

The CJEU decision in Brompton Bicycle (Case C-833/18): An original take on technical functionality?

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The facts

This case concerns the protectability, or otherwise, by copyright of the Brompton Bicycle. In particular, it concerns whether copyright law has a technical functionality exclusion, and if so, how far the exclusion extends. The famous Brompton Bicycle has three different positions (a folded position, an unfolded position and a stand-by position enabling the bicycle to remain balanced on the ground). The folding bike was previously protected by a patent,¹ but that had expired. Brompton brought a copyright infringement action against Get2Get, which had launched its own, similar-looking version of a folding bicycle that worked in the same way. Get2Get raised a defence that the Brompton Bicycle was barred from copyright protection because its appearance was dictated by the technical solution sought, i.e. to enable the bicycle to fold/unfold in the once-patented manner. The makers of the Brompton Bicycle argued that it should not be barred from protection because there were other possible shapes that would allow a bicycle to be folded into three positions (the multiplicity of forms approach). However, the tribunal de entreprise de Liège noted that the CJEU had, in its recent design decision, *DOCERAM*, found that, in order to determine whether features of a product's appearance are solely dictated by its technical function, it must be established that the technical function is the *only* factor which determined those features (a causality-based approach), the existence of alternative designs not being decisive in that regard. The Belgian Court sought clarification from the CJEU as to what the correct approach is under EU copyright law where the appearance of the product is closely associated to a particular technical effect.

Directive 2001/29/EC² does not include a functionality exclusion for copyright protection, so the Belgian Court's first question asked: 'Must EU law, in particular Directive [2001/29],... be interpreted as excluding from copyright protection works whose shape is necessary to achieve a technical result?' The referring court then asked which, if any, of a list of four factors it provided would be relevant to 'ascertaining whether a shape is necessary to achieve a technical result', namely, the existence of other possible shapes that could achieve the same technical result; the effectiveness of the shape in achieving that result, the intention of the alleged infringer to achieve the result and the existence of an earlier patent for the process for achieving the technical result.

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¹ EP0026800B; see also <www.youtube.com/watch?v=pEA2jwsDv30> (accessed 14 July 2020) for illustration of the folding mechanism in action.

² 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 (OJ 2001 L 167, p. 10).

Legal background

Unlike the European systems for trade marks³ and designs,⁴ copyright has no explicit technical functionality exclusion. As the Advocate General in *Brompton* explained,⁵ the difficulty with this is that a product shape might benefit from the relatively short term of protection offered by patent or design law, and then, rather than entering the public domain, could be ‘re-enclosed’ by copyright, which would afford the copyright owner a significant term of protection. Alternatively, if copyright law offers largely equivalent protection, innovators might by-pass the patent and design systems (along with their in-built checks and balances) altogether. Similar concerns have fuelled the development of a substantial body of functionality case law in relation to the protection of technical product shapes by trade mark registration,⁶ though in the case of trade mark law, there is an explicit exception.

One traditional way of withholding copyright protection from functional shapes is to require a minimum level of artistic merit to qualify for copyright protection. However, this has been ruled out under EU copyright law in a previous recent case, in which the CJEU has adopted a position of *unité de l’arte*.⁷ Following *Cofemel*, any subject-matter can be protected by copyright as long as it is a ‘work’ - there can be no additional test of artistic merit.⁸ To qualify as a work, subject-matter must be (i) a sufficiently precise expression,⁹ and (ii) original. Generally we might except functional product shapes to be sufficiently precise – the *Brompton Bicycle* certainly was.¹⁰ However, there is more scope for developing limitations on functional shapes in the originality requirement, which the *Cofemel* Court defined as where ‘the subject matter reflects the personality of its author, as an expression of his free and creative choices’.¹¹ It is questionable how original an author can be where his choices of how the shape the product are constrained by requirements to make it work effectively. The Advocate General, in

³ Art.7(1)(e). Art 7(1)(e)(i) of Regulation (EU) 2017/1001 on the European Union trade mark [2017] OJ L154/1; Art 4(1)(e)(i) of Directive (EU) 2015/2436 to approximate the laws of Member States relating to trade marks (Recast) [2015] OJ L336/1.

⁴ Article 8(1) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1).

⁵ Case C-833/18, *Brompton Bicycle Ltd v Chedech/Get2Get*, Opinion of Advocate General M. Campos Sánchez-Bordona, ECLI:EU:C:2020:79, [39] to [56]. For more discussion of this Opinion, see I Fhima, ‘Functionality, cumulation and lessons from trade mark law: the Advocate General’s Opinion in *Brompton Bicycle*’ (2020) 15(4) *Journal of Intellectual Property Law & Practice* 301.

