



The Protection of Works of Applied Art under EU Copyright Law – Opinion of the European Copyright Society in *Mio/konektra* (Cases C-580/23 and C-795/23)

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Abstract In *Cofemel*, the Court of Justice of the European Union held that works of applied art are subject to the same originality requirement as other works (namely that the work be an expression of the author’s own intellectual creation). At the same time, the CJEU recognized the potential dangers of a generous approach when a work is recognized as an original work of applied art, in particular, the potential to undermine the specific legislative regime protecting designs. The Court indicated that copyright law should only exceptionally offer protection to designs. Two cases

The European Copyright Society (ECS) was founded in January 2012 with the aim of creating a platform for critical and independent scholarly thinking on European Copyright Law and policy. Its members are scholars and academics from various countries of Europe, seeking to articulate and promote their views of the overall public interest on all topics in the field of authors rights, neighbouring rights and related matters. The ECS is neither funded nor instructed by any particular stakeholders. Its Opinions represent the independent views of a majority of ECS members. The ECS sees it as part of its mission to give opinions on cases pending at the Court of Justice of the European Union.

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pending before the CJEU – *Mio* and *konektra* – both relating to claims to copyright in modernist furniture, highlight two consequences of this earlier case-law: firstly, how to apply the test in practice to ensure that copyright law is not granted too readily to designs; and, secondly, how far the test of infringement, initially elaborated in *Infopaq*, can also be made compatible with that goal. This Opinion of the European Copyright Society seeks to help the Court clarify when works of applied art should benefit from copyright protection and makes proposals relating to the scope of protection.

Keywords Copyright · Works of applied art · Originality · Idea/expression dichotomy · Infringement test · Court of Justice of the European Union · Designs

1 Executive Summary

Background: In *Cofemel*, the Court of Justice of the European Union (hereinafter CJEU) recognized that (i) the standard test of originality, first adopted in *Infopaq*, applies as much to works of applied art as other works but nevertheless indicated (ii) in order that the copyright regime does not undermine the balance inscribed in EU design law, the circumstances in which designs benefited from copyright protection as works of applied art would be limited. In two pending references, *Mio* and *konektra*, it will fall to the CJEU to develop and apply these propositions.

In this Opinion, the ECS draws on the existing case-law of the CJEU to highlight how these two propositions can be reconciled. It begins by explaining why it is important that copyright not be available too readily in this field.

Following the AG in *Cofemel*, the Opinion argues that much of the necessary work to delimit overlaps between copyright and *sui generis* design law can be achieved by a “rigorous” application of the CJEU’s criterion of originality that takes account of the factual restrictions on creativity in the context of works of applied art.

As regards protection, the Opinion elaborates from the case-law a four-stage approach to the assessment of the work, which according to the CJEU case-law includes determining whether there is expression and originality:

- (i) Identify expression, excluding from consideration basic ideas, where ideas merge with expression, and building blocks such as materials, shapes and colours;

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- (ii) Identify “free choices”, i.e. those that were “unconstrained”, noting that the notion of “free choice” does not include situations where there are only a small number of ways to express a functional goal;
- (iii) Identify which of the free choices constitute “creative choices” taken by the author (designer). These do not include copying existing works, trivial variations, or obvious choices or choices which follow existing trends, or choices that are determined by functional goals. They do not include skillful or workmanlike choices.
- (iv) Determine whether the creative choices, if any, mean that the personality of the author is expressed in the final production. This requires that the output itself must have some features that reflect the individual characteristics of the author. The features in the work should reflect the fact that its author is a different human being from other potential authors of works of the same sort: the effect must be to “set his work apart from that of other authors”. We suggest this depends on the quality and quantity of the “creative choices” that have been made.

In assessing these matters, all relevant evidence should be taken into account and assessed objectively including:

- (i) The designer’s account of their own motives and decisions (where available);
- (ii) Prior patents or patent applications over particular features;
- (iii) Evidence of independent creation of identical or similar designs (either before or after the work in issue);
- (iv) Evidence of experts and of museums.

That said, careful scrutiny will need to be made by a national court as to precisely how the evidence has a bearing on the issues before the tribunal. In particular, we sound caution over the likely relevance of the fact that a design is now in a museum: this may reflect judgements about fame, aesthetics or ergonomics and have nothing to do with whether there were creative choices.

This Opinion urges the CJEU to clarify these hitherto vague criteria and indicate how they might apply to different concrete circumstances. Although lacking the benefit of the evidence in these two cases, the Opinion tentatively and respectfully offers indications as to how the elements of the test might bear on the examples of a modernist designed dining table and modular system for shelving.

The Opinion goes on to consider the scope of protection afforded to works of applied art.

In many cases, works of applied art that pass the originality threshold will exhibit low levels of originality, because of the many constraints on free choices, and the presence of only a few creative choices. In such cases, following *Infopaq*, the Opinion argues that there will only be infringement if a person has reproduced that

which made the claimant's work original. This will often require exact duplication. We argue that the rough shorthand that "low originality" works obtain "thin" protection is consistent with this principle, and that suggestions to the contrary, based on *Painer*, are a misunderstanding.

Finally, this Opinion provides answers to each of the questions posed in the two references.

2 Introduction

1 The two cases pending before the CJEU – *Mio* and *konektra* – concern disputes where the plaintiffs claim copyright respectively in a table and modular shelving, as works of applied art. The table in question is Mio's "Palais table", a circular dining table with a single, central cylindrical support (decorated with vertical rods) and designed by Swedish designers Anya Sebton and Eva Lilja Löwenhielm. The modular shelving, USM Haller's system, is attributed to the Swiss architect Fritz Haller and form engineer, Paul Shaerer Jr. The referring court describes this as system of "high-gloss chrome-plated tubes that are connected using connector balls to form a frame. Metal closure boards of different colours (known as "panels") can be inserted into the frame. The bodies made in this way can be put together in any combination by adding bodies on top or to the side". The Court is asked by two national courts to clarify the conditions/criteria under which copyright protection must be afforded to works of applied art, as well as the circumstances in which any such copyright is infringed.

2 Works of applied art are special because, under EU law, they can be protected by copyright law but also by design laws (that is, the rules relating to EU Registered Designs and EU Unregistered Designs, as well as the harmonized national registered design regimes).¹ The two EU design regimes protect identically defined subject-matter – "the appearance" of a product.² As one might expect the registered regime is predicated on registration and offers protection for up to 25 years.³ Where a design is unregistered, protection lasts for only three years,⁴ and is limited (as with copyright) to the situation where the defendant has copied the design.⁵

¹ Directive 98/71/EC (hereinafter DD). See also Directive (EU) 2024/2823 of the European Parliament and of the Council of 23 October 2024 on the legal protection of designs (recast), PE/97/2023/REV/1, OJ L, 2024/2823, 18.11.2024, replacing the DD and to be implemented by 9 December 2027. We have adopted the new terminology *i.e.* EU design instead of Community design.

² Council Regulation No. 6/2002, Art. 3(a) (hereinafter DR). See also Regulation (EU) 2024/2822 of the European Parliament and of the Council of 23 October 2024 amending Council Regulation (EC) No. 6/2002 on Community designs and repealing Commission Regulation (EC) No. 2246/2002, PE/96/2023/REV/1, OJ L, 2024/2822, 18.11.2024. The new regulation will apply from 1 May 2025.

³ Article 12 DR.

⁴ *Ibid.*, Art. 11.

⁵ *Ibid.*, Art. 19(2).

3 The CJEU said in *Cofemel*⁶ that the two legal regimes (copyright and designs) have “fundamentally different objectives and are subject to distinct rules. [...] [T]he purpose of the protection of designs is to protect subject matter which, while being new and distinctive, is functional and liable to be mass-produced. Further, that protection is to apply for a limited time, but sufficient time to ensure a return on the investment necessary for the creation and production of that subject matter, without thereby excessively restricting competition. For its part, the protection attached to copyright, the duration of which is significantly greater, is reserved to subject matter that merits being classified as works”. (*Cofemel*, [50]).⁷

4 The pre-requisites for protection differ markedly. In copyright law, the CJEU has harmonised originality as being the “author’s own intellectual creation” for all works; in design law, a design will only benefit from protection if it is new and possesses individual character, the latter being judged from the perspective of a notional person (“the informed user”).⁸ The infringement tests also differ. In copyright, *Infopaq* requires only that a part has been copied which shares in the originality of the work.⁹ In design law, the Court assesses whether the overall impressions between the claimant’s and defendant’s designs are different from the point of view of an informed user.¹⁰ It is also worth noting that the exceptions and limitations to rights that are explicitly recognised in each regime differ (for example the repair clause).¹¹ Perhaps most remarkable are the differences in the duration of protection. Copyright protects works for 70 years from the death of the author; unregistered design right for three years from the making available of the design to the public; and registered designs, for a maximum of 25 years from filing for registration.¹²

5 While the principle of cumulation in EU design law means that copyright and design protection may overlap in certain specific cases,¹³ other aspects of the interface between copyright and design has been largely left unaddressed by the EU legislature. This has left the CJEU with the herculean (and in some instances perhaps impossible) task of trying to develop workable interactions between the regimes so that neither ends up undermining the careful balances drawn in the other

⁶ Case C-683/17 *Cofemel – Sociedade de Vestuário SA v G-Star Raw CV*, ECLI:EU:C:2019:721.

