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This work was originally published in  
27 Cardozo Arts & Ent. L.J. 375 2009-2010

OF SILOS AND CONSTELLATIONS:  
COMPARING NOTIONS OF ORIGINALITY IN COPYRIGHT  
LAW<sup>♦</sup>

ELIZABETH F. JUDGE<sup>\*</sup> AND DANIEL GERVAIS<sup>\*\*</sup>

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Originality is simply a pair of fresh eyes.

– Thomas Wentworth Higginson (1823-1911)<sup>◇</sup>

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<sup>\*\*</sup> Associate Professor, University of Ottawa, Faculty of Law (Common Law Section).

## I. INTRODUCTION

Originality is a central theme in the efforts to understand human evolution, thinking, innovation, and creativity. Artists strive to be original, however the term is understood by each of them. It is also one of the major concepts in copyright law. In a previous discussion of the notion,<sup>1</sup> one of the Authors noted that (a) the notion is defined neither in international treaties nor in the vast majority of national laws and (b) it is the most important notion of copyright law because it is the sieve that determines which “productions of the human spirit” are protected by copyright and acquire the status of “work.”<sup>2</sup> The other main condition, namely that the production should belong to the literary or artistic domain,<sup>3</sup> has not precluded databases or computer programs from being protected by copyright.<sup>4</sup>

In *Feist Goes Global*, it was suggested that the notions of originality developed by courts in civil law and major common law jurisdictions tended to converge around a notion based on what the U.S. Supreme Court referred to as a “modicum of creativity.”<sup>5</sup> In some jurisdictions, the threshold of creativity was somewhat higher. In others, it was referred to in different terms. For example, in the Canadian Supreme Court case of *CCH Canadian Ltd. v. Law Society of Upper Canada*,<sup>6</sup> the Court found that originality required non-mechanical, non-trivial skill and judgment, and that the work must originate from an author and not be copied from another work. In parsing the content of those notions, *Feist Goes Global* argued that originality stemmed from creative choices made

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<sup>\*\*</sup> Professor of Law, Vanderbilt University Law School.

We gratefully acknowledge support from the Social Sciences and Humanities Research Council of Canada, the Law Foundation of Ontario, and the Faculty of Law at the University of Ottawa. We thank Leanne Fioravanti, Kiernan Murphy, Anna Wysocka, and Martin Zatowkaniuk for their excellent research assistance. © 2009 Elizabeth F. Judge & Daniel Gervais.

◇ Thomas Wentworth Higginson, *Atlantic Essays* 54 (2009).

<sup>1</sup> Daniel Gervais, *Feist Goes Global: A Comparative Analysis of the Notion of Originality in Copyright Law*, 49 J. Copyright Soc’y U.S.A. 949 (2002) [hereinafter *Feist Goes Global*].

<sup>2</sup> We use this generic term as it is used in Article 2 of the Berne Convention for the Protection of Literary and Artistic Works, July 24, 1971 25 U.S.T. 1341, 828 U.N.T.S. 221 [hereinafter *Berne Convention*].

<sup>3</sup> *Berne Convention*, *supra* note 2 (protecting “literary and artistic works”). The role of the Convention, which is the most important copyright convention in both age and coverage (e.g., number of member countries), was further enhanced when most of its substantive provisions were incorporated into the Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, 1869 U.N.T.S. 299, 33 I.L.M. 1125, 1197 [hereinafter *TRIPS Agreement*].

<sup>4</sup> There remains a third condition in a few legal systems, namely that the production should be fixed in a “tangible medium of expression.” *See, e.g.*, 17 U.S.C. § 102(a).

<sup>5</sup> *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346 (1991).

<sup>6</sup> *CCH Canadian Ltd. v. Law Soc’y of Upper Can.*, [2004] 1 S.C.R. 339 (Can.).

by the author. “Creative choices” were defined in that context as those made by a human author which are not dictated by the function of the work, the method or technique used, or by applicable standards or relevant “good practice.”<sup>7</sup> Literary and artistic works are the result of one or more of three types of choices: *technical choices*, those that are essentially dictated by the technique used (e.g., in painting or photography, or certain forms of poetry); *functional choices*, those dictated by the function that a utilitarian work will serve (e.g., a chair must not collapse when someone is sitting on it); and finally *creative choices*, those that truly stem from the author and where, if someone else has produced the work, there would most likely have been a different result. Intellectual property does not reward the first category (unless a *new* technique is invented perhaps); copyright does not reward the second but other forms of intellectual property (e.g., patent) might. Copyright’s focus is on the latter category.

In this paper, we consider the evolution of the notion of originality since 2002 (when *Feist Goes Global* was published) and continue the analysis, in particular whether the notion of “creative choices,” which seems to have substantial normative heft in several jurisdictions, is optimal when measured in more operational terms. In Part II, we consider the four traditional silo-like notions of originality used in national legal systems. In Part III, we look at the major international treaties for guidance in defining the parameters of an international notion of originality. In Part IV, we analyze the silos and suggest that they take the form of constellations which cannot be defined or compared hierarchically or indeed as completely separate notions; rather, they overlap in myriad ways. In the last part, we conclude that while normatively *Feist* had a very significant impact, the notion of originality it strived to define was perhaps best explained and operationalized in the *CCH* case.

## II. SILOS OF ORIGINALITY STANDARDS

Under the orthodox interpretation of originality for purposes of copyright law, there are four different families of standards, speaking broadly, which, ranged from most restrictive to most generous, are the European Union’s (“E.U.”) personal intellectual creation,<sup>8</sup> the United States’s *Feist* minimal degree of creativity,<sup>9</sup> Canada’s *CCH* standard of non-mechanical and non-trivial exer-

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<sup>7</sup> *Feist Goes Global*, *supra* note 1, at 976-77.

<sup>8</sup> See *infra* Part II.A.

<sup>9</sup> See *infra* Part II.B.

cise of skill and judgment,<sup>10</sup> and the United Kingdom's skill and labour standard.<sup>11</sup> Part II overall discusses the origin, development, complexities, and critiques of copyright originality standards in continental Europe, the United States, Canada, the United Kingdom and other commonwealth jurisdictions; and a discussion of originality under international treaties follows in Part III.

### A. *Personal Intellectual Creation*

#### 1. Originality in Continental European Systems and National Law

Interestingly, the notion of originality appeared rather late in French jurisprudence. It had emerged first in doctrine, as is often the case in civil law systems. Professor Henri Desbois is credited with using the notion as a filter or criterion to determine what deserves protection.<sup>12</sup>

The classic originality test in France is that the work must express or reflect the author's personality. In theory, this is consistent with a Hegelian-derived intellectual property philosophy, but in application, it is a fairly subjective standard.<sup>13</sup> According to French commentator Jean Martin, it was not surprising that such a subjective test would emerge during the nineteenth century because it fit "the modes of expression then in vogue – sculpture, painting and writings–," that is to say, "the expression of (inner) turmoil (*tourmente*) of the author, the emotional, subjective and non-rational aspect of human thought. In a way, what differentiates one work from another is its irrationality, a reflection of the author's own irrational mind."<sup>14</sup> The personality test is still regularly invoked by courts.<sup>15</sup>

<sup>10</sup> See *infra* Part II.C.

<sup>11</sup> See *infra* Part II.D.

<sup>12</sup> André Lucas & H.J. Lucas, *Traité de la Propriété Littéraire et Artistique* 72 (3d ed. 2006).

<sup>13</sup> *Id.* at 73-74, "The classic thesis is simple: Originality must be understood as the mark of the author's personality." (translated by authors).

<sup>14</sup> Jean Martin, *Le Droit D'Auteur Applicable au Logiciel*, in *Le Droit d'Auteur Aujourd'hui* 99, 111 (Isabelle de Lamberterie ed., 1991) (translated by authors).

<sup>15</sup> See, e.g., *France: Intellectual Property Code – "Sawkins v. Harmonia Mundi,"* 37 INT'L REV. INTELL. PROP. COMPETITION L. 116 (2006) [hereinafter *Sawkins/Harmonia Mundi*]. The court concluded that a performance edition restoring the music of a French Baroque-era composer, where the only surviving copy was posthumous, was original as he was "obliged to make personal and arbitrary artistic choices on the basis of his personal interpretation." *Id.* at 119.

In order to be eligible for copyright protection, a work must bear the intellectual and personal stamp of the author's contribution, irrespective of its degree of originality . . . . Given the state of the sources, the defendants have not proven a degree of strict faithfulness of the restored work to [the composer's] intention that would be capable of denying any personal character in the restoration and composition work such that it became a mere act of transcription.

*Id.* at 118-19.

This approach, while understandable for expressive works, such as sculpture, writings, and painting, did not mesh well with more utilitarian works, such as compilations and databases. For these works, the French courts did not jettison the traditional notion of originality when deciding which of these works were protected, or to what extent. Instead, they searched for a more objective test than personality because it became unrealistic to find the personality of the author of a database or of a computer operating system. These problems, though *quantitatively* unprecedented in the evolution of copyright given the size of the computer industry (which saw itself suddenly as both a newcomer and the largest player among copyright holders) and which were certainly made more acute by information technologies,<sup>16</sup> were not altogether *qualitatively* new, for authors' rights did apply to utilitarian works, such as encyclopedias, maps, and other works in which the search for a subjective mark of the author's personality was unlikely to be convincingly fruitful.

The test that courts developed in France and in a number of other European countries is creative choices: which choices did the author make that were guided neither by applicable standards, the method used to create the works, nor considerations of optimal functionality and efficiency.<sup>17</sup> Professor André Lucas refers to this as "l'arbitraire de l'auteur."<sup>18</sup>

For example in a case involving a bilingual dictionary, the Court of Appeal of Paris found that "the choices and intellectual operations required to create the [dictionary] tend to give the resulting work a certain degree of originality, even when dealing with a technical type of work."<sup>19</sup> The court made it clear that the fact of sorting data that was difficult to generate in alphabetical order was not original, thus refusing a sweat of the brow or labour-based (dessert) approach. Originality can only follow, it said, from intellectually creative (as opposed to mechanical or functional or format-driven) choices.<sup>20</sup> A similar conclusion was reached by the same court a few years later concerning a catalog

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See *infra* note 109 for *Sawkins's* successful litigation involving a similar work before England's Court of Appeals applying the skill, labor, and judgment originality standard.

<sup>16</sup> When measured in dollar terms, worldwide revenues in 2006 for companies in the *Software 500* list were \$394 billion. This can be compared to the \$891 billion that the core copyright industries generated in the U.S. in 2006. See STEPHEN E. SIWEK, COPYRIGHT INDUSTRIES IN THE U.S. ECONOMY: THE 2006 REPORT (2006), [http://www.iipa.com/pdf/2006\\_siwek\\_full.pdf](http://www.iipa.com/pdf/2006_siwek_full.pdf); John P. Desmond, *Innovation Alive and Well*, SOFTWARE MAG. (Nov. 2008), available at <http://www.softwaremag.com/L.cfm?Doc=1175-10/2008>.

<sup>17</sup> See *supra* note 7 and accompanying text.

<sup>18</sup> Lucas, *supra* note 12, at 84-85.

<sup>19</sup> Cour d'appel [CA] [regional court of appeal] Paris, 4e ch., March 21, 1989, R.I.D.A. 1989, 333, 338-39 (Fr.) (translated by authors).

