



Neutral Citation Number: [2022] EWHC 2084 (IPEC)

Case No: IP-2022-000001

IN THE HIGH COURT OF JUSTICE
BUSINESS & PROPERTY COURTS OF ENGLAND & WALES
INTELLECTUAL PROPERTY ENTERPRISE COURT

Royal Courts of Justice
Rolls Building, Fetter Lane, London, EC4A 1NL

Date: 5 August 2022

Before:

DAVID STONE
(sitting as a Deputy High Court Judge)

Between:

WATERROWER (UK) LIMITED

Claimant

- and -

LIKING LIMITED (T/A TOPIOM)

Defendant

Ms Jacqueline Reid (instructed by **Moore Commercial Law Limited**) for the **Claimant**
Mr Jonathan Moss and Ms Kendal Watkinson (instructed by **Gunnercooke LLP**) for the
Defendant

Hearing date: 28 July 2022

APPROVED JUDGMENT

I direct that pursuant to CPR PD 39A para 6.1 no official shorthand note shall be taken of this judgment and that copies of this version as handed down may be treated as authentic.

Covid-19 Protocol: This judgment is to be handed down by the deputy judge remotely by circulation to the parties' representatives by email and release to Bailii. The date for hand-down is deemed to be 5 August 2022.

David Stone (sitting as Deputy High Court Judge) :

1. By application notice dated 1 July 2022 the Defendant sought to strike out (or alternatively to obtain summary judgment of) the Claimant’s claim for infringement of copyright in its WaterRower water resistance rowing machine on the basis that the machine is not a “work of artistic craftsmanship” within the meaning of section 4(1)(c) of the Copyright Designs and Patents Act 1988 (as amended) (the **CDPA**).
2. The Defendant has admitted that, if the Claimant’s machine is a “work of artistic craftsmanship”, then copyright subsists, and the Defendant’s machines infringe (at least in relation to the eighth iteration of the Claimant’s machine). Therefore, the sole issue before the Court is whether the Claimant’s WaterRower rowing machine is a work of artistic craftsmanship.
3. Ms Jacqueline Reid appeared for the Claimant. Mr Jonathan Moss appeared for the Defendant (and Ms Kendal Watkinson contributed to the Defendant’s skeleton argument). Both counsel argued persuasively: I am also grateful for the efficiency with which they presented their clients’ arguments.

The Application

4. Technically, the Defendant’s application is for strike out of the Claim Form and Amended Particulars of Claim (**APoC**) under CPR 3.4(2)(a) and/or summary judgment under CPR 24.2(a)(i). However, counsel for the Defendant conceded that the strike out application and the summary judgment application must stand or fall together, and so I need only address the strike out application. Counsel for the Claimant pointed out that the request for summary judgment is not made in the application notice, only in the draft order attached to it, but in light of the approach taken, that issue does not arise.
5. The Defendant also sought summary judgment on its Counterclaim. The Counterclaim is for various declarations of non-infringement – during the course of argument, these were narrowed to a single declaration for the territory of the UK – “that the WaterRower is not a work of artistic craftsmanship.” Counsel for the Defendant submitted that this is merely the flipside of the Defendant’s application to strike out the claim, but conceded, quite rightly, that declarations sit within the Court’s equitable jurisdiction and involve the exercise of discretion, and it therefore does not necessarily follow that if the strike out application is granted, declarations of non-subsistence of copyright follow. I return to this issue below.
6. The evidence before me was contained within the statements of case (each of which has been amended, some several times) and in two witness statements. The Claimant relied on a witness statement of Mr Jonathan Moore, solicitor for the Claimant. The Defendant relied on a witness statement of Ms Rachel Pearse, solicitor for the Defendant. Neither witness was cross-examined as, in reality, their evidence dealt with other applications that were before the Court, not the Defendant’s application to strike out the claim.

7. The Defendant also sought to rely on draft Particulars of Claim that were never signed, but were sent from the Claimant's then legal advisors to the Defendant prior to the action being launched. I do not consider that that document assists me – it may evidence how the Claimant's then advisors planned to plead the case, but I do not consider that anything more can be gained from that document.
8. I need also say something at this stage about the machines in issue and the claimed copyright works. The Claimant's machine is called the WaterRower. There have been eight iterations of the WaterRower in four series, each of which differs from the previous one. Photographs of each were in evidence before the Court. The first iteration is shown here:



9. The Defendant now admits to having copied the eighth iteration of the WaterRower to create its TOPIOM Model 1. Its TOPIOM model 2 was an attempt to work around any rights said to subsist in the WaterRower.
10. The Claimant claims that copyright subsists in each of the eight iterations of the WaterRower, which it defined in its APoC collectively as “the Works”. In its Re-Amended Defence and Counterclaim (which prior to hearing the Defendant's strike out application, I gave permission to file and serve with some amendments), the Defendant does not adopt the definition of “the Works”, but rather refers to “the WaterRower”.

11. Given the single issue before the Court, neither side sought to argue that it matters for present purposes which of the eight iterations of the WaterRower I consider – whilst there are differences between them, they are, in my judgment, insufficient for present purposes to suggest, for example, that iteration 1 might be a work of artistic craftsmanship whereas iteration 8 might not be. The Defendant has other arguments as to the additional copyright that may subsist in iteration 8 as compared to iteration 1, but that is not a matter for today. It will therefore be largely unnecessary to distinguish between them.
12. The Defendant did not seek to argue that a water resistance rowing machine could never be a work of artistic craftsmanship. Rather, the argument before me was on the question of whether or not the WaterRower is a work of artistic craftsmanship. I will refer to that question during the course of this judgment. Of course, that is not the complete question to be asked on an application for strike out/summary judgment – and I have kept in mind throughout that I am to apply the relevant legal tests, set out below. In reality, I am to ask myself whether the Claimant has “no reasonable grounds” to claim that the WaterRower is a work of artistic craftsmanship and/or that it has no real prospects of success in relation to that claim.
13. The expression “work of artistic craftsmanship” entered the CDPA in 1911 when gender-neutral drafting was largely unknown. I will use the expression in the CDPA.