⁶ See, e.g. Case C-299/99, *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd*, ECLI:EU:C:2002:377; Case C-48/09 P, *Lego Juris v OHIM*, ECLI:EU:C:2010:516; Case C-205/13, *Hauck GmbH & Co. KG v Stokke A/S and Others*, ECLI:EU:C:2014:2233. Case C-683/17, *Cofemel - Sociedade de Vestuario v G-Star Raw CV*, ECLI:EU:C:2019:721, [50] to [55] and Case C-833/18, *Brompton Bicycle Ltd v Chedech/Get2Get*, Opinion of Advocate General M. Campos Sánchez-Bordona, ECLI:EU:C:2020:79, [46] to [65] have also highlighted the difficulties of cumulation between copyright and design law, but the *Brompton* Court focusses on the patent/copyright interface.

⁷ A Kur, ‘Unité de l’arte is here to stay - *Cofemel* and its consequences’ (2020) 15(4) *Journal of Intellectual Property Law & Practice* 290.

⁸ Case C-683/17, *Cofemel - Sociedade de Vestuario v G-Star Raw CV*, ECLI:EU:C:2019:721, [29]-[30].

⁹ C-310/17, *Levola Hengelo v Smilde Foods*, ECLI:EU:C:2018:899.

¹⁰ Case C-833/18, *Brompton Bicycle Ltd v Chedech/Get2Get*, ECLI:EU:C:2020:461, [28].

¹¹ Case C-683/17, *Cofemel - Sociedade de Vestuario v G-Star Raw CV*, ECLI:EU:C:2019:721, [30].

Brompton, suggested this route be taken. He drew attention¹² to analogous case law in relation to football fixture databases¹³ and graphical user interfaces,¹⁴ as examples of cases where technical constraints inherent in the subject matter meant that the author could not make free and creative choices in its creation, and where consequently, it was foreseen that the work would not be original.

Finding that the range of works that can be protected by copyright is limited by technical concerns begs the question though, *when* will these technical constraints be sufficient to prevent a work from being protected by copyright? This issue has attracted particular attention recently in relation to design law in *DOCERAM*.¹⁵ There the CJEU was asked whether the decisive question was one of ‘causality’, i.e. was the feature in question there to make the product work, or should a design feature be protectable, even if a feature does a technical job, provided there are other shapes that can achieve the same technical result – the ‘multiplicity-of-forms approach’. While early decisions of the European Intellectual Property Office (EUIPO) had favoured ‘multiplicity-of-forms’, the EUIPO had switched to a ‘causality’ approach.¹⁶ Similarly, the CJEU favoured ‘causality’ in *DOCERAM*,¹⁷ as indeed it had adopted an analogous stance in relation to trade mark law in previous cases.¹⁸ Was this approach appropriate for any judicially developed copyright exclusion, and if it was, what sort of evidence would be helpful in demonstrating it?

Finally, many product shapes contain a blend of functional and non-functional features. This issue is implicitly acknowledged by the CJEU, which rephrased the referred question to read: does ‘copyright ... appl[y] to a product whose shape is, *at least in part*, necessary to obtain a technical result’ (emphasis added).¹⁹ In that situation, should a shape be barred from protection altogether because competitors need access to the functional features? Or should it be protected because of the designer’s effort, investment or contribution in developing the non-functional features? This has been the subject of particular attention in trade mark law, where the CJEU has held that a shape mark with non-functional essential characteristics will benefit from protection because competitors can ‘design around’ such shapes.²⁰ Likewise, the design exclusion only denies a shape design protection in instances where all of a product’s features

¹² Case C-833/18, *Brompton Bicycle Ltd v Chedech/Get2Get*, Opinion of Advocate General M. Campos Sánchez-Bordona, ECLI:EU:C:2020:79, [62] to [65]. See also, Case C-683/17, *Cofemel - Sociedade de Vestuário v G-Star Raw CV*, ECLI:EU:C:2019:721, [31].

¹³ Case C-604/10, *Football Dataco v Yahoo!*, ECLI:EU:C:2012:115, [39].

¹⁴ Case C-393/09, *Bezpečnostní softwarová asociace - Svaz softwarové ochrany (BSA) v Ministerstvo kultury*, ECLI:EU:C:2010:816, [48] to [50].