⁷ Although the court uses the term “distinctive”, to avoid confusion, that term is better reserved to the field of registered trade marks. The legislation on designs requires that the design display “individual” rather than “distinctive” character.

⁸ *Ibid*, Art. 4(1), Art. 6.

⁹ Case C-5/08 *Infopaq International A/S v Danske Dagblades Forening* [2009] ECR I-06569, [38].

¹⁰ Article 10(1) DR.

¹¹ *Ibid*, Art. 20, Art. 110. The new legislation introduces a referential use defence in Art. 18(1)(d) Directive recast and Art. 20(1)(d) Regulation 2024/2822 that appears to extend beyond the concept of the quotation defence in the Infosoc Directive 2001/29, Art. 5(2)(d) given the restrictive definition of “quotation” embraced by the CJEU in Case C-476/17, *Pelham GmbH & Ors v. R. Huetter & F. Schneider Esleben* [2019] ECLI:EU:C:2019:624.

¹² Article 11, Art 12 DR.

¹³ It only appears in Art.17 DD and Art. 96(2) DR which state that Member States are free to determine the extent of copyright protection of works of applied art and the conditions under which such protection is conferred.

regime.¹⁴ In this respect, there remain many aspects which the EU legislature should consider (going beyond these referrals).¹⁵ In *Cofemel*, the Court indicated that “the grant of protection, under copyright, to subject matter that is protected as a design must not have the consequence that the respective objectives and effectiveness of those two forms of protection are undermined”. (*Cofemel* [51]).¹⁶ Therefore, copyright protection must be “reserved to subject matter that merits being classified as works” (*Cofemel*, [50]). It added “that concurrent protection [of design and copyright] can be envisaged only in certain situations” (*Cofemel*, [52]), considering the particularities, the dynamics and the constraints of this form of creative expression.

6 The cases before the Court also illustrate the difficulty. The appearance of the MIO table certainly falls within the definition of a “design”, so whether it is protected by EU Unregistered Design Right or as an EU Registered Design depends on whether the design was, at the relevant moment, new and possessed individual character (and, of course, in the case of EU Registered Design, whether protection had in fact been applied for). Careful consideration therefore needs to be given to whether this is an exceptional case in which copyright is merited in the expressive form (Fig. 1).

7 The *konektra* case highlights a further issue. The Haller system was created in the 1960s – reputedly in 1963 by Swiss Architect Fritz Haller and the engineer (and grandson of USM founder) Paul Schaefer. It is a modular shelving system based on steel frames joined together by a ball joint (for which a patent application was made in 1965). Such a system might have been protected by national registered design law

¹⁴ The Design Directive recast in recital 3 refers to the careful “balance” that designs law implements; this reinforces the importance that copyright should not disturb that balance.

¹⁵ The CJEU could lead the way for a legislative intervention in this field, safeguarding legal certainty and the appropriate cumulation of design law and copyright protection. The revision of the EU design law package has moved decisively towards a principle of full cumulation, by removing in the cited recitals and Articles the references to the possibility of Member States to establish “the extent of copyright protection and the conditions under which such protection is conferred”. This is tantamount to a full harmonisation of copyright protection, and in particular of the concept of originality as well as its duration in relation to one of the few areas that were left unharmonised by the letter of the DD and DR. Whereas the harmonisation (and unification) of various aspects of EU copyright law is important for a functioning internal market, its achievement via the reform of the DD and DR may not be the most appropriate avenue. In particular, such a move towards full cumulation and therefore to an expansion of copyright protection via design law may be criticised as regards its appropriateness for a competitive internal market and for the EU design industry. It may be further criticised due to a (real or perceived) “surreptitious” attempt to change copyright law via the reform of design law. Therefore, the ECS strongly suggests that the Commission (DG Connect) properly revisits the copyright/design interface to address these issues, as otherwise there is a risk of overprotecting works of applied art by copyright which could also undermine design protection.

¹⁶ As Advocate General Szpunar said “it is necessary to ensure the autonomy and the achievement of the respective goals of each protection regime”: ECLI:EU:C:2019:363, [5]. At [52], he elaborated “there is a risk that the copyright regime would supplant the *sui generis* regime intended to protect designs. This would have several negative effects: the devaluation of copyright, sought to protect everyday creations, restriction of competition on account of the excessive duration of protection and even legal uncertainty, in that competitors are not able to predict whether a design whose *sui generis* protection has expired is also protected by copyright”.

Fig. 1 Mio table. Source: judgment from the Swedish court referring the case to the CJEU



– the EU design legislation makes specific provision for modular systems.¹⁷ But any registered design protection will have lapsed. However, if the design benefits from copyright protection the protection will continue for at least another 58 years, Haller having died in October 2012, perhaps much longer.¹⁸ Given the iconic status the design has acquired, it is hard to imagine anything similar being created “independently”; so, in this situation, any copyright would function as a very, very lengthy industrial property right (Fig. 2).

3 Criteria of Protection

8 In *Cofemel*, the CJEU clarified that while the Design Directive and Design Regulation recognised the principle of “cumulation” of copyright with designs,¹⁹ and while the same criterion of originality applied to copyright in works of applied art, “concurrent protection” could be admitted only “in certain specific situations”.

9 The Court in *Cofemel* confirmed that the test as to whether a work is original, in the sense of being “its author’s own intellectual creation”, applied as much to works of applied art (there, the design of clothing) as to any other works. This turns on whether the work reflects the personality of the author, as an expression of their free and creative choices (*Painer*, [87], [89], [94]; *Renckhoff*, [14]; *Cofemel*, [30]).

10 *Cofemel*’s reference to “certain specific situations” appears to be as a call to adopt a rigorous assessment of the originality standard,²⁰ which takes into account the specific characteristics of works of applied art and the different functions of

¹⁷ Article 8(3) DR.

¹⁸ This is because it is a joint work. In the case of such a work, Term Directive 2006/116/EC, Art. 1(2) requires Member States to protect copyright until 70 years after the death of the last of the co-authors to die. Despite the fact that the Directive has now been in place for virtually 30 years, the Court has yet to be asked for guidance on the meaning of a “work of joint authorship”, though it would no doubt regard this as an autonomous concept of European law.

¹⁹ Article 17 DD; Art. 96(2) DR. See also Directive (EU) 2024/2823, Art. 23, recital 12 (on cumulation) and Case C-168/09 *Flos SpA v Semeraro Casa e Famiglia SpA* [2011] EU:C:2011:29.

²⁰ *Cofemel*, [AG53]–[AG54] (“the strict application of copyright by national courts could, to a large extent, overcome the disadvantages resulting from the combination of copyright protection with the *sui generis* protection of designs”).

Fig. 2 Example of USM Haller shelving furniture. Source: USM Haller website



copyright and design law. Those characteristics can appear both in the creative process and the final creative result.

11 The originality standard so understood is a conceptual matrix whose application must take account of the substantial particularities of the creative process and of the work itself. This approach is reflected in *Painer*, where in applying the horizontal originality concept to a portrait photograph, the CJEU explained the various stages in the process of producing a portrait photograph in which free and creative choices of the author of a photograph might be identified (*Painer*, [89]–[94]).

12 It is hoped that the CJEU will (without trespassing on the domain of the national courts with respect to fact-finding) offer similarly detailed analytical guidance in its response to the *Mio* and *konektra* cases. The need for further clarification can be seen from national court decisions which, far from limiting the availability of copyright to exceptional cases, seem to open copyright to protecting virtually all designs. This is visible in two recent English cases. Although the United Kingdom has, of course, left the European Union, the courts continue to apply the standards developed by the CJEU.

13 In *Lidl v Tesco*, the Court of Appeal of England and Wales affirmed the trial court's finding that the following logo was protected as an original artistic work (Fig. 3):

The logo was an adaptation of a pre-existing Lidl logo, the adaptation being merely the addition of the blue square. The Court of Appeal reasoned that choosing to surround the yellow and red circles with a blue square involved not just (i) the choice of shape but also (ii) the precise shade of blue, (iii) the decision where to position the yellow/red circles within the square, and (iv) the distance between the edge of the circles and the edges of the square.²¹ The Court of Appeal thought four choices of this sort sufficient to reach the European Union's standard: "The degree of creativity involved in the creation of the ... Work may have been low, but it was

²¹ *Lidl v Tesco* [2024] EWCA Civ 262, [190]–[191], affirming EWHC [288]–[290].