The Law on Strike Out/Summary Judgment

14. The parties were agreed as to the law to be applied.
15. In relation to strike out, CPR 3.4(2)(a) provides that the Court may strike out a statement of case if it appears to the Court “that the statement of case discloses no reasonable grounds for bringing or defending the claim.” CPR PD3A provides some examples of cases which may fall within rule 3.4(2)(a), including “those which contain a coherent set of facts but those facts, even if true, do not disclose any legally recognisable claim against the defendant.” The White Book, volume 1 at paragraph 3.4.1, emphasises that claims which are “obviously ill-founded” or “which do not amount to a legally recognisable claim” should be struck out. Counsel for the Claimant also brought the following passage from the White Book to my attention:

“Statements of case which are suitable for striking out on ground (a) include those which raise an unwinnable case where continuance of the proceedings is without any possible benefit to the respondent and would waste resources on both sides (*Harris v Bolt Burdon* [2000] C.P. Rep. 70; [2000] C.P.L.R. 9). A claim or defence may be struck out as not being a valid claim or defence as a matter of law (*Price Meats Ltd v Barclays Bank Plc* [2000] 2 All E.R. (Comm) 346, Ch D). However, it is not appropriate to strike out a claim in an area of developing jurisprudence, since, in such areas, decisions as to novel points of law should be based on actual findings of fact (*Farah v British Airways*, *The Times*, 26 January 2000, CA referring to *Barrett v Enfield BC* [2001] 2 A.C. 550; [1989] 3 W.L.R. 79, HL). A statement of case is not suitable for striking out if it raises a

serious live issue of fact which can only be properly determined by hearing oral evidence (*Bridgeman v McAlpine-Brown*, 19 January 2000, unrep., CA). An application to strike out should not be granted unless the court is certain that the claim is bound to fail (*Hughes v Colin Richards & Co* [2004] EWCA Civ 266; [2004] P.N.L.R. 35, CA (relevant area of law subject to some uncertainty and developing, and it was highly desirable that the facts should be found so that any further development of the law should be on the basis of actual and not hypothetical facts)).”

16. I have been asked to decide this application on the basis of a strike out, but Counsel for the Defendant also referred me to the law on summary judgment, so I have also kept it in mind. He excerpted the usual passage from the White Book at paragraph 24.2.3, adding his own emphasis as shown below:

“The following principles applicable to applications for summary judgment were formulated by Lewison J in *Easyair Ltd v Opal Telecom Ltd* [2009] EWHC 339 (Ch) at [15] and approved by the Court of Appeal in *AC Ward & Sons Ltd v Catlin (Five) Ltd* [2009] EWCA Civ 1098; [2010] Lloyd’s Rep. I.R. 301 at [24]:

i) The court must consider whether the claimant has a “realistic” as opposed to a “fanciful” prospect of success: *Swain v Hillman* [2001] 1 All E.R. 91;

ii) A “realistic” claim is one that carries some degree of conviction. This means a claim that is more than merely arguable: *ED & F Man Liquid Products v Patel* [2003] EWCA Civ 472 at [8];

iii) In reaching its conclusion the court must not conduct a “mini-trial”: *Swain v Hillman*;

iv) This does not mean that the court must take at face value and without analysis everything that a claimant says in his statements before the court. In some cases it may be clear that there is no real substance in factual assertions made, particularly if contradicted by contemporaneous documents: *ED & F Man Liquid Products v Patel* at [10];

v) However, in reaching its conclusion the court must take into account not only the evidence actually placed before it on the application for summary judgment, but also the evidence that can reasonably be expected to be available at trial: *Royal Brompton Hospital NHS Trust v Hammond (No.5)* [2001] EWCA Civ 550;

vi) Although a case may turn out at trial not to be really complicated, it does not follow that it should be decided without the fuller investigation into the facts at trial than is possible or permissible on summary judgment. Thus the court should hesitate about making a final decision without a trial, even where there is no obvious conflict of fact at the time of the application, where reasonable grounds exist for believing that a fuller investigation into the facts of the case would add to or alter the evidence

available to a trial judge and so affect the outcome of the case: *Doncaster Pharmaceuticals Group Ltd v Bolton Pharmaceutical Co 100 Ltd* [2007] F.S.R. 3;

vii) **On the other hand it is not uncommon for an application under Pt 24 to give rise to a short point of law or construction and, if the court is satisfied that it has before it all the evidence necessary for the proper determination of the question and that the parties have had an adequate opportunity to address it in argument, it should grasp the nettle and decide it. The reason is quite simple: if the respondent's case is bad in law, he will in truth have no real prospect of succeeding on his claim or successfully defending the claim against him, as the case may be. Similarly, if the applicant's case is bad in law, the sooner that is determined, the better.** If it is possible to show by evidence that although material in the form of documents or oral evidence that would put the documents in another light is not currently before the court, such material is likely to exist and can be expected to be available at trial, it would be wrong to give summary judgment because there would be a real, as opposed to a fanciful, prospect of success. **However, it is not enough simply to argue that the case should be allowed to go to trial because something may turn up which would have a bearing on the question of construction: *ICI Chemicals & Polymers Ltd v TTE Training Ltd* [2007] EWCA Civ 725."**

17. I have therefore kept at the forefront of my mind that this application is not to be a mini-trial, that I must take into account the evidence before me (not without analysis) as well as the evidence that can reasonably be expected to be available at trial, that I should hesitate about making a final decision without a trial, that I should grasp the nettle and decide any "short point of law or construction" but that it is not appropriate to strike out a claim in an area of developing jurisprudence, since, in such areas, decisions as to novel points of law should be based on actual findings of fact. Where I use below the expression "no real prospects", I have in mind also the expressions relevant to strike out applications: "no reasonable grounds", "no legally cognisable claim" and "bound to fail".

Background

18. The following facts were before me. I do not consider any of them to be contentious.
19. The Claimant is a company registered in England and Wales which sells exercise equipment, including the WaterRower. The WaterRower is a water resistance rowing machine. The WaterRower was designed by Mr John Duke between 1985 and 1987. Mr Duke is a citizen of the United States and a former rower, having been a member of the US National Team in 1975. Mr Duke has a Bachelor of Science degree from Yale and a Masters in Ocean Systems Management from MIT, which included a study of naval architecture. He has designed and built boats, including designing and building his own wooden one man shell for the "Head of the Charles" regatta in 1977. He has a life-long interest in various forms of art, crafting with wood, and artistic design.