<sup>20</sup> *Id.* at 338-39.

of Cajun words.<sup>21</sup> A test similar to creative choices is applied by the French courts when deciding who the author of a collective work is. In a case involving a multimedia work, the author was determined to be the person who selected the texts, music, and displays, not the person who took all the necessary technical steps to give the work its “materiality.”<sup>22</sup>

Another interesting case that illustrates the standard applied to compilations involved a compilation of short stories based on traditional folklore.<sup>23</sup> Because the stories themselves were in the public domain through the expiration of the term of protection, copyright could only subsist in the original selection and arrangement of stories. The court found that “by choosing the stories, by narrating them with his own style, and by arranging them according to a sequence chosen by him and which was not necessary,<sup>24</sup> and by giving the book a specific structure, Mr. Guillois created a creative work.”<sup>25</sup>

The French courts have recognized the protection of several types of compilations: statistical studies,<sup>26</sup> collective agreements,<sup>27</sup> comparative tables of television audience ratings,<sup>28</sup> specialized telephone directories,<sup>29</sup> and calendars.<sup>30</sup> The French Supreme Court<sup>31</sup> made it clear that labor itself was insufficient<sup>32</sup> and that one had to look at the choice of the method used by the author of the compilation.<sup>33</sup> In fact, recognizing that the classical test could not be used for newer types of works such as databases (a type of compilation) and computer software, several French courts have

<sup>21</sup> Cour d'appel [CA][regional court of appeal] Paris, 1e ch., Jan. 14, 1992, R.I.D.A. 1992, 198 (Fr.).

<sup>22</sup> Cour d'appel [CA][regional court of appeal] Paris, 4e ch., Apr. 28, 2000, R.I.D.A. 2000, 314 (Fr.).

<sup>23</sup> Cour d'appel [CA][regional court of appeal] Paris, 4e ch., Sept. 23, 1992, R.I.D.A. 1992, 224 (Fr.).

<sup>24</sup> “Not necessary” in the sense of not having been guided by the technique used or standard practices concerning this type of compilation.

<sup>25</sup> Cour d'appel [CA][regional court of appeal] Paris, 1e ch., *supra* note 23, at 224-25 (translated by authors).

<sup>26</sup> Tribunaux de grande instance [T.G.I.][ordinary courts of original jurisdiction] Paris, *réf.* Jan. 18, 1999 (Fr.); Juris-Data no. 043760.

<sup>27</sup> Tribunaux de grande instance [T.G.I.][ordinary courts of original jurisdiction] Lyon, Dec. 28, 1998, R.I.D.A. 1998, 325 (Fr.).

<sup>28</sup> Cour d'appel [CA] [regional court of appeal], Paris, 1e ch., May 22, 1990, R.I.D.A. 1990, 67 (Fr.).

<sup>29</sup> Cour d'appel [CA] [regional court of appeal], Dec. 18, 1924, D.H., 1925, 30 (Fr.).

<sup>30</sup> Cour d'appel [CA] [regional court of appeal] Paris, 4e ch., Apr. 14, 1986, D. 1987, Somm. 152, obs. F. Colombat (Fr.).

<sup>31</sup> The Civil Supreme Court, namely the *Cour de cassation*. There are other “supreme courts” in France for administrative and constitutional law.

<sup>32</sup> Cour de cassation, Première chambre [Cass. 1e civ.][highest court of ordinary jurisdiction, first civil division], May 2, 1989, Bull. civ. I., No. 309 (Fr.).

<sup>33</sup> Cour de cassation, Chambre commerciale et financière [Cass. com.][highest court of ordinary jurisdiction, commerce and finance division], Mar. 17, 2004, Bull. civ. IV, No. 263 (Fr.).

tried to develop a new test or, more precisely, to elevate the classical test to a higher level of abstraction by answering the following question: what is it that an author does to show her personality through a work? The fairly unanimous answer given by French courts is that it is creative choices that distinguish one work from another and reveal personality.<sup>34</sup> This doctrine was applied by a court denying protection to a database of requests for proposals by governmental authorities that was produced by a newspaper.<sup>35</sup>

Thus, in France the modern test is seen to be a subset of the classic test for originality: the modern test of examining creative choices is a way to evaluate whether an author's personality is reflected in a work and, hence, if the work is original.

Similar, though not as completely developed, doctrines have been accepted by courts in Belgium,<sup>36</sup> the Netherlands<sup>37</sup> and Switzerland.<sup>38</sup> Swiss copyright scholars Denis Bannelet and Willi Egloff assert that what creates originality are choices made by the author that were not dictated by custom or good practice.<sup>39</sup>

In Belgium, there is authority recognizing copyright originality in functional works, albeit thin, if the author's personality is distinguished. The Supreme Court (*Cour de cassation*) acknowledged that a catalog could be original, but that the protection would be very thin.<sup>40</sup> Another decision recognized that certain non-descriptive newspaper headlines could also be original, while invoking the classic personality test that a work "must be original, that is, it must be distinguished by the personality, the distinctive stamp, of its author."<sup>41</sup>

In the Netherlands, copyright protection has been denied to television program listings, not because of their utilitarian nature

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<sup>34</sup> See Daniel Gervais, *La Notion d'Œuvre dans la Convention de Berne et en Droit Comparé* 85-86 (Librairie Droz 1998).

<sup>35</sup> Cour d'appel [CA] [court of appeal] Paris, June 18, 1999, R.I.D.A. 1999, 316 (Fr.).

<sup>36</sup> Cour de cassation, Première chambre civile [Cass. 1<sup>e</sup> civ.] [highest court of ordinary jurisdiction, first civil division], Apr. 27, 1989, R.W. 1989-90, at 362; Oct. 25, 1989, R.W. 1989-90, at 1061; see also Alain Strowel, *L'Originalité de L'Œuvre*, in *Copyright and Industrial Property: Congress of the Aegean Sea II* 392 (1991); ALAIN STROWEL, *DROIT D'AUTEUR ET COPYRIGHT* 420-31 (Librairie Générale de Droit et de Jurisprudence 1993).

<sup>37</sup> See *Van Dale v. Romme II*, HR Apr. 1, 1993, IER 1993 (3) at 82; see also STROWEL, *DROIT D'AUTEUR ET COPYRIGHT*, *supra* note 36, at 5-26.

<sup>38</sup> See Gervais, *supra* note 34 at 87-88; MAX KUMMER, *DAS URHEBERRECHTLICH SCHÜTZBARE WERK* 30 (Verlag Stämpfli & Cie 1968); Denis Bannelet & Willi Egloff, *Le Nouveau Droit D'auteur: Commentaire De La, Loi Fédérale Sur le Droit d'Auteur et les Droits Voisins* 24 (1994).

<sup>39</sup> In French, "règles de l'art." See Denis Bannelet & Willi Egloff, *supra* note 38, at 10-24. One leading commentator specifically excludes as a requirement that the author's personality be visible. See F. Dessemontet, *Le Droit d'Auteur*, 1999, at § 159.

<sup>40</sup> Cour de cassation [Supreme Court of Belgium], C.00.0391.N, May 11, 2001, Art Research & Contact v. B.S. (Belg.), available at [http://jure.juridat.just.fgov.be/pdfapp/download\\_blob?idpdf=F-20010511-4](http://jure.juridat.just.fgov.be/pdfapp/download_blob?idpdf=F-20010511-4).

<sup>41</sup> *Google Inc. v. Copiepress SCRL*, [Court of First Instance of Brussels] [2007] E.D.C.R. 5 (Belg.) (translated by authors).

per se, but because they did not reflect the author's personality: "the way in which they are ordered is not sufficient evidence of a personal vision or any originality on the part of their creator. These schedules can therefore not be regarded as works of literature, science or art which are entitled to full copyright protection."<sup>42</sup>

In another Dutch case, this one before the Supreme Court and involving "kinetic schemes" (representations of a factually existing chemical reaction system), the court again emphasized the subjective personality test, namely whether the scheme bore the "imprint of the maker."<sup>43</sup>

Germany, however, is a somewhat different story. Although the standard may not be different, German courts have applied a stricter test. While influenced by Hegelian and Kantian theories, which, especially in Hegel's case, linked creative expression with the formation and deployment of personal autonomy and, therefore, attached great importance to artistic expression, modern German doctrine combines a mostly subjective search for individuality (*individualität*)<sup>44</sup> with the requirement of a minimal threshold of creativity (*gestaltungshöhe*).<sup>45</sup> In a case involving telephone directories, the Court found the work not to be protected by copyright, even though it followed a complex system of rules:

The personal intellectual creation required for the assumption of a protected literary work can be found in the intellectual formation and structuring of the contents presented or in the particularly imaginative form and manner of the collection, classification and arrangement of the material presented. A telephone directory is a work of reference, and the information it contains is, from a copyright point of view, in the public domain, with the result that, given the small scope for individual arrangement, there can a priori be no intellectual creative content in the formation and structure of ideas of the contents reproduced . . . . [C]ompliance with this system of rules does not mean that the . . . telephone directories . . . can be regarded as individual intellectual creations with the necessary level of creativity. As often in the sorting of large data collections to be reproduced in full, these rules concern less the selection of the data records to be included – the subscribers to be included in the directory are in any event determined in advance – and more the uniformity of the arrangement and presentation . . . .

<sup>42</sup> Holdingmaatschappij de Telegraaf N.V./Nederlandse Omroep Stichting, Gerechtshof [Hof] [ordinary court of appeal], The Hague, 30 januari 2001, [2002] E.C.D.R. 8 (Neth.).

<sup>43</sup> Antoon A. Quaevlieg, *Netherlands: Copyright Act 1912, Arts. 1, 10: "Technip Benelux,"* 38 INT'L REV. OF INTELL. PROP. COMPETITION L., 615, 619-21 (2007).

<sup>44</sup> See ERNST ULMER, URHEBER- UND VERLAGSRECHT 124 (3rd ed. 1980), at 124.

<sup>45</sup> See U. LOEWENHEIM, URHEBERRECHT KOMMENTAR §20-21 (G. Shricker ed., 3d ed. 2006).

Even if there may be several alternatives, the scope for individual creative arrangement is restricted by the fact that such directories are to a large degree subject to the conventions that have developed for alphabetical lists in general and telephone directories in particular . . . .<sup>46</sup>

In, *Buchhaltungsprogramm*, a different case involving computer programs, the court recalled the *Inkasso* case,<sup>47</sup> which denied protection to a computer program for lack of originality. According to the decision in *Inkasso*, software originality required that the creative work involved in the computer program “presuppose a significant amount of creativity with respect to selection, accumulation, arrangement and organization, as compared to the general, average ability.”<sup>48</sup> In noting the adoption of the Computer Programs Directive,<sup>49</sup> the *Buchhaltungsprogramm* court stated that the originality standard would have to be lowered, at least for software, but failed to elaborate on the revised standard.<sup>50</sup>

A lower requirement was also applied in a case involving maps,<sup>51</sup> and another accepted that headnotes could be original.<sup>52</sup> In such contexts, where factual accuracy is at a premium (e.g., in reporting what a judgment stated) or where there is little public interest in providing incentives to deviate from established and familiar formatting conventions (e.g., legends on maps), it is more difficult to identify how an author’s creative individuality should be assessed and what should be required. Thus, for headnotes, the court drew the line by accepting that concise formulation and structuring of the grounds for the legal decision amounted to a creative and individual activity, whereas simply stating the legal problem or a verbatim reproduction without classification would not. In the former situation, there was at least minimal room for choices made by the author.