Fig. 3 Logo of Lidl

not a purely mechanical exercise, nor was the result dictated by technical considerations, rules or other constraints which left no room for creative freedom”.

14 In *AGA Rangemaster Group Ltd v UK Innovations Group Ltd*,²² the English High Court held that copyright existed in the following technical drawing for a thermostat for an AGA cooker (Fig. 4):

The court reasoned (at [88]) that the drawing was not dictated by technical considerations, that the author “made creative or aesthetic choices driven by his wish to create a design that captured what he called the historic look of the traditional AGA cookers”. The judge (Nicholas Caddick KC, sitting as a Deputy High Court Judge) noted that the choices included (i) rotational dials (rather than push buttons), (ii) aligning those dials vertically, (iii) adding an elongated oval line around the dials, (iv) adding a further line running, initially horizontally, away from that oval across and then vertically up to a thermodial, and (v) positioning the thermodial on the upper right hand side of the pane. The court then went on to hold that this had been infringed by the defendant’s dial.

15 In these cases, the English courts seem to regard it as sufficient that the designer made (two or more) choices in the development of the subject-matter, and that those choices were not dictated by technical considerations, rules or constraints, and that they somehow are reflected in the subject-matter. Consequently, the originality assessment is effectively completed by merely ascertaining the presence of choices not constrained by technical factors. Such an interpretation neglects to examine whether the choices are creative or whether the subject-matter itself (that is, the end result of the creative process) actually gives expression to any creative choices. Such an approach makes the word “creative” redundant. The CJEU has stated on many occasions that the choices must be both free *and* creative.

²² [2024] EWHC 1727 (IPEC).

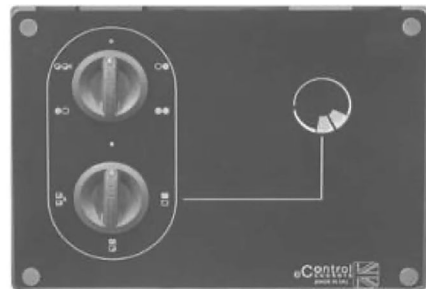
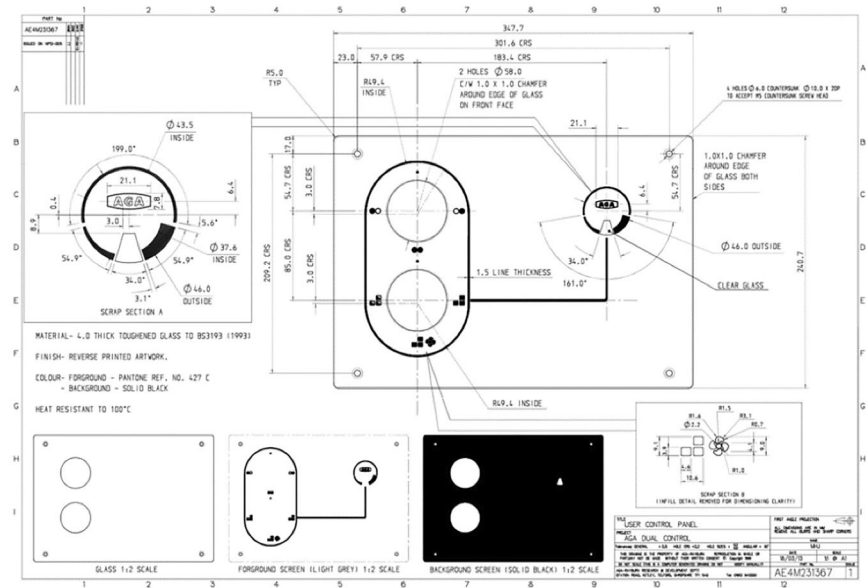


Fig. 4 AGA cooker thermostat. Source: judgment in *AGA Rangemaster Group Ltd v UK Innovations Group Ltd*

16 The result is the adoption of relatively low requirements of originality, leading to cumulative copyright protection for almost all works of applied art. If relatively simple subject-matters, which can in many cases still have high commercial value, were to receive copyright protection, competition and innovation could be negatively affected, as the CJEU noted in *Brompton*. In turn, the danger exists that copyright protects swathes of designs which would not merit protection under design law at all (because they did not meet the threshold of novelty and individual character) for much longer than the protection they would be entitled to if they had met that standard. Moreover, further concerns are that specific limitations placed on

designs law (such as the repair clause in Art. 110 of the Regulation) will be completely undermined if copyright subsists so readily.²³

17 In contrast, it might be noted that the Portuguese Supreme Court that had referred the *Cofemel* case to the CJEU ultimately ruled that the G-Star raw designs lacked originality. This was so despite the fact that the jeans and sweatshirts at issue clearly were the product of a number of important choices by their designer (and produced novel aesthetic effects). The Portuguese court, in contrast to the English courts, did not regard a series of choices as ipso facto sufficient to produce a copyright work. Although the designers made significant efforts and even choices in developing the design, these efforts/choices are not creative in the copyright sense, as they amount to design “concepts”. Such concepts are not protectable by copyright. Rather, they are in the public domain.

18 While the CJEU has yet to break its analysis down to this level of granularity, the originality standard that has been developed by the CJEU appears to be made up of four overlapping elements: first, the author must express themselves (rather than, for example, merely create ideas);²⁴ second, the author must have freedom to choose that expressive form; third, the choices of expressive form must be “creative”; finally, as a result, of exercising free and creative choices, the designer must express themselves in such a way as to imprint their personality on the work.

19 The corollary of this analysis is that a production may be excluded from copyright (i) because it comprises mere ideas; (ii) because there was no freedom of choice as to the expression; (iii) because, while there was freedom to choose the expressive form, the choices were not “creative”; and (iv) because, while there was freedom to choose, and the author made creative choices, these were insufficient to stamp their personality on the work. While in some circumstances (for example, works of poetry or painting), if an author has expressed themselves sufficiently to stamp their personality on the work, then ipso facto, they must have had sufficient freedom to make choices and must have exercised that freedom by making creative choices, we think in the field of applied art any such shortcut in reasoning is dangerous. In particular, courts may (wrongly) assume that because there is aesthetic impact or novelty, then necessarily there is imprint of personality, and thus creative choices. We therefore recommend the four-stage approach be taken in all cases of works of applied art.

²³ Recitals 32 and 33 and Art. 19 DD recast emphasize repair and the new European Green Deal and recital 19 and Art. 20A of Regulation (EU) 2024/2822 ensures coherence with the Directive’s repair clause. This reinforces the importance that copyright does not undermine the repair clause and interconnections provisions in design law.

²⁴ This first element can equally be understood as part of the requirement that there be a work, with steps 2–4 relating to the originality of that work.

3.1 Relevant Criteria

3.1.1 *Is There Expression? Is There a Work?*

20 In *Levola Hengelo*, the court indicated that for there to be a work there must be two elements: expression and intellectual creation.²⁵ The first task of a court then is to identify what, if anything in the subject matter constitutes protectable expression. In principle, this has the important effect of excluding “ideas” from consideration.

21 The exclusion of “ideas” (and “principles”) from copyright is explicitly recognized in Art. 1(2) of the Software Directive,²⁶ recital 11 of which recognizes that this is a general “principle of copyright”. It is also a feature of international legal arrangements to which the EU adheres. Article 9(2) of the WTO-TRIPS Agreement asserts that copyright protection shall extend to expressions and not to ideas, procedures, methods of operation, or mathematical conceptions as such.²⁷ The exclusion of ideas has been recognized in CJEU jurisprudence.²⁸ In both *SAS* and *Brompton*, the Court indicated that the idea/expression dichotomy is designed to avoid the monopolisation of ideas to the detriment of technical progress and industrial development.²⁹

22 At one level, an idea is an abstraction – what philosophers might call a “type” while expression is the concretisation of the idea into a particular form – what philosophers call “tokens”. But while such statements have a benign simplicity and can be helpful in explaining the idea/expression distinction, copyright scholars have long recognized that it can be practically difficult to draw the line between idea and expressions. As the American judge, Learned Hand once said: “Nobody has ever been able to fix that boundary, and nobody ever can”.³⁰

23 Also excluded from protectable expression are the building blocks that make such expression possible. In its first case concerning originality of newspaper articles, the *Infopaq* decision, the CJEU in effect identified what are in effects the building blocks of creation for literary works, namely words, and indicated that they cannot be subject to copyright in isolation.³¹ Subsequent case law has identified other such building blocks, such as figures and mathematical concepts (*SAS*, [69]). In the context of works of applied art, key “building blocks” would include materials (wood, steel, plastic, etc.), basic shapes (circular, cylindrical, rectangular,

²⁵ Case 310/17, *Levola Hengelo*, ECLI:EU:C:2018:899, [36]–[37]; C-683/17, *Cofemel*, op. cit. [29] and [32]; Case C-833/18 *SI and Brompton Bicycle Ltd v Chedech / Get2Get* [2020] EU:C:2020:461, [22]

²⁶ Directive 2009/24/EC, Art. 1(2). Note also recital 11 (implying that “logic, algorithms and programming languages” comprise ideas and principles).