20. The APoC set out Mr Duke’s inspiration for his design of the WaterRower, including the wooden shells created by George Pocock and George Sims, both well-known rowing equipment designers who crafted in wood. Mr Duke considers their shells to be “works of art”. He was also influenced by the works of US furniture maker Thomas Moser, the Arts and Crafts movement and the aesthetics of Shaker furniture design. In creating the WaterRower, Mr Duke’s aim was to recreate the sparse elegance of a Shaker design and to create a rowing machine in which the user has “a welcoming emotional connection, as they would with a piece of art or furniture”.
21. Early versions of the WaterRower were made from mahogany, but are now made from more sustainable woods. The evidence is that the WaterRower is “deliberately crafted in the same manner in which a cabinet maker would make a fine piece of furniture, and with consideration for the aesthetics of touch, including dipping in furniture maker’s oil rather than eg varnishing, so that the patina developed and the wood felt different to the user”.
22. The initial WaterRower was hand-made by Mr Duke. Aspects of the WaterRower continue to be handmade. The processes used to make the WaterRower include inspection and selection of wood, manual staining, sanding and oiling of the wood, and manual assembly. Mr Duke presented his hand-made version to a public boat show in 1987 and received his first orders at that time.
23. Mr Duke applied for a US patent for the WaterRower, and the patent application was in evidence before me. The patent expired some time ago.
24. The WaterRower has been recognised as an “iconic design” in the United Kingdom and the United States – I was taken to excerpts from publications by the Museum of Modern Art (**MOMA**), the Conran Shop and design magazines including *Architectural Digest* and *Galerie*. I do not need to set out those excerpts in detail but I return to them below – relevantly, the Defendant has (quite rightly) conceded that the WaterRower is aesthetically pleasing. The WaterRower has featured in magazines, newspapers and on television, including in *GQ*, *Men’s Health*, *Playboy*, *Men’s Fitness* and *House of Cards*. The WaterRower is on display in the Design Museum in London.
25. The Defendant is a company incorporated under the laws of Hong Kong. Since at least November 2019, it has sold its TOPIOM rowing machine, including in the United Kingdom. The TOPIOM rowing machine is also a water resistance rowing machine. It is a replica of iteration 8 of the WaterRower and was copied from it. The Defendant advertises its TOPIOM machines on the amazon.co.uk website with the slogan “Beautiful Enough as Furniture”.

The Defendant’s Strike Out Case

26. I will need to return to the Defendant’s strike out case in more detail once I have considered the law on “works of artistic craftsmanship”, but, for present purposes, it is useful to set out counsel for the Defendant’s helpful summary.

27. First, he argued that there are currently several unresolved points of law in this area:
- i) Whether the use of closed categories of copyright works in the CDPA is permissible under EU law (as it subsisted at the time of the UK's exit from the EU);
 - ii) Whether the leading House of Lords authority on works of artistic craftsmanship, *George Hensher Ltd v Restawile Upholstery (Lancs) Ltd* [1976] AC 64, conflicts with two Court of Justice decisions handed down prior to the UK's exit from the EU: *Cofemel-Sociedade de Vestuário SA v G-Star Raw CV* (C-683/17; [2020] ECDR 9 and *SI and another v Chedech/Get2Get* (C-833/18: EU:C:2020:461; [2020] Bus LR 1619) (*Brompton*); and
 - iii) Whether a recent decision of HHJ Hacon in this Court which discusses the two issues above (*Response Clothing Ltd v Edinburgh Woollen Mill Ltd* [2020] EWHC 148 (IPEC); [2020] ECC 16) was correctly decided.
28. Counsel for the Defendant accepted that this Court is bound by *Hensher*, *Cofemel* and *Brompton*, but submitted that, whilst the Court of Appeal is bound by *Hensher*, it is able to depart from *Cofemel* and *Brompton*. However, he submitted that it was not necessary for me to resolve the apparent inconsistency as the WaterRower would fail under the test set out by the House of Lords in *Hensher*, and also under the Court of Justice's test in *Cofemel/Brompton*.
29. In relation to *Hensher*, he submitted first that, "on any view" of their Lordships five separate speeches, the WaterRower is not *artistic* – it has aesthetic appeal, but that is not enough. Second under *Hensher*, he submitted that the WaterRower fails for not being a work of *craftsmanship* – the WaterRower is an invention, but it is, he said, "totally technical", with some "design choice", but no skill of a craftsman. Third, he urged on me the explanation of *Hensher* set out in *The Modern Law of Copyright* (also known as Laddie, Prescott and Vitoria) (Fifth Edition, LexisNexis), submitting that without artistry and without craftsmanship, there could not be the "interplay" expected of a work of artistic craftsmanship, and that therefore, the Claimant would fail. With the WaterRower, he said, all three requirements are missing. Finally, the Defendant propounded its own test, and said that on its pleaded case, the Claimant also failed to meet that test.
30. The Defendant further submitted that the WaterRower clearly fails the Court of Justice's tests set out in *Cofemel* and *Brompton* because the creation of the WaterRower was mainly based on technical considerations – such that the only free choices left to Mr Duke are the choice of wood – which is insufficient to make the WaterRower a work of artistic craftsmanship.
31. Thus, he submitted, I should "grasp the nettle" and strike out the claim, on the basis that nothing further will come out at trial to "move the needle".

