

# *The Role of the CJEU's autonomous concepts as a harmonising element of copyright law in the United Kingdom*

## **I. Introduction**

It is fair to say that the Court of Justice of the European Union has in recent years issued a series of judgments that have affected copyright fundamentally. In this article I will try to look at the impact these judgments have had on UK copyright. The aim is not to look at each of the judgments separately. The article will instead focus on the concepts of (copyright) work and originality. The UK copyright system is rather averse to levies, so the judgments covering levies have affected it less. And a lot has already been said about the 'harmonisation' of the right of communication to the public and the concept of a new public. In any case, UK copyright is not very special in that respect, even it is affected in the same way as all other national copyright systems. The UK copyright system is however different because it operates a closed list of copyright works and because of its historical skill and labour approach to the originality requirement. Hence the decision to focus on the concepts of (copyright) works and originality. Both of these have been treated by the Court of Justice of the European Union as autonomous concepts of EU law and that did have and is continuing to have an impact on UK copyright law.

In the traditional copyright order of things there needs to be a work before there can be copyright and in addition that work needs to be original. The concept seems therefore to be the starting point and one then moves on to the originality requirement on the way to granting the work copyright protection. As it will turn out, matters are far less straightforward than this simple two step approach makes them appear at first, but, nevertheless, we first turn to the concept of a work and we approach it from a UK copyright perspective to start with.

## **II. The concept of a (copyright) work**

What is a work? Does a work attract copyright? This will depend upon the nature of the material involved, produced through intellectual or entrepreneurial activity, and upon the qualification issue. The latter element is more international in scope.

The copyright and related rights conventions<sup>1</sup> contain minimum provisions that are translated and implemented by the national copyright Acts. The provisions also require that authors and works linked in a certain way to one of the adherents to the conventions will be treated by national copyright legislation in the same way as will national authors and works. On the one hand, this link or qualification issue constitutes a separate hurdle and only those works that pass it will attract copyright protection; on the other, no formalities—such as registration—are required to secure copyright protection. But these are not the key issues. The concept of a work is in essence concerned with subject matter.

### ***II.1 Subject matter: from Berne to London***

In relation to the material involved, the Berne Convention defines this broadly as literary and artistic works. The UK legislature found this vague definition problematic. In the absence of a registration system in which the registrar can play a role in determining what is a copyright work and what is not and inform the applicant of the outcome when a registration is attempted, the users of the system and in particular the authors of the (alleged) copyright work and the users of such work need to be able to determine whether the work will attract copyright protection. A first essential step therefore consists of a clear definition of the concept of a work. The UK legislature has addressed this issue by establishing a closed list of copyright works, or rather of works that can attract copyright protection. Right from the start, one should emphasise that it is a closed list. There is no open-ended residual category of works at the end of the list. That means rather straightforwardly that the subject matter for which protection is sought needs to fall (at least) within one category in the list. Otherwise it will not be able to attract copyright protection and it will not be a work for the purposes of UK copyright. The list itself is contained in section one of the Copyright, Designs and Patents Act 1988 (CDPA, the UK copyright act):

‘1. Copyright and copyright works.

(1) Copyright is a property right which subsists in accordance with this Part in the following descriptions of work—

<sup>1</sup> Such as the Berne Convention for the Protection of Literary and Artistic Works 1886 and the Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations 1961.

(a) original literary, dramatic, musical or artistic works,

(b) sound recordings, films or broadcasts, and

(c) the typographical arrangement of published editions.

(2) In this Part “copyright work” means a work of any of those descriptions in which copyright subsists.

(3) Copyright does not subsist in a work unless the requirements of this Part with respect to qualification for copyright protection are met (see section 153 and the provisions referred to there).’

By defining various types of work<sup>2</sup> the Act is trying to cover the spectrum of literary and artistic works set out in the Berne Convention. This classification of works is an important aspect of the UK copyright system: not only does a work that does not come within the definition of any of the types of work will not be protected by copyright. It might also be argued that each work must be classified in one category: a work would not be able to get copyright protection under two different classifications at the same time. Indeed, slight differences may exist between the various regimes of copyright protection for each of the types of work and this could give rise to problems. A product may include more than one work for copyright purposes, but each of these works will be classified and protected as a single type of work. This point was summarized as follows by Laddie J:<sup>3</sup>

although different copyrights can protect simultaneously a particular product and an author can produce more than one copyright work during the course of a single episode of creative effort, for example a competent musician may write the words and the music for a song at the same time, it is quite another thing to say that a single piece of work by an author gives rise to two or more copyrights in respect of the same creative effort.<sup>4</sup>

This point has now been addressed further by the Court of Appeal, however, and it is submitted that the view of Laddie J now needs to be confined to those copyrights that are listed in s. 1(1)(a) of the 1988 Act. This seems to flow logically from the decision of the Court of Appeal in *Norowzian v. Arks*,<sup>5</sup> in which the court

<sup>2</sup> The concept of a work is as such, though, not defined and this results in a certain amount of uncertainty. See Ch. Handig, ‘The Copyright Term “Work”: European Harmonisation at an Unknown Level’ (2009) 40(6) IIC 665–85.

<sup>3</sup> *Electronic Techniques (Anglia) Ltd v. Critchley Components Ltd* [1997] FSR 401, per Laddie J; see also *Anacon Corp. Ltd v. Environmental Research Technology Ltd* [1994] FSR 659.

<sup>4</sup> *Electronic Techniques (Anglia) Ltd v. Critchley Components Ltd* [1997] FSR 401, per Laddie J at 412.

<sup>5</sup> *Norowzian v. Arks Ltd (No. 2)* [2000] FSR 363.

held that a film could also constitute a dramatic work, as long as the criteria for both categories were met. This means that a work can, at the same time, be protected as an original work in one of the categories listed in s. 1(1)(a) of the 1988 Act and as sound recording, film, or broadcast under s. 1(1)(b) of that Act.

A lot does of course depend on the exact definition of each of these categories. Let us by way of example look in a bit more detail at the definitions of literary, dramatic, musical and artistic works. In doing so we leave the originality requirement to one side, as that concept will be addressed later on in this article.

### *II.1.1 Literary works*

The Act characterizes literary works as ‘*any work, other than a dramatic or musical work, which is written, spoken or sung*’.<sup>6</sup> This category should not be restricted to works of literature. As Peterson J put it, this category contains every ‘*work which is expressed in print or writing, irrespective of the question whether the quality or style is high*’.<sup>7</sup>

The case law supplements high-quality works with all kinds of compilations<sup>8</sup> and tables.<sup>9</sup> Trade catalogues,<sup>10</sup> street directories,<sup>11</sup> timetable indexes,<sup>12</sup> examination papers,<sup>13</sup> football fixtures lists,<sup>14</sup> a listing of programmes to be broadcast,<sup>15</sup> a racing information service,<sup>16</sup> business letters,<sup>17</sup> and consignment notes<sup>18</sup> have all been held to be literary works protected by copyright. Lyrics for songs and computer programs are also protected.