²⁷ WIPO Copyright Treaty, Art. 2.

²⁸ Case 310/17, *Levola Hengelo*, op. cit. [39].

²⁹ Case C-833/18, *SI and Brompton Bicycle Ltd v Chedech / Get2Get*, op. cit. [27]; Case C-406/10, *SAS Institute v World Programming*, EU:C:2021:259, [33] and [40].

³⁰ *Nichols v Universal Pictures Corporation*, 45 F.2d 119 (2d Cir. 1930).

³¹ *Infopaq*, [45]–[46].

square) and colours. Although basic building blocks are excluded from protection as such, as will become clear, an original combination of such basic elements or public domain works could be original, if there were creative choices made in the combination of such elements such that the personal touch of the author were stamped on the resulting production.

24 Moreover, it is clear from the existing jurisprudence of the CJEU that the exclusion from protection of ideas is not confined to abstract ideas but extends to situations where ideas are expressed. If there are only a few ways of giving effect to an idea, the Court has indicated that such expressions are equally unprotected. In *BSA*,³² the CJEU held that a graphic user interface (GUI) did not fall to be protected under Art. 1(2) of the Software Directive, but indicated that such a production might be protected under the InfoSoc Directive if a national court could deem it as “its author’s own intellectual creation” (*BSA*, [46]). In light of the specificities of the subject matter, however, the Court also ruled that elements necessitated by their technical functions shall be excluded from protection, “*since the different methods of implementing an idea are so limited that the idea and the expression become indissociable*”, and the author does not make any original choice that would amount to her own intellectual creation (*BSA*, [48]–[50]). On one reading, at least, the Court there embraces what is known in the United States as “the merger doctrine”.³³ In *Brompton*,³⁴ the CJEU indicated that when the expression of specific components is dictated by their technical function, the different methods of implementing an idea are too limited, so that the idea and the expression becomes indissociable (*Brompton*, [27]). This applies also where a possibility of choice remains available as to the shape of the subject matter (*Brompton*, [32]), for the court needs to determine if the author has expressed her creative ability by making free and creative choices, with a work of applied art that reflects her personality.³⁵

25 Despite the difficulties in identifying ideas, there is no doubting the importance for competition of the limitation of copyright to expression. In *Cofemel*, the Advocate General highlighted the specific role that the exclusion of ideas from copyright plays in mediating the relationship between copyright and designs. Advocate General Szpunar stated that characteristics of the clothing in the case such as the “specific composition based on shapes, colours, words and numbers”, the “combination of colours”, the “placement of the pocket on the stomach” or even “the way the jeans are made by assembling the three pieces” should be analysed as ideas capable of being expressed differently, or even as practical solutions, pointing out that a pocket placed on the back of a sweatshirt is not of much use. These characteristics, the Advocate General stated, should not be protected by copyright

³² Case C-363/09 *Bezpečnostní softwarová asociace – Svaz softwarové ochrany v Ministerstvo kultury* [2010] EU:C:2010:816 (hereinafter “*BSA*”).

³³ Pamela Samuelson, “Reconceptualizing Copyright’s Merger Doctrine” (2016) 63 *Journal of the Copyright Society of the U.S.A.* 417.

³⁴ Case C-833/18, *SI and Brompton Bicycle Ltd v Chedech / Get2Get*, op. cit.

³⁵ See also Case C-469/17, *Funke Medien NRW GmbH v Bundesrepublik Deutschland* [2019] ECLI:EU:C:2019:623, [24].

(AG, *Cofemel*, [60]). As we already noted (at [15] above), the referring court in Portugal reached a very similar conclusion.

26 In the context of the two references, it seems clear that the idea of a table, the idea of a circular topped table, the idea of a wooden table are all simple ideas capable of a multitude of expressive instantiations – and thus not in themselves protected by any copyright. Equally, the idea of a shelving system is just that, an idea; so also, the idea that the shelving system is modular. In relation to the *konektra* reference, therefore, it seems especially important that the national court takes care to identify precisely what is being claimed as protected by copyright: copyright may be able to offer some protection to modules and components within a shelving system, but it is difficult to conceive that copyright could protect a modular shelving “system”. Moreover, it might be that key practical components in a modular shelving system, such as connectors, constitute “ideas” that fall outside the scope of any copyright protection. Interconnecting features (including, e.g. in modular systems) will in most cases be unoriginal because highly functional, lacking free and creative choices.

3.1.2 Is There Freedom of Choice?

27 In a series of cases – *BSA*,³⁶ *Flos*,³⁷ *Football Association Premier League (FAPL)*³⁸ and *Football Dataco*³⁹ – the Court has indicated that there will not be “free” choices if the freedom available to the author (or designer) is constrained by technical considerations, rules or other factors, such as a limited number of ways of expressing an idea. For example, in *FAPL*, the Court excluded sporting events from the category of protected works on the basis that the existence of rules of the game precluded the presence of creative choices, and thus originality.⁴⁰ Sometimes, rather tautologically, the court indicates that there are no free choices if the constraints remove creative freedom.

28 The *FAPL* case suggests that the concept of “free” choice in this context is not an absolute one: there are many ways that players can play football within the rules of the game, but the CJEU appears to exclude them all. This seems also to be the case with regard to technical constraints. The mere fact that a technical goal can be achieved in a number of ways does not mean that there is relevant “freedom” of

³⁶ Op. cit.

³⁷ Op. cit.

³⁸ Joined cases C-403/08 and C-429/08, *Football Association Premier League and Others* [2011] EU:C:2011:631 (*FAPL*).

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

⁴⁰ Joined cases C-403/08 and C-429/08, *Football Association Premier League and Others*, op. cit. [96]–[98].

choice. In line with jurisprudence under other intellectual property regimes,⁴¹ it would be inconsistent with the aim of promoting technological innovation and the avoidance of anticompetitive situations if a person could through copyright claim rights that limited the technical freedoms of others.⁴² As with “ideas” (see [22] above), it seems that if functional goals can be achieved in only a limited number of ways, the choice of one of those ways is not to be treated as a “free” choice.

29 The CJEU’s decisions, however, did not provide further guidance on how to apply these principles to different types of functional works, and particularly to works of applied art. No more clarity came from the Court’s ruling in *Brompton*,⁴³ which focused on whether the notion of “work” under the InfoSoc Directive could be stretched to cover also products whose shape is, at least in part, necessary to obtain a technical result. The decision simply recalls the Court’s precedents to state that a subject-matter that is original may be eligible for copyright protection even if its realisation has been dictated by technical considerations, provided that this did not prevent the author from expressing her free and creative choices (*Brompton*, [26]).

30 Works of applied art are primarily functional works. For this reason, they are necessarily marked by rules, procedures, and constraints, technical or other, which might impact the range of creative freedom and choices. For example, in producing shelving, it is necessary to have vertical and horizontal components, with weight-bearing capacity: the choice of materials is therefore considerably constrained. If the shelving is to be mass-manufactured for sale, further limitations may exist as to potentially suitable material. The constraints might be such that there ends up being little practical freedom as to the choice of material. The height of such shelving is constrained by the height of ceilings in most accommodation, and to some extent by the height of human beings. The width of such shelving, if intended for use in residential accommodation, might be further constrained by the traditional dimensions of housing.

31 With respect to the design of a dining table, the height of the table will be constrained by the size of human beings sitting, and the standard size of chairs. The size of the table, at least for domestic use, might be constrained by housing size, sizes of families, as well as technical issues relating to stability. The depth of the tabletop will be informed by the choice of material and the load bearing requirements. The size of the base/foot will also at least be governed by issues of load bearing and stability.

⁴¹ Article 8(1) DD, according to which designs solely dictated by technical considerations are excluded from protection. The CJEU has already specified that in order to establish whether features of appearance of a product are solely dictated by technical considerations the presence of other designs fulfilling the same function is not decisive (Case C-395/16, *Doceram GmbH v CeramTec GmbH*, ECLI:EU:C:2018:172 [31]). This implies that the so-called “multiplicity of forms” theory is not conclusive in this determination even if it can play a role.

⁴² *Doceram*, [28]–[30] op. cit.; for copyright, see *Brompton*, [16]–[18] op. cit.

⁴³ *Brompton*, op. cit.

32 In *Mio* and *konektra*, the CJEU should make clear that also in the field of works of applied art only the choices that are free can lead to copyright protection and then only if that freedom is used by making creative choices with the effect that the designer stamps their personality on the resulting work. In so far as choices are, on the contrary, dictated by technical rules, considerations or constraints there can be no protection by copyright.

