Kluwer Copyright Blog

Rowing nowhere? Long awaited IPEC judgment confirms UK law on works of artistic craftsmanship is incompatible with EU law

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The long-awaited and much anticipated judgment of the Intellectual Property Enterprise Court ("**IPEC**") in *Waterrower (UK) Limited v Liking Limited (t/a TOPIOM)* [2024] EWHC 2086 ("***WaterRower*"**) was finally handed down last month. IP practitioners and the wider design community have been eagerly awaiting the decision as it was expected to be the first UK decision to grapple with the boundaries of UK copyright protection and thorny issues surrounding the protection of works of artistic craftsmanship under s.4(1)(c) of the Copyright Designs and Patents Act 1988 ("**CDPA**").

The Judge held that the WaterRower did not qualify for protection as a work of artistic craftsmanship under s.4(1)(c) CDPA, but that it did satisfy the EU threshold originality. The outcome means the statutory regime in the UK providing copyright protection for works has been formally recognised by the courts as being irreconcilable with EU law. The consequence is that we now need a decision of an appellate court or an Act of Parliament to clarify what the correct legal position is, and if the threshold for copyright protection is solely the *Cofemel* test of originality or the criteria prescribed by the closed list in the CDPA.

We have covered a number of previous cases where the English court has touched on these issues, but was able to avoid tackling them head on based on the facts of each (see here and here). On this occasion Deputy Judge Campbell Forsyth was forced to grasp the nettle and wrestle with these thorny issues. However, the outcome of the case has not necessarily brought the desired clarity. Further, the judgment outcome has the consequence that the UK does not recognise copyright protection for works of applied art.

Factual background

The Claimant, Waterrower (UK) Ltd, claimed that various iterations of the WaterRower were protected by copyright under s.4(1)(c) CDPA as "works of artistic craftsmanship".

By way of reminder, the CDPA has a 'closed list' of specified works which qualify for copyright protection. Further to avoid the consequences of the poorly worded s.51 CDPA, which in essence prevents copyright in a functional non-artistic article being infringed unless it is it is an 'artistic'

work', the Claimant needed the WaterRower to fall within one of the specified works in the CDPA's 'closed list', specifically work of artistic craftmanship.

The original creator of the WaterRower (pictured below) was Mr James Duke, a former rower with experience designing and building boats, including rowing boats.

The Claimant alleged that the Defendant, Liking Limited (t/a TOPIOM), copied and reproduced a substantial part of the copyright works in its "TOPIOM" rowing machine. The Defendant argued that the WaterRower did not qualify as a work of artistic craftsmanship because the design was not original and had been dictated by technical and functional constraints.

Guidance on the assessment of "works of artistic craftsmanship" under UK law

A considerable portion of the judgment is devoted to analysing the UK authorities on works of artistic craftsmanship, in particular the leading House of Lords authority, *Hensher v Restawhile*[1] and more recent authorities, such as *Response Clothing*. Despite acknowledging the difficultly of interpreting *Hensher* and attempting to align the approaches taken in subsequent cases, the Judge managed to extract several threads of guidance on the assessment of works of artistic craftsmanship:

1. More than "eye appeal" is required – a work of artistic craftsmanship will often have visually appealing aesthetics, but evidence of that quality is not determinative of the assessment.
2. "Aesthetic appeal" can be of a nature which causes the work to appeal to potential customers.
3. The assessment should avoid a qualitative evaluation of "*artistic merit or quality"*.
4. The process of creating a work of artistic craftsmanship and the resulting work are intrinsically linked: the craftsmanship creating the work must be artistic.
5. It is the craftsmanship in the work that is relevant to determining if the author is a craftsman, not the qualification or training of the craftsman (although skills and training will assist in assessing the questions of craftsmanship).
6. Mass manufacture of the work does not preclude it from being a work or artistic craftsmanship.

Thus, the assessment is multi-factorial and requires the court to consider and balance a host of factors from the author's own intention to public perception of the work.

Compatibility between EU and UK law

The CJEU decisions in *Cofemel* and *Brompton* confirm that "works" are protected by copyright under EU law provided they are original, in the sense that they are expressions of the author's own intellectual creation. *Cofemel* ruled that Member States cannot impose any requirement that a work has 'aesthetic appeal' or is otherwise 'artistic' in order to attract copyright protection under EU law. In contrast, it was clear from the line of UK authorities that to attract protection as a work of artistic craftsmanship, the work must (among other things) have "*artistic merit*" which is "*something more than eye appeal*", therein lying the source of the tension between the two positions.

Ultimately, the Judge felt unable to resolve that tension and reconcile the two legal positions. Construing s.4(1)(c) in accordance with the InfoSoc Directive as interpreted by the CJEU would require the court "*go against the grain of the wording of the CDPA and distort the intention of Parliament*".

The Judge's findings on copyright protection for the WaterRower

Notwithstanding his finding on the inconsistency between UK and EU law, the Judge accepted that the court remains under a strong duty to interpret UK law in conformity with the InfoSoc Directive, which forms part of retained EU law post-Brexit. To navigate that inconsistency and achieve what the Judge described as "partial conformity" he adopted a hybrid two-step approach to s.4(1)(c): the first step involves applying the EU standard of originality as a "gateway"; if the work is original according to the EU standard, the second step involves assessing whether it qualifies as a work of artistic craftsmanship under UK law.

The Judge held:

1. the WaterRower **was original according to the EU standard** applying *Cofemel* and *Brompton*, however,
2. the WaterRower **did not qualify as a work of artistic craftmanship** under s.4(1)(c) CDPA.

