

Shift of paradigm for copyright protection of the design of products

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In the *Cofemel* proceedings, the CJEU is expected to decide later this year whether the level of originality of its *Infopaq*-judgement is applicable also to product designs and whether therefore no criterion other than originality in the sense of the "author's own intellectual creation" formula may be applied to determine the eligibility of a product design for copyright protection. On the occasion of the forthcoming judgement, this article discusses the latest developments in Europe and the USA regarding the copyright/design interface. The analysis reveals that a paradigm shift towards a lowering of the copyright protection threshold is already taking place in various jurisdictions and that the recent case law of the CJEU seems to point in the same direction. This article also addresses some consequences of this shift.

I. Introduction

"It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations [...] some works of genius would be sure to miss appreciation".¹

What makes a product design qualify as a 'work of literature, science or art' eligible for copyright? While the growing digitalisation of the world is driving the courts and the legal literature to an almost unmanageable deluge of judgments and publications, such fundamental questions of the analogue world have almost fallen into oblivion.

This seems to be changing, as the Court of Justice of the European Union (CJEU) in the past decade repeatedly hinted that the concept of work, i.e. the eligibility criterion for EU copyright protection, is not only vertically harmonised with regard to specific work categories, but also horizontally² by an overarching and uniform interpretation of the concept of work throughout the European Union. According to the CJEU's perception, an *own intellectual creation* is the sole criterion for copyright protection not only for harmonized works such as software, databases and photographs, but also for all other work categories, and in particular – of relevance here – designs of products. Therefore, irrespective of its artistic quality, a product design ought to receive copyright protection.

Despite the fact that this broad interpretation of the CJEU's decisions remains controversial and the harmonisation tendencies of the CJEU in general have been criticised,³ various national courts implemented an indulgent jurisprudence with regard to the eligibility of product designs for copyright protection.⁴ Other jurisdictions, on the other hand, maintain the "special treatment" of product designs and seem to perceive the hues of the recent CJEU case law differently. Due to the highly diverging interpretations of the CJEU's tendencies, European manufacturers and designers are now eagerly awaiting whether the CJEU will continue its previous line in its upcoming copyright/design interface judgement on *Cofemel*.⁵

This contribution to the discussion analyses and compares the diverging developments and outlines the most recent, extremely high variance across the legal scenery regarding the product

design copyright interface. The authors approve the path which the CJEU seems to be pursuing and consider the observed shift of paradigm to be a long overdue step towards a Europe-wide *unity of art*.⁶ In addition, the authors counteract the broad criticism on lower thresholds for protection by outlining practical solutions for a well-balanced copyright protection for product designs.

II. Product designs caught between the fronts of IP rights

1. International Framework

In the following, product design is understood as the commercial design of industrially manufactured objects of utility such as furniture, clothing, vehicles, tools, etc.⁷ In accordance with the terminology of the Paris Convention ("PC") and the Revised Berne Convention (hereinafter "BC"), product designs are regularly included under the categories "industrial design" and/or "works of applied art". According to the BC, "the expression literary and artistic works shall include every production in the literary, scientific and artistic domain, whatever may be the mode or form of its expression" (Art. 2(1) BC). In this enumeration of the categories of work covered by the concept of work, *works of applied art* are explicitly referred to, without differentiating them from other works such as painting, architecture or photographic works.

Therefore, the fact that courts all over the globe have nevertheless struggled to subject works of applied art to copyright protection must be observed with a certain bewilderment. In countless jurisdictions, works of ap-

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plied art have been and are required to obtain a certain artistic value in order to be protected by copyright. Especially product designs, which by their very nature not only have aesthetic but also functional and technical characteristics, have to bear a particularly bitter fate from a copyright point of view.

There are various explanations for the legal bigotry with regard to the application of copyright on these genres of work. On the one hand, a first qualitative differentiation can already be found in the prevalent conceptual differentiation of *applied art* with utility purpose from *traditional, pure or non-utilitarian art*.⁸ This leads to the concern that an indulgent design copyright regime – due to the lack of a registration requirement and its *de facto* hundred-year protection – could result in an excessive monopolization of the appearance of everyday utility goods and, ultimately, ends in an inhibition of the creative progress.⁹

In addition, there is a lack of a generally applicable notion of "work" in international copyright law. Neither the relevant international treaties on intellectual property rights nor the *acquis communautaire* of the EU specify which criteria a work must generally meet in order to enjoy copyright protection.¹⁰ The lack of an international, unified concept of a "work" ultimately led to the fact that at the national level different criteria for copyright protection have been required, whereby these have been unequally strict, especially for works that the BC refers to as "works of applied art".¹¹

With regard to the latter, Art. 2(7) BC increased this tendency at an early stage: Accordingly it shall be a matter for legislation in the countries to determine the extent of the application of their

laws to works of applied art and industrial designs and models, as well as the conditions under which such works, designs and models shall be protected. Furthermore, Art. 2(7) BC provides a reciprocity rule according to which works protected in the country of origin solely as designs and models shall be entitled in another country only to such special protection as is granted in that country to designs and models. The relevance of this historically and politically determined special treatment of works of applied art in the early days of international copyright law has been and continues to be misinterpreted and over-interpreted for the most part.

The deliberate reticence of the fathers of the Paris and Berne Convention on the concept of the work can be explained by the widely differing status of copyright at the time and, in particular, its treatment of industrial design within the various member states. Accordingly, in its 1991 Green Paper on the Legal Protection of Industrial Design,¹² the EU Commission acknowledged – to put it simply – its inability to harmonise the different national regulations with regard to the eligibility of product designs for copyright protection. Even at the turn of the millennium, this admission was included in the Directive and the Regulation on Community Designs¹³ and thus continues to serve as legitimation for the special copyright status of product designs to this day. Although Art. 17 of the Design Directive avoids attempts to exclude registered designs *per se* from copyright protection and therefore explicitly dictates a mandatory overlap between copyright and designs, this provision had opposite effects: For one thing, countries raised the threshold for copyright protection of product designs with the result that most product designs will be *de facto* deprived of copyright and be left with design protection only¹⁴ or, on the other hand, countries subsequently dropped former design copyright provisions.¹⁵

2. Insufficient protection through design law

Jurisprudence and literature have long been dealing with the question of the relationship between Copyright and Design Law. However, this question is inevitably misleading – at the latest when speaking of their “distinction”. Even if we assume that the legislators are striving for coherence of law and do not want to undermine valuations in one field of law in another, intellectual property rights are not mutually exclusive, but rather exist independently of each other and, above all, are structured differently in many respects.¹⁶

The call for a generally higher threshold for product designs to be eligible for copyright protection is essentially rooted in an incorrectly interpreted coherence of intellectual property law, according to which an accumulation of protection is not permitted. This strict position is thoroughly remarkable, since no convincing reasons for refusing accumulation of protection can be found. Works of applied art – the surface decoration of everyday useful articles – are located at the interface between copyright and design protection. Both intellectual property rights protect, among other things, the appearance of useful consumer goods. What is protectable by design law is protectable by copyright – and *vice versa*.¹⁷ This overlap of the subject matter of copyright and design law often serves as justification of the fact that works of applied art and works of “pure art” are measured with different yardsticks.¹⁸ However, what many fail to recognise is the fundamental difference between the copyright approach (intellectual creation) and the design approach (differentiation from the existing design corpus).¹⁹ With regard to its term of protection, obligation to register and its requirements for protection such as novelty and

individual character, design law is essentially modelled and leaned more on patent law than on copyright law, and must therefore, in relation to the latter, be regarded as a genuine property right which is to have its own space in the framework of intellectual property law.²⁰

The different conception of the two property rights opposes the reluctant stance towards the accumulation of protection. Copyright protects intellectual creations where the author stamped his work with a personal touch by choices of free creativity. On the other hand, design law allows for those who invest in a new and individual ornamental design of their jewellery, furniture or beverage containers to use and exploit the developed design exclusively for a certain period of time.²¹ In order to obtain this protection by design law, it is simply necessary that the overall impression of the design of the product differs from that of already known designs. Any industrial form that differs from the relevant known shapes is thus accessible to design protection – irrespective of any personal “stamp” of the designer.²² Moreover, a design is an unexamined intellectual property right – the requirements of novelty and individual character are not examined in the registration procedure.

Now consider the outstanding design works of the exceptional talents Charles and Ray Eames or Arne Jacobsen: At the time of the implementation of national design legislation in Europe at the end of the 20th century, their designs had long been on the market in most jurisdictions and thus, lacked novelty. Due to the novelty requirement in design law, this circumstance constituted a ground for exclusion from protection and thus implicitly precludes these works from protection by design law.²³ In many countries, no protection at all would be granted in such a situation since a distorted understanding of the relationship between design law and copyright result in the latter only being accessible to exceptional works of applied art.

