

**Case C-795/23**

**Summary of the request for a preliminary ruling pursuant to Article 98(1) of the Rules of Procedure of the Court of Justice**

**Date lodged:**

21 December 2023

**Referring court:**

Bundesgerichtshof (Germany)

**Date of the decision to refer:**

21 December 2023

**Defendant, respondent and appellant on a point of law:**

konektra GmbH

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**Applicant, appellant and respondent in the appeal on a point of law:**

USM U. Schärer Söhne AG

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**Subject matter of the main proceedings**

Directive 2001/29/EC – Copyright – Concept of ‘work’ – Assessment of originality

**Subject matter and legal basis of the request**

Interpretation of EU law, Article 267 TFEU

**Questions referred for a preliminary ruling**

1. 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?

2. 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?

3. 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?

### **Provisions of European Union law relied on**

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 (OJ 2001 L 167, p. 10), in particular Article 2(a), Article 3(1) and Article 4(1) thereof

### **Provisions of national law relied on**

Urheberrechtsgesetz (German Copyright Act; 'the Copyright Act'), in particular point 4 of Paragraph 2(1) and Paragraph 2(2) thereof

### **Succinct presentation of the facts and procedure in the main proceedings**

- 1 The applicant at first instance ('the applicant') is the manufacturer of a modular furniture system which it has marketed for decades under the name 'USM Haller', the system comprising round 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.
- 2 Defendant at first instance 1 ('the defendant'), whose managing director is defendant 2, offers spare parts and extension parts for the USM Haller furniture system via its online shop, which correspond in shape and primarily also in colour to the original components of the applicant. After initially confining itself purely to the sale of spare parts, the defendant reorganised its online shop in 2017/2018, by listing all the components needed for the assembly of complete USM Haller furniture. The defendant also uses images of assembled furniture on its website for promotion purposes. Its furniture deliveries are accompanied by an assembly manual which explains how to build complete pieces of furniture. It offers its customers an assembly service in which the individual parts delivered are assembled at the customer's premises into a complete piece of furniture.

- 3 The applicant asserts that the USM Haller furniture system is a work of applied art, protected by copyright, or, in any event, is a performance outcome protected against imitation under the law on fair trading practices. It regards the reorganisation of the online shop as a realignment of the defendant's business model, with the aim of no longer offering only spare parts for the applicant's furniture system, but also of manufacturing, offering and marketing its own furniture system which is identical to the applicant's furniture system. The applicant claims that, in so doing, the defendant is infringing the copyright in its furniture system or that, in any event, the defendant's furniture system must be regarded as an imitation which is not permitted under competition law.
- 4 The applicant brought an action against the defendant seeking a prohibitory injunction, the provision of information and accounts, reimbursement of costs incurred in giving formal warning and a declaration that the defendant was liable to pay damages. In support of its claims, the applicant is relying primarily on copyright or, in the alternative, on the protection of related rights under competition law.
- 5 The Landgericht (Regional Court, Germany) upheld the claims principally on the basis of copyright. The appellate court (Oberlandesgericht Düsseldorf (Higher Regional Court, Düsseldorf, Germany), judgment of 2 June 2022 – 20 U 259/20, juris), on the other hand, dismissed the claims in this respect on the grounds that the USM Haller furniture system is not a work of applied art protected by copyright within the meaning of point 4 of Paragraph 2(1) and Paragraph 2(2) of the Copyright Act because it does not fulfil the requirements to be met by a work according to the recent case-law of the Court of Justice of the European Union, and granted the claims only in so far as they are based on the protection of related rights under competition law. By its appeal on a point of law, the applicant is pursuing its claims under copyright, while the defendants are also requesting that the claims be dismissed in so far as they are based on competition law.

### **Succinct presentation of the reasoning in the request for a preliminary ruling**

- 6 The success of the applicant's appeal against the dismissal of the claims asserted primarily on the basis of copyright depends on the interpretation of the concept of 'work' contained in Article 2(a), Article 3(1) and Article 4(1) of Directive 2001/29. In the light of the request for a preliminary ruling made by the Swedish Svea hovrätt (Svea Court of Appeal, Stockholm, Sweden) on 20 September 2023, which is pending before the Court of Justice under case number C-580/23, the correct application of EU law is not so obvious as to leave no scope for any reasonable doubt (see judgment of 6 October 2021, *Conorzio Italian Management and Catania Multiservizi*, C-561/19, EU:C:2021:799, paragraph 32 et seq.).
- 7 The first question referred: The appellate court inferred from the judgment of 12 September 2019, *Cofemel* (C-683/17, EU:C:2019:721, paragraph 51 et seq.),

that copyright protection for utilitarian objects, as compared with design protection, would have to remain the exception in order not to undermine the objectives and effectiveness of both types of protection.

