

CASE LAW SECTION

ACCESS TO COPYRIGHT PROTECTION

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The definition of an intellectual work is not clearly stated in the Intellectual Property Code. Yet it is admitted in both legal writing and case law that an intellectual work is the creation of an original form. This does not lead to any certainties, however.

Both conditions of form and originality can be challenged, not to mention that both may be hard to isolate and proof of originality can sometimes be a real challenge...

Finally, the fragile predictability of solutions relative to access to protection may be contested by applying rules of private international law.

I. REQUIREMENT OF (AN ORIGINAL) FORM

Reproducing an audiovisual scenography cannot be considered to be infringement of an intellectual work, if the work cannot be characterised. Conversely, by placing himself in his predecessor's wake and generating confusion, the acquirer is guilty of acts of parasitism.

Immersive artistic experience, whether indoors or in natural outdoor sites, has become common practice. Consequently, its success raises the question of protectability. Quite naturally, this concerns authors' rights — though not always successfully, as in the ruling of the **First Civil Chamber of the Court of Cassation on 31 January 2018**¹.

In this case, Albert Plécy, a journalist fascinated by images, was the first to undertake the project of transforming a stone quarry into a venue for showing images. In 1975, he transformed abandoned quarries at Les Baux-de-Provence into an immense 'Cathedral of Images', plunging spectators into an immersive experience, bathed in images projected on the ground and walls of these colossal quarries. To this end, he had founded Cathédrale d'Images, a company with a commercial lease granted by the municipality of Les Baux-

1. Cass. 1st civ., 31 Jan. 2018, no. 15-28.352, Ph. Mouron, "Le concept de la cathédrale d'images au regard du droit d'auteur," *D. IP/IT* 2018, p. 425; L. Larrieu, "Du parasite dans le son et lumière," *Prop. industr.* 2018, June 2018, comm. 42

de-Provence until 2011 when, following a call for tender, the Culturespaces Company took over and pursued the activity under public service contract.

This gave rise to a thorny dispute, leading to a decision by the *Conseil d'État* on 15 February 2016², which ruled that the quarries could not be considered as being in the public domain. Another decision that draws our attention here was rendered by the Court of Cassation on 31 January 2018, opposing the two companies, the former accusing the latter of engaging in exactly the same activity as theirs.

Two questions were submitted to the high magistrates: Is reproduction of the show an infringement? If not, is it an act of parasitism? The plaintiffs failed regarding infringement, since the judges rejected the presence of an original form; but their action, immaterial for the criteria for access to copyright, was admitted for parasitism.

1. Presence (or not) of an original form: alleged infringement

First, Cathédrale d'Images accused Culturespaces of unauthorised reproduction of their show, which constitutes infringement, but this required the capacity for the work to be qualified. This entailed two approaches: the first concerns the very principle of projecting such images; the second concerns the scenography.

2. CE, 8th and 3rd ss.-sect. réun., 15 Feb. 2016, no. 384228, Lebon; *AJDA* 2016. 347; *RDI* 2016. 472, chron. N. Foulquier; *AJCT* 2016. 331, obs. P. Noual; *JCP A* 27 June 2016, p. 37, note H. Pauliat

The first argument in support of the infringing action tends to qualify the **artistic process** itself as a work, *i.e.*, according to the terms of the appeal, “*misappropriation by [the artist, then his grandson who took over the exploitation after his wife,] of an old abandoned quarry to create an audiovisual scenography which takes spectators into total immersion in the images.*”

This opens the door to a forced notion of a ‘work’, an intellectual creation. And that is the allegation by the Court on request and which serves as the basis for rejecting this part of the plea:

“But given (...) that the ruling justly states that misappropriation of the quarries (...) to project reproductions of artistic works to immerse spectators in these images, is no more than the expression of an idea that, as such, cannot be eligible for copyright protection.”

The assertion is obvious and appears quite convincing. Both the Tribunal de Grande Instance and Court of Appeal of Paris³ in this case had also ruled in this way, yet the assertion probably deserved some nuance, since the result could have shifted to the opposite conclusion.

True, according to Henri Desbois’s now famous formula, “*ideas range freely by essence and by destination*” (*les idées sont par essence et par destination de libre parcours*). The condition for freedom of expression and freedom of creation, preservation of the common heritage of mankind in which all

3. CA Paris, pôle 5, 1st ch., 1 Dec. 2015, no. 14/14179, JurisData no. 2015-027121; *LEPI* 2016, no. 38, obs. A. Lebois; *Propri. intell.*, no. 59, April 2016, p. 213, obs. J.-M. Bruguière.

creators find inspiration is inherent to the existence of a monopoly. It is because authors' rights do not encroach on ideas that this reservation may be justified.

In fact, the appeal sought to reserve the concept of entertainment Albert Plécy had set up and meticulously described in one of his books, aiming “*to integrate spectators within the images projected on natural floors and walls.*” To this end, it emphasised “*Albert Plécy’s choice of abandoned quarries to create a complete show on the theme in 1977 of the Passion of Christ*” (underscoring ours). It then shifted from the intellectual creation, and thus the idea/form boundary, to the condition of originality. Are such ‘choices’ sufficient to obtain the qualification sought? Are they creative enough to be original? Internal case law was able to support this. In 2013, for *La Route du Rhum* sailing race, the Court of Cassation admitted protection of the ‘*original implementation*’ of a competition “*as a sporting activity and live performance work*”⁴.

Furthermore, in more recent case law from the Court of Justice of the European Union, it appears that choices should aim to support qualification of the condition of originality.

Above all, it is useful to recall the method used by the Court, which may seem open to criticism: relying on three special directives defining the notion of work, the Court inferred, on the basis of what they consider as ‘*Common*

4. Cass. com., 8 Oct. 2013, no. 11-27.516; JurisData no. 2013-022172; *Comm. com. électr.* 2013, comm. 121, note C. Caron

Law' copyright, *i.e.*, Directive 2001/29, a '*horizontal*' definition of work as '*the author's own intellectual creation*'.

It is then hard to understand the relevance of this notion of choice⁵. Indeed, in the *Eva-Maria Painer* case⁶, the Court of Justice asserted that "*an intellectual creation is an author's own if it reflects the author's personality*," and continued by indicating that "*the author of a portrait photograph can stamp the work created with his 'personal touch'*" by making 'free and creative choices'⁷. Here, this means that authors' freedom enables him to make creative choices that leave the stamp of his personality on the work. Similarly, in the *SAS Institute* case of 2 May 2012⁸, the European judges made reference to '*creative spirit*', considering that "*it is only through the choice, sequence and combination of those words, figures or mathematical concepts that the author may express his creativity in an original manner and achieve a result which is an intellectual creation.*"

Thus, choice is clearly the sign of the author's arbitrariness⁹, thereby expressing his personality. But such is not always the case: the choices made may, however, sometimes be insufficient to reveal the author's personality. Thus, regarding Football League fixture lists, the Court of Justice asserts that "*the significant labour and skill required for setting up that database cannot as such justify such a protection if they do not express any originality in the selection*

5. For this, see C. Bernault, *JCl Propriété littéraire et artistique*, fasc.1135, no. 44

6. CJEU, 1 Dec. 2011, aff. C-145/10, pt 88

7. *Ibid.*, pts 90 and 92

8. CJEU, 2 May 2012, *SAS Institute Inc.*, aff. C-406/10, pt 67

9. A. Lucas and P. Sirinelli, "L'originalité en droit d'auteur," *JCP G* 1993, I, 3681

or arrangement of the data which that database contains”¹⁰. As Professor Valérie-Laure Benabou noted, “the notion of choice is then no longer a sign of creative arbitrariness, but rather the exercise of a process of selection from data or expertise in their arrangement” closer to a “purely accounting dimension of originality”¹¹.