Let us return briefly to the definition that the 1988 Act gives of a ‘literary work’.<sup>19</sup> A literary work is defined widely as any work that is written, spoken, or sung, and that is not a dramatic or musical work. The exclusion of any work that comes within the definition of a musical or a dramatic work from the category of literary works implements the basic principle that every original work can only fall within a single category of original

<sup>6</sup> CDPA 1988, s. 3(1).

<sup>7</sup> *University of London Press Ltd v. University Tutorial Press* [1916] 2 Ch 601, at 608.

<sup>8</sup> See also A. Monotti, ‘The Extent of Copyright Protection for Compilations of Artistic Works’ (1993) 5 EIPR 156.

<sup>9</sup> See also CDPA 1988, s. 3(1)(a).

<sup>10</sup> *Collis v. Cater* (1898) 78 LT 613; *Purefoy Engineering Co. Ltd v. Sykes Boxall* (1955) 72 RPC 89.

<sup>11</sup> *Kelly v. Morris* (1866) LR 1 Eq 697.

<sup>12</sup> *Blacklock (H) & Co. Ltd v. Pearson* [1915] 2 Ch 376.

<sup>13</sup> *University of London Press Ltd v. University Tutorial Press* [1916] 2 Ch 601.

<sup>14</sup> *Football League v. Littlewoods* [1959] Ch 637, [1959] 2 All ER 546.

<sup>15</sup> *Independent Television Publications v. Time Out Ltd* [1984] FSR 64; a subsequent competition law initiative made the copyright owners grant licences and made the listings available to other publishers.

<sup>16</sup> *Portway Press v. Hague* [1957] RPC 426.

<sup>17</sup> *British Oxygen Co. Ltd v. Liquid Air Ltd* [1925] Ch 383.

<sup>18</sup> *Van Oppen & Co. Ltd v. Van Oppen* (1903) 20 RPC 617.

<sup>19</sup> CDPA 1988, s. 3(1).

types of work. This exclusion slightly narrows the category of literary works, but it remains rather wide.

The last point is demonstrated by the fact that a literary work need not be expressed in words or any particular notation: any kind of notation can turn a work into a work that is written.<sup>20</sup> As a result of this, a software program that is written in any kind of computer programming language will fall within the category of literary works.

### *II.1.2 Dramatic works*

The category of ‘dramatic works’ shares the same set of general rules with the literary works category from which it is excluded by s. 3(1) of the Act. The obvious example is a synopsis or script for a play or for a film,<sup>21</sup> but dance and mime are also included in this category.<sup>22</sup> Another relevant rule is the recording requirement: no copyright can be granted if those lines are not recorded and this same conclusion was reached in a case that was concerned with an elaborated visual skit for a music hall sketch involving the use of fireworks.<sup>23</sup> On that basis the format for a game show could be another example of a dramatic work, if the various features are clearly identified and different from other formats and if there is a coherent framework connecting these features.<sup>24</sup>

Titles are excluded from protection on the basis of the originality requirement, which applies to this category as well and results in a *de minimis* rule. This rule also covers the names of characters and the typical way in which they behave,<sup>25</sup> unless the link and the characteristics are so strong that they become an independent and recognizable entity.<sup>26</sup> All this is of course subject to the exception that items for which the expression can be distinguished from the mere idea and where that expression passes the originality test and includes the author’s own intellectual creation, will attract copyright. But the protection granted to scripts for plays and movies does not extend to costumes and scenic effects, which will only attract copyright if they are artistic works. Characters and the merchandising rights involved can be protected under passing off, but only in the cases in which they benefit from an established trading reputation.<sup>27</sup>

What has become clear from the examples is that dramatic works involve action and movement. This is also

<sup>20</sup> See H. Laddie, P. Prescott, and M. Vitoria (2000) *The Modern Law of Copyright and Designs*, 3rd edn, London: Butterworths, p. 64.

<sup>21</sup> The film itself attracts a separate copyright.

<sup>22</sup> CDPA 1988, s. 3(1).

<sup>23</sup> *Tate v. Fullbrook* [1908] 1 KB 821.

<sup>24</sup> *Banner Universal Motion Pictures Ltd v. Endemol Shine Group Ltd* [2017] EWHC 2600 (Ch) (obiter).

<sup>25</sup> See *Kelly v. Cinema Houses Macg Cap Cas* (1932) 362, per Maugham J at 368.

<sup>26</sup> *Exxon Corp. v. Exxon Insurance Consultants International Ltd* [1982] Ch 119, [1981] 2 All ER 495, which refers to Lewis Carroll’s *Jabberwocky* as an example.

<sup>27</sup> See P. Torremans, (2019) *Holyoak and Torremans Intellectual Property Law*, Oxford: Oxford University Press, Ch. 31.

reflected in the comment by Lord Bridge that a dramatic work must be capable of performance.<sup>28</sup> It is submitted that a dramatic work can be best defined as ‘*a work created in order to be communicated in motion, that is, through a sequence of actions, movements, irrespective of the technique by which this movement is retrieved or expressed*’.<sup>29</sup>

### II.1.3 Musical works

Lyrics are protected as literary works, so what remains of a song is the music. Every overlap is excluded, because a musical work is defined as a work consisting of music, exclusive of any words or action intended to be sung, spoken, or performed with it.<sup>30</sup> For copyright purposes, music and lyrics are distinct works. They can be owned by different persons and can expire at different times, etc. A musical work is, then, ‘*intended to be performed by the production of a combination of sounds to be appreciated by the ear*’.<sup>31</sup>

The 1988 Act does not offer a definition of a musical work. In many cases, one recognizes a musical work if one sees (or hears) one, but, on the borderlines, problems were bound to arise, as happened in the *Hyperion* case,<sup>32</sup> which gave the Court of Appeal the opportunity to clarify the concept of a musical work. It will be recalled that Dr Lionel Sawkins had restored out-of-copyright musical works by Lalande, with the aim of recreating the works as Lalande would originally have created them. The question arose whether such a restoration effort that led to new performing editions of the works involved the creation of musical works. Hyperion did not want to pay royalties to Sawkins for the use of the performing editions when it recorded its CD and had argued that no new musical work had been created. In its view, the performing edition has no impact on the sound that is produced and perceived by the audience. That sound is essentially the result of Lalande’s musical work and has nothing to do with Sawkins’ work. The fact that Sawkins wanted to stay as close as possible to Lalande’s original work provides a further argument for denying the existence of a new copyright work.

The court summarized that argument as follows:<sup>33</sup>

The effect of the editorial interventions of Dr Sawkins was, as he asserted was his intention, only to

<sup>28</sup> *Green v. Broadcasting Corp. of New Zealand* [1989] 2 All ER 1056, [1989] RPC 700.

