

AIPPI's inaugural Copyright Round-Up seminar

Speakers:

Speakers: Nicholas Caddick KC (Hogarth Chambers) and Professor Uma Suthersanen (Director, Queen Mary Intellectual Property Research Institute).

Moderator: Calum Smyth

Hybrid event, 18:00, 13 September 2023

Kindly hosted by Mishcon de Reya

Copyright update

Nicholas Caddick K.C.
September 2023

H|C

Artificial Intelligence

- Generative AI – creating text, images, music, speech, code or video based on learning from existing available content
- Text or Data Mining (“TDM”)
- Currently s.29A CDPA 1988 allows some TDM (where there is lawful access) for “non-commercial purposes”
- Vallance Report (March 2023) – recommends:
 - Regulatory “Sandbox”
 - Government should enable TDM (i.e. the input into AI) and apply IPR only to the output of AI
 - Code of Practice
- Government Response (March 2023) – accepting Vallance recommendations
- UKIPO Terms of Reference (May 2023)
 - Working on Code of Practice to make licences for TDM more available
 - Voluntary – but legislation if needed
- Report of Commons Culture Media and Sport Committee (HC1643) at [29]-[32]
- Currently litigation in High Court - *Getty Images v Stability AI*

Shazam Productions v Only Fools The Dining Experience
[2022] EWHC 1379 (IPEC)

The copyright works relied on

- **Scripts** – each is a dramatic work
- **Body of scripts** – not a separate dramatic or literary work
 - Body of scripts is not intended to be performed/published as one work
 - Contrast compilations/Dickens serialisations
- **Character of Del Boy** – a literary work
 - 2 stage test (*Cofemel/Levola*) – (a) originality – i.e. AOIC; (b) identifiability – i.e. expressed with sufficient clarity and precision; objectively discernible.
 - Test satisfied - Del Boy highly original and distinctive. His fully rounded character is discernible from the scripts (not just from the actor's performance)
 - Consistent with position in Germany (Pippi Longstocking) and US (Sherlock Holmes)
 - Literary work (not dramatic work)

Shazam Productions v Only Fools The Dining Experience
[2022] EWHC 1379 (IPEC)

- **Infringement of copyright in character**
 - “evidence of infringement overwhelming and obvious”
 - Commonality between depiction of Del Boy in script and in D’s show
 - Indirect copying (from TV broadcasts of the scripts)
- **Infringement of copyright in scripts**
 - Due to case management order, does not make detailed finding on whole list of features relied on by C
 - Finds 21 particular features copied (again indirect copying)

Shazam Productions v Only Fools The Dining Experience
[2022] EWHC 1379 (IPEC)

- **Parody/pastiche exclusion**
 - s.30A CDPA 1988 – exclusion for fair dealing for purposes of caricature, parody or pastiche
 - Exclusions are subject to the 3 step (Berne Convention) test – (1) must be confined to certain special case; (2) must not conflict with normal exploitation of the work; (3) must not unreasonably prejudice legitimate interests of copyright owner.
 - Court must strike balance between parties' interests.

- **Parody**
 - Must (a) evoke an existing work – whilst be noticeably different from it and (b) be an expression of humour or mockery. See CJEU in *Deckmyn v Vandersteen* (C-201/13)
 - Must express an opinion by means of the imitation – the opinion may be of the work parodied or something outside it (e.g. a political figure)

- **Pastiche**
 - Either (a) imitation of the style of an existing work or (b) an assemblage of existing works in a new work
 - Product of pastiche must be noticeably different from the original
 - No requirement of the element of humour/mockery
 - Wide scope – but subject to 3 stage test

- **D's show neither a parody nor a pastiche**
 - Not being used to express humour about or mock OFAH script, or Del Boy character, or anything else. It reproduced them, not a parody of them
 - Not imitating style of the works but is taking characters and back story. A reproduction of them, not a pastiche using them
 - In any event, not fair dealing and fails the 3 stage test bearing in mind:
 - (i) Extent of D's use; (ii) D had made no attempt to express critical view; (iii) copying was to entertain D's customers; and (iv) D's use competed with normal exploitation by C

