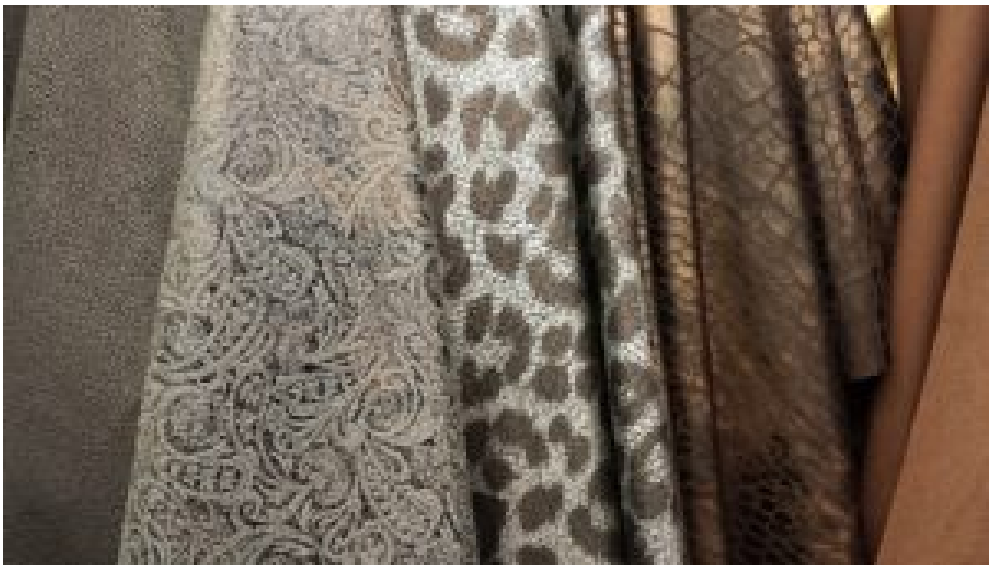

In ***Response Clothing Ltd v The Edinburgh Woollen Mill Ltd*** **[2020] EWHC 148**, His Honour Judge Hacon ("**HHJ Hacon**") found that copyright subsisted in a fabric design as a work of artistic craftmanship and that the sale of garments made from such fabric amounted to copyright infringement.

The case is an interesting development in English law and the first that begins to consider the CJEU's *Cofemel* decision. It provides guidance about the qualification for works of artistic craftsmanship and seemingly expands that scope of copyright protection in the UK. It is a helpful case for owners of certain types of consumer products, which might usually be unable to have copyright enforced. However, the legal analysis and reasoning of HHJ Hacon might expose the judgment to criticism on a number of points.

Facts & Background:

The claimant, Response, is a clothing company involved in the design and marketing of clothing products. The defendant, EWM, is a major retailer of clothing with about 400 stores across the UK.

Between 2009 and 2012, Response supplied EWM with ladies' tops made of a jacquard fabric with a design referred to as a 'wave arrangement' (the "**Wave Fabric**"). In 2012, Response attempted to raise the price of the tops, but EWM rejected the price increase and sought alternative suppliers. After stopping its supply from Response, a number of other companies supplied EWM with garments made from jacquard fabric.

Response issued infringement proceedings claiming that copyright subsisted in the Wave Fabric as an artistic work (under s.4 of the Copyright, Designs and Patents Act 1988 ("**CDPA 1998**") either as (a) a graphic work; or (b) a work of artistic craftsmanship. Response alleged that the other garments made from jacquard fabric were infringing copies of the Wave Fabric and that EMW's sales of garments made from those infringing fabrics amounted to primary and secondary copyright infringement.

It is important to understand the only way to enforce copyright in certain types of consumer products is if they qualify as artistic works such as works of artistic craftsmanship. If they do not, then section 51 of the CDPA prevents the copyright in those products being enforced against copies and the owner will instead have to rely on the unregistered design right (if possible) which has a shorter term.

Findings of HHJ Hacon:

1. The fabric as a graphic work

According to HHJ Hacon, all the examples of graphic works set out under the CDPA 1988 "*are created by the author making marks on a substrate to generate an image*". Despite recognising that the examples in the statutory definition are not exhaustive, HHJ Hacon adopted a narrow interpretation of the statutory language noting that *"[i]t does not follow that the definition is endlessly flexible"*. Without explaining why he had adopted such a narrow view of the statutory language, HHJ Hacon found that the definition of a graphic work could not be extended to include a fabric design, regardless of whether it was made on a loom or knitting machine.

2. The fabric as a work of artistic craftsmanship

Having concluded that the Wave Fabric was not protectable as a graphic work, HHJ Hacon moved to consider if the Wave Fabric qualified as a work of artistic craftmanship. After a fairly extensive analysis of the House of Lords judgments in *Hensher**[1]*, HHJ Hacon felt unable to discern any binding principles on the meaning of artistic craftsmanship; instead he adopted the test framed by Tipping J in the High Court of New Zealand decision of *Bonz Group (Pty) Ltd v Cooke**[2]*.

Adopting the approach of Tipping J in *Bonz*, HHJ Hacon explained that in order to qualify as a work of artistic craftsmanship it would be necessary to show Wave Fabric was (a) a work of craftmanship in the sense that the creation of the fabric required skilful workmanship; and (b) artistic in the sense that it was produced with creative ability that produced aesthetic appeal. On the facts, HHJ Hacon was satisfied that the creation of the Wave Fabric involved the necessary craftsmanship and that the commercial success of the design illustrated the required aesthetic appeal.