III. Copyright protection of product designs in national case law

The need for protection of product designs by copyright leads to the question of what requirements they must fulfil in order to be protected by copyright as “works of applied art”. The international conventions and the EU legislator have – in the absence of a harmonized understanding of the concept of work – essentially left this question to the national legislators. In addition, the above mentioned overlap of copyright and design law give rise to delicate questions concerning the accumulation of the two IP regimes, the threshold and scope of protection and the duration of the exclusive rights. As a result, a variety of national concepts have been developed that could not possibly differ more from each other.

1. Europe

a) Paradigm shift in Germany

The *personal intellectual creation* criterion laid down in § 2 (2) of the German copyright act is essential for copyright protection. Any work of art – including product designs – enjoy copyright protection if they fulfil this criterion. Despite this open wording, works of applied art faced a difficult status for a long time.²⁴ In the past, the stringency with regard to works of applied art was justified by the fact that such works already enjoyed a “special” protection by the law on

copyright in designs and models.²⁵ Accordingly, product designs were protected by the copyright for designs and models if they stood out from purely craftmanlike and everyday average designs.²⁶ At the turn of the millennium, however, the dichotomy of the “small” copyright for designs and models with a low protection threshold and the “big” copyright law for “pure art” was largely abandoned with the implementation of the EU Design Directive, but, however, without resolving the relationship between the new IP right and the remaining copyright framework for “pure” art.²⁷

Subsequently, in accordance with the so-called “step theory” of the BGH (Federal Supreme Court), product designs were suddenly required to have a particularly high level of creativity (the “aesthetic surplus”) to qualify as work eligible for copyright protection.²⁸ Only completely outstanding, unusual and trend-setting designs of products were eligible to copyright protection.²⁹ However, this also meant, for instance, that minimalism, which is characterized by the general reduction of the variety of colour and form – i.e. aesthetics based on less rather than more – was contradictory to a concept, which is primarily based on the criterion of height or level of creativity. It took almost 10 years after the implementation of the Design Directive³⁰ for the BGH to unify the requirements for copyright protection for all work categories with its landmark decision *Geburtstagszug*.³¹ Accordingly, there is no justification for a higher protection threshold for works of applied art than for other work categories. Thus, it is not required that a product design surpasses the average level of creativity.³² This breach with the step theory is to be welcomed and undoubtedly improves access of product designs to copyright protection.³³ In

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particular, the dogmatic reasoning is convincing, since the BGH acknowledged that with the implementation of design law an autonomous intellectual property right was created and the former link between design right and copyright was eliminated.³⁴

At this stage, it still remains to be seen how the new understanding of the BGH will be reflected in the lower and upper court jurisprudence in the longer term.³⁵ While the Higher Regional Court of Schleswig Holstein ultimately denied copyright protection to the locomotive toy, which was the subject of BGH’s landmark *Geburtstagszug* ruling,³⁶ the Regional Court of Cologne recently affirmed copyright protection for various table models by referring to the *Geburtstagszug* postulate.³⁷ Following the same reasoning also the Higher Regional Court of Nürnberg ruled that a well-known and popular Bundesliga table of the Kicker magazine enjoys copyright protection³⁸ and finally, the Regional Court of Hamburg held that the product design of the “5,0 Original” beer is protected by copyright.³⁹

b) Everything remains in Switzerland?

The sparse and partly outdated case law of the Swiss courts indicates a similarly high threshold for design copyright, as it was the case in Germany up to the outlined shift of paradigm.⁴⁰ In order to legitimize the unequal treatment of product designs with regard to copyright protection, the Federal Supreme Court made use of a rule according to which works of applied art are – in the case of doubt – to be regarded as purely handcrafted products.⁴¹ The critical voices in the

literature and their demand for a legal-dogmatic justification of this thoroughly questionable “rule of doubt” have so far not been taken into account by the Federal Supreme Court.⁴²

Recently, the Federal Supreme Court did not take advantage of the opportunity to dismiss its “rule of doubt”.⁴³ Although the Court granted copyright protection for a bar stool designed by the famous Swiss artist Max Bill, the reasoning was odd and based on principles derived from design and trademark law.⁴⁴ It remains to be seen whether, in the longer term, Swiss jurisprudence will also refrain from its strict opinion due to the change of course of their northern neighbor, who often serves as a model.

c) Italian art judges

The Italian courts have traditionally made a sharp distinction between copyright protection (for “unique” works of art) and design protection (for industrially manufactured utilitarian products).⁴⁵ This criterion of “scindibilità” meant that only designs that could be separated from their intended use are protected by copyright.⁴⁶

Thereby the evaluation of the qualification as “unique work of art” is carried out by an “art-legal” approach: A “museum-like standing” of a product design serves as decisive criterion for its eligibility for copyright protection. For example, a court in Milan recently held the well-known *Moon Boots* are protected by copyright solely because the Louvre museum ranked their product design among the hundred most important designs in recent history.⁴⁷ Of all places, in Italy, the very epicenter of the international designer community, the judges claim the prerogative of interpretation regarding the question which designs should and should not be considered unique works of art.⁴⁸

Recently, the Italian “art judges” too seem to be approaching a tipping point: In recent decisions, the Italian Courts started to attribute copyright protection to several product designs – irrespective of whether they are worthy of mention by museums.⁴⁹

d) Theory of “cumul absolu” in France

In France, the overlap of copyright and design law is kept simple: French copyright law and special design legislation share the same scope of protection and are of parallel and cumulative application (“cumul absolu”).⁵⁰

Furthermore, in contrast to their Italian colleagues, the judges in France apply the principle of the unity of art (“unité de l’art”) and generally abstain from deciding whether a design is artistic or not. This principle, detached from any level originality, implies the equal treatment of all intellectual works (“oeuvres de l’esprit”)⁵¹ and precludes the judges from subjectively determining the artistic character of a work.⁵² The level of originality only comes into consideration when the question of the scope of protection is at issue, i.e., in infringement proceedings.⁵³

e) Brexit and the “skill and labour”-test in the UK

Also in the UK the copyright law is in a state of change. According to the traditional view of the UK courts, a

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work is original and therefore protected by copyright if it is the result of the author's skills, work, judgment and effort.⁵⁴ This so-called "skill and labour" test focuses on the sweat⁵⁵ and effort sacrificed for the creation of the work. In simple terms, the key criterion is the human effort involved in creating (and imitating) a work, not its originality. This fundamental, seemingly insurmountable contradiction between the continental European model was often seen as an obstacle to an EU-wide harmonisation of the concept of work.⁵⁶

With regard to works of applied art Sec. 51 of the 1988 Copyright, Designs and Patents Act (CDPA) lays down an exception to copyright protection in relation to drawings or preliminary models that exist specifically to be made into a particular object, i.e. product designs. Moreover, Sec. 4 of the CDPA protects works of "artistic craftsmanship", a narrow category of works of applied art, if they obtain an artistic quality.⁵⁷

Under the impression of recent case law of the CJEU in relation to copyright originality,⁵⁸ neither the traditional "skill and labour" test nor the concept of 'works of artistic craftsmanship' was considered to be in conformity with European copyright law. Therefore a gradual adaptation of the author's right doctrine and lower thresholds for copyright protection for works of applied arts was expected.⁵⁹

However, in the light of the upcoming "Brexit", it is unclear whether the new continental author's rights doctrine may cause any adjustments to originality in UK copyright law in the longer term.

f) Absence of any special creativity criteria in Dutch case law

While in the jurisdictions outlined above the shift of paradigm has only recently become apparent or has not yet taken place, the relationship between copyright and design law in the Benelux law has been built up at an earlier stage in a much more harmonious way. Whereas the Uniform Benelux Law on Designs and Models (UBLDM) of 1975 still stated that in order to be eligible for copyright protection, models and designs must be of "a clearly artistic character",⁶⁰ in the 1987 judgement *Screenprints* the Benelux Court of Justice laid down that the "normal" originality criterion applies also to designs.⁶¹ Subsequently, the Dutch courts began to make copyright protection eligible even for essentially functional product designs.⁶² As a result, to sum up, only trivial or banal designs without any creative features fall outside of the scope of Dutch copyright protection.⁶³

A copyright regime that precludes only "works" which are so trivial or banal that they bear no creative labour of whatever kind, is open to a wide range of critiques.⁶⁴ Despite this criticism, the Dutch courts adhere to this indulgent practice, which is currently even strengthened by the emerging harmonization of the level of originality initiated by the CJEU in 2009.⁶⁵

2. USA

a) Design patent v. Copyright

In US federal law, since the year 1842, product designs are protectable as design patents for the period of 14 years. However, since this special protection for new, original and ornamental designs

is described as insufficient for various reasons, there has always been a demand for adequate protection of product designs by copyright.⁶⁶

In this context, the US Supreme Court held in its landmark decision *Mazer v. Stein*⁶⁷ that works of applied art, even with intended or actual use in industry, may enjoy copyright protection. This put an end to the practice of the lower instances and copyright offices, which at that time only granted copyright to works of applied art without a utilitarian function. The manufacturer of useful articles may choose between design patent or copyright registration and the choice of registration to one right cannot exclude the application to another right.⁶⁸

b) The separability test

Furthermore, *Mazer v. Stein* set the foundation for the so-called "separability" test, according to which individual aesthetic elements of a useful article (*in casu* specially formed lampstands) are eligible for copyright protection, as long as they can be separated from the article in question (*in casu* a table lamp). In essence, the purpose of this test is to distinguish between functional design of the useful article – that is not protected by copyright – and pure aesthetic features thereof that do not contribute to its functionality. If the latter are physically or at least conceptually identified independently of and can exist independently of the function of the product, these aesthetic elements are eligible for copyright protection.

