

Case C-833/18

Request for a preliminary ruling

Date lodged:

31 December 2018

Referring court:

Tribunal de l'entreprise de Liège (Belgium)

Date of the decision to refer:

18 December 2018

Applicant:

SI

Brompton Bicycle Ltd

Defendant:

Chedech / Get2Get

[...]

**The President of the Tribunal de l'entreprise de Liège
(Companies Court, Liège, Belgium)**

[Or. 2]

IN THE CASE:

Mr SI, residing in London (United Kingdom)

[...]

Brompton Bicycle Ltd, a company incorporated under English law whose registered office is at ... Greenford, Middlesex UB6 0FD (United Kingdom) [...]

[...]

applicants,

[...]

v

Chedech / Get2Get, a company incorporated under Korean law whose registered office is in Bucheon-si (Republic of Korea) [...]

defendant,

[...]

[...] [Procedural details]

[Or. 3]

1. The claims

Mr SI and Brompton Bicycle Ltd ('Brompton') claim that the court should:

– Rule that Chedech bicycles, irrespective of the distinctive signs affixed to the folding bicycles in question, infringe Brompton's copyright and Mr SI's non-pecuniary rights in the Brompton bicycle;

– Order the defendant to cease all activities which infringe the applicants' copyright, including but not limited to the production, use, sale or offer for sale, distribution, import, export, promotion or exhibition of the Chedech bicycles at issue and any folding bicycle which exhibits the following original features of the Brompton bicycle:

(i) In the unfolded position:

– the shape of the main frame, as characterised by a curved main tube and a rear triangular section; and/or

– the shape of the rear frame, as characterised by a slender, right-angled triangle curved at one of the lower corners and with a suspension component at the top corner; and/or

– the appearance of the chain tensioner mechanism; and/or

– the loose cables;

(ii) In the stand-by position:

- the position of the triangular rear frame folded under the main frame and of the rear wheel which follows the curve of the main frame; and/or
- the appearance of the folded chain tensioner which takes up the slack in the chain;

(iii) In the folded position:

- the appearance of the rear frame, in which the rear wheel is secured so that it touches the lower part of the curved main tube; and/or
- the appearance of the front wheel, which is parallel to the main frame and rests on the ground; and/or
- the handlebar, which folds downwards, away from the bicycle,

in Belgian territory, including on any website accessible in Belgium and controlled by Get2Get or an affiliated company, in particular www.chedech.com, in accordance with the judgment to be delivered, within 10 days of service of the present judgment, on pain of a penalty payment of EUR 75 000 per day of non-compliance with the foregoing, and per unlawful product sold;

– Order the defendant to:

(i) notify the judgment to be delivered to all sales outlets and do everything within its means to ensure that sales outlets cease all unlawful activities, including on all websites and in all sales outlets which are accessible in Belgium, in accordance with the present judgment;

(ii) provide the applicants with an exhaustive list of all sales outlets;

(iii) provide evidence that all of the foregoing has been done, upon first being requested to do so by the applicants; **[Or. 4]**

all of the foregoing to be done within 10 days of service of the decision to be delivered, on pain of a penalty payment of EUR 50 000 per day of non-compliance with the foregoing, and per sales outlet;

– Order the defendant to:

(i) recall all unlawful products from all sales outlets;

(ii) destroy all unlawful products;

(iii) provide appropriate evidence, such as a certificate of destruction, that all of the foregoing has been done, upon first being requested to do so by the applicants;

all of the foregoing to be done within 10 days of service of the judgment to be delivered, on pain of a penalty payment of EUR 50 000 per day of non-compliance with the foregoing, and per sales outlet;

– Order the defendant to publish the following text (or, where appropriate, a sworn translation) for a period of 30 days:

‘By decision of [...], the President of the Tribunal de Commerce de Liège (Commercial Court, Liège) held that the Chedech folding bicycle, available inter alia at www.chedech.com, infringes Brompton Ltd's copyright and the non-pecuniary rights of Mr SI, the inventor of the Brompton folding bicycle. Get2Get has been ordered to cease sales, offers for sale, promotions or any other unlawful activities in Belgian territory, including on any website accessible in Belgium. To read the full decision, click here’

on all of the following websites and in all of the following magazines:

(i) on the homepages/first pages of the following magazines, in both their online and print versions (if available in printed form), and in both the French and Dutch versions (or in the language available):

- Grinta: <https://wyvw.grinta.be>
- Cycling.be: <http://www.sport.be/cycling>
- 02 Bikers: <http://www.o2bikers.com/>
- Tweewieler: <http://www.tweewieler.nl/>
- Fietsmarkt: <http://www.fietsmarkt.com/>
- Fiets: <https://www.fiets.nl/>
- Fiets Actief: <http://www.fietsactief.nl/>
- Bike & Trekking: <http://www.bikeandtrekkingmagazine.nl/>

(ii) on the homepages of its websites, in particular <http://chedech.com>

(iii) on the homepages of the websites of its affiliate companies; it is ordered to do everything within its means to ensure that it is published there,

on websites in Dutch, the publication will have to be in Dutch only; on websites in French, the publication will have to be in French only; on all other websites, the publication will have to be in English only; on websites using more than one of the abovementioned languages, the publication will have to be in all of those languages;

all of the foregoing to be done within 10 days of service of the present judgment to be delivered, on pain of a penalty payment of EUR 50 000 per day of non-compliance with the foregoing, and per missing publication;

– Order the defendant to pay the full costs, provisionally estimated at EUR 1 440. **[Or. 5]**

The company incorporated under Korean law, Chedech ('Get2Get'), contends that the claim is unfounded and that the applicants should be declared jointly and severally liable for the payment of a procedural cost indemnity of EUR 5 000.

In the alternative, it contends that the court should:

With regard to the principal cessation order, concerning the sale of 'unlawful products':

- Declare that the various conditions describing the applicants' exclusive rights are all cumulative (rather than alternative), but exclude those conditions which are too vague and those which concern technical matters;
- In any event, limit the penalty payment to EUR 500 per day of delay, per sales outlet, in the event of failure to comply with the cessation order within two months of service of the judgment to be delivered;

With regard to the publication order:

- Limit the penalty payment to EUR 100 per day of delay with respect to publication on the website www.chedech.com, in the event of failure to comply with the cessation order within two months of service of the judgment to be delivered;

With regard to the notification, recall and destruction orders:

- Rule that no sales outlet has been found and dismiss the orders to notify distributors as well as the recall and destruction orders;

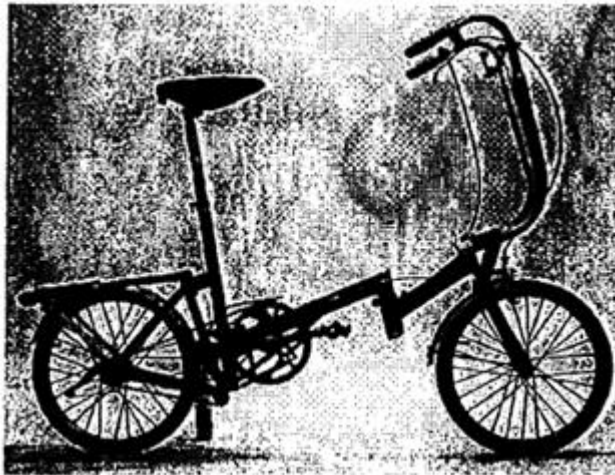
In any event, in respect of all the orders sought:

- Limit the total amount of the penalty payments that may be imposed in enforcement of the judgment to be delivered to EUR 25 000.