¹⁵ Case C-395/16, *DOCERAM GmbH v. CeramTec GmbH*, ECLI:EU:C:2018:172.

¹⁶ Case R 690/2007-3, *Lindner Recyclingtech GmbH v. Franssons Verkstäder AB*, [2010] E.C.D.R. 1. For a discussion of ‘multiplicity-of-forms’, see J Schovsbo and G.B. Dinwoodie, ‘Design Protection for Products that are “Dictated by Function” in A Kur, M. Levin and J. Schovsbo (eds), *The EU Design Approach – A Global Appraisal* (Edward Elgar, 2018), pp 148-149; U Suthersanen and M Mimler, ‘An Autonomous EU Functionality Doctrine for Shape Exclusions’ (2020) 69(6) *GRUR International* 567, 568-569.

¹⁷ Case C-395/16, *DOCERAM GmbH v. CeramTec GmbH*, ECLI:EU:C:2018:172, [21]-[22] and [31] in particular.

¹⁸ Case C-299/99, *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd*, ECLI:EU:C:2002:377, [81] and [83]; Case C-48/09 P, *Lego Juris v OHIM*, ECLI:EU:C:2010:516, [53]- [58].

¹⁹ Case C-833/18, *Brompton Bicycle Ltd v Chedech/Get2Get*, ECLI:EU:C:2020:461, [20].

²⁰ Case C-48/09 P, *Lego Juris v OHIM*, ECLI:EU:C:2010:516, [48] and [52] in particular.

are *solely* dictated by its technical function. The Advocate General in *Brompton* favoured developing a trade mark-like approach for copyright,²¹ but would the CJEU agree?

The CJEU's decision

The meaning of a 'work': originality and expression

Copyright protects 'works.' There are two conditions for something to be a 'work': (i) it must be original subject-matter, which is the author's own intellectual creation and (ii) there must be an expression of that creation that is identifiable with sufficient precision and objectivity.²² The Court found that, following *Cofemel*,²³ for a work to be original, it must 'reflect the personality of its author, as an expression of his free and creative choices'.²⁴

The impact of technical constraints

Subject-matter will not be original, and hence will not be protectable by copyright where the 'realisation of the subject-matter' has been dictated by technical considerations, rules, or other constraints and these technical constraints have left no room creative freedom.²⁵ I would suggest that a proper understanding of such technical constraints could be well served by a consideration of extra-legal literature focussing on the design process.²⁶

However, the fact that the design has been dictated by technical constraints is *not* fatal to subject matter being original if, despite those technical constraints, there has been an opportunity for the author to reflect his personality through an expression of free and creative choices. In that situation, the design has not been *solely* dictated by technical constraints. This must be something different from the components of the subject matter that are technically functional, because protecting technically functional elements would amount (says the Court) to protecting ideas.²⁷ However, frustratingly, the CJEU does not give any examples of the sort of extra evidence or material that would demonstrate that the author has gone beyond the technical constraints in a way that reflects his personality. It appears that an element of choice is important – but choice as to what?

As noted above, a similar exercise occurs under the trade mark functionality doctrine. The trade mark functionality exclusion applies only when the mark consists 'exclusively of characteristics necessary to achieve a technical result'. The CJEU has interpreted this to mean that, even if a shape features technical characteristics, it will not be barred from trade mark

²¹ Case C-833/18, *Brompton Bicycle Ltd v Chedech/Get2Get*, Opinion of Advocate General M. Campos Sánchez-Bordona, ECLI:EU:C:2020:79, [76].

²² Case C-833/18, *Brompton Bicycle Ltd v Chedech/Get2Get*, ECLI:EU:C:2020:461, [22] and [25].

²³ Case C-683/17, *Cofemel - Sociedade de Vestuário v G-Star Raw CV*, ECLI:EU:C:2019:721.

²⁴ Case C-833/18, *Brompton Bicycle Ltd v Chedech/Get2Get*, ECLI:EU:C:2020:461, [23].

²⁵ Case C-833/18, *Brompton Bicycle Ltd v Chedech/Get2Get*, ECLI:EU:C:2020:461, [24].

²⁶ See, e.g. P. Bloch, 'Seeking the Ideal Form: Product Design and Consumer Response' (1995) 59 *Journal of Marketing* 16, 18-19, who mentions performance (which may include technical, environmental, service life, shelf life and durability, as well as aesthetics), ergonomic, production and cost, regulatory and legal, marketing programme (including storage, handling, transportation and display) and designer's constraints (e.g. desire to conform to professional norms).