Following *Mazer v. Stein* the separability-test was transferred to the US Copyright Act of 1976.⁶⁹ Although these

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delimitation criteria may sound well elaborated – the differentiation between functional and aesthetic elements was difficult and the US courts were unable to develop a consistent and coherent case law. Particularly with regard to design features that could not be physically separated from a useful article, very divergent and sometimes pedantic results occurred.⁷⁰

c) The *Star Athletica* decision

More than 60 years after *Mazer v. Stein* and for the first time since the US Copyright Act entered into force, the US Supreme Court could take up its detailed position on the application of the separability test in its 2017 decision *Star Athletica*.⁷¹ On the one hand, it eliminated certain components of the analysis that had been adopted based on the Copyright Act's legislative history, e.g. the distinction between physical and conceptual separability. In particular, it clarified that an artistic feature of the design of a useful article (*in casu* a cheerleader uniform) is eligible for copyright protection if the feature can be *perceived* as a two- or three-dimensional work of art separate from the useful article and if the feature would qualify as a protectable pictorial, graphic, or sculptural work either on its own or in some other medium if imagined separately ("imaginatively removed") from the useful article. On the other hand, it is not required that the article remains fully functioning after separating the aesthetic feature. This means, *e contrario*, that the design features may even be protectable when they are partially functional.

The decision is perceived as a clear extension of the copyright protection of product designs. Nevertheless, it is still controversial⁷² how the lower courts will apply the decision to aesthetic elements of product designs outside the fashion industry.

IV. Harmonisation tendencies in EU law

The observed change of course in copyright protection requirements for product designs by the national courts in Europe was, of course, not completely detached from corresponding supranational developments. In addition to multiple copyright directives at EU level (so-called *vertical harmonisation*), several rulings of the CJEU (so-called *horizontal harmonisation*) have served as the legal foundation for various “copyright-friendly” decisions in the national states.

1. Vertical harmonisation of the concept of work

As set out above, the thresholds for works of applied art to enjoy copyright protection are primarily determined at national level. In addition, however, an increasing “vertical” harmonisation of copyright law has also been underway at Union level for thirty years, starting 1988 with the Green Paper on Copyright in the knowledge economy.⁷³ Today, harmonized copyright law of the EU consists of over ten directives, by which, *inter alia*, specific work categories are harmonized with regard to their protection criteria. So far, the European legislator has made use of this harmonisation approach in the area of software⁷⁴, databases⁷⁵ and photographs.⁷⁶

These directives stipulate with EU-wide effect, that software, databases and photographs shall be protected by copyright if they are the *author's own intellectual creations* and that no other criteria shall be applied to determine their eligibility for protection. The required level of originality in the sense of the *author's own intellectual creation* formula can be placed in between the high threshold of the former case law in Germany and the very low standard provided by Dutch courts. To put it short: to determine a software's, database's or photograph's eligibility for copyright protection, any requirement of an artistic character or above-average level of creativity, e.g. the requirements of the Italian judges, is expressly excluded.⁷⁷

2. Horizontal harmonisation by the CJEU

a) Application of the criterion of the author's own intellectual creation for further creative works

With regard to the criteria which shall be applied to determine the eligibility for protection, the EU legislative framework thus confines itself to a fragmentary vertical harmonisation for the three aforementioned creative works. For further creative works, this form of harmonisation has so far been lacking. For product designs in particular, the EU legislator merely stated that in the absence of a harmonisation of copyright law, it is important to establish the principle of *cumulation of protection* under the Community design and under copyright law, whilst leaving Member States free to establish the extent of copyright protection and the conditions under which such protection is conferred.⁷⁸

However, while the EU legislator vertically harmonised the originality standard in relation only to these subject matter, i.e., computer programs, databases and photographs, the CJEU has been playing a fundamental role in *horizontally* expanding this originality formula to all

subject matter covered by EU copyright law. The impetus for this involvement of the CJEU was the landmark *Infopaq* judgement.⁷⁹ In *Infopaq* the CJEU had to decide whether the storing and subsequent printing out of a text extract from an article in a daily newspaper, consisting of eleven words, can be regarded as act of reproduction according to Art. 2 of the InfoSoc Directive.⁸⁰

The CJEU held that the various parts of a work enjoy protection under Art. 2(a) of the InfoSoc Directive, provided that they contain elements which are the expression of the *intellectual creation of the author* of the work. Thereby the CJEU referred to the recitals 4, 9 to 11 and 20 in the preamble of the InfoSoc Directive, according to which, in a nutshell, any harmonisation of copyright must take as a basis a high level of protection as well as the principles and rules laid down in earlier directives such as the database or software directives.⁸¹

b) Importance of the decision for product design

In *Infopaq* the CJEU could not directly base its determination of the copyright protection criteria for press products on a codified EU provision. Nonetheless, the CJEU indirectly linked its assessment via the preamble of the InfoSoc Directive to the criteria of the already vertically harmonised categories of works “*such as* computer programs, databases or photographs”.⁸² This derivation of the “author’s own intellectual creation” formula is widely understood as a clarification that the vertically regulated categories of works are only examples of an overarching uniform EU concept of work.⁸³

By referring to *Infopaq*, the CJEU subsequently applied its “author’s own intellectual creation” formula as the test for originality in a number of rulings on further work categories.⁸⁴ Just recently the CJEU in its *Levola* judgement⁸⁵ of 13 November 2018 referred to its *Infopaq* interpretation with regard to the question of copyright protection of the taste of cheese. In *Levola* the CJEU explicitly stated that in view of the need for a uniform application of EU law and the principle of equality, the concept of work according to the BC must normally be given an autonomous and uniform interpretation throughout the European Union.⁸⁶ However, since the existence of a work was ultimately denied with regard to the taste of cheese because of its unidentifiable nature, the CJEU did not rule on the qualitative requirements for the copyright protection of the taste of a food and thus missed the opportunity to further strengthen its interpretation of the InfoSoc Directive as a statutory basis for a general EU wide concept of work.⁸⁷

With regard to product designs, the CJEU expressed its opinion on the principles of the relationship between design law and copyright law in *Flos*.⁸⁸ Accordingly, the Design Directive precludes national copyright regimes that exclude copyright protection for designs which were protected by a registered design right and entered the public domain before the date of entry into force of that legislation, provided they meet all the requirements to be eligible for copyright protection.⁸⁹ Furthermore, the CJEU also expressly stated in this judgement that it is conceivable that copyright protection for works which may be *unregistered* designs could arise under other directives concerning copyright, in particular the InfoSoc Directive, if the conditions for that directive’s application are met.⁹⁰

The reasoning in the judgment indicates that *Flos* considered the level of originality harmonized, at least for unregistered or formerly registered designs, whereas Art. 17 of the Design Directive which leaves Member States free to establish the conditions for copyright protection is still applicable for registered designs. Although there are academic voices suggesting that *Flos* was wrongly decided and it is at this stage not entirely clear whether and how the CJEU will apply the “own intellectual creation” formula to further work types,⁹¹ it appears that national courts already recognise that the horizontal harmonisation developed by the CJEU extends to product design. For example, the Supreme Court of the Netherlands granted copyright protection to a rather simple fire stove by referring to *Flos*.⁹² A preliminary ruling to the CJEU was not considered necessary.⁹³

c) Solution of the “Gordian Knot of Copyright” in Luxembourg?

a. Necessity for Europe-wide legal certainty

Although we assume that the direction in which the CJEU is heading seems to be clear in such a way that it expanded the concept of “author’s own intellectual creation” beyond the three vertically harmonised subject matter, the need for an unambiguous clarification is still considerable. The above-mentioned extremely high variance across the

