

CASE LAW SECTION

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1. SUBJECT MATTER PROTECTED BY COPYRIGHT:

CJEU, Grand chamber, 13 Nov. 2018, case C-310/17, Levola Hengelo BV v Smilde Foods BV

Interpretation of European and international copyright legislation shows that the taste of a food product cannot be protected by copyright, which means that national legislation cannot provide otherwise.

Looking at its simplest contribution, the decision handed down by the Court of Justice of the European Union on 13 November 2018¹ sets out

1. CJEU, 13 November 2018, case C-310/17: D. 2018. 2464, note F. Pollaud-Dulian; CCE 2019, no 1, note C. Caron; LEPI Jan. 2019, p. 1, obs. Lebois, Prop. intell., January 2019, p.18, obs J.M. Bruguère.

a solution that will come as no surprise to most specialists in literary and artistic property: the taste of a food product cannot be protected by copyright because it does not meet the basic requirements for entitlement to protection.

However, the decision handed down by the grand chamber of the CJEU, is more interesting than this because it provides clarification on the fundamental concept of an intellectual work and because of the scope that can be granted to this concept.

A retailer of vegetables and foodstuffs created a spreadable dip containing cream cheese and fresh herbs called *Heksenkaas* or *Heks'nkaas* ("Heksenkaas"). Four years later, in 2011, he transferred the intellectual property rights which he believed he had over that product to Levola Hengelo BV ("Levola"). A year later, a patent for the method of manufacturing this cheese was granted. Two years later, another company, Smilde Foods BV ("Smilde"), began manufacturing and distributing a similar product. Levola took the view that this new product infringed its copyright in the taste of the spreadable cheese and brought proceedings against Smilde before a Netherlands court. To substantiate its claim for compensation and for a marketing ban, Levola stated that copyright in a taste refers to the "*overall impression on the sense of taste caused by the consumption of a food product, including the sensation in the mouth perceived through the sense of touch*" and argued that the Smilde product reproduced the characteristic features of its product.

The Dutch court of first instance dismissed this claim on the sole ground that the applicant had not indicated which elements, or combination of elements, of

the taste of Heksenkaas gave it its unique, original character and personal stamp. In appeal, the referring court held that the key issue in the case before it was whether the taste of a food product may be eligible for copyright protection. Noting that the parties were diametrically opposed on this issue and that the Dutch and French courts of cassation had adopted radically different solutions to the related question of whether the scent of a perfume was eligible for protection – where the Dutch court accepted in principle the possibility of recognising copyright and the French court categorically rejected the possibility of granting copyright protection – the Dutch appeal court (Gerechtshof Arnhem-Leeuwarden, Netherlands) decided to refer two questions to the Court of Justice of the European Union.

The two questions were as follows:

“1) a) Does EU law preclude the taste of a food product – as the author’s own intellectual creation – being granted copyright protection? In particular:

“b) Is copyright protection precluded by the fact that the expression “literary and artistic works” in Article 2(1) of the Berne Convention, which is binding on all the Member States of the European Union, includes “every production in the literary, scientific and artistic domain, whatever may be the mode or form of its expression”, but that the examples cited in that provision relate only to creations which can be perceived by sight and/or by hearing?

“c) Does the (possible) instability of a food product and/or the subjective nature of the taste experience preclude the taste of a food product being eligible for copyright protection?

“d) Does the system of exclusive rights and limitations, as governed by Articles 2 to 5 of Directive [2001/29], preclude the copyright protection of the taste of a food product?”

“2) If the answer to question 1(a) is in the negative:

“a) What are the requirements for the copyright protection of the taste of a food product?”

“b) Is the copyright protection of a taste based solely on the taste as such or (also) on the recipe of the food product?”

“c) What evidence should a party who, in (infringement) proceedings, claims to have created a copyright-protected taste of a food product, put forward? Is it sufficient for that party to present the food product involved in the proceedings to the court so that the court, by tasting and smelling, can form its own opinion as to whether the taste of the food product meets the requirements for copyright protection? Or should the applicant (also) provide a description of the creative choices involved in the taste composition and/or the recipe on the basis of which the taste can be considered to be the author’s own intellectual creation?”

“d) How should the court in infringement proceedings determine whether the taste of the defendant’s food product corresponds to such an extent with the taste of the applicant’s food product that it constitutes an infringement of copyright? Is a determining factor here that the overall impressions of the two tastes are the same?”

The first question is existential because the answer will dictate whether copyright applies.

The question amounts to examining the scope of the concept of an intellectual work. It also involves comparing and contrasting the characteristics of a work (potential instability/subjective nature of the taste experience) and its constituent elements. This gives rise to an interesting reflexivity between the potential links at either end of the characterisation chain: is the protection afforded by copyright compatible with the matter under dispute, the production of a taste? Replying in the negative means denying eligibility for protection because incompatibility indicates an absence of grounds for protection and hence justifies exclusion from protection. This is an interesting inversion of the reasoning generally adopted by lawyers. Ordinarily, the regime applicable to an institution is deduced by first characterising the nature of the element in question (“concept”). Here, it is the prior examination of the regime that helps define the nature of the element in question and which therefore underlies the characteristic features of the concept...

Assuming that taste could naturally come under copyright law, the referring court asked the Court of Justice to clarify the conditions to be met so that protection could be effectively afforded. And if these conditions are met, would the scope of protection extend to just the taste itself or would it include the recipe as well? Another astonishing link between either end of the chain... and vice versa. Furthermore, on a very important practical level, the Dutch court asked the Court of Justice to rule on the burden and subject matter of proof both in terms of whether taste could be protected and as regards

similarities that could lead to a decision penalising copyright infringement. But do all these questions come under the CJEU's remit to provide a unifying interpretation?

This gives rise to another question, that of whether – failing any clarification by the applicant on the elements of the spreadable cheese that could characterise an intellectual work – the referral for preliminary ruling is admissible.

The answer provided (paragraphs 26–31) gives valuable insight into the Court's role in interpreting Union law.

In this scenario, the Court is in principle, always bound to rule.² Indeed, “*questions on the interpretation of EU law referred by a national court in the factual and legislative context which that court is responsible for defining, and the accuracy of which is not a matter for the Court to determine, enjoy a presumption of relevance*”.

The Court can only refuse to rule in a number of well-defined cases. The Court may refuse to rule on a question referred by a national court only “*where it is quite obvious that the interpretation of EU law that is sought bears no relation to the actual facts of the main action or its purpose*” or “*where the problem is hypothetical*”, or “*where the Court does not have before it the factual or legal material necessary to give a useful answer to the questions submitted to it*”.

2. CJEU, judgements of 10 March 2009, Hartlauer, C 169/07, EU:C:2009:141, paragraph 24, and of 1 July 2010, Sbarigia, C 393/08, EU:C:2010:388, paragraph 19.

(judgements of 24 June 2008, *Commune de Mesquer*, C188/07, EU:C:2008:359, paragraph 30 and the case-law cited, and of 21 May 2015, *Verder LabTec*, C657/13, EU:C:2015:331, paragraph 29)”. As the case in question did not come under any of these categories, the Court undertook to answer the questions referred.

The answers provided by the CJEU do not overturn the French legal order (I). However, the scope of the exclusion from copyright protection could be queried (II).

I. THE REASONS FOR NOT AFFORDING PROTECTION TO A TASTE

The lesson to be drawn from the Court’s decision is easy to summarise: the taste of a cheese cannot be copyright protected because it is not considered an intellectual work. But this exclusion is more difficult to justify on the basis of European law insofar as the guidance sought to justify the decision says nothing about this fundamental concept. The European judges first endeavoured to find a legislative foundation for their reasoning (A) before explaining, generally and specifically, what an intellectual work consisted of (B).

A. Legislative foundation(s)

The truth is, Directive 2001/29 – which provides the legal basis for the Court of Justice – contains no definition of an intellectual work. In order to deliver nothing less than an “*autonomous and uniform interpretation*” of

the concept, the Court of Justice refers to the internal logic of the European directive and relies on international agreements which the judges considered relevant.

Paragraph 33 of the ruling expresses the need for coherence and the idea of internal logic:

“33 In that regard, Articles 2 to 4 of Directive 2001/29 state that the Member States are to provide for a set of exclusive rights relating, in the case of authors, to their ‘works’, while Article 5 sets out a series of exceptions and limitations to those rights. The directive makes no express reference to the laws of the Member States for the purpose of determining the meaning and scope of the concept of a ‘work’. Accordingly, in view of the need for a uniform application of EU law and the principle of equality, that concept must normally be given an autonomous and uniform interpretation throughout the European Union (see, to that effect, judgements of 16 July 2009, Infopaq International, C5/08, EU:C:2009:465, paragraphs 27 and 28, and of 3 September 2014, Deckmyn and Vrijheidsfonds, C201/13, EU:C:2014:2132, paragraphs 14 and 15).”

Under Directive 2001/29, the classification of a work as an intellectual work would seem to result from the fact that the work's author has been granted protection! And this protection is shaped by the allocation of rights limited by exceptions. In other words, the importance of the concept results from the fact that within the European area, protection is afforded to authors as creators of intellectual works! This is indisputably correct but paradoxically, it also reveals that the European institutions have put the cart before the horse,

regulating rights before worrying about their basis. The same could be said for the concept of author, the prime beneficiary of protection. The history of the construction of European copyright law is indicative of this type of approach. Instead of building general European legislation from grand principles serving as foundations, the choice made was to settle a number of specific important and urgent questions seen as requiring clarification and harmonisation. This was how computer programs (first copyright directive in 1991)³ and databases (directive in 1996)⁴ were handled. However, the Luxembourg court did not refer to these directives, even though they relate to copyrightable intellectual works. Is this because their subject matter was utilitarian works? Even if it could be seen as lifestyle-enhancing, it is difficult to characterise a cheese as being more beautiful than useful. Perhaps it is because the technical creations at issue in the first texts were too specific whereas the point here was to identify the core concept of an intellectual work. However, it is precisely these works⁵ that must be “*the author’s own intellectual creation*” and all other

3. Council Directive 91/250/EEC of 14 May 1991 on the legal protection of computer programs.

4. Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases.

5. Article 1 of Directive 91/250/EC:

“*Object of protection:*

1. *In accordance with the provisions of this Directive, Member States shall protect computer programs, by copyright, as literary works within the meaning of the Berne Convention for the Protection of Literary and Artistic Works. For the purposes of this Directive, the term ‘computer programs’ shall include their preparatory design material.*

2. *Protection in accordance with this Directive shall apply to the expression in any form of a computer program. Ideas and principles which underlie any element of a computer program, including those which underlie its interfaces, are not protected by copyright under this Directive.*

3. *A computer program shall be protected if it is original in the sense that it is the author’s own intellectual creation. No other criteria shall be applied to determine its eligibility for protection.”* (Emphasis added).