²⁷ Case C-833/18, *Brompton Bicycle Ltd v Chedech/Get2Get*, ECLI:EU:C:2020:461, [27].

protection where it also has at least one non-minor, non-technical characteristic.²⁸ Any comparison across IP rights should be made with caution, given their different rationales and different scopes of protection. Moreover, it is noteworthy that the Advocate General in *Brompton* referred to the trade mark jurisprudence on essential characteristics in trade mark law,²⁹ but the CJEU refrained from doing so. Nonetheless, looking to trade mark law in this context does show that it is possible to devise an approach to functionality that separates out functional and non-functional elements, with a view to providing access for competitors to the former while protecting the latter. *DOCERAM* also suggests a similar approach in relation to designs.³⁰ The design functionality exclusion is limited to those ‘features of appearance of a product which are solely dictated by its technical function’. The Court interpreted this to mean that to meet this test ‘it must be established that the technical function is the only factor which determined those features’. In particular, the design of a product will not be excluded where considerations of a ‘visual aspect’ have played a role in the design process. Again, there is a separating out of functional and non-functional features. As in *Brompton*, provided that there is at least one feature where those non-functional choices are present, the product falls beyond the exclusion.

If the CJEU, in subsequent cases, continues down the route of separating out technical and non-technical elements, it will be essential to have a better understanding of what the parameters of a work are. In trade mark law, the starting point is the representation of the mark that forms part of the registration. There may not be such a definitive document in copyright, given its lack of formalities, and so it will be for the parties to debate the exact details of what constitutes the copyright work. Indeed, many product designs evolve via a series of prototypes or sketches, each with slightly different features.³¹ The likelihood of subject matter being solely dictated by technical function will be greater, the more narrowly the subject matter is defined. To take (my own) example, if the work is taken to be the connected bolt of the bicycle, it is likely to be entirely technical. On the other hand, if the work is the bicycle as a whole, there is greater opportunity for the author to make creative choices – for example, by the exact choice of the shape of the handles or the frame. This is a familiar concept in UK unregistered design right, where a design can constitute the ‘whole or any part’ of an article, meaning that claimants can as a consequence of the absence of any definitive statement of the design in a registration, define their designs to focus those parts reproduced in an allegedly infringing product.³² There is some indication of a possible future exercise in ‘salami slicing’ what we would normally think of as single copyright work in the fact that the CJEU speaks at one stage about

²⁸ Case C-48/09 P, *Lego Juris v OHIM*, ECLI:EU:C:2010:516, [52].

²⁹ Case C-833/18, *Brompton Bicycle Ltd v Chedech/Get2Get*, Opinion of Advocate General M. Campos Sánchez-Bordona, ECLI:EU:C:2020:79, [71] to [76].

³⁰ Case C-395/16, *DOCERAM GmbH v. CeramTec GmbH*, ECLI:EU:C:2018:172, [31] and [32].

³¹ Indeed, in this case the Advocate General, at [33], notes that the original version of the bicycle was different to that for which copyright was sought in this case, although both versions had the same folding mechanism.

³² Copyright Designs and Patents Act 1988, s.213(2). See e.g. *A Fulton Company Ltd. v Totes Isotoner (UK) Ltd.* [2003] EWCA Civ 1514.

‘components of a subject matter which are differentiated only by their technical function’³³ [emphasis added] as not meeting the criterion of originality.

A further question will be how to work out whether the element of the subject-matter that is non-functional reflects the author’s personality. The Court calls for ‘free and creative choices.’ Quite what constitutes a choice of this type in product design is not specified, but it should be noted that in *Painer*, a case involving a portrait photograph which has been treated as a definitional case for originality under EU law, the choices involved were fairly minimal.³⁴ We might hazard a guess that likewise, a very minimal distinction between the subject-matter and a functional shape would be enough to show that the designer has engaged in a choice that makes the work original. This would also be aligned with trade mark law (where the ‘added matter’ that converts functional shapes to non-functional shapes is an essential characteristic that is non-trivial³⁵) and design law (where a product shape is protected provided that one or more of its features of appearance are not solely dictated by technical function³⁶).