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different legal traditions creates an unsatisfactory situation for internationally oriented right holders. An early clarification covering all work categories is therefore more than desirable and would undoubtedly be in the interest of free movement of goods in Europe.⁹⁴

In particular a broad application of the InfoSoc Directive with regard to product designs is highly controversial since it would essentially break with the Commissions Green Paper on the Legal Protection of Industrial Design of 1991 and the preamble of the Council Regulation on Community designs of 2001. Although we are of the opinion that full harmonisation or unification of EU copyright law should rather be achieved through legislative intervention, an early harmonisation through judicial convergence seems unavoidable.⁹⁵ After all, the CJEU will probably be able to clarify these questions in 2019 already.⁹⁶

b. Portuguese copyright law as litmus test of the horizontal harmonisation tendencies

While the world of tastes and smells is at present excluded from European copyright law, European product designers are currently focusing their attention on the upcoming *Cofemel* judgment.⁹⁷ In this request for a preliminary ruling, the Supreme Court of Portugal referred to the CJEU to rule on the question, whether the InfoSoc Directive precludes the strict criteria under Portuguese Copyright Law which confers copyright protection only on original works of applied art, industrial designs and works of design, which, in addition to their utilitarian purpose, create their own visual and distinctive effect from an aesthetic point of view. Furthermore, such works are only eligible for copyright protection if – in the light of a particularly rigorous assessment of their artistic character, and taking account the dominant views in cultural and institutional circles – they qualify as artistic creation or work of art.

If the CJEU continues its path started in *Infopaq*, the criterion of artistic value for copyright protection for product designs stipulated in the Portuguese law will be considered incompatible

with the EU law. Currently it is eagerly awaited whether and how the CJEU will relate its interpretation to Art. 9 of the InfoSoc Directive, which provides that the Directive is without prejudice to provisions concerning design rights and utility models and particularly to the Design Directive and the Community Designs Regulation, which leave Member States free to establish the extent of copyright protection and the conditions under which such protection is conferred to product designs.⁹⁸

In our opinion, the CJEU could argue that the Design Regulation – the most recent of the referred legislations⁹⁹ – contains the slightly altered wording “in the absence of the *complete* harmonisation” in contrast to the older wording “in the absence of harmonisation” and therefore the Commission may have changed its attitude towards Europe-wide harmonisation and that the horizontal harmonisation thus reflects the agenda of the European Commission.

V. Summary appraisal

A special treatment of “works of applied art” compared to other works, not only works of art, lacks any basis of legitimation. For no matter how the concept of “art” in copyright is turned and twisted – its assessment is aleatory and in modern copyright law it seems misplaced. The art-historical and copyright concepts of work and art are anything but congruent. An everyday banality can be regarded as a work of art in cultural and institutional circles, but may not have to enjoy copyright protection at all. Conversely, the concept of work within the meaning of copyright law must be completely detached from its presence in art exhibitions or art-historical evaluations from the relevant circles. An exhibitor directory should not be a vademecum of a judge and an arbitrarily set benchmark with regard to an artistic character of a product design shall not be decisive. Even if the courts leave the assessment of the artistic character of a product design to an expert, this is still carried out from an art-historical perspective, which, due to the discrepancy between art and copyright, entails the danger of false judgements.¹⁰⁰

Infopaq is dogmatically unobjectionable and must be regarded as a major evolvement of the European concept of work shaped by primarily non-legislative harmonisation.¹⁰¹ The CJEU adopted and continued the legislative harmonisation tendencies and found an elegant way within its assigned powers¹⁰² to circumvent the difficulties to find consensus on copyright at EU level.¹⁰³ The aim of the InfoSoc Directive is the harmonisation of a number of key copyright aspects, such as copyright exceptions, reproduction and distribution, which previously varied considerably from one member state to another. Although the InfoSoc Directive does not directly harmonise the concept of work, the concept of reproduction provided for in Art. 2 therein must nevertheless be based on a subject-matter of protection, which must be given an autonomous and uniform interpretation throughout the European Union.¹⁰⁴

However, since the importance and impact of *Infopaq* remains highly controversial, a definite clarification is urgently needed.¹⁰⁵ Especially with regard to the protectability of product designs, legal uncertainty takes a heavy toll: Depending on the jurisdiction, rights holders of world-famous design classics can defend themselves in

Europe against imitations of their products either well, sufficiently or not at all. The urgency is accentuated by the spread of 3D printing and the future importance of the Chinese market in Europe.¹⁰⁶

It is to be expected that the CJEU will continue the horizontal harmonisation of the concept of work in the upcoming judgement on *Cofemel* and will clarify that product designs must be eligible for copyright protection provided that they contain elements which are the expression of the *intellectual creation of the author* of the work. As a consequence, there will be no room anymore for European "art judges" assessing the eligibility of a product design on the basis of its artistic character – and quite incidentally, this would also prevent judges from being accused of being artistically "half a century behind".¹⁰⁷

VI. Solutions for a well-balanced copyright protection for product designs

The following solutions shall address the fear that protecting functional works by copyright might result in significant monopolies. The proposals are based on two premises: First, no criterion other than originality in the sense of the "author's own intellectual creation" formula should be applied to determine the eligibility of a work of applied art for copyright protection. The author must solely stamp his work (as a whole) with his personal touch by choices of free creativity.¹⁰⁸ Second, it is important to foster the development of the usual shapes available and not to hinder it with excessive protection. In other words, a balance must be sought between incentives for design innovation and ensuring design progress.

1. Usage of a creative freedom as decisive criterion

The long duration of copyright and the absence of registration is – in particular when it comes to useful articles – accompanied by scepticism and concern about a potential inhibition of creative progress.¹⁰⁹ A Europe-wide abandonment of aesthetic or qualitative criteria results in lower requirements for protection and thus a higher level of protection than previously. Critics fear that the removal of the criterion of artistic value means that *more* product designs are protected for a *longer* period, and thus hampers the creative progress.¹¹⁰ This defensive reflex is legitimate, since these works – as their categorization as "applied art" in distinction to "pure art" implies – are usually functional or technically conditioned and the "creative flexibility" of the designers is limited.¹¹¹

This objection must be countered by ensuring that purely functional or technical product designs or elements thereof are excluded from the definition of the author's own intellectual creation and thus from the scope of protection. Hence, the right question must be: Did the designer use his/her freedom in developing the design/feature in question or is the appearance of the product/feature thereof *solely* dictated by its technical/functional purposes?¹¹² The latter must remain in the public functional domain in the interest of "creative progress".¹¹³

The criteria of technical and functional necessity must be interpreted, according to the view represented here, as the *absence* of technically and economically *reasonable* alternatives from the point of view of a potential infringer.¹¹⁴ Consequently, if every component of the appearance of a useful article is indispensable in order to achieve its functional or technical purpose, the designer cannot take action against imitators on the basis of copyright law.¹¹⁵ The same applies to features

of a product that are not indispensable – because other shapes would achieve the same purpose – but still *solely* serve technical or functional purposes. These characteristics of a design are not based on the usage of the creative freedom and are therefore excluded from the scope of protection. On the other hand, every element with aesthetic qualities, although they *also* or even *primarily* serve a technical or functional result, are eligible for protection.

This relationship between the degree of freedom of the designer in developing the design and the exclusion of features of appearance of a product which are dictated by its technical function corresponds to Arts. 6(2) and 8(1) of the Community Designs Regulation.¹¹⁶ In recent copyright rulings, the CJEU applied this principle in its own words by stating that the criterion of originality according to the InfoSoc Directive cannot be met by components of a graphic user interface which are differentiated only by their technical function.¹¹⁷ Furthermore, in *Painer/Standard*,¹¹⁸ the CJEU interpreted the freedom in developing the design as capability of the designer to express his/her creative abilities in the production of the work by making free and creative choices.¹¹⁹ Also the national courts seem to be increasingly focusing on the criterion of free and creative choices. For example, the BGH required product designs to have an appearance that is not *solely dictated* by its technical function¹²⁰ and the Court of Appeal of Amsterdam held that elements that are the mere the results of technical constraints do not enjoy copyright protection.¹²¹ In a ruling on unfair

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competition law the BGH further stated that there is no technical necessity if a design feature can be replaced by another design that fulfils the same technical purpose and quality requirements.¹²²

2. Symmetry between the usage of a creative freedom and the scope of protection

a) Appropriate limitation of the scope of protection

There is no doubt that the functional and technical necessity of a product design must be included in the copyright assessment in order to prevent an inhibition of the creative progress. However, in infringement proceedings, to ensure that the barrier for protection is not raised through the back door of a stringent application of functional/technical necessity, the criterion of the usage of freedom in developing the design must only be addressed in the assessment of the scope of protection.¹²³

If the assessment of the usage of freedom of the designer is already addressed with regard to the eligibility for protection, there is a potential risk that the removal of the criterion of artistic value will be circumvented by a strict focus on functional/technical necessity. As already mentioned, the degree of creative freedom in developing useful articles is naturally very limited.¹²⁴ Experience with the separability test has shown that functional and aesthetic features are difficult to divide. Thus, there is a tendency to prematurely assume a functional or technical character and to *a priori* preclude copyright protection. In this case, the turning tide in copyright would be nothing more than a little wave.