<sup>29</sup> P. Kamina, ‘Authorship of Films and Implementation of the Term Directive: The Dramatic Tale of Two Copyrights’ (1994) 8 EIPR 319, 320; cf. J. Phillips, R. Durie, and I. Karet (1993) *Whale on Copyright*, 4th edn, London: Sweet and Maxwell, p. 27.

<sup>30</sup> CDPA 1988, ss. 1(1)(a) and 3(1).

<sup>31</sup> H. Laddie, P. Prescott, and M. Vitoria (2000) *The Modern Law of Copyright and Designs*, 3rd edn, London: Butterworths, at 79.

<sup>32</sup> *Hyperion Records v. Lionel Sawkins* [2005] 3 All ER 636, [2005] 1 WLR 3281 (CA).

<sup>33</sup> *Hyperion Records v. Lionel Sawkins* [2005] 3 All ER 636, [2005] 1 WLR 3281 (CA), at para. 41 of the judgment.

produce more faithful and better copies of Lalande's original music and to make it playable, rather than to create new music of his own. The kind of effort and skill expended by Dr Sawkins was not appropriate or relevant to the creation of a fresh musical copyright, such as might be achieved by changes to the melody and harmony of the underlying work.

At first instance, Patten J had summarized Hyperion's position on subsistence as follows:<sup>34</sup>

[U]nless the edition includes the composition of new music in the form of the notes on the score (and not merely the correction of wrong or unsatisfactory notes in the scores used) then no copyright would exist in the edition as a musical work.

Both Patten J and the Court of Appeal refused to follow this unduly narrow approach. It seems, indeed, that there is more to music than notes on a score. Any plain language definition will, for example, also refer to sound and rhythm, and the impact on the ear in general. By focusing narrowly on notes only, Hyperion's argument is also inconsistent with the approach of assessing the work as a whole that the House of Lords laid down in *Ladbroke v. William Hill*.<sup>35</sup>

The Court of Appeal summarized these two points as follows, on the basis of which it rejected Hyperion's argument and held the performing editions to amount to a musical work:<sup>36</sup>

In my judgment, the fallacies in Hyperion's arguments are that (a) they only treat the actual notes in the score as music and (b) they approach the issue of subsistence from the wrong direction by dividing the whole of the performing edition into separate segments and by then discarding particular segments on the basis that they are not music and not therefore covered by copyright. That is contrary to the correct approach to subsistence of copyright laid down by the House of Lords in *Ladbroke (Football) Ltd v. William Hill (Football) Ltd*. The subsistence of copyright involves an assessment of the whole work in which copyright is claimed. It is wrong to make that assessment by dissecting the whole into separate parts and then submitting that there is no copyright in the parts. Hyperion's arguments ignore the fact that the totality of the sounds produced by the musicians are affected, or potentially affected, by the information inserted in the performing editions produced by Dr Sawkins. The sound on the CD is not just that of the musicians playing music composed by Lalande. In order to produce the sounds the musicians played from Dr Sawkins' scores of his edition. Without them Ex Cathedra would not have produced the combination of sounds of *Te Deum*, *La Grande Piece Royale* or *Venite Exultemus* for recording on the CD.

<sup>34</sup> At para. 50 of his judgment, which the Court of Appeal praised unanimously and which is reported at [2004] 4 All ER 418. See also V. Jones, 'Musical Works: Out with the Old and In with the New' (2005) 16 Ent LR 89; P. Groves, 'Better than it Sounds: Originality of Musical Works' (2005) 16 Ent LR 20; V. Jones, 'What Constitutes a Copyright Work: Does it really Matter?' (2005) 16 Ent LR 129.

<sup>35</sup> *Ladbroke (Football) Ltd v. William Hill (Football) Ltd* [1964] 1 All ER 465, [1964] 1 WLR 273, at 277-91 (HL).

<sup>36</sup> *Hyperion Records v. Lionel Sawkins* [2005] 3 All ER 636, [2005] 1 WLR 3281 (CA), at para. 49 of the judgment.

There is indeed no reason for restricting the coverage of musical copyright to the actual notes of the music only; after all, a dramatic work is not limited to the words that are to be spoken by the actors either. It is thus common sense that a recording of a person's spontaneous singing or any form of improvisation also amounts to music for copyright purposes.

Sawkins' work was required for the musician to play Lalande's work in the way that they did and, more importantly, it produced aural effects—that is, it changed what people heard. From a subsistence point of view, a separate musical work had therefore been created. Music is therefore more than notes on a score: what the audience hears also counts. The court did not arrive at a definition in statutory language, but the concept of a musical work has at least been clarified somewhat.

#### *II.1.4 Artistic works*

Graphic works, photographs, sculptures, or collages are protected as artistic works irrespective of their artistic quality.<sup>37</sup> 'Graphic works' include any painting, drawing, diagram, map, chart, plan, engraving, etching, lithograph, woodcut, or similar work.<sup>38</sup> This means that works ranging from a painting by Salvador Dali, to an engineer's plans and drawings for an electromagnetic train, are protected in the same way: no distinction is made between aesthetic, functional, and utilitarian works.

Casts, moulds, or models made for a sculpture are treated as a sculpture.<sup>39</sup> The word 'sculpture' should, however, be given its normal plain English meaning. In that sense, for a work to be a sculpture in the first place, it must be a three-dimensional work made by an artist's hand. It follows therefore that not every mould is an artistic work. A mould will not be an artistic work if nothing:

suggests that the manufacturers of [this] mould considered themselves, or were considered by anybody else, to be artists when they designed the [mould] or that they were concerned in any way with the shape or appearance of what they were making, save for the purpose of achieving a precise functional effect.<sup>40</sup>

An attempt was also made to keep pace with future technological developments: a photograph was defined as '*a recording of light or other radiation on any medium on which an image is produced or from which an image may by any means be produced, and which is not part of a film*'.<sup>41</sup> Any conflict with films, which may be seen as a succession of a huge number of photographs, is thus ruled out.

<sup>37</sup> CDPA 1988, s. 4(1)(a).

<sup>38</sup> CDPA 1988, s. 4(2).

<sup>39</sup> CDPA 1988, s. 4(2).

<sup>40</sup> *Metix (UK) Ltd v. GH Maughlan (Plastics) Ltd* [1997] FSR 718, per Laddie J.

<sup>41</sup> CDPA 1988, s. 4(2).



Technological developments are nonetheless bound to raise questions. Computer and video games involves a succession of frames, and the question of whether they are to be considered artistic works has arisen. The individual frames might be seen as graphic works—but the question was also asked whether the series of frames as an entity could also be considered to be a graphic work, as part of the wider category of artistic works. In *Nova Productions*,<sup>42</sup> the Court of Appeal held that an artistic work was defined in the Act as including the types of things listed in s. 4, all of which shared the characteristic of being static—that is, non-moving. A series of drawings or frames is therefore a series of graphic works and not a single graphic work or artistic work in itself. Individual frames are graphic works, however, and, as such, they come within the category of artistic works. Section 4 therefore also covers images that are generated on a screen and bitmap files.