Looking further down the line, if copyright protection is granted to a shape composed of both functional and non-functional elements, difficult questions regarding the scope of protection arise when a third party reproduces only the functional elements of that shape. Arguably, the whole point of having a functionality exception is defeated if an infringement action can be brought in those circumstances.³⁷

Merger doctrine

One choice that will not suffice to make subject-matter original is where the choice is between different methods of implementing an idea that are ‘so limited that the idea at the expression become indissociable’. In other words, there may be some small degree of choice, perhaps between different forms of technical subject-matter, but choices that are so small as to be irrelevant. This is known in the US as the ‘merger doctrine’.³⁸ Its application in *Bromopton* is taken from the CJEU’s case law on copyright protection for graphic user interfaces.³⁹

Justifying a limitation on copyright based on technical constraints

The CJEU very briefly considered the underlying policy behind denying copyright protection to components of subject matter that are technically functional. Art.2 of the WIPO Copyright Treaty precludes granting copyright protection to ideas. More generally, granting copyright to

³³ Case C-833/18, *Brompton Bicycle Ltd v Chedech/Get2Get*, ECLI:EU:C:2020:461, [27].

³⁴ Case C-145/10, *Eva-Maria Painer v Standard Verlags GmbH*, ECLI:EU:C:2011:798, [98] (choice of background, pose, framing, lighting, angle, development techniques).

³⁵ Case C-48/09 P, *Lego Juris v OHIM*, ECLI:EU:C:2010:516, [52].

³⁶ Article 8(1) CDR.

³⁷ See, e.g. in the UK in relation to designs *Sealed Air Ltd v. Sharp Interpack Ltd* [2013] EWPC 23, as well as the discussion in J. Schovsbo and G. Dinwoodie, ‘Design Protection for Products that are “Dictated by Function”’, in A. Kur, M. Levin, J. Schovsbo (eds.) *The EU Design Approach: A Global Appraisal* (Edward Elgar, 2018) at pp 151-152.

³⁸ See, e.g. P Samuelson, ‘Reconceptualizing Copyright’s Merger Doctrine’ (2016) 63 *Journal of the Copyright Society of the USA* 417.

³⁹ Case C-393/09, *Bezpečnostní softwarová asociace - Svaz softwarové ochrany (BSA) v Ministerstvo kultury*, ECLI:EU:C:2010:816, [48] and [49].

ideas would make it possible to ‘monopolise’ ideas. This would be detrimental to technical progress and industrial development.⁴⁰

This paragraph is striking for its brevity. While at times the *Brompton* judgment feels very much like an exercise in technical copyright, this paragraph makes it clear that underlying the copyright technicalities is a desire to prevent monopolies. Although the *Brompton* decision embeds the copyright functionality exclusion firmly in copyright concerns regarding originality, this makes it clear that it is a tool to achieve a wider aim of protecting competition.⁴¹ This aligns it with the justifications offered for the trade mark and design functionality exclusions in other cases.⁴²

What is equally striking is what has been left out of the discussion on the underlying policy is cumulation.⁴³ Cumulation is the situation where a single artefact benefits from overlapping (i.e. cumulative) IP rights. The difficulty with cumulation is that the legislator has given strong protection in the form of certain IP rights, particularly patents, and to a lesser extent designs, for a limited period of time, at which point the subject matter enters the public domain. The difficulty with cumulation is that, on expiry of the ‘strong’ IP right, the owner may then attempt to ever-green their rights by relying upon protection under trade mark or copyright law, with their much longer terms of protection, thus preventing the subject-matter from entering into the public domain.⁴⁴ As discussed above, cumulation has played an important role in both the trade mark and design functionality cases. The Advocate General in *Brompton* devoted considerable attention to the difficulties of cumulation, particularly as between copyright and designs,⁴⁵ referring extensively to the CJEU’s *Cofemel* case.⁴⁶ However the CJEU in *Brompton* said nothing. Indeed, it accepted that there may be a degree of cumulation in its holding that a patent does not automatically negate the originality of subject matter. (Again, this is in line with earlier CJEU jurisprudence in trade mark and design law.)

An expression

⁴⁰ Case C-833/18, *Brompton Bicycle Ltd v Chedech/Get2Get*, ECLI:EU:C:2020:461, [27].

⁴¹ The ‘the intrinsic anti-competitive safeguards contained within copyright law’ are also discussed in U Suthersanen and M Mimler, ‘An Autonomous EU Functionality Doctrine for Shape Exclusions’ (2020) 69(6) *GRUR International* 567, 575.

⁴² Case C-299/99, *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd*, ECLI:EU:C:2002:377, [78] to [80]; Case C-48/09 P, *Lego Juris v OHIM*, ECLI:EU:C:2010:516, [43]; Recital 10 CDR and Case C-395/16, *DOCERAM GmbH v. CeramTec GmbH*, ECLI:EU:C:2018:172, [28]-[29].