Consequently, we plead for an *appropriate limitation* of the scope of protection by excluding technically or functionally indispensable characteristics from the scope of protection and keeping them in the public domain in order to ensure design progress.¹²⁵

Hence, competitors are free to copy mere functional aspects. If a product design consists of 90 % elements resulting from mere functional choices, these elements can be copied, since they are not part of the scope of protection. That ten percent proportion of aesthetic elements, however, determines the protected scope from which the competition must keep its distance.

Therefore, even if the product design in question mainly result from arbitrary functional choice, it is not *a priori* excluded from copyright protection, but its scope of protection is limited to the few aesthetic elements. However, copying of even one of these protected elements could lead to an infringement.

b) Application in infringement proceedings

Symmetry between the usage of freedom in developing the design and the scope of protection means that a low degree of creative freedom leads to a small scope of protection and, correspondingly, the broader the creative freedom and the more intensively this freedom is used, the more the competing product designs must differ themselves from the previous design. In a nutshell: above-average designs compared to the priory known designs deserve a large scope of protection.¹²⁶ Thus, in infringement proceedings, the necessary differences in their aesthetic execution from the original design to which competitors must adhere to in order to act within the permissible scope must be determined on the basis of the scope of protection.¹²⁷

As a result, a copyright infringement may be denied despite a high degree of similarity in the overall impression of the product designs if this similarity is based on technical necessities and not on an imitation of aesthetic characteristics of the design which originate from the original designer's freedom in developing. A piece of furniture whose designer has succeeded in expressing his or her creative abilities despite a low degree of creative freedom should enjoy copyright protection. At the same time, however, this does not mean that other furniture manufacturers who are inspired by this design infringe copyright.¹²⁸

The outlined solution means *in extremis* that numerous product designs with a degree of creative freedom close to zero may regularly only act against identical replicas. Nevertheless, in contrast to a claim against "slavish imitations" based on unfair competition law, the difficult burden of proving, e.g., competitive originality, deception or confusion between the original and the copy among the consumers, etc. is omitted here.

In our view, the courts have sufficient discretion in determining the appropriate scope of protection: If, for example, the BGH had based its reasoning in the aforementioned *Seilzirkus* decision on this formula, it would have come to the same conclusion – the rejection of the infringement action – but with a reasoning that seems more convincing to us: The similarity between the two designs was caused by the technical requirements. The scope of protection for the plaintiff's product design was thus limited and even the practically identical replica of the product design did not fall within the scope of protection. The result would be the same, but without *a priori* excluding the plaintiff's product design from copyright protection. In this manner, the OLG (Higher Regional Court) of Nuremberg¹²⁹ has granted copyright protection to the popular

“Bundesliga” table of the magazine “Kicker” on the basis of BGH’s *Geburtstagszug* interpretation. However, since the similar design of the defendant kept a sufficient distance from the narrow scope of protection, the action was ultimately dismissed.

Therefore, should the CJEU decide in *Cofemel* that works of applied art are eligible to copyright protection provided that they are the author's own intellectual creation, the argument of excessive “monopolization” of product design does not stand up, given that the national courts still have sufficient leeway in determining the concrete scope of protection. Moreover, in contrast to trademark, design

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or patent law, a product design protected by copyright does not have a comparable blocking effect. A valid patent on a pharmaceutical product keeps the generic manufacturer off the market. In contrast, the risk of an infringement of the copyright in a classic furniture or fashion design simply means that the competing designer has to come up with new ideas. There can be no talk of a deterrent effect that hinders creative progress. Besides, copyright in France, the Netherlands and Belgium prove that renouncing any kind of “artistic” character as regards to the eligibility does not lead to an inhibition of creative progress. And even in Germany, five years after the lowering of the protection threshold with *Geburtstagszug*, neither a flood of lawsuits nor the feared stagnation in the creative progress can be observed.¹³⁰

3. Evidence and allocation of the burden of proof

The proposed solutions put the designer's arbitrary creative choices in developing the product design product at the forefront of infringement proceedings. These choices must be convincingly substantiated in proceedings so that the plaintiff that bears the burden of proof can enforce its claims based on copyright.¹³¹

From a practitioners view, the concept of symmetry between the creative freedom and the scope of protection raises the question of whether a high degree of similarity with regard to the pure aesthetic characteristics would justify a reversal of the burden of proof in infringement proceedings.¹³² The judge could request from the potential infringer proof of the technical/functional and economic necessity of the original design or features thereof if this appears appropriate in the individual case, e.g. due to the significant similarity of the imitation.

Of course, this proposal has not yet been elaborated down to the last detail. In addition to the difficulty of a gradual determination of the similarity, the question also arises of how the alleged infringer can succeed in producing this evidence. It would be conceivable to orientate on the earlier “first to invent”- practice. In contrast to patent law, it would be necessary to document the actual usage of the creative freedom. Such “laboratory journals” in the creative field are no novelty. It is common and – especially with regard to EU design law to defend against accusations of infringing unregistered designs – urgently advisable for designers to document the processes of their developments and choices. In infringement proceedings, such documentation is likely to be a valuable means of defence.¹³³

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¹ US Supreme Court – *Bleistein v. Donaldson Lithographing Co.* (188 U.S. 239 (1903), 251).

² *Horizontalisation* refers to the application of vertically harmonised provisions to similar areas of copyright law. On the concept of the horizontalisation of European copyright law, see already *Würfel*, *Europarechtliche Möglichkeiten einer Gesamtharmonisierung des Urheberrechts*, Karlsruhe 2005, p. 160.

³ *Quaedvlieg*, *The Copyright/Design Interface in the Netherlands*, in: *Derclaye Estelle*, *The copyright/design interface: past, present, and future*, Cambridge 2018, p. 51; *Bently*, *The Return of Industrial Copyright?*, *Legal Studies Research Paper Series 19/2012*, pp. 661 et seq.; *von Lewinski*, *Introduction: The Notion of Work under EU Law*, *GRUR Int.* 2014, 1097 et seqq. *Schulze*, *Schleichende Harmonisierung des urheberrechtlichen Werkbegriffs? Anmerkung zu EuGH*, *GRUR* 2009, 1019 et seqq. – *Infopaq/DDF*.

⁴ See e.g. Judgement of the Supreme Court of the Netherlands of 25 October 2013, *S&S Import en Export v. Esschert Design*.

⁵ CJEU Proceeding, C-683/17 – *Cofemel – Sociedade de Vestuário S.A./G-Star Raw CV*.

⁶ As a reference to French understanding of the “*unité de l’art*” according to Art. L. 112-1 CPI: “*Les dispositions du présent code protègent les droits des auteurs sur toutes les oeuvres de l’esprit, quels qu’en soient le genre, la forme d’expression, le mérite ou la destination.*”; see also *Mezger*, *Die Schutzwelle für Werke der angewandten Kunst nach deutschem und europäischem Recht*, Göttingen 2017, pp. 169 et seqq.

⁷ Thereby industrial design and product design are often used as synonyms.

⁸ BGH, *GRUR* 2014, 175, para. 16 – *Geburtstagszug*; *Obergfell*, *Abschied von der „Silberdistel“: Zum urheberrechtlichen Schutz von Werken der angewandten Kunst*, *GRUR* 2014, 621.

⁹ *Schack*, *Urheber- und Urhebervertragsrecht*, Tübingen 2017, para. 237; *Kriesel*, *Einheitlicher europäischer Werkbegriff und Herabsenkung der Anforderungen an die Gestaltungshöhe bei Werken der angewandten Kunst*, Frankfurt a.M. 2014, p. 34.

¹⁰ While all European copyright directives use the term “*work*”, only three of them define its conditions for particular kinds of works, see below chapter IV.1.

¹¹ Cf. *Erdmann*, *Die Relativität des Werkbegriffs*, in: *FS Michael Loschelder*, Köln 2010, pp. 61 et seqq., who speaks of the “*relativity*” of the concept of work.

¹² See Green Paper on the Legal Protection of Industrial Design. Working document of the services of the Commission. III/F/5131/91-EN.

¹³ Recital 32 and Art. 96(2) of the Council Regulation (EC) No. 6/2002 of 12 December 2001 on Community designs and recital 8 and Art. 17 of the Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs.

¹⁴ *Derclaye/Leistner*, *Intellectual property overlaps: a European perspective*, Oxford 2011, p. 46.