33 The question whether constraints leave no free choices (or how much freedom they leave) is one on which a court will be instructed by evidence, which in turn will be a matter for the procedural rules of Member States. However, without stepping on the domain of Member States, the Court has already indicated that the existence of an earlier patent covering the shapes and their technical results is not *per se* evidence that there are no free and creative choices (*Brompton*, [35–36]). As the Court said, “As regards the existence of an earlier, now expired, patent [...] and the effectiveness of the shape in achieving the same technical result, they 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”. Thus, when faced with such evidence, national courts will have to examine what the patent covers (i.e. what falls within the scope of claims) bearing in mind precisely in what the claimant is asserting copyright subsists.⁴⁴ If the claimant in *konektra* is asserting copyright in the connectors or anything else in the shelving system, and it is shown those features have been the subject of a patent (or even just a patent application), the national court will need to scrutinise the evidence to decide whether it indicates that the shape of the features has been developed to achieve a technical function and should not be regarded as a product of free (and a fortiori, creative) choices.

3.1.3 Are the Choices Creative?

34 The CJEU built the EU originality standard on a twofold basis: the existence of “free” and “creative” choices. The requirement of “creativity” emphasizes the need to identify the personal input of the author, leading to the possibility that their personality is reflected in these choices and the work itself. These two parameters are interlinked but they should be examined as independent and separate components of the concept of originality.

35 The Court has yet to explain how “creative choices” are to be identified. This has led some courts, such as the English courts in the *Lidl* and *AGA* cases, to assume that all choices other than “mechanical choices” matter and that a small number will suffice. We think this is a mistake and would contribute towards excessive overlap between copyright and designs.

36 Trivial, insignificant or obvious choices will not count. By contrast, surprising or unusual decisions, are likely to be regarded as creative. If it is necessary for an oven

⁴⁴ See *WaterRower v Liking Ltd* [2024] EWHC 2806 (IPEC), [163] (Deputy Judge Campbell Forsyth) (examining closely a patent for the prototype of a rowing machine, but nevertheless identifying creative freedom, and concluding – perhaps surprisingly – that the machine was an intellectual creation).

to have two dials, there may be a choice of locating them side-by-side or one above the other. Choosing between these two alternatives and deciding to place one dial vertically above the other is not creative.

37 In addition, random selections should not be taken into consideration, since in that case the expression of the work is not the result of choices. In contrast, choices that are made for their own sake, to please the designer and reflect their whims are likely to be regarded as creative. In *Cofemel*, [54], the Court noted, *en passant*, that “aesthetic considerations play a part in creative activity”. The creator therefore may decide to make a certain creative choice because of aesthetic considerations. However, as the Court said in the same paragraph, this does not mean that if a creation has an aesthetic effect it automatically is the result of free and creative choices. The national court must always determine whether the author has made free and creative choices (see above [18] of this Opinion).

38 Moreover, copying is not to be regarded as creative. If a work of applied art consists of elements found in common designs or build on and constitute variations of earlier known designs or an ongoing design trend, the Court should hold that, provided there was copying, that the claimed work of applied art lacks originality. That said, while the presence of other identical or similar subject-matter that has been created before may give rise to a presumption of copying, it should not in itself stand as irrebuttable evidence of derivation.

39 However, even if elements in a design are derived from earlier designs, creative choices can be made by combining those elements. It is clear that creativity can arise through selection and arrangement of existing components.

40 Merely following existing trends is not creative. Choices that ignore existing trends are, in contrast, likely to be treated as creative.

41 The mere fact that skill was involved does not imply creative choice: *Football Dataco v Yahoo! UK*, [42].⁴⁵ Thus, the mere fact that a design involved skillful draftsmanship or a facility in technical drawing will not be relevant to the question of whether there were creative choices. “Workmanlike” choices are insufficient.⁴⁶

42 Finally, choices directed to achieving useful effects are not creative (as well as, in most – perhaps all – cases, not “free”). “Usefulness” here can be understood broadly, so might include choices designed to make a logo more noticeable for marketing purposes. For example, the choice of a colour “blue” to accompany yellow might be characterised as non-creative in so far as “yellow” and “blue” are regarded as colours that are most visible to people with sight-impairment. Such colour choices might be regarded, too, as obvious.

43 In evaluating whether a choice is creative, the subjective motivation of the designer can be relevant but not determinative. As the German Federal Cour of

⁴⁵ Op. cit. See also Case C-469/17, *Funke Medien*, [23].

⁴⁶ *WaterRower v Liking Ltd* [2024] EWHC 2806 (IPEC), [173] (no intellectual creation where changes to prototype were “are technically constrained and mundane in nature, arising from the workmanlike, practical decisions behind the development of these adaptations”).

Justice in its referral in *konektra* states ([14]), knowingly making a creative choice cannot be required because creative achievements can also be made unknowingly or subconsciously.⁴⁷ In addition, as the Federal Court of Justice rightly states ([18]), if only the subjective perception of the creator were relevant – as the assumptions of the appellate court in the case at issue show – creators who believe that they are bound by rules or constraints, but who, in fact, made creative choices that are not determined by rules or constraints and are therefore free, would not obtain copyright protection even though they have, objectively, created a work worthy of protection. Similarly, creators who consider themselves to be acting freely and creatively, but who are actually bound by rules or constraints, would obtain copyright protection for their work of applied art, even though they have not, objectively, created any work worthy of protection.

44 However, explanations of the author as to how choices have been made can be relevant, insofar as they can inform conclusions that the author was or was not copying existing designs, following design trends, or attempting to achieve some sort of technical goal. But such evidence will, in many cases, not be available (most obviously, the author might be dead). Where such evidence is unavailable, the existence of creative choices will have to be inferred from the end product itself, accompanied perhaps by expert evidence relating to the design practices, design freedom, trends, etc. at the time the work or production was created or developed.

3.1.4 Is There an Imprint of Personality?

45 The fourth element, which is closely related to but distinct from the third, is the “output” element, namely that to be an original work, the output must bear the imprint of personality of the author. The CJEU has yet to elaborate on how such a personal imprint is to be recognised. There is a tendency in some of the national case-law to assume that merely by making choices the author imprints their personality on the work or stamps their personal touch.

46 The Court has already ruled, in *Cofemel* that aesthetic effect is a different criterion to “stamp of personality”. Therefore, the opinion of the judge in the case, experts or the public on the artistic or aesthetic value of the work, whatever this means, ought to be treated as *prima facie* irrelevant.⁴⁸ Moreover, the fact that the

⁴⁷ For a doctoral thesis arguing the same, see N. Enser, *Conscience de la création et droit d’auteur*, Edition Prix de thèse CEIPI/Vercken & Gaullier, 2022.

⁴⁸ There is first a terminological issue to be cleared up and this is extremely important because the CJEU’s judgments in *Mio* and *konektra* will be translated in the several languages of the EU. In some countries, the term “artistic” is used as a synonym of “aesthetic” (e.g. Art. 2(10) Italian Copyright Act, Art. 2(1) Cyprus Copyright Act). Similarly to Italy, in the *MIO* referral, the Swedish court seems to prefer to equate artistic to aesthetic when it says “whether the subject-matter itself is an artistic achievement and gives expression to an artistic effort”, therefore not referring to the free and creative choices of the author. In some countries, instead artistic means creative. In Germany for instance, the Federal Court of Justice equates artistic with aesthetic and with creative: “A personal intellectual creation is a creation of individual character whose aesthetic content has reached such a degree that, in the opinion of circles receptive to art and reasonably familiar with artistic views, it can be considered an “artistic” achievement”: *Vitrinenleuchte*, German Federal Court of Justice, 15 December 2022 – case No. I ZR

design is new or different is not, of itself, sufficient to indicate either that the author exercised creative choices or stamped their personality on the resulting output.⁴⁹

47 The ECS considers that in order for an author to mark the production with their personal touch the output itself must have some features that reflect the individual characteristics of the author. The features in the work should reflect the fact that its author is a different human being from other potential authors of works of the same sort. As Advocate General Bot said, in relation to computer programs, the effect must be to “set his work apart from that of other authors” (SAS, AG, [48]). The arrangement of elements in the output are akin to a signature; they are objective representations of the subjective individuality of the author.

48 Whether there will be such an imprint will, of course, depend on the sorts of “creative choices” the author made. In this context, both the quantity and the quality of the choices matter: there is a sliding scale between a lot of small creative choices and a few very significant ones.⁵⁰ When creating a literary work, creativity often involves a multiplicity of small creative choices as to words – and because there are so many small choices, the resulting literary work reflects the individuality of its author.⁵¹ The same is true of the multiplicity of choices made by a painter (each paint stroke being a particular choice).