Returning to the condition of form, the Court of Cassation asserted that ‘misappropriation’ — with images projected on quarry walls — is only the ‘expression of an idea’, not reservable as such. The formulation is probably awkward. If the idea is actually expressed, as noted by the Court, it can be thought that it left the world of abstraction to enter the world of form. In fact, it is a matter of considering that the idea of projecting images is not protectable, like the idea of wrapping objects in Land Art¹².

Yet, some ‘misappropriation’ has given rise to authors’ rights. For example, posting the word ‘Paradis’ above the door to the toilets in a former hospital dormitory for alcoholics. In fact, even if this misappropriation is a stroke of genius, it is the form in which it is materialised that is protected. This is the meaning of the decision of the Court of Cassation in this case, which takes care to note that “the disputed work does not consist of a simple reproduction of the term ‘Paradise,’ but in writing the word in golden letters with a patina effect

10. CJEU, 1 March 2012, *Football Dataco Ltd*, aff. C-604/10, pt 46

11. V.-L. Benabou, “L’originalité, un Janus juridique. Regards sur la naissance d’une notion autonome dans le droit de l’Union,” in *Mélanges A. Lucas*, LexisNexis, 2014, p. 17, spéc. p. 23. – Adde V.-L. Benabou, “La qualification de l’œuvre de l’esprit à l’épreuve de la jurisprudence européenne : une notion harmonisée?” in A. Bensamoun, F. Labarthe and A. Tricoire (Dir.), *L’œuvre de l’esprit en question(s), Un exercice de qualification*, Mare & Martin, 2015, p. 225

12. See Christo case: Accueil de la protection: CA Paris, 13 March 1986, Christo, D. 1987, somm. p. 150, obs. C. Colombet; *Gaz. Pal.* 1986, 1, 238; then rejection for attempting to protect the idea of wrapping objects: TGI Paris, 26 May 1987, D. 1988, somm. p. 201, obs. C. Colombet

using a specific graphic design on a decrepit old door with a cross-shaped lock in a battered wall with the paint flaking off;” and “*this combination implies aesthetic choices expressing the author’s personality.*” Thus, the Regulatory Court approved the ruling in question for having thus “*revealed the fact that the artist’s conceptual approach, which consists of affixing a word in a specific place by altering its commonly accepted meaning, was formally expressed in an original material creation.*” (underscoring ours)¹³.

Thus, in this ruling, it is the result of misappropriation that could have been protected, the scenography — and this is the second argument supporting the infringing action. Yet, the judges did not comply with the request. Does this suggest, in this case, that the misappropriation was not formally expressed in an original material creation?

To reject the request for qualification of the **scenography**, the magistrates proceeded in two steps, opposing both the argument of proof and that of qualification.

Evidently, such scenography may be protected by authors’ rights, as is theatrical or cinematographic staging. Article L. 113-7 of the CPI actually makes the director one of the presumed co-authors of audiovisual works. Thus, the ‘director of sound and light’ for a Sound-and-Light show¹⁴ or the composer of lighting effects intended to reveal and highlight the Eiffel Tower’s

13. Cass. 1st civ., 13 Nov. 2008, no. 06-19.012; JurisData no. 2008-045778; *JCP G* 2008, II, 10204, note G. Loiseau; *Comm. com. électr. 2009*, comm. 1, note C. Caron.

14. CA Bourges, 1 June 1965, D. 1966, jurispr. p. 44, note H. Delpech

lines and shapes¹⁵ were considered to be authors of intellectual works. There again, choices had a role in the characterisation and obvious originality thanks to the combination of choices made¹⁶.

Thus, the appeal maintains in particular “*that the show presented in 1977 was divided into several chapters from the Passion of Christ,*” “*a plan mentioning the division into ten parts, representing chapters, images projected for the same show, as well as a drawing indicating that the images were projected on walls, ceilings and floors.*” True, we learned that the shows could change, but that certain immutable elements defined the scenography, thereby characterising an intellectual work according to the appeal.

This explanation was unconvincing, since the Court of Cassation again rejected the argument, considering that in the exercise of its sovereign power the Court of Appeal “*considered (...) that the characteristics claimed, taken together, although they reflected the work of transforming the former quarries to host audiovisual shows, thereby materialising Albert A...’s idea, remained nonetheless insufficient to establish that this scenography expressed an artistic process revealing its authors’ personality.*”

This goes back to the idea of choice: choices were made and expressed, but they remain ‘insufficient’ to characterise a work. This assertion must be clarified.

15. Cass. 1st civ., 3 March 1992, D. 1993, p. 358, note B. Edelman

16. See this for theatrical staging, CA Paris, pôle 5, 2nd ch., 9 Sept. 2011, no. 10/04678, *RLDI* 2011, no. 2537, B. Spitz

First, this idea of insufficiency refers to a kind of gradation in the formalisation of an idea¹⁷. Thus, between the ‘bare idea’¹⁸, which is non-appropriable, and form, protectable by authors’ rights, there is a ‘grey area’, within which distinctions are hard to make. Some ideas may thus be expressed, but the form selected is insufficient. How can this (in)sufficiency be justified? How can passing from a non-eligible form to a form eligible for protection be justified? This is where the shift between form and originality appears the most clearly. Justification of banality can often be found in case law, which inspired one legal author to note “*the confusion between substance and form: in fact, it is because the idea is commonplace that it is not protected — were it better presented, it would not be better regarded*”¹⁹.

But another identifying element can make form switch back to non-protection: technical constraints. Just as banality inhibits the efficacy of presentation, technical constraints prevent characterisation of the work, since they prevent the expression of personality.

Here, the trial judges considered that the choices made had been constrained more by the technique and the nature of the venue than arbitrary factors. Thus, form, the foundation of originality, is insufficient to establish such originality. We know that, by nature, purely functional forms are

17. For this, see Ph. Mouron, *op. cit.*

18. P.-Y. Gautier, *Propriété littéraire et artistique*, PUF, coll. Droit fondamental, 10^e éd., 2017, no. 38

19. P.-Y. Gautier, *Propriété littéraire et artistique*, *op. cit.*, no. 41. Comp. C. Caron, *Droit d’auteur et droits voisins*, LexisNexis, 5^e éd., 2017, no. 73. — Adde, on the subject, B. Edelman, “Création et banalité,” D. 1983, chron. 73

excluded from copyright protection²⁰. But, there again, there is a considerable grey area between exclusively functional forms, where form is dictated by function, and partially functional forms, where form is part of function. Here, it seems obvious that Albert Plécy was limited in his creation by the nature of the venue, which probably determined where to place the projectors. Yet, technical constraints should not block access to authors' rights, at the risk of excluding certain genres — thereby in breach of the principle of immateriality²¹ — like architecture, a constrained art if there ever was one. In the end, there again, it could be said that placement and choices, more generally, were 'commonplace' in view of the constraints. Similarly, the judges may have considered, regarding audiovisual capture of a concert, that "*the placement of several cameras in a room to film the stage from several angles with different focuses and the fact of filming from the pit as well as filming the audience to reproduce their reactions are simply standard practices for such events*"²².

In fact, banality and technical constraints are only two aspects of the same limitation, preventing the efficacy of form. So, Professor Pierre-Yves Gautier proposes selection as the 'real criterion' not the simple need for a form, but the precision of that form²³. Does this mean that greater precision of form would help determine originality?