United Kingdom Law on Works of Artistic Craftsmanship

32. Section 4(1) of the CDPA includes within the scope of protected artistic works “a work of artistic craftsmanship”, but does not provide any further definition on what that term means. The leading case on the scope of works of artistic craftsmanship is *Hensher*, in which the House of Lords unanimously held that the prototype piece of furniture before them was not a work of artistic craftsmanship. In that case, the defendants had conceded at trial that the furniture was a work of craftsmanship, so the only issue before the House of Lords was whether it was a work of *artistic* craftsmanship.
33. In *Response Clothing*, HHJ Hacon said this about *Hensher*:
- “It is not a straightforward judgment, as has been acknowledged since. In *Lucasfilm Ltd v Ainsworth* [2011] UKSC 39; [2012] 1 AC 208 Lord Walker and Lord Collins (in a combined judgment with which Lord Phillips and Lady Hale agreed) concurred (at [29]) with Mann J’s assessment at first instance that it was difficult to identify the true principle of the judgment in *Hensher* and thus a meaning given to ‘artistic craftsmanship’ by the House of Lords. The Supreme Court in *Lucasfilm* was not required itself to reach a view on the meaning because after the first instance judgment the claimant no longer contended that its Imperial Stormtrooper helmets and armour, the articles in issue, were works of artistic craftsmanship.”
34. I respectfully agree with that analysis. However, as Counsel for the Defendant relied in detail on the speeches of the five Law Lords, I will take each in turn.
35. Giving his judgment first, Lord Reid initially explained the significance of the intention of the individual(s) who created or designed an item but he did not (at page 78) consider the creator’s intention to create something artistic to be “either necessary or conclusive”. He went on to hold at page 79 (emphasis added):
- “I am quite unable to agree with the view of the Court of Appeal ante, p. 72F-G, that “there must at least be expected in an object or work that its utilitarian or functional appeal should not be the primary inducement to its acquisition or retention.” **The whole conception of artistic craftsmanship appears to me to be to produce things which are both useful and artistic in the belief that being artistic does not make them any less useful.** A person who only wants, or has only room for, one of a particular kind of household object may be willing to pay more to get one which he regards as artistic; if a work of craftsmanship it is none the less of artistic craftsmanship because his primary purpose is to get something useful.”
36. He further held that eye appeal is not enough to establish a work of artistic craftsmanship: “looking nice appears to me to fall considerably short of having artistic appeal” (at page 79).
37. Lord Morris of Borth-y-Guest held that “in its place in the phrase “work of artistic craftsmanship” the word “artistic” will be well understood” (at page 81). He was disinclined “to formulate any kind of judicial definition of a word which needs no such aid” (at page 81). He emphasised that in order to qualify as “artistic”, a

work of craftsmanship needed something more than simple eye appeal. He stated at page 81:

“If it is asked whether works which possess distinctive features of design and skill in workmanship or works which possess distinctive characteristics of shape, form and finish all qualify to be called artistic I would say that the word “artistic” calls for something additional and different. If it is asked whether there is artistry if there is an appeal to the eye I would say that something more is needed.

[...]

In deciding whether a work is one of artistic craftsmanship I consider that the work must be viewed and judged in a detached and objective way. The aim and purpose of its author may provide a pointer but the thing produced must itself be assessed without giving decisive weight to the author’s scheme of things. Artistry may owe something to an inspiration not possessed by the most deft craftsman. But an effort to produce what is artistic may, if forced or conscious, for that very reason fail.”

38. So Lord Morris, too, suggested that the intention of the creator may be helpful, but not conclusive, and that something more than eye appeal is required. He went on to hold at page 82 that whether an item was a work of artistic craftsmanship was a question of fact to be decided on the basis of the evidence before the court, and that an intention to attract purchasers through design and shape was not sufficient to show artistic intent.
39. Viscount Dilhorne also did not set out a test or formula – he held, at page 86 “in my opinion, the proper interpretation of the words of the statue does not involve the formulation of any test or the application of any particular formula”. He held that the words “works of artistic craftsmanship” should be given their ordinary and natural meaning: “it is simply a question of fact whether a work is one of artistic craftsmanship” (at page 87). He held that expert evidence may be relevant, but at the end of the day, it was a matter for the judge to decide on the basis of the evidence.
40. Lord Simon of Glaisdale set out (at page 89 and following) the background to the enactment in 1911 of the amendment that introduced protection for works of artistic craftsmanship. He discussed the Arts and Crafts Movement, and the furniture of William Morris. He held (at page 90):

“But although, in my view, there can be no doubt that, when Parliament, in 1911, gave copyright protection to ‘works of artistic craftsmanship,’ it was extending to works of applied art the protection formerly restricted to works of the fine arts, and was doing so under the influence of the Arts and Crafts movement, and although the aesthetic of the Arts and Crafts movement was a handicraft aesthetic, Parliament used the words ‘artistic craftsmanship,’ not ‘artistic handicraft.’ It seems likely that this was done advisedly: I have already indicated that section 22 of the Act of 1911 envisaged that an industrial design might be an artistic work. Moreover, however ideologically opposed to current industrial and commercial

society, at least some of the leaders of the Arts and Crafts movement recognised that they would have to come to terms with the machine.”

41. Lord Simon emphasised at page 91 that “works of artistic craftsmanship” was a composite phrase to be construed as a whole, and thus an item had to have both the necessary qualities of being artistic and a piece of craftsmanship. His Lordship went on to give some examples at pages 91 to 92 of things which would qualify as works of artistic craftsmanship, and things which would not:

“A cobbler is a craftsman, and those in the Arts and Crafts movement would have valued his vocation as such. But neither they, nor anyone else using the words in their common acceptation, would describe his craftsmanship as artistic, or his products as “works of artistic craftsmanship.” A dental mechanic is a similar example; so is a pattern-maker, a boiler-maker, a plumber, a wheelwright, a thatcher. At the other extreme is the maker of hand-painted tiles. He too is a craftsman; but his craftsmanship would properly be described as artistic and his products as “works of artistic craftsmanship.” In between lie a host of crafts some of whose practitioners can claim artistic craftsmanship, some not—or whose practitioners sometimes exercise artistic craftsmanship, sometimes not. In the former class, for example, are glaziers. The ordinary glazier is a craftsman, but he could not properly claim that his craftsmanship is artistic in the common acceptation. But the maker of stained glass windows could properly make such a claim; and, indeed, the revival of stained glass work was one of the high achievements of the Arts and Crafts movement. In the latter class is the blacksmith—a craftsman in all his business, and exercising artistic craftsmanship perhaps in making wrought-iron gates, but certainly not in shoeing a horse or repairing a ploughshare. In these intermediate—or rather, straddling—classes come, too, the woodworkers, ranging from carpenters to cabinet-makers: some of their work would be generally accepted as artistic craftsmanship, most not. Similarly, printers, bookbinders, cutlers, needleworkers, weavers—and many others.”

42. Further, Lord Simon held that originality of design and appealing to the eye as a commercial selling point are not sufficient for a work to qualify as a work of artistic craftsmanship. At pages 94 to 95, Lord Simon held that whether or not a work is a work of artistic craftsmanship is a matter for evidence, including evidence from “acknowledged artist-craftsmen” – that is, expert evidence. He also considered the intention of the creator to be relevant:

“It is probably enough that common experience tells us that artists have vocationally an aim and impact which differ from those of the ordinary run of humankind. Given the craftsmanship, it is the presence of such aim and impact—what Stewart J. called “the intent of the creator and its result”—which will determine that the work is one of artistic craftsmanship.”

