

Case C-580/23

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 September 2023

Referring court:

Svea hovrätt, Patent- och marknadsöverdomstolen (Sweden)

Date of the decision to refer:

20 September 2023

Applicants:

Mio AB

Mio e-handel AB

Mio Försäljning AB

Defendant:

Galleri Mikael & Thomas Asplund Aktiebolag

Subject matter of the main proceedings

Infringement of copyright

Subject matter and legal basis of the request

Request pursuant to Article 267 TFEU for an interpretation of Articles 2 to 4 of 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

Questions referred for a preliminary ruling

1. 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 Articles 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.

2. 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?

3. 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 Articles 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.

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?

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, Articles 2 to 4

Provisions of national law relied on

Lagen (1960:729) om upphovsrätt till litterära och konstnärliga verk (Law 1960:729 on copyright in literary and artistic works)

According to Paragraph 1, the person who has created a literary or artistic work has copyright to that work, irrespective of whether it is

1. a fictional or descriptive representation in written or spoken form,
2. a computer programme,
3. a musical or staged work,
4. a cinematographic work,
5. a photographic work or any other work of visual art,
6. a work of architecture or applied art, or
7. a work that has been given expression in any other way.

According to Paragraph 2, copyright includes, subject to certain limitations, the exclusive right to dispose of the work by producing copies of it and by making it available to the public, in its original or amended form, in translation or adaptation, in another literary or artistic form or in another technique. The production of copies includes any direct or indirect, temporary or permanent production of a work, by any means and in any form, in whole or in part. The work is made available to the public, inter alia, when the work is transmitted to the public or when copies of the work are offered for sale, rental or on loan or otherwise distributed to the public.

According to Paragraph 53(b), a court may prohibit, on pain of a penalty, a person who takes, or participates in, a measure infringing copyright from continuing that measure.

Succinct presentation of the facts and procedure in the main proceedings

- 1 The parties to the proceedings are Galleri Mikael & Thomas Asplund Aktiebolag ('Asplund'), on the one hand, and Mio AB, Mio e-handel AB and Mio Försäljning AB (together, 'Mio'), on the other. Asplund manufactures and designs various interior decoration products and items of furniture. Mio engages in retail trade in the furniture and home decoration sector.
- 2 Asplund's range includes dining tables in the Palais Royal furniture series (the 'Palais tables'), an image of which is below.



- 3 Mio's range includes dining tables in the Cord furniture series (the 'Cord tables').
- 4 In October 2021, Asplund brought an action before the Patent- och marknadsdomstolen (Patent and Market Court) against Mio for copyright infringement. In that case, Asplund claimed, inter alia, that the Patent and Market Court should prohibit Mio, on pain of a penalty, from manufacturing, marketing or selling the Cord tables. Mio contested the action brought by Asplund.
- 5 The Patent- och marknadsdomstolen upheld the action brought by Asplund. It ruled that the Palais tables were protected by copyright as a work of applied art and that Mio's Cord tables infringed the Palais tables' copyright protection.
- 6 Mio lodged an appeal against the judgment of the Patent and Market Court and claimed that the Patent- och marknadsöverdomstolen (Patents and Market Court of Appeal) should dismiss the action brought by Alspund. In the proceedings before the Patent- och marknadsöverdomstolen, questions arose concerning the interpretation of 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.

The essential arguments of the parties

- 7 Asplund has claimed, in essence, the following. The Palais tables are works of applied art and are protected by copyright as works. Mio's Cord tables exhibit strong similarities to the Palais tables and fall within the scope of protection afforded to the Palais tables. By producing copies of the Cord tables and making them available to the public, therefore, Mio thus infringed Asplund's copyright to the Palais tables.
- 8 Mio has contended, in essence, the following. The Palais tables are not protected by copyright. The tables lack sufficient originality to enjoy copyright protection. The design of the Palais tables is attributable largely to functional and production engineering considerations. The Palais tables are based on simple variations of common designs and are devoid of originality. If the Palais tables are deemed eligible for copyright protection, the scope of protection is, in any event, limited and very narrow given the limited degree of originality. The differences between the tables are sufficient for the Cord tables to fall outside the scope of any protection afforded to the Palais tables. In any event, the Cord tables are not imitations of the Palais tables. The Cord tables have been produced independently by Mio with inspiration from its own earlier designs and an international trend with round shapes and wooden rods or rods in other materials.

Succinct presentation of the reasons for the request for a preliminary ruling

The question whether a subject-matter of applied art has the requisite originality to merit protection as a work

- 9 The case concerns subject-matter of applied art in the form of tables. A central question in the case is whether the Palais tables, as subject-matter of applied art, enjoy copyright as artistic works. The question of whether the tables should be afforded protection as works within the meaning of Directive 2001/29/EC must be determined on the basis of the criteria for assessment laid down by the Court of Justice in its case-law (see judgment of 12 September 2019, *Cofemel*, C-683/17, EU:C:2019:721, paragraphs 29 to 31 and 50, and judgment of 11 June 2020, *Brompton Bicycle*, C-833/18, EU:C:2020:461, paragraphs 23 to 26 and 37).
- 10 In the view of the Patent- och marknadsöverdomstolen, however, it is not clear how the Court of Justice's rulings regarding the originality of a work – that the subject-matter give expression to the author's free and creative choices – should be interpreted and applied. More specifically, there is definitely still unclarity as to how the concrete assessment should be conducted – and which factors must or should be taken into account – in 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.