20. On this matter, see C. Bernault, "La protection des formes fonctionnelles par la propriété intellectuelle," D. 2003, p. 957; F. Pollaud-Dulian, "Le mystère de la forme fonctionnelle," in *Mélanges Béguin*, LexisNexis, 2004, p. 657

21. Art. L. 112-1 CPI: *The provisions of this Code shall protect the rights of authors in all works of the mind, whatever their kind, form of expression, merit or purpose.*

22. CA Paris, pôle 5, 2nd ch., 3 Oct. 2014, no. 13/21736, *Propriété intellectuelle*. Jan. 2015, p. 43, obs. J.-M. Bruguière

23. P.-Y. Gautier, *op. cit.*, no. 42

Again, the problem shifts towards the matter of proof of originality, the subject of the second part of this article — the reason why we will just make a few remarks. We know the importance of the stakes, so much so that, in France, CSPLA (*Conseil Supérieur de la Propriété Littéraire et Artistique*), the Culture Ministry's consulting body, launched a mission in July 2018, entrusted to Josée-Anne Benazeraf²⁴ and Valérie Barthez, on this matter²⁵.

In this ruling, the judges assert “*that assessing the scope of the elements of proof with sovereign power in this debate, including the minutes of meetings, notes and plans drawn up in 1976, the Court of Appeal observed, on the basis of reasoned and well-founded grounds on the one hand, that they were such as to characterise the initial creative contribution of Albert A..., and on the other hand, that there was no mention making it possible to determine precisely subsequent characteristics invoked, relating to the visitors' itinerary, the sequence of images, choice of location of technical equipment and the surfaces on which the images are projected.*”

This shows that the probative failure bears both on quality and quantity, the elements reported having been insufficient to characterise originality.

If infringement proceedings fail, proceedings for parasitism will be receivable. Obviously, the requirement of an original form is then immaterial. On the contrary, its absence is often what justifies the route.

24. See J.-A. Benazeraf, “La qualification d’œuvre de l’esprit à l’épreuve du procès: *probatio diabolica?*,” in A. Bensamoun, F. Labarthe and A. Tricoire (dir.), *L’œuvre de l’esprit en question(s), Un exercice de qualification*, Mare & Martin, 2015, p. 189

25. See the letter of commitment: <http://www.culture.gouv.fr/Thematiques/Propriete-litteraire-and-artistique/Conseil-superieur-de-la-propriete-litteraire-and-artistique/Travaux/Missions/Mission-du-CSPLA-sur-la-preuve-de-l-originalite>

2. Immateriality of the original form: parasitic actions

Second, since the form submitted resisted authors' rights, the plaintiffs saw themselves as victims of parasitic acts resulting from the reproduction of the Cathedral of Images concept. More precisely, the Culturespaces Company was accused of having created ambiguity, by having "*intentionally placed in the wake of Cathédrale d'Images,*" "*maintaining confusion on its status of acquirer and new operator of Cathédrale d'Images shows, in order to draw profit of the shows' success and reputation.*" Thus, the Court of Appeal convicted the new operator for parasitism.

The latter, in his defence, insisted that, in the absence of private rights (due to failure to characterise the work), "*the reproduction of a show concept is not at fault in itself, unless it occurs in specific circumstances, contrary to fair trade practice;*" here, the search for savings contributed to free trade and competition. Then, the new operator maintains "*that know-how cannot be subject to unfair appropriation if it is not of confidential nature and is not specific to an enterprise.*" Finally, the company declares "*that parasitism implies demonstration of acts contrary to fair trade practice*" and "*that the creation of a risk of confusion cannot constitute an offence of unfair competition only on condition of resulting from unfair actions.*"

These arguments did not convince the Court of Cassation, which repeated the demonstration of the Court of Appeal. The new operator did indeed maintain ambiguity, placing himself intentionally and officially '*in continuity*' with previous programming, "*reproducing the concept of projecting images on quarry walls by immersing spectators,*" when he could have done

otherwise, given the generality of the call for tender. This ambiguity was further increased by use of the name 'Cathédrale d'Images' and new operator's communication.

Nor does the solution call for more comment, except to note that the judges evoke the risk of confusion created by parasitic actions, while the criterion is more characteristic of unfair competition²⁶.

What is more surprising is the method the Court of Appeal applied for calculating damages, "*regarding investments by the Cathédrale d'Images Company for over thirty years to ensure its shows' success and reputation.*" This method aims to redress the loss for the victim of parasitism rather than enrich the parasite.

Thus, form is the source of all conflict: conflict over boundaries with the idea, originality, conflicts of proof, etc. And in the absence of effective characterisation on the grounds of authors' rights, there remains the common law of parasitical acts on the basis of Article 1240 of the *Code Civil* (former 1382).

II. PROOF OF THE ORIGINALITY OF PHOTOGRAPHS

The originality of a series of works may be established by demonstrating the existence of shared characteristics expressing aesthetic bias.

26. See J. Larrieu, *op. cit.*

Access to copyright protection depends not only on demonstrating the existence of a form (see I, above), but also its precise contours and originality to establish the genuine object of the reservation claimed. Ordinarily, the task is not easy, but it is even more complicated when the work in question is not a simple Fine Arts creation, but a utilitarian work, or when the dispute bears on a considerable number of creations.

The ruling of the **Commercial Chamber of the Court of Cassation of 5 April 2018**²⁷ largely illustrates these difficulties even if it is excessive to consider that works in question — catalogues and photographs — raise as many queries as, for example, software for which it is often hard to detect the stamp of personality.

A photographer, M. B, and an auction house, Camard & Associés, considered that Artprice.com, which runs an online database created by digitising auction house catalogues, had infringed authors' rights by integrating their creations in the database, which they claimed to hold for the

27. Com., 5 April 2018, no. 13-21.001. The dispute was submitted to the Commercial Chamber for a trademark problem which will not be discussed here. The Court of Appeal considered: *“that the trademark is reproduced on the artprice.com website, in the same forms and for the same products, i.e., catalogue covers illustrating sales organised by Camard & Associés; that the purpose of such reproduction is to guarantee the products' provenance; that the essential function of the trademark is thus fulfilled; that, for a reproduction of the trademark, the risk of confusion has no incidence on the assessment of the infringement and that, to the extent posting their catalogues online infringes Camard & Associés's copyright for these catalogues, the reproduction of the trademark on the infringing catalogue covers was not done for information, but is also an act of infringement of this brand.”* This solution was censured by the Regulatory Court: *“By making this choice, without seeking, as they had been invited to do, if the owner of the brand's exclusive right had not been exhausted by the sale in the European Union of products bearing the trademark, the Court of Appeal deprived its decision of any legal basis.”*

The reasoning in the field of copyright is the result of a deliberation of the 1st Civil Chamber.

photographs and catalogues respectively. They filed a complaint against the latter for infringement and unfair competition²⁸.

On 26 June 2013, the Court of Appeal of Paris imposed sanctions for the infringement and for unauthorised reproduction of the catalogue and reproduction of the photographs without the rights holders consent.

The appeal formulated by Artprice accused the trial judges of not having characterised the originality of the disputed works.

Regarding the catalogues, the appeal deemed that the Court of Appeal had simply noted the existence of choices which, according to the defendant, had been made only on the basis of '*purely functional requirements*' linked to the need to provide clients with exhaustive information on the origin of the objects sold. In short, the judges did not explain how, "*beyond their functional aspect, the disputed catalogues bore the mark of their author's personality.*" The appeal added that originality could not "*be deduced solely from the observation that the realisation of the works had required arbitrary choices*" or the simple brutal assertion of the presence of a '*specific physiognomy*' distinguishing them from other works without characterising how they were marked by their author's personality.

This ground of appeal was rejected: "*But, since the ruling notes that each catalogue includes, in addition to a methodical systematic presentation of the lots,*

28. This case also reveals issues relating to Trademark Law. The ruling of the Regulatory Court would censure the trial judges' decision in this field.

short biographies of the works' authors and a description of each work, placing them in their historical, cultural or social context; adding that the catalogues of decorative art objects showed furniture in situ, with old photographs of places where they were on show, that the catalogues of posters had organised their presentation by motif, period, school or region, and the choice of the photograph of the object illustrating the cover which extended to the spine and on the back cover reflected genuine aesthetic pursuit; that the Court of Appeal had, thus, without contradiction, item 71b being made up of two catalogues, the Court of Appeals considered that these characteristics taken as a whole expressed an aesthetic bias marked by the personality of the catalogues' authors, legally justifying its decision."