Courts in Austria also look for the mark of the author’s personal intellectual creation, but are willing to recognize that a web-

<sup>46</sup> Bundesgerichtshof [BGH][Federal Court of Justice] May 6, 1999, I ZR 199/96 (F.R.G.), translated in 31 INT’L REV. INDUS. PROP. COPYRIGHT L. 1055, 1057-58 (2000), available at <http://lexetius.com/1999,844>.

<sup>47</sup> Bundesgerichtshof [BGH][Federal Court of Justice] May 9, 1985, IZR 52/83 (F.R.G.), translated in 17 INT’L REV. INDUS. PROP. COPYRIGHT L. 681 (1986). See also JOSEF DREXL, WHAT IS PROTECTED IN A COMPUTER PROGRAM?: COPYRIGHT PROTECTION IN THE UNITED STATES AND EUROPE, IIC Studies (VCH, Munich 1995).

<sup>48</sup> Bundesgerichtshof [BGH][Federal Supreme Court] May 9, 1985, *supra* note 47, at 688.

<sup>49</sup> See *infra* note 56.

<sup>50</sup> *Buchhaltungsprogramm*, BGH, 14 July 1993, [1993] CR 752-755. Translated in Andreas Günther & Ulrich Wuermelling “Software protection in Germany – Recent court decisions in copyright law,” [1995] 11 *Computer Law and Security Review* 12, 13.

<sup>51</sup> Bundesgerichtshof [BGH][Federal Supreme Court], May 28, 1998, I ZR 81/96 (F.R.G.), translated in 30 INT’L REV. INDUS. PROP. COPYRIGHT L. 968 (1999).

<sup>52</sup> Bundesgerichtshof [BGH][Federal Supreme Court], Nov. 21, 1991, I ZR 190/89 (F.R.G.), translated in 24 INT’L REV. INDUS. PROP. COPYRIGHT L. 669 (1993).

site of rental properties meet the requirement: “The person creating the work must reveal personal features – in particular through the visual design and the conceptual processing . . . . The requirements to be made of the work character of a database are no higher than for other types of work; quality and aesthetic worth are of no relevance.”<sup>53</sup> The same rule was applied to a website used to offer kitchen design services.<sup>54</sup>

What is strikingly absent in traditional Continental doctrine, whether in Germany, France or elsewhere, is an explicit utilitarian perspective, even though utilitarian considerations may well have informed some of the decisions, in effect lowering the threshold for protection. The equation – if P is protected by author’s rights, then result Q will enhance social welfare – is not commonly found in Europe in either cases or commentary, at least not explicitly. European legislators, however, seem determined to modernize the notion of originality by giving it more objective characteristics.

## 2. Originality in the European Union

Several directives have been adopted by the European Union to regulate various aspects of copyright policy.<sup>55</sup> When adopting directives, which are essentially legal instruments addressed at individual E.U. Member States asking them to change their legislation to comply with the directive, a process known as transposition, E.U. legislators, both Commissioners and members of the European Parliament, are obliged to take account of the interests of all twenty-seven EU Member States. In the field of copyright, this includes common law jurisdictions (e.g. Ireland and the United Kingdom). Three copyright directives are most important for our purposes, namely the Directive on the Legal Protection of Databases,<sup>56</sup> the Directive on the Legal Protection of Computer

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<sup>53</sup> Oberster Gerichtshot [OGH] [Supreme Court] July 10, 2001, 4 Ob 155/01 (Austria), translated in 34 INT’L REV. INTELL. PROP. COMPETITION L. 223, 225 (2003).

<sup>54</sup> Oberster Gerichtshof [OGH] [Supreme Court], April 24, 2001, 4 Ob 94/01 (Austria), translated in 34 INT’L REV. INTELL. PROP. COMPETITION L.106 (2003).

<sup>55</sup> Apart from the Directives mentioned in the following three notes, relevant Directives would include the following: Council Directive 98/71, Legal Protection of Designs, 1998 O.J. (L 289) 28 (EC); Council Directive 2004/48, The Enforcement of Intellectual Property Rights, 2004 O.J. (L 195) 15 (EC); Council Directive 2001/29, Harmonisation of Certain Aspects of Copyright and Related Rights in the Information Society, 2001 O.J. (L 167) 10 (EC); Council Directive 92/100, Rental Right and Lending Right and on Certain Rights Related to Copyright in the Field of Intellectual Property, 1992 O.J. (L 346) 61 (EEC); Council Directive 2001/84, The Resale Right for the Benefit of the Author of an Original Work of Art, 2001 O.J. (L 272) 32 (EC); Council Directive 93/83, The Coordination of Certain Rules Concerning Copyright and Rights Related to Copyright Applicable to Satellite Broadcasting and Cable Transmission, 1993 O.J. (L248) 15 (EEC); Council Directive 87/54, The Legal Protection of Topographies of Semiconductor Products, 1987 O.J. (L 24) 36 (EEC).

<sup>56</sup> Council Directive 96/9, 1996 O.J. (L 77) 20 (EC) [hereinafter Database Directive].

Programs,<sup>57</sup> and the Directive on the Term of Protection of Copyright.<sup>58</sup>

The Computer Programs Directive states that 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.”<sup>59</sup> The Database Directive provides, using similar language but incorporating language closer to Article 2(5) of the Berne Convention<sup>60</sup> that “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.”<sup>61</sup> Finally, the Term Directive provides that photographs

[W]hich 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. Member States may provide for the protection of other photographs.<sup>62</sup>

The last sentence can be explained in that a number of Northern European countries provide protection for non-original photographs, for a shorter term than full copyright.<sup>63</sup> However, Recital 17 of the Term Directive adds the following:

Whereas the protection of photographs in the Member States is the subject of varying regimes[;] whereas in order to achieve a sufficient harmonization of the term of protection of photographic works, in particular of those which, due to their artistic or professional character, are of importance within the internal market, it is necessary to define the level of originality required in this Directive[;] whereas a photographic work within the meaning of the Berne Convention is to be considered *original if it is the author’s own intellectual creation reflecting his personality*, no other criteria such as merit or purpose being taken into account . . . .<sup>64</sup>

<sup>57</sup> Council Directive 91/250, 1991 O.J. (L 122) 42 (EEC) [hereinafter Computer Programs Directive].

<sup>58</sup> Council Directive 93/98, 1993 O.J. (L 290) 9 (EEC) [hereinafter Term Directive].

<sup>59</sup> Computer Programs Directive, *supra* note 57, at art. 1(3) (emphasis added). Recital 8 makes it plain that no tests as to the qualitative or aesthetic merits of the program should be applied.

<sup>60</sup> Berne Convention, *supra* note 2, at art. 2(5).

<sup>61</sup> Database Directive, *supra* note 56, at art. 3(1).

<sup>62</sup> Term Directive, *supra* note 58, at art. 6.

<sup>63</sup> See Institute for Information Law, *The Recasting of Copyright & Related Rights for the Knowledge Economy: Final Report*, Nov. 2006, at 33, available at [http://www.ivir.nl/publications/other/IViR\\_Recast\\_Final\\_Report\\_2006.pdf](http://www.ivir.nl/publications/other/IViR_Recast_Final_Report_2006.pdf) [hereinafter Recasting Report].

<sup>64</sup> Term Directive, *supra* note 58, at recital 17 (emphasis added).

Two important points can be made. First, originality is the only criterion that the twenty-seven EU Member States are allowed to apply in determining whether content that fits one of the categories of copyright material is protected. Second, originality, at least for computer programs, databases and photographs, is present when the work is an author's own intellectual creation.

It has been said that the formulation chosen by European lawmakers was clever because it can be read in two different ways.<sup>65</sup> One can read it as a reflection of the traditional Continental notion based on the personality of the author. Indeed, the term "personal creation" seems infused with at least some degree of personhood theory. Depending on the linguistic version, that interpretation is reinforced. In French, the creation must be *propre à son auteur*, and the Italian version is to the same effect, *una creazione dell'ingegno propria del loro autore*, while in German it is *eine eigene geistige Schöpfung ihres Urhebers*. The Spanish is simpler: *una creación intelectual de su autor*. Recital 17 of the Term Directive is an important argument in support of that thesis.

Another way to interpret the Directive is that the creation is the author's own simply if the author is the originator, that is, if she has not copied. This is closer to the traditional U.K. test.<sup>66</sup>

There is little doubt that the drafters intended to embrace the latter interpretation. In a key preparatory document,<sup>67</sup> one can see that the Commission envisaged a single, low common denominator, in order to protect (European) computer programs and databases:<sup>68</sup>

In every Member State, to be eligible for copyright protection *stricto sensu* a work must be "original" in the sense that it is the result of the creator's own intellectual efforts and not itself a copy. But in some jurisdictions, more may be required in certain cases, particularly where works have a utilitarian rather than an aesthetic function. Courts may then find that work lacks sufficient creative merit or is too modest in scope to attract full copyright protection though in some cases this "small change" (in German, "kleine Munze") may still be eligible for a lesser form of protection designed to protect the investment of time, manpower and money.<sup>69</sup>

<sup>65</sup> Lucas, *supra* note 12, at 85.

<sup>66</sup> See *infra* Part D.

<sup>67</sup> *Communication from the Commission: Green Paper on Copyright and the Challenge of Technology: Copyright Issues Requiring Immediate Action*, COM (88) 172 final (June 7, 1988) [hereinafter Green Paper], available at <http://aei.pitt.edu/1209/>.

<sup>68</sup> *Commission First Evaluation of Directive 96/9/EC on the Legal Protection of Databases* (Dec. 12, 2005), 7-8, available at [http://ec.europa.eu/internal\\_market/copyright/docs/databases/evaluation\\_report\\_en.pdf](http://ec.europa.eu/internal_market/copyright/docs/databases/evaluation_report_en.pdf).

<sup>69</sup> *Green Paper*, *supra* note 67, § 5.6.3.

A similar point was made in the Explanatory Memorandum to the Computer Programs Directive,<sup>70</sup> and the E.U. official who was responsible for copyright policy at the time seems also to have supported this view.<sup>71</sup>

This desire to endorse a single low common denominator is understandable. The Directive was adopted at a time when Europe may have been concerned that too high a standard could hurt its chances of competing in the (then exponentially growing) computer software industry, based on the belief that more copyright protection would help develop a stronger industry. That policy debate was also apparent elsewhere. In the United States, although there was no doubt that copyright applied to software by the time the Computer Programs Directive was adopted, courts were trying to determine the exact scope of protection, which in turn determined the scope of allowable competition.<sup>72</sup>

Indeed, the Computer Programs Directive was

primarily aimed at reconciling the strict continental test, especially as developed by German courts, with the more generous Anglo-Saxon “skill and labour” standard. According to the Commission, as a result the “droit d’auteur countries have had to lower their threshold for protection of software, while notably the UK and Ireland have had to raise their standard.”<sup>73</sup>

This explains why its drafters would have likely been motivated more by the U.K. approach; lowering the standard applied on the Continent at the time seemed like a more appropriate way of achieving the stated policy objective of protecting (more) computer software by copyright.

It is difficult to draw a single conclusion from our analysis of the E.U. Directives. One could conclude that two standards exist: one for photographs, another for other categories, including software and databases (compilations). One could even conclude that there are three zones of originality, namely skill-and labor-based (non-copied) originality for computer programs (and probably then also for databases); a zone with a higher standard based on the mark of the author’s personality for photographs; and a third

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<sup>70</sup> *Commission Proposal for a Council Directive on the Legal Protection of Computer Programs*, at § 1.3, COM (88) 816 final (Jan. 5, 1989).