The originality requirement for this first group of artistic works is the same as that for all previous types of work. The work should not be copied, should originate from the author, and its creation should involve the minimal amount of skill and labour.<sup>43</sup> That originality relates to artistic matters, rather than, for example, to technical matters in relation to the content of the drawing. The term ‘artistic’ should be defined here as anything that is visually significant.<sup>44</sup> That minimal amount of skill and labour is clearly present when a photographer makes a photograph from a picture<sup>45</sup> or any other single static object.<sup>46</sup> This is shown by the choice of the angle under which the picture is taken, the exposure time, the degree of focus, the positioning of the object, etc.<sup>47</sup> The decisive element in relation to whether the photograph is the author’s own intellectual creation are these arrangements selected by the photographer him- or herself.<sup>48</sup> Often the skill, and therefore the originality, of the photographer is found in reproducing faithfully what is in front of the lens. And the visually significant aspect of the work is found not in the scene or object before the lens, but in the image of it, which is produced on the photograph. The details of the arrangements made by the photographer are then particularly important.<sup>49</sup> Other good examples are a woodcut made from a drawing<sup>50</sup> and the label design for

<sup>42</sup> *Nova Productions Ltd v. Mazooma Games Ltd and ors; Nova Productions Ltd v. Bell Fruit Games Ltd* [2007] RPC 25 (CA).

<sup>43</sup> On that basis the work becomes the author’s own intellectual creation.

<sup>44</sup> *Interlego AG v. Tyco Industries Inc.* [1989] AC 217, per Lord Oliver at 266; *Ultra Marketing (UK) Ltd & Thomas Alexander Scott v. Universal Components Ltd*, judgment of 12 March 2004, Ch D, unreported.

<sup>45</sup> *Graves’ Case* (1869) LR 4 QB 715. For a detailed analysis of copyright in relation to photographs, see Y. Gendreau, A. Nordemann, and R. Oesch (1999) *Copyright and Photographs*, London: Kluwer Law International.

<sup>46</sup> *Antiquesportfolio.com plc v. Rodney Fitch & Co. Ltd* [2001] FSR 23. There may also be cases in which the person who arranges the scene that is to be photographed specifically for a picture to be taken is the joint author of the photograph. That will, however, not be the case of any later pictures taken of the same scene without authorization: see *Creation Records v. News Group* [1997] EMLR 444.

<sup>47</sup> *Antiquesportfolio.com plc v. Rodney Fitch & Co. Ltd v. Rodney Fitch & Co. Ltd* [2001] FSR 23; see K. Garnett, G. Davies, and G. Harbottle (2005) *Copinger and Skone James on Copyright*, 15th edn, London: Sweet and Maxwell, pp. 128–9; K. Garnett, ‘Copyright in Photographs’ (2000) 22 EIPR 229.

<sup>48</sup> E.g. placing a red London double-decker bus centrally in a grey background of famous London landmark buildings: *Temple Island Collections Ltd v. New English Teas Ltd and Nicholas John Houghton* [2012] EWPC 1.

<sup>49</sup> *Temple Island Collections Ltd v. New English Teas Ltd and Nicholas John Houghton* [2012] EWPC 1.

<sup>50</sup> Or a coin engraved in three dimensions from a drawing: *Martin v. Polyplax Manufacturers Ltd* [1969] NZLR 1046; see also *Wham-O Manufacturing Co. v. Lincoln Industries Ltd* [1985] RPC 127, the New Zealand frisbee case in which wooden models

a sweet tin.<sup>51</sup>

But the skill and labour does not necessarily need to be artistic: a plan for a technical device containing three concentric circles was protected, because technical judgement was involved in drawing them to precise measurements, which allowed the technical device to work.<sup>52</sup> Meanwhile, a plan containing a design for toy bricks that was only different from an earlier plan because minor variations were mentioned in words and figures, which are not themselves artistic works, fell foul of the originality requirement and was not awarded distinct copyright.<sup>53</sup>

### *II.1.5 Comprised in a category or no copyright*

All this shows the great lengths to which the UK copyright system goes to define the various categories of copyright works and how this idea of categories of works and the fact that there can only be a copyright work if the subject matter for which protection is sought comes within one of the categories is an essential element of the UK copyright system.

But can it be maintained? Can the idea of a closed list be reconciled with the way in which the Court of Justice of the European Union defined ‘a work’ as an autonomous concept of EU law?

## *II.2 The Court of Justice of the European Union’s autonomous concept comes along*

### *II.2.1 From BSA to Heksenkaas*

The autonomous concept of ‘a work’ sneaked in in a rather unexpected way in the *BSA* case.<sup>54</sup> One would have thought that in the absence of a definition of the concept of a (copyright) work in a Directive or Regulation the EU legislature had left it to the Member-States to set out their own approach to this concept, within the broad boundaries of the Berne Convention 1886 and the TRIPS Agreement 1994. But when dealing with a graphic user interface the Court argued that ‘the graphic user interface can, as a work, be protected by copyright if it is the author’s own intellectual creation’.<sup>55</sup> This set off the alarm-bells in the UK.

from which molds for the plastic frisbees were made were protected as sculptures, while the molds themselves were protected as engravings.

<sup>51</sup> *Tavener Rutledge v. Specters* [1959] RPC 355.

<sup>52</sup> *Solar Thomson Engineering Co. Ltd v. Barton* [1977] RPC 537 at 558.

<sup>53</sup> *Interlego AG v. Tyco Industries Inc.*[1989] AC 217.

<sup>54</sup> Case C-393/09 *Bezpečnostní softwarová asociace – Svaz softwarové ochrany v. Ministerstvo kultury* ECLI:EU:C:2010:816.

<sup>55</sup> *Ibid.* at para. 46.

Was the Court putting down the simple, but harsh, rule that anything that was original was to be considered a copyright work, i.e. originality as the author's own intellectual creation as the sole criterion to define the autonomous concept of 'a work'? That could mean that the UK's closed list of copyright works or categories of works was in breach of EU law.

The question remained open at that stage, as the court did not really elaborate on the point. One could therefore argue that the words 'as a work', placed between commas hinted at a precondition, i.e. one first needs to meet the requirement that there is a work and only then does the requirement of the author's own intellectual creation come in. The graphic user interface does than first of all need to meet the requirements of a work, whatever these may be under the national copyright law of the member state concerned and only in a second phase does it need to meet the requirement that it is the author's own intellectual creation if it is to attract copyright protection. Or one could argue that the court merely stated that in a non-exhaustive way one of the criteria to be satisfied by a protected work.<sup>56</sup> Be that as it may, one should not underestimate the potential impact on UK copyright. As my colleague Prof Lionel Bentley stated on the IPKat blog, in the court's statement there seems to be no place either for the requirement that works be recorded or fixated as it currently the case under UK copyright law. Nor is it obvious that one can still refuse to treat a title as a copyright work in its own right.