Concerning the 8,779 (!) photographs reproduced, the appeal alleged that the Court of Appeal did not respect the principle that "*to determine the copyright-protectable nature of several works, the trial judges were held to search whether and how each work bore the stamp of its author's personality.*" According to the defendant company, the trial judges had undertaken "*an overall appraisal of the eight thousand seven hundred and seventy-nine photographs claimed by M. B whose originality was contested by the plaintiff, without undertaking a detailed examination, photograph by photograph, of their specific characteristics to determine how each one bore the stamp of its author's personality.*" Such reasoning would be devoid of any legal basis given Article L. 112-2 of the Intellectual Property Code. The trial judges were also rebuked for having deduced the originality of the author's choices "*to satisfy purely functional requirements or those reflecting know-how*" rather than explaining precisely "*how the disputed photographs would have borne a stamp of personality.*" The Court would then have ruled on the basis of inappropriate motives for characterising the

originality of these photographs and consequently violated Articles L. 111-1 and L. 112-2 of the Intellectual Property Code.

This ground of appeal was also rejected: “*But, given that the ruling notes that the photographic works considered here are characterised by aesthetic concerns in the positioning of each of the objects represented and, for some, by zooming in on a detail, or positioning several objects in the same photograph, in opposition or in complementarity with each other, in particular for furniture and sets of tables, thereby creating a ‘specific dynamic’; and adds that, similarly, the framing and angles for photographing objects, like furniture and home accessories, reflect arbitrary aesthetic choices, the objects having been photographed in a studio, some at an angle or at a distance, with special attention to contrasts of light and shadow, using a flash to cast shadows to highlight the object photographed as in the choice of special background gradients in the photographs; that the ruling states that M. B justifies specific post-production work using specialised software in order, precisely, to calibrate the colours and contrasts; that, proceeding with the examination of each photograph in question, without misrepresenting item no. 129, which included what was targeted by the third branch, the Court of Appeal thus identified the combination of characteristics common to these works, which expressed aesthetic bias marked by the author’s personality; that, for these reasons alone, legally justified its decision.*”

Summing up to the extreme these divergent points of view, it would be possible to say that, regarding these two series of works, the defendants objected mostly to the trial judges having taken an overall approach based on

the shared characteristics of the works concerned, rather than undertaking an individual search, case by case, creation after creation.

This reasoning is validated, however, by the Court of cassation.

This is not the first time the Regulatory Court ruled on this process. In a decision of 11 May 2017²⁹, the Civil Chamber of the Court of Cassation censured the reasoning, which it deemed insufficient, led by the trial judges who, all together, rejected protection for a series of action photographs of athletes taken in ‘burst mode’:

“Given that, to reject the requests of M. X..., the ruling, which observed that the disputed photographs represent players in either collective portraits, or individual portraits, some static, others in action, notes that, despite displaying genuine technical and aesthetic qualities, when a large number of them concern football players in rapid action, they were made, in particular, using ‘burst mode’, which requires no true choice by the photographer, that the choice of staging and no lighting since the players’ attitudes and behaviour and the natural and artificial light were not determined by M. X... himself, the framing and choice of shooting angles are partly due to chance and display no research bearing the stamp of the personality and sensibility of M. X..., who photographed football players and scenes of play, i.e., ordinary subjects, with no personal research, and, finally, the few changes he made

29. Civ.1st., 11 May 2017, no. 15-29.374; RIDA, no. 255 January 2018, p. 205, and our observations, p. 167ff; Communication Commerce électronique no. 7-8, July 2017, comm. 59, note C. Caron; Propriétés intellectuelles, July 2017, p. 55 obs. J.-M. Bruguière and C. Bernault

afterwards on the photographs improved them but do not bear the stamp of his personality;

That, by taking this position, without proceeding with a distinct comparison of the photographs with each other or assessing their respective originality, by regrouping them, if need be, according to their shared characteristics, the Court of Appeal did not give any legal basis for their decision” (underscoring ours).

In the case reported (for a reverse practical solution: originality admitted rather than denied) the pronouncement is even clearer regarding recourse to such a process. What can we make of this?

Traditionally, three questions arise regarding originality: What (what definition for originality)? Where (where does such originality lie; what precise form does it take)? Who (which of the litigants is responsible for giving proof of its existence)?

Here, the answers provided by the two jurisdictions seem to respect the principles regarding the first and third questions. Although we could be sensitive to the rebuke formulated by the appeal regarding taking into consideration a certain know-how, though this criterion is usually ineffective. But, for the most part, theorists of the subject find, in the statement of principles, what is usually expected for these points. Originality comes from the stamp of the personality of the work's creator revealed through arbitrary choices which leave their mark on the works created. This demonstration is the responsibility of the party invoking the benefit of protection.

Conversely, it is not certain that the process followed by each of the two jurisdictions is perfectly orthodox. It is classically asserted, and the appeal bears the trace of this principle, that research should be undertaken – case by case – for each of the creations concerned in the dispute. Even if the task were to be burdensome and lead to drafting conclusions on several hundred pages with equally wordy decisions... Neither the Court of Paris nor the Regulatory Court seem to respect this precept fully.

True, the argumentation followed by the judges here actually displays the trace of the deviant reasoning sometimes used and satisfied with a demonstration of the originality of the creator's *modus operandi* rather than seeking the characteristics of the works in question. Such reasoning, as we know, should be banned, since it is not a matter of answer the question 'How?' by studying the author's artistic process, but rather assessing the materialisation of the creative work in the resulting form. This is not the case here. The Court of Cassation specified that the judges worked by "*proceeding with the examination of each of the photographs in question.*" Thus, there is no confusion between upstream (creative process) and downstream (works created). Nonetheless, the shortcut used by the judges may not be fully convincing to justify their conclusions for admission to copyright protection.

True, as we said, the different works concerned were examined. This is absolutely indispensable since, to study the '*shared characteristics*', while avoiding to focus only on the process, there is necessarily a reason to examine each creation to determine gradually, on the basis of observation, correlation and categorisation. The reasoning is grounded first on a work-by-work

method to identify common features and regroup them. When this work of categorisation has been accomplished, the originality is sought in these shared characteristics, to deduce, in the event of a fruitful process determining the existence of a stamp of personality, that each work bearing this trace is consequently copyright protectable.

But, to hold such reasoning, (at least) three questions may be asked.

First, even if this process is accepted, is it certain that each of the photographs in question actually bears these shared characteristics? If such were the case, finding one or more common denominators should undoubtedly lead to selecting only general characteristics where we may have trouble finding some degree of originality. The truth required admitting that the description provided by the judges doubtless lead to highlighting certain technical characteristics or a *modus operandi* rather than particularly original traits.

Second, does not working on the shared characteristics not amount to virtual reasoning in terms of style? We all know that the latter is reputedly not copyright-protectable. There is no possibility of reserving a manner 'à la Vasarely or Mondrian', or a sound 'à la Pink Floyd'. We can object that the judges' view may be slightly different here, since their reasoning is developed on the basis of the form of the works in question. The repetition of certain characteristics is not necessarily seen as a style. There is an approach to the forms created which, in theory, should form the basis on which the judge builds his reasoning. But, even if the process is – perhaps – the reverse of what

is fulminated (style), we can observe that, on many occasions, the difference seems very slight.

The third question relates to the consequences to be drawn from such a process. Although originality lies in the shared characteristics, they are what may justify copyright protection. Hence, suffice it to observe the existence of these characteristics (or only some of them) in third-party works to deduce that they are necessarily infringing the former. Is this not too hasty an assumption? Beyond situations of servile reproduction, as is the case here, does this not entail expanding the field of reservation thus granted beyond what is reasonable?