<sup>71</sup> J.-F. Verstryngne, *Protecting Intellectual Property Rights Within the New Pan-European Framework: Computer Software*, in *A HANDBOOK OF EUROPEAN SOFTWARE LAW* 4 (M. Lehmann and C. Tapper eds. 1993).

<sup>72</sup> Contrast the protection of “everything that is not necessary to that purpose or function” of the program in *Whelan Assocs., Inc. v. Jaslow Dental Lab, Inc.*, 797 F.2d 1222-36 (3d Cir. 1986), to the abstraction-filtration-comparison test in *Computer Assocs. Int’l v. Altai, Inc.*, 982 F.2d 693 (2d Cir. 1992), and the refusal to protect menus in *Lotus Dev. Corp. v. Borland Int’l*, 49 F.3d 807 (1st Cir. 1995).

<sup>73</sup> Recasting Report, *supra* note 63, at 37 (footnote omitted).

zone which for E.U. Member States remains unregulated. Formally, the latter three-zone approach is the one that more closely matches the current letter of E.U. Directives, but perhaps not their spirit. If asked to consider the appropriate standard of originality, the European Court of Justice is unlikely to adopt the three-zone approach. After all, the Directives were adopted to harmonize the internal market. It would be a strange result indeed if Members (the vast majority) who currently have a single standard had to move to a double or triple standard. Yet, Recital 17 of the term Directive should be factored in the equation, as it forms part of E.U. law.

A solution to harmonize the originality standard may emerge as follows. For all categories of works, based on the World Intellectual Property Organization's ("WIPO") studies on the interpretation of the Berne Convention (and its incorporation in the Agreement on Trade-Related Aspects of Intellectual Property Rights ("TRIPS Agreement")), a single notion of originality based on creative choices seems to be implied in international copyright law. For functional or utilitarian works such as most computer programs and databases, creative choices are those that were not dictated to the author(s) by considerations of efficiency, functionality, or applicable standards and practices of the techniques used to program and create the works. For photography, originality follows from similar creative choices, but, as with other artistic media, the choices, the author's *arbitraire* in Professor André Lucas' words,<sup>74</sup> will reflect the author's personality, something that is illusory for technical works. Hence, a single standard of originality could be based on creative choices, while acknowledging that how those choices are reflected in a particular work, or category of work, may vary depending, *inter alia*, on the technical nature of the work. This dynamic solution (because the nature of creative choices may evolve as new forms of creation emerge) would also allow modulation of the notion by each Member State to reflect possible differences among "unharmonized" elements of their national legislation. As the Recasting Report notes:

[H]ow the courts interpret the criterion of originality depends on other 'local' factors as well, such as the availability of actions in unfair competition. The meaning of the criterion is dynamic, i.e. bound by time, place and local use, which has implications for any attempt to legislate a single standard for all categories of works across the [E.U.].<sup>75</sup>

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<sup>74</sup> Lucas, *supra* note 12, at 85.

<sup>75</sup> Recasting Report, *supra* note 63, at 38 (footnotes omitted).

### B. *Originality in the United States: Feist's Minimal Creativity*

There are many excellent articles in this volume about *Feist*.<sup>76</sup> The *Feist* standard is also discussed in *Feist Goes Global*.<sup>77</sup> It is thus unnecessary to dwell on the standard applied in that case; a short reminder suffices. In *Feist*, a unanimous Court explained that originality requires independent creation plus a modicum of creativity.<sup>78</sup> Because the requirement was distilled from the Constitution's use of the word "authors" in the Copyright Clause,<sup>79</sup> the requirement was said to be constitutionally mandated.<sup>80</sup> While *Feist* was ostensibly anchored in a number of important precedents, including *Trade-Mark Cases*<sup>81</sup> and *Burrow-Giles Lithographic Co. v. Sarony*,<sup>82</sup> there had been a long-standing split among the circuits and only the Second, Fifth, Ninth and Eleventh Circuits had openly espoused a notion of originality based on "creative selection."<sup>83</sup>

### C. *Originality in Canada: CCH's Exercise of Skill and Judgment*

Canada offers a particularly useful perspective for comparative originality studies, as Canada's Copyright Act is a hybrid that draws on both the common law and civil law traditions, and at various times and for various types of works it has drawn on both the United Kingdom's industriousness standard and the U.S. *Feist* standard. We also consider the impact that the *CCH* decision may have on other jurisdictions. In 2008, the *New York Times* ran an article on the waning influence of the U.S. Supreme Court and observed that the Supreme Court of Canada is widely cited by other foreign courts now:

Frederick Schauer, a law professor at the University of Virginia, wrote in a 2000 essay that the Canadian Supreme Court had been particularly influential because "Canada, unlike the United States, is seen as reflecting an emerging international consensus rather than existing as an outlier."

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<sup>76</sup> *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346 (1991).

<sup>77</sup> *Feist Goes Global*, *supra* note 1.

<sup>78</sup> *Id.* at 346.

<sup>79</sup> U.S. CONST. art. 1, § 8, cl. 8.

<sup>80</sup> Whether this limits the powers of Congress or whether Congress could invoke the Commerce Clause to legislate to protect productions that do not result from even a modicum of creativity is beyond the scope of this Article. However, the question is relevant both for sound recordings (protected as works under U.S. copyright law unlike other countries where they are protected under a separate, "neighboring" right) and the recent discussions about databases, see Daniel Gervais, *The Protection of Databases*, 82 CHI-KENT L. REV. 1109 (2007).

<sup>81</sup> *Trade-mark Cases*, 100 U.S. 82 (1879).

<sup>82</sup> *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884).

<sup>83</sup> See Tracy Lea Meade, *Ex-Post Feist: Applications of a Landmark Copyright Decision*, 2 J. INTEL. PROP. L. 245 (1994).

In New Zealand, for instance, Canadian decisions were cited far more often than those of any other nation from 1990 to 2006 in civil rights cases, according to a recent study in *The Otago Law Review* in Dunedin, New Zealand.

“As Canada’s judges are, by most accounts, the most judicially activist in the common-law world — the most willing to second-guess the decisions of the elected legislatures — reliance on Canadian precedents will worry some and delight others,” the study’s authors wrote.

American precedents were cited about half as often as Canadian ones. “It is surprising,” the authors wrote, “that American cases are not cited more often, since the United States Bill of Rights precedents can be found on just about any rights issue that comes up.”<sup>84</sup>

This may be prescient for copyright law as well. In a judgment of the India Supreme Court<sup>85</sup> and in a recent oral argument before the Australian High Court,<sup>86</sup> Canada’s Supreme Court decision in *CCH* was cited as a dominant precedent, together with *Feist*.

Canada’s Copyright Act expressly provides that copyright shall subsist in every original work, though there is no statutory definition of “originality.”<sup>87</sup> In 2004, the Supreme Court of Canada introduced Canada’s current originality standard that the work must originate from the author, that is be “more than a mere copy,”<sup>88</sup> and “must be the product of an author’s exercise of skill and judgment”<sup>89</sup> that “must not be so trivial that it could be characterized as a purely mechanical exercise.”<sup>90</sup> Under *CCH*’s “exercise of skill and judgment” standard, the court defined *skill* as “the use of one’s knowledge, developed aptitude or practised ability in producing the work,” and *judgment* as “the use of one’s capacity for

<sup>84</sup> Adam Liptak, *U.S. Court, a Longtime Beacon, Is Now Guiding Fewer Nations*, N. Y. TIMES, Sept. 17, 2008, at A1, available at <http://www.nytimes.com/2008/09/18/us/18legal.html?pagewanted=all>.

<sup>85</sup> *Eastern Book Co. v. Modak*, (2008) 1 S.C.C. 1.

<sup>86</sup> *IceTV Proprietary Ltd. & Anor v. Nine Network Austl. Proprietary Ltd.*, (2008) HCA-Trans 356. (Austl.). Subsequently in its judgment in that case, *IceTV Pty Limited v Nine Network Australia Pty Ltd* [2009] HCA 14 (22 April 2009), the High Court of Australia again distanced itself from a sweat of the brow approach in commenting about *Desktop Marketing*, (2002) 119 FCR 491, a previous copyright decision on compilations: “It may be that the reasoning in *Desktop Marketing* with respect to compilations is out of line with the understanding of copyright law over many years. These reasons explain the need to treat with some caution the emphasis in *Desktop Marketing* upon ‘labour and expense’ per se and upon misappropriation.” *Id.* at ¶¶ 187-188.

<sup>87</sup> Copyright Act, R.S.C., ch. C-42, §§ 2, 5 (1985).

<sup>88</sup> *CCH Canadian Ltd. v. Law Soc’y of Upper Can.*, [2004] 1 S.C.R. 339, ¶ 15 (Can.).

<sup>89</sup> *Id.*, at ¶ 25.

<sup>90</sup> *Id.*, at ¶16. The reference to not being mechanical presumably picks up on language from *Feist* that the “selection and arrangement of facts cannot be so mechanical or routine as to require no creativity whatsoever.” *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 362 (1991).

discernment or ability to form an opinion or evaluation by comparing different possible options in producing the work.”<sup>91</sup> As the court explained, an exercise of skill and judgment will “necessarily involve intellectual effort.”<sup>92</sup>

Previous to *CCH*, as the Supreme Court of Canada acknowledged, there were effectively two standards for minimal originality thresholds that were being applied by Canadian courts. On one end there was a low standard of sweat of the brow or industriousness, derived from the U.K. decision in *University of London Press* and usually characterized as “skill, judgment or labour,” which required that a work “originate from” the author in the sense of not having been copied.<sup>93</sup> On the other end, the higher standard reflected the *Feist* test of a modicum of creativity.<sup>94</sup> As in many other jurisdictions, the case that brought the debate over the appropriate copyright originality standard to a head in Canada involved telephone directories. In *Tele-Direct*, the Federal Court of Appeal approvingly cited *Feist*’s creativity requirement and, ruling that “skill, judgment or labour” is “conjunctive,” declined copyright in the arrangement of data in a yellow pages directory.<sup>95</sup> In the wake of the Federal Court of Appeal’s decision, *Tele-Direct* was criticized as straying too far from the traditional U.K. standard and too close to the U.S. *Feist* standard.<sup>96</sup> Some suggested the higher originality standard applied only to compilations, with the Federal Court’s own Trial Division putting forth that view.<sup>97</sup> After *Tele-Direct* and before the Supreme Court of Canada introduced Canada’s current originality standard in 2004, the two originality standards co-existed, with the high standard thought to be limited to factual compilations, while the traditional labor-based standard adopted from the U.K. continued to apply to other works. The confusion was exacerbated by the fact that courts evaluating the copyright of utilitarian or fact-based works in Canada (as in other jurisdictions that adopted the Anglo-standard) used various formulations for

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<sup>91</sup> *CCH*, [2004] 1 S.C.R. at ¶16.

<sup>92</sup> *Id.*

<sup>93</sup> *Univ. of London Press, Ltd. v. Univ. Tutorial Press, Ltd.*, (1916) 2 Ch. 601, 609, 611 (U.K.).

<sup>94</sup> *Feist*, 499 U.S. at 341.