Article 3 of Directive 96/9/EC:

“*Object of protection:*

1. *In accordance with this Directive, databases which, by reason of the selection or arrangement of their contents, constitute the author’s own intellectual creation shall be protected as such by copyright. No other criteria shall be applied to determine their eligibility for that protection.”* (Emphasis added).

criteria are irrelevant.⁶ And it was based on this joint definition of software and databases (as well as photographs)⁷ that the Court of Justice retained a cross-cutting approach, extending these definitions to any potentially copyrightable creation.⁸

That said, it should firstly be noted that the Court of Justice merely adopted the same approach it first used when settling the question of eligibility for copyright protection in relation to the other condition required, namely the originality of the form at issue. In the Infopaq case,⁹ the Court of Justice stated:

“33. Article 2(a) of Directive 2001/29 provides that authors have the exclusive right to authorise or prohibit reproduction, in whole or in part, of their works. It follows that protection of the author’s right to authorise or prohibit reproduction is intended to cover ‘work’.”

As in that case, the Luxembourg court based its decision on international agreements: not only the Berne Convention – as in the Infopaq case¹⁰ – but

6. See above the wording *“No other criteria shall be applied”*.

7. Council Directive 93/98/EEC of 29 October 1993 harmonizing the term of protection of copyright and certain related rights:

“Article 6 - Protection of photographs Photographs which are original in the sense that they are the author’s own intellectual creation shall be protected in accordance with Article 1. No other criteria shall be applied to determine their eligibility for protection.” (Emphasis added).

8. CJEU, 16 July 2009, Infopaq International, C5/08, EU:C:2009:465, regarding a literary work: see paragraphs 33 & seq.

9. CJEU, 16 July 2009, op. cit.

10. *“34 It is, moreover, apparent from the general scheme of the Berne Convention, in particular Article 2(5) and (8), that the protection of certain subject-matters as artistic or literary works presupposes that they are intellectual creations.*

“35 Similarly, under Articles 1(3) of Directive 91/250, 3(1) of Directive 96/9 and 6 of Directive 2006/116, works such as computer programs, databases or photographs are protected

also the World Intellectual Property Organization Treaty of 20 December 1996 and the 1994 TRIPS Agreement on trade-related aspects of intellectual property rights.

The key provisions are in the Berne Convention and the reference to this entails a slight detour which, in less academic circles, could be regarded as a game of three-cushion billiards:

“38 It should be recalled in that regard that although the European Union is not a party to the Berne Convention, it is nevertheless obliged, under Article 1(4) of the WIPO Copyright Treaty, to which it is a party and which Directive 2001/29 is intended to implement, to comply with Articles 1 to 21 of the Berne Convention (see, to that effect, judgements of 9 February 2012, Luksan, C277/10, EU:C:2012:65, paragraph 59 and the case-law cited, and of 26 April 2012, DR and TV2 Danmark, C510/10, EU:C:2012:244, paragraph 29).

by copyright only if they are original in the sense that they are their author’s own intellectual creation.

“36 In establishing a harmonised legal framework for copyright, Directive 2001/29 is based on the same principle, as evidenced by recitals 4, 9 to 11 and 20 in the preamble thereto.

“37 In those circumstances, copyright within the meaning of Article 2(a) of Directive 2001/29 is liable to apply only in relation to a subject-matter which is original in the sense that it is its author’s own intellectual creation.”

The Luxembourg court have not always used the same arguments. See for example CJEU, 4 October 2011, case C-403/08 on sporting events:

“96 FAPL cannot claim copyright in the Premier League matches themselves, as they cannot be classified as works.

“97 To be so classified, the subject-matter concerned would have to be original in the sense that it is its author’s own intellectual creation (see, to this effect, ruling of 16 July 2009, Infopaq International, case C5/08, ECR I6569, paragraph 37).

“98 However, sporting events cannot be regarded as intellectual creations classifiable as works within the meaning of the Copyright Directive. That applies in particular to football matches, which are subject to rules of the game, leaving no room for creative freedom for the purposes of copyright.

“99 Accordingly, those events cannot be protected under copyright. It is, moreover, undisputed that European Union law does not protect them on any other basis in the field of intellectual property.”

“39 Under Article 2(1) of the Berne Convention, literary and artistic works include every production in the literary, scientific and artistic domain, whatever the mode or form of its expression may be. Moreover, in accordance with Article 2 of the WIPO Copyright Treaty and Article 9(2) of the Agreement on Trade-Related Aspects of Intellectual Property Rights, which is mentioned in paragraph 6 of this judgement and which also forms part of the EU legal order (see, to that effect, judgement of 15 March 2012, SCF, C135/10, EU:C:2012:140, paragraphs 39 and 40), copyright protection may be granted to expressions, but not to ideas, procedures, methods of operation or mathematical concepts as such (see, to that effect, judgement of 2 May 2012, SAS Institute, C406/10, EU:C:2012:259, paragraph 33).”

To sum up, the reference to international standards is wider here than in the Infopaq case because according to the ruling discussed here, the European Union, which is party to the WIPO Treaty – implemented by Directive 2001/29 – must comply with the Berne Convention even though it is not a party to it. The situation is similar to that of an isolated state which is obliged to comply with the terms of the Berne Convention as a condition of membership of the TRIPS and WTO agreements.

The lesson is important: European copyright law is part of a wider set of standards that cannot be disregarded.

The Berne Convention allows for a definition of an intellectual work.

B. The concept of intellectual work

Under Article 2(1) of the Berne Convention, “*literary and artistic works include every production in the literary, scientific and artistic domain, whatever the mode or form of its expression may be*”. While due to the reference to arts and letters the wording on first analysis could cast doubt on whether a taste can be copyright-protected, the irrelevance of form generally admitted and the irrelevance – explicitly set out here – of the mode or form of expression used should on the contrary point to a favourable response to the application.

Nothing could be further from the truth. Why is that?

The Court of Justice of the European Union gives us its reasoning in paragraphs 35–37:

“35 n that regard, two cumulative conditions must be satisfied for subject matter to be classified as a ‘work’ within the meaning of Directive 2001/29.

“36 First, the subject matter concerned must be original in the sense that it is the author’s own intellectual creation (judgement of 4 October 2011, Football Association Premier League and Others, C403/08 and C429/08, EU:C:2011:631, paragraph 97 and the case-law cited).

“37 Secondly, only something which is the expression of the author’s own intellectual creation may be classified as a ‘work’ within the meaning of Directive 2001/29 (see, to that effect, judgements of 16 July 2009, Infopaq International,

C5/08, EU:C:2009:465, paragraph 39, and of 4 October 2011, Football Association Premier League and Others, C403/08 and C429/08, EU:C:2011:631, paragraph 159).”

It is this approach that must ultimately be adopted by the French courts because the Court of Justice, in giving an interpretation of a uniform and autonomous concept, has necessarily provided a view with retroactive effect.

Will this overturn French law?

Traditionally, the law and case law have always been presented by scholars as open to two-step analysis: (i) are we witnessing a new form taking shape? If yes, (ii) is this form original in that it bears the author's personal touch?

There does seem to be a trace of two-step reasoning (entailing two cumulative conditions) in relation to form and originality in the Court's reasoning but one could ask whether the sequence of questioning is the same as has been practised heretofore by the French courts.

The Court of Justice starts by presenting the issue of originality of the subject matter (paragraph 36) before looking at “*something which is the expression of the author's own intellectual creation*” (paragraph 37).

If misunderstood, the approach could surprise some. The chronology laid out might suggest that the first priority is to assess originality in general, followed by an investigation of the personal approach used in a particular

instance – what the Court terms “*expression*”. This inversion of the reasoning would be highly questionable because originality must be assessed in terms of form rather than the creative method or process.

In fact, what the Court refers to as two cumulative conditions to be satisfied should doubtless be seen as the expression of three-step reasoning:

- identify the form, which is the fruit of the author’s creative work;
- investigate the originality of this form;
- only retain as eligible for protection those forms that convey this originality. In a polymorphous work or one made up of different elements, only forms or elements identifiable separately as bearing the imprint of the author are protected. There is no such thing as originality by capillary action.

It would be useful for the Court of Justice to clarify its thinking if called to rule on another referral for preliminary ruling.

That said, how can we know in practical terms if subject matter presented as a work is likely to be classified as original?

The Court of Justice of the European Union answers this question in paragraphs 40 et seq: these clarifications are extremely important because they led to the exclusion of taste from protection.

“40 Accordingly, for there to be a ‘work’ as referred to in Directive 2001/29, the subject matter protected by copyright must be expressed in a manner which makes it identifiable with sufficient precision and objectivity, even though that expression is not necessarily in permanent form.”

Paragraph 40 provides fundamental clarifications. In order for protection to be granted to intellectual work, the work must:

- be expressed...
- in a manner which makes it identifiable...
- with sufficient precision and objectivity,
- even though that expression is not necessarily in permanent form.

There is no need to dwell on the requirement for expression, which is the same as the requirement for a form. It is merely answering the elementary and fundamental question: “*what is it about?*” and enabling an effective search for the quality expected: originality. It also thanks to this that it will be possible, in copyright infringement proceedings, to compare similarities.

Identifiability also touches on this issue. It’s only common sense.

But identifiable how?

In the absence of means, the Court specified the qualities expected: “*with sufficient precision and objectivity*”.

The requirement for precision shares the same idea. The French Court of Cassation has already confirmed this in relation to a similar problem – that of perfume fragrances (see section II B below). How can originality be ascertained if we don’t know exactly what a work is about? How, in copyright infringement proceedings, can similarities between the original constituent elements of the primary work and the characteristic features of the secondary work be established if the subject matter for which copyright protection is asserted is vague or indescribable?

The Court of Justice explains exactly how. It comes down to predictability and, consequently, to a degree of certainty. These are not only expected by any legal system but also qualities essential to life in society and trade. Users of works, economic operators and the courts all need to be aware of the boundaries between what is reserved to personal rights and what is freely available. Paragraph 41 of the ruling says this very clearly:

“41 That is because, first, the authorities responsible for ensuring that the exclusive rights inherent in copyright are protected must be able to identify, clearly and precisely, the subject matter so protected. The same is true for individuals, in particular economic operators, who must be able to identify, clearly and precisely, what is the subject matter of protection which third parties, especially competitors, enjoy. Secondly, the need to ensure that there is no element of subjectivity – given that it is detrimental to legal certainty – in the process of identifying the protected

subject matter means that the latter must be capable of being expressed in a precise and objective manner.”