2. Facts of the case

(a) The parties

In 1975, Mr SI created an initial design for a folding bicycle, which he named Brompton:

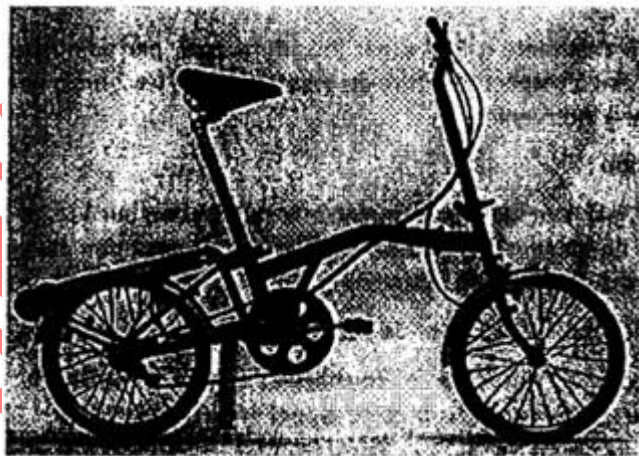


[Or. 6]

In 1976, Mr SI founded Brompton Ltd with a view to developing the marketing of his folding bicycle by granting a licence to a larger undertaking to manufacture and market the bicycle.

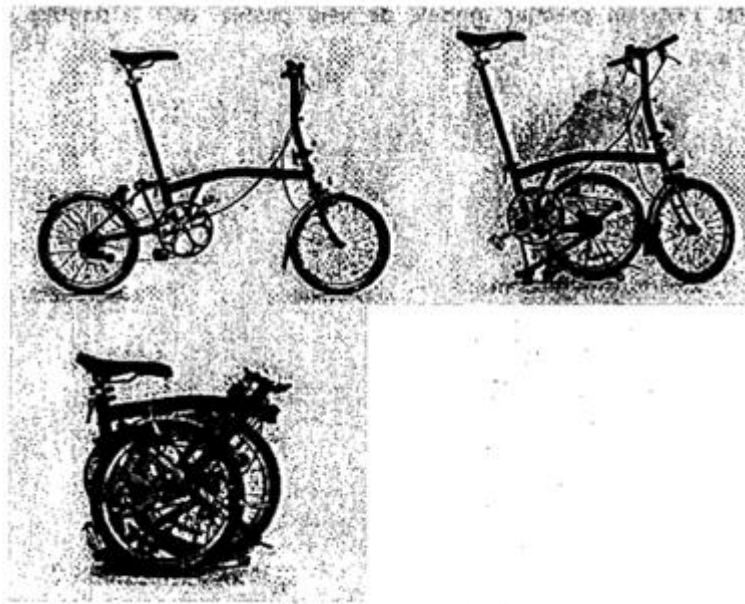
However, at that time, he was unable to find an undertaking that was interested and so continued to work alone.

In 1981, he received his first order for 30 Brompton bicycles. He manufactured them to a design that was slightly different from his original bicycle:



Following that first order, Mr SI sought to expand his company's activities to increase market awareness of his folding bicycle design.

Since 1987, the Brompton bicycle has been marketed in the following form:



[Or. 7]

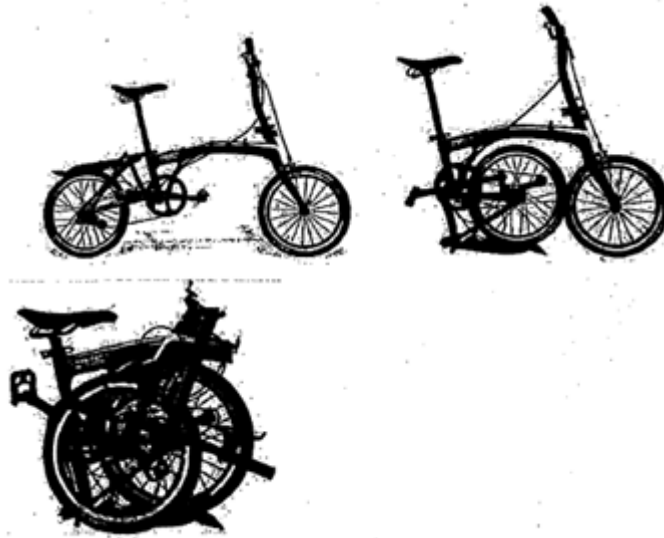
From the outset, its feature has been that it can be folded into three positions: unfolded, stand-by and folded.

