INTELLECTUAL PROPERTY - SPAIN

Copyright protection: impact of recent ECJ decision on Spanish legal framework

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Introduction

The European Court of Justice's (ECJ's) 12 September 2019 judgment in *Cofemel-Sociedade de Vestuário, SA v G-Star Raw*(1) is good news for EU designers, as it confirms what has already been stated by some Spanish courts – namely, that a design need not have artistic merit, aesthetic value or a particular visual attraction to qualify for copyright protection.

Although the ECJ's judgment was issued in response to a preliminary ruling by the Portuguese courts, it will undoubtedly have clear and direct consequences throughout the European Union. This article examines the decision in view of the Spanish legal framework.

ECJ decision

The Portuguese Supreme Court asked the ECJ whether – in light of the latter's interpretation of the EU Copyright Directive (2001/29/EC) in *Infopaq International*(2) and *Painer*(3):

- the protection afforded by copyright extends to these kinds of work (ie, works of applied art, designs and models) in the same way as to literary and artistic works and therefore on the condition that they have the quality of originals, in the sense of being the result of their author's own intellectual creation; or
- it is possible to subject the recognition of that protection to the existence of a specific level of aesthetic or artistic value.

After confirming that design and copyright protection are cumulative, the ECJ held that such cumulative protection can be afforded only in certain situations. Further, it clarified that the fact that a design generates an aesthetic effect does not justify classifying it as a 'work' within the meaning of the EU Copyright Directive. Therefore, the ECJ held that Article 2(a) of the EU Copyright Directive must be interpreted as precluding national legislation from conferring copyright protection on works such as the items of clothing in question in view of the fact that, beyond their practical purpose, they have a visual effect which is aesthetically significant.

Spanish legal framework

The possibility of combining industrial design and copyright protection for the same intangible asset is recognised at the EU level in both Article 17 of the EU Designs Directive (98/71/EC) and Article 96(2) of the EU Community Designs Regulation (6/2002). Thus, EU legislation is clearly in favour of cumulative protection. However, the abovementioned articles also allow EU member states to determine the scope and conditions under which such protection will be granted, including the level of originality required.

In Spain, Article 3.2 of Royal Legislative Decree 1/1996 – which approved the consolidated text of the Copyright Act – expressly contemplates the possibility of simultaneously applying copyright and "industrial property rights that may exist over [a] work". Further, under Article 10(1)(e) of the Copyright Act, visual works – regardless of whether they are applied – are included among the list of original creations covered by intellectual property.

However, from the Explanatory Memorandum (Section II) and the 10th Additional Provision of Law 20/2003 on the Legal Protection of Industrial Designs, it could be understood that in order to enjoy the protection afforded by intellectual property, a design must be original and especially creative. This regulatory situation has led to controversy as to the level of creativity that industrial designs

must enjoy to qualify for copyright protection.

In a 15 September 2017 decision, Section 28 of the Madrid Court of Appeal – which is specialised in IP matters – recognised that a bag can be an original creation worthy of copyright protection not only as a design which differs from others in existence at the time of conception, but also as an expression of the designer's personality. In this judgment, the court argued that the criteria of 'creative height' does not require a work to have a certain artistic quality, but rather a level of originality that makes it distinguishable from other works.

Thus, the Madrid Court of Appeal adhered to the harmonised concept of originality emanating from the EU directives on the protection of photos, computer programs and databases and expressly accepted the relevant ECJ case law (ie, *Infopaq International*, *BSA*(4) and *Painer*). Therefore, the judgment (which is now final) concluded that a creation of industrial form which falls outside the scope of the traditional concept of an artistic work deserves copyright protection in accordance with the harmonised concept of originality, which applies to other visual works.

However, it must be recognised that in contrast to this accurate line of Spanish case law, another part of the doctrine has tended to require a qualified level of creativity and artistic value of formal creations which aspire to copyright protection in addition to the special protection conferred by industrial design regulations. This duality of interpretations derives from the fact that neither the Copyright Act nor the Design Act specifies the level of originality that a given design must have in order to be protected by copyright, just as with other regulations in other EU countries. This is why the ECJ's 12 September 2019 judgment, which interprets Article 2(a) of the EU Copyright Directive, is of particular importance in Spain.

Comment

The ECJ has advocated moving away from examining the aesthetic value of a work of applied art. This decision is an important step towards harmonising the level of originality that a creation must have in order to qualify for copyright protection, which will have binding consequences throughout the European Union, including in Spain.

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Endnotes

(1) Case C-683/17, EU:C:2019:721, 12 September, 2019.

(2) C-5/08, EU:C:2009:465, 16 July 2009.

(3) C-145/10, EU:C:2011:798, 1 December 2011.

(4) C-393/09, EU:C:2010:816, 22 December 2010.

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