The Court of Justice returned to the autonomous concept of 'a work' in a much more explicit way in the *Heksenkaas* case<sup>57</sup>, where the question arose whether a taste (here of a cheese spread) could be a copyright work and as such attract copyright protection. The CJEU, sitting as Grand Chamber, argued that there are two cumulative conditions that must be satisfied for there to be a work and that this is an autonomous and uniform interpretation. First, the subject matter concerned must be the author's own intellectual creation, i.e. it must be original. Secondly, there must be an expression of the author's own intellectual creation. It is regrettable that this definition contains elements of a circular argument. Copyright starts with a work and then requires that work to meet the originality criterion. It is therefore not straightforward to include originality already in the test when one is merely defining the concept of a work. But one sees here another application of the almost obvious finding that the concepts of originality and of a work conflate in the CJEU's caselaw.<sup>58</sup>

<sup>56</sup> See J. Griffiths, 'ECJ decision in Czech GUI case could pose questions for UK copyright law', [https://uk.practicallaw.thomsonreuters.com/6-504-8145?transitionType=Default&contextData=\(sc.Default\)&firstPage=true&comp=pluk&bhcp=1](https://uk.practicallaw.thomsonreuters.com/6-504-8145?transitionType=Default&contextData=(sc.Default)&firstPage=true&comp=pluk&bhcp=1).

<sup>57</sup> Case C-310/17 *Levola Hengelo BV v. Smilde Foods BV* ECLI:EU:C:2018:899.

<sup>58</sup> See E. Rosati, *Originality in EU Copyright: Full Harmonization through Case Law*, (2013), Edward Elgar Publishing.

But let us leave that initial disappointment behind and look in a bit more detail at the court's reasoning. The court puts it as follows:

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

36 First, the subject matter concerned must be original in the sense that it is the author's own intellectual creation [...].

37 Secondly, only something which is the expression of the author's own intellectual creation may be classified as a ‘work’ within the meaning of Directive 2001/29’.<sup>59</sup>

### *II.2.2 The Court of Justice of the European Union's two requirements*

The first requirement is straightforward from a technical point of view. There needs to be originality in the sense that the subject matter concerned is the author's own intellectual creation, as set out in the *Infopaq* case.<sup>60</sup> That originality requirement will be examined later on in this article.

The second of the cumulative requirements for there to be a work in the sense of the autonomous concept defined by the court, is that the subject matter needs to be ‘the expression’ of the author's own intellectual creation. One could argue that the court therefore still operates the requirement that there needs to be a (literary and artistic) work and that the originality requirement is a separate requirement and that in a sense the court merely takes the requirements in the ‘wrong’ order from a traditional copyright perspective.<sup>61</sup> But what exactly does the court have in mind when the judgment talks about ‘expression’? The court refers to article 2(1) of the Berne Convention. That article states that we are dealing in copyright with productions in the literary, scientific and artistic domain, irrespective of the mode or form of its expression. The production must therefore be expressed in a mode or form. The combination of a production and a form of expression also suggests that the subject matter is identifiable. An expression is maybe not necessarily directed at third persons, but it is at least available and perceivable by third persons, so a certain level of precision is required. The Court then moves on to the TRIPS Agreement and its confirmation of the fact that copyright protects expressions, but not ideas.<sup>62</sup> That is, only the particular expression of an idea is protected. The dichotomy between ‘idea’ and ‘expression’ is a key element in copyright law, but its real meaning, as well as its application in practice, raises difficult issues.

<sup>59</sup> Case C-310/17 *Levola Hengelo BV v. Smilde Foods BV* ECLI:EU:C:2018:899, paras. 35-37.

<sup>60</sup> Case C-5/08, *Infopaq International A/S v. Danske Dagblades Forening* ECLI:EU:C:2009:465, [2009] ECDR 16.

<sup>61</sup> M. Vercelletto, ‘La saveur d’un produit alimentaire n’est pas une œuvre’, [2018] *Les MAJ de L’IRPI*, issue 3, page 1.

<sup>62</sup> Case C-310/17 *Levola Hengelo BV v. Smilde Foods BV* ECLI:EU:C:2018:899, para. 39.

### II.2.3 The Idea-Expression dichotomy in UK copyright

Traditionally, the idea-expression dichotomy did not play a prominent role in UK copyright, but Lord Hoffmann offered the following explanation in *Designers Guild v. Russell Williams Textiles Ltd*:

‘My Lords, if one examines the cases in which the distinction between ideas and the expression of ideas has been given effect, I think it will be found that they support two quite distinct propositions. The first is that a copyright work may express certain ideas which are not protected because they have no connection with the literary, dramatic, musical or artistic nature of the work. It is on this ground that, for example, a literary work which describes a system or invention does not entitle the author to claim protection for his or her system or invention as such. The same is true of an inventive concept expressed in an artistic work. However striking or original it may be, others are (in the absence of patent protection) free to express it in works of their own: see *Kleeneze Ltd v. DRG (UK) Ltd* [1984] FSR 399. The other proposition is that certain ideas expressed by a copyright work may not be protected because, although they are ideas of a literary, dramatic or artistic nature, they are not original, or so commonplace as not to form a substantial part of the work. *Kenrick & Co. v. Lawrence & Co.* (1890) 25 QBD 99 is a well-known example. It is on this ground that the mere notion of combining stripes and flowers would not have amounted to a substantial part of the plaintiff’s work. At that level of abstraction, the idea, though expressed in the design, would not have represented sufficient of the author’s skill and labour as to attract copyright protection.’<sup>63</sup>

As is clear from this quote, the author needs to invest a minimum amount of skill and labour in his or her work. That makes it an expression of an idea and it can therefore be protected by copyright. Copyright therefore protects works that are the author’s own expression of the underlying idea. These works are then the author’s own intellectual creation. Limiting the protection offered by copyright to the author’s own expression of the idea leaves the idea unprotected and part of the common heritage of mankind. It is free to be used by others to create their own expressions when they exercise their freedom of expression, with which copyright is carefully balanced.

In those cases, the expression will be original. Originality is therefore linked to the idea–expression dichotomy. Copyright uses the concepts of idea–expression and originality to determine what can be appropriated through the grant of copyright; anything else will be in the public domain and will not be

<sup>63</sup> [2000] 1 WLR 2416, at 2423.

subject to an exclusive right. Through these concepts, copyright really regulates the balance and tension between the exclusive right and the public domain. Striking a correct balance is essential to justify copyright as an exclusive right. There remains a level of discretion on this point for national legislators, as the Berne Convention does not define originality.