This is why taste must be excluded from the scope of copyright protection. Because, as things currently stand, it has none of the qualities expected.

“42 The taste of a food product cannot, however, be pinned down with precision and objectivity. Unlike, for example, a literary, pictorial, cinematographic or musical work, which is a precise and objective form of expression, the taste of a food product will be identified essentially on the basis of taste sensations and experiences, which are subjective and variable since they depend, inter alia, on factors particular to the person tasting the product concerned, such as age, food preferences and consumption habits, as well as on the environment or context in which the product is consumed.”

Here, the Court further explains the reasons for and content of the objectivity requirement. It attaches this requirement to the requirement for precision. The main issue is still to determine the contours of the subject matter of the right of ownership. Obviously, it is also important that parties, courts and third parties can all determine in the same way the scope of the protection sought. But while the observation is understandable, its application – which forms the basis for excluding taste from the scope of copyright protection – appears more debatable. Is there not always in the perception of works an element of subjectivity? It would seem that the difference – as in this case – is one of degree rather than nature... So why the harsh exclusion? In truth, without emphasising it, the Court of Justice seems to be proclaiming the

exclusion of works accessed via taste. This is an interesting development for French academics, who up until then had access to many decisions confirming that a work was eligible for copyright protection if accessible to one of the five senses: sight, hearing, touch, smell – and taste.¹¹ But the conclusions of the Advocate General, Melchior Wathelet, in this case leave no room for doubt. Mr Wathelet maintained (§51):¹²

“I note, however, notwithstanding the fact that according to Article 2(1), of the Berne Convention, “[t]he expression ‘literary and artistic works’ shall include every production in the literary, scientific and artistic domain, whatever may be the mode or form of its expression”, this provision only refers to works perceived by visual or audio means, such as books and musical compositions, and excludes works that can be perceived by other senses such as taste, smell or touch”.

After the exclusion of olfactory works by the Court of Cassation, we can see that the French principle has been seriously dented. We look forward future decisions applying the sense of touch (also mentioned by Levola)...

By contrast, there is no need to dwell on the last clarification: “*not necessarily in permanent form*”. The observation is welcome. The long-term nature of a creative work has never been a condition for copyright protection. A work can be fragile, consumable (the original form of a wedding cake for example), fleeting (a stage production, happening, magic trick) or ephemeral

11. See for example, Paris, 3 July 1975: RIDA, no. 91, 1/1977, p. 108, which states that although article L. 112-2 of the Intellectual Property Code “*only cites as works of the mind those that are perceptible to sight or sound*” adds that “*the presence of the adverb ‘in particular’ does not mean that works that could be perceived by any of the other three senses can be excluded*”.

12. Conclusions of the Advocate General, Melchior Wathelet, §51.

(a snowman, ice statue or sandcastle). Questions of evidence rather than fundamental issues are the important thing here. But nothing is impossible. Above all, there are ways of fixing – or pinning down – the traces of a creative work. However, the Court of Justice did not push its reasoning as far as imposing a requirement for the work to be “fixed” in advance as one of the conditions for being granted protection – as is the case with some copyright laws in contrast with French law.¹³

II. SCOPE OF EXCLUSION

The exclusion of taste from the scope of copyright protection merits some clarification as regards its scope.

Scope must be assessed in terms of space and time in comparison to culinary works (A) and is highly instructive regarding other categories of human production that should also be refused classification as works of the mind (B).

A. Scope of exclusion regarding culinary or gastronomic works

The decision of the Court of Justice of the European Union is restricted to excluding taste in the current state of the art. This means that not only might

13. For an application of this principle that material fixation is irrelevant, see for example 1st civil chamber, 22 Jan. 2009, no. 08-11.404, RIDA, no. 219, 1/2009, p. 199, note P. Sirinelli, RTD com. 2009. 302, obs. F. Pollaud-Dulian: “*Although olfactory sensations are fleeting and ephemeral, and although the material fixation of a work is not a necessary criterion for protection, the work does survive after its material medium is destroyed.*” On appeal, see Aix-en-Provence, 10 Dec. 2010: D. 2011. Pan. 2165, obs. Sirinelli.

the solution evolve as regards taste but also that other modes of protection could be found. It is also possible to inquire whether other elements relating to culinary productions are eligible for copyright protection.

It should first be noted that the wording used by the Court of Justice opens the doors a little to protection. In their arguments, the Luxembourg judges stated:

“43 Moreover, it is not possible in the current state of scientific development to achieve by technical means a precise and objective identification of the taste of a food product which enables it to be distinguished from the taste of other products of the same kind.

Conversely, if scientific development were to offer the technical means to identify a work precisely and objectively, protection could be granted.

Could **future – or even current – biochemical data** not be used to solve the problem of identifying the subject matter protected? As with a poem composed of common words, could a taste not be considered as resulting from the composition of objectively measurable molecules? In fact, the thing that is fleeting and/or subjective is the sensation that a taste produces in an individual. But is that not exactly what is at issue?

Could a new referral for preliminary ruling, better worded in both legal and material terms, change the court’s analysis? Perhaps a better apprehension and understanding of the elementary particles at issue would also allow the

court to look differently at the issue, identifying the contours of the form at issue.¹⁴

But pending such a development, is the originator of the production of the taste deprived of any protection?¹⁵

A reading of the decision seems to indicate that the route of **patenting** the mechanism of production is open. True, the subject matter protected by copyright is not the same but the protection thus granted could provide a competitive advantage.

It could also be considered that the **form of the dish** or food offered can be protected by copyright.¹⁶ But here again, the subject matter protected by copyright is quite different and the scope of protection does not extend to gastronomic production, i.e. its taste and mouth feel.

As for the rest, it may be possible to look at copyright protection of **recipes**. However, it is best to be cautious and distinguish between form and substance.

14. For a scientific and legal study of the means that could be used for this purpose, see the rich analysis published after this commentary was written: T. Gisclard, *L'identification des fragrances et des saveurs en droit de la propriété intellectuelle*. - À propos de l'arrêt de la CJUE, 13 nov. 2018, aff. C-310/17, *Levola Hengelo B.V. v Smilde Foods B.V.*, *Propriété industrielle* no. 2, February 2019, paper 3.

15. For a pioneering study on this topic, see Valfrido Piredda, "*La protection des œuvres gastronomiques, en droit d'auteur français*", thesis, Paris sud, 2000, published in 2017 by A.N.R.T [national association of research and technology]. On this issue in general, see N. Binctin, *Le cumul d'appropriation: du parfum au logiciel*: *Comm. com. électr.* 2006, paper 36.

16. See for example A. Bensamoun, CCE 2010. Paper 4: *quand l'inspiration rejoint la gourmandise... - À propos de sculptures en chocolat*.

In terms of substance, in France it has been decided that “*while their literary expression can be protected, cooking recipes do not in themselves constitute intellectual works; they can be broken down into a succession of instructions, a method; this is know-how, which is not copyrightable*”.¹⁷

But what of the literary form taken by a recipe as communicated to others? It is a literary work like any other. True, its purpose is utilitarian but this consideration is not in itself sufficient reason for denying copyright protection. It all comes down to originality.¹⁸ However, protection would give the owner little benefit because all that would be needed to circumvent it would be to express the recipe (the substance) in another form.

But other routes could open up. One possibility could be **unfair competition or unfair trade practices**, if the person using the taste does not behave like a “reasonable” prudent, conscientious and informed individual. The **trade secret** route recently enshrined by legislators also seems promising.

17. TGI Paris, 30 Sep. 1997: RIDA, no. 177, 3/1998, p. 273, note Piredda; *ibid.* p. 147, obs. Kéréver; JCP E 2000, p. 1376, obs. Bougerol. See also Paris, 17 March 1999: RIDA, no. 182, 4/1999, p. 202; *ibid.* p. 121, obs. Kéréver; RTD com. 2000, p. 91, obs. Françon; Comm. com. électr. 1999, comm. 23, note C. Caron. See also Cass. 1st civil chamber, 5 Feb. 2002: D. 2002, p. 2253, note B. Edelman; Comm. com. électr. 2002, comm. 35, obs. C. Caron, who refuses to consider that the person executing a recipe on air is co-author of the audiovisual work capturing this performance. On beer-based recipes, see also CA Liège, 14th chamber, 10 June 2011: Propr. intell. 2011, no. 41, p. 390, obs. J.-M. Bruguière.

18. See for example Paris, 1st chamber, 27 May 1992: RIDA, no. 154, 4/1992, p. 157.

B. Scope of exclusion with regard to other creative works also accessible to touch, taste or smell

Many other human productions could be affected by the exclusion proclaimed by the Court of Justice of the European Union. And this is regardless of the official reason – precise form and objectively perceptible – or of the unstated reason underlying the exclusion – no perception by sight or sound of the form of the work.

By immediate analogy, it would seem that both **drinks and beverages** will have to be excluded from protection. In that case, vintage wines would suffer the same fate as taste. With the same exclusion in principle and the same arrangements on indirect means for protection (see section II A above).

Perfume **fragrances** are also affected.¹⁹ The decision challenges Dutch case law, which had extended copyright protection to these types of works. By contrast, it confirms the recent analysis by the French Court of Cassation which has consistently proclaimed – albeit using different reasoning – the principle that ideas are not protected by copyright.

Three days after the French Court of Cassation's initial decision denying protection, the Dutch Supreme Court²⁰ ruled that “[t]he description laid down

19. On this question, see for example the pioneering work of J.-P. Pamoukdjian, *Le droit du parfum*: LGDJ, 1982. Or more recent monographs: D. Galan, *La protection de la création olfactive par le droit de la propriété intellectuelle*: PUAM, 2010; T. Fringans, *Protection et valorisation des recettes culinaires*: th. Lille, 2014. Or cross-disciplinary studies: M. Vivant, *Le paradis pour le boulon? L'enfer pour le parfum?*: RLDI 2013, no. 3043.

20. Hoge Raad der Nederlanden [Dutch Supreme Court], 16 June 2006, LJN AU8940, *Kecofa v Lancôme*. For more on this, see for example A. Quaedvlieg, *Copyright and perfume*:

in article 10 of types of works, of what must be understood to be a ‘work’ in the sense of this Act, is put in general wording and does not rule out scents”. In other words, even though a scent is only perceptible through the nose, it is copyrightable. The Dutch judges also distinguished the scent of a perfume from its composition or the liquid from which it emanates. With this approach, the liquid that produces the fragrance is irrelevant, legally speaking, because it is the scent itself that is protected, regardless of the list of different ingredients that may produce it. This distinction implies that a perfume that contains completely different ingredients but smells the same may be infringing, while a perfume with a similar formula but a different scent would not be. There are therefore material – and legal – factors to be distinguished. But only the scent is copyrightable.