Step 1: qualification as an original work under EU law

The Judge concluded that the genus design of the WaterRower, the "Prototype", was an original work within the meaning of the InfoSoc Directive because it was the author's own intellectual creation, as understood by the CJEU decisions in *Cofemel* and *Brompton*. Even though the Judge acknowledged that aspects of the WaterRower's shape and structure were limited by technical constraints and functional considerations, he found that the shape was not solely dictated by function. Indeed, the Judge held that there was sufficient room for Mr Duke to "*reflect his personality in the subject matter, combining these striking visual elements as an expression of his free and creative choices*".

In contrast, the Judge held that adaptations in later iterations of the WaterRower were designed to improve functional aspects, such as manufacturability, efficient assembly and supply issues. These changes all fell "*in the camp of functional constraints or practical alternatives*". Therefore, the

Judge held that the iterative changes did not result from Mr Duke's free and creative choices and so did not reflect an expression of his own intellectual creation.

Step 2: qualification as a "work of artistic craftsmanship" under UK law

When it came to assessing the WaterRower as a work of artistic craftsmanship the Judge adopted a multi-factorial analysis of all the relevant evidence before him and having regard to the "*ordinary and natural"* meaning of the statutory language in s.4(1)(c).

On the evidence, the Judge accepted that Mr Duke was a craftsman. In creating the WaterRower, Mr Duke had exercised significant skill and effort, and took great care and pride to preserve and enhance the natural beauty of the wood used in the design. The Judge went on to accept that the evidence showed "*a significant section of the public found the WaterRower design aesthetically pleasing*" and that there was "*high regard for the quality of the design"*.

However, when assessing the subjective intentions of Mr Duke the Judge found that although he had intended the WaterRower to have "*aspirational sensory impact*", Mr Duke lacked the intention to "*produce something of beauty which would have an artistic justification for its own existence*" as required by *Hensher*. Consequently, he found that the WaterRower fell short of the requisite artistic quality to qualify as a work of artistic craftsmanship. In reaching this conclusion the Judge was evidently influenced by the technical constraints of designing a rowing machine and placed considerable weight on the underlying subjective intentions of Mr Duke, which the Judge held to be primarily commercially motivated.

Unsurprisingly, the Judge reached the same conclusion in respect of the iterative adaptations of the WaterRower, concluding that the nature of the changes was "*workmanlike*" and the purpose was "*predominantly of a practical nature*" to improve the "*manufacturability and commerciality"* of the WaterRower.

The implications of WaterRower and what does the future hold

The *WaterRower* judgement raises a host of issues and arguably gives rise to more questions than answers. We wanted to pick up on the following two issues specifically:

1. First, is the subjective intention of the author now the primary factor for assessing works of artistic craftsmanship or did the Judge give too much weight to this factor?
2. Second, what is the correct test to apply to determine copyright protection for works of artistic craftsmanship moving forwards?

On the first issue, despite finding that the WaterRower was made by a craftsman exercising skill and effort, and accepting evidence that the design was perceived by the public to be aesthetically pleasing, the Judge found that WaterRower still did not qualify as a work. The evidence on the author's intention was insufficient to show he intended to produce something of beauty which would have an artistic justification for its own existence.

The amount of weight the Judge attributed to the subjective intention of the author was surprising

and was essentially the determinative factor. The Judge's approach begs the question why if the public considers a work to be aesthetically pleasing should that be negated by the author's own intent. Save a thought for humble craftspeople who believe their works are not worthy and just go about their job never intending to produce a thing of beauty, but through their own genius are able to produce something which the public deem to be. Whether the Judge's approach elevates the subjective intention of the author to be the primary factor for assessing works of artistic craftsmanship remains to be seen though we would expect not, but then if not, why was subjective intention not given less weight than the public's perception in this case. The silver lining is that the judgment is clear that the assessment is multi-factorial, which would not prioritise one factor over the other.

On the second issue, UK and EU law in this area of copyright has been on a collision course for some time, so it is unsurprising that the Judge found that the law on s.4(1)(c) is irreconcilable with the EU standard of originality. However, the Judge's hands were tied – on the one hand being bound by the CDPA and *Hensher*, on the other hand being bound to consider CJEU case law and construe s.4(1)(c) in "conformity".

Whether the hybrid "gateway" approach adopted by the Judge achieves "partial conformity" is arguably irrelevant. Asking whether the Judge's approach was the correct one is perhaps the wrong question. The Judge was clear that the two tests are irreconcilable so it is difficult to see how the courts could construe s.4(1)(c) consistently with EU case law without leaving the statutory language meaningless. Perhaps the focus should be on how Parliament can solve the root of the problem by amending the CDPA and achieving 'full conformity' with EU law. Maybe the *WaterRower* decision can spark that debate and potentially an even wider discussion about more fundamental changes to the closed list system under the CDPA. Given the significance of this issue for the scope of UK copyright law, it is safe to say the IPEC decision will not be the final say on the matter.

The consequence of the current inconsistency is simple and impactful, works of applied art do not receive the same level of copyright protection under UK law as they do under EU law. That is evident from the findings in this case. Those consequences will be compounded by the recent CJEU decision in *Kwantum* which confirmed that works of applied art (arguably what the WaterRower machine is) emanating from outside the EU can qualify for copyright protection under the InfoSoc Directive if the article in question satisfies the cumulative criteria for a work (see more here).

The UK will now need to decide which waters it wishes to row in.

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

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