¹⁵ For example in the case of Germany, see below II.2.

¹⁶ See on this topic *Geier*, *Schutzkumulationen: Angriff auf die Gemeinfreiheit oder legitimer Schutz Geistigen Eigentums?*, Tübingen 2015.

¹⁷ *Obergfell*, *GRUR* 2014, 621. In this sense also the French understanding of the concept of “*cumul absolu*”; *Rudes*, *Urheberrechte an Werken der angewandten Kunst in der Europäischen Gemeinschaft: Die Lücke im gemeinschaftsweiten Urheberrechtsschutz der Werke der angewandten Kunst*, Frankfurt a.M. 2001, p. 31; *Mezger* (supra note 6), p. 172; On the intellectual property protection cumulations: *Geier* (supra note 16). Deviating *Klawitter*, *Urheberschutz für*

Designleistungen: Kehrtwende oder Randkorrektur?, GRUR-Prax 2013, 31, who states that product designs may be works of applied art, but usually they are not.

¹⁸ *Hasselblatt/v.Gerlach*, in: Hasselblatt (ed.), Münchener Anwaltshandbuch, Gewerblicher Rechtsschutz, 5. Aufl., München 2017, § 45 para. 7.

¹⁹ *Obergfell*, GRUR 2014, 621.

²⁰ *Zentek*, Designspezifische Absenkungen der urheberrechtlichen Gestaltungshöhe – Keine Angst vorm BGH, WRP 1/2010, 75; *Schramm*, Der europaweite Schutz des Produktdesigns: das Gemeinschaftsgeschmacksmuster und sein Verhältnis zur Gemeinschaftsmarke, Baden-Baden 2005, pp. 136 et seqq.; *Erdmann* (supra note 11), p. 69.

²¹ *Hasselblatt/v. Gerlach* (supra note 18), § 45 para. 1.

²² *Hasselblatt/v. Gerlach* (supra note 18), § 45 para. 7.

²³ See also Art. 4(1) of the Regulation on Community designs, according to which a design shall be protected by a Community design to the extent that it is new and has individual character. A design shall be considered to be new if no identical design has been made available to the public (Art. 5(1) 1 of the Regulation on Community designs).

²⁴ BGH, GRUR 1995, 581 – *Silberdistel*; BGH, GRUR 2012, 58 – *Seilzirkus*; *Kriesel* (supra note 9), p. 35; *Zentek* (supra note 20), pp. 73 et seqq.

²⁵ I.e. the former Act on Copyright in Designs, *Kriesel* (supra note 9), p. 33; *Obergfell*, GRUR 2014, 622.

²⁶ In the former system in Germany, for example, the “above-average achievements” covered by the former copyright on designs were located “below” the scope of the “small coin” (“kleine Münze”) of copyright law (“Gesetz betreffend das Urheberrecht an Mustern und Modellen”); See the – historically grown – distorted relationship of copyright law to design in *Zentek* (supra note 20), p. 74. See former BGH, GRUR 1995, 581 – *Silberdistel*; *Kriesel* (supra note 9), p. 33; *Schack* (supra note 9), para. 232.

²⁷ *Kur*, Die Auswirkungen des neuen Gemeinschaftsgeschmacksmusterrechts auf die Praxis, GRUR 2002, 669.

²⁸ BGH, GRUR 1995, 581 (582) – *Silberdistel*; GRUR 1998, 830 (832) – *Les-Paul-Gitarren*; BGH, GRUR 2004, 941 (942) – *Metallbett*; *Obergfell*, GRUR 2014, 622 et seqq.

²⁹ BGH, GRUR 2004, 941 (942) – *Metallbett*; BGH, GRUR 1995, 581 (582) – *Silberdistel*; BGH, GRUR 1987, 903 – *Le Corbusier*.

³⁰ The German design law based on Community design law entered into force on 1 June 2004.

³¹ BGH, GRUR 2014, 175 – *Geburtstagszug*.

³² BGH, GRUR 2014, 175, para. 22 et seqq. – *Geburtstagszug*. See also on this *Obergfell*, GRUR 2014, 621; *Klawitter*, GRUR-Prax 2014, 30.

³³ *Obergfell*, GRUR 2014, 621. However, there are also voices that interpret this decision solely as a comeback of old case law rather than a lowering of the protection requirements, e.g. *Liebenau*, *Star Athletica v. Varsity Brands – German Comparative Perspectives and European Harmonization of Copyright for Applied Art – Part II*, GRUR Int. 2017, 922. See also the critical view on this judgement in *Klawitter*, GRUR-Prax 2014, 31.

³⁴ BGH, GRUR 2014, 175, para. 38 et seqq. – *Geburtstagszug*

³⁵ See *Hartmann*, *Geburtstagszug in voller Fahrt?*, WRP 11/2016, 1327 et seqq. for an overview of the case law following the *Geburtstagszug* decision.

³⁶ Judgement of OLG Schleswig, 11 September 2014, 6 U 74/10.

³⁷ See unpublished judgment of the regional court Cologne of 22 March 2018 (14 O 24/18).

³⁸ See judgement of 20 May 2014 (Az. 3 U 1874/13).

³⁹ Judgement of LG Hamburg, 7 July 2016, 310 O 212/14.

⁴⁰ *Ritscher*, Hält der Geburtstagszug auch in der Schweiz? – Gedanken zur urheberrechtlichen Schutzwelle und zum Schutzzumfang von Produktgestaltungen in Deutschland und in der Schweiz, in: Dreier/Pfeifer/Specht, *Anwalt des Urheberrechts*, Festschrift für Gernot Schulze zum 70. Geburtstag, 2017, pp. 31 et seqq.

⁴¹ BGE 68 II 53, 61; BGE 113 II 190, 196 f. – *Le Corbusier*; BGer of 2 May 2011 (4A_78/2011) consid. 2.4.

⁴² *Ritscher* (supra note 40), pp. 36 et seq., 99.

⁴³ BGE 143 III 373 of 12 July 2017.

⁴⁴ Accordingly, the bar stool to be judged creates an overall impression which individualizes it as such and clearly distinguishes it from the previously known models (BGE 143 III 373, 384, consid. 2.8.5.) In connection with product designs, the judgment of 3 July 2012 (4A_20/2012) with regard to form marks (Lego bricks) is also worth reading.

⁴⁵ *Ritscher* (supra note 40), p. 33.

⁴⁶ *Roder*, Die Methodik des EuGH im Urheberrecht: die autonome Auslegung des Gerichtshofs der Europäischen Union im Spannungsverhältnis zum nationalen Recht, Tübingen 2016, p. 380.

⁴⁷ Tribunale Milano of 12 July 2016 (8628/2016).

⁴⁸ This approach was also the basis of the old case law of the German courts concerning the simple design classics from the "Bauhaus" era, which were only eligible for copyright protection due to their art historical fame (see BGH, GRUR 1987, 903 (905) – *Le Corbusier-Möbel*; BGH, GRUR 1974, 740 (742) – *Sessel*; BGH, GRUR 1961, 635 (638) – *Stahlrohrstuhl I* and recently Higher Regional Court Munich, GRUR-RR 2011, 54 (55) – *Eierkoch*. Even the *Geburtstagszug* decision still contains the criterion that in the opinion the circles that are receptive to art must speak of an "artistic" achievement (BGH, GRUR 2014, 175 (177) – *Geburtstagszug*).

⁴⁹ In the decision 21367/2013 of 23 March 2017 copyright protection was granted to ceramic figurines of the manufacturer "Thun" and in the decision 22715/2014 of 6 June 2018 to the TV character "Gabbibo" and his procedural opponent, the mascot "Big Red".

⁵⁰ See Art. L. 511-1 CPI; see also *Zech*, Der Schutz von Werken der angewandten Kunst im Urheberrecht Frankreichs und Deutschlands, München 1999, pp. 29 et seqq. and *Mezger* (supra note 6), p. 170.

⁵¹ Art. L112-1 CPI "oeuvres de l'esprit"; see also *Rudes* (supra note 17), p. 43; *Mezger* (supra note 6), pp. 169 et seqq.

⁵² *Zech* (supra note 50), pp. 68 et seq.; *Mezger* (supra note 6), p. 171.

⁵³ *König*, Der Werkbegriff in Europa – Eine rechtsvergleichende Untersuchung des britischen, französischen und deutschen Urheberrechts, Tübingen 2015, p. 190; *Mezger* (supra note 6), p. 171.

⁵⁴ "result of its author's own skill, labour, judgment and effort", see *University of London Press v. University Tutorial Press* [1916] 2 Ch 601, 609-610.

⁵⁵ Based on the criterion of work, formulated earlier as "sweat of the brow".

⁵⁶ *Würfel* (supra note 2), p. 165.