- 8 The referring court is of the view that it does not follow from the considerations set out in paragraphs 50 to 52 of the judgment in *Cofemel* that, in the case of utilitarian objects, higher requirements are to be imposed with respect to the originality required for copyright protection as a work of applied art than for other types of work. The Court of Justice held that designs are to be regarded as works within the meaning of Directive 2001/29 where they meet two conditions – which apply equally to all subject matter which may be protected by copyright. First, they must be original in the sense of being the author’s own intellectual creation and, second, they must express such a creation (judgment of 12 September 2019, *Cofemel*, C-683/17, EU:C:2019:721, paragraphs 29 and 48; see also Opinion of Advocate General Szpunar in *Cofemel*, C-683/17, EU:C:2019:363, point 31; on the scope of protection, see judgment of 1 December 2011, *Painer*, C-145/10, EU:C:2011:798, paragraph 97 et seq.).
- 9 The Court’s observation that concurrent protection of designs and copyright protection can be envisaged only in certain situations must therefore, in the view of the Chamber, be understood not in a normative way, but in a purely descriptive way. It simply means that, in reality, the protection of the same subject matter, both as a design and as a work, will be the exception because a utilitarian object will more rarely fulfil the conditions for copyright protection than the conditions for design protection.
- 10 In the case of utilitarian objects with design characteristics linked to use, the scope for artistic design is generally limited. Therefore, the question arises, to a particular extent in the case of utilitarian objects, as to whether they are artistically designed beyond their functionally prescribed shape and whether this design reaches a level of originality that justifies copyright protection (BGH, GRUR 2023, 571 [juris paragraph 15] – Vitrinleuchte, with further references). In this regard, it should be borne in mind that, in order to benefit from copyright protection for works of applied art, as for all other types of work, it is necessary to require a level of originality that is not too low, having regard in particular to the extremely long duration of the protection conferred by copyright (see BGHZ 199, 52 [juris paragraph 40] – Geburtstagszug; BGH, judgment of 29 April 2021 – I ZR 193/20, GRUR 2021, 1290 [juris paragraph 60] = WRP 2021, 1461 – Zugangsrecht des Architekten).
- 11 When assessing individual character, which is a condition for design protection (see Article 4(1) and Article 6(1) of Regulation No 6/2002, Article 3(2) and Article 5(1) of Directive 98/71/EC), it is true that the degree of design freedom – namely that of the designer in the case of design development – is also to be taken into account (Article 6(2) of Regulation No 6/2002, Article 5(2) of Directive 98/71). However, unlike copyright protection, the protection of designs does not assume that the designer uses such freedom to make creative choices reflecting his

personality. Rather, it is sufficient if he succeeds in creating a design whose overall impression differs, from the point of view of the informed user, from the overall impression created by another design which has been made available to the public (Article 6(1) of Regulation No 6/2002, Article 5(1) of Directive 98/71).

- 12 The second question referred: The appellate court stated that, according to the case-law of the Court of Justice of the European Union, decisive consideration is to be given to the creator's considerations when creating the subject matter. Assessment of originality hinges on the subjective view of the creator (see also, in that regard, the Svea Court of Appeal's decision to refer, paragraphs 26 to 35). The creator must make creative choices knowingly, which is precluded where he is actually, or even only supposedly, bound by rules, technical conditions or other constraints. The aesthetics of a design also say nothing about whether it is based on free and creative choices because, in the creator's statements regarding the creation process, there is no basis for assuming free and creative choices.
- 13 By contrast, the referring court takes the view that originality must be assessed in a uniformly objective manner for all types of work and on the basis of the specific work actually presented. The subjective view of the author, in the sense of creative intent or knowingly making free and creative choices, should not be relevant.
- 14 In defining the original as being the author's own intellectual creation, the Court of Justice did not state that a 'knowingly' free and creative choice is necessary for that purpose, as the appellate court held in its analysis. On the contrary, according to the case-law of the Court, the assessment is carried out on the basis of circumstances in which a possible creative intention on the part of the creator is expressed in an objectively ascertainable manner. For example, in written reports, originality may result from the choice, sequence and combination of words (see judgment of 29 July 2019, *Funke Medien NRW*, C-469/17, EU:C:2019:623, paragraph 23 and the case-law cited). It does not follow from the case-law of the Court that, in addition to the finding that the author made a (creative) choice which was not objectively determined by constraints and which is therefore free, it is necessary to find that the author knowingly made a free and creative choice in this sense. Similarly, knowingly making a creative choice cannot be required because artistic achievements can also be made unknowingly or subconsciously.
- 15 In so far as the Court, in its judgment in *Brompton Bicycle*, relied on the factors and considerations which influenced the creator in the choice of the shape of the product (judgment of 11 June 2020, *Brompton Bicycle*, C-833/18, EU:C:2020:461, paragraph 35 et seq.), it also does not follow, in the view of the referring court, that the assumption of originality presupposes a finding of a 'knowingly' creative choice on the part of the creator. Rather, it follows from the *Brompton Bicycle* judgment that what matters is whether the result of the creation process constitutes an artistic achievement. Thus, it is for the national courts to determine whether, through the choice of the shape of the product, the author has expressed his creative ability in an original manner by making free and creative