⁴³ Although E Derlaye argues that the fact that the CJEU endorsed its Advocate General’s comments on cumulation in *Cofemel* means that not too much should be read into the absence of a discussion of cumulation in *Brompton*, see: ‘The CJEU decision in *Brompton Bicycle* – A welcome double rejection of the multiplicity of shapes and causality theories in copyright law’ (2020) Kluwer Copyright Law Blog <http://copyrightblog.kluweriplaw.com/2020/06/25/the-cjeu-decision-in-brompton-bicycle-a-welcome-double-rejection-of-the-multiplicity-of-shapes-and-causality-theories-in-copyright-law/?doing_wp_cron=1594590201.5337910652160644531250>.

⁴⁴ A cumulation of rights can, when the rights run simultaneously, allow the IPR holder to enforce its rights under the right with the most favourable infringement regime and narrowest defences.

⁴⁵ Case C-833/18, *Brompton Bicycle Ltd v Chedech/Get2Get*, Opinion of Advocate General M. Campos Sánchez-Bordona, ECLI:EU:C:2020:79, [46] to [56] (cumulation of copyright and designs) and [78] (cumulation of patents and other IPRs).

⁴⁶ Case C-683/17, *Cofemel - Sociedade de Vestuário v G-Star Raw CV*, ECLI:EU:C:2019:721.

The second condition for something to be a work was said by the Court to be an ‘expression’. This entailed the existence of subject matter that can be identified with precision and objectivity. In *Brompton* the national court had not raised any question regarding whether the bicycle was precisely and objectively identified, and so this element of the definition of a work was not discussed further.

Establishing whether a shape is necessary to obtain a technical result

In this case, the shape of the Brompton Bicycle *was* necessary to obtain a technical result, in the sense that the bicycle could be folded into three positions, one of which allowed it to balance on the ground folded. However, this was not automatically fatal to the shape being original because, to be barred, a shape must be *solely* dictated by its function. This will not be the case where, despite the shape including technical components/features, the author has none the less been able to express free and creative choices in addition to the technical content. This has to be the right kind of choice, i.e. one that allows the author to express their creative ability (we might call this a ‘copyright choice’). For example, a choice between different forms which would achieve a technical result (a ‘technical choice’) is not enough.

Multiplicity-of-forms

As has been mentioned, the Court found that fact that there are other possible shapes that can achieve the same technical result does not prevent a shape from being functional under copyright law.⁴⁷ The rationale for this different from other IPRs though. In trade mark law, the existence of alternative shapes arguably not relevant and in design law, this factor is not dispositive.⁴⁸ This is because of the risk to competition from a trader or group of traders holding IPRs in all of the different forms of the shape that would achieve the technical result.⁴⁹ In *Brompton* though, the debate is whether the existence of multiple forms can provide the element of ‘choice’ that is necessary for a work to be original (in the sense that the author will be choosing between the possible shapes). This is not directly a competition concern, although of course the upstream policy that copyright protection is only granted to *original* works is something which protects the ability of third parties to access (technical) ideas.

The effectiveness of the shape, causality and earlier expired patents

Similarly, how effective the shape is at achieving the technical result, and whether the shape was protected by an earlier patent was placed in the context of the author’s choice, rather than on the impact that protected the shape would have on competition. The Court held that these factors are relevant ‘only in so far as those factors make it possible to reveal what was taken into consideration in choosing the shape of the product concerned’.⁵⁰ Again, this can be contrasted with other IPRs, where causality or effectiveness of the shape is the key question in

⁴⁷ Case C-833/18, *Brompton Bicycle Ltd v Chedech/Get2Get*, ECLI:EU:C:2020:461, [35].

⁴⁸ Case C-395/16, *DOCERAM GmbH v. CeramTec GmbH*, ECLI:EU:C:2018:172, [30].

⁴⁹ Case C-48/09 P, *Lego Juris v OHIM*, ECLI:EU:C:2010:516, [54] to [58] ; Case C-395/16, *DOCERAM GmbH v. CeramTec GmbH*, ECLI:EU:C:2018:172, [30].