⁵⁷ *Masiyakurima*, Copyright in Works of Artistic Craftsmanship: An Analysis, 36 (3) Oxford Journal of Legal Studies 506 (2016).

⁵⁸ See Chapter IV below.

⁵⁹ *Masiyakurima* (supra note 57), p. 508; *Bently* (supra note 3), p. 654. According to *Rahmatian* the practical impact of the CJEU's case law on the UK copyright system will be small (see *Rahmatian*, Originality in UK Copyright Law: The Old "Skill and Labour" Doctrine Under Pressure, International Review of Intellectual Property and Competition Law, 44(4)).

⁶⁰ *Quaedvlieg* (supra note 3), 39.

⁶¹ Judgement of the Benelux Court of Justice of 22 May 1987, para. 23 – *Screenoprints v. Citroën*.

⁶² See for example Judgement of the Supreme Court of the Netherlands of 25 October 2013 – *S&S Import en Export v. Esschert Design*; Judgements of the Court of Appeal of Arnhem of 16 March 1999 – *Vredestein v. Ring 65* or of the Court of Appeal of The Hague of 3 February 2000 – *Slagboom Electric v. Koz Products*. See also the *Tripp Trapp* Judgements of the Supreme Court which provide valuable approaches to how to deal with merely or at least partially functionally determined product designs (Judgement of the Supreme Court of the Netherlands of 22 February 2013 – *Stokke v. H3*, of 12 April 2013 – *Stokke v. Fikszo* and of 12 April 2013 – *Hauck v. Stokke*).

⁶³ Judgement of the Supreme Court of the Netherlands, 30 May 2008, 44 IIC 103 (2013) – *Endstra v. Uitgeverij Nieuw Amsterdam*.

⁶⁴ *Quaedvlieg*, The Tripod of Originality and the Concept of Work in Dutch and European Copyright, GRUR Int. 2014, 1105 (1109); *Quaedvlieg* (supra note 3), p. 48 with further references.

⁶⁵ See below Chapter IV.

⁶⁶ *Strowel*, Droit d'auteur et copyright: divergences et convergences: étude de droit comparé, Brussels 1993, p. 455.

⁶⁷ Judgement of the US Supreme Court *Mazer v. Stein*, 347 U.S. 201 (1954).

⁶⁸ Judgement of the US Supreme Court *Mazer v. Stein*, 347 U.S. 201 (1954), 217.

⁶⁹ See Art. 101 of the 1976 US Copyright Act: "the design of a useful article [...] shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article".

⁷⁰ See, e.g., U.S. Court of Appeals, Second Circuit, Case No. 1351 – *Kieselstein-Cord v. Accessories By Pearl, Inc.; Pivot Point International Inc. v. Charlene Products, Inc.* 372 F.3d 913 (7th Cir. 2004); *Universal Furniture International, Inc. v. Collezione Europa USA, Inc.* 618 F.3d 418 (4th Cir. 2010). *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir.1987) ("Where design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences, conceptual separability exists."); *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir.1980) (finding sculptural element of belt buckle conceptually separable from utilitarian function). See also *Schaefer/Nordemann*, Die Neubestimmung des Schutzzumfangs urheberrechtlich geschützter Werke der angewandten Kunst nach den Entscheidungen Seilzirkus und Geburtstagszug, in: Dreier/Pfeifer/Specht (supra note 40), p. 39.

⁷¹ US Supreme Court No. 15-866 of 22 March 2017 – *Star Athletica, LLC v. Varsity Brands, Inc.*; See on this already *Liebenau*, GRUR Int. 2017, 843 et seqq.

⁷² See *Ginsburg* according to which the approach in *Star Athletica* only offers an effective way to discern separability of pre-existing artworks applied to useful articles, but identifies difficulties in the case of artistic designs created as useful articles (as a whole), see *Ginsburg*, Courts Have Twisted Themselves into Knots (and the Twisted Knots Remain to Untangle): US Copyright Protection for Applied Art after *Star Athletica* in: Derclaye, The copyright/design interface: past, present, and future, Cambridge 2018, pp. 297 et seqq. See also *Ginsburg's* concurring opinion in the *Star Athletica* decision (580 U.S. (2017)). According to *Liebenau*, the decision merely answers the narrow question about the separability of surface decorations from their utilitarian base, see *Liebenau*, *Star Athletica v. Varsity Brands – U.S. Copyright Protection for Applied Art – Part I*, GRUR Int. 2017, 844.

⁷³ Commission of the European Communities, Green Paper on Copyright and the Challenge of Technology, Copyright Issues requiring immediate action (Com (88) 172).

⁷⁴ Council Directive 91/250/EEC of 14 May 1991 on the legal protection of computer programs and Directive 2009/24/EC of 23 April 2009 on the legal protection of computer programs.

⁷⁵ Directive 96/9/EC of 11 March 1996 on the legal protection of databases.

⁷⁶ Directive 2006/116/EC of 12 December 2006 on the term of protection of copyright and certain related rights.

⁷⁷ *Erdmann* (supra note 11), pp. 63 et seqq.

⁷⁸ See recitals 32 in the preamble and Art. 96 (2) of the Council Regulation (EC) No. 6/2002 of 12 December 2001 on Community designs.

⁷⁹ CJEU Judgements of 16 July 2009, C-5/08 – *Infopaq International*. See on this already *Berger*, Aktuelle Entwicklungen im Urheberrecht – Der EuGH bestimmt die Richtung, ZUM 2012, 353 et seq.; *von Lewinski*, GRUR Int. 2014, 1099 et seq. and *Rosati*, Originality in EU copyright: full harmonization through case law, Cheltenham 2013, pp. 97 et seqq.

⁸⁰ Directive 2001/29/EC of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society.

⁸¹ CJEU Judgement of 16 July 2009, C-5/08, paras. 36 and 39 – *Infopaq International*.

⁸² CJEU Judgement of 16 July 2009, C-5/08, para. 35 – *Infopaq International*.

⁸³ *Kriesel* (supra note 9), p. 178; *Rosati*, Why originality in copyright is not and should not be a meaningless requirement, 13 (8) Journal of Intellectual Property Law & Practice 597 (2018).

⁸⁴ See CJEU Judgements of 22 December 2010, C-393/09 – *Bezpečnostní softwarová asociace*; of 4 October 2011, C-403/08/C-429/08 – *Football Association Premier League v. Murphy*; of 1 December 2011, C-145/10 – *Painer/Standard* and of 3 September 2014, C-201/13 – *Deckmyn and Vrijheidsfonds*.

⁸⁵ CJEU Judgement of 13 November 2018, C-210/17 – *Levola Hengelo BV/Smilde Foods BV*.

⁸⁶ CJEU Judgement of 13 November 2018, C-310/17, para. 33 – *Levola Hengelo BV/Smilde Foods BV*; see also *Schulze*, Urheberrechtsschutz für den Geschmack von Lebensmitteln? Anmerkungen zu EuGH, Urteil vom 13.11.2018 – C-310/17 – *Levola Hengelo*, ZUM 2/2019, 65 and the opinion of AG *Wathelet* delivered on 25 July 2018, para. 40.

⁸⁷ According to the CJEU, the taste of a food product can, in the current state of scientific development, not be pinned down with necessary precision and objectivity. Therefore, the taste of a food product cannot be classified as a 'work' within the meaning of the InfoSoc Directive and is thus precluded from being protected by copyright. According to *Schulze*, the CJEU should have left

it open to national law how the individuality of a taste is to be determined, see *Schulze*, ZUM 2/2019, 65.

⁸⁸ CJEU Judgement of 27 January 2011, C-168/09 – *Flos*.

⁸⁹ CJEU Judgement of 27 January 2011, C-168/09, para. 44 – *Flos*.

⁹⁰ CJEU Judgement of 27 January 2011, C-168/09, para. 34 – *Flos*.

⁹¹ According to *Bently* (supra note 3), *Flos* was wrongly decided because it ignored the legislative history of the Design Regulation and the Information Society Directive, whereas *Roder* (supra note 46), pp. 420 et seqq., states that the CJEU did not fully harmonise the level of originality and that member states may continue to determine the threshold at national level, since the harmonised originality is only one aspect of the concept of work.

⁹² Judgement of the Supreme Court of the Netherlands of 25 October 2013 – *S&S Import en Export v. Esschert Design*.

⁹³ With regard to BGH's *Geburtstagszug* decision it is disputed whether the BGH decided to lower the threshold for protection directly in view of a fully harmonised European concept of work, see *Roder* (supra note 46), p. 420 and *Klawitter*, GRUR-Prax 2014, 31. According to *Ohly*, the departure of the BGH from its previous case law was not mandated by EU law but rather a "home made" solution, see *Ohly*, The Case for Partial Cumulation in Germany, in: Derclaye, The copyright/design interface: past, present, and future, Cambridge 2018, p. 167.