Thus, we can measure the disadvantages of such a process. True, this reasoning undoubtedly help better fight against infringement and, more precisely, mass infringers. But is this argument sufficient?

Taking into consideration this aim to improve the fight against infringement and more precisely the concern with not seeing infringers escape the law because of the difficulty for plaintiffs to find proof, some legal specialists have explored or exposed other paths.

Professor Latreille has underscored the advantages and disadvantages in a summary³⁰ of some of these:

30. « La création photographique face au juge : entre confusion et raison », Legipresse, July 2010 p. 139ff., not. p.144

“First, the creator may limit the request to a few particularly significant snapshots. Proof becomes reasonable again, but compensation will be limited by definition and the infringer partially unpunished.

Second, the jurisdiction could proceed by sampling. In case of originality of excerpts, the entire collection would be presumed to be protected. Clearly, the choice should be random and sufficiently broad to be statistically representative. One or the other parties will inevitably criticise the relevance of the samples depending on the outcome of the dispute.

Third, it is possible to attribute the quality of work to the collection as a whole. This interesting solution entails establishing a common denominator for creativity to the ‘meta-work’ applicable to all the snapshots it contains.

Part of the doctrine is more daring, to the point of advocating the admission of presumption of originality³¹.

Professor Pierre-Yves Gautier, reasoning on precedence, wrote³²:

“Let us conclude this listing of means of defence by noting that, in compliance with the right of proof, the defendant/accused will be responsible for demonstrating the absence of originality or the existence of precedence.

31. See, for example, G. Vercken, “L’originalité vue par la pratique : vers une reconnaissance de précomptions généralisées d’originalité ?,” LPA, 6 December 2007, no. 244, pp. 17-24

32. *Propriété littéraire et artistique*, PUF, 10th edition, § 757 : “qui prouve quoi ?”

Thus, we can formulate a kind of presumption of originality, as is done, for example, by the Regulation du 12 December 2001 on Community designs (Article 85).

The contrary would amount to forcing the plaintiff to produce a second proof, in addition that, which he should obviously administer, of infringing similarities: that of the originality of one's own work, which is a separate issue. This could be a reversal of the burden of proof and considerable weakening of repression. Moreover, is this not the connotation of Article L. 111-1, which provides full protection?

We can further recall that the originality of the allegedly infringed work can be assessed on the day of its creation since this is the very moment when it is possible to set precedence, belonging in the public domain, etc.”

Trace of such presumption can sometimes be found, but it should also be emphasised that there is a movement of rejection in this regard in case law.

The trial judges have already accepted recourse to presumption of originality for photographs. The Court of Paris, in a case they decided on 9 June 2009³³ in a conflict with the Agence France-Presse (AFP) and some of its photographers with the development of an online platform of images offering subscribers the possibility of downloading photographs they wish to publish.

33. Paris, 22nd ch., sect. B, 9 June 2009, *AFP c/ P*: this revue, no. 226, Oct. 2010, p. 476 obs. P. Sirinelli; Rev. Lamy dr. immat. July 2009, no. 1671, p. 26, note M. Trézéguet ; Rev. Lamy dr. immat. Nov. 2009, no. 1803, p. 47, comm. N. Quoy and G. Corman, JCP E, no. 30, 29 July 2010, 1691 obs. M.-E. Laporte-Legeais, <http://www.legalis.net>

Reduced to arguing for the absence of originality of the mass of snapshots in question to avoid the grievance of infringement, the agency had to succumb. The photographers claimed it was for the defendant, *“who never contested the original nature of the photographs in this collection, to bring proof that they were not of the original nature presumed.”* This reasoning was taken up by the Parisian judges who considered that, *“by providing in employment contracts a copyright transfer clause, which they claim to enforce in all its generality, AFP considered that photographs by salaried authors benefitting from presumption of originality without distinction; that this presumption prevails since it bears, for most interested parties, on a few thousand photographs that became part of the AFP’s photographic collection, itself attached, vis-à-vis third parties, to defend the authors’ rights it draws from this clause, without distinction between the works; that the AFP’s way drawn from the absence of proof of originality of photographs, work by work, or their absence of production in the debate, is ineffective.”*

The difference in reasoning with the ruling of the Commercial Chamber commented here is obvious. It is not a shift in the evaluation of originality of the whole towards the single work (ruling de la Commercial Chamber), but clearly an assertion of the existence of presumption of originality drawn from the presence of a series of indications, in particular, taking into consideration of the AFP’s attitude for two reasons: in their relations upstream, *i.e.*, with authors through the signature of transfer contracts, and downstream, *i.e.*, with possible operators. The agency’s attitude demonstrated that they considered these works were protected and they changed their minds only because they had been in conflict with their photographers.

In the future, we can wonder about the incentive nature of such reasoning. Agencies having signed – unfortunately irregular – contracts with their authors will witness their attitude backfire on them regarding the status of these works because of their implicit admission. Though, this boomerang effect may seem brutal, conversely, we may be able to hope that this will convince agencies to be more attentive to respecting the formalism instituted by the Intellectual Property Code. There would be no half-measures: either their photographers are ignored, or the fate of their works is dealt with properly. Our preference goes to the second option.

Regardless, we can only take note of the existence of a presumption of originality.

But, even setting aside any theoretical issues raised by such a solution, there is good reason to consider some fundamental practical questions. First, how can we reverse the existence of such a presumption? If it is the defendant who bears the burden of proof of the absence of originality, we must observe, independently of the reversal of the burden of proof, which is questionable in the area of principles to be respected in case of legal action, that would put the defendant in a rather uncomfortable position since it is for him to demonstrate how the work is not original, while knowing nothing of the author's creative process so he will have difficulty determining precisely where the creator's personal contribution lies. There are traces of the condemnation of such a burden – *diabolica probatio* – in certain decisions.

The Court of Paris stated their position very clearly on this matter. In a ruling of 25 May 2012³⁴, the Parisian judges asserted:

“Indeed, in a time when the use of digital photographic devices has become widespread and commonplace, when most adjustments are made automatically without human intervention other than choice of subject and shutter release, demanding the plaintiff suing for infringement of a photograph provide a precise definition of what characterises the originality of his photograph and indicate where to find the stamp of his personality without transferring the burden of such proof to the jurisdictions concerned, since they can base their decisions only on the facts previously submitted and contradictorily argued.”

The rejection of such reasoning is not limited to snapshots anyone can take with virtually totally automatic cameras. This is unrelated to any reference to such a hypothesis that the Tribunal de Grande Instance of Paris estimated on 21 May 2015:

“If protection of an intellectual work is granted to its author without formality and solely through the creation of an original form in that it bears the stamp of its author’s personality and is not the simple reproduction of a non-appropriable common heritage, it is incumbent on the person claiming authors’ rights whose existence is challenged to define and clearly mark the contours of the alleged originality. Indeed, only the author, for whom the judge cannot substitute his failure, can ‘identify the elements expressing their

34. Paris, pôle 5, 25 May 2012, Propriétés intellectuelles, October 2012, p. 395, obs. A. Lucas

personality and justifying their monopoly and the principle of contradiction posed by Article 16 of the Code of Civil Procedure orders that the defendant may know precisely the underlying characteristics of the infringement imputed to them and bring proof incumbent on them of failure” (underscoring ours).

It was possible, however, to have it recognised that the existence of a presumption of originality would logically find its place, at least in a more limited manner, regarding works of Fine Art, because the probationary mechanism may, in a way, rest on what is usually the foundation of a presumption: *plerumque fit*. Presumptions are traditionally admitted as probationary shortcuts because they are based on likelihood. And it is true that, most often, a symphony, poem or painting bears the stamp of their creator’s personality³⁵.