49 Matters become more complicated where there are fewer choices and they are more constrained, as is often the case with works of applied art. In judging whether there is an imprint, one important indicator can be whether other designers have produced or would produce similar outputs independently. If other designers have produced or are likely to produce substantially the same design, then there is no relevant imprint.

50 Indeed, if two or more authors having worked independently arrive at a substantial similar design, this may be because (i) they faced similar constraints and rules, such that there were no free choices; (ii) they were following design trends, or copying from common sources, or otherwise failed to exercise the choices available “creatively”; and/or (iii) although they made creative choices these were minimal

Footnote 48 continued

173/21. The Federal Court of Justice repeats this in its referral in *konektra*, para. 10. However, reception by artistic circles is subjective. In the *konektra* referral, the Court nuances this by stating that “in so far as the aesthetic effect of the design is based on artistic achievement, that is to say, on free and creative choices, and gives expression thereto, the question whether that design reaches a level of originality justifying copyright protection also depends on the degree of aesthetic content”. So, in this case, aesthetic effect is only protected if it is the result of free and creative choices.

The Court should therefore use terminology, especially the word artistic, in a very clear way such that there is no confusion once the judgment is translated in the several languages of the EU.

⁴⁹ In this respect, the English High Court was clearly wrong in *Response Clothing Ltd v The Edinburgh Woollen Mill Ltd* [2020] EWHC 148 (IPEC), [60].

⁵⁰ Database Directive 96/9/EC, recital 19 (indicating that a compilation of recordings on a CD would not meet the threshold). This suggests that the legislature considered that the selection and arrangement of around 15 items could not be an intellectual creation.

⁵¹ As would choosing the 1000 most important poems: *Gedichttitelliste* (2008) IIC 985 (BGH).

or trivial so that the exercise of those choices failed to give their personal imprint to the work.

51 In this respect, it should be possible for national courts to take into account all relevant evidence. This might include circumstances subsequent to the creation of the product, such as assessments in the technical world, insofar as they may provide an indicator for assessing whether, at the time of its design, the subject-matter was its author's own intellectual creation. This may enable the courts to carry out their task of taking account of all the relevant facts of the case as they existed when the subject-matter was designed even if *Brompton* ([37]) implicitly excludes "subsequent events" when stating that "it is for the referring court to take account of all the relevant aspects of the present case, as they existed when that subject-matter was designed, irrespective of the factors external to and subsequent to the creation of the product".

52 In general, the Court should be slow to exclude particular sorts of evidence from consideration. In so doing, it steps on the toes of the national court's primary role in fact-finding in accordance with national procedures and rules of evidence. As the CJEU has stated, courts should look at all the evidence and address the question of originality objectively.⁵² Nevertheless, the Court can responsibly warn the national tribunals as to potential pitfalls. Care must be taken with any evidence to establish that it is relevant to the originality inquiry. This is particularly problematic with respect to evidence that a work has been exhibited in a museum or gallery after the creation of the work. In some Member States such as Germany and Italy, courts take account of the respect the work of applied art has found in professional circles and/or among the public to determine its protectability, in particular treating museum and gallery exhibitions as probative or highly probative.⁵³ There is a real danger that relying on such evidence introduces subjective considerations and aesthetic judgments inappropriately into the analysis of originality. Depending on the institution's selection criteria, the fact that a work of applied art is featured in a gallery or museum may indicate it is aesthetic but that does not necessarily demonstrate that the author exercised "creative choices", nor indeed that they stamped their personality on the work. That said, occasionally, the narrative presented in a museum or gallery may be relevant to establishing that the design did not follow an existing trend/copy from earlier designs and thus have a bearing on the question of whether the choices made were indeed to be regarded as "creative choices".

⁵² *Levola*, [42] op. cit. By analogy, see *Doceram*, [36–38] op. cit.

⁵³ See e.g. German Federal Court of Justice, judgment of 10 December 1986 – case No. I ZR 15/85, GRUR 1987, 903 [juris para. 31] – *Le Corbusier-Möbel*, with further references; OLG München, GRUR-RR 2011, 54 [juris para. 43]; Italian Supreme Court, case No. 11413/2024 (*Castiglioni*).

4 Scope of Protection

53 In addition to defining more clearly the circumstances in which works of applied art qualify for copyright protection, problems of overlap with designs can be reduced through clarification of aspects of the law relating to infringement of copyright and the scope of protection. In this section, we highlight (i) the importance of the requirement of “derivation” as a limit on how far copyright can tread on the field of EU Registered Designs and national registered designs; (ii) the significance of the concept of infringement by reproduction of “a part” of a copyright work and the difference between this and the tests used in EU designs law; and (iii) the confusion over the relationship between levels of originality and infringement.

4.1 Derivation

54 It is a universally accepted principle of copyright that, for there to be an infringement, the material claimed to infringe must have been derived, i.e. copied (directly or indirectly) from the claimant’s copyright protected work. See *Cofemel AG*, [64]. The corollary of this is that there is no infringement where a person creates a work independently. In this respect, copyright law differs from registered design protection (but not from EU Unregistered Design).

55 The rule that an independent created work does not infringe a pre-existing work, however similar they may appear to be, is of particular importance in the context of works of low originality, as will be the case with many works of applied art. If such a work is recognised as protected based on a relatively small number of creative choices, the negative effects of such a conclusion are to some extent mitigated by the fact that other designers who use similar combinations of features independently should not be regarded as infringing.

56 In some situations, however, it will be difficult to rely on “independent creation” to escape liability. One such situation will be where an earlier work of applied art has become iconic. This is because such a circumstance will render claims to “independent creation” all but impossible to sustain. In effect, the fame of a work can in practice obliterate the formal distinction between the qualified rights conferred by copyright and the monopoly right given by registration.

57 This is an important reason why courts should not be swayed into assuming works of low creativity pass the originality threshold based merely on the fame they have subsequently acquired. A circular wooden tabletop mounted on a cylindrical support may produce an elegant aesthetic effect which leads it to feature in a museum. Absent such fame, it is quite easy to envisage multiple designers independently creating such a table. A rigorous application of protectability criteria should be applied in such cases to ensure that copyright law does not operate excessively.

58 Another situation in which the limitation of copyright protection to derivation may prove insufficient is where a person is compelled to copy a work of applied art, for example, to carry out repairs or to restore the work. Unlike in design law, where specific provision is made for spare parts and interconnections, the repair exception in copyright law (Art. 5(3)(1) InfoSoc Directive) is peculiar in formulation – referring to “*use in connection with the [...] repair of equipment*” and, of course, not mandatory. This reinforces the desirability of rigorous application of the originality requirement as well as the idea/expression dichotomy, so as to ensure competitors are free to make parts that interconnect with the work.

4.2 Part of a Work

59 Copyright is infringed by reproduction in whole or in part. The CJEU in *Infopaq* held, while interpreting Art. 2 of the InfoSoc Directive, that so long as the defendant reproduces a part of the work which embodies the expression of the author’s own intellectual creation (even if it is as little as 11 words as it was in that case), it infringes.⁵⁴

60 This is quite a different approach from that by which infringement of designs are assessed. There the question is whether the design creates on the informed user a different overall impression.⁵⁵ That concept of the overall [visual] impression is, in principle, “alien to copyright” (AG, *Cofemel*, [63]). Copyright allows the author of a work of applied art to oppose the reproduction or communication to the public of another design which involves the reproduction of original elements of the author’s design, whether or not it produces the same or a different overall [visual] impression (AG, *Cofemel*, [65]).

61 That said, some courts in Member States appear to apply a test of overall impression or similarity in copyright disputes rather than checking whether original parts have been taken.⁵⁶ In some countries such as Denmark and the Netherlands, this test is routinely applied. As we will see (para. [68] *infra*), although this may at first glance appear to confuse copyright and design law, it may in fact be a plausible

⁵⁴ Op. cit. [47], [48].

⁵⁵ See op. cit. at [4].

⁵⁶ See for some of the most recent cases, *e.g.* Luxembourg: case No. 37999, *SOC A v SOC B*, CA Luxembourg, 20/12/2012 (chair); Sweden: Case No. PMT 3853-18, *Star Trading i Svenljunga AB v Smak Design Stockholm AB*, CA Stockholm, 28 June 2019 (candlestick); Case No. B 9635-16, *GP (C.H Son Mobelfabrik, Cassina S.p.A, E.J Mobelfabrik, Flos Scandinavia, Frederica Firnityre, F.H., L.P. Lightning, Rosendahl Design Group*, CA Stockholm, 25/01/2018 (furniture); Belgium: CA Brussels, 6 November 2018, case No. 2017/AR/240, *Neoz Pty Ltd v Imagilights B.V.B.A.* (lamp); CA Brussels, 25 November 2019, case No. 2018/AR/1247, *Taiden Industrial Co. & Media Vision The Conference Company SAS v NV Televic Conference* (graphical user interface); Denmark: CA Copenhagen, 27 May 2021, case No. BS-15944/2020-OLR, *Bitz v Würtz* (pottery); Finland: Supreme Court, 28 March 2018, case No. KKO:2018:21, *A v B* (photograph); The Netherlands: CA The Hague, 6 April 2021, case No. 200.258.243/01, *Philips v Lidl* (razor) and case No. 200.277.196/01, *Airwair v Primark*; CA Amsterdam, 13/04/2021 (boots) case No. 200.192.044/01, *Arpe v Happy Cocooning*; CA The Hague, 20/02/2018 (gas fireplace); and CA The Hague, 9 March 2021, case No. 200.265.693/01, *Diesel v Calvin Klein* (jeans).