Pasternak v Prescott [2022] EWHC 2695

Main claim – copyright in selection and arrangement

- Like *Baigent v Random House* (the Da Vinci Code case), Pasternak involved a claim that the copyright in her work of non-fiction (“Lara”) had been infringed by D’s work of fiction (“The Secrets We Kept”)
- No claim for infringement based on the copying of text.
- Claim based on copying of C’s selection and arrangement of events to include in her book
- Judge finds copyright did subsist in C’s selection and arrangement (applying the CJEU’s approach from *Cofemel* and *Levola*)
- However, Judge rejects copying claim
 - Some similarities – but consistent with D having used the same source materials that C had used in writing her book
 - Other instances of copying of specific words (intended to show D must have copied the selection as well), largely rejected
 - Although D had had a copy of C’s book, she had merely used it as a secondary source

Pasternak v Prescott [2022] EWHC 2695

Copyright in a translation and the quotation defence

- C's work included a passage from another work, translated into English, which passage was copied by D
- Found that copyright can subsist even in a simple translation as it involves creative choices by the translator
- D relied on the s.30(1ZA) defence – which permits use of a quotation where (inter alia) it amounts to fair dealing and where it is accompanied by a sufficient acknowledgement (unless that would be impossible).
- s.30(1ZA) defence fails:
 - D's use was fair dealing – D not seeking to compete with translator and did not interfere with C's dealings with the translation; however,
 - There was no sufficient acknowledgement (either of the work or the author – see s.178 CDPA 1988) because D had not made any attempt to identify the author of the translation

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Cofemel (2019)

D



PORTUGUESE LAW

- Art.2.(1)(i), Copyright Act, 1985
- The intellectual creations in the literary, scientific and artistic domain «comprise:(...) works of applied arts, industrial designs and design works which constitute *artistic creation*».



COFEMEL (2019)

CJEU - SUMMARY

- **Work** = would constitute an autonomous notion of EU law with 2 elements:

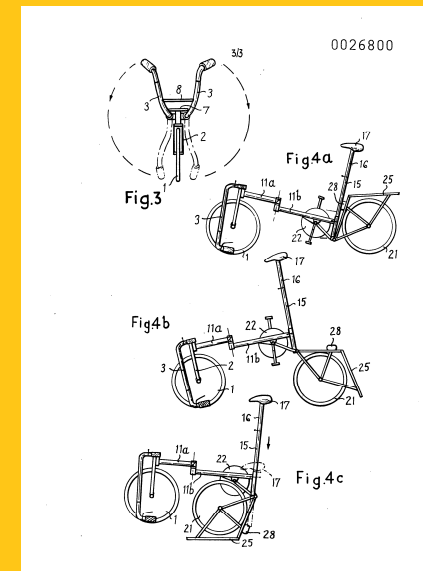
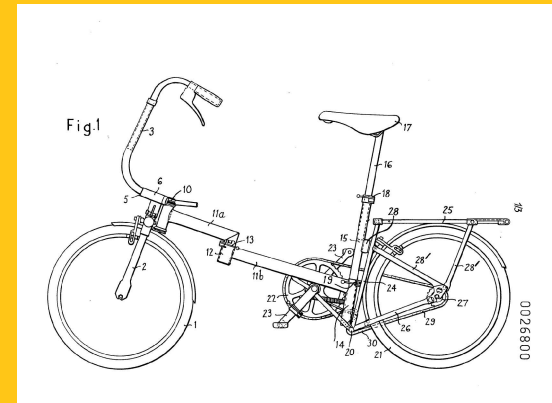
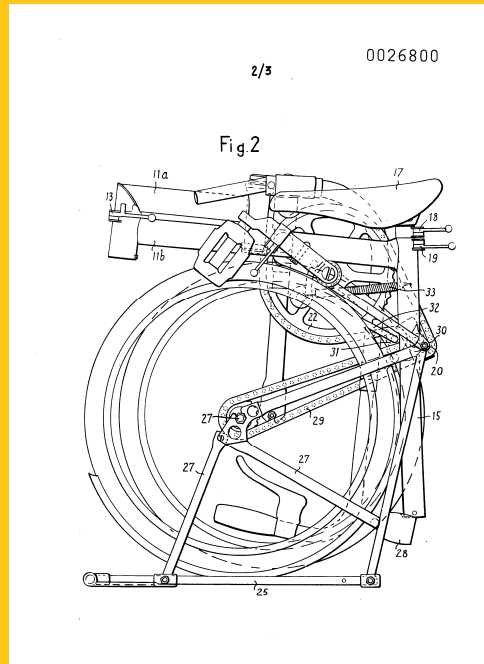
- **Originality**