But this observation which would justify a presumption also partly indicates its uselessness. First, because only rarely is the originality of such works challenged. Then, because, when this occurs, the plaintiff’s burden of proof is far from insuperable. Consequently, admitting a presumption in such a case may not be necessary. Independently of the grievance that may be formulated regarding the reasoning in terms of genre that would then be accepted³⁶ and the difficulty of determining the limit (or at least the criteria) between what is truly Fine Art and what does not fit into this category.

35. For this, see C. Caron, *Droits d’auteur et droits voisins*, LexisNexis, 5^e édition, § 100. The author observing, nonetheless, that in practice the issue is infrequently raised for this type of work.

36. See, nuanced in this matter, C Caron, *loc. cit.*

On reflection, it seems more difficult for the defendant to demonstrate the absence of originality than for the plaintiff to establish its presence. The presumption would be admissible — independently of the grievances presented above — only if the plaintiff were expected to designate precisely the object of the protection claimed (what forms are in question?) in order to enable the defendant to refute their protection for reasons of banality or precedence. This implies that it is accepted that the existence of originality simply results from the absence of these characteristics.

In short, we prefer the solution of current legal practice: when the originality is not contested, it is accepted, but when it is denied by the defendant, the burden of proof lies with the plaintiff. The violation of the principle does not go all the way to an unfair reversal of the burden of proof, but it must be admitted that, beyond the principles, there is also a constant tendency to question decisions that may enable some infringers to avoid sanctions because it was impossible for the plaintiff to bring proof of his personal stamp.

III. INTERNATIONAL PRIVATE LAW – PROTECTION IN FRANCE OF AN AMERICAN DESIGN AND MODEL

The determination of applicable law results from a conflict-of-law rule in Article 2.7 of the Berne Convention which requires the judge to examine the law of the country of origin — here, Copyright Law of the United States — to determine whether plaintiffs can benefit in France from the copyright protection claimed.

Confronted with a utilitarian object, US Copyright Law excludes its protection, except if the object comprises separable artistic elements that could not in themselves be considered to be pictorial, graphic, and sculptural works.

The issue of an intellectual work's access to protection may be even further complicated with the appearance of foreign elements, especially in the presence of issues relating to copyright and rights governing designs and models.

Such was the case submitted to the Court of Appeal **of Paris on 13 April 2018**³⁷. It concerned models of chairs and armchairs (known under the name 'Tulip') designed by the designer Eero Saarinen of Finnish origin but of American nationality. His fame was such that one of these creations is now on display in permanent collections of the New York Museum of Modern Art (MoMA). These creations also being utilitarian objects, the artist had transferred his exploitation rights to Knoll Inc. (hereinafter, 'Knoll'), which marketed reproductions. The Knoll Company discovered with dismay that the Mobilère & Technique d'Organisation Productive Company (hereinafter, 'MTO') had supplied identical models in response to a call for tender from the Amiens-Picardie Chamber of Commerce. The resemblance was not fortuitous, since MTO was only respecting the technical clauses in the specifications ordering the supply of 80 chairs "*similar or equivalent to Knoll's Tulip Ref armchair.*"

37. Cour d'appel de Paris, Pôle 5 – Chambre 2, 13 April 2018, no. 15/05833 : Propriétés intellectuelles, July 2018, p. 78, obs. A. Lucas

Knoll then proceeded with an infringement seizure on the premises of the Amiens-Picardie Chamber de Commerce and Industry to establish that MTOP had delivered to this establishment chairs they had obtained from the Italian Matrix International company (hereinafter, 'Matrix'). A bailiff's report on Matrix website also established that the company sold an armchair model with the Tulip armchair's original characteristics.

Knoll decided to engage the infringement liability of all these parties, but, although there could be no doubt on the matter of resemblance, the defendants considered they were above all reproach from the standpoint of intellectual property since, in their opinion, the works in question could not come under any protection.

Article 2.7 of the Berne Convention was introduced into the debate to determine what law applies in such a situation. According to this text: “(7) *Subject to the provisions of Article 7(4) of this Convention, it shall be a matter for legislation in the countries of the Union to determine the extent of the application of their laws to works of applied art and industrial designs and models, as well as the conditions under which such works, designs and models shall be protected. Works protected in the country of origin solely as designs and models shall be entitled in another country of the Union only to such special protection as is granted in that country to designs and models; however, if no such special protection is granted in that country, such works shall be protected as artistic works.*”

This provision abrogates the normal conventional rule of national treatment (provided for in Art 5[2]) in that it provides, for works of artistic

craftsmanship, what could be considered to be a rule of partial reciprocity. It is in fact the result of a compromise between countries (like France), which enforce the so-called ‘unity of art’ approach, also granting copyright protection to works of artistic craftsmanship — in addition to protection from the Law relating to Designs — and States (such as the United Kingdom) which limit protection of applied art to a specific system for designs and models³⁸.

Pursuant to Article 2.7, a French judge must first examine the access to copyright protection for the work of artistic craftsmanship in question in the country of origin (here, the United States of America). And if, in the country of origin, this work is excluded from the copyright law’s field of application, the work benefits only from protection of designs and models (‘design patents’, or even ‘utility patents’, invention patents *sensu stricto*), this judge could only enforce the special law relating to designs, without possibility of enforcing the copyright law.

The plaintiff had tried to avoid such analysis, by objecting, in first instance, to the enforcement of this special conflict rule on the grounds of alleged incompatibility with the European principle of non-discrimination on grounds of nationality. This meant invoking the effect of the solution selected by the Court of Justice of the European Union, which, in their *Tod’s* ruling of 30 June 2005³⁹, considered that the rule of the Berne Convention

38. On this matter, see, for example, Sam Ricketson and Jane C. Ginsburg, “*International Copyright and Neighbouring Rights: The Berne Convention and Beyond*”, paras. 8.59-8.69 (Oxford University Press 2006).

39. CJEU, 2nd ch., 30 June 2005, case C-28/04, *Tod’s SpA, Tod’s France SARL / Heyraud SA*, CCE, 2005, comm133, note C. Caron ; Propriétés intellectuelles, October 2005, p. 442, obs. A. Lucas and p. 460, obs. P. de Condé; D. 2005.2533, obs. C. Brière; RTD Com. 2005 p.735, obs. Fr. Pollaud Dulian; PIBD 2005, no. 815-III-554,: “*Article 12 CE, which establishes*

was incompatible with Article 12 CE (18 TFUE), which criticised all discrimination, direct or indirect, based on nationality. But, in truth, there was little opportunity for such argumentation – drawn from a rationale of strict European law – to prosper since, here, the companies in question, the artist concerned and the disputed works concerned the situation in the United States of America.

The reason for the plaintiff's approach likely resulted from the previous observations. It entailed avoiding enforcement of the special conflict rule posed by the international text and likely to lead to designation of American law, in appearance more complex and likely less favourable to a favourable outcome for the request, to return to simpler enforcement of the law of the country for which protection is requested, *i.e.*, French law. This would lead to addressing the issue of access to protection solely from the standpoint of the originality of the creation in question, taken as a whole.

But this argumentation not having been taken up in the appeal – and for good reason – it is indeed in the field of Article 2.7 of the Berne Convention that the question must be viewed. As would appear immediately, this leads to far more delicate reasoning to the point that each of the parties called for complex scholarly opinions from specialists in both American law and international copyright law.

the general principle of non-discrimination on the basis of nationality, should be interpreted since it goes against the receivability of an author to claim in a Member State the copyright protection granted by this State's legislation be subordinated to a distinguishing criterion based on the country of origin of the work."

Looking into the question of private international law, the Court of Paris thus deduced first, from enforcement of Article 2.7 of the Berne Convention, that they had “*to examine the law of the country of origin, here that of the United States of America on copyright, before being able to determine whether the appealing parties can benefit in France from the copyright protection they claim.*”

Indeed, two conclusions seem to result from the International Convention:

- First, each member of the Berne Union (including the United States) is free to organise the protection of works of artistic craftsmanship and implement or not the possible cumulation of authors’ rights with those of designs and models;
- Second, applicable law may vary with the system of creation in the country of origin of the work.