Or rather “was” copyrightable because the very general reasoning of the Supreme Court is doubtless in opposition to the reason underlying the CJEU decision, and relates to the accessibility of production to certain senses. The requirement for a precise and objective form as proclaimed by the Court seems – in the current state of the art – to exclude protection (see section II A above). It was indeed because of these diverging solutions regarding olfactory productions found by the French and Dutch courts of cassation (see paragraph 24 of the decision) that the Dutch referring court initiated the reference for a preliminary ruling.

nose, intellect and industry, RIDA, no. 230, 4/2011, p. 6 & seq; Cohen Jehoram, *Propriété intellectuelle* 2007, no. 22, p. 6; la Cour de cassation des Pays-Bas reconnaît un droit d’auteur sur la fragrance d’un parfum; B. Hugenholtz, RIDA, no. 226, 4/2010, pp. 299–303, *News from Netherlands*.

Three observations can be made about French case law.

Firstly, the ruling of the Court of Justice validates the most recent reasoning proposed by the French Court of Cassation.

After attempting to justify – questionably – the exclusion of scents from copyright protection by reducing them to simple know-how (see below), the court maintained the principle of non-protection at the cost of a change in its reasoning: scents did not qualify for copyright protection because they did not present in a precise, identifiable form. The French Court of Cassation ruling of 10 December 2013²¹ leaves no doubt about this, restating the principle clearly:

“But whereas authors’ rights protect creations in their perceptible form only insofar as the latter is identifiable with sufficient precision to permit its communication; whereas, accordingly, a perfume fragrance, which, apart from its composition process, which is not itself a work of the mind, does not assume a form presenting this characteristic, cannot enjoy protection by authors’ rights.”
(Emphasis added).

Secondly, the almost identical reasoning of the French Court of Cassation and the Court of Justice of the European Union may well dramatically reduce resistance from certain lower courts opposed to the exclusion rule.²²

21. Com., 10 Dec. 2013, no. 11-19.872; RIDA no. 239 1/2014, p. 499 and p. 415, obs. P. Sirinelli; Comm. com. électr. 2014, comm. 13, note C. Caron; Propr. intell. 2014, p. 51, obs. J.-M. Bruguière; D. 2014, p. 2079, obs. P. Sirinelli.

22. See for example M. Vivant, D. 2007. Point de vue 1088: Parfum: l’heureuse résistance des juges du fond.

Mostly because the previous ground retained by the Court of Cassation was unsatisfactory.

Therein lies the third observation. The reasoning retained by both the first civil chamber²³ and the commercial chamber²⁴ of the Court of Cassation was based on another argument. The initial ruling in this case law sequence was emphatic:

“A perfume fragrance, which is the result of the simple application of know-how, does not constitute the creation of a form of expression, within the meaning of the [IPC], able to benefit from the protection of works of the mind by authors’ rights.”

This reasoning attracted some criticism. Can a perfume really be reduced to the simple application of know-how? And what creations coming under copyright protection do not require a minimum level of know-how? Pictorial artists have generally learnt how to paint and draw. A programmer needs to master the constraints of computer programming and will have learnt how to do this. Musicians usually need to know and apply chord theory, etc.

23. 1st civil chamber, 13 June 2006, no. 02-44.718; RIDA, no. 209, 2/2006, p. 209, note Kéréver, D. 2006, p. 2470, note B. Edelman; D. 2006, p. 2993, obs. P. Sirinelli; JCP G 2006, II, 10138, note F. Pollaud-Dulian; Propr. intell. 2007, no. 24, p. 367, obs. M. Vivant; Dr. et patrimoine 2007, no. 156, p. 42, note J.-M. Bruguière, Légipresse 2007. II. 184, obs. C. Alleaume, Propr. ind. 2006, no. 82, note J. Schmidt-Szalewski, RTD com. 2006. 587, obs. F. Pollaud-Dulian; Cass. 1st civil chamber, 22 Jan. 2009, no. 08-11.404; RIDA no. 219 1/2009, p. 371, obs. P. Sirinelli; RTD com. 2009, p. 302, obs. F. Pollaud-Dulian.

24. Com., 1 July 2008, no. 07-13.952; D. 2009, p. 1182, note B. Edelman; Comm. com. électr. 2008, comm. 100, obs. C. Caron; Propr. intell. 2008, no. 29, p. 419, obs. J.-M. Bruguière.

In failing to explore the reasoning on know-how, the Court of Justice incidentally revealed the inherent of this argument. Let's hope that this line of reasoning will not be pursued in future cases – whatever the type of creative work concerned.

Does this mean that excluding perfumes from copyright protection is a definitive solution and that no future plaintiff will seek such protection? The answer is uncertain because while the exclusion from protection seems clearly asserted, the perception of the form of the subject matter for which protection is sought could change. The appearance of “artificial noses” for example, could help better determine – in a precise and objective manner – the contours of the form in question and hence the scope of the protection sought. This would resolve in part the difficulties beforehand in relation to originality and the issue of similarities with another allegedly counterfeit production at a later stage.

2. PHOTOGRAPHS – BALANCING INTERESTS

CA Versailles, 1st chamber. section 1, 16 March 2018, no. 15/06029
- A Malka v P Klasen

The test of proportionality between copyright over a primary work and the artistic freedom of the author of a secondary work hangs on the substitutability and hence the necessity of the primary work.

The French Court of Cassation has undertaken a reform, one of the consequences of which was to favour scrutiny of proportionality over syllogism,

in line with the type of reasoning adopted by supranational courts. Copyright is no exception. Thus, in its famous *Klasen* ruling, the Court of Cassation asked the second court of appeal to balance the interests of copyright and freedom of expression to ascertain whether the unauthorised appropriation of fashion photographs into paintings constituted copyright infringement.²⁵ In this case, a painter [Klasen] appropriated photographs representing the made-up face of a young woman, originally published in an Italian magazine in a section entitled “*glam and shine*”. A proponent of appropriation in art, the painter argued that his work constituted a social critique.

The keenly anticipated appeal ruling was handed down by the court of appeal of Versailles on 16 March 2018.²⁶ The court found that the painter had not established how setting a fair balance between the fundamental freedoms at issue required him to use the photographer’s work without his consent, and thus tilted the balance in favour of ownership rights, basing its reasoning on the substitutability of photographs, from which it followed that these specific

25. 1st civil chamber, 15 May 2015, no. 13-27391, D. 2015, p. 1094, obs. A. T.; *ibid.* p. 1672, comm. A. Bensamoun and P. Sirinelli; Comm. com. électr. 2015, comm. 55, note C. Caron; JCP G 2015, 967, note C. Geiger; *Légipresse* 2015, p. 474, note V. Varet; Propr. intell. 2015, p. 281, obs. A. Lucas, and p. 285, obs. J.-M. Bruguière; RTD com. 2015, p. 515, obs. F. Pollaud-Dullian. – See also P.-Y. Gautier, “Contre la ‘balance des intérêts’: hiérarchie des droits fondamentaux”, D. 2015, p. 2189; C. De Haas, “Quelques réflexions sur les origines de l’irrésistible émergence du principe de proportionnalité avec balance des intérêts in situ. À propos de l’arrêt *Klasen* rendu par la première chambre civile de la Cour de cassation le 15 mai 2015”, Propr. intell. Oct. 2016, p. 418; C. Thomas-Raquin and M. Le Guerer, “Pratique contentieuse. Le contrôle de proportionnalité en droit d’auteur devant la Cour de cassation”, Comm. com. électr. no. 1, 2018, p. 50; É. Treppoz, “*Klasen*: liberté de création et tension”, *Juris art. etc.* no. 39, 10/2016, p. 28; M. Vivant, “La balance des intérêts... enfin”, Comm. com. électr. 2015, paper 17.

26. CA Versailles, 1st chamber, 1st section., 16 March 2018, no. 15/06029, JCP G 2018, 513, note J.-M. Bruguière; Comm. com. électr. 2018, comm. 32, note C. Caron; LÉPI June 2018, p. 4, obs. A. Lucas; Propr. intell. 2018, no. 68, p. 66, obs. A. Lucas; Dalloz IP/IT 2018, p. 300, obs. V.-L. Benabou; RTD com. 2018, p. 345, obs. F. Pollaud-Dullian; *Légipresse*, June 2018, no. 361, p. 336, note V. Varet.

photographs were not necessary to exercise the freedom claimed. The Court's reasoning to arrive at this conclusion is doubtless the main contribution of the appeal ruling, as both theorists and practitioners were seeking clarity on how to strike a fair balance in practice. The result may not be quite up to expectations, although some will welcome the fact that copyright emerged unscathed. But the ruling throws up many parallel questions and is puzzling in other aspects.

To avoid the charge of copyright infringement, authors of secondary works typically try to attack at either end of the chain, first contesting the fact that photographs, primary works, are considered primary works (I); if this argument fails, they will then try to hamstring the exercise of rights (II).

I. DISPUTING THE ORIGINALITY OF PRIMARY WORKS

The first question raised is that of the originality of primary works. In a negative interpretation, the court first rejected various arguments as irrelevant (A), and then suggested a positive qualification of the eligibility criterion for protection (B).

A. Negative interpretation

From a negative perspective, originality was disputed due to the photographer's lack of freedom and in consideration of the genre to which the primary works belonged.

Firstly, the painter argued that the photographer had merely worked to order, with no room for manoeuvre, that his work had to comply with the overall style of the magazine, and that hence there was no room for freedom of expression on the photographer's part.

This assertion proved too hasty, however. It cannot be argued that just because there is an order – even if it includes a brief – the author cannot be creative, because this would mean excluding utilitarian works from protection, which is prohibited by the principle, set out in article L. 112-1 of the Intellectual Property Code, that the purpose of the work is immaterial.