- author's own intellectual creation
- the object in question reflects the personality of the author through the expression of free and creative decisions (*Painer* case)
- This excludes objects which are constrained by technical considerations and would therefore not provide much scope for creative choices (*Football Dataco* case)

- **Work** = limited to expressions of creativity
- which are capable of being identified with sufficient precision and objectivity and
- to **avoid any subjectivity** which would undermine legal certainty (*Levola* case)

- **Aesthetics** : The *Cofemel* approach excludes any consideration of aesthetic quality or merit of appearance

SI, Brompton Bicycle
Ltd. v Chedech /
Get2Get - patent
EP0026800A1 -
drawings



Brompton

Court of Justice

11 June 2020

- 1. Work: the concept of 'work' has two conditions: an original subject matter which is the author's own intellectual creation and, second, it requires the expression of that creation
- 2. Originality: the subject matter must reflect the personality of its author, as an expression of his free and creative choices
- 3. Expression: the concept of 'work' necessarily entails the existence of a subject matter that is identifiable with sufficient precision and objectivity
- (*Cofemel* is cited for all 3 points)

Brompton

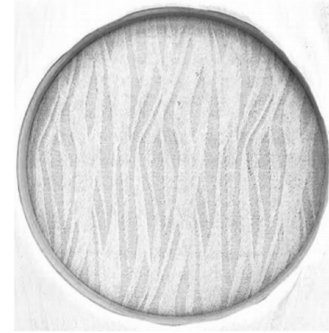
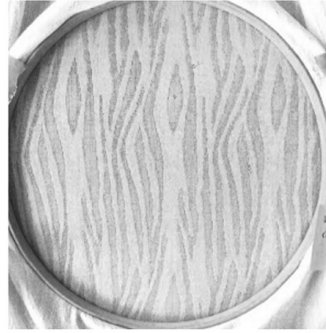
Court of Justice

11 June 2020

- 4. Technical function
 - “where the realisation of a subject matter has been dictated by technical considerations, rules or other constraints which have left *no room for creative freedom*, that subject matter cannot be regarded as possessing the originality required for it to constitute a work”
 - “.... a subject matter satisfying the condition of originality may be eligible for copyright protection, even if its realisation has been dictated by technical considerations, provided that its being so dictated has *not prevented the author from reflecting his personality* in that subject matter, as an *expression of free and creative choices*.”
 - “Where the expression of those components is dictated by their technical function, the different methods of implementing an idea are so limited that the idea and the expression become *indissociable*” - derived from Art.2, WIPO Copyright Treaty (reminiscent of US merger doctrine)
- **Factors to be taken into account are**
 - **is shape “solely dictated by its technical function” (this language is taken from design law)**
 - **has author made “free and creative choices”**
 - **existence of alternative shapes not decisive that author made free and creative choices**
 - **existence of patent should be taken into account**

Response Clothing Ltd v. Edinburgh Woollen Mill Ltd[2020]
EWHC 148 (IPEC)

- Response - designs and markets clothes / Edinburgh Woollen Mill (EWM) - major clothing retailer
- Response supplied EWM with tops made of a jacquard fabric with a design referred to as a “wave arrangement” (the “Wave Fabric”) – attempt to raise the price of the tops rejected
- Alternative suppliers - Visage, Bengal Knittex and Cingo -supplied EWM with similar tops also made from jacquard fabric
- Response issued infringement proceedings claiming =
 - copyright subsisted in the Wave Fabric as an artistic work (under s.4 CDPA)
 - either as (a) a graphic work; or (b) a work of artistic craftsmanship
 - alleged that fabrics supplied by Visage, Bengal Knittex and Cingo were infringing copies of the Wave Fabric
 - EWM sales of tops made from those fabrics = primary and secondary copyright infringement



Response Clothing Ltd v. Edinburgh Woollen Mill Ltd[2020]
EWHC 148 (IPEC)

- A work of craftsmanship in the sense that it was made by a person in a skillful way who took justified pride in their workmanship; and
- Artistic in the sense that it was produced by a person with creative ability and had aesthetic appeal.
- Based on the facts of the case, HH Judge Hacon was satisfied that the creation of the Wave Fabric involved the necessary craftsmanship, finding that the fact that the design was created on a machine did not matter.
- The design was created by a craftsman working in a skillful way (there was no evidence on this issue), it could be assumed that they would have taken justified pride in their workmanship. He also assumed that their primary goal was to produce something that would be aesthetically pleasing to customers, which he concluded must have been the result since the design was a commercial success.
- Accordingly, he concluded that the Wave Fabric did qualify as a work of artistic craftsmanship because it fell within the *Bonz* criteria, which had subsequently been approved by two English High Court decisions [High Court decision from New Zealand]
- Hacon expressly acknowledged the tension between *Cofemel* and UK case law on works of artistic craftsmanship