In concrete terms, this means that here, we should examine how American Law protects seats – the creations in question. Although American protection is based on copyright, when protection is claimed in France, the applicable law determining access to protection is French law on authors’ rights. If, on the contrary, the United States protect only seats claimed in the field of designs and models, such furniture cannot benefit from such special protection in France.

Having stated these principles, the judges’ task is to understand the content of American law.

This can be summed up as follows.

The Law of 1976 provides⁴⁰ that the subject of authors' rights includes pictorial, graphic and sculptural works, defined by the law, in Section 101:

“Pictorial, graphic and sculptural works’ include two-dimensional and three-dimensional works of fine, graphic and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article”⁴¹.

This definition indicates that there is indeed a possibility of copyright protection for works of artistic craftsmanship, but to the exclusion of its mechanical or utilitarian aspects. The law then poses a criterion, that of the ‘separability’ of form and function. In the presence of useful articles, it is not possible to accept the presence of a ‘pictorial, graphic or sculptural work’ only if, and only to the extent that, form of the creation in question integrates pictorial, graphic or sculptural elements that can be identified separately and

40. 17 U.S.C. sec. 102(a)(5)

41. WIPO translation (in French)

can exist independently of utilitarian aspects. Thus, there are three steps in the reasoning:

1 – Is the work a ‘useful article’?

2 – If so, does it have ‘separable’ elements?

3 – If so, can copyright protection apply, but only to such separable elements, without being extended beyond these elements to be able to understand the totality of the useful article.

Does this mean the reasoning was made in this particular case?

In fact, the judges’ task is not easy since the parties supply a mass of various interpretations and applications. According to the plaintiff, the Tulip chair and armchair cannot benefit from American copyright protection, *i.e.*, authors’ rights (which implies the application of French authors’ rights) while the defendants claim these seats may not benefit from any protection on these grounds. To bolster this argumentation, the plaintiff produced a contract letter between the creator and Knoll, a contract between the same company and the creator’s rights holders, a letter from an American lawyer, a report and two sworn affidavits from an American professor. On their side, Matrix and MTOP provide several sworn affidavits from another American professor, well known to our readers.

Despite these divergences, the court expressed an opinion on the content of the American law and its conditions of application.

First, it recalls that “*confronted with a utilitarian object, US Copyright Law excludes its protection, except if there are in this object separable artistic elements that could be considered in themselves as pictorial, graphic and sculptural works and, in this case, protection does will apply only to these elements.*” To conclude that “*this raises the question is thus that of known whether the disputed chair and armchair may be considered as ‘useful articles’ without separable aesthetic elements and thus relating exclusively to the area of designs and models in the United States.*”

This is a reminder of the principles presented above; but for what application? For Knoll, there can be no doubt that these seats display purely artistic and aesthetic characteristics – which are described – that are clearly conceptually separable and functionally independent of the seats’ utilitarian function.

This observation did not convince the judges, however, who deemed: “*that the form of a chair or armchair taken as a whole cannot be viewed as a pictorial, graphic or sculptural work, since it is narrowly tied to its function; that the shape of the Tulip chair and armchair, though guided by the principles of modern design chosen by Eero S, will not be perceived other than as that of a chair or an armchair, with no existing separable aesthetic element, it being added that, although the pedestal could be separated from the seat, it remains nonetheless a utilitarian part to provide support, like the seat or back which are intended to let the user sit down; that the seats themselves are monochrome, with the cushion as only accessory added to the American designs and models, with a contrasting colour*” to conclude that “*no artistic element can be imagined separately in Tulip*

chairs, considered in whole or in part, so it can be fully protected as a 'pictorial, graphic or sculptural work by American copyright.'

To bolster their analysis, the judges highlighted the fact that the parts supplied by the plaintiff attested to the utilitarian nature of their design. This would apply for both the '*design patents*' and the invention patent for the chair whose claims and the description of the invention establish "*that Eero S.'s aesthetic choices are closely tied to the function of the Tulip chair.*" The creator himself having emphasised that the seat's shell and base provided "*visual unity (unity of design) giving the feeling that both elements form a whole and are in fact parts of a single entity.*"

Finally, as if to erase all remaining doubts on this question, the Court of Paris took care to specify that there is "*no registration of copyright by the author although, at the time of creation of Tulip chairs, American law applicable at the time required registering a work with the competent office to benefit from this protection.*"

In conclusion, in the wake of Professor G. who, in the documents supplied, emphasised that the American legislator had raised "*to the rank of archetypal example that of the form of a chair that is inherently non-separable from its function,*" that these chairs "*are not protected under American copyright since they do not satisfy its conditions for protection.*"

The conclusion of the demonstration provided is obvious: since American law – the law of the country of origin of these creations – does not protect

them or part of them under copyright but only in the field of a special right for designs and models, it is impossible to admit their protection in France on the basis of authors' rights.

The plaintiffs had completed their conclusions with a request based on the field of unfair competition.

The Court began by recalling the well-established temperament and principle according to which "*a model which is not protected by a private right may be freely reproduced, except in case of violation, in particular through the creation of a risk of confusion.*" But examination of the case reveals "*that no violation resulting from the reproduction of the infringing armchairs is established by the appealing parties and thus the first judges rightly rejected the unfair competition plea formulated.*"

Since the Court considered that although it "*is constant that the parasitic actions are constituted by all the behaviour by which an economic agent interferes in another's wake to make a profit, free of charge, from the latter's efforts, investments and know-how,*" it is impossible to accede to Knoll's request since the latter has provided "*no information on investments, financial or intellectual, it had made specifically to the products concerned in this dispute.*"

Although it may be regrettable that, in the end, it is possible for persons knowingly to reproduce, in practice, elements created by a world-famous designer, without offering financial compensation or even requesting authorisation, we can only praise the Court of Paris for the quality and rigour

of their reasoning which enhances the reader's understanding of the content of American law in the field of intellectual property.

This calls for some remarks.

First, we can note that the possible simultaneous application of two bodies of rules that may occasionally exist in American law has nothing to do with the cumulation known in French law. While the latter system, irrigated by the theory of the 'unity of art', provides protection for both authors' rights and law relating to designs, the American construction limits copyright protection solely to aesthetic elements 'separable' from functional aspects of works of applied art. There is more — whenever possible — distributive application than true cumulation.

As we have said, the American law of 1976⁴² excludes '*useful articles*' from the field of authors' rights when it includes no pictorial, graphic or sculptural elements that can be identified separately and exist independently of utilitarian aspects. This text defines the notion of 'useful article'⁴³:

*"A 'useful article' is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information"*⁴⁴.

42. L. No. 94-553, 90 Stat. 2541 (1976), 17 U.S.C. secs. 101ff. [1976]

43. 17 U.S.C. sec. 101

44. WIPO translation (in French)

Thus, it is not a matter of determining if the creation in question has a ‘*unique*’ intrinsic utilitarian function, but more simply ‘*an* intrinsic utilitarian function’ for the text to be applicable. As such, this means that, in the United States, objects that are not ‘exclusively functional’ cannot, by this sole attribute, automatically benefit from copyright protection.

We can also observe that the debate focuses on ‘separability’. Consequently, we can note that, on 22 March 2017, the US Supreme Court rendered a major decision⁴⁵ on the issue of protection by American copyright of useful works of art (“applied art”). It was led to decide on the ‘separability’ of decorative elements from functional elements, required for the work to be protected as a ‘pictorial, graphic or sculptural’ work. The precedent is interesting for the assessment of this determinant question which alone can settle the question of possible access to protection under United States copyright law.

