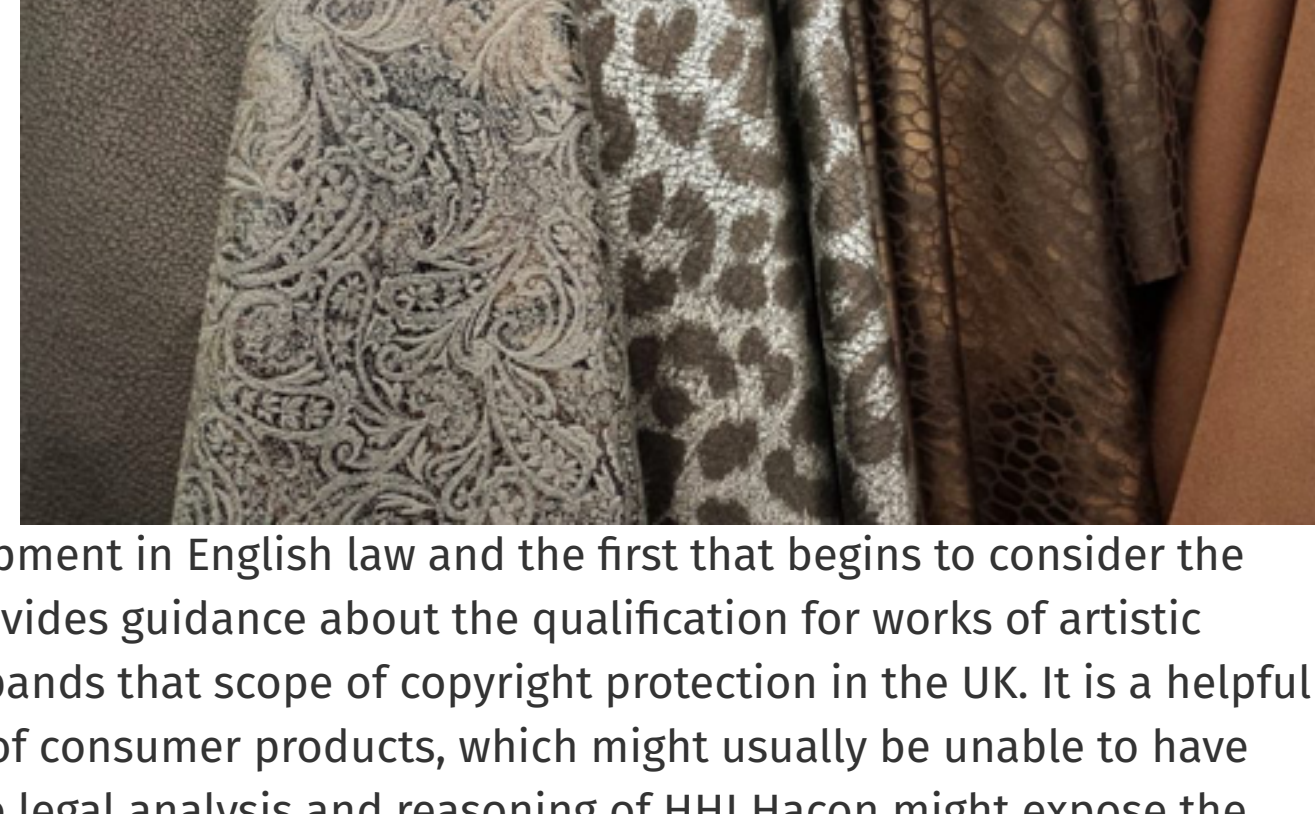


CASE LAW, INFRINGEMENT, ORIGINALITY, SUBJECT MATTER (COPYRIGHTABLE), UNITED KINGDOM

Fabrics can be works of artistic craftsmanship in the UK: Response Clothing Ltd v The Edinburgh Woollen Mill Ltd

Jeremy Blum, Marc Linsner (Bristows LLP) / February 10, 2020 / Leave a comment

In Response Clothing Ltd v The Edinburgh Woollen Mill Ltd [2020] EWHC 148, His Honour Judge Hacon ("HHJ Hacon") found that copyright subsisted in a fabric design as a work of artistic craftsmanship and that the sale of garments made from such fabric amounted to copyright infringement.