[...]

Brompton used to hold a patent for its bicycle's folding mechanism, but this has now fallen into the public domain. **[Or. 8]**

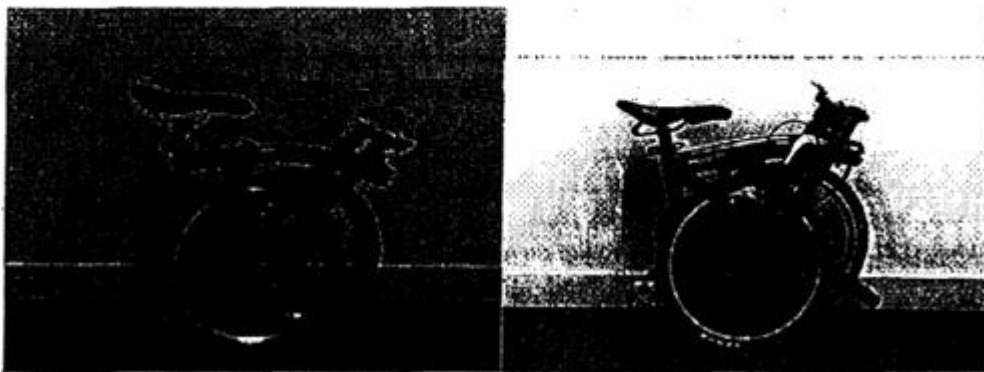
Brompton also holds the economic rights arising from the copyright in the appearance of the Brompton bicycle, while Mr SI holds the non-pecuniary rights in that bicycle.

Get2Get is a South Korean company which specialises in the production of sports equipment. It produces and markets via its website (www.chedech.com), inter alia, a bicycle which also folds into three different positions:



Brompton considers that the Chedech bicycle, which is available for sale inter alia in Belgium, is almost identical in appearance to its own bicycle and that it infringes its copyright. **[Or. 9]**

Brompton therefore carried out a comparison of the two bicycles in each of the three positions (folded, stand-by and unfolded):



It considers that these images adequately demonstrate that the two bicycles are almost identical in appearance in each of the three positions of use.

In so far as Brompton and Mr SI submit that they have never given Get2Get permission to use their copyright to manufacture those bicycles, they decided to bring the present proceedings. **[Or. 10]**

3. Issues

(a) Jurisdiction *ratione materiae* and *ratione loci*

Article XVII.14 § 3 of the Belgian Code de droit économique (Code of Economic Law) confers on the President of the Tribunal de l'entreprise (Companies Court)

jurisdiction to determine the existence of any copyright infringement and to order its cessation.

The jurisdiction *ratione loci* of the Tribunal de l'entreprise (Companies Court) is based on Article 96(2) of the Belgian Code de droit international privé (Code of Private International Law) (CDIP), which confers jurisdiction in respect of actions relating to an obligation arising from a harmful event on the court of the place in which the damage occurred or is at risk of occurring.

In the present case, the applicants submit that the bicycle marketed by Get2Get on its website www.chedech.com infringes their copyright in the Brompton bicycle. That website is accessible to potential purchasers inter alia in the territory of the judicial district of Liège.

It is clear from the foregoing that this court has jurisdiction *ratione materiae* and *ratione loci* to hear and determine the present dispute, and this is recognised by each of the parties to the proceedings.

(b) Conditions for the existence of copyright

Under Article 2(1) of the Berne Convention for the Protection of Literary and Artistic Works:

The term 'literary and artistic works' includes every production in the literary, scientific and artistic domain, whatever the mode or form of its expression, such as books, pamphlets and other writings; lectures, addresses, sermons and other works of the same nature; dramatic or dramatico-musical works; choreographic works and entertainments in dumb show, the acting form of which is fixed in writing or otherwise; musical compositions with or without words; cinematographic works and works produced by a process analogous to cinematography; works of drawing, painting, architecture, sculpture, engraving and lithography; photographic works and those obtained by a process analogous to photography; works of applied art; illustrations, geographical charts, plans, sketches and plastic works relative to geography, topography, architecture or science.