It should be noted that the Intellectual Property Code says more or less the same thing when stipulating what happens to rights in the event of artistic creation by salaried employees or produced to order. Paragraph 3 of article L. 111-1 thus provides that “*[t]he existence or conclusion of a contract for hire or of service by the author of a work of the mind shall in no way derogate from the enjoyment of the right afforded by the first paragraph above.*” Despite all the practical difficulties and the failed attempts at reform, the legislators retained the principle that the author-creator, a natural person, has initial ownership of such works. Thus, the existence of a commissioning contract (what the code calls “for hire”) is irrelevant when it comes to characterising works. Case law has repeatedly restated this,²⁷ including in photography,²⁸ unless originality is obviously the sole preserve of the ordering party.²⁹

27. See in particular 1st civil chamber, 24 Oct. 2000, no. 97-19032, JCP G 2000, IV, 2824.

28. Soc., 24 Jan. 2001, no. 98-45802, Légipresse 2001, III, p. 41, 2nd esp., note B. Montels.

29. 1st civil chamber, 2 May 2001, RIDA no. 191 1/2002, p. 177, obs. A. Kéréver.

In its ruling, the court of appeal therefore stated that “*the order from the magazine which published the visuals at issue does not itself exclude originality if it can be effectively implemented in a manner that displays the author’s personal touch; in brief, an order does not exclude the author’s personal and creative interpretation*”.

Furthermore, the painter denied the photographs were original because they were glamour photographs as evidenced by their “*hackneyed character as advertisements*”. Submitting iconographic research at the hearing, he argued that the choices made by the photographer were banal and that the protection sought would amount to protecting a genre. Here again, the principle of non-discrimination between works means that the genre of the work being evaluated, its merits or purpose should not be taken into consideration. Evidently, the fact that the works in question are photographs of make-up, that their purpose is utilitarian (advertising), and that they are glamour shots does not mean disqualification. While genre does not automatically entail protection, protection is not exclusive to any one genre. Thus, the second court of appeal ruled that “*the photographic treatment of make-up products does not in itself exclude originality; there is no law on genre that imposes any given photographic treatment; and hence the author can undeniably give his own personal touch in the treatment of the image*”. It further stated that “*the usual photographic techniques can also be implemented in a manner that is quite particular to the author; the same applies to the glamour genre; in short, the fact that the visuals at issue belong to this genre does not in itself exclude originality*”.

B. Positive categorisation

After excluding the criteria irrelevant to accessing protection, the court characterised photographic creations in a positive light, highlighting their originality. In the famous *Painer* ruling,³⁰ European case law clarified that originality can manifest beforehand, when the pictures are taken, or afterwards, through subsequent work on the photographs, and that originality does not have to be manifest in each of these three stages:

“90 As regards a portrait photograph, the photographer can make free and creative choices in several ways and at various points in its production.

“91 In the preparation phase, the photographer can choose the background, the subject’s pose and the lighting. When taking a portrait photograph, he can choose the framing, the angle of view and the atmosphere created. Finally, when selecting the snapshot, the photographer may choose from a variety of developing techniques the one he wishes to adopt or, where appropriate, use computer software.

“92 By making those various choices, the author of a portrait photograph can stamp the work created with his ‘personal touch’.”

30. CJUE, 1 Dec. 2011, case C-145/10, Eva-Maria Painer, RIDA, no. 232 2/2012, p. 324, obs. P. Sirinelli; Comm. com. électr. 2012, comm. 26, obs. C. Caron; Propr. intell. 2012, no. 42, p. 30, obs. A. Lucas; D. 2012, p. 471, note N. Martial-Braz; RTD com. 2012, p. 109 and 118, obs. F. Pollaud-Dulian; JDE 2012, no. 189, p. 146, obs. V.-L. Benabou; RLDI 2012, no. 78, p. 14, obs. L. Costes and no. 80, p. 14, obs. V. Dahan and C. Bouffier.

In the ruling, the court took into account “*the angle of view chosen and the choice of lighting*”. However, this reasoning is not without its critics, undoubtedly because genre and purpose are not unrelated, at least not to the court of appeal. That court revisited the notion of genre, indicating that the photograph was not “*hackneyed*”, holding that the author had made “*aesthetic choices*” and assessing originality in a manner that combined a traditional approach and criteria taken from the law on designs and models. The court held that originality should not be assessed based on each element taken in isolation but according to “*the overall impression produced by their layout to determine if the photographs had their own physiognomy distinguishing them from other photographs of the same genre*”. This type of reasoning is not unprecedented in trial court case law on utilitarian works;³¹ it refers to the mechanisms and vocabulary of article L. 513-5³² regarding designs and models. However, the commercial chamber of the Court of Cassation has previously condemned this incorporation of criteria into copyright law.³³ While ultimately it is true that the decision of the Versailles court also refers to the conventional criterion of the author’s personal touch to characterise originality; the detour via industrial property law is puzzling, as if the conventional approach on its own was insufficient.

31. Regarding a website, using exactly the same vocabulary, see CA Versailles, 12th chamber, 21 June 2016, no. 15-00612, Propr. intell. no. 62, Jan. 2017, p. 14, note C. Bernault; RIDA, no. 255 1/2018, p. 197, obs. A. Bensamoun and P. Sirinelli.

32. “The protection conferred by the registration of a design or model shall be extended to any design or model which does not produce on the informed observer a different overall visual impression.”

33. Com., 8 April 2014, no. 13-10689, unpublished, Propr. intell. 2014, no. 52, p. 273, obs. A. Lucas.

Having failed in his characterisation of the photographs, the painter attempted to hamstring the subsequent exercise of rights.

II. THE ATTEMPT TO STYMIE RIGHTS

The application of copyright law is suspended in certain cases. While exceptions to copyright law are essential to ensuring the acceptability of protection and to balancing interests, the interference of fundamental rights in French law could upset the balances (A). In an attempt to evade the charge of copyright infringement due to the unauthorised use of photographs, the author of the secondary works invoked two mechanisms to suspend the application of rights: the exception of parody (B) and the balance of interests between fundamental rights (C).

A. Balance, balances...

In French law, exceptions to author's copyright are subject to strict interpretation. In contrast to the concept of fair use applied in America, the list of exceptions is exhaustive, just as it is in European law.³⁴ However, exclusivity can also be kept in check by external standards, particularly competition law or personality rights. The specific nature of copyright means that it cannot give rise to an “*self-sustaining*”³⁵ system; rights do not operate autonomously.

34. CJEU, 16 July 2009, case C-5/08, *Infopaq International*, A & M 5/2009, p. 521; Comm. électr. 2009, comm. 97, note C. Caron; Propr. intell. 2009, p. 379, obs. V.-L. Benabou; JCP E 2010, 1691, no. 11, obs. F. Sardain; RTD com. 2009, p. 715, obs. F. Pollaud-Dulian; Paragraphs 56–58.

35. V.-L. Benabou, “Drawing from the Source of Authors' Rights”, RIDA no. 192 2/2002, p. 2, esp. p. 82.

Nevertheless, there has been a lively academic debate surrounding freedom of expression. Considering that many exceptions are rightly based on freedom of expression (parody, short quotation, etc.), some academics have opposed using article 10.1 of the European Convention on Human Rights as an external means of stymieing the exercise of copyright. The argument here is that balance is already provided within copyright law.

After rejecting this reasoning on the ground that “*the author’s legal monopoly over his work is an intangible property right, guaranteed under the right of any natural person or legal entity to enjoy peaceful enjoyment of his possessions, to which the legislators set proportional limitations, both in terms of the exceptions listed under article L. 122-5 of the Intellectual Property Code and of manifest abuse as per article L. 122-9 of the same code*”³⁶, the Court of Cassation accepted it in the *Klasen* appeal ruling.³⁷ Courts in other EU member states have followed suit³⁸ and the European Court of Human Rights has even weighed interests at the request of copyright infringers attempting to evade sanction using the freedom of expression argument.³⁹

36. 1st civil chamber, 13 Nov. 2003, Musée de Lodève, D. 2004, jurisp. p. 200, note N. Bouche; Comm. com. électr. Jan. 2004, comm. no. 2, note C. Caron; Propr. intell. no. 10, Jan. 2004, p. 550, obs. A. Lucas; Légipresse no. 209, March 2004, III, p. 23, note V. Varet; JCP G 2004, II, 10080, note C. Geiger.

37. 1st civil chamber, 15 May 2015, op cit.

38. For a more complete analysis of comparative law, see: A. Lucas and J. Ginsburg, “Copyright, freedom of expression and free access to information (comparative study of American and European law)”, RIDA no. 249 3/2016, p. 4, esp. p. 26-69.

39. ECHR 10 Jan. 2013, no. 36769/08, *Ashby Donald v France*, RIDA no. 237 3/2013, p. 322, and p. 236, obs. P. Sirinelli; Comm. com. électr. 2013, comm. 39, note C. Caron; Propr. intell. 2013, p. 216, obs. J.-M. Bruguière; RTD com. 2013, p. 274, obs. F. Pollaud-Dulian; D. 2013, p. 2487, obs. J. Larrieu, C. Le Stanc and P. Tréfigny. – ECHR, 19 Feb. 2013, no. 40397/12, *Neij and Sunde Kolmisoppi v Sweden*, “*The Pirate Bay*” case: RIDA no. 237 3/2013, p. 324, and p. 236, obs. P. Sirinelli; Comm. com. électr. 2013, comm. 63, note C. Caron; Propr. intell. 2013, p. 216, obs. J.-M. Bruguière; RTD com. 2013, p. 274, obs. F. Pollaud-Dulian; D. 2013, p. 2487, obs. J. Larrieu, C. Le Stanc and P. Tréfigny.

This reversal could be either welcomed or contested. Some have criticised reactions from academics denouncing the advent of an American-style fair use system,⁴⁰ fearing “*the model of a court of equity and appropriateness*”⁴¹ or calling for a hierarchy of fundamental rights.⁴² Even though the lines of reasoning are substantiated, not everyone will find them convincing. It is also difficult to contest the fact that balancing interests ultimately comes down to setting up a sort of open-ended “*meta-exception*”,⁴³ with unknown limits and implementation conditions, while noting that the instrument was aimed at removing basic obstacles due to the faint-hearted interpretation of exceptions by the courts.⁴⁴ Because they are highly controversial, the criteria laid down by the second court of appeal do not provide much assistance. The opening-up challenges the balance imposed in the internal legal order, here as in other matters.

Does this mean that from now on one should simply note the paradigm shift in copyright law? The answer depends on what the lower courts do with the instrument they have been given. Balancing interests may redraw the boundaries of copyright law or serve merely as an additional tool for use on the margins.

Before the ruling, the Paris court of appeal had already effectively implemented the new instrument in the *Prokofiev* case. In this case, Prokofiev’s

40. C. Caron, note re 1st civil chamber, 15 May 2015, op. cit.

41. F. Pollaud-Dulian, “*Quo vadis lex?* La législation française sur le droit d’auteur dans les affaires de la modernité”, RTD com. 2016; p. 641.