[Waterrower \(UK\) Ltd v Liking Ltd \(t/a Topiom\)](#)

[\[2022\] EWHC 2084 \(IPEC\); \[2023\] E.C.D.R. 1; \[2022\] 8 WLUK 12 \(IPEC\)](#)

Waterrower (UK) Ltd v. Liking Ltd (t/a Topiom)

- The WaterRower had been recognised as an “iconic design” by design magazines and museums such as the Museum of Modern Art in New York and the Design Museum in London.
- John Duke – designer from former member of the USA National Rowing Team - design inspiration from Shaker furniture - initial WaterRower entirely made by hand - certain aspects of the WaterRower machines continued to be made by hand even after outsource to industrial manufacturers.
- David Stone, sitting as a Deputy High Court Judge, adopted same approach as Hacon in *Response Clothing*

Waterrower (UK) Ltd v. Liking Ltd (t/a Topiom)

- A real prospect of demonstrating at trial that the WaterRower falls within the definition of “works of artistic craftsmanship”
- Duke, the designer, approached the project with artistic intention
- Defendant conceded that the WaterRower was pleasing to the eye
- Artistic quality of the WaterRower had been recognised in design magazines and museums focusing on modern art and design
- WaterRower did not appear markedly less artistic in its conception or appearance than the examples of works of artistic craftsmanship – hand-painted tiles, stained-glass windows, wrought-iron gates and the like – set out in the case law.

Waterrower (UK) Ltd v. Liking Ltd (t/a Topiom)

- IF adopt CJEU case law – then use concept of original work - so, WaterRower is a “work” entitled to copyright protection
- Some aspects of the WaterRower technically constrained – however not of type which forces the designer to a single, pre-defined outcome
- Claimant could demonstrate designer still had room to exercise his free and creative choices within those constraints, such as the choice of materials, how the different types of materials were to be treated, the shape and dimensions of various features, and so forth.
- Court acknowledged inconsistencies between the CDPA’s closed list of subject matter categories on the one hand and the CJEU’s case law on the other – but no need to resolve at this stage

Waterrower (UK) Ltd v Liking Ltd (t/a Topiom) - Intellectual Property Enterprise Court [2022] EWHC 2084 (IPEC)

Response Clothing Ltd v Edinburgh Woollen Mill Ltd - Intellectual Property Enterprise Court [2020] EWHC 148 (IPEC)