43. Lord Kilbrandon also held (at page 97) that a “comprehensive definitive interpretation” of “artistic” was impossible. Lord Kilbrandon did not consider that expert evidence would assist, but rather he held that the question is one for the judge to determine. He held that the “conscious intention of the craftsman will be the primary test of whether his product is artistic or not”.

44. It is not necessary for me to reduce their Lordships' speeches to a snappy definition of "works of artistic craftsmanship". For present purposes counsel for the Defendant argued that "on any view", I am in a position now to conclude that the WaterRower is not "artistic". I reject that submission for three reasons.

- i) First, Lords Reid, Morris and Kilbrandon all held that the intention of the creator was at least relevant to whether or not a work of craftsmanship is artistic. Indeed, Lord Kilbrandon held that it was the "primary test". In this case, there is already some evidence as to Mr Duke's artistic intention, and the Claimant has sought permission to adduce a further witness statement from Mr Duke for the purposes of the trial. The Defendant has said in the *inter partes* correspondence that it wishes to cross-examine Mr Duke as to his intentions. This evidence, relevant to three of the five Law Lords in *Hensher*, is therefore the very thing which the authorities emphasise ought to cause hesitation prior to striking out a claim. The evidence before me is that Mr Duke intended to recreate the sparse elegance of a Shaker design and to create a rowing machine in which the user has "a welcoming emotional connection, as they would with a piece of art or furniture". This evidence is, in my judgment, sufficient to avoid a strike out. There is in any event likely to be more to come.

(Several of the Defendant's submissions appeared to suggest that it is the *primary* purpose of the creator that is relevant, and that here Mr Duke's *primary* purpose was to create a water resistance rowing machine to simulate the feeling of rowing on water, through both sensation and sound. Even assuming that that was Mr Duke's primary purpose, I do not consider that to be grounds for striking out the claim: I cannot discern in any of their Lordships' speeches any indication that it is the *primary* purpose of the creator that matters. As I read their Lordship's speeches, so long as the artistic purpose was *one of* the creator's purposes, it does not need to be the primary or dominant one. To take one of Lord Simon's examples, clearly, a set of wrought-iron gates would be rejected by the purchaser if they did not open, or did not keep people/animals in or out – those are amongst the primary purposes of gates. But gates can still be works of artistic craftsmanship, even if their artistry is secondary to their usefulness.)

- ii) Second, I cannot say at this stage of proceedings that the WaterRower would not fall within the notion of "work of artistic craftsmanship" as described by their Lordships. I do not consider that it is for me to say whether or not their Lordships, if sitting today, would find that the WaterRower is a work of artistic craftsmanship – that is not the relevant test, as each of their Lordships emphasises. It is a matter for the trial judge on the basis of the evidence. As things stand, even leaving aside the further evidence that may be adduced at trial, I cannot say that the Claimant has no real prospects of proving that the WaterRower is artistic. The Defendant conceded that it has eye appeal, but said that was not enough. As I read the speeches of Lords Reid, Morris, Simon and Kilbrandon, whilst requiring more than eye appeal, none of their Lordships sets out what that "more" is, and counsel for the Defendant did not. Perhaps for some of their Lordships (particularly Lord Kilbrandon) it was the intention of the creator. Perhaps

it is recognition by others that the work is artistic (and hence the suitability of expert evidence). In this case, even on the evidence before me at this strike out stage, both are present – in Mr Duke’s intentions as creator and in the recognition from MOMA and others. Whilst counsel for the Defendant sought to minimise the weight of the recognition from MOMA and others on the basis that it did not expressly say that the WaterRower was “artistic”, it seems to me that this evidence is probative (for present purposes) in two ways. First, for what it says: for example, the *Galerie* article describes the WaterRower as being “masterfully crafted” and the MOMA website describes it as “looking artful”. Second, the presence of the WaterRower in the MOMA shop indicates that the curators of the MOMA shop consider it to be worthy of inclusion – that is, they recognise that it belongs alongside the other artistic works celebrated and sold by MOMA. No doubt further such evidence will be adduced at trial – but that which is already before the Court means that I cannot say that the Claimant’s case is hopeless.

iii) Third, Lord Simon set out a series of examples of works which he considered could be held to be artistic: hand-painted tiles, stained glass windows, wrought-iron gates, and “some of the [...] work” of carpenters, cabinet-makers, printers, bookbinders, cutlers, needleworkers and weavers. Although technology has clearly moved on since 1974, I cannot conclude on a strike out basis that the WaterRower is any less artistic in its conception or its appearance than the examples given by Lord Simon.

45. I therefore reject counsel for the Defendant’s first argument under *Hensher*, that “on any view”, the Claimant has no real prospect of proving that the WaterRower is “artistic”.

46. Second under *Hensher*, counsel for the Defendant argued that there are no prospects of the Court finding that the WaterRower is a work of craftsmanship. I also reject that finding. As counsel for the Defendant conceded, *Hensher* was not a case about craftsmanship – the defendant in that case had already admitted that the furniture in issue was a work of craftsmanship. Counsel for the Defendant conceded that any comments from the House of Lords on craftsmanship were “strictly obiter”.

47. In any event, on the basis of the evidence before me, I cannot conclude at this stage that the WaterRower is not a work of craftsmanship. Mann J said this in *Lucasfilm* when discussing Imperial Stormtrooper helmets and armour created by Mr Ainsworth for the *STAR WARS* films (at paragraph 133):

“With those authorities in mind, I turn to the question of whether the Stormtrooper helmets and armour are works of artistic craftsmanship. I am prepared to assume that the ultimate production of these articles was an act of craftsmanship. Mr Ainsworth can fairly be called a craftsman—he produces high quality products and has a justifiable pride in his work. He is not a slavish copier, or a jobbing tradesman. The production of the helmets and armour required the activity of a craftsman to realise the vision of the creators of the film in this respect.”