42. P.-Y. Gautier, “Contre la “balance des intérêts” (...)”, op. cit.

43. A. Bensamoun and P. Sirinelli, comm. re 1st civil chamber, 15 May 2015, op cit.

44. On these criticisms, see J.-M. Bruguière, note on appeal ruling, op.cit.

heirs brought proceedings for copyright infringement against the composer of a music work that patently drew too heavily on a passage in the ballet *Romeo and Juliet*. Convicted at first instance, the composer appealed, arguing artistic licence and invoking the *Klasen* ruling. In its ruling handed down on 25 September 2015⁴⁵ the court of appeal rejected the various arguments, including the one based on article 10 of the European Convention, on the grounds that the appellant “*had not put forward any argument that would enable the court to adjudicate in concrete terms on the balancing of competing rights*” and referred to the benefit of exceptions to evade copyright, which the appellant had not invoked. Similarly, in the *Jeff Koons* case⁴⁶ relating to the sculpture *Naked*, which copied a photograph of children by Bauret, TGI Paris found that Koons had “*failed to justify why he needed to use this representation of two children for his artistic work without the author’s permission and that the assertion of copyright by the applicants did not constitute disproportionate infringement of freedom of expression*”. The same happened in a case where Koons was found to have plagiarised an advertisement for Naf-Naf clothing in a porcelain sculpture.⁴⁷

Finally, we should add that the balance of interests affects not just property rights, but also moral rights. So said the Court of Cassation in

45. CA Paris, Pole 5, chamber 2, 25 Sep. 2015, no. 14/01364, *Blazy v Le Chant du Monde & consorts Prokofiev*, Propr. intell. 2016, no. 58, p. 51, obs. A. Lucas; JCP E 2016, 1481, § 10, obs. A. Zollinger.

46. TGI Paris, 3rd chamber, 4th sect., 9 March 2017, no. 15/01086, unpublished, D. 2017. 759, obs. F. Laffaille; Dalloz IP/IT 2017, p. 277, obs. P. Mouron; RTD Com. 2017, p. 353, obs. F. Pollaud-Dulian; Juris art etc. 2017, no. 46, p. 3, obs. E. Treppoz; Propr. intell. 2017, no. 64, p. 69, obs. J.-M. Bruguière; JCP E 2018, 1031, §10, obs. A. Zollinger.

47. TGI Paris, 3rd chamber, 1st sect., 8 Nov. 2018, no. 15/02536, Propr. intell. 2019, no. 70, p. 27, obs. A. Lucas and p. 30, obs. J.-M. Bruguière.

relation to *Dialogue des Carmélites*,⁴⁸ where Dimitri Tcherniakov's staging made significant changes to the end of Francis Poulenc's opera, itself based on the posthumous work of Georges Bernanos. The Court of Cassation referred the case to the court of appeal of Versailles.⁴⁹ Holding that a "*fair balance needed to be found between the author's rights to the integrity of his work and the freedom of the director*", the Versailles court found that as a derivative work, the disputed staging offered an "*interpretation in line with the creative freedom of its author but did not infringe the integrity of the work*".

As we have seen, the lower courts have to perform a real "*balancing act*"⁵⁰ to find the right balance of interests in concrete terms, although how this is to be done in practice remains unclear. Balancing has now become plural, oscillating between the legislators (the exceptions) and the courts (balancing interests).

B. The parody exception

One of the grounds of defence put forward by the painter was the exception of parody. Contrary to the lower courts, the Paris court of appeal⁵¹ rejected the parody argument made on an ancillary basis by the artist, based

48. 1st civil chamber, 22 June 2017, appeal no. 15/28467 and 16/11759, RTD com. 2017, p. 891, obs. F. Pollaud-Dulian; D. IP/IT 2017, p. 536, J. Daleau; JCP G 2017, p. 890, X. Daverat; Com. com. élect. 2017, comm. 69, C. Caron; Propr. intell. 2017, no. 65, p. 60, obs. A. Lucas; D. 2017, p. 1955, Ph. Malaurie; Comm. com. élect. 2018, p. 2; C. Thomas-Raquin and M. Le Guerer.

49. CA Versailles, 1st chamber, 1st sect., 30 Nov. 2018, n° 17/08754, P.-Y. Gautier, «Retour au Moyen-Age: le droit moral dévasté par la balance des intérêts», D. IP/IT, Feb. 2019, p. 101.

50. A. Zollinger, "Droit d'auteur et liberté d'expression. Comment procéder à la balance des intérêts *in concreto*?", Comm. com. élect. 2017, paper 7.

51. CA Paris, Pole 5, chamber -1, 18 Sep. 2013, no. 12/02480.

on the “*right of inspiration*” and justified by the end pursued, which was to provoke. The Court of Cassation rejected this argument and remitted the matter to the second court of appeal. The painter reiterated his arguments and contended that “*his approach involved exposing the excesses of consumerism and the ‘advertising subculture’ through the image of women in the media, the primary advertising target*”, adding that there was no risk of confusion between his own work and the works of the claimant.

For his part, the photographer refuted the prerogative of exception, contending that there was no material or moral element of parody, the conventional distinction since Françon.⁵² He also argued that the material element was lacking insofar as his works were “*incorporated as is*”, except for colouring and occasional reframing. According to him, the moral element was also missing, given that there was no humorous intent: “*simply claiming membership of the movement of narrative figuration or relying on ‘the 1970 manifesto’ could not alone justify the right to reproduce in 2017 the three works at issue in a few dozen contentious works*”.

The Versailles court responded that “*the parody exception relates to the work itself; just because a work – even one aimed at social critique – is incorporated in another work does not mean that it is a parody; that if that was the message of Mr. Peter K’s work, it must be noted that the photographs of Mr. Alix M. are not themselves parodied; that in fact, the elements added do not strip the contentious photographs of the attractive impact intended by the photographer,*

52. “Questions de droit d’auteur relatives aux parodies et productions similaires”, Dr. auteur 1988, p. 302.

because they are merely juxtaposed with other unorthodox representations, inviting investigation of the relevance of the attraction induced by the primary work; that therefore although they involve the appropriation of another's work, the works of Mr. Peter K. cannot be classified as parody or mockery of the primary works as defined in article L. 122-5(4) of the Intellectual Property Code; that the appealed judgement is therefore reversed on this point”.

Here the analysis relates only to the material element, which implies that there must be no confusion between the primary work and the secondary work – a condition that appears fulfilled in this case. It also implies that the nature of exception itself needs investigation: should parody be transformative or not?⁵³ Does it imply that the primary work is modified? The second court of appeal ruled that it does and stated that parody “*concerns the work itself*”. In other words, a parody must relate to the work, implying therefore that the primary work should not be incorporated as is – which it was in this instance. And yet, the CJEU – which in the *Deckmyn* ruling⁵⁴ held that parody was an autonomous concept under EU law – said precisely the opposite, holding that the exception provided for in article 5(3)(k) of Directive 2001/29 is not subject to the condition that parody “*should relate to the original work*

53. For an overall reflection on this topic, see V.-L. Benabou, *Mission of CSPLA relating to transformative creations*:

<http://traduction.culture.gouv.fr/url/Result.aspx?to=en&url=http%3A%2F%2Fwww.culture.gouv.fr%2FThematiques%2FPropriete-litteraire-et-artistique%2FConseil-superieur-de-la-propriete-litteraire-et-artistique%2FTravaux%2FMissions%2FMission-du-CSPLA-relative-aux-creations-transformatives>.

54. CJEU, 3 Sep. 2014, case C-201/13, *John Deckmyn and Vrijheidsfonds VZW v Helena Vandersteen et al*, Propri. intell. 2014, p. 393, obs. J.-M. Bruguière; Comm. com. électr. 2014, comm. 82, note C. Caron; RIDA no. 242 4/2014, p. 386, obs. P. Sirinelli; RTD com. 2014, p. 815, obs. F. Pollaud-Dulian; D. 2014, p. 2097, note B. Galopin; Légipresse 2014, p. 604, note N. Blanc; JCP E 2015, 1389, no. 7, obs. A. Zollinger; RLDI 2014/108, 3583, obs. C. Castets-Renard.

itself. Disregarding this precedent, the court of appeal rejected the benefit of exception.

The court did not specifically refer to the moral element. Does this mean that there was none in this case? Nothing could be less certain. In fact, humorous intent could be part of a wider message. The *Deckmyn* ruling states that “*parody is an appropriate way to express an opinion*”.⁵⁵ In the ruling, the judges do not seem to have worried about such distinctions, confining themselves to asserting that social critique as defended by the appropriation movement is not on its own sufficient to characterise the parody or ‘*derision*’ required to avail of the benefit of exception.

Ultimately – and regrettably – this interpretation is insufficiently reasoned and too narrow to establish parody. And yet, undoubtedly because exceptions are not traditionally applied to their full extent despite the recommendation of the Court of Cassation,⁵⁶ the attraction of fundamental rights becomes more pressing.⁵⁷

55. *Op. cit.*, Paragraph 25.

56. 1st civil chamber, 14 June 2005, 2 rulings, Com. com. électr. Sep. 2005, comm. 132, note C. Caron; Propr. intell. 2005, p. 438, obs. A. Lucas: “the strict application of a repealing provision does not exclude it from being applied to its full extent” (the quotation is taken from the 1st case but the second contains a similar assertion).

57. For a scholarly proposal, see J.-M. Bruguière, “Reception of British ‘fair dealing’ in the French closed system of exceptions. A plea in favour of ‘fair dealing’ à la française using revivification of copyright standards (and the revelation of the philosophy of the ‘reasonable’”, RIDA no. 257 3/2018, p. 5. – And, also developing the general idea of a philosophy of the ‘reasonable’ in copyright law, A. Bensamoun, *Essai sur le dialogue entre le législateur et le juge en droit d’auteur*, PUAM, 2008. See also P. Sirinelli, “Brèves observations sur le “raisonnable” en droit d’auteur”, in *Propriétés intellectuelles, Mélanges en l’honneur de André Françon*, Dalloz, 1995, p. 397.

C. Balancing fundamental rights

The other means of contesting the application of monopoly consists of invoking fundamental rights. The Court of Cassation here reproached the Paris court of appeal for not explaining “*in concrete terms how seeking a fair balance between the rights at play required the judgement handed down*”. Thus, the balance of interests requires the courts to provide the reasoning behind the articulation between fundamental rights – in this case, the right of ownership, which includes copyright – and the freedom of expression underlying artistic licence. The issue here therefore is to settle a conflict between fundamental rights of equal value – as highlighted by the second court of appeal – in the same way as the ECHR, by applying the three-step verification specifically provided for in article 10.2 of the Convention: is the restriction on freedom of expression provided for by law? Does it have a legitimate purpose? Is it proportionate to the goal pursued? The first two questions do not pose any difficulties for copyright law: the restriction is provided for by law and means that the property of others can be legitimately protected. What remained to be determined was the proportionality of this interference.