<sup>95</sup> See *Tele-Direct Publ’ns Inc. v. Am. Bus. Info. Inc.* [1998] 2 F.C. 22 (Can.) (quoting J. Décarý, “[I]t is true that in many of the cases we have been referred to, the expression ‘skill, judgment or labour’ has been used to describe the test to be met by a compilation in order to qualify as original and, therefore, to be worthy of copyright protection. It seems to me, however, that whenever ‘or’ was used instead of ‘and’, it was in a conjunctive rather than in a disjunctive way.”).

<sup>96</sup> Australia’s Federal Court of Appeal, for example, declined to follow *Tele-Direct*’s shift to *Feist*. *Desktop Mktg. Sys. Party Ltd. v. Telstra Corp.*, (2002) F.C.A.F.C. 112 (Austl.).

<sup>97</sup> See *Hager v. ECW Press Ltd.*, [1999] 2 F.C. 287 (Can.); *Neudorf v. Netzwerk Prod.*, [2000] C.P.R. (4th) 154, ¶ 19 (Can.).

the originality standard: “skill, judgment or labour,”<sup>98</sup> “industry, skill or judgment,”<sup>99</sup> “work, skill, judgment and knowledge,”<sup>100</sup> “industriousness, sweat of the brow,”<sup>101</sup> and “independent research and labour.”<sup>102</sup> The language of the originality standard generally converged around “skill, judgment or labour,” but there were frequent deviations in wording, and discrepancies even within those courts applying a sweat of the brow standard as to whether it was a conjunctive “and” requiring both skill and labour or a disjunctive “or” phrasing that would allow the industrious collection of information to qualify for originality.<sup>103</sup>

The Canadian Supreme Court presented *CCH* as a Goldilocks solution, a “workable yet fair standard” between the “too low” sweat of the brow standard, which “shifts the balance...too far in favour of the owner’s rights, and fails to allow copyright to protect the public’s interest in maximizing the production and dissemination of intellectual works”<sup>104</sup> and the “too high” “creativity standard” of *Feist*, which, the court contended, “implies that something must be novel or non-obvious—concepts more properly associated with patent law than copyright law,” even though Justice O’Connor in *Feist* had stated that originality did not require novelty.<sup>105</sup> Although “intellectual creation” was not explicitly analyzed as part of the hierarchy of originality standards, and only *Feist* and sweat of the brow were contrasted, the Court did suggest that the common law industriousness standard departed from the idea of intellectual creation that was implicit in the Berne Convention and that the new standard was more congenial with the civilian jurisdictions’ requirement that the author must contribute something intellectual to the work. The court interestingly interprets that “something intellectual” as “namely skill and judgment”;<sup>106</sup> further, by incorporating the notion of “comparing different possible options” in the definition of judgment, the concept aligns with the European test of personal choices.<sup>107</sup> Thus, while widening the gap between the new standard of an “exercise of skill and

<sup>98</sup> *Slumber-Magic Adjustable Bed Co. v. Sleep-King Adjustable Bed Co.*, [1984] 3 C.P.R. (3d) 81 (Can.).

<sup>99</sup> *Id.*

<sup>100</sup> *B.C. Jockey Club v. Standen*, [1985] 22 D.L.R. (4th) 467 (Can.).

<sup>101</sup> *U & R Tax Serv. Ltd. v. H & R Block Canada Inc.*, [1995] 62 C.P.R. (3d) 257 (Can.).

<sup>102</sup> *Id.*

<sup>103</sup> On utilitarian works and the pre-*CCH* originality threshold in Canada, see Teresa Scassa, *Originality and Utilitarian Works: The Uneasy Relationship between Copyright Law and Unfair Competition*, 1 U. OTTAWA L. & TECH. J. 51 (2004).

<sup>104</sup> *CCH Canadian Ltd. v. Law Soc’y of Upper Can.*, [2004] 1 S.C.R. 339, ¶ 24 (Can.).

<sup>105</sup> *CCH*, [2004] 1 S.C.R. at ¶ 17; *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346 (1991).

<sup>106</sup> *CCH*, [2004] 1 S.C.R. at ¶ 20.

<sup>107</sup> *Id.* at ¶ 16.

judgment” and industriousness (or “skill and labour”), the court effectively aligns the new standard with the civil law “intellectual contribution.” By treating creativity as a high threshold, one closer to the colloquial sense of creativity than to how it was described in *Feist* or how it has since been applied by the U.S. courts, the *CCH* court situates creativity as not only conceptually distinct from intellectual contribution but seemingly higher than intellectual contribution, given that the court stated it would not “go as far” as requiring a minimal degree of creativity and yet saw analogies between intellectual contribution and skill and judgment.<sup>108</sup> Whether this *CCH* standard is indeed a middle standard and whether it is situated between “two extremes” is discussed in Part IV.

Applying the newly crafted standard, the full court unanimously ruled that the headnotes for judicial cases are original, “[e]ven if the summary often contains the same language as the judicial reasons” because the “act of choosing which portions to extract and how to arrange them in the summary requires an exercise of skill and judgment.”<sup>109</sup> Likewise, topical indexes were original because knowing which headings to include and distilling the decision down to a pithy summary indicated skill and judgment; conversely, published judicial reasons without editorial additions and which added only basic information and corrected minor grammatical errors were trivial and mechanical changes that did not satisfy originality. It is important to note that, similarly to the civil law standard of personal intellectual creation, the idea of selection and choices played a prominent role in the Court’s application of the standard.<sup>110</sup>

The Court associated *CCH*’s originality standard with the explicit public interest statement of copyright purpose that was first elaborated in *Théberge v. Galerie d’Art du Petit Champlain*<sup>111</sup>:

[T]he purpose of copyright law was to balance the public interest in promoting the encouragement and dissemination of works of the arts and intellect and obtaining a just reward for the creator. When courts adopt a standard of originality requiring only that something be more than a mere copy or that

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<sup>108</sup> *Id.* at ¶¶ 19-20, 22.

<sup>109</sup> *Id.* at ¶ 31.

<sup>110</sup> *Id.* On the case summary: “act of choosing which portions to extract and how to arrange them in the summary requires an exercise of skill and judgment,” *id.*; on the headnotes: “authors must select specific elements of the decision and can arrange them in numerous different ways. Making these decisions requires the exercise of skill and judgment . . . . They must also use their capacity for discernment to decide which parts of the judgment warrant inclusion in the headnotes.” *Id.* at ¶ 30; on the topical index: “[t]he author of the index had to make an initial decision as to which cases were authorities . . . .” *Id.* at ¶ 32.

<sup>111</sup> *Galerie d’art du Petit Champlain Inc. v. Théberge*, [2002] 2 S.C.R. 336 (Can.).

someone simply show industriousness to ground copyright in a work, they tip the scale in favour of the author's or creator's rights, at the loss of society's interest in maintaining a robust public domain that could help foster future creative innovation . . . . By way of contrast, when an author must exercise skill and judgment to ground originality in a work, there is a safeguard against the author being overcompensated for his or her work. This helps ensure that there is room for the public domain to flourish as others are able to produce new works by building on the ideas and information contained in the works of others.<sup>112</sup>

Though the court had articulated that purpose statement only in 2002, it was quickly entrenched in the high court's jurisprudence. By *Robertson* in 2006, the judgment could iterate that "This Court has repeatedly held [i.e. since 2002] that the overarching purposes of the Copyright Act are twofold: promoting the public interest in the encouragement and dissemination of artistic and intellectual works, and justly rewarding the creator of the work."<sup>113</sup>

#### D. *Originality in Common Law Jurisdictions: Skill and Labour and Its Development*

England's traditional standard for originality was a Lockean-derived industriousness standard, in which the work must originate from the author and be the product of more than minimal skill and labour. The standard was developed in *University of London Press*,<sup>114</sup> *Walter v. Lane*,<sup>115</sup> and *Ladbroke*.<sup>116</sup> This standard has been adopted by Ireland, Australia,<sup>117</sup> New Zealand,<sup>118</sup> Singapore,<sup>119</sup> and South Africa.<sup>120</sup> Factual compilations and other functional

<sup>112</sup> CCH, [2004] 1 S.C.R., at ¶ 23.

<sup>113</sup> *Robertson v. Thomson Corp.*, [2006] 2 S.C.R. 363 (Can.); 2006 SCC 43, ¶ 69, citing *Théberge*, *supra* note 111, at ¶ 30; *CCH*, *supra* note 6, at ¶ 23; and *Society of Composers, Authors and Music Publishers of Canada ("SOCAN")* 2004 SCC 45 at ¶ 40.

<sup>114</sup> *Univ. of London Press, Ltd. v. Univ. Tutorial Press, Ltd.*, (1916) 2 Ch. 601, 609, 611 (U.K.).

<sup>115</sup> *Walter v. Lane*, (1900) A.C. 539 (U.K.).

<sup>116</sup> *Ladbroke (Football) Ltd. v. William Hill (Football) Ltd.*, (1964) 1 W.L.R. 273, 287 (H.L.) (U.K.).

<sup>117</sup> *Sands & McDougall Proprietary Ltd. v. Robinson*, (1917) 23 C.L.R. 49 (Austl.); Australia's Federal Court of Appeal, for example, declined to follow *Tele-Direct's* shift to *Feist*. *Desktop Mktg. Sys. Party Ltd. v. Telstra Corp.*, [2002] F.C.A.F.C. 112 (Austl.).

<sup>118</sup> *Wham-O Mfg. Co. v. Lincoln Indus.* [1984] 1 N.Z.L.R. 641 (C.A.); *Henkel KGAA v. Holdfast N.Z. Ltd.*, [2006] N.Z.S.C. 102, ¶ 37 (S.C.), available at <http://www.worldlii.org//cgi-bin/disp.pl/nz/cases/NZSC/2006/102.html?query=Copyright%20and%20originality%20and%20New%20Zealand>.

<sup>119</sup> See Susanna H.S. Leong, *Legal Protection of Factual Compilations and Databases: Rethinking the Copyright Protection Model in Singapore*, 5 J. World Intell. Prop. 1047, 1048 (2002).

<sup>120</sup> *Haupt t/a Softcopy v. Brewers Marketing Intelligence (Pty) Limited and Others* 2006 (4) SA 458 (SCA) at 40 (S. Afr.), available at <http://www.saflii.org//cgi->

works, however, remain a source of tension when courts apply the industriousness standard. Though most of the Commonwealth jurisdictions remain adherents to the industriousness standard, many cases reveal judicial concerns that skill and labor needs to be applied vigilantly to factual compilations and derivative works to ensure that there is a sufficient contribution by the author. It has proven difficult for courts to, on the one hand, avoid overly expansive copyright when industriousness is applied and, on the other hand, articulate a strict industriousness threshold without incorporating terms associated with other originality standards, such as creativity or personality.

This concern has led some jurisdictions that had used skill and labour to break from that tradition: Canada, as described, has recently replaced that standard with a purportedly higher standard of the exercise of skill and judgment, and India has recently moved away from industriousness to Canada's standard, but with interesting inflections of *Feist's* minimal creativity. In both instances the supreme courts changed the standard when considering editorial enhancements to law judgments.

In the U.K., there is no statutory definition of originality in the Copyright Designs and Patents Act 1988, except for databases. Section 3A, which was added to transpose the E.U.'s Database Directive<sup>121</sup> into law, provides that databases are original if the selection or arrangement constitutes the author's own intellectual creation.<sup>122</sup> For works that fall outside the scope of E.U. copyright harmonization, U.K. courts continue to apply the skill, labour and judgment standard for originality. Interestingly, the U.K. simply incorporated the words of the Database Directive in the copyright statute without an indication of the impact on the definition of originality in other contexts.