(and relatively unproblematic) practical solution in cases of low originality works, where there is only infringement by reproducing the protected work in its totality.

4.3 Level of Originality

62 The link between infringement by reproducing a part and the standard of originality reinforces why it is important that the standard of originality be set clearly, at a high level, and applied rigorously. There is only infringement where a person reproduces a part of the work that itself embodies the expression of free and creative choices by which the author imprinted their personality on the work. There is no infringement by the reproduction of ideas, building blocks, expressions that reflect rules or constraints, expressions that follow trends and are thus uncreative, and creative expressions that are insufficient to stamp the individuality of the author on the work.

63 Where the originality of a work of applied art lies in a combination of commonplace elements or building blocks from the public domain, the *Infopaq* principle implies that the scope of protection is limited to that very combination. It is only if the intellectual creation generated through the combination is reproduced that there can be infringement. Merely reproducing some of the constituents does not amount to an infringement.

64 Moreover, when subject-matter builds on and constitutes a variation of an earlier known design or an ongoing design trend, the originality is limited to the additional elements that reflect the creative choices and bear the stamp of the author. There would be therefore no infringement by a later work which also built on earlier designs or followed similar trends, so long as the added components that confer originality on the earlier work were not themselves reproduced.

65 Some confusion in the application of these basic principles has been generated as a consequence of the CJEU decision in *Painer*.⁵⁷ There, the CJEU stated (in the context of a claim to copyright in a portrait photograph) that the level of protection granted to a work should not depend on its degree of originality (*Painer*, [97]). More specifically, it stated “nothing in Directive 2001/29 or in any other directive applicable in this field supports the view that the extent of such protection should depend on possible differences in the degree of creative freedom in the production of various categories of works”. The statement was repeated in *Cofemel* at [35].

66 *Painer* has been taken by some to mean that the degree of originality of a work has no bearing on the scope of protection it receives. However, it is clear from *Infopaq* that where a work has a high level of originality, so that many parts of the work would in themselves satisfy the originality standard, there will be infringement by reproducing any of those parts. The logical consequence is that a work of higher originality in fact gains protection in a greater range of situations than a work that only just creeps over the threshold. Because there are many more modes of

⁵⁷ Case C-145/10, *Eva-Maria Painer v Standard Verlags GmbH and Others* [2011] EU:C:2011:798.

infringing a high originality work, a shorthand way of expressing this proposition is to say that a low scope of protection is given to low originality works (or that the copyright therein is “thin”); and broader protection is conferred on works of higher originality (or the copyright is “thick”). The shorthand expression may give the impression that low originality works get “less protection”: but that is not correct: like other works, they simply get protection for whatever is original. There is no discrimination, just the application of the basic principles of copyright. Such a proposition is widely recognized well beyond EU law.⁵⁸

67 In Sweden,⁵⁹ Italy,⁶⁰ Germany⁶¹ and Belgium⁶² some courts have given low originality works a low scope of protection. In Luxembourg, some courts held that a higher originality means a higher level of protection and vice versa.⁶³ In addition, in the UK, which still follows the copyright *acquis* post-Brexit, the Court of Appeal of England and Wales recently also gave a low originality work (a yellow-filled circle with a thin red border framed by a blue square) a low scope of protection.⁶⁴ It found there was no infringement where even if Tesco’s sign copied Lidl’s colours (yellow and blue), the dimensions were different (the distance between the circle and the square) and the shade of blue were not the same (Figs. 5, 6).

68 The English Court of appeal explained how such an approach was consistent with *Painer* even more clearly in *THJ v Sheridan*:

27. It is plain that the degree of visual creativity which went into the R & P Charts was low. But that does not mean that there was no creativity at all. The consequence of the low degree of creativity is that the scope of protection conferred by copyright in the R & P Charts is correspondingly narrow, so that only a close copy would infringe: see *Infopaq* at [45]–[48]. (It is sometimes suggested that *Painer* at [95]–[98] is authority to the contrary, but all that passage establishes is that the protection conferred by copyright on portrait

⁵⁸ *Feist Publications Inc v Rural Telephone Services Inc* (1991) 499 U.S. 340, 249 (“copyright in a factual compilation is thin”) (US); J. Margolis, ‘Hong Kong’, in B. Ong (ed), *International Copyright Law and Practice* (2023), section 8[1], (referring to the “rule of thumb that the scope of copyright increases with originality”).

⁵⁹ Case No. PMT 11062-16, *Gillholms Marina v Benny & Jessica AB*, CA Stockholm, 12 January 2018 (boat); case No. B 11011-16, *J.K. & J.A v Louis*, CA Stockholm, 2 February 2018 (lamp).

⁶⁰ Supreme court, 6 February 2020, N.R.G. 8433/2020, *Kiko S.r.l. v. Wjcon S.r.l.*, translated and published in IIC 2021, 52(1), 82–91, <https://doi.org/10.1007/s40319-020-01006-w>; EIPR 2021, 43(2), 138–141 (design of shop interior).

⁶¹ *Vitrinenleuchte*, German Federal Court of Justice, 15 December 2022 – case No. I ZR 173/21. “A level of design that justifies copyright protection, but is nevertheless low, leads to a correspondingly narrow scope of protection of the work in question (BGHZ 199, 52 [juris para. 41] – *Geburtstagszug*, mwN)”.

⁶² CFI Antwerp, 16 January 2019, case No. A/18/5692, *Phobos and Actor v NV W Cup*, para. 7 (packaging); CFI Antwerp, 14 February 2019, case No. A/18/2884, *Olma BV v Texfinity NV*, para. 7 (laundry machines); CFI Antwerp, 4 July 2019, case No. A/2018/7799, *NV Serax v Kwantum Belgium & Kwantum Nederland*, para. 12 (lamp).

⁶³ Case No. 266/2006, *MDI v GLOBAL REFUND Luxembourg*, CFI Luxembourg, 14 November 2006 (map).

⁶⁴ *Lidl v Tesco*, op. cit.

Fig. 5 Lidl's logo**Fig. 6** Tesco's clubcard logo

photographs *as a category* is not inferior to that enjoyed by other *categories* of works, including other kinds of photographs.) It does not mean that the R & P Charts are not protected by copyright at all, which would have the consequence that even an identical copy would not infringe.⁶⁵

69 This approach is consistent with other areas of intellectual property, which recognize that the scope of protection should be proportionate to the “achievement”.⁶⁶

⁶⁵ [2023] EWCA Civ 1354.

⁶⁶ The Court has stated that the more distinctive the trade mark, the greater will be the likelihood of confusion (see, for example, Case C-251/95, *SABEL v Puma, Rudolf Dassler Sport*, EU:C:1997:528, [24], and case C-342/97, *Lloyd Schuhfabrik Meyer*, EU:C:1999:323, [20]). See also Art. 10 DR.

70 It may be that, reflecting this approach, some national courts apply an overall impression test in cases of low originality works.⁶⁷ This can be a rough shortcut, but is no substitute for a rigorous analysis because it carries with it a risk that courts fail to identify precisely what is original about the copyright holder's work. It might be, as in *Lidl v Tesco*, that a very similar overall impression is created without reproducing the totality of elements that make the earlier work (the *Lidl* logo) original.

5 Conclusion – Answers to the Questions Referred to the CJEU

71 Drawing on the explanations, we now offer our view as to how the CJEU should answer the questions referred in the two cases.

72 *Mio, Q1* – *In the assessment of whether a subject matter of applied art merits the far-reaching protection of copyright as a work within the meaning of Arts. 2 to 4 of Directive 2001/29/EC, how should the examination be carried out – and which factors must or should be taken into account – in the question of whether the subject matter reflects the author's personality by giving expression to his or her free and creative choices? In that regard, the question is in particular whether the examination of originality should focus on factors surrounding the creative process and the author's explanation of the actual choices that he or she made in the creation of the subject matter or on factors relating to the subject matter itself and the end result of the creative process and whether the subject matter itself gives expression to artistic effect.*

ECS: We have explained the approach above at [18]–[50]. As established in the Court's jurisprudence, for there to be a protectable work, there must be expression (not merely ideas), and that expression needs to involve free *and* creative choices as a result of which the author has stamped their personality on the work. In general, in the case of works of applied arts, the presence of functional constraints will often severely limit the freedom of choice, and the utilitarian goals may well mean that the designer will rarely make creative choices. Importantly, the mere presence of alternative choices is not of itself sufficient to show creativity. Even where there is freedom to choose the expressive elements, and that freedom is exercised creatively, it is also possible that the resulting designs will not bear the imprint of the author. As the Court made clear in *Cofemel*, just because the production is aesthetically appealing or attractive does not imply either that creative choices have been made, or that the result bears the personal imprint of the author.