Under Belgian law, the provisions applicable to copyright protection are set out in Book XI of the Code de droit économique (Code of Economic Law), in Article 164 et seq. Their purpose is, inter alia, to transpose into Belgian law a number of European directives, including Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society, which determines the various exclusive rights conferred on copyright holders. Article XI.165 transposes into Belgian law Articles 2 to 5 of that directive, which set out the exclusive rights conferred on authors in their work.

Under Belgian law, a creation is protected by copyright where it is expressed in a particular form and it is original. Originality is defined unanimously in both case-

law and legal literature as being the expression of the intellectual effort [Or. 11] of the author. The work must bear the author's personal stamp, reveal creative choices on his part and thus be individualised.

The Court of Justice of the European Union has also developed a body of case-law on copyright which is now well established. Thus, copyright protection may be granted to a creation only if it is original, that is to say the *author's own intellectual creation*, which means that it '*reflects the author's personality*'. According to the Court of Justice, that is the case if '*the author was able to express his creative abilities in the production of the work by making free and creative choices*' (see, inter alia, the judgments of the Court of Justice of 16 July 2009, *Infopaq*, C-5/08, EU:C:2009:465, in particular paragraphs 37 and 39, and of 1 December 2011, *Painer*, C-145/10, EU:C:2011:798, paragraphs 87 to 89).

The originality of a creation is assessed at the time of its conception. It cannot be challenged on account of something that has been created subsequently. Originality, however, is not the same as novelty, a criterion which exists in patent or design law.

Lastly, it is now accepted that a utilitarian object — such as a bicycle — may be protected by copyright, provided that it is capable of being classified as an original creation. In the case of such objects, the only exclusions from the possibility of copyright protection are the shapes necessary to obtain a technical result.

Some legal writers have developed a test to determine whether or not the shape of an object is dictated by the technical result to be achieved: this criterion is known as the inseparability or multiplicity of forms.

[...] [Legal literature considerations]

The Belgian courts have adopted that theory, recognising, for example, that copyright may exist in the shape of a feeding bottle (Liège, 8 September 2008, IRDI 2008, p. 409, and the references cited):

[...] [Or. 12]

The multiplicity of forms criterion comes from design law. However, in a recent judgment, the Court of Justice of the European Union held that:

Article 8(1) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs must be interpreted as meaning that, in order to determine whether the features of appearance of a product are exclusively dictated by its technical function, it must be established that the technical function is the only factor which determined those features, the existence of alternative designs not being decisive in that regard (judgment of 8 March 2018, DOCERAM, C-395/16, EU:C:2018:172).

In that judgment, the Court departed from the multiplicity of forms test and employed the no-aesthetic-consideration test for the purposes of applying Article 8(1) of Regulation 6/2002, which excludes from protection as a Community design features of appearance of a product which are dictated by its technical function.

In his Opinion of 19 October 2017, Advocate General Saugmandsgaard Øe also recommends that the multiplicity of forms theory should be discarded. He states that there is no requirement that *the feature in question be the only means by which the desired technical function can be achieved* (point 37 of the Opinion). The European legislature wished to ensure that features of a product which are of exclusively technical origin cannot be monopolised by a design (point 38).

The no-aesthetic-consideration test would therefore have to be favoured. For the purposes of applying that test, the intention of the object's designer is decisive: what is the technical result sought? Does this require the object to be a particular shape?

One of the reasons given [for using this test] is, inter alia, to ensure that the provisions on patents are not circumvented by obtaining an exclusive right in a technical feature for a period longer than that provided for in the legislation applicable to patents and on less stringent terms.