#### *II.2.4 No definition of a literary, scientific and artistic work*

The Court of Justice of the European Union avoids attempting to define the literary, scientific and artistic domain, whereas UK copyright on the contrary tries to capture the entire literary, scientific and artistic domain by setting out a closed list of categories of works that between them cover the lot. The Court of Justice of the European Union sidesteps that difficult definitional issue and focuses instead on the word ‘production’ in article 2(1) Berne Convention.<sup>64</sup> The way the idea-expression dichotomy is read in there through the words ‘whatever the mode or form of its expression’ on the one hand and the concept of originality is read in there through the definition of that idea-expression dichotomy itself on the other hand leads to the conclusion that a production is the author’s individual way of expressing a certain idea.

Techniques, scientific principles, etc. are therefore not covered on their own, as such. Ideas and the overall level of abstraction that goes with them are left to one side by copyright and by covering every mode or form of expression one arrives at such a broad spectrum of (author’s individual) expressions that it inevitably covers anything that may be considered to be within the literary, scientific or artistic domain.<sup>65</sup>

The Court of Justice of the European Union’s approach may not be the most elegant one and the double reliance on elements of originality leaves on with the impression that the argument is a bit of a circular one, but the result is not that far removed from the traditional copyright logic after all.

#### *II.2.5 Can UK copyright cope with this evolution?*

It is vital though for our current purposes to examine whether this way of approaching the autonomous concept of ‘a work’ can be reconciled with UK copyright law. The main question that arises is whether UK copyright law can retain its closed list of categories of works. One may be tempted to say that that is not the case, as there is bound to be an original expression that meets the requirements of the autonomous concept and is therefore a work, whilst it does not find a place within one of the categories of work set out in the CDPA 1988. But that may in practice represent less of a problem than it seems. The caselaw does after all

<sup>64</sup> Case C-310/17 *Levola Hengelo BV v. Smilde Foods BV* ECLI:EU:C:2018:899, para. 39.

<sup>65</sup> *Ibidem*.

show a rather flexible approach to the closed list. Subject matter is squeezed into one category or another if the courts feel there is a need to do so. A good example is found in *Banner v. Endemol*.<sup>66</sup> This case was concerned with a format for a TV gameshow and rather readily accepts that such a format could come under the category of dramatic works and could therefore attract copyright protection, even if that was not so on the facts of this case. Even more importantly is the statement from the court:

‘What I think is apparent from the authorities, however, is that copyright protection will not subsist unless, as a minimum, (i) there are a number of clearly identified features which, taken together, distinguish the show in question from others of a similar type; and (ii) that those distinguishing features are connected with each other in a coherent framework which can be repeatedly applied so as to enable the show to be reproduced in recognisable form.’<sup>67</sup>

It may be a touch provocative, but are these features not a form of expression and does their distinguishable feature not point towards their originality? In any case, the emphasis is laid here and not on the characteristics of the category of dramatic works. Another example of the flexible approach to the closed list in UK copyright is found in *SAS Institute v. World Programming*.<sup>68</sup> That case covered computer languages, data file formats and interfaces.

Another aspect of the idea-expression dichotomy, and one whose implications are often forgotten in the UK, is the fact that one must be able to distinguish between the unprotected idea on the one hand and its expression on the other hand. Since that expression must be the author’s own, there must at least be two expressions that are possible and neither of these can be (merely) identical to the idea. One cannot call an expression one’s own if an alternative expression (of the same idea and by another person) is not possible. That covers what in the US is covered by the functionality doctrine. A form of expression that is merely functional and where for technical and functional reasons only one expression is possible (e.g. for reasons of interactivity between computer programs) will not give rise to copyright protection.<sup>69</sup> On that basis it is not possible to identify the author’s own intellectual creation and the idea dictates the expression rather than the author’s originality. That undercuts the critique that the Court of Justice’s approach would stop the UK from applying the rule that de minimis works, such as titles and single words (e.g. used as trade marks) cannot

<sup>66</sup> *Banner Universal Motion Pictures Ltd v. Endemol Shine Group Ltd, Friday TV AB and NBC Universal Global Networks UK Ltd* [2017] EWHC 2600 (Ch).

<sup>67</sup> *Ibid.*, at para. 44.

<sup>68</sup> [2013] EWHC 69 (Ch), at para. 27.

<sup>69</sup> Case C-393/09 *Bezpečnostní softwarová asociace – Svaz softwarové ochrany v. Ministerstvo kultury* ECLI:EU:C:2010:816 (graphic user interfaces dictated by their technical function are not protected by copyright).

attract copyright protection. That rule can stay, as in those cases one will not be able to distinguish between the unprotected idea and the expression in the form of the author's own intellectual creation.

Interestingly though, having set out the idea-expression dichotomy, the CJEU then went on to argue that both the authorities, individuals and other economic operators must be able to ascertain in an objective way what the protected subject matter, i.e. the work, is. The protected subject matter needs to be identifiable with sufficient precision and objectivity and one therefore needs to be able to identify it clearly and precisely. That is maybe a more interesting starting point, despite the fact that it bears great similarity with the court's approach to trade marks.<sup>70</sup> Be that as it may, in the cheese spread case the taste of the food product failed the test on the points of precision and objectivity and can therefore not be a work for the purposes of copyright. More importantly, one should not be misled by the idea of subjectivity in the expression of the author. That is only one side of the story. As many expressions of the same idea are possible (and encouraged by the logic of copyright) third parties need to know what an author's expression is in order to be able to make their own distinctive expression of the same underlying idea (in the sense of avoiding copying). That covers the authorities, individuals and other economic operators to which the Court of Justice of the European Union refers and for them a requirement that the expression is identifiable with sufficient precision and objectivity is then entirely logical. One should not be misled in this respect by the fact that it intuitively generates links to the area of trade marks. And the matter is unlikely to complicate things for UK copyright. Suffice it to refer back to the decision in *Banner v. Endemol*. And to quote paragraph 44 of the judgment again:

‘What I think is apparent from the authorities, however, is that copyright protection will not subsist unless, as a minimum, (i) there are a number of clearly identified features which, taken together, distinguish the show in question from others of a similar type; and (ii) that those distinguishing features are connected with each other in a coherent framework which can be repeatedly applied so as to enable the show to be reproduced in recognisable form.’<sup>71</sup>

Clearly identified features by way of expression and a recognisable format arguably refer to the same underlying idea that the expression is identifiable with sufficient precision and objectivity. The UK's fixation requirement<sup>72</sup> may also be seen as fitting in here. If the work has been fixated the subject matter covered and its expression are more easily identifiable with sufficient precision and objectivity.

<sup>70</sup> See Case C-273/00 *Ralf Sieckmann v. Deutsches Patent- und Markenamt* ECLI:EU:C:2002:748.

<sup>71</sup> *Banner Universal Motion Pictures Ltd v. Endemol Shine Group Ltd, Friday TV AB and NBC Universal Global Networks UK Ltd* [2017] EWHC 2600 (Ch), at para. 44.

<sup>72</sup> For borderline cases see *Merchandising Corp. of America Inc. v. Harpbond Inc.* [1983] FSR 32 (the *Adam Ant* case) and *Komesaroff v. Mickle* [1988] RPC 204.



