

Does Technical Function Impede Copyright?

Background

The dispute is based on the claim that appearance features of Brompton Bicycles, which have been produced and sold in the same form since 1987 by the Designer SI and Brompton Bicycle Limited Company and can be adjusted to three different positions (folded, unfolded and stand-by) are copied in the production of 'Chedech Bicycles' by Get2Get, thus infringing the copyright in the Brompton Bicycle.

The dispute commenced at the local level before the Belgian Court (Referring Court) where it was discussed whether copyright protection must be provided in cases where appearance features are dictated by technical function, such as in the case of Brompton Bicycles, and what criteria the Court must use when conducting that assessment. At this point the Referring Court stayed the proceedings and referred the following questions to CJEU for a preliminary ruling:

- 1) Must EU law, in particular Directive 2001/29/EC, which determines, inter alia, the various exclusive rights conferred on copyright holders, in Art. 2 to 5 thereof, be interpreted as excluding from copyright protection Works whose shape is necessary to achieve a technical result?
- 2) In order to assess whether a shape is necessary to achieve a technical result, must account be taken of the following criteria:
- i. The existence of other possible shapes which allow the same technical result to be achieved?
 - ii. The effectiveness of the shape in achieve that result?
- iii. The intention of the alleged infringer to achieve that result?iv. The existence of an earlier, now expired, patent on the process for achieving the technical result sought?

CJEU Decision

CJEU framed the issue raised by the Referring Court as whether the 'Directive on the Harmonization of Certain Aspects of Copyright and Related Rights in the Information Society' numbered 2001/29 EC should be applied to products whose shapes are necessary to achieve a technical result at least partially.

The decision stated that copyright protection would not be granted to products whose appearance features are exclusively dictated by technical functions, but it may be provided for the ones whose shapes are, at least in part, necessary to obtain a technical result provided that the requirements concerning originality and objective perception sought for a product to be regarded as a 'work' are met.

The CJEU noted that the bicycle appears to be identifiable with sufficient precision and objectivity. As such it is necessary to examine whether the folding bicycle at issue is capable of constituting a work eligible for copyright protection, namely, does it meet the originality criteria. In its evaluation of the criteria for originality, the CJEU stated that if a subject matter is to be capable of being regarded as original, it is both necessary and



sufficient that the subject matter reflects the personality of its creator, as an expression of his/her free and creative choices.

In terms of the effect of the technical function on the evaluation of originality, the CJEU held that a creator's original intellectual creation is capable of copyright protection but not where it is dictated by technical considerations, rules or constraints which have left no room for creative freedom.

The CJEU stated that it is not decisive in assessing the factors which influenced the choice made by the creator, even though the existence of other possible shapes which can achieve the same technical result makes it possible to establish that there is a possibility of choice. Thus, multiplicity of shapes theory, whereby the availability of other possible shapes allowing the same technical result construes that single shape is not considered necessary to achieve a technical result making the shape in question not solely dictated by the technical function, was not applied by the CJEU in this dispute. The intention of the alleged infringer, the expired patent, and the effectiveness of the shape in achieving the same technical result were deemed irrelevant in the overall assessment. These factors could be taken into account only in so far as they make it possible to reveal what was taken into consideration in choosing the shape of the product.

According to the CJEU, regardless of the external and subsequent factors in the creation of the product, it should be evaluated whether the criteria of originality has been met by considering all conditions that existed at the time of creation of the 'work'. As at the time of writing, the Belgian Court has not rendered its decision in the main proceedings. It remains to be seen how the Referring Court will interpret the findings of the CJEU.

Conclusion and Comments

The CJEU has clarified that in terms of appearance features of products such as bicycles for Daily use, the technical function may not prevent copyright protection if the condition of originality is met. It is clear that the CJEU finds both necessary and sufficient an original subject matter, in the sense of being the author's own intellectual creation and a subject matter that is identifiable with sufficient precision and objectivity for copyright protection.