According to the Advocate General, the no-aesthetic-consideration test is also consistent with the Court's case-law concerning trade marks (point 45):

a sign consisting exclusively of the shape of a product is unregistrable by virtue [of the provisions that were interpreted] if it is established that the essential functional features of that shape are attributable only to the technical result'. The Court has held that 'the ground for refusal ... of registration' as a trade mark of 'the shape of goods which is necessary to obtain a technical result' 'cannot be overcome by establishing that there are other shapes which allow the same technical result to be obtained', in accordance with those provisions. It based this rejection, which is implicit but clear in my view, of the multiplicity of forms theory in particular on the finding that the refusal of registration is not subject to the condition that the shape at issue is the only one which could achieve the intended technical result and on the observation that a significant number of alternative shapes might become unusable for the trade mark proprietor's competitors if such a criterion were considered to be decisive. [Or. 13]

(c) Application to the present case

In the present case, Get2Get submits that the appearance of its Chedech bicycle is dictated by the technical solution sought, that is to say a functional and lightweight bicycle which folds into three different positions (folded, unfolded and stand-by).

It states that it deliberately adopted the folding technique, previously covered by Brompton's — now expired — patent, because it considers that method to be the most functional. Get2Get takes the view that the choice of that folding method is a technical constraint which dictates the appearance of the Chedech bicycle.

Brompton and Mr SI submit that, in so far as there are other bicycles on the market which fold into three positions and are different in appearance from their own, they have copyright over their bicycle, the appearance of which demonstrates the existence of creative choices on their part and, therefore, originality.

The applicants' argument is based on the application of the multiplicity of forms theory, which has just been rejected by the Court of Justice of the European Union in relation to designs.

Even though those intellectual property rights are based on a system of protection other than that provided by copyright, it is worth recalling that the multiplicity of forms theory was originally developed within the field of design law and then extended to copyright.

Next, the arguments put forward by both the Court and the Advocate General in support of the [applicability of the] no-aesthetic-consideration theory in matters of design may be transposed to copyright.

Thus, the protection granted to an author in respect of his work is an extended exclusive right which has a longer term than the protection available under patent law. The conditions for obtaining copyright are also different from, and in some respects less restrictive than, those laid down in patent law.

In the present case, Brompton held a patent for its bicycle's three-position folding system. Since that patent has now fallen into the public domain, any competitor [may] now produce and market a bicycle using the 'Brompton' folding technique.

If that folding technique required the bicycle to be a specific shape and the applicants could use copyright law to prevent a competitor from entering the market by producing bicycles which are similar in appearance to the Brompton bicycle, they would effectively enjoy exclusivity in respect of their folding method, despite the fact that their patent for that method has expired. **[Or. 14]**

However, it is apparent from the documents before this court that other producers have chosen to market bicycles which, although of different shapes, are nonetheless capable of being folded into three positions, like the Brompton bicycle.

Consequently, the outcome of the present dispute depends on whether the existence of copyright — and thus the exclusive rights that flow from it — is excluded where the appearance for which protection is sought is necessary in order to achieve a particular technical effect.

It is therefore appropriate to stay the proceedings and consult the Court of Justice on the interpretation of Directive 2001/29 and the extent of the protection to be afforded to the appearance of a product where that appearance is dictated by technical constraints.

If copyright can be granted in a shape which is necessary to achieve a given technical result, is there any relevance, for the purposes of determining whether or not a shape is necessary to obtain a technical result, in considering whether other possible shapes allow the same result to be achieved?

This court is also unsure about the relevant criteria to be taken into account in assessing whether or not a shape is necessary in order to obtain a technical result. Thus, is the effectiveness of the shape in achieving the technical result sought of any relevance in this context or is the mere fact that the designer had the intention of achieving that result sufficient? Does the existence of an earlier, now expired, patent on the process for achieving the technical result have any bearing on the assessment of the existence of copyright in the present case?

ON THOSE GROUNDS:

[...]

This court, ruling after hearing both parties and before giving judgment on the substance of the case,

Refers the following questions to the Court of Justice of the European Union for a preliminary ruling under Article 267 of the Treaty on the Functioning of the European Union:

- Must EU law, in particular Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society, 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?
- In order to assess whether a shape is necessary to achieve a technical result, must account be taken of the following criteria: **[Or. 15]**
 - 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?

[...]

WORKING DOCUMENT