48. The evidence already before me is such that I cannot conclude that the production of the WaterRower was not an act of craftsmanship. There is evidence that Mr Duke is a craftsman – he studied naval architecture and built boats. (Counsel for the Defendant submitted that whilst the evidence may have established that Mr Duke was a craftsman in relation to rowing shells, he could not be considered a craftsman of rowing machines. I reject that submission, not least because many of the parts of a rowing machine are to be found in a shell (including a seat, footrest and runners). Mr Duke has produced a high quality product, which was initially made entirely by hand, and continues to be made in part by hand. He has pride in his work. He is not a slavish copier or a jobbing tradesman. It matters not that the creation of the WaterRower is now outsourced to others – there is nothing in the authorities that requires works of artistic craftsmanship to be the work of a single person, and art practice for centuries, and, more recently, craft practice, have both involved heavy aspects of outsourcing of the actual manufacture. William Morris designed the chairs sold under his name, but he did not make them.
49. I therefore reject counsel for the Defendant’s submission that the Claimant has no real prospects of proving that the WaterRower is a work of craftsmanship.
50. Third, counsel for the Defendant relied on the summary in Laddie, Prescott and Vitoria that refers to the *interplay* of artistry and craftsmanship which the learned authors’ draw from their reading of *Hensher*. The passage on which he relied is at paragraph 4.37 on page 230:
- “It is submitted that the answer is as follows. The making of any work of art implies two things, a medium in which to work and a result which is significant because of its visual appearance. In the case of a work of artistic craftsmanship the *medium* is the working of materials by manual dexterity (craftsmanship); and the *visual appearance* is significant if it would cause at least some members of the public to wish to acquire and retain the object on especial account thereof: an objective fact, capable of ascertainment.”
51. I do not need to form a view on whether or not that test is an appropriate one (or indeed, whether it properly captures the five speeches in *Hensher*). For present purposes, it is sufficient for me to say that, on the basis of the evidence before me, I cannot say at this stage that the WaterRower has no real prospect of passing the test set out by the learned authors. I have already set out above that the Claimant has a real prospect of proving that the WaterRower is a work of craftsmanship – the evidence is that Mr Duke worked on materials with “manual dexterity”. The visual appearance of the WaterRower is clearly popular – and at least some members of the public have wished to acquire, and indeed have acquired, it.
52. Counsel for the Defendant also relied on an excerpt from *Copinger and Skone James on Copyright* (18th edition, Sweet & Maxwell) at paragraph 3-155, where the learned authors state:
- “For a work to be regarded as one of artistic craftsmanship, it should be possible to say that the creator was both a craftsman and an artist. It has been suggested that determining whether a work is a work of artistic

craftsmanship does not turn on assessing the beauty of aesthetic appeal of work or on assessing any harmony between its visual appeal and its utility, but on assessing the extent to which the particular work's artistic expression, in its form, is unconstrained by functional considerations. Accordingly, the more constrained the designer is by functional considerations, the less likely the work is to be a work of artistic craftsmanship. It is a matter of degree.”

53. As previously, I am unable to say on the basis of the evidence before me that the Claimant has no real prospect of its WaterRower passing this test. Much reliance was placed by counsel for the Defendant on the functional aspects of the WaterRower, and the constraints they place on a designer of a water resistance rowing machine. As Lord Reid made clear in *Hensher*, a work of artistic craftsmanship can still be useful. And from the examples given by Lord Simon, many of which were practical items, a level of functionality is no bar to a finding of artistic craftsmanship. I have already referred to the example of a set of wrought-iron gates which has a clear utility and aspects of which are dictated by function – the hinges, any lock, the need to keep out people and animals etc. Indeed, many, or perhaps even most, of the choices taken by the blacksmith in crafting the gates will be functional choices, with the decorative elements being those that elevate the work of craftsmanship into a work of artistic craftsmanship. I accept that many of the aspects of the WaterRower have an element of functionality to them – but it is the crafting of something both functional and artistic that the Claimant pleads makes the WaterRower a work of artistic craftsmanship. As Lord Simon said at page 90 when discussing the aims of the Arts and Crafts movement:

“Functional efficiency and respect for the worked material would impose its own appropriate form, showing, to quote Lethaby again, that it was “made for a human being by a human being”.”

54. I therefore also reject this submission.
55. Finally in relation to *Hensher*, the Defendant's skeleton argument suggested the following test for something to be protected as a work of artistic craftsmanship:
- i) The creator should have a conscious intention to produce a work of art. However, this is not determinative;
 - ii) The item must have a real artistic or aesthetic quality, beyond simply being appealing to the eye; and
 - iii) The item must embody a sufficient degree of both craftsmanship and artistry, with the combination of these two things leading to the end result.
56. I do not need to decide whether that test adequately reflects the law of England & Wales. But I can say, without hesitation, that the Claimant has, on the basis of the evidence before me, a real prospect of meeting that test at trial. On the language of the Defendant's proposed test, i) is not conclusive, so I say no more about it. The Claimant has a real prospect of proving that the WaterRower has a real artistic or aesthetic quality, beyond simply being appealing to the eye, and

that the WaterRower embodies a sufficient degree of both craftsmanship and artistry, with the combination of these two things leading to the end result.

57. It therefore follows that I do not consider that the Claimant has no real prospects of establishing that the WaterRower is a work of artistic craftsmanship under *Hensher*.

EU Copyright Law

58. Counsel for the Defendant's primary submission was that "the law on artistic craftsmanship is set out in the binding House of Lords authority of *Hensher v Restawile*." I have already explained why I consider the Defendant's strike out application fails on that primary basis. However, counsel for the Defendant also argued that the WaterRower would fail to attract copyright protection under principles set out in the Court of Justice decisions of *Cofemel* and *Brompton*. I therefore discuss those cases below.
59. *Cofemel* (C-683/17) involved an allegation of infringement of copyright in jeans and t-shirts. These were said to be "original creations" and therefore "works" protected by copyright. The *Supremo Tribunal de Justiça* referred the issue to the Court of Justice for a preliminary ruling on the interpretation of Article 2(a) of the Information Society Directive. Specifically, the CJEU was asked whether EU law precludes national laws from providing copyright protection to design works which generate a significant aesthetic effect, on the basis of any other criteria apart from originality.
60. The Court of Justice held that there are two cumulative requirements, both of which are necessary to qualify as a work:
- i) the existence of an original object; and
 - ii) the expression of intellectual creation.