choices and has designed the product in such a way that it reflects his personality (judgment of 11 June 2020, *Brompton Bicycle*, C-833/18, EU:C:2020:461, paragraph 34).

- 16 Furthermore, the Court of Justice did not adopt the Advocate General’s proposal to take account, as regards the concept of work, of factors other than the characteristics of originality and the expression of creation, such as the intention of the designer (see Opinion of Advocate General Campos Sánchez-Bordona in *Brompton Bicycle*, C-833/18, EU:C:2020:79, point 92 et seq.). Instead, the Court relies decisively, for the purposes of assessing originality, on the existence of scope for design which leaves room for creative freedom (judgment of 11 June 2020, *Brompton Bicycle*, C-833/18, EU:C:2020:461, paragraph 24). The purpose of relying on design freedom, which can be established on the basis of objective factors, such as known shapes or technical requirements, is precisely to make the concept of ‘work’ objective (see Zech, ZUM 2020, 801, 802). Since it is difficult to establish, as an internal process, whether a designer is utilising design freedom knowingly (Tolkmitt, GRUR 2021, 383, 386), the national court, which must take into account all relevant aspects of the respective case as they existed when the subject matter was designed (judgment of 11 June 2020, *Brompton Bicycle*, C-833/18, EU:C:2020:461, paragraph 37), will regularly have to infer the designer’s intention in the creation process from the design outcome and may also use supporting objective evidence for this purpose.
- 17 Legal certainty and a comparison with the second element of the grounds for protection (‘express’) militates in favour of an objective interpretation, for which, according to the case-law of the Court, any subjective element detrimental to legal certainty must be excluded from the identification of the protected subject matter (judgment of 13 November 2018, *Levola Hengelo*, C-310/17, EU:C:2018:899, paragraph 41). It would be detrimental to legal certainty and lead to unfair results if it were not necessary to exclude any subjective element also in relation to the first element of originality.
- 18 First, if only the subjective perception of the creator were relevant – as the assumptions of the appellate court in the case at issue show – a creator who believes that he is bound by rules or constraints, but who, in fact, has made creative choices that are not determined by rules or constraints and are therefore free, would not obtain copyright protection even though he has, objectively, created a work worthy of protection. Such a result is likely to be incompatible with the requirement to protect intellectual property under Article 17(2) of the EU Charter of Fundamental Rights. Second, a creator who considers himself to be acting freely and creatively, but who is actually bound by rules or constraints, would obtain copyright protection for his design, even though he has not, objectively, created any work worthy of protection. This would lead to the result, incompatible with the principles of intellectual property law, that any person could freely grant himself absolute rights, such as the authorisations stemming from copyright (see A. Nordemann in Fromm/Nordemann *ibid.*, Paragraph 2 Copyright Act, point 16). Similarly, the Svea Court of Appeal is concerned that an

interpretation of the requirement of originality based on the creation process and the choices made therein by the author would lead to relatively low requirements with respect to free and creative choices and the risk that subject matter which does not merit being classified as a work would also obtain copyright protection (Svea Court of Appeal, judgment of 20 September 2023, paragraphs 26 to 28).