The reasoning pursued by the court on this point is puzzling. Noting that “*freedom of expression and copyright are both fundamental rights protected by the European Convention on Human Rights*”, it first pointed out that member states retained “*significant room for manoeuvre*” when it came to balancing interests. It then noted that copyright provisions pursued a legitimate goal – which was not contested – and that “*in these conditions, the prohibition on representing or reproducing a work without the author’s permission was proportionate to the goal*”

pursued'. The court was not asked to rule in abstract terms on the legitimacy of French law. And the issue of proportionality should not be deduced from this. Its role was rather to determine the balance between the different rights at play taking the facts of the matter into consideration.

The ruling went on to state that “*the courts must not set themselves up as arbitrators of a right that is more deserving of protection than another*”. Should this be seen as a “*dissenting ruling*”?⁵⁸ The statement needs interpretation. In fact, it relates to the weight of concrete research, which is not the remit of the courts.

The second court of appeal was tasked with answering two questions: the burden of proof and the subject matter of proof.

The burden of proof, necessary to balance interests, lies with the respondent, who must prove, in line with article 1353, paragraph 2, of the Civil Code, that they are released from copyright rules due to the predominance of another fundamental freedom. “*Whereas on the contrary, Mr. Peter K., claiming freedom of expression, must establish how a fair balance between protecting this right and that due to the photographer’s right entitled him to use the latter’s works without permission (...)*”.

The statement also provides information on the subject of proof: here, the test of proportionality requires proof – not provided in this case – that use of the primary works was necessary in the secondary works. This

58. A. Lucas, obs. on this ruling, *op. cit.*, p. 69.

necessity is assessed, according to the court of Versailles, in reference to the “substitutability” of the primary works: in this regard, the author of the secondary works “*could have used other advertising photographs of the same genre*”. In these conditions, use of the primary works was not “*necessary*” to the exercising of freedom of expression by the secondary author. The court concluded that “*asking for the author’s prior permission cannot constitute an infringement of his right to create*”.

So much for the long-awaited methodology! The criterion of necessity⁵⁹ must be assessed in terms of the substitutability of works used without permission. But how can this non-substitutability be proven? Other than imposing a “*significant restriction on artistic freedom*”⁶⁰, in that only the obligation to use a specific work could excuse the behaviour in question, how should this proof be provided? How is the use of the primary work in the secondary work to be justified – and how can artists be compelled to do so? And how can the courts legitimately assess such a justification, how can they ascertain the value of appropriation while avoiding the risk of introducing forms of judicial censorship?

This model is supplemented by a second, no less reassuring criterion – identification. Citing the argument presented by Klasen regarding the use of cans of “*Campbell soup*” by Warhol and the “*Déjeuner sur l’herbe*” in several paintings, the court of appeal held that “*the analogy was not appropriate in this case*”, firstly because the cans of soup were everyday

59. More generally, see A. Zollinger, “La nécessité, nouvelle exception au droit d’auteur?”, *Prop. intell.* 2019, no. 70, p. 6.

60. V.-L. Benabou, obs. on this ruling, *op. cit.*

consumer staples and “*nothing suggested that Andy W. was responsible for the graphics of the Campbell soup cans*”, and then because “*in Picasso’s painting, the primary work was clearly identifiable, such that it was obviously an ‘appropriation’*”. The court concluded that “*this was not the case with Mr. Alix M.’s photographs, which were not sufficiently well-known to be identified as such in the secondary work*”. Does this mean that had the author been well-known and his work identifiable (by whom? a lay, informed or expert public?), he would have to tolerate appropriation, including a slavish copy as in this case, while a lesser-known author could oppose it? A sort of variable protection depending on the author’s reputation, the reputation of his work or both? Let’s not get ahead of ourselves here... The concrete application of the balance of interests by the courts has evidently not yet revealed all its secrets.

3. LIABILITY OF THE OWNER OF AN INTERNET SUBSCRIPTION IN THE EVENT OF COPYRIGHT INFRINGEMENT

CJUE, third chamber, 18 October 2018, case C-149/17 – Bastei Lübbe GmbH & Co. KG v M Strotzer

The owner of an internet connection used for copyright infringements through file-sharing cannot be held liable to pay damages if he can name at least one family member who might have had access to that connection.

“*If it wasn't you, then it was your...*”⁶¹ The ruling handed down by the CJEU on 18 October 2018⁶² illustrates perfectly the proliferation of targets in copyright infringement: alongside infringers themselves, people also seek to pin liability on internet access subscribers or on UUC platforms (user uploaded content).⁶³ This means that the fight against copyright infringement is now multi-pronged:⁶⁴ awareness-raising and compensation schemes for internet users, “follow the money” approaches involving intermediaries, blocking procedures, naming and shaming of some stakeholders, etc. This fight against content piracy, which is becoming more and more circuitous, inevitably poses questions of balance between rights: privacy, freedom of expression, intellectual property, etc.

Can subscribers of an internet connection that is used to share protected files without permission evade liability by pointing the finger at a family

61. J. de La Fontaine, *The Wolf and the Lamb* (1668):

“(…) *And I know you said bad things of me last year.*

– *How could I do that when I wasn't born,*

Answered the lamb; I am still at my mother's breast.

– *If it wasn't you, then it was your brother.*

– *I haven't a brother.*

– *It was then someone close to you;*

For you have no sympathy for me,

You, your shepherds and your dogs.

I have been told of this. I have to make things even. (...) [Translation by Eli Siegel]”

62. CJEU, 18 Oct. 2018, C-149/17, *Bastei Lübbe GmbH & Co. KG*, D. 2008, summary, p. 2270, obs. J. Larrieu, C. Le Stanc and P. Tréfigny; RCA, Dec. 2018, alert 26; Propr. intell. 2019, no. 70, p. 39, obs. C. Bernault; D. IP/IT, p. 40, comm. A. Bensamoun. – *The authors thank the Dalloz IP/IT review for the partial reproduction of the commentary published in the above-mentioned issue.*

63. See the proposal for a directive on copyright in the digital single market (COM (2016) 593 final) of 14 September 2016, particularly article 13 (currently under discussion). – A. Bensamoun, “The value gap: an adaptation of copyright for the digital single market”, RIDA 254 4/2017, Tribune, p. 5 and “Le *value gap* ou le partage de la valeur dans la proposition de directive sur le droit d'auteur dans le marché unique numérique”, Dossier *Réforme du droit d'auteur et copyright*, *Revue Entertainment*, Bruylant, no. 2018-4, p. 278.

64. Hadopi, *Rapport de veille internationale – Stratégies de lutte contre la piraterie*, Feb. 2019.

member with access to this connection, without providing any further clarification? Generally speaking, the issue involves mediating between privacy protection and copyright protection in the digital universe. More specifically, it involves reflecting on the “effective and dissuasive” character of the sanction and the effectiveness of measures to ensure intellectual property rights are upheld.

The *Bastei Lübbe* case revolves around copyright infringement in the family sphere, families of legislation, opposition between (fundamental) rights within the same family. In short, a family affair (I), based on family resemblance (II), which in fact hides a family feud (III).

I. A FAMILY AFFAIR

The question put to the CJEU in the *Bastei Lübbe* case is twofold, based firstly on Directive 2001/29 (the Infosoc Directive) and secondly on Directive 2004/48 on the enforcement of intellectual property rights; but the problem is in fact one and the same thing – and requires a homogeneous solution in the name of the principle of unity and coherence of legal order in the Union⁶⁵ – with the same types of sanctions and measures to be taken in the event of copyright infringement.

In this case, the owner of an internet subscription was sued by a German company that owned the copyright on the audio version of a book for making the audiobook available (as defined in article 3 of Directive 2001/29) for

65. Paragraph 27.

download via a peer-to-peer exchange network. The rightholder had issued a formal warning to the subscription owner to cease and desist this infringement; as this request was ignored, it referred the matter to the courts to obtain financial compensation, in accordance with German law.⁶⁶

In his defence, the subscriber “*denies having himself infringed copyright and maintains that his connection was sufficiently secure*”; he also asserted that his parents, who live in the same household, also had access to that connection, “*but that to his knowledge they did not have the work in question on their computer, were not aware of the existence of the work and did not use the online exchange software*”.⁶⁷ He added that his computer was switched off when the illegal download occurred. These arguments may seem tenuous, particularly as the subscriber did not provide any further details on when his parents could have used the connection or on how the connection was used.

However, under case law of the German *Bundesgerichtshof*, the federal supreme court, this defence is perfectly valid and allows the subscriber to evade liability if he names a family member, because of his fundamental right to the protection of family life. In fact, under this case law, “*it is for the applicant to allege and prove the infringement of copyright. The Bundesgerichtshof considers, moreover, that the owner of an internet connection is presumed to have committed such an infringement provided that no other person was able to use the internet connection at the time of the infringement. However, if the internet connection was not sufficiently secure or was knowingly made available to other*

66. Article 97 of the act on copyright and related rights, cited in Paragraph 11 of the decision.

67. Paragraph 15.

persons, then the owner of that connection is not presumed to have committed the infringement.”⁶⁸ Thus, the owner of the internet connection merely had a “a secondary burden to present the facts”, which he discharged “by explaining that other persons, whose identity he discloses, where appropriate, had independent access to his internet connection and are therefore capable of having committed the alleged infringement of copyright. Although a family member of the owner of the internet connection had access to that connection, the owner of that connection is not, however, required to provide further details relating to the time and the nature of the use of that connection, having regard to the protection of marriage and family guaranteed by article 7 of the Charter of Fundamental Rights of the European Union [...] and the corresponding provisions of the German Basic Law.”⁶⁹

Despite the case law, the Regional court of Munich asked the court of justice for a preliminary ruling on whether this position was in line with the European *acquis* on the protection of intellectual property rights. The issue was to determine “whether article 8(1) and (2) of Directive 2001/29, read in conjunction with article 3(1) thereof, and article 3(2) of Directive 2004/48 must be interpreted as precluding national legislation, such as that at issue in the main proceedings, under which the owner of an internet connection used for copyright infringements through file-sharing cannot be held liable to pay damages if he can name at least one family member who might have had access to that connection, without providing further details as to when and how the internet was used by that family member”.⁷⁰

68. Paragraph 20.

69. Paragraph 21.

70. Paragraph 29.

In accordance with the conclusions of the Advocate General, the CJEU held that the texts mentioned must be interpreted as precluding national legislation, such as that at issue in the main proceedings, under which, as interpreted by the competent national courts, the owner of an internet connection used for copyright infringements through file-sharing cannot be held liable to pay damages if he can name at least one family member who might have had access to that connection, without providing further details as to when and how the internet was used by that family member. The court's based its decision on the "*primary objective*" of Directive 2001/29, which is "*to establish a high level of protection of copyright and related rights, since such rights are crucial to intellectual creation*".⁷¹ The right to respect for private and family life must be reconciled with the other fundamental rights at issue, the right to intellectual property and the right to an effective remedy. Thus, in accordance with article 8 of the above-mentioned directive, member states "*should provide for effective sanctions and remedies for infringements of rights and obligations as set out in this directive*" and "*should take all the measures necessary to ensure that those sanctions and remedies are applied*". These sanctions should be "*effective, proportionate and dissuasive*", as also provided for in article 3.2 of Directive 2004/48, to ensure that "*rightholders whose interests are affected by an infringing activity carried out on its territory can bring an action for damages*".⁷²

However, under the hypothesis put forward, copyright infringement and the identification of the perpetrator of the infringement can never be established because it is not possible to obtain evidence on family members.