Hence, the object in question must express the "intellectual creation" of its author, ie, the author has made free and creative choices in creating the work. The Court of Justice noted at paragraph 31:

"On the other hand, when the realisation of a subject matter has been dictated by technical considerations, rules or other constraints, which have left no room for creative freedom, that subject matter cannot be regarded as possessing the originality required for it to constitute a work (see, to that effect, judgment of 1 March 2012, *Football Dataco and Others*, C-604/10, EU:C:2012:115, paragraph 39 and the case-law cited)."

61. In *Brompton*, infringement was alleged of copyright in the shape of a folding bike. The *Tribunal de l'entreprise de Liège* referred a preliminary question to the Court of Justice, seeking clarification on whether copyright protection under the Information Society Directive applies to a product where its shape is at least in part necessary to obtain a technical result.

62. The Court of Justice confirmed that functional shapes could in principle be protected by copyright, subject to their being original works (at paragraphs 31, 34, 36 and 39):

“[31] In that regard, as recalled in paragraphs 24, 26 and 27 of the present judgment, that cannot be the case where the realisation of a subject matter has been dictated by technical considerations, rules or other constraints which have left no room for creative freedom or room so limited that the idea and its expression become indissociable.

...

[34] Therefore, in order to establish whether the product concerned falls within the scope of copyright protection, it is for the referring court to determine whether, through that choice of the shape of the product, its author has expressed his creative ability in an original manner by making free and creative choices and has designed the product in such a way that it reflects his personality.

...

[36] As regards the existence of an earlier, now expired, patent in the case in the main proceedings and the effectiveness of the shape in achieving the same technical result, they should be taken into account only in so far as those factors make it possible to reveal what was taken into consideration in choosing the shape of the product concerned.

...

[39]... that product is an original work resulting from intellectual creation, in that, through that shape, its author expresses his creative ability in an original manner by making free and creative choices in such a way that that shape reflects his personality...”

63. Whilst both parties agreed that the apparent inconsistencies between UK law on the one hand (with its closed categories) and EU law on the other would need to be resolved in due course, I do not need to do so. I have already found that the Claimant has a real prospect of success under *Hensher*. In my judgment, the Claimant also has a real prospect of success under *Cofemel/Brompton*. It is clear to me that the WaterRower is an original object (and I did not understand the Defendant to argue otherwise). It is also clear to me that the WaterRower is an expression of Mr Duke’s intellectual creation. Neither seems to me to be in doubt. That leaves counsel for the Defendant’s submission that the technical and other constraints on Mr Duke “left no room for creative freedom or room so limited that the idea and its expression become indissociable”, and that therefore the WaterRower cannot be regarded as possessing the originality required for it to constitute a work. I also reject that argument – it seems to me that the Claimant has real prospects of arguing that, whilst there were some technical constraints, they are not such that the idea and its expression become indissociable. Counsel for the Defendant accepted that the WaterRower was not solely dictated by technical function, but also accepted that that is not the relevant test in the field

of copyright. But he said that many aspects of the WaterRower are technically constrained:

“it needs runners, a seat with padding. It has to be virtually flat. It needs footrests with something to keep your foot in place. It needs a pool of water with a paddle in it for resistance. It needs cross-beams to keep the two planks of wood which act as runners for the seat together. It has a groove on the inside of the runners to stop the seat flying out the back. It has a wheel to allow the end to be lifted up and moved. The pulleys to allow the paddle to be moved in the water.”

64. The Claimant submitted that there is no evidence of these allegations – and I accept that submission up to a point. It is clear to me on the evidence before me that the WaterRower has those features, but it is also clear from the images of other types of rowing machine that were in evidence that those features can be presented in different forms, in different materials and in different combinations. On the basis of the evidence before me, these constraints do not seem to be of the type that force a designer to a single, defined outcome. In my judgment, on the evidence before me the Claimant has real prospects of demonstrating that Mr Duke worked within the constraints for a water resistance rowing machine such that he was still able to exercise his own free and creative choices, and design the WaterRower in such a way that it reflects his personality. Reliance was placed on the use of wood, and the choice of wood. That was clearly a creative choice. But creative choices also needed to be made as to the shape and dimensions of the various features mentioned by counsel for the Defendant, in addition to choosing which features would be made of which materials, and how those materials would be treated. Whilst a body of water is present in all water resistance rowing machines (but not all rowing machines), the size and shape of that body of water, and how it is contained, are all creative choices, or, to put it more correctly, on the basis of the evidence already before me the Claimant has a real prospect of establishing as much at trial.
65. I also reject counsel for the Defendant’s argument that the existence of the US patent application to which I have already referred means that all of the features of the WaterRower are technical features. Obviously, aspects of the WaterRower are technical, and, as I have set out above, there were technical constraints (some of which are described in the patent application). But the patent application does not deal, for example, with the selection of materials, or how those materials would be treated. To adopt the words of counsel for the Claimant, the patent application “says nothing about how it’s made”.
66. The Defendant’s third set of arguments rest primarily on the submission that *Response Clothing* was wrongly decided. Neither counsel submitted that *Response Clothing* is binding on me – and so in at least one respect, this submission goes nowhere. However, as it was canvassed in written and oral argument, I will deal with it briefly.
67. *Response Clothing* involved a claim for copyright infringement of a jacquard fabric with a distinctive wave design. The claimant alleged that copyright subsisted in the wave design as a graphic work or as a work of artistic craftsmanship. I have already set out above HHJ Hacon’s comments in relation

to *Hensher*. His Honour then turned first to *Lucasfilm*, where Mann J considered *Hensher*, before turning to a judgment of the High Court of New Zealand, *Bonz Group (Pty) Ltd v Cooke* [1994] 3 NZLR 216, where that court considered “artistic craftsmanship” in the context of woollen sweaters. Mann J adopted the approach of Tipping J in *Bonz*:

“...[F]or a work to be regarded as one of artistic craftsmanship it must be possible fairly to say that the author was both a craftsman and an artist. A craftsman is a person who makes something in a skilful way and takes justified pride in their workmanship. An artist is a person with creative ability who produces something which has aesthetic appeal”.