It was thus a matter of what we can call ‘surface decoration’ on cheerleaders’ uniforms. The judges first had to resolve the matter of separate identification of forms to isolate two or three-dimensional elements likely to display pictorial, graphic or sculptural quality. They then had to examine a second, more problematic point: the requirement of independent existence. This meant determining whether the previously identified element had the capacity of existing separately from the article’s utilitarian aspects, *i.e.*, showing that, if there are indeed pictorial, graphic or sculptural characteristics independent of the useful aspect.

45. *Star Athletica v. Varsity Brands* case, 197 L. Ed. 2d 354 (2017)

Thus, it is a matter of focusing on elements that can be distinguished both in the form of their whole and their functional parts: *i.e.*, isolating the decoration on a guitar from the musical instrument itself. Although decoration on the surface of a guitar may follow its contours, they are unrelated to the instrument's function. Strictly speaking, there is no reproduction of the guitar as a useful article. Similarly, the Supreme Court distinguished a decorative element which adapts to the cut of a garment from the cut of the garment itself. Stripes on a garment being nothing more than 'surface decoration', it is possible to separate it from the dress itself and there is no reproduction in using them as such on a garment. 'Surface decoration' does not make a garment.

In fact, this solution complies with the indications provided in the Report of the U.S. Congress Committee. Only those elements that are unrelated to an article's functionality may be considered to be 'pictorial, graphic, and sculptural works': a design on the back of a chair, a floral relief on silverware. These two examples share two remarks: not only should the elements in question be easily identified but it can also be observed in both cases that the removal of such decorative elements from these objects will not cause them (chair or fork) to lose their functionality. This said, all is not resolved since the Supreme Court, which admitted — in a part of the reasoning that may have inspired perplexity in many American legal writers — that a separable element may have an incidence on the function of the useful article.

In short, 'separability', in the Court's view, requires the separate existence of the 'element' in question, that can be envisaged independently of the useful

article and whose pictorial, graphic or sculptural nature is admissible. Given that, to receive this qualification, this element itself cannot be a useful article.

Applied to the case decided by the Court of Paris, the US Supreme Court reasoning clearly leads to lack of copyright protection for the elements of these chairs. The issue did not concern decoration on a cushion or the design of a chair back ('surface decoration'), but the form taken as a whole or the chairs' useful forms. None of these elements was sufficiently 'baroque', fanciful or arbitrary to receive the qualification giving it separate access to copyright. Setting aside a holistic view to isolate independent elements is useless in this case, since the rule of the independence of form from utilitarian function also applies to 'parts' of useful articles and leads similarly to the impossibility of copyright protection. To return to the reverse approach previously presented, the Tulip chair in question would completely lose its utility without the disputed elements, and most surprising, it had no isolated element strictly speaking. According to the 'form follows function' aesthetic design, it was probably impossible, here, to isolate one element from the functional whole of the article.

In conclusion, we should emphasise that the Parisian judges' reference to the absence of filing with the Copyright Office should not mislead us. It is not a matter of saying that the chairs could not be protected because of revocation, for not having undertaken the necessary formalities. Because of Article 5.2⁴⁶ of the Berne Convention, this solution would be inadmissible in

46. "(2) *The enjoyment and the exercise of these rights shall not be subject to any formality; such enjoyment and such exercise shall be independent of the existence of protection in the country of origin of the work. Consequently, apart from the provisions of this Convention, the extent of*

the international order for a French judge. The designation of the law of the country of origin according to Article 2.7 can only refer to the conditions of substance, not form of this national legislation. Accordingly, the reference to the absence of filing should be viewed only as proof of the creator's own state of mind, having, with full knowledge of the applicable American rules, placed himself solely in the field of Industrial Property rather than address that of copyright, too. Indeed, since he himself was convinced of the impossibility of benefiting from copyright for these models. Consequently, this is no more than an index of non-separability.

(English translation by ATTIC Traduction)

protection, as well as the means of redress afforded to the author to protect his rights, shall be governed exclusively by the laws of the country where protection is claimed."

COURT OF CASSATION

1st Civil Chamber

Appeal no. 15-28.352

31 January 2018

Madame X and Sté Cathédrale d'Images c/ Sté Culturespaces

AUTHORS' RIGHTS: Infringement of intellectual work (no) – Deliberation by the First Civil Chamber of Court of Cassation

AUTHORS' RIGHTS: Access to protection (refusal) – Audiovisual scenography – Idea (yes) – Insufficiency of form (yes) – Originality (no) – Rejection – Deliberation by the First Civil Chamber of Court of Cassation

PARASITISM: Reproduction of a previously exploited concept – Addition of changes to the concept of origin – Indifferent consideration – Acquirer's will to follow the wake of the first operator – Maintenance of confusion on the status of the acquirer and new operator – Will to profit from the success and renown of the previous shows – Will the profit from thirty years of efforts by the first operator – Saving promotional expenses for the shows and reducing risk with respect to the proven economic value of a commercial success – Risk of confusion (yes) – Damages (yes) – Calculation of compensation – Taking into account the loss to the injured party (yes) – Taking into account of the parasite's profits (no) – Rejection – Deliberation by the Commercial, Financial and Economic Chamber

Complete version of the decision available on the Légifrance site:

<https://www.legifrance.gouv.fr/affichJuriJudi.do?oldAction=rechJuriJudi&idTexte= JURITEXT000036584708&fastReqId=234923581&fastPos=8>

COURT OF CASSATION

Commercial Chamber

Appeal no. 13-21.001

5 April 2018

Monsieur X and Sté Camard & Associés c/ Sté Artprice.com

AUTHORS' RIGHTS: Infringement of intellectual works – Deliberation by the first Civil Chamber of the Court of Cassation

ACCESS TO PROTECTION: Protected work – Auction house catalogue – Originality of the work (yes) – Personal stamp of the creator (yes) – Set of characteristics expressing aesthetic bias (yes) – Rejection;

AUTHORS' RIGHTS: Access to protection – Protected works – Photographs of objects in an auction house catalogue – Originality of the work (yes) – Personal stamp of the creator (yes) – Aesthetic bias (yes) – Large number of works – Demonstration of originality – Examination

of 8,779 photographs – Identification of a combination of characteristics common to these works (yes) – Aesthetic research on positioning each of the objects photographed – Arbitrary aesthetic choices for the framing and shooting angle of objects – Considered use of play of light and shadow – Considerable post-production work using specialised software – Rejection;

AUTHORS' RIGHTS: Infringement of photographic works – Reproduction of photographs on a website – Violation of author's moral rights – Author's name not mentioned on a large number of photographs reproduced – Alterations made on certain photographs – Moral damage – Allocation of damages = €100,000 – Decision justified (no) – Necessary specification of the number of modified uncredited photographs taken into account – Precision omitted – Lack of legal basis – Cassation;

PARASITISM: Reproduction of photographs on a website – Defendant not having informed the Court of Appeal that the alleged acts of parasitism were not distinct from those incriminated for infringement – New plea inadmissible since mixing fact and law;

INDUSTRIAL PROPERTY: Trademark – Trademark infringement – Deliberation by the Commercial Chamber of the Court of Cassation;

INDUSTRIAL PROPERTY: Trademark – Trademark infringement – French Camard brand – Act of trademark infringement decided by the Court of Appeal – Illegal trademark reproduction – Identical reproduction

of the trademark on a website – Reproduction of the trademark on the cover of infringing catalogues posted online – Decision justified (no) – Judge's Office- No search requested – Exhaustion of trademark rights – Sale in the European Union of products bearing the trademark – Search omitted – Lack of legal basis – Cassation

Complete version of the decision available on the Légifrance site:

<https://www.legifrance.gouv.fr/affichJuriJudi.do?oldAction=rechJuriJudi&idTexte=JURITEXT000036829493&fastReqId=1441931725&fastPos=1>