Having looked at the autonomous concept of ‘a work’ in detail and having identified the links with the concept of originality, we now turn to the autonomous concept of originality.

### **III. The autonomous concept of originality**

#### ***III.1 The historical perspective of UK Copyright Law***

Let us first of all look at the concept of originality from the historical perspective in UK copyright law. Originality should not, first of all, be taken in the normal sense: neither novelty nor innovation is required; the starting point is that the work is not copied and originates from the author.<sup>73</sup> The author must produce his or her own expression of the idea, but the test to establish whether the work originates from the author is in origin only a minimum-effort standard. It is not required that the idea is new, because the *idea* is not covered by copyright at all. A radically new and different expression of the idea of the passionate love story between two people with irreconcilable cultural backgrounds set in outer space is equally not required; the author’s own expression of the classic *Romeo and Juliet* tale will suffice. The author must only have expended ‘skill, judgement and labour’, or ‘selection, judgment and experience’, or ‘labour, skill and capital’ in creating the work.<sup>74</sup>

In reality, two cumulative requirements are involved: first, the work must originate from the author; secondly, there must have been a minimum investment by the author of skill, judgement, and labour. Both requirements have to be met. The investment of skill, judgement, and labour merely in the process of copying someone else’s work cannot confer originality.<sup>75</sup> But even if that threshold is low, works that do not meet this minimum standard will not attract copyright protection: a copy that incorporates some minor alterations of a work which is no longer protected under copyright, for example, will not attract copyright.<sup>76</sup> Even if the content of a work may be nothing more than a compilation of existing elements, some skill and labour must have been invested in the way in which those elements are organized and expressed.<sup>77</sup> On the one hand, that skill and labour must not be so trivial that it could be characterized as

<sup>73</sup> *Ladbroke (Football) Ltd v. William Hill (Football) Ltd* [1964] 1 All ER 465, [1964] 1 WLR 273, per Lord Pearce at 479 and 291; *University of London Press Ltd v. University Tutorial Press Ltd* [1916] 2 Ch 601, per Peterson J at 609.

<sup>74</sup> *Ladbroke (Football) Ltd v. William Hill (Football) Ltd* [1964] 1 All ER 465, [1964] 1 WLR 273, per Lord Pearce at 479 and 291; and *University of London Press Ltd v. University Tutorial Press Ltd* [1916] 2 Ch 601, per Peterson J at 609.

<sup>75</sup> This was reconfirmed by the Court of Appeal in *Biotrading & Financing OY v. Biohit Ltd* [1998] FSR 109 at 116; see also Lord Oliver’s opinion in *Interlego AG v. Tyco Industries Inc.* [1989] AC 217 at 258.

<sup>76</sup> See *Interlego AG v. Tyco Industries Inc.* [1989] AC 217.

<sup>77</sup> See *Cramp (GA) & Sons Ltd v. Smythson* [1944] AC 329, [1944] 2 All ER 92.

a purely mechanical exercise; on the other, creativity, as such, is not required either.<sup>78</sup> Football pool coupon lists, for example, can be protected, but only if it can be shown that the presentation of the material is special: it must be shown that the author has invested skill and labour in the way in which the table is organized. There must be ‘*a relation of creation between the work and the author whatever this act of creation (sometimes only presentation) means*’.<sup>79</sup> But what amounts to a sufficient amount of independent skill, labour, and judgement is not capable of definition in advance; it has to be determined on the facts of each case.<sup>80</sup>

### ***III.2 The recent shift in UK Copyright Law***

Most other European countries have in origin a slightly higher originality threshold. They define an original work as a work that constitutes the expression of the personality of its author and a work should be the author’s own intellectual creation.<sup>81</sup> It is interesting to note though that recent House of Lords decisions seem to depart from a strict interpretation of the ‘mere skill and labour’ test. Harmonization may therefore be further advanced than one would have thought, which is possible in the absence of a statutory definition of ‘originality’. One can indeed see a tendency for English courts to use the concept of the author’s own intellectual creation as the standard for originality.<sup>82</sup> Let us now move away from the historical cases and look in more detail at the recent evolution.

#### ***III.2.1 An attempt at clarification in Hyperion***

The exact meaning of the concept of originality in English law has never been absolutely clear, but a recent case allowed the Court of Appeal to shed some more light on it. In *Hyperion Records v. Lionel Sawkins*,<sup>83</sup> the question arose of whether originality could be found in a restored musical work. The original musical work by Lalande was out of copyright, but Dr Lionel Sawkins had restored the work by making performing editions that allowed the work to be played again. In doing so, Sawkins had made additions and corrections, but he had done so with the aim of restoring the work in its original format—that is, as Lalande would have composed it.

<sup>78</sup> See the decision of the Supreme Court of Canada in *The Law Society of Upper Canada v. CCH Canadian Ltd, Thomson Canada Ltd & Canada Law Book Inc.* [2004] SCC 13.

<sup>79</sup> A. Dietz, ‘The Artist’s Right of Integrity under Copyright Law: A Comparative Approach’ (1994) 25 IIC 177, at 182.

<sup>80</sup> *Biotrading & Financing OY v. Biohit Ltd* [1998] FSR 109, at 116.

<sup>81</sup> For a recent example, see *Bettina Rheims v. M. Jakob Gautel and others*, decision of the 1st Civil Division of the French Cour de Cassation (Supreme Court) of 13 November 2008, 40 (2009) 4 IIC 485.

<sup>82</sup> See e.g. *SAS Institute Inc v. World Programming Ltd* [2013] EWCA Civ 1482.

<sup>83</sup> [2005] 3 All ER 636, [2005] 1 WLR 3281 (CA).

A lot has been made in relation to this case of the public policy issue that granting copyright in a restored, out-of-copyright work would hinder access to the work itself. The underlying argument seems to be that the real originality and the real work is that which is out of copyright, and, in that line of thought, granting a new copyright would clash with public policy. The *Hyperion* case offered a unique opportunity to dispel that myth. Copyright only protects a particular expression of a certain idea and not the idea itself. Copyright in a restored or reconstituted version of an out-of-copyright work will protect only the expression of the restored or reconstituted version; everyone remains free to use the out-of-copyright material itself. To use the specific facts of *Hyperion*: granting Lionel Sawkins copyright in his performing editions will not protect anyone from copying Lalande's music or from making their own performing editions. All they cannot do is use the shortcut offered by the existence of Sawkins' performing editions by copying these without his consent.

This last point is the most basic expression of the public policy of copyright—namely, to prevent the unauthorized copying of certain material forms of expression. One should therefore be very careful in using the public policy argument in this type of case.

### *III.2.2 The broad perspective restated*

The key point is, however, found in the fact that only certain material forms of expression are, from a public policy point of view, worth protecting by copyright. Only original forms of expression are to be protected.