An *obiter* statement by Lord Oliver in *Interlego v. Tyco* had questioned whether *Walter v. Lane's* skill and labour standard should be applied to copies, averring that "[s]kill, labour or judgment merely in the process of copying could not confer original-

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bin/disp.pl/za/cases/ZASCA/2006/40.html; *Biotech Laboratories (Pty) Ltd v. Beecham Group Plc and another* 2002 SA 11 (SCA) at para 8 (S. Afr.), available at <http://www.saflii.org/cgi-bin/disp.pl/za/cases/ZASCA/2002/11.html>.

<sup>121</sup> Database Directive, *supra* note 56.

<sup>122</sup> Copyright, Designs And Patents Act, 1988, Ch. 48, §3A(2), amended by Copyright and Rights in Databases Regulations, 1997, S.I. 1997/3032. Section 6(3A)(2) reads as follows: "For the purposes of this Part a literary work consisting of a database is original if, and only if, by reason of the selection or arrangement of the contents of the database constitutes the author's own intellectual creation."; See also Report from the Commission to the Council, the European Parliament and the Economic and Social Committee on the implementation and effects of Directive 91/250/EEC on the legal protection of computer programs, COM(2000) 199, available at [http://eur-lex.europa.eu/LexUriServ/site/en/com/2000/com2000\\_0199en01.pdf](http://eur-lex.europa.eu/LexUriServ/site/en/com/2000/com2000_0199en01.pdf).

ity.”<sup>123</sup> In *Hyperion Records v. Sawkins*, the Court of Appeal considered that question of how the originality of a work intended to be a copy of another should be evaluated. The case involved modern performing editions of a late 17th-century composer’s musical scores that were intended to be as close as possible to the composer’s, with the court ruling that they did qualify as original musical works.<sup>124</sup> In Lord Jacob’s view, the question of originality is one of degree: “how much skill, labour and judgment in the making of the copy is that of the creator of the copy?”<sup>125</sup> Sawkins “re-created [the 17<sup>th</sup>-century composer’s] work using a considerable amount of personal judgment. His re-creative work was such as to create something really new using his own original (not merely copied) work.”<sup>126</sup> As with other jurisdictions using the traditional Anglo-standard and facing works on the periphery of originality, such as factual compilations and copies of pre-existing works, skill and labour are shored up by recourse to personality or creativity (“re-creative work” and “create something really new”).<sup>127</sup> Significantly, the same author was also successful in protecting other performing editions of the composer’s music in litigation before the French courts under the personality test for originality.<sup>128</sup>

In Australia, the principles of originality for compilations are set out in *Desktop Publishing*, a “whole of universe” telephone directory case in which the Full Court of the Federal Court of Australia endorsed skill and labour and rejected *Feist*:

[A] compilation will ordinarily be an original literary work for copyright purposes if the compiler has exercised skill, judgment or knowledge in selecting the material for inclusion in the compilation . . . or in presenting or arranging the material . . . [I]f the compiler has undertaken substantial labour or incurred substantial expense in collecting the information recorded in the compilation.<sup>129</sup>

. . . .

[T]here is no principle that the labour and expense of collecting, verifying, recording and assembling (albeit routinely) data to be compiled are irrelevant to, or are incapable of themselves

<sup>123</sup> *Interlego A.G. v. Tyco Indus. Inc.*, [1988] R.P.C. 343, 371 (U.K.).

<sup>124</sup> *Hyperion Records Ltd. v. Sawkins*, [2005] EWCA (Civ) 565 (U.K.), available at <http://www.bailii.org/cgi-bin/markup.cgi?doc=/ew/cases/EWCA/Civ/2005/565.html>.

<sup>125</sup> *Id.* at ¶ 83.

<sup>126</sup> *Id.* at ¶ 86.

<sup>127</sup> *Id.*

<sup>128</sup> *Sawkins/Harmonia Mundi*, *supra* note 15.

<sup>129</sup> *Desktop Mktg. Sys. Party Ltd. v. Telstra Corp.*, [2002] F.C.A.F.C. 112, ¶ 409 (Austl.) (per Sackville, J.).

establishing, origination, and therefore originality. . . .<sup>130</sup>

In 2007, the Federal Court of Australia upheld copyright under the industriousness standard for a factual compilation produced by a television network of its weekly television schedule. The weekly schedules were computer generated from a master programming grid that was entered into a computer database. Consistent with *Ladbroke*, the court considered not only the skill and labour of drafting the synopses and selecting and arranging the additional program information but also the “‘antecedent’ or ‘preparatory’ skill and labour” of compiling the information, which in this case consisted of the network selecting and arranging television programs to attract viewers to programs in different timeslots and meet competitors’ programming.<sup>131</sup> In oral arguments of this case on appeal, the High Court seemed prepared to reconsider those precedents and *CCH* was invoked as a possible benchmark for Australia.<sup>132</sup>

In South Africa, the Supreme Court of Appeal also rejected *Feist*’s standard of minimal creativity and applied the U.K. substantial skill, judgment and labour standard to a computer program.<sup>133</sup>

In New Zealand, the Court of Appeal recently addressed a compilation of financial survey data for industry benchmarking. Although the court endorsed the U.K. “sufficient degree of labour, skill, and judgment” standard, in explaining how the standard was satisfied it stressed the survey’s “number of unusual or unique features which clearly result from the expenditure of sig-

<sup>130</sup> *Id.* at ¶160 (per Lindgren, J.).

<sup>131</sup> *Nine Network Austr. Proprietary Ltd. v. IceTV Proprietary Ltd.*, (2007) F.C.A. 1172, ¶ 46, available at [http://www.austlii.edu.au/cgi-bin/sinodisp/au/cases/cth/federal\\_ct/2007/1172.html?query=FCAFC%202002%20112%20or%202002%20FCAFC%20112](http://www.austlii.edu.au/cgi-bin/sinodisp/au/cases/cth/federal_ct/2007/1172.html?query=FCAFC%202002%20112%20or%202002%20FCAFC%20112) (citing *Ladbroke (Football) Ltd. v. William Hill (Football) Ltd.*, (1964) 1 W.L.R. 273, 287-88 (H.L.) (U.K.); see also *Desktop Mktg.*, [2002] F.C.A.F.C. 407-09 where Justice Sackville states:

Despite these qualifications, the course of authority in the United Kingdom and Australia recognises that originality in a factual compilation may lie in the labour and expense involved in collecting the information recorded in the work, as distinct from the “creative” exercise of skill or judgment, or the application of intellectual effort . . . . Moreover, much-cited cases . . . have rejected the view that, in assessing the originality of a compilation, only skill, judgment or labour associated with the presentation of the compilation (as distinct from skill, judgment or labour at an earlier stage) can be taken into account . . . . In assessing whether a factual compilation is an original work, the labour or expense required to collect the information can be taken into account regardless of whether the labour or expense was directly related to the preparation or presentation of the compilation in material form, provided it was for the purpose of producing the compilations . . . .

<sup>132</sup> See *Eastern Book*, *supra* note 85.

<sup>133</sup> *Haupt t/a Softcopy v Brewers Mktg. Intelligence (Pty) Ltd.* 2006 (4) SA 458, ¶ 35 (S. Afr.), available at <http://www.saflii.org/cgi-bin/disp.pl/za/cases/ZASCA/2006/40.html?query=copyright%20and%20originality>.

nificant creative effort and skill on the appellant's part."<sup>134</sup> That is, the unusual and unique features and creative effort were used to measure whether the originality standard of sufficient labour, skill and judgment had been satisfied.

Like the Supreme Court of Canada, the Supreme Court of India recently seemed to move away from the skill and labour standard in a case involving the copyright of a compilation of court decisions. In *Eastern Book Company v. Modak*, after a lengthy review of copyright originality cases, including English and Indian cases applying skill and labour, *Feist*, and *CCH*, the Court concluded that:

[The] principle laid down by the Canadian Court in [*CCH*] would be applicable to copyright of [a compilation of] , , , the judgments of the courts which are in the public domain [by statutory provision]. To claim copyright in a compilation, the author must produce the material with exercise of his skill and judgment which may not be creativity in the sense that it is novel or non-obvious, but at the same time it is not a product of merely labour and capital. The derivative work produced by the author must have some distinguishable features and flavour to raw text of the judgments delivered by the court. The trivial variation or inputs put in the judgment would not satisfy the test of copyright of an author.<sup>135</sup>

Under this standard, the publisher's additions of headnotes, editorial notes, and footnotes; designations for whether a judgment was concurring or dissenting; and even changes to the paragraphing to correspond to divisions in the judgment's legal arguments were all original, while minor editorial enhancements to the raw judgments, such as verifying case citations and quotations, were not. Interestingly, though it explicitly adopted Canada's *CCH* standard, which is positioned between the creativity and industriousness standards, India's Supreme Court nonetheless re-engages *Feist* by also requiring a minimal degree of creativity. This dual allegiance to *CCH* and *Feist* seems to follow from its requirement that the derivative work have "some distinguishable features and flavour," by which the court seeks a sign of individuality, and hence creativity:

No doubt the appellants have collected the material and improved the readability of the judgment by putting inputs in the

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<sup>134</sup> *Univ. of Waikato v. Benchmarking Services Ltd. & Anor*, [2004] N.Z.C.A. 90, ¶ 42 (C.A.), available at <http://www.worldlii.org/cgi-bin/disp.pl/nz/cases/NZCA/2004/90.html?query=Copyright%20and%20originality%20and%20New%20Zealand>.

<sup>135</sup> *Eastern Book*, *supra* note 85, at ¶ 38.

original text of the judgment by considerable labour and arranged it in their own style, but that does not give the flavour of minimum requirement of creativity. The exercise of the skill and judgment required to produce the work is trivial and is on account of the labour and the capital invested and could be characterized as purely a work which has been brought about by putting some amount of labour by the appellants . . . . To support copyright, there must be some substantive variation and not merely a trivial variation, not the variation of the type where limited/unique ways of expression are available and an author selects one of them which can be said to be a garden variety. Novelty or invention or innovative idea is not the requirement for protection of copyright but it does require minimal degree of creativity. In our view, the aforesaid inputs put by the appellants in the copy-edited judgments do not touch the standard of creativity required for copyright.<sup>136</sup>

In applying this blended standard to the paragraphing changes, India's Supreme Court upheld their originality. The paragraphing changes required the "exercise of the brain work . . . , careful consideration, discernment and choice" and thus "can be called as a work of an author . . . ." <sup>137</sup> These inputs "require knowledge, sound judgment and legal skill" and therefore "ha[ve] a flavour of minimum amount of creativity."<sup>138</sup>

### III. ORIGINALITY IN INTERNATIONAL COPYRIGHT TREATIES

The notion of originality was present in the minds of the majority of the drafters of the Berne Convention. A vast majority of those countries that negotiated the Berne Convention belong to the Roman/Civil law tradition of author's rights. The United States and the United Kingdom, which represented the more economic/utilitarian approach generally attributed to the common law tradition, were also present. However, even in the United States, debates about the role of the author under state common law persisted (this was before the 1909 Act and state common law protection remained, especially for unpublished works<sup>139</sup>). In ad-

<sup>136</sup> *Id.* at ¶¶ 59-60.