The case is an interesting development in English law and the first that begins to consider the CJEU's Cofemel decision. It provides guidance about the qualification for works of artistic craftsmanship and seemingly expands that scope of copyright protection in the UK.

Facts & Background:

The claimant, Response, is a clothing company involved in the design and marketing of clothing products. The defendant, EWM, is a major retailer of clothing with about 400 stores across the UK.

Between 2009 and 2012, Response supplied EWM with ladies' tops made of a jacquard fabric with a design referred to as a 'wave arrangement' (the "Wave Fabric"). In 2012, Response attempted to raise the price of the tops, but EWM rejected the price increase and sought alternative suppliers.

Response issued infringement proceedings claiming that copyright subsisted in the Wave Fabric as an artistic work (under s.4 of the Copyright, Designs and Patents Act 1988 ("CDPA 1998") either as (a) a graphic work; or (b) a work of artistic craftsmanship.

It is important to understand the only way to enforce copyright in certain types of consumer products is if they qualify as artistic works such as works of artistic craftsmanship. If they do not, then section 51 of the CDPA prevents the copyright in those products being enforced against copies and the owner will instead have to rely on the unregistered design right (if possible) which has a shorter term.

Findings of HHJ Hacon:

1. The fabric as a graphic work

According to HHJ Hacon, all the examples of graphic works set out under the CDPA 1988 "are created by the author making marks on a substrate to generate an image". Despite recognising that the examples in the statutory definition are not exhaustive, HHJ Hacon adopted a narrow interpretation of the statutory language noting that "[i]t does not follow that the definition is endlessly flexible".

2. The fabric as a work of artistic craftsmanship

Having concluded that the Wave Fabric was not protectable as a graphic work, HHJ Hacon moved to consider if the Wave Fabric qualified as a work of artistic craftsmanship. After a fairly extensive analysis of the House of Lords judgments in Hensher[1], HHJ Hacon felt unable to discern any binding principles on the meaning of artistic craftsmanship; instead he adopted the test framed by Tipping J in the High Court of New Zealand decision of Bonz Group (Pty) Ltd v Cooke[2].

Adopting the approach of Tipping J in Bonz, HHJ Hacon explained that in order to qualify as a work of artistic craftsmanship it would be necessary to show Wave Fabric was (a) a work of craftsmanship in the sense that the creation of the fabric required skilful workmanship; and (b) artistic in the sense that it was produced with creative ability that produced aesthetic appeal. On the facts, HHJ Hacon was satisfied that the creation of the Wave Fabric involved the necessary craftsmanship and that the commercial success of the design illustrated the required aesthetic appeal.

After finding that the Wave Fabric qualified for protection as a work of artistic craftsmanship, the judge provided the following guidance on the definition of artistic craftsmanship:

- it is possible for a work of artistic craftsmanship to be made using a machine;
aesthetic appeal can be of a nature which causes the work to appeal to potential customers; and
a work is not precluded from being a work of artistic craftsmanship solely because multiple copies of it are subsequently made and marketed.

3. Infringement

Having concluded that copyright subsisted in the Wave Fabric, HHJ Hacon went on to find that the other jacquard fabrics used for the garments sold by EWM copied a substantial part of the Wave Fabric design, therefore EWM's sales of tops made from those infringing fabrics amounted to secondary infringement contrary to s.23 of the CDPA 1988.

Comment

HHJ Hacon provides some useful guidance on what is required for a work to qualify as artistic craftsmanship. The guidance given by HHJ Hacon appears to have watered down the ostensible requirements of "artistic appeal" and "craftsmanship" which may be welcomed by a host of industries as a considerable expansion in the scope of copyright protection.

The judge's finding on graphic work

According to HHJ Hacon the statutory definition of "graphic work" could not extend to include a fabric design. There is a tension between the judge's narrow interpretation of the statutory language and focus on the medium which captures the work on one hand, and the judgment of Birss J in Abraham Moon on the other.

HHJ Hacon later refers to the Levola Hengelo decision and quotes a passage of that judgment which expressly refers to Art.2(1) of the Berne Convention which provides for the protection of artistic works "whatever the mode or form of its expression".

The application of Cofemel - requirement for aesthetic appeal

The decision in Response is the first English court decision to 'consider' the implications of the CJEU decision in Cofemel. In Cofemel the CJEU reaffirmed that originality is the only qualifying criteria for copyright protection under Article 2(a) of the InfoSoc Directive and any national laws which make copyright protection contingent on artistic value are incompatible with the InfoSoc Directive.