In assessing these elements, “factors surrounding the creative process” might offer indications as to what functional constraints existed, how much freedom there was, and whether the decisions made by the author were creative. As explained at [41]–[42], while the author's explanation of the choices s/he/they made is not irrelevant (and could assist a tribunal in understanding the author's perception of the

⁶⁷ Alternatively, such courts may be either sticking to established traditions or exhibiting a discomfort that the *Infopaq* test protects too much.

design freedom and the character of the choices), it is also not determinative. Ultimately, the tribunal will need to decide whether, as a result of making creative choices, the objective features of the resulting production reflect the author's personal touch.

73 Mio Q2. For the answer to Question 1 and the question of whether a subject matter of applied art reflects the author's personality by giving expression to his or her free and creative choices, what is the significance of the facts that

- (a) *the subject matter consists of elements that are found in common designs?*
- (b) *the subject matter builds on and constitutes a variation of an earlier known design or an ongoing design trend?*
- (c) *identical or similar subject matter has been created before or – independently and without knowing whether the subject matter of applied art for which protection as a work is claimed – after the creation of the subject matter in question?*

ECS: If the subject-matter consists of elements found in common designs, the subject matter will only be an intellectual creation if as a result of the combination of such elements, the author has been able to exercise free and creative choices and thereby create an expressive form that reflects their personality. Similarly, if the subject-matter builds on and constitutes a variation of an earlier known design or an ongoing design trend, it can only be original if the author has made additional free and creative choices, with the effect of stamping their personal touch on the resulting work. Following an existing trend will in almost all situations negate the exercise of creative choices, and, even were there minimally creative choices, the resulting production will be unlikely to bear the imprint of the designer's personality.

Where identical or similar subject matter has been created before or after the work in question, this may indicate that the constraints on design were so extensive that there were no, or very limited, free choices. The existence of such subject matter also suggests that, in so far as there was design freedom, the available freedom was not exercised creatively, but rather by following trends or obvious decisions. Finally, the generation of such (identical or similar) productions independently is indicative of a failure of the makers to stamp any individual touch on their outputs.

74 Mio Q3. How should the assessment of similarity be carried out – and what similarity is required – in the examination of whether an allegedly infringing subject matter of applied art is covered by a work's scope of protection and infringes the exclusive right to the work which, according to Arts. 2 to 4 of Directive 2001/29/EC, must be conferred on the author? In that regard, the question is in particular whether the examination should focus on whether the work is recognisable in the allegedly infringing subject matter or on whether the allegedly infringing subject matter creates the same overall impression as the work, or what else the examination should focus on.

ECS: As explained at [57], the test of infringement under Art. 2 (and, by analogy, Arts. 3 and 4), is whether the defendant has reproduced the whole or a part of the work. As the Court indicated in *Infopaq*, this turns on whether the appropriated element is itself the author's own intellectual creation. The focus, therefore, is on the elements of the claimant's work that have been copied into the defendant's production. What the defendant has added is not relevant, so long as the elements in the defendant's work that are derived from the claimant are still recognisable. In principle, this means that even if the overall appearance of the defendant's work is different from that of the claimant, the defendant's work could still infringe if they are found to have reproduced and incorporated an original part of claimant's work. In general, it is irrelevant whether the allegedly infringing subject matter creates the same overall impression as the work. That test is the one deployed in design law and not the test in copyright law. However, if the originality of the claimant's work derives from the combination of "building blocks" (shapes, colours etc.) or of public domain elements, then a test of overall similarity might be the practical equivalent of applying the *Infopaq* test.

75 Mio Q 4. For the answer to Question 3 and the question of whether an allegedly infringing subject matter of applied art is covered by a work's scope of protection and infringes the exclusive right to the work, what is the significance of

- (a) *the degree of originality of the work for the scope of the work's protection?*
- (b) *the fact that the work and the allegedly infringing subject matter of applied art consist of elements found in common designs or build on and constitute variations of earlier known designs or an ongoing design trend?*
- (c) *the fact that other identical or similar subject matter has been created before or – independently and without knowledge of the work – after the creation of the work?*

ECS: As we explain in Section 3.3, following the logic of *Infopaq*, a work of high originality will be able to be infringed by a wide range of derivatives, the only criterion being that the derivative production reproduces an original part of the claimant's work; equally, if a work is one of minimal originality, there will only be infringement where the totality of the work is reproduced, because it is only then that the originality will be reproduced. In the case of works of applied art, the functional constraints mean that the level of originality is often low, so that there will only be infringement where most of the creative choices are duplicated in the defendant's work.

If the allegedly infringing subject matter consists of elements found in common designs or builds on and constitutes a variation of earlier known designs or an ongoing design trend, then it may be reasonably asserted that the subject matter has not been copied or derived from the protected work of applied art. Even if an inference of copying might be derived from the similarities between the claimant's and defendant's works, it is always open to a defendant to explain away those differences by reference to common sources. If this is done persuasively, then there is no infringing act. If, however, the defendant admits or is shown to have taken

inspiration from the claimant, whether there would be infringement would depend on whether the elements in its subject matter that are derived from the claimant's work of applied art are elements that represent the author's own intellectual creation. Given what we said in answer to questions 2b and 4a, the level of originality (if any) of the claimant's work is likely to be very low, and thus infringement is only conceivable in a case of substantial identity/similarity.

Likewise, as we explained in answer to 2c, the presence of many similar, but independently created designs, suggests (i) that the claimant's work may well lack originality, or, if it possesses any, the level of originality will be low; (ii) that the defendant's design may too have been independently created and thus non-infringing; and (iii) that even if the defendant did take a shortcut of relying on the claimant's design, because the claimant's work, if protected at all, will be a work of low originality, the defendant will only infringe if the two productions are substantially identical.

76 konektra, Q1. Is there a rule-exception relationship between design protection and copyright protection in the case of works of applied art, such that, when assessing the originality of those works for copyright purposes, higher requirements are to be imposed with respect to the creator's free and creative choices than for other types of work?

ECS: As explained in *Cofemel*, the tests of originality (and by extension infringement) need to be applied rigorously to works of applied art to ensure that there is not excessive overlap between copyright and designs. The relevant steps, which are the same as those for works in general, are specified in [18]–[50]. As indicated elsewhere, productions in the field of design and the applied arts are subject to functional constraints, and the choices that are made will often be directed at producing certain (technical, ergonomic, aesthetic) effects, so will rarely be creative. When works of applied arts are original, the level of originality will often be low.

77 konektra, Q2. When assessing originality for copyright purposes, is it (also) necessary to consider the creator's subjective view of the creation process and, in particular, does the creator have to make the free and creative choices knowingly in order for them to be regarded as free and creative choices within the meaning of the case law of the Court of Justice of the European Union?

ECS: We have explained the approach above. In essence, the tribunal is concerned with the objective combination of features that comprise the alleged "work of applied art". Although the tests of "creative choices" and "imprint of the personality" invite consideration of the relationship between the subjective, individual processes of the author and their outputs, and as a consequence, evidence of what the producer/designer thought, believed, intended or hoped to achieve can inform the decision-making, ultimately the question is an objective one for the tribunal. Importantly, creators do not have to make the free and creative choices knowingly in order for them to be regarded as free and creative; nor do they

have to intend to stamp their personality on the work – the ultimate question is whether they have objectively done so.

78 konektra, Q3. If, in the context of the assessment of originality, the decisive consideration is whether and to what extent artistic creation was objectively expressed in the work; Can circumstances occurring after the date of design creation that is relevant for the assessment of originality, such as the presentation of the design in art exhibitions or museums or its recognition in professional circles, also be taken into account for the purposes of that assessment?

ECS: While we would not wish to absolutely exclude such evidence from consideration, it must be treated with extreme care and will only be relevant where it is probative as to the existence of free choices, the exercise of creative choices by the designer and the resulting imprint of their personality. The exhibition of a production in museums of design, which focus primarily on aesthetic effect, or its recognition by professional circles needs to be treated with special prudence: as indicated in *Cofemel*, aesthetic effect is not relevant to the appraisal of originality. Moreover, the popularity of manufactured artefacts, which is often reflected in the choices of such museums, is often the consequence of marketing efforts, price, etc., which have no probative value in relation to the appraisal of originality.

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