EIP

The WaterRower managed to row back from being struck out

In the recent strike out application heard on 28 July 2022, Waterrower (UK) Limited v Liking Limited (T/A Topiom) [2022] EWHC 2084 (IPEC), David Stone, sitting as deputy high court judge, considered whether a rowing machine could be considered to be a work of artistic craftmanship when deciding if the Claimant, Waterrower (UK) Ltd, are likely to succeed in their infringement claim.

Background and the Application

In the ongoing proceedings the Claimant is claiming copyright infringement of their rowing machine the WaterRower by the Defendant, Liking Limited.

The WaterRower is a water resistance rowing machine crafted in wood. It was designed and hand-made in mahogany by Mr John Duke between 1985 and 1987. It is an iconic design in the UK and US and has featured in magazines, newspapers and on television, including GQ, Men's health, Playboy, Men's Fitness and House of Cards. It is even featured in publications by the Museum of Modern Art (MoMA) and is sold in their shop.

The Claimant is claiming that copyright subsists in eight iterations of the WaterRower as they are works of artistic craftmanship within the meaning of s.4(1)(c) of the Copyright and Patents Act 1988 (CDPA). The Defendant has admitted to copying the eighth iteration of the WaterRower when designing their TOPIOM model 2 rowing machine.

On 1 July 2022 the Defendant brought this strike out application under CPR 3.4(2), also seeking summary judgment in the order attached to the application, arguing that the Claimant is unlikely to prove that the WaterRower is a work of artistic craftmanship

within the meaning of s.4(1)(c) CPDA.

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UK law on works of Artistic Craftmanship

s.4(1)(c) CDPA does not provide any further definition of what is meant by work of artistic craftmanship hence the definition is based on caselaw - George Hensher Ltd v Restawile Upholstery (Lancs) Ltd [1976]AC 64 being the leading case. Although it should be noted that in Hensher it had been conceded that the work was a work of craftmanship, so it only really considered the meaning of artistic craftmanship.

Intention of the creator and more than eye appeal

Hensher does not set out an exact formula to be followed when deciding if a work is an artistic craftmanship, rather the meaning should be a matter for evidence for the judge of the case in question to decide having consideration for the words' "ordinary and natural meaning".

Nevertheless, Hensher still found that the intention of the creator when making the work is helpful in deciding if the work is of artistic craftmanship as well as the appearance of the work – something more than simple eye appeal being required.

In regards to this application the Judge found that on the documents before him there was some evidence that Mr Duke had artistic intentions when creating the WaterRower; he wanted to recreate the sparse elegance of the Shaker design and create a rowing machine in which the user has "a welcoming emotional connection, as they would with a piece of art or furniture". The Judge dismissed the Defendant's argument that Mr Duke's primary intention was to create a rowing machine which simulated rowing on water, stating there is nothing in Hensher indicating that it is the creator's primary intention which is the relevant one.

In regard to the appearance, the Judge found there is some evidence before him, although not conclusive, which would be probative in proving that the WaterRower is artistic. He referred in particular to the MoMA website describing the WaterRower as "looking artful" and the Galerie article describing it as "masterfully crafted".

Work of a craftsman

Although the Defendant recognised that any commentary on craftmanship in Hensher would be strictly obiter they still argued that the Claimant would fail to prove that the

WaterRower is a work of craftmanship.

p3 The Judge rejected this argument on the basis there was evidence before him which could find the WaterRower to be a work of craftmanship. He referred in particular to the fact that Mr Duke had produced a high-quality product initially entirely by hand, and although the creation of the WaterRower is now outsourced to others the Judge found that there was nothing in the authorities that required the work to be done by a single person.

Functional

Further to Hensher the Defendants relied on an excerpt from Copinger and Skone James on Copyright (18th edition, Sweet & Maxwell) (paragraphs 3-155) which holds that the more constrained the designer is by functional considerations, the less likely the work is to be a work of artistic craftmanship.

The Judge commented that he could not say, based on the evidence before him, whether the Claimant would be likely to pass this test. But referring to commentary by Lord Reid in Hensher that a "work of artistic craftmanship can still be useful" and the examples of works of artistic craftmanship which are to an extent guided by function (for example a wrought-iron gate) given by Lord Simon in Hensher, the Judge rejected the Defendant's submission.

Conclusion

Based on the above the Judge found that he did not consider that the Claimant has no real prospect of establishing that the WaterRower is a work of artistic craftmanship under Hensher.

EU Copyright Law

In addition to Hensher the Defendant also argued that the Claimant would fail to show copyright subsists in the WaterRower under principles set out in the two EU Copyright law authorities Cofemel-Sociedade de Vestuário SA v G-Star Raw CV (C-683/17; [2020] ECDR 9) (Cofemel) and SI and another v Chedech/Get2Get (C-833/18: EU:C:2020:461; [2020] Bus LR 1619) (Brompton).

The test in Cofemel is that to qualify as a work it must be an original object as well as being an expression of intellectual creation. In other words, if the creation of a work was restricted because it needed to fit a certain shape etc. it cannot be an original object or an expression of intellectual creation. Brompton, which considered whether copyright

could subsist in the shape of a folding bike, confirmed that functional shapes could in principle be protected by copyright – subject to them being original works.

The Judge found that the WaterRower was clearly an original object as well as an expression of Mr Duke's intellectual creation, therefore he rejected the Defendant's submission that the Claimant had no real prospect of showing that, whilst Mr Duke would have faced some technical constraints when designing the WaterRower for it to function as rowing machine, they were "not such that the idea and its expression became indissociable". In summary, the Judge found that on the evidence before him the Claimant would be able to show that Mr Duke still exercised his own free and creative choice when designing the WaterRower even though he had technical issues to consider.

When considering the EU Copyright Law, the Judge also considered the existence of a US patent application for the WaterRower. Following Brompton the Judge found that, while the patent application deals with technical aspects of the WaterRower, it does not deal with other aspects which are relevant for its overall shape and look, for example the selection of materials or how those materials would be treated; it does not deal with what would be artistic choices. Therefore, the Judge did not find that the existence of the patent application would mean that copyright would not be found to subsist in the WaterRower.

Response Clothing and the inconsistencies between Cofemel/Brompton and the CDPA

The Judge acknowledged the inconsistency between Cofemel/Brompton and the CDPA (the need for aesthetic appeal by the CDPA) and that it will need to be resolved in due course. However, he did not consider that the inconsistency affected his findings on this application as he came to the same conclusion, that the Claimant did have a chance of showing that copyright subsisted in the WaterRower, under the CDPA and under Cofemel/Brompton.

Because of this the Judge also rejected the Defendant's third basis for its strike out application – which depended on whether Response Clothing Ltd v Edinburgh Woollen Mill Ltd [2020] EWHC 148 (IPEC); [2020] ECC 16) was correctly decided.

Conclusion

The Defendant's application failed as the Judge found that the Claimant did not have no real prospect of showing that the WaterRower was a work of artistic craftmanship both under the CDPA and EU Copyright law.

Commentary

Although the Judge found that Claimant would not necessarily fail to show that the WaterRower is a work of artistic craftmanship, he did not make an absolute finding that the WaterRower is a work of artistic craftmanship, indeed that remains for the trial judge to decide.

This case will no doubt be an interesting one to follow at trial as it would seem the trial judge would surely struggle to find the WaterRower not to be a work of artistic craftmanship given some of the Judge's comments on this application, in particular his comments when considering Cofemel/Brompton, that it was clear that the WaterRower was original and of intellectual creation, and the finding when considering Hensher, that the presence of the WaterRower in the MoMA shop is indicative of it belonging alongside other artistic works.