<sup>137</sup> *Id.* at ¶ 61.

<sup>138</sup> *Id.*

<sup>139</sup> See Staff of S. Subcomm. on Patents, Trademarks, and Copyrights of the Comm. on the Judiciary, 86th Cong. (Comm. Print 1961):

In the United States the rule is now well established that an author or his assignee may have perpetual common law rights in his work unless he publishes it, whereupon the common law rights are terminated . . . . Section 2 of title 17, U.S.C. (sec. 2, Act of 1909) provide[d] as follows: "Nothing in this title shall be construed to annul or limit the right of the author or proprietor of an unpublished work, at common law or in equity, to prevent the copying, publication, or use of such unpublished work without his consent, and to obtain damages therefor."

dition, the U.S. representative, the U.S. Consul at the Swiss Embassy in Berne, was at a disadvantage because he did not attend the first of the three Berne Conferences (in 1884) at which the groundwork for the future Convention was laid. The initial draft of the Convention was prepared by the Paris-based International Literary Association.<sup>140</sup> The president of the Association, Louis Ulbach, was a member of the French delegation at the first two Conferences, at which most of the substantive work was done. This should demonstrate the direct impact that the Civil Law/authors' rights notion of originality played in the elaboration of the Convention. This is confirmed by the text of Article 1, which refers to authors, and the many references throughout both the original text and future revisions of the Convention<sup>141</sup> to authors and their economic and moral rights, and to the term being linked to authors' lifetime with no provision for "corporate" authorship.<sup>142</sup>

That said, there is no direct definition of the concept of "originality" in either the Berne Convention<sup>143</sup> or the TRIPS Agreement.<sup>144</sup> In fact, the requirement that a work be "original" is not even mentioned. There are, however, several statements in records of diplomatic conferences and committees of experts meeting under the aegis of WIPO that confirm the requirement that originality be present, and that this is the only applicable criterion, to the exclusion, for example, of artistic merit or purpose.<sup>145</sup>

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*Id.* at §§ 2-3.

<sup>140</sup> This association was the predecessor of the modern-day International Literary and Artistic Association ("ALAI"), which is still active in many countries. The first President of the Association was Victor Hugo, the well-known French author. The key role of the Association is described in the initial letter sent by the Swiss government (Federal Council) on December 3, 1883, to invited governments.

<sup>141</sup> The last such revision of the Berne Convention was the Paris Act (1971). Berne Convention, *supra* note 2.

<sup>142</sup> Specific provisions had to be made for anonymous and pseudonymous works though. *See id.* at art. 7(3).

<sup>143</sup> *Id.*

<sup>144</sup> TRIPS Agreement, *supra* note 3. Actually, very few national laws contain such a definition. We studied ninety-three national laws and found a specific definition of originality in only three national laws, namely Bulgaria, Burkina Faso, and Malaysia. *See* GERVAIS, *supra* note 34, at 72-76. Indirectly, a definition is contained in the three European Union Directives that require that a work be the result of the author's "own intellectual creation." *See supra* notes 55-62 and accompanying text; *see also* Bridgeman Art Library, Ltd. v. Corel Corp., 36 F. Supp. 2d 191, 195 (S.D.N.Y. 1999).

<sup>145</sup> The first statement on originality was made during the Revision Conference of the Berne Convention held at Rome from May 7 to June 2, 1928. The Acts of this conference were originally published only in French (Actes de la Conférence réunie à Rome du 7 mai au 2 juin 1928 (Berne: Bureau de l'Union internationale pour la protection des oeuvres littéraires et artistiques, 1929)), but WIPO published an English translation of the records of all Berne revision conferences on the occasion of the centenary of the Berne Convention. *See* WIPO, *Berne Convention Centenary: 1886-1986* (1986) [hereinafter *Berne Centenary*]. In the General Report, rapporteur Edoardo Piola Caselli wrote:

The protection enjoyed by other works of art should be reserved for cinematographic productions which meet the requirements of originality laid down in

The term “work” itself is only “defined” officially by the list of categories of works in Article 2 of the Berne Convention. However, a WIPO Committee of Experts concluded that this expression was synonymous with “intellectual creation,”<sup>146</sup> and that such creation should contain “an original structure of ideas or impressions.”<sup>147</sup> The same committee also noted that originality “was an integral part of the definition of the concept of ‘work.’”<sup>148</sup>

In its memorandum for the meeting of the Committee of Experts, the International Bureau of WIPO explained:

Although this is not stated explicitly in Article 2(1) [of the Berne Convention], the context in which the words “work” and “author” are used in the Convention—closely related to each other—indicates that only those productions are considered works which are intellectual creations (and, consequently, only those persons are considered authors whose intellectual creative activity brings such works into existence). This is the first basic element of the notion of literary and artistic works.<sup>149</sup>

The records of various diplomatic conferences adopting and revising the Berne Convention reflect that the reason why Article 2(1) of the Convention does not state explicitly that works are intellectual creations is that that element of the notion of works was considered to be evident.<sup>150</sup>

The General Report of the Berne Convention Revision Conference held in Brussels in 1948 specifically states:

You have not considered it necessary to specify that those works constitute intellectual creations because . . . if we are speaking of literary and artistic works, we are already using a term which means we are talking about personal creation or about an intel-

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paragraph (2) [of Article 14]. In order to show clearly that the only requirement concerned here is that of the originality with which every work of the mind must be endowed . . .

*Id.* at 174.

<sup>146</sup> The concept of intellectual creation has been acknowledged as a synonym of work in several international meetings. See GERVAIS, *supra* note 34, at 45-49.

<sup>147</sup> Int'l Bureau of World Intellectual Prop. Org., *WIPO Committee of Experts on Model Provisions for Legislation in the Field of Copyright, First Session*, ¶178 WIPO Doc. CE/MPC/1/3 (March 3, 1989) (also stating: “[O]riginality [is] part of the definition of ‘work’ and . . . a reference to it should be included in Section 2(1) . . . The idea of providing a definition of the concept of ‘work’ was, however, opposed by a number of participants; it was felt that that question should rather be left to national legislation and/or to the courts.”).

<sup>148</sup> *Id.* While international meetings of this nature are not normative in nature, their findings are relevant as doctrinal input and in certain cases may reflect an existing international custom (see Article 38(1)(b) of the Statute of the International Court of Justice). The history of the Convention was also used extensively by a WTO dispute-settlement panel to interpret provisions of the Convention that were incorporated by reference into the TRIPS Agreement.

<sup>149</sup> Int'l Bureau of World Intellectual Prop. Org., *Memorandum prepared for the WIPO Committee of Experts on Model Provisions for Legislation in the Field of Copyright*, ¶151, WIPO Doc. CE/MPC/1/2-III (Oct. 20, 1988).

<sup>150</sup> *Id.* at ¶52.

lectual creation within the sphere of letters and the arts.<sup>151</sup>

The Berne Convention itself provides two important hints as to what constitutes an original work. Article 2, when discussing the protection of collections, states that, “[c]ollections of literary or artistic works such as encyclopedias and anthologies which, by reason of the selection and arrangement of their contents, constitute intellectual creations shall be protected as such, without prejudice to the copyright in each of the works forming part of such collections.”<sup>152</sup> Again, selection and arrangement are essentially choices that must be creative in order to generate copyright protection; and a creation may be considered “intellectual” if it fits that description.

The TRIPS Agreement only contains an *a contrario* definition, as it were. For the first time in an international agreement in this field a list of exclusions was agreed upon. In a provision which mirrors § 102(b) of the U.S. Copyright Act, Article 9(2) of TRIPS states, “[c]opyright protection shall extend to expressions and not to ideas, procedures, methods of operation or mathematical concepts as such.”<sup>153</sup> However, while this provision confirms the exclusion of ideas, it does not allow one to draw firm, detailed conclusions about originality, only that it must be “expressed,” that is, objectified so that it can be communicated to third parties if the author so wishes.

The WIPO Copyright Treaty (“WCT”) is also relevant.<sup>154</sup> The WCT, which entered into force on March 6, 2002 and has seventy member countries,<sup>155</sup> echoes Article 2(5) of the Berne Convention. Article 5 of the WCT provides in part as follows: “Compilations of data or other material, in any form, which by reason of the selection or arrangement of their contents *constitute intellectual creations*, are protected *as such*.”<sup>156</sup> Again this implies that intellectual creation is the applicable threshold, and we know that threshold is referred to as originality in most national legal systems. This recent international instrument thus confirms the link between (at least a modicum of) creativity and the fact that that creativity may be derived from choices, such as selection and arrangement. Intellectual creation is, however, a standard that, like *Feist*’s modicum of creativity, is difficult to operationalize, especially in borderline

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<sup>151</sup> Berne Centenary, *supra* note 145, at 179.

<sup>152</sup> Berne Convention, *supra* note 2, at art. 2(5).

<sup>153</sup> TRIPS Agreement, *supra* note 3, at art. 9(2).

<sup>154</sup> WIPO Copyright Treaty, Dec. 20, 1996, S. Treaty Doc. No. 105-17 [hereinafter WCT].

<sup>155</sup> This figure is as of September 2009. See WIPO, Contracting Parties, [http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty\\_id=16](http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=16) (last visited September 22, 2009).

<sup>156</sup> WCT, *supra* note 154, at art. 5 (emphasis added).

cases such as factual or collective works. It may be that the *CCH* standard of a non-mechanical and non-trivial exercise of skill and judgment would work better as an implementation of the international norm. It certainly seems compatible with it. Put differently, while *Feist* and the creation-based standard is normatively anchored, the *CCH* standard may provide a better implementation in cases where the presence of creativity, as that term is generally understood at least, is not obvious. It is worth noting that the English text of the Convention uses the conjunctive phrasing “selection and arrangement” while the WCT uses the disjunctive “selection or arrangement.” However, the French text of the Convention, which governs in case of any discrepancy between linguistic versions,<sup>157</sup> uses the disjunctive “or.”

#### IV. ANALYSIS

As the discussion describes, originality standards are not harmonized internationally. Not only might there be different standards for different categories of works within a country (e.g., computer programs, databases, and photographs may have a distinct standard from other works), but different countries might apply the same standard differently in practice (e.g., Germany’s more rigorous application of the personality test). In this part, we suggest some hypotheses that test the conventional wisdom about the distinctions between originality standards, the hierarchy of originality standards, the significance of the originality standards, and the possibility and desirability of harmonization.

##### A. *Hypothesis One: Originality Standards Are Constellations Not Silos*

Originality standards are conventionally presented as four silos of autonomous standards with little overlap and clear conceptual distinctions between jurisdictions. Indeed, the Supreme Court of Canada’s characterization of its “exercise of skill and judgment” standard as a “workable and appropriate standard” positioned between the “extremes” of the “too low” sweat of the brow standard and the “too high” creativity standard is axiomatic of this premise. Moreover, the lack of harmonization for the originality requirement, which has preserved these separate formulations of originality, underscores the distinctiveness of their objectives and application. However, originality standards are more properly understood as constellations, rather than silos, where the surface differences in wording mask similarities in both concepts and results.

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<sup>157</sup> Berne Convention, *supra* note 2, at art. 37(1)(c).