The facts in Response seemed to provide a prime opportunity for HHJ Hacon to grapple with the compatibility of national law post-Response. However, on the facts of the case, he found that the Wave Fabric had aesthetic appeal. In other words, he was not faced with the question of whether a design without aesthetic appeal could qualify as a work of artistic craftsmanship post-Cofemel.

HHJ Hacon expressly recognised that "[c]omplete conformity with art.2, in particular as interpreted by the CJEU in Cofemel, would exclude any requirement that the Wave Fabric has aesthetic appeal and thus would be inconsistent with the definition of work of artistic craftsmanship stated in Bonz Group".

We now have a High Court decision with an express acceptance that Cofemel precludes any requirement for a work to have aesthetic appeal whilst applying that very test to determine if copyright subsists in a work of artistic craftsmanship.

The application of Cofemel - closed categories of protectable subject matter

Post-Cofemel, if the only criteria for copyright protection to arise is originality, there is an implication that exhaustive lists of protectable subject matter, such as that contained in the CDPA, are also incompatible with EU law. Again, this issue was not addressed by HHJ Hacon in Response.

Post-Response, it is unclear why the judge placed so much weight on the medium of the Wave Fabric. Had HHJ Hacon followed Abraham Moon and Levola Hengelo and not focused on the fabric as the medium for the work, he may well have reached a different conclusion on whether the Wave Fabric constituted a graphic work.

Again, it will be interesting to see how the English Court deals with this aspect of English copyright law following Cofemel. For the time being the English courts are technically bound by the decision, but post-Brexit this may be one of the first areas where we see UK copyright protection diverge from the position in the EU.

[1] George Hensher Ltd v Restawile Upholstery (Lancs) Ltd [1976] AC 64

[2] [1994] 3 N.Z.L.R. 216

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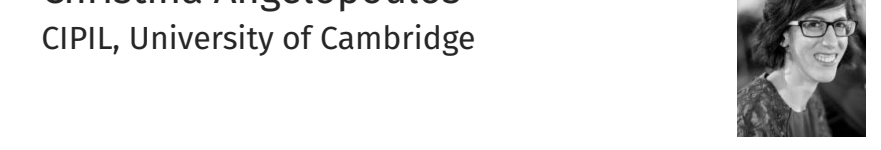
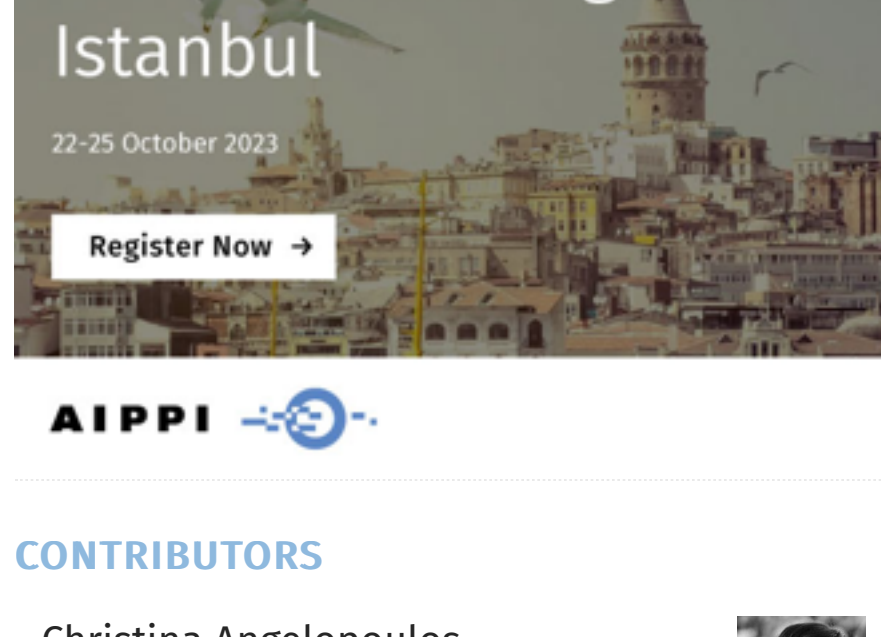
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