- 19 In order to be consistent with the general objective of Directive 2001/29 of ensuring a high level of protection of copyright (judgment of 29 July 2019, *Pelham and Others*, C-476/17, EU:C:2019:624, paragraph 30), the determination of the concept of a work under EU law must also take account of the circumstances which have a bearing on the effective enforcement of copyright for the author in the context of the proceedings. In that regard, account must be taken of the fact that, in the copyright infringement process, it is the applicant author who bears the burden of demonstrating the existence of a personal intellectual creation. The requirement to demonstrate a particular motivation on the part of the creator is liable to increase the requirements relating to the protection of authors in an inappropriate manner (see OLG Hamburg, GRUR 2022, 565 [juris paragraph 39]).
- 20 A standard relying on the creator's perception would be encumbered by the difficulties regularly encountered with regard to subjective elements in establishing the facts. In addition, the creator's comments on his perceptions when creating the object in question or, in any event, indications of those perceptions, should rather be the exception. Furthermore, there is a danger that, in view of the long period of copyright protection, those difficulties will also be increased by the fact that the relevant time of creation is often years or even, as in the present case, several decades in the past. These factors stand in the way of uniform and legally certain handling, throughout the European Union, of the circumstances that are relevant for the protection of copyright by the national courts called upon to do so.
- 21 By contrast, the interpretation of the concept of originality, held to be correct by the referring court, hinges on objective circumstances which can be determined more easily by the national courts, such as the features of the design or the overall impression of the work or the design freedom which is to be determined in light of the shapes already known and the technical design requirements. In this respect, it is generally sufficient for the applicant to produce the work in question and to set out the specific design elements giving rise to copyright protection. In addition, in the case of utilitarian objects for which the possibilities of artistic and aesthetic design are regularly limited because they have to meet certain technical requirements and have design features dictated by technology, it is necessary to set out precisely and clearly the extent to which they are designed in an artistic manner beyond their shape dictated by function (BGH, judgment of 12 May 2011 – I ZR 53/10, GRUR 2012, 58 [juris paragraph 24 et seq.] – Seilzirkus, with further references; BGH, GRUR 2023, 571 [juris paragraph 21] – Vitrinenleuchte). If, on the other hand, the defendant defends itself with the objection that protectability would be omitted or the scope of protection would be limited because the author has resorted to previously known shapes, it is its

responsibility to set out and prove the appearance of the older work (BGH, judgement of 27 May 1981– I ZR 102/79, GRUR 1981, 820 [juris paragraph 25] – Stahlrohrstuhl II, with further references).

- 22 As regards the design’s aesthetics, reference should be made to the case-law of the Court of Justice of the European Union, according to which the aesthetic effect of a design does not, in itself, make it possible to determine whether that design constitutes an intellectual creation meeting the requirement of originality. However, aesthetic considerations can play a part in creative activity (judgment of 12 September 2019, *Cofemel*, C-683/17, EU:C:2019:721, paragraph 54). Consequently, the referring court considers that the aesthetic effect of the design may justify copyright protection (only) in so far as it is based on and gives expression to artistic achievement (see BGH, GRUR 2023, 571 [juris paragraph 13] – Vitrineneuchte, with further references). However, 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.
- 23 The third question referred: In German copyright law, when assessing the originality of a work, account must be taken of certain indications which militate in favour of or against the individuality of a work in order to obtain a result which is as objective and comprehensible as possible. As an indication of the suitability of a work for protection, account must also be taken of the respect it has found in professional circles and among the rest of the public; the presentation of the work in art museums and exhibitions may also indicate that circles receptive to the arts regard it as an artistic achievement that is subject to copyright protection (see BGH, judgment of 10 December 1986 – I ZR 15/85, GRUR 1987, 903 [juris paragraph 31] – Le Corbusier-Möbel, with further references; OLG München, GRUR-RR 2011, 54 [juris paragraph 43]; Dreier in Dreier/Schulze *ibid.* Paragraph 2, point 61 *et seq.* with further references; BeckOK.UrhR/Rauer/Bibi *ibid.* Paragraph 2, point 102; Leistner, GRUR 2019, 1114, 1120; aA OLG Hamburg, ZUM-RD 2002, 181 [juris paragraph 83]).
- 24 It seems doubtful whether these circumstances could, following the *Brompton Bicycle* judgment, continue to be taken as indications.
- 25 The Court of Justice has stated that, when assessing originality, it is for the national court to take account of all the relevant aspects as they existed when the subject matter was designed, irrespective of factors external to and subsequent to the creation of the product (judgment of 11 June 2020, *Brompton Bicycle*, C-833/18, EU:C:2020:461, paragraph 37).
- 26 However, the referring court understands the Court’s comments merely as clarification that, when ascertaining whether sufficient design freedom existed and was creatively used by the creator, only the situation at the time of creation is decisive (see also BGH, GRUR 1961, 635, 638, under III 4 – Stahlrohrstuhl I).

According to this view, subsequent developments in shape are, in particular, irrelevant. However, it should be possible to take into account circumstances subsequent to the creation of the product, such as assessments in the technical world, in so far 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 enables national 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 (judgment of 11 June 2020, *Brompton Bicycle*, C-833/18, EU:C:2020:461, paragraph 37).

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