



A bicycle built for two (IP rights)?

Brompton Bicycle Ltd. v. Get2Get (C-833/18)

The European Court of Justice, in the recent case of *Brompton Bicycle Ltd. v. Get2Get (C-833/18)*, has held that a functional shape may be protected by copyright if it is 'original' in the copyright sense. Whether this means that products such as bicycles will enjoy copyright protection in the UK is far from certain.

Introduction

The shape at issue in this case was the famous Brompton bicycle. The recognisable design of the Brompton bicycle can assume three positions: a folded position, an unfolded position and a stand-by position enabling the bicycle to stay balanced on the ground. The Brompton bicycle had been protected by a patent. After the patent's expiry, Get2Get began selling a rival bicycle with a similar ability to assume three folding positions and, crucial to the claim for copyright, a similar shape.

Brompton brought an action before the Companies Court in Liège, Belgium, seeking a ruling that Get2Get's bicycles infringed Brompton's copyright. Get2Get contended that the appearance of its bicycle was dictated by the desired technical solution, namely to ensure that the bicycle can fold into three different positions, and that such a result could not be protected under copyright law.

The questions referred to the Court of Justice

The Belgian court referred the following questions to the Court of Justice:

- 1) Must EU law, in particular Directive [2001/29], which determines, inter alia, the various exclusive rights conferred on copyright holders, in Articles 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:
 - The existence of other possible shapes which allow the same technical result to be achieved?
 - The effectiveness of the shape in achieving that result?
 - The intention of the alleged infringer to achieve that result?
 - The existence of an earlier, now expired, patent on the process for achieving the technical result sought?



Answer to question (1): Copyright protection will only be precluded per se where the shape of the product is solely dictated by its technical function.

In answering the first question, the Court held that copyright protection will only be precluded per se where the shape of the product is solely dictated by its technical function. It derived this rule from its previous recent decision in *Cofemel* (C-683/17) (judgment of 12 September 2019). In *Cofemel*, the Court held two conditions must be satisfied for there to be a copyright protected 'work': first, there must be subject matter which is "original", in the sense that it represents the author's "own intellectual creation"; second, the subject matter must be expressed in such a way to make it "*identifiable with sufficient precision and objectivity.*" The Court observed that there appeared to be no dispute that the Brompton bicycle satisfied the second condition, since the bicycle's shape was identifiable with sufficient precision and objectivity.

As to whether the shape had the necessary degree of originality, this assessment falls to the national court. The Court of Justice outlined the principles to be applied by the national court. It observed that, in order for subject matter to be original, "*it is both necessary and sufficient that the subject matter reflects the personality of its author, as an expression of his free and creative choices.*" Where the subject matter has been "*dictated by technical considerations, rules or other constraints which have left no room for creative freedom*" (our emphasis), then there will be no protection under copyright. The Court stressed that the mere presence of technical considerations will not be a bar *per se* to copyright protection, and the national court must assess "*whether, through that choice of the shape of the product, its author has expressed his creative ability in an original manner by making free and creative choices and has designed the product in such a way that it reflects his personality.*"

Answer to question (2): originality is key

The Court emphasised that originality is the controlling factor. Consistently with that, it held that:

- 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, but this alone is not decisive in assessing the factors which influenced the choice made by the creator;
- the intention of the infringer is irrelevant; and
- the existence of an earlier, now expired, patent and the effectiveness of the shape in achieving the same technical result should be taken into account 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.

Where does this leave bicycles and similar products in the UK?

Traditionally, designers of bicycles and similar products will have looked to patent protection (as did Brompton) and registered or unregistered design rights to protect their creations. The decision of the Court of Justice certainly leaves the door open for some designs in some EU jurisdictions to enjoy copyright protection. Copyright protection clearly has its attractions to bicycle designers, since its duration of the creator's life plus 70 years far outstrips the duration of patent or design rights.

However, each design must, on its own facts, satisfy the Court's *Cofemel* test of being both 'original' and being a work of 'sufficient precision and objectivity'. These conditions must be met in all EU jurisdictions.



The UK has traditionally imposed a further condition: a 'work' must also fall into one of the recognised, closed categories of original literary, artistic, dramatic or musical works listed in section 1 of the Copyright, Designs and Patents Act 1988, or else the broader (but still closed) categories of article 2 of the Berne Convention. This further condition now appears at odds with the second condition in *Cofemel* and it is not clear how the UK courts will resolve this tension between a judgment of the European Court of Justice and the text of UK legislation, particularly in view of Brexit.

If the UK courts remain loyal to the text of the legislation, then it is very difficult to imagine how bicycles could fall into one of the recognised categories (the most promising, if any, would seem to be 'artistic' works, where 'sculptures' and 'works of artistic craftsmanship' are recognised subcategories).

Given these uncertainties, creators would be advised to continue to seek protection in the form of patents and/or design rights, and to rely on copyright only as a fall-back in litigation or when patent and design rights have expired.

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