⁵⁰ Case C-833/18, *Brompton Bicycle Ltd v Chedech/Get2Get*, ECLI:EU:C:2020:461, [36].

establishing technical functionality,⁵¹ and where the existence of a patent covering the same subject matter is strong evidence of functionality.⁵² Some have read this paragraph as a rejection by the CJEU of causality in the context of copyright.⁵³ It is important to note, though, that causality has been defined as where ‘features of the design in question are due solely to the need to develop a technical solution’ and consequently, ‘it is necessary to identify the reason why the feature in question was chosen by the designer of the product.’⁵⁴ The *Brompton* Court does not mention any form of choice when it comes to ascertaining the relevance of the effectiveness of the shape in achieving the technical result. This would seem to bring the Court’s statement closer to the trade mark functionality exclusion, where the test is an objective one and the designer’s motivation for choosing the shape does not play a central role.⁵⁵

Intention of the infringer

The intention of the infringer had been raised by the referring court in its questions. This was rightly deemed irrelevant by the CJEU as it has no impact on whether the author has made creative choices that will render a work original.⁵⁶

⁵¹ In relation to trade marks, see Case C-299/99, *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd*, ECLI:EU:C:2002:377, [83] and Case C-48/09 P, *Lego Juris v OHIM*, ECLI:EU:C:2010:516, [51]; for designs see Case C-395/16, *DOCERAM GmbH v. CeramTec GmbH*, ECLI:EU:C:2018:172, [31] and Case C-395/16, *DOCERAM GmbH v. CeramTec GmbH*, Opinion of Advocate General Saugmandsgaard Øe, ECLI:EU:C:2017:779, [22] to [47].

⁵² For the role of pre-existing patents in establishing that a trade mark is functional see Case C-48/09 P, *Lego Juris v OHIM*, ECLI:EU:C:2010:516, [46]: ‘When the shape of a product merely incorporates the technical solution developed by the manufacturer of that product and patented by it, protection of that shape as a trade mark once the patent has expired would considerably and permanently reduce the opportunity for other undertakings to use that technical solution’; Case C-237/19, *Gömböc Kutató, Szolgáltató és Kereskedelmi Kft. v Szellemi Tulajdon Nemzeti Hivatala*, ECLI:EU:C:2020:296, [34]: ‘In that regard, it is important to point out that the determination by the competent authority of the technical functions of the product in question must be based on objective and reliable information. That authority may look for such features, inter alia, in any description of the product submitted at the time of filing of the application for registration of the mark, in data relating to intellectual property rights conferred previously in respect of that product, by looking at surveys or expert opinions on the functions of the product, or in any relevant documentation, such as scientific publications, catalogues and websites, which describes the technical features of the product.’

⁵³ E.g., E. Derlaye, ‘The CJEU decision in *Brompton Bicycle* – A welcome double rejection of the multiplicity of shapes and causality theories in copyright law’ (2020) *Kluwer Copyright Law Blog* <http://copyrightblog.kluweriplaw.com/2020/06/25/the-cjeu-decision-in-brompton-bicycle-a-welcome-double-rejection-of-the-multiplicity-of-shapes-and-causality-theories-in-copyright-law/?doing_wp_cron=1594590201.5337910652160644531250>.

⁵⁴ *DOCERAM GmbH v. CeramTec GmbH*, Opinion of Advocate General Saugmandsgaard Øe, ECLI:EU:C:2017:779, [22] – although the actual test is likely an objective one – see e.g. see e.g. D Stone, *European Union Design Law: A Practitioners’ Guide* (OUP, 20120, pp.72-73; U Suthersanen and M Mimler, ‘An Autonomous EU Functionality Doctrine for Shape Exclusions’ (2020) 69(6) *GRUR International* 567, 570 discuss the benefit of an ‘objective assessment’.

⁵⁵ While Case C-299/99, *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd*, ECLI:EU:C:2002:377 [83] adopted causality-type language: ‘Where the essential functional characteristics of the shape of a product are attributable solely to the technical result, Article 3(1)(e), second indent, precludes registration of a sign consisting of that shape, even if that technical result can be achieved by other shapes, this language was not adopted in Case C-48/09 P, *Lego Juris v OHIM*, ECLI:EU:C:2010:516, [59] where a more objective test was suggested: ‘a sign consisting of the shape of a product that, without the inclusion of significant non-functional elements, merely performs a technical function cannot be registered as a trade mark.’.

⁵⁶ Case C-833/18, *Brompton Bicycle Ltd v Chedech/Get2Get*, ECLI:EU:C:2020:461, [35].

Timing

The CJEU indicates that the correct point in time for judging whether a product shape is an original creation is at the point at which the shape was designed.⁵⁷ Factors that occurred subsequent to the creation of the product are not relevant. This would seem to echo the Advocate General's suggestion⁵⁸ that design awards and the like, which are external and subsequent to the design process, are not relevant to judging originality. Again, this highlights a potential difference from the other IPRs, where such awards might conceivably be used to support an argument that the feature in question makes the shape work, or work better, giving a potential explanation for their inclusion in the shape, and a reason why they should be accessible to competitors.