- 11 One interpretation, on the one hand, could be that it is sufficient that the author have had scope and have in fact made different kinds of choices in the creation of the subject-matter, that those choices not be dictated by technical considerations, rules or constraints, and that the choices be somehow reflected and expressed in the subject-matter. Such a broad interpretation would thus mean in practice that the starting point of the assessment is the creative process itself and the choices that the author has made in that process. It would also mean that, in principle, all the choices made by the author in the creative process that are not dictated by technical considerations, rules or constraints would be considered free and creative.
- 12 Such an interpretation, based on the actual choices that the author has made in the creation of the subject-matter, could mean that the court’s examination of originality focuses on the creative process and that the author has made choices in that process, rather than whether the subject-matter itself – or the end result of the creative process – actually gives expression to an artistic effort. The question whether the subject-matter displays sufficient originality would thereby become a matter of evidence rather than a matter of law.
- 13 If the interpretation of the originality requirement were limited in that way, it would probably mean that relatively low requirements would be placed on the creative and free choices that the author needs to have made and to which a subject-matter of applied art must give expression. That, in turn, would risk leading to even subject-matter which might not merit classification as works being granted copyright protection. Furthermore, it could lead to simple subject-matter which has not been created with an artistic purpose in the first place – or in any event do not possess individual artistic character – being protected as works.
- 14 If relatively simple subject-matter, which can in many cases still be of high commercial value, were to receive the generous protection offered by copyright, there would be a risk of negative consequences for competition and innovation. A low requirement on originality would also risk reducing compliance with copyright as such.
- 15 A further consequence of a low originality requirement for subject-matter of applied art is that it would risk undermining the importance of the less generous protection for designs. In that respect, the question might also be asked how a low requirement of originality for subject-matter of applied art would relate to the requirement of individual character required to obtain protection for designs. Although copyright and design law have different objectives, it does not appear to be a reasonable and desirable arrangement for a design to be eligible for copyright protection as a work when it is not sufficiently individual to receive protection as a design. As the Court of Justice has held, although the protection of designs and the protection associated with copyright may be granted cumulatively to the same

subject-matter of applied art, that concurrent protection can be envisaged only in certain situations (see judgment in *Cofemel*, paragraph 52). An originality requirement that was set too low, however, would instead risk leading to subject-matter of applied art being able to receive dual protection in the majority of cases. In such circumstances, which function design protection should perform within EU law may be questioned.

- 16 Another interpretation, on the other hand, could be that the starting point of assessment as to whether the subject-matter of applied art reflects the personality of the author, by giving expression to his or her free and creative choices, should be the work itself; the subject-matter itself must reflect the author's personality and exhibit a degree of artistry or possess what has been referred to – at least in the past – as 'originality' in Sweden and Germany, among others. An assessment according to that interpretation could mean that the subject-matter must have a certain individual character and be somewhat unique. Or, to put it another way, it must be a subject-matter which has risen to a certain degree of independence and originality and which gives expression to the author's individuality.
- 17 In such an assessment, the focus would thus be on whether the subject-matter of applied art itself gave expression to some form of artistic effect. The starting point of the assessment of whether the subject-matter should be protected is therefore the subject-matter itself and not the author's creative process and the choices that he or she actually made in the creation of the work. The question should be whether the subject-matter itself is an artistic achievement and gives expression to an artistic effort.
- 18 In such an assessment – in particular where subject-matter of applied art is concerned – the person claiming an exclusive right might need to explain – and possibly also provide evidence of – the ways in which the subject-matter expresses an artistic effort. In clear-cut cases, where those elements may be discerned simply by looking at the subject-matter, the situation may however be such that no clarification or evidence is needed at all.
- 19 It may also be discussed whether, in such an assessment, there is scope to apply some kind of auxiliary rule. For example, the question may be asked whether it is significant for the assessment that identical or similar subject-matter have been created before or – independently and without knowledge of the subject-matter – after the subject-matter in question was created. To illustrate this, it may be noted that in Swedish law – in the past at least – a so-called 'duplication criterion' has been applied. That criterion meant that if a subject-matter could be the subject of an independent duplication, it did not satisfy the requirement of originality. However, the criterion in itself did not answer the question of whether the originality requirement was satisfied.
- 20 In the assessment of a subject-matter's originality, it may also be discussed what is the significance of the fact that the subject-matter of applied art consists of elements found in common designs or that the subject-matter builds on and

constitutes a simple variation of earlier known models. In the view of the Patent- och marknadsöverdomstolen, there should per se be no obstacle to protecting, as a work, a subject-matter of applied art which consists of elements from common designs. In order to obtain copyright protection, the decisive factor should instead be the fact that those design elements have been used and combined in such a way that the end result merits copyright protection as a work of art. Where subject-matter of applied art is concerned, however, the scope for artistic creativity based on known design elements is often more limited. Accordingly, simple variations of earlier known models as a starting point can hardly give expression to the kind of artistic effort required for the subject-matter to be afforded protection as a work.