Abraham Moon & Sons Ltd v Thornber & Ors [2012] EWPC 37 (05 October 2012) - ([2012] EWPC 37	Lucasfilm Ltd v Ainsworth - Supreme Court [2011] UKSC 39 27 Jul 2011; Court of Appeal (Civil Division) [2009] EWCA Civ 1328 16 Dec 2009; Chancery Division [2008] EWHC 1878 (Ch) 31 Jul 2008
Nova Productions Ltd v Mazooma Games Ltd - Court of Appeal (Civil Division) [2007] EWCA Civ 219 14 Mar 2007	X Ltd v Nowacki (t/a Lynton Porcelain Co)- Chancery Division [2003] EWHC 1928 (Ch) 1 Aug 2003
Guild v Eskandar Ltd (formerly Ambleville Ltd) - Court of Appeal (Civil Division) [2002] EWCA Civ 316 14 Mar 2002	Vermaat (t/a Cotton Productions) v Boncrest Ltd (No.1) - Chancery Division [2000] 5 WLUK 735 25 May 2000
Spraymiser Ltd v Wrightway Marketing Ltd - Chancery Division [1999] 12 WLUK 662 20 Dec 1999	BBC Worldwide Ltd v Pally Screen Printing Ltd - Chancery Division [1998] 1 WLUK 402 26 Jan 1998
Creation Records Ltd. & Ors v News Group Newspapers Ltd [1997] EWHC Ch 370 (25 April 1997)	X Ltd. v Nowacki & Anor [2003] EWHC 1928 (Ch) (01 August 2003) ([2003] EWHC 1928 (Ch)
Shelley Films Ltd v Rex Features Ltd - Chancery Division [1993] 12 WLUK 138 10 Dec 1993	Komesaroff v Mickle - Supreme Court (Victoria) [1986] 11 WLUK 227 24 Nov 1986
British Leyland Motor Corp Ltd v Armstrong Patents Co Ltd - House of Lords [1986] A.C. 577 27 Feb 1986	Merlet v Mothercare Plc - Court of Appeal (Civil Division) [1985] 10 WLUK 105 14 Oct 1985
British Northrop Ltd v Texteam Blackburn Ltd - [1973] F.S.R. 241, [1973] 3 WLUK 70	Ford Motor Co Ltd's Replacement Body Parts Policy, Re Monopolies and Mergers Commission [1985] 2 WLUK 1 1 Feb 1985
Merlet v Mothercare Plc - Chancery Division [1984] 4 WLUK 126 13 Apr 1984	Hoover Plc v George Hulme (Stockport) Ltd - Chancery Division [1982] 5 WLUK 227 27 May 1982
Foley v Elliott - Chancery Division [1981] 8 WLUK 65 25 Aug 1981	LB (Plastics) Ltd v Swish Products Ltd - House of Lords [1979] 2 WLUK 22 2 Feb 1979; Chancery Division [1976] 11 WLUK 176 29 Nov 1976
Radley Gowns Ltd v Costas Spyrou (t/a Touch of Class and Fiesta Girl) - Chancery Division [1975] 5 WLUK 82 19 May 1975	George Hensher Ltd v Restawile Upholstery (Lancs) Ltd - House of Lords [1976] A.C. 64 1 May 1974; Court of Appeal (Civil Division) [1973] 3 W.L.R. 453 4 Jul 1973; Chancery Division [1973] 1 W.L.R. 144 31 Oct 1972
Merchant Adventurers Ltd v M Grew & Co Ltd (t/a Emess Lighting) - Chancery Division [1972] Ch. 242 22 Mar 1971	King Features Syndicate Inc v O&M Kleeman Ltd - Court of Appeal [1940] Ch. 806 8 Jul 1940
Burke & Margot Burke Ltd v Spicers Dress Designs - Chancery Division [1936] Ch. 400 4 Feb 1936	

Using Originality
and Functionality
rules in lieu of
“work of artistic
craftsmanship”
for 3D designs

Post-Brexit
Option One

- Reject CJEU / EU law on categories and “original work”
- Reject CJEU law: *Flos*, *Cofemel*, *Brompton*, *Football Dataco* (*functionality*), *Levola*
- Return to the notion of “industrial copyright for 25 years as a means to balance competition”
- Legislative change required - re-introduce s.52 on industrial manufacture; emphasise closed list?
- Define “artistic” and “craftsmanship”? Codify *Hensher* and *Lucasfilm*?
- Parts of *Response and Waterrower* should be rejected (ie the bits referring to EU law)

Using Originality
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3D designs

Post-Brexit Option
Two

- No legislative changes required – active court required
- Flexible historical approach
- Classification is technical in character without notions of quality - basic UK philosophy is economic. 1911 CA = works of artistic craftsmanship = works of applied art - *Art.2 Berne Convention*.
- Categories are fluid - cases on circuit diagrams, maps = literary & artistic. S.4 CDPA - flexible category of works (Berne Convention flexibility) (***Norowzian, SAS Institute, Nova Productions***)
- *Hensher* is open to myriad interpretations, *Lucasfilm* calls for multi-factorial test which can expand to protect designs which are destined for general products / consumer market
- Courts adopt approaches in *Response* and *Waterrower* - but latter decisions straddle two streams of jurisprudence – pre *Cofemel* (ie applying *Hensher* and *Lucasfilm*) and the post *Cofemel*/Brexit (ie a second layer of analysis on “original work”)....