Comment

Suthersanen and Mimler have recently argued that the CJEU is developing an 'autonomous functionality doctrine within IP' (in which they include trade marks, designs and copyright), based on a 'macro-rationale within these laws namely to ensure that protection does not unduly restrict market freedom and competition.'⁵⁹ Analogously, others have argued that the CJEU is engaged in an exercise of 'negative convergence'.⁶⁰ On the basis of the CJEU's judgment in *Brompton Bicycles*, I would argue that this is correct, but only up to a point. In interpreting the originality component of a 'work' so as to rule out protection for shapes which are solely dictated by technical function, the CJEU has performed a feat of legislative interpretation that aligns copyright with the other IPRs. In this case, and in the preceding cases where the CJEU considered the protection of databases and functional user interfaces, a technical functionality exclusion has effectively been conjured up from nothing – at least in legislative terms. Moreover, the concepts that are being discussed, of the relevance of patents, cumulation, causality and multiplicity-of-forms are being referred to across the case law applying to the different IPRs. However, what the CJEU is *doing* with those concepts is different in copyright than in trade mark and design law. Trade mark and design law both have explicit technical functionality exclusions. The CJEU has articulated their purpose as the protection of competition and access for competitors as the purpose of their exclusions. Therefore, the Court has been able to openly use competitive concerns to calibrate the relevance of those key concepts. However, in relation to copyright, there is no explicit exclusion, and functionality concerns have to be viewed through the prism of originality. While it is true that the underlying justification for having an originality requirement in the first place is to protect competition and access to works, the CJEU does not address this directly when it comes to defining the

⁵⁷ Case C-833/18, *Brompton Bicycle Ltd v Chedech/Get2Get*, ECLI:EU:C:2020:461, [37].

⁵⁸ Case C-833/18, *Brompton Bicycle Ltd v Chedech/Get2Get*, Opinion of Advocate General M. Campos Sánchez-Bordona, ECLI:EU:C:2020:79, [94].

⁵⁹ U Suthersanen and M Mimler, 'An Autonomous EU Functionality Doctrine for Shape Exclusions' (2020) 69(6) *GRUR International* 567, 568.

⁶⁰ See e.g. E Derclaye and M Ricolfi, 'Opinion of the European Copyright Society in relation to the pending reference before the CJEU in *Brompton Bicycle v Chedech / Get2Get*, C-833/18' (2020) 42(4) E.I.P.R. 205 or <<https://europeancopyrightsocietydotorg.files.wordpress.com/2019/12/ecs-opinion-brompton-final-12-12-2019-final-3.pdf>>, and the sources cited at n.11.

scope of technical functionality in copyright.⁶¹ Instead, technical functionality is a means to an end, namely finding originality. Thus, the key concepts (multiplicity-of-forms, causality etc.) are just used as tools for establishing whether the author had the opportunity to make ‘copyright choices’, and so the relative weight given to them is significantly different than in trade mark and design law. Competition is protected by this approach, but only indirectly.

In terms of priorities for future case law, the Court has indicated that it is possible for a product shape with technical features to nonetheless be original. This is because a shape will only be entirely unoriginal if it is *solely* dictated by technical function. The suggestion is that a shape can be original if aspects of it reflects the author’s personality through free and creative choices. This leaves the question open of what sorts of choices will fit that criterion, and how will they manifest themselves in terms of features of product design. Will it be the case that, as in trade mark law, any non-minor non-technical feature will suffice? This is something we will only understand through application of these principles of live examples. Indeed, the CJEU has left this to the national court in this case. The CJEU indicated that the Brompton Bicycle does have technical features, but somewhat frustratingly, did not comment on whether the additional design features of the bicycle are enough to indicate that the shape as a whole embodies the author’s own personal choices.

⁶¹ The differing justifications for copyright and designs in particular was a key plank of the European Copyright Society’s opinion in this case, see: E Derclaye and M Ricolfi, ‘Opinion of the European Copyright Society in relation to the pending reference before the CJEU in *Brompton Bicycle v Chedech / Get2Get*, C-833/18’ (2020) 42(4) E.I.P.R. 205 or <<https://europeancopyrightsocietydotorg.files.wordpress.com/2019/12/ecs-opinion-brompton-final-12-12-2019-final-3.pdf>>.