⁹⁴ *Würfel* (supra note 2), pp. 153 et seqq.

⁹⁵ Similarly *Roder* (supra note 46), p. 306.

⁹⁶ See the pending CJEU proceeding, C-683/17 – *Cofemel – Sociedade de Vestuário S.A./G-Star Raw CV*.

⁹⁷ CJEU Proceeding, C-683/17 – *Cofemel – Sociedade de Vestuário S.A./G-Star Raw CV*.

⁹⁸ See Recital 32 and Art. 96(2) of the Council Regulation (EC) No. 6/2002 of 12 December 2001 on Community designs and recital 8 and Art. 17 of the Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs. See also Judgement of the Supreme Court of the Netherlands of 25 October 2013 – *S&S Import en Export v. Esschert Design*, in which it was held that this freedom already had been limited by the previous horizontal harmonisation of the CJEU. See also *Derclaye/Leistner* (supra note 14), p. 46 et seq.; *Quaedvlieg* (supra note 3), p. 50; *Roder* (supra note 46), p. 404.

⁹⁹ Design Directive: 13 October 1998, InfoSoc Directive: 22 Mai 2001 and Design Regulation: 12 December 2001.

¹⁰⁰ *Schaefer/Nordemann* (supra note 70), pp. 42 et seqq.

¹⁰¹ *Berger*, ZUM 2012, 354. See also a different views in *Rahmatian* (supra note 59), p. 30 et seqq. and *von Lewinski*, GRUR Int. 2014, pp. 1099 et seqq., according to which a recital can only interpret an article of the directive rather than be the basis for harmonization beyond such wording.

¹⁰² Similarly with regard to the competence of the CJEU see *Roder* (supra note 46), p. 306. See also a different view: *Rahmatian* (supra note 59), p. 30, who states that the CJEU "has arguably acted beyond its assigned powers."

¹⁰³ As it can currently be observed in connection with the proposal for a Directive on copyright in the Digital Single Market (COM(2016)).

¹⁰⁴ *Berger*, ZUM 2012, 354; See also *Erdmann* (supra note 11), p. 65, who correctly notes that the answer to the question of the reproduction of a work also requires a uniform interpretation of the underlying concept of the work.

¹⁰⁵ *Kriesel* (supra note 9), p.189; See also *König* (supra note 53), p. 8, according to which a unified European copyright law is indispensable in the long term in a European economic and cultural area. Similarly *Kriesel* (supra note 9), p.190, and *Schack* (supra note 9), para. 155, who demand an EU copyright regulation.

¹⁰⁶ See already *Würfel*, according to which differing requirements for protection constitute trade barriers and thus, a harmonisation of the notion of work should be a concern of internal market relevance (*Würfel* (supra note 2), p. 166). However, the Commission took a different view in 2004, according to which different interpretations of originality do not hinder the free movement of goods, Commission Staff Working Paper on the Review of the EC Legal Framework in the field of copyright SEC(2004)995, 13, see also *König*, (supra note 53), p. 8.

¹⁰⁷ Appropriately formulated by *Rau*, *Antikunst und Urheberrecht*, Berlin 1978, p. 42.

¹⁰⁸ *Quaedvlieg*, GRUR Int. 2014, 1105 (1112).

¹⁰⁹ With regard to the extremely low protection threshold in Dutch copyright law see *Quaedvlieg* (supra note 3), pp. 36 et seqq. The threat of monopolization was addressed by the German BGH already at an early stage, see e.g. BGH, GRUR 1958, 562 (564) – *Candida-Schrift*; see also *Erdmann* (supra note 11), pp 71 et seq.

¹¹⁰ *Erdmann* (supra note 11), p. 71; *Schack* (supra note 9), para. 237; *Masiyakurima* (supra note 57), p. 508.

¹¹¹ BGH, GRUR 2014, 175, para. 45 – *Geburtstagszug*.

¹¹² *Abrams*, *The Law of Copyright*, St. Paul 2008, § 3: 18.

¹¹³ This term can be regarded as the counterpart of “technical progress” under patent law.

¹¹⁴ See also the German BGH with regards to unfair competition law, BGH, GRUR 2012, 58 – *Seilzirkus*) and the Judgements of the Swiss Federal Supreme Court regarding 3D-marks, BGer of 3 July 2012, 4A_20/2012 and BGE 129 III 514 of 2 July 2002.

¹¹⁵ BGH, GRUR 2012, 58 (62) – *Seilzirkus*; *Schaefer/Nordemann* (supra note 70), p. 40.

¹¹⁶ Council Regulation (EC) No. 6/2002 of 12 December 2001 on Community designs.

¹¹⁷ CJEU Judgement of 22 December 2010, C-393/09, para. 48 – *Bezpečnostní softwarová asociace*.

¹¹⁸ CJEU Judgement of of 1 December 2011, C-145/10 – *Painer/Standard*.

¹¹⁹ CJEU Judgement of of 1 December 2011, C-145/10, para. 88 et seq. – *Painer/Standard*; see also *Metzger*, *Der Einfluss des EuGH auf die gegenwärtige Entwicklung des Urheberrechts*, GRUR 2012, 118 (122); *Strömholm*, *Was bleibt vom Erbe übrig? Überlegungen zur Entwicklung des heutigen Urheberrechts*, GRUR Int. 1989, 15 (17 et seqq.); *Berger*, ZUM 2012, 355.

¹²⁰ BGH, GRUR 2012, 58, para. 25 – *Seilzirkus*.

¹²¹ Judgement of the Court of Appeal of Amsterdam of 17 January 2012 – *Stokke v. Jamak*.

¹²² BGH, GRUR 2015, 909 – *Exzenterzähne*. See the critical view on this judgement in *Leistner*, *Exzenterzähne 2.0*, GRUR 2018, 697.

¹²³ See on the topic of the scope of protection of registered designs: *Christof*, *Der Schutzzumfang von eingetragenen Design und Gemeinschaftsgeschmacksmuster*, Hamburg 2017, passim.

¹²⁴ See also the German BGH in *Geburtstagszug* which held that a low creative degree may lead to copyright protection but also to a correspondingly narrow scope of protection (BGH, GRUR 2014, 175 (178), para. 45) – *Geburtstagszug* with references to BGH, GRUR 1987, 360 (361) – *Werbepläne*, BGH, GRUR 1991, 529 (530) – *Explosionszeichnungen* as well as BGH, GRUR 2011, 803, para. 63 – *Lernspiele*).

¹²⁵ See, for example, BGH, GRUR 2005, 600 (602) – *Handtuchklemmen*; BGH, GRUR 2007, 339, para. 27 – *Stufenleitern*; GRUR 2007, 984, para. 20 – *Gartenliege*; GRUR 2008, 1234, para. 36 – *Baugruppe*) with regard to the similar criteria under unfair competition law. On this topic also *Zentek* (supra note 20), pp. 78 et seq.

¹²⁶ On symmetry as a “primary phenomenon” of the law *Florstedt*, *Recht als Symmetrie*, Ein Beitrag zur Theorie des subjektiven Privatrechts, Tübingen 2015; see also *Ritscher*, FS-Schulze, p. 32 and BGH, GRUR 2014, 175 (178) – *Geburtstagszug*.

¹²⁷ *Schaefer/Nordemann* (supra note 70), p. 45.

¹²⁸ See also *Schaefer/Nordemann* (supra note 70), p. 46, according to which even small deviations may leave the scope of protection and can be regarded as “free use” according to § 24 of the German Copyright Act.

¹²⁹ Judgement of the OLG Nuremberg of 20 May 2014 (Az. 3 U 1874/13).

¹³⁰ *Hartmann*, WRP 2016, 1334.

¹³¹ *Stokke*, for example, succeeded in doing this by demonstrating that the L-shape of the Tripp Trapp chair was also based (also) on aesthetic choices, see Judgement of the Supreme Court of the Netherlands of 22 February 2013 – *Stokke v. H3*.

¹³² Cf. the similar demand of *Jaeger* in connection with the “subconscious copying” doctrine, *Jaeger*, *Does that Sound Familiar?*, *Vanderbilt Law Review*, Vol. 61, No. 6, 2008. A different burden of proof distribution was chosen in the *Seilzirkus* decision of the German BGH. Accordingly, the plaintiff must clearly and precisely state the extent to which the useful article is designed beyond the form determined by its function (BGH, GRUR 2012, 58, para. 25 – *Seilzirkus*).

¹³³ Just recently, for example, British pop star *Ed Sheeran* used a video documentation of the creation process of his song *Shape of you* as a defensive argument in copyright infringement proceedings (see the IPKat, 14 August 2018 „Oh why, oh I, wonder if it is a substantial part ...“).