There is a great deal of overlap in results when the different standards are applied to similar facts: ordinarily, a given work that qualifies as original under one standard will also meet the other tests: it will reflect an author's intellectual creation, have a modicum of creativity, show skill and judgment, and originate from the author. Although the wording of the standards might suggest that the results would frequently diverge—industriousness would seem on its face to be much more lenient than intellectual creation or creativity—the judicial application of the standards has narrowed the gap by insisting on a sufficient degree of skill and labor, on one end, and accepting a very low degree of creativity, on the other. As the U.S. Supreme Court took pains to clarify with respect to *Feist*, “the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, ‘no matter how crude, humble or obvious’ it might be.”<sup>158</sup> Across the jurisdictions, there are many commonalities that could be said of originality: originality does not require an original form of expression; originality does not require original ideas; originality does not require innovation or novelty; and originality is irrespective of aesthetic quality or merit. What the England and Wales' Court of Appeal stated recently could be said of any of these jurisdictions regardless of the originality standard that they apply: “The policy of copyright protection and its limited scope explain why the threshold requirement of an ‘original’ work has been interpreted as not imposing objective standards of novelty, usefulness, inventiveness, aesthetic merit, quality or value.”<sup>159</sup> Thus, it is only in unusual contexts, notably utilitarian works, that the different formulations are potentially meaningful.

B. *Hypothesis Two: Public Policy Through Infringement Analysis Rather Than Copyrightability*

Although Canada purportedly increased its standard, relative to sweat of the brow, for the public policy of ensuring the appropriate copyright balance, increasingly the originality standard is not where that proper balancing is being guarded. Instead, the judicial trend is to find that the threshold for minimal original copyright has been met and to patrol the public policy objectives through infringement rather than copyrightability; that is, borderline cases are likely to be found original, but the scope of protection is thin and another work will have to copy it almost exactly to infringe. As the Supreme Court of New Zealand recently stated:

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<sup>158</sup> *Feist*, *supra* note 5, ¶ 10, quoting 1 M. Nimmer & D. Nimmer, *Copyright*, § 1.08[C][1].

<sup>159</sup> *Hyperion Records*, *supra* note 109, at ¶ 31.

The threshold for originality is a low one and it can be material for other purposes how original the work is; that is, how much skill and labour has gone into its creation. In general terms the greater the originality, the wider will be the scope of the protection which copyright affords and vice versa.<sup>160</sup>

C. *Hypothesis Three: Originality Standards Can Deviate from the Assumed Hierarchy*

Certainly the four families of originality standards do overlap in result most of the time and are operationally similar for most types of works. Despite the insistent positioning of *CCH* as a middle standard, the catchment for cases where there will be a functional difference between “exercise of skill and judgment” and creativity (or personal intellectual creation) will be small. The originality standards will usually produce the same results, and this is not surprising because it is only on the margins (e.g., compilations of facts or functional works) that the minimal originality threshold is an issue. That being understood as the norm, it is still the exceptions that are most appealing intellectually and best illustrate the nature of each standard. The relatively infrequent occasions in which the standards lead to different conclusions on originality are the most interesting and the most informative, as it is the exceptions on the periphery that prove the rule of the standards’ stability and overlap at the center. Two points can be made about these relatively infrequent instances where the originality standards will lead to different results. First, the hierarchy of standards that we followed in Part II will usually hold true; that is, it is usually easier to satisfy sweat of the brow than minimal creativity or intellectual creation. But second, the hierarchy of standards that we followed in Part II is not a necessary result of the standards; that is, in some contexts it may be easier to satisfy minimal creativity than an exercise of skill and judgment.

In Part II, we followed the traditional hierarchy by sequencing the standards from highest (i.e., most rigorous and most difficult to meet) to lowest with the E.U. at the upper end of the spectrum, followed by the U.S., Canada with its avowedly middle ground, and the U.K. industriousness standard at the low end of the spectrum. This hierarchy will hold true for most works where the standards have different results. For functional works (e.g., databases or software), it is harder to satisfy standards that emphasize the author’s personality than a standard that stresses industri-

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<sup>160</sup> Henkel KGAA v. Holdfast N.Z. Ltd., [2006] N.Z.S.C. 102, ¶ 38 (S.C.), available at <http://www.worldlii.org/cgi-bin/disp.pl/nz/cases/NZSC/2006/102.html?query=Copyright%20and%20originality%20and%20New%20Zealand>.

ousness.

Courts from outside the U.S., which may interpret creativity as a significant threshold, but worry (like the U.S. Supreme Court) that sweat of the brow had proved to be too low, have sometimes concluded that a new originality standard needed to be fashioned. The Supreme Court of Canada's design for an originality standard specifically addressed the conundrum of how to protect works in which accuracy is paramount and where creativity in the sense of individual personality is an undesirable aspect (with judicial headnotes being the paradigmatic example). *CCH's* new originality standard seems designed to set the standard at a threshold where works whose value resides in accuracy could satisfy originality without jeopardizing copyright's purposes (which might occur, for example, if the application of a too generous industriousness standard results in the contents of factual compilations being included within copyright's protection). Canada's Supreme Court proceeds from the premise that headnotes are worth protecting but did not, in their view, have the requisite creativity to satisfy the *Feist* standard, and therefore required a new originality standard to be fashioned.

Other examples of types of works for which a *CCH* standard seems to be intended and where it indeed functions as a middle standard are "whole-of-universe" directories in which the author has also used discretion and judgment to sequence the entries because simple principles of alpha- and chron-ordering are insufficient but where creativity is not desirable. This type of authorial contribution could meet a non-mechanical and non-trivial exercise of skill and judgment more easily than creativity. Similarly, the fraught problem of copies of art works (e.g., photographs of paintings or of other photographs) would seem more likely to satisfy skill and judgment than creativity.<sup>161</sup>

In each of these instances, *CCH's* standard would function as

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<sup>161</sup> See, e.g., *ATC Distrib. Group, Inc. v. Whatever It Takes Transmissions & Parts Inc.*, 402 F.3d 700 (6th Cir. 2005). The court states:

A reproduction of a work of art or photograph in a different medium is copyrightable in principle, if it involves great skill and originality, or substantial variation, not merely a trivial variation such as might occur in the translation to a different medium. Mere sweat of the brow, however, is insufficient to render a copy eligible for copyright protection. ...[n]or is the mere demonstration of physical skill or special training. The illustrations in ATC's catalog fall far short of the "substantial variation" required to justify copyright protection. The illustrations were intended to be as accurate as possible in reproducing the parts shown in the photographs on which they were based, a form of slavish copying that is the antithesis of originality.

*Id.* at 712 (citations omitted).

See also the discussion of copies of pre-existing works in Jane C. Ginsburg, *The Concept of Authorship in Comparative Copyright Law*, 52 DEPAUL L. REV. 1063, 1082-85 (2003).

the Supreme Court of Canada envisioned it, as a middle way. Importantly, however, this hierarchy is not a required conclusion of the standards themselves. It is possible to imagine works that would be protected under *Feist* but not under *CCH*; in some cases, albeit rarely, *CCH* may be more rigorous than *Feist*, and especially so if the language of the standards is applied in their colloquial sense. Originality standards do not always fall neatly and consistently in the hierarchy that has been presumed. That is, *CCH* is not necessarily a middle standard; it may simply be easier to apply because it focuses on the nature of the choices made by the author, independently of the type of work concerned or indeed any preconceived notion of creativity. *CCH* may thus solve the post-*Feist* quandary of operationalizing the “modicum of creativity” test.

Canada’s Supreme Court contended, “While creative works will by definition be ‘original’ and covered by copyright, creativity is not required to make a work ‘original.’”<sup>162</sup> Yet, this may be *obiter* if the standard is taken to prevail over the interpretation since it does not seem to follow that, by definition, creativity, especially if the term is defined colloquially, will always be an exercise of skill and judgment. Consider, for example, a translator of poetry who has a bad command of the original poem’s language, confusing homonyms and cognates for instance, but is a gifted stylist: the new poem is an inaccurate and inept translation but an elegant lyrical poem in its own right.<sup>163</sup> An inept translation arguably is not an “exercise of skill and judgment,” though viewed as a poem it is creative, and indeed is more likely to be creative the worse the translation is and the greater the divergence from the first poem. Here *CCH* is arguably operatively higher than *Feist*.

This points to a question that was not addressed by Canada’s Supreme Court: an exercise of skill and judgment with respect to *what*? Although the U.S. courts resist making authorial intention a relevant criterion, for Canada’s courts it may prove to be difficult to evaluate skill and judgment without considering the author’s intention as to the outcome.<sup>164</sup> How should the author who intends a poem to be a translation and not an homage, and who fails at the former but succeeds at the latter, be judged with respect to originality? Is “skill and judgment” to be evaluated according to whether it is *intended* by the author to be a poetic homage or a

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<sup>162</sup> *CCH Canadian Ltd. v. Law Soc’y of Upper Can.*, [2004] 1 S.C.R. 339, ¶ 25 (Can).

<sup>163</sup> Ezra Pound’s translations of *Sextus Propertius* are an excellent example of this hypothetical. See Elizabeth F. Judge, *Make It Pound: Translation, Professionalism, and the Right to Propertian Discourse in “Homage to Sextus Propertius,”* 33 PAIDEUMA 127 (2004).

<sup>164</sup> On the role of authorial intention, see David Nimmer, *The Fifth Annual Frankel Lecture: Address Copyright in the Dead Sea Scrolls: Authorship and Originality*, 38 HOUS. L. REV. 1 (2001).

translation, according to the objective *result* as a translation (or, conversely, as a poem), or considering only the category of the *work* (e.g., whether it is an original literary work)? Given that skill and judgment were defined in *CCH* with reference to knowledge, aptitude, ability, and discernment, inaccuracies would seem to obviate a finding of skill and judgment if the value of the work was primarily with respect to its accuracy but may not be fatal where the value of a work is aesthetic.

Works of “accidental authorship”—a myopic Mr. Magoo who inadvertently paints a masterpiece, for example—also could be anticipated to meet a colloquially defined creativity standard more readily than a skill and judgment standard.<sup>165</sup>

## V. CONCLUSION

*Feist* was certainly a major step forward in forging the normative foundations of the modern notion of originality in copyright law. It sent an unmistakable message that pure labor, or sweat of the brow, does not deserve protection. The social pact requires more, or something else. While the policy underpinnings of *Feist* seemed fairly clear, its definition of originality as being the result of a modicum of creativity posed two problems. One is quantitative in nature: what is a modicum? The other is qualitative: how does one decide what is “creative”? Courts around the world, many of which found the normative appeal of rejecting copyright protection of pure sweat of the brow productions compelling, have since tried to operationalize the notion of originality. In this Article, we suggested that the Canadian Supreme Court in *CCH* probably comes the closest to a truly workable standard, one that eschews the colloquial notion of creativity and focuses instead on choices made by the author in the process of creating a new work, and insists that those choices be neither trivial nor mechanical. Other courts could thus follow the example of the *CCH* standard, which prompts courts to look for evidence of a more than minimal number of such choices, to solve both the qualitative and quantitative conundrums posed by *Feist*.

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<sup>165</sup> See *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951). The court states:

There is evidence that [the mezzotints] were not intended to, and did not, imitate the paintings they reproduced. But even if their substantial departures from the paintings were inadvertent, the copyrights would be valid. A copyist's bad eyesight or defective musculature, or a shock caused by a clap of thunder, may yield sufficiently distinguishable variations. Having hit upon such a variation unintentionally, the “author” may adopt it as his and copyright it.

*Id.* at 104-05 (footnotes omitted).