After finding that the Wave Fabric qualified for protection as a work of artistic craftsmanship, the judge provided the following guidance on the definition of artistic craftsmanship:

- it is possible for a work of artistic craftsmanship to be made using a machine;
- aesthetic appeal can be of a nature which causes the work to appeal to potential customers; and
- a work is not precluded from being a work of artistic craftmanship solely because multiple copies of it are subsequently made and marketed.

3. Infringement

Having concluded that copyright subsisted in the Wave Fabric, HHJ Hacon went on to find that the other jacquard fabrics used for the garments sold by EWM copied a substantial part of the Wave Fabric design, therefore EWM's sales of tops made from those infringing fabrics amounted to secondary infringement contrary to s.23 of the CDPA 1988. In contrast, HHJ Hacon held that the sales by EWM did not amount to primary infringement in the form of issuing to the public contrary to s.18 of the CDPA 1988. According to HHJ Hacon, the previous sale from a supplier to EWM qualified as issuing to the public as that sale transferred to EWM the right to dispose of the fabric, therefore EWM's subsequent sales did not qualify as issuing to the public.

Comment

HHJ Hacon provides some useful guidance on what is required for a work to qualify as artistic craftsmanship. The guidance given by HHJ Hacon appears to have watered down the ostensible requirements of "artistic appeal" and "craftsmanship" which may be welcomed by a host of industries as a considerable expansion in the scope of copyright protection. However, the reasoning of HHJ Hacon on a number of issues is curious.

The judge's finding on graphic work

According to HHJ Hacon the statutory definition of "graphic work" could not extend to include a fabric design. There is a tension between the judge's narrow interpretation of the statutory language and focus on the medium which captures the work on one hand, and the judgment of Birss J in *Abraham Moon* on the other. In *Abraham Moon,* Birss J is clear that when it comes to artistic works the focus is on the content of the work rather than the medium on which the work is recorded. Oddly, HHJ Hacon did not refer to *Abraham Moon* in his analysis and, contrary to the approach of Birss J, his characterisation of the statutory examples and his conclusion that "fabric" would not fall within statutory language is evidently driven by the medium in which the fabric design was recorded rather than the content of the fabric design itself.

HHJ Hacon later refers to the *Levola Hengelo* decision and quotes a passage of that judgment which expressly refers to Art.2(1) of the Berne Convention which provides for the protection of artistic works "*whatever the mode or form of its expression*". Having referred to that quote in his judgment, it is unclear why the judge placed so much weight on the medium of the Wave Fabric. Had HHJ Hacon followed *Abraham Moon* and *Levola Hengelo* and not focused on the fabric as the medium for the work, he may well have reached a different conclusion on whether the Wave Fabric constituted a graphic work.

The application of Cofemel – requirement for aesthetic appeal

The decision in *Response* is the first English court decision to 'consider' the implications of the CJEU decision in Cofemel. In *Cofemel* the CJEU reaffirmed that originality is the only qualifying criteria for copyright protection under Article 2(a) of the InfoSoc Directive and any national laws which make copyright protection contingent on artistic value are incompatible with the InfoSoc Directive. The apparent implication of the decision in *Cofemel* is that the traditional interpretation of works of artistic craftmanship, in particular the requirement for "artistic" or "aesthetic" appeal, is inconsistent with EU law.

The facts in *Response* seemed to provide a prime opportunity for HHJ Hacon to grapple with the compatibility of national law post-*Response*. However, on the facts of the case, he found that the Wave Fabric had aesthetic appeal. In other words, he was not faced with the question of whether a

design without aesthetic appeal could qualify as a work of artistic craftmanship post-*Cofemel*.

HHJ Hacon expressly recognised that "*[c]omplete conformity with art.2, in particular as interpreted by the CJEU in Cofemel, would exclude any requirement that the Wave Fabric has aesthetic appeal and thus would be inconsistent with the definition of work of artistic craftsmanship stated in Bonz Group*". Having acknowledged the consequence of *Cofemel* the judge still felt able to apply the test for artistic craftmanship based on *Bonz.* The judge's reasoning for not properly engaging with *Cofemel* is somewhat circular in the sense that he avoided considering if the requirement for aesthetic appeal was consistent with *Cofemel* by applying that very test and finding that the Wave Fabric had the required aesthetic appeal.

We now have a High Court decision with an express acceptance that *Cofemel* precludes any requirement for a work to have aesthetic appeal whilst applying that very test to determine if copyright subsists in a work of artistic craftmanship. Hopefully a case comes to court in the near future with a fact pattern that allows the court to fully test the decision in *Cofemel* and the impact that has on English Law.

The application of Cofemel – closed categories of protectable subject matter

Post-*Cofemel,* if the only criteria for copyright protection to arise is originality, there is an implication that exhaustive lists of protectable subject matter, such as that contained in the CDPA, are also incompatible with EU law. Again, this issue was not addressed by HHJ Hacon in *Response*. *Response* can be contrasted with the recent *Charlotte Tilbury* decision (see previous blog here). In that case, the Deputy Master held that "artistic copyright" subsisted in two designs embodied in Charlotte Tilbury's 'Filmstar Palette', without expressly assigning those designs to a particular category of artistic work.

Again, it will be interesting to see how the English Court deals with this aspect of English copyright law following *Cofemel.* For the time being the English courts are technically bound by the decision, but post-Brexit this may be one of the first areas where we see UK copyright protection diverge from the position in the EU.

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[1] George Hensher Ltd v Restawhile Upholstery (Lancs) Ltd [1976] AC 64

[2] [1994] 3 N.Z.L.R. 216

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