71. Paragraph 30.

72. Paragraphs 31 and 32.

This deprives rightholders of the right to an effective remedy and does not allow a fair balance to be struck between the fundamental rights at issue. In fact, the protection of family life systematically precludes a finding of copyright infringement. As the court notes, this “*fundamental right to the protection of family life is, in respect of the national legislation at issue, an obstacle preventing the injured party from obtaining the evidence necessary for supporting its claims from the opposing party*”.⁷³ However, “*article 6(1) of Directive 2004/48, read in the light of recital 20 thereof, must be interpreted as meaning that member states must, in an effective manner, enable the injured party to obtain the evidence within the control of the opposing party necessary for supporting its claims, provided that providing such evidence respects the protection of confidential information*”.⁷⁴

In these conditions, while “*under article 7 of the Charter, persons belonging to the same family may, as such, benefit from special protection allowing them not to be compelled to comply with an obligation requiring them to incriminate one another, where one or another of them is suspected of having committed an illegal act*”⁷⁵ – a fact which is not contradicted by article 8(3)(d) of Directive 2004/48, read in conjunction with article 8(1) and (2) thereof⁷⁶ – this protection must not enable them to evade sanction.

The court added that effective remedies could nevertheless be provided by other means. Thus, the solution could be different if “*for the purposes of preventing what was regarded as an unacceptable interference with family life*”,

73. Paragraph 42.

74. Paragraph 41.

75. Paragraph 49.

76. Paragraph 50.

national legislation provided that “*rightholders had at their disposal another effective remedy, allowing them, in particular, in such a situation, to have the owner of the internet connection in question held liable in tort*”.⁷⁷ In the case of Germany, the CJEU therefore invited the referring court “*to determine whether, if applicable, there are, in the national law concerned, any other means, procedures or remedies which would allow the competent judicial authorities to order that information necessary for proving, in circumstances such as those at issue in the main proceedings, an infringement of copyright and who infringed it be provided*”.⁷⁸

II. A (FALSE) FAMILY RESEMBLANCE

Comparison with the system introduced in France by the 2009 HADOPI legislation may appear obvious – at least in theory. However, the approaches are quite different.

In essence, France has instigated a “graduated response”, described in article L. 331-25 of the Intellectual Property Code and implemented by an independent administrative authority – the High Authority for the dissemination of works and the protection of rights on the internet (Hadopi) – more specifically the Rights Protection Commission of Hadopi. The two-stage procedure implemented in the event of breach by the owner of the obligation to monitor his internet connection – an obligation laid down in article L. 336-3 of the Intellectual Property Code – starts with a warning and culminates in

77. Paragraph 53.

78. Paragraph 54.

criminal proceedings. Article R. 335-5 defines as gross negligence failure by an internet subscription owner to secure or sufficiently secure his connection even though he is aware that copyright infringement is being committed via this connection. A fine is imposed for a repeat offence (third infringement on the same line) involving use of the connection to download or share files. French law thus allows the infringer to be penalised directly for copyright infringement and the subscriber to be penalised indirectly in the event of gross negligence (failure to secure the connection). Criminal proceedings may ensue and offenders are likely to be ordered to compensate the victims for the loss suffered.

The German system is rather different. There, the approach favours compensation and the formal warning letter proposes an amicable settlement procedure as an alternative. There are also restrictions in terms of the fines internet users can be ordered to pay. The system is based on the presumption of liability: the owner of the connection is presumed to have committed the infringement reported by the rightholders. This presumption does not, however appear to be associated with a duty of due care or an obligation to secure the line. Thus, German case law refuses to hold the owner liable if he can show that the internet connection was being used by another person at the time of the infringement. If the connection was knowingly made available to other persons, to evade liability, the owner must identify those persons, who may therefore have committed the infringement. The difficulty in this case lies in the possibility that the owner would be required to identify a family member. Article R. 335-5 defines as gross negligence failure by an internet subscription owner to secure or sufficiently secure his connection

even though he was aware that copyright infringement was being committed this connection. would be required to identify a family member. If this is the subscriber's underage child, German case law holds the parents liable unless they can show that they informed the child and secured access. But when the internet connection is used by adults living in the same household as the subscriber – as in this case – the federal court of justice agreed that the subscriber should not have to provide additional information regarding the time and type of use in question, in light of article 7 of the EU Charter of Fundamental Rights and the relevant provisions under German constitutional law. The subscriber could thus evade liability by either refusing to “inform on” the person responsible or by having tried and failed to identify which of the adult household members had illegally shared protected content. It is precisely this interpretation that was challenged by the CJEU in the *Bastei Lübbe* case.

As we have seen, the French and German systems are not based on the same rationales: the former comprises an initial educational phase and criminal liability of the connection owner, the latter a compensation-based procedure and the presumption of civil liability with identified grounds for exemption of liability.

While it is true that the ruling handed down could be read as legitimising the solution retained in French law in that it holds that the subscription owner can be designated liable by default to avoid invasion of privacy.⁷⁹ In France, it was due to similar considerations that the legislators decided not to list the title of works in the recommendations issued by HADOPI. Paragraph

79. Paragraph 53.

3 of article L. 331-25 of the Intellectual Property Code thus provides that “*advisory notes issued on the basis of this article shall mention the date and time when the acts potentially constituting a breach of the obligation under article L. 336-3 were noted. However, they shall not disclose the contents of the protected works affected by this breach*”.

Thus, contrary to German law, French law does not allow copyright infringers to evade sanctions by invoking their right to privacy. Nonetheless, the CJEU decision does not appear to endorse the idea that effective recourse in civil law can translate into criminal charges laid against the owner of the internet subscription.

III. A NEW FAMILY FEUD (IN THE LARGE FAMILY OF FUNDAMENTAL RIGHTS)

Considering that national regulations as interpreted by case law afford “*almost absolute protection for the family members of the owner of an internet connection, through which copyright infringements were committed by means of file-sharing*”⁸⁰ and thus make it impossible to characterise infringement and identify the perpetrator and hence to take action and enforce intellectual property rights, the CJEU found that “*the requirement to ensure a fair balance between the various fundamental rights in question is not respected*”.⁸¹

80. Paragraph 52.

81. Paragraph 51; see, by analogy, the ruling of 16 July 2015, *Coty Germany*, C-580/13, Paragraph 41.

It must be said that copyright law seems to have become *the* preferred arena for disputes regarding fundamental rights. This has long been the situation in European law and now also in domestic law, with *Klasen*⁸² or the *Dialogue des Carmélites*,⁸³ cases that balance property and moral rights against freedom of expression as laid down by article 10 of the ECHR.

The necessity of reconciling rights of equal value requires a test of proportionality, the handling and outcome of which are not yet fully mastered. The requirement is twofold:⁸⁴ (1) when transposing directives, national legislators must ensure a fair balance between the different fundamental rights protected by the legal order of the EU; and (2) when implementing provisions, the authorities and courts must not interpret these in a way that would contradict fundamental rights or other general principles of EU law. Interests need to be balanced at all stages and arguably this is what will characterise copyright in future, in the offensive as well as in the defensive.

At a time when France is reflecting on the reform aimed at extending the remit and powers of HADOPI, the question of weighing interests is present in everyone's mind.

82. See above.

83. See ref. in the *Klasen* commentary.

84. Paragraph 45.

COURT OF JUSTICE OF THE EUROPEAN UNION

Case C-149/17

Third Chamber

18 October 2018

Bastei Lübbe GmbH & Co. KG v Michael Strotzer

Request for a preliminary ruling from the Landgericht München I

REFERENCE FOR A PRELIMINARY RULING – Copyright and related rights – Directive 2001/29/EC – Enforcement of intellectual property rights – Directive 2004/48/EC – Charter of Fundamental Rights of the European Union – Article 7 (privacy) – Balance of interests between copyright and privacy rights (yes) – Compensation in the event of file-sharing in breach of copyright (German law) – Internet connection accessible by members of the owner’s family – Exemption from liability of the owner without the need to specify the nature of the use of the connection by the family member (no)

The decision is available on the CJEU website in the following electronic address: <https://curia.europa.eu>

COURT OF JUSTICE OF THE EUROPEAN UNION

Case C- C-310/17

Grand Chamber

13 November 2018

Levola Hengelo BV v Smilde Foods BV

Request for a preliminary ruling from the Gerechtshof Arnhem-Leeuwarden

REFERENCE FOR A PRELIMINARY RULING – Intellectual property – Notion of intellectual work – Harmonisation of certain aspects of copyright and related rights in the information society – Directive 2001/29/EC – Autonomous and uniform interpretation – Scope – Berne Convention – Article 2, §1 – Reproduction rights – Concept of ‘work’ – Requirement for original form – Taste of a food product – Protection (no)

The decision is available on the CJEU website in the following electronic address: <https://curia.europa.eu>

COURT OF APPEAL - VERSAILLES

Chamber 1, Section 1

RG N0 15/06029

16 March 2018

Alix M. v Peter K.

PHOTOGRAPHY – Existing work – Exclusive right of the author – Inclusion of photographs in the works of a painter - Derivative work – Freedom of expression – Need of a fair balance – Exceptions – Parody (no)

[Decision not reproduced]