Using Originality
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Post-Brexit
Option Three

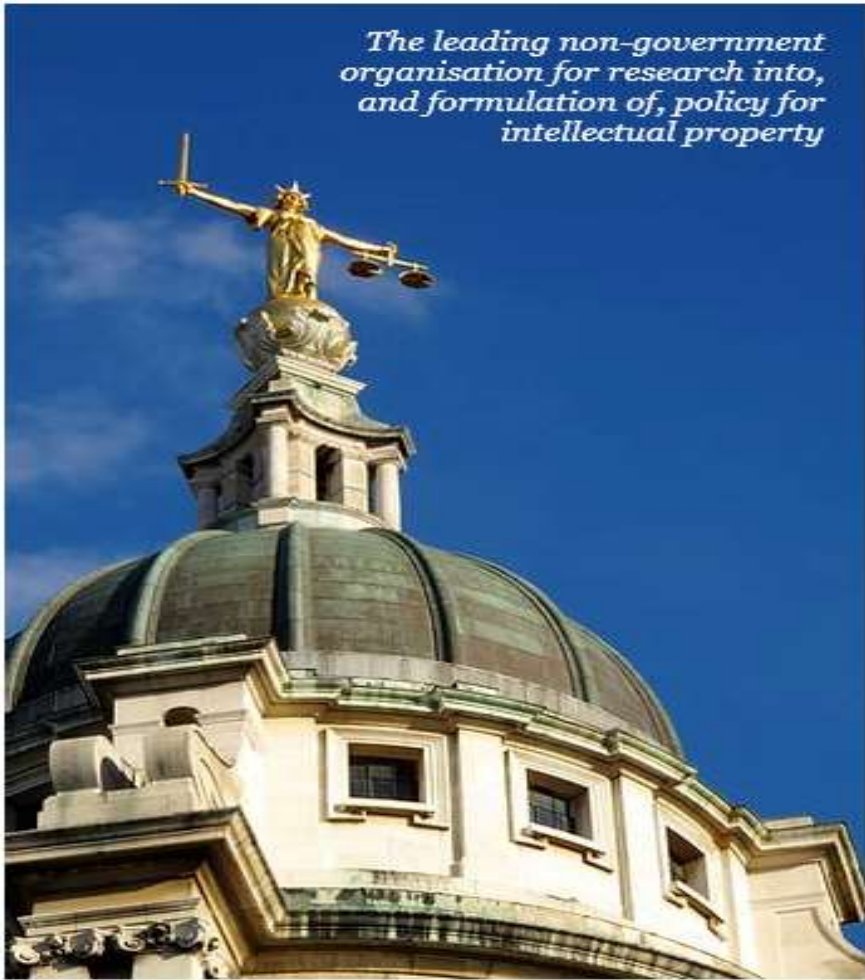
- So why not just merge the two approaches?
- The current approach (*Response Clothing; Waterrower*) - Courts have to apply a single test - whether design constitutes “an original work of artistic craftsmanship”
- “Original work” (*Infopaq, Flos, BSA, Football Dataco, Levola, Cofemel, Brompton*) (*Response Clothing; Waterrower*)
- 2D and “design documents” protectable to the extent satisfy ss 4 & 51 CDPA ; 3D designs protectable to the extent satisfy s.4 and “sculpture” or “works of artistic craftsmanship”
- Flexible interpretations - *Hensher, Lucasfilm, Response Clothing*
- No legislative change required – active court required
- Introduce or concretise the existing norms in jurisprudence - “free and creative” contribution [eg see *HoL Cramp v Smythson (1944)*], personality and a functionality/technical constraints

Copinger & Skone James on Copyright (18th edition) – hints on this

- “For a work to be regarded as one of artistic craftsmanship, it should be possible to say that the creator was both a craftsman and an artist. It has been suggested that determining whether a work is a work of artistic craftsmanship does not turn on assessing the beauty of aesthetic appeal of work or on assessing any harmony between its visual appeal and its utility, but on assessing the extent to which the particular work’s artistic expression, in its form, is unconstrained by functional considerations. Accordingly, the more constrained the designer is by **functional considerations**, the less likely the work is to be a work of artistic craftsmanship. It is a matter of degree.”

Using Originality and Functionality rules in lieu of “work of artistic craftsmanship” for 3D designs

- *Lucasfilm* - Supreme Court determined sculpture in correlation to functional purpose - court so concerned with drawing a demarcation line between functional works and non-functional works, to the extent that its discussion on functionality or utilitarianism edged its discussion on “sculpture”.
- In my opinion, if a Supreme Court were to consider the facts of this decision again, in light of the CJEU jurisprudence on “original work” and the shift of the *Government’s policy*, the court would consider the extent of a work’s originality in light of *Brompton/Cofemel* = namely the extent to which the particular work’s artistic expression, in its form, is unconstrained by functional considerations (*Brompton*)



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Thank you.