68. In addition to the approval of Tipping J’s analysis by Mann J, HHJ Hacon in *Response Clothing* also notes the approval of Tipping J’s comments in *Vermaat (t/a Cotton Productions) v Boncrest Ltd (No 1)* [2001] FSR 5. In *Response Clothing*, His Honour also adopted the *Bonz* test, explaining that, for the fabric in issue before him to be a work of artistic craftsmanship, it was necessary to show that the fabric design was (a) a work of craftsmanship in the sense that the creation of the fabric required skilful workmanship, and (b) artistic in the sense that it was produced with creative ability that produced aesthetic appeal. His Honour found that the fabric was a work of artistic craftsmanship.
69. However, at paragraph 42 of his judgment, HHJ Hacon expressed a “difficulty” – his impression was that “none of their Lordships in *Hensher* would have concluded that the Wave Fabric is a work of artistic craftsmanship had that been the issue before them”. As I have said, I do not consider that that difficulty confronts me. However, given that counsel for the Defendant argued the point, I will deal with it briefly.
70. Having set out excerpts from the five speeches, HHJ Hacon found that whilst their Lordships may have concluded that the wave fabric was not a work of artistic craftsmanship had that issue been before them, “no binding principles of law can be deduced from the judgment in *Hensher* which compel me to the same conclusion now.” Rather, he again referred to Tipping J’s comments in *Bonz*, and the approval of those remarks at first instance in *Lucasfilm* and *Vermaat*.
71. HHJ Hacon then reviewed the position under EU law, which included a discussion of *Cofemel*, but not *Brompton*, as it had not been decided prior to His Honour’s judgment. HHJ Hacon then used the *Marleasing* principle (*Marleasing SA v La Comercial Internacional de Alimentación SA* (C-106/89) to read section 4 of the CDPA, so far as possible, in conformity with the principles set out in *Levola Hengelo BV v Smilde Foods BV* (C-310/17; EU:C:2018:899) and *Cofemel*.
72. Counsel for the Defendant referred me to the discussion of *Response Clothing* in *Copinger* at [13-565]:

“Nevertheless, as the judge recognised, it is not clear that *Marleasing* will always provide an adequate solution. For example, a work of design which (unlike that in issue in *Response Clothing*) did not have an aesthetic appeal or a three-dimensional work which failed to qualify as a “sculpture” under UK law might satisfy the *Levola Hengelo/Cofemel* requirements for

copyright protection and yet fall outside the closed lists of the 1988 Act as traditionally construed. It remains to be seen whether, in order to conform with those requirements, the 1988 classification system can be re-interpreted so that its references to “artistic”, “craftsmanship” and “artistic quality” are taken to refer to the personality of or the creative choices available to the author and to the quasi-functionality rule. In other words, merely as imposing a requirement that a work is not one that is dictated by function and is one where the author had exercised at least some creative choices in a manner similar to that discussed in *Cofemel*.”

73. Before me, counsel for the Defendant submitted that HHJ Hacon’s approach in *Response Clothing* was incorrect. He submitted that whilst His Honour recognised that conforming to Article 2 and *Cofemel* would exclude any requirement that the wave design had aesthetic appeal, he went on to apply the test for artistic craftsmanship in *Bonz*, which included the requirement of aesthetic appeal.
74. I was informed that permission to appeal the decision in *Response Clothing* was given. However, because the Edinburgh Woollen Mill went into administration, the appeal did not proceed.
75. As I have explained, for the purposes of the present application, I do not need to resolve the apparent inconsistency between *Cofemel/Brompton* and the CDPA. If the WaterRower did not have eye appeal, it may well have been necessary for me to resolve the apparent inconsistency – because the Law Lords in *Hensher* said that eye appeal is necessary (but not sufficient), whereas *Cofemel* says that eye appeal cannot be required. However, the Defendant has conceded that the WaterRower has eye appeal – and I have held that the Claimant has a real prospect of demonstrating at trial that the WaterRower meets the requirements of *Hensher*, *Cofemel/Brompton* and *Bonz*. It therefore does not matter for present purposes if those requirements are not aligned.
76. I therefore also reject this third basis for the Defendant’s strike out application.
77. During the oral hearing, counsel for the Defendant urged me to “grasp the nettle” and dispose of what he described as a “short point of law”. That would enable, he said, one of the parties to appeal to the Court of Appeal, and would allow the Court of Appeal an opportunity to consider the difficulties set out above. For my part, I do not consider the submissions put to me to amount to a short point of law. The interaction between the CDPA and *Cofemel/Brompton* is not a simple one. It is one which would appear to need to be resolved at some stage, by Parliament or the higher courts. But the inconsistencies on which counsel for the Defendant relied do not arise on the facts of this case as they are currently before the Court. If the evidence at trial changes that, then the Enterprise Judge who hears the trial can make all the necessary findings of fact, and the Court of Appeal will, if permission is given, determine the position in light of proper findings of fact. In my judgment, that is the appropriate course in this case.
78. Counsel for the Defendant suggested that the issue before the Court could have been determined by way of a preliminary issue. But that is not how this application was framed – this is an application to strike out the claim. Further, he

submitted that it would be better to have the Court of Appeal set out now a test for work of artistic craftsmanship so that the Enterprise Judge can then apply that test to the facts of this case. However, there is no mechanism for me to refer a question for a preliminary ruling to the Court of Appeal, and the option to do so to the Court of Justice is no longer open to me.

79. I therefore reject the Defendant’s application to strike out the claim on the basis that the WaterRower is not a work of artistic craftsmanship.

Declaration

80. Given my finding above, the application for summary judgment on the Counterclaim for a declaration is also rejected. The Claimant has real prospects of establishing that the WaterRower is a work of artistic craftsmanship.

Conclusion

81. As previously noted, this was an application to strike out the Claimant’s claim. I have set out above the test for strike out applications – is the claim “obviously ill-founded” or “bound to fail”? I have found that the Claimant’s case that the WaterRower is a work of artistic craftsmanship is not “bound to fail”. I have not reached a concluded view that the WaterRower is a work of artistic craftsmanship – that is a matter for the Enterprise Judge who hears the trial. At the conclusion of the hearing, having reserved my judgment on this application, I made a number of CMC orders to prepare the matter for trial, those orders being contingent on my not striking out the claim. As the Defendant’s application has failed, those orders should now be sealed, and, if the matter cannot be settled, it should be prepared for trial.