The question whether a work of applied art infringes the exclusive right to the work

- 21 A question has arisen in this case as to how the examination should be carried out in the assessment of whether an allegedly infringing subject-matter is covered by – and infringes – the exclusive right to the work which is to be conferred on the author under Articles 2 to 4 of Directive 2001/29/EC. Essentially, the question is how the assessment of similarity between the work and the allegedly infringing subject-matter should be carried out and which similarity is required in order for the allegedly infringing subject-matter to be regarded as infringing the work.
- 22 The Court of Justice has ruled that Article 2(c) of Directive 2001/29 must be interpreted as meaning that the phonogram producer's exclusive right under that provision to reproduce and distribute his or her phonogram allows him or her to prevent another person from taking a sound sample, even if very short, of his or her phonogram for the purposes of including that sample in another phonogram, unless that sample is included in the phonogram in a modified form unrecognisable to the ear (see judgment of 29 July 2019, *Pelham and Others*, C-476/17, EU:C:2019:624, paragraph 39).
- 23 On the basis of the Court's ruling in the judgment in *Pelham and Others*, one might understand that what must be examined is whether the work is recognisable in the allegedly infringing subject-matter in order for an infringement of the exclusive right to the work which the author must have pursuant Articles 2 to 4 of Directive 2001/29/EC to be deemed to exist. Should that be the case, questions arise as to how the assessment should be conducted and what exactly is required for the work to be recognisable in the allegedly infringing subject-matter. If, on the contrary, the examination is not to focus on whether the work is recognisable in the allegedly infringing subject-matter, the question instead becomes whether what is to be examined is whether or not the subject-matter creates a different overall impression from the work or what else the examination should focus on.
- 24 A comparison can also be made in this context with what applies in other areas of intellectual property law. The decisive factor in the case of alleged infringement of a Community design is whether the allegedly infringing design produces – or

does not produce – a different overall impression (see Article 10(1) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs). As regards trade marks, it is instead that the likelihood of confusion on the part of the public must be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, for example, the judgment of 22 June 1999, *Lloyd Schuhfabrik Meyer*, C-342/97, EU:C:1999:323, paragraph 18). In that regard, it should be noted that the relevant legal acts are worded differently as regards the scope of the respective exclusive rights.

- 25 As regards the scope of protection for a work, the Court of Justice has ruled that the protection conferred by Article 2 of Directive 2001/29 must be given a broad interpretation (judgment of 16 July 2009, *Infopaq International*, C-5/08, EU:C:2009:465, paragraphs 40 to 43). Furthermore, the Court has held that nothing in Directive 2001/29 supports the view that the extent of protection should depend on possible differences in the degree of creative freedom in the production of various categories of works (see judgment of 1 December 2011, *Painer*, C-145/10, EU:C:2011:798, paragraph 97). The Court has added that the extent of the protection does not depend on the degree of creative freedom exercised by its author, and that that protection is therefore not inferior to that to which any work is entitled (see judgment in *Cofemel*, paragraph 35). It is not clear from those judgments, however, whether the Court's rulings relate to the significance of originality to the scope of protection for the work or, as the Patent- och marknadsöverdomstolen understands it, constitute a finding that copyright works of different kinds – photographic works, works of applied art and other kinds of works – should be assessed and protected in the same way.
- 26 In other areas of intellectual property law, it has been clearly stated that distinctiveness or individual character has significance for the scope of protection. For example, the Court has stated that the more distinctive the trade mark, the greater will be the likelihood of confusion (see, for example, judgment of 11 November 1997, *SABEL v Puma, Rudolf Dassler Sport*, C-251/95, EU:C:1997:528, paragraph 24, and judgment of 22 June 1999, *Lloyd Schuhfabrik Meyer*, C-342/97, EU:C:1999:323, paragraph 20). Furthermore, Article 10 of the Regulation on Community designs provides that, in assessing the scope of protection, the degree of freedom of the designer in developing his design is to be taken into consideration. Under Article 6, the same factor is to be taken into consideration in assessing the individual character of a design. The question is whether this approach – the link between distinctiveness or individual character, on the one hand, and the scope of protection, on the other – applies in the same way to copyright matters as regards the originality of a work and the scope of protection afforded to it.
- 27 An arrangement where the degree of originality has significance for the scope of protection appears, in the view of the Patent- och marknadsöverdomstolen, to be appropriate. The more original – or unique and artistically individual – a work is, the greater the scope of protection the work should have.

- 28 In the assessment of the scope of protection for a work, also, the question arises as to what significance has the fact that other similar subject-matter of applied art were created before or – independently and without knowledge of the work – after the creation of the work.
- 29 In the same manner as for the assessment of whether a subject-matter of applied art merits protection as a work, the question can also be asked what is the significance that the assessment of the infringement and the assessment of the scope of protection of the fact that the work and the allegedly infringing subject-matter consist of elements found in common designs or are based on and constitute simple variations of earlier designs or an ongoing design trend.

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