Let us look at this from a broad perspective. Remember that originality should not be taken in the normal (dictionary) sense here: neither novelty nor innovation is required; the starting point is that the work is not copied and originates from the author, as the House of Lords made clear in *Ladbroke v. William Hill*.<sup>84</sup> The author must produce his or her own expression of the idea, but the test to establish whether the work indeed originates from the author is only a minimum-effort standard. It is not required that the idea is new, because the idea is not covered by copyright at all. The author must only have expended 'skill, judgement and labour', or 'selection, judgement and experience', or 'labour, skill and capital' in creating the work, in relation to which two cumulative requirements are involved: that the work must originate from the author and that there must have been a minimum investment by the author of skill, judgement, and labour. The investment of skill, judgement and labour merely in the process of copying someone else's work cannot confer originality, as was

<sup>84</sup> *Ladbroke (Football) Ltd v. William Hill (Football) Ltd* [1964] 1 All ER 465, [1964] 1 WLR 273, per Lord Pearce at 479 and 291; *University of London Press Ltd v. University Tutorial Press Ltd* [1916] 2 Ch 601, per Peterson J at 609.

confirmed by the Court of Appeal in *Biotrading v. Biohit*,<sup>85</sup> with reference to Lord Oliver's famous dictum in *Interlego v. Tyco*.<sup>86</sup>

But even if the threshold is low, works that do not meet this minimum standard will not attract copyright protection. The question of whether an item that is similar to a copyright work is, in its own right, an original copyright work is a difficult question, in relation to which the Court of Appeal provided some guidance in *Guild v. Eskander Ltd*.<sup>87</sup> A piecemeal approach should be guarded against; the question was, instead, whether all—and not just any one or more—of the additional features gave rise to the requisite quality of originality. The need to look at the work as a whole is crucial and the Court of Appeal also emphasizes this in *Hyperion*. Despite that, some consideration of individual features would be unavoidable in answering that question.

A copy that incorporates some minor alterations of a work that is no longer protected under copyright will not attract copyright.<sup>88</sup> The principle is clearly stated in the *Interlego* case and is widely accepted. Its exact coverage, however, and the answer to the question of whether it can be reconciled with the judgment of the House of Lords in *Walter v. Lane*,<sup>89</sup> is less clear. The *Hyperion* case obliged the Court of Appeal to rule on these points and we will return to that ruling shortly, but here we will mention only that copyright infringement in a performing edition of a fourth work was ruled out, because there had been only a very limited editorial input by Dr Sawkins.

Even if the content of a work may be nothing other than a compilation of existing elements, some skill and labour must have been invested in the way in which they are organized and expressed.<sup>90</sup> That skill and labour must not be so trivial that it could be characterized as a purely mechanical exercise, but creativity as such is not required either, as can be seen from the decision of the Supreme Court of Canada in *The Law Society of Upper Canada v. CCH Canadian Ltd, Thomson Canada Ltd & Canada Law Book Inc*.<sup>91</sup>

There is no better way to conclude this overview of the general approach to originality in English law than to quote Dr Dietz, who wrote that there must be '*a relation of creation between the work and the author whatever this act of creation (sometimes only presentation) means*'.<sup>92</sup> With hindsight, these wise words almost sound prophetic in a *Hyperion* context. What amounts to a sufficient amount of independent 'skill, labour and

<sup>85</sup> *Biotrading & Financing OY v. Biohit Ltd* [1998] FSR 109, at 116.

<sup>86</sup> *Interlego AG v. Tyco Industries Inc.* [1989] AC 217, at 258.

<sup>87</sup> *Guild v. Eskander Ltd* [2003] FSR 23.

<sup>88</sup> See *Interlego AG v. Tyco Industries Inc.* [1989] AC 217.

<sup>89</sup> *Walter v. Lane* [1900] AC 539 (HL).

<sup>90</sup> See *Cramp (GA) & Sons Ltd v. Smythson* [1944] AC 329, [1944] 2 All ER 92.

<sup>91</sup> *The Law Society of Upper Canada v. CCH Canadian Ltd, Thomson Canada Ltd & Canada Law Book Inc.* [2004] SCC 13.

<sup>92</sup> A. Dietz, 'The Artist's Right of Integrity under Copyright Law: A Comparative Approach' (1994) 25 IIC 177, at 182.

judgement' is not capable of definition in advance; it has to be determined on the facts of each case.<sup>93</sup>

### III.2.3 How does *Hyperion* apply in practice?

It is now time to return to the somewhat narrower perspective of the *Hyperion* case and to apply these principles in detail. Mummery LJ looks at this from the following angle:

The first question is whether the performing editions are incapable of being regarded as 'original' works because Lalande composed the music and Dr Sawkins made his editions of that music with the intention that they should be as close as possible to the Lalande originals.<sup>94</sup>

The Court of Appeal answers that question by relying very strongly on the dictum of the House of Lords of over a century ago in *Walter v. Lane*.<sup>95</sup> The Court of Appeal suggests that that decision is still good law as a result of the confirmation it received in *Express Newspapers plc v. News (UK) Ltd*.<sup>96</sup>

In *Walter v. Lane*, the House of Lords held that copyright subsisted in shorthand writers' reports of public speeches as 'original literary' works. The Earl of Rosebery had made the speeches in public, with the reporters present. The reporters had made notes in shorthand; they had later transcribed them, corrected, revised, and punctuated them, and they had published them in newspapers as verbatim reports of the speeches. From the copyright point of view adopted by the House of Lords, a speech and a *report* of a speech are two different things. Lord Rosebery was the author of his speeches; the shorthand writers were the authors of their reports of his speeches. They spent effort, skill, and time in writing up their reports of speeches that they themselves had not written. For our current purposes, it is very important to note that the reports were held to be 'original' literary works, even though the intention of the reporters was to produce as accurate a report as possible of a work of which they were not the authors.

This analysis led Mummery LJ to the following conclusion in the *Hyperion* case:<sup>97</sup>

In my judgment, on the application of *Walter v. Lane* to this case, the effort, skill and time which the judge found Dr Sawkins spent in making the 3 performing editions were sufficient to satisfy the requirement that they should be 'original' works in the copyright sense. This is so even though (a) Dr Sawkins worked on the scores of existing musical works composed by another person (Lalande); (b) Lalalande's works are

<sup>93</sup> *Biotrading & Financing OY v. Biohit Ltd* [1998] FSR 109, at 116.

<sup>94</sup> *Hyperion Records v. Lionel Sawkins* [2005] 3 All ER 636, [2005] 1 WLR 3281 (CA) at para. 32 of the judgment.

<sup>95</sup> *Walter v. Lane* [1900] AC 539 (HL), a decision on the Copyright Act 1842 that used a different kind of wording when compared to the CDPA 1988.

<sup>96</sup> *Express Newspapers plc v. News (UK) Ltd* [1990] FSR 359 at 365–6.

<sup>97</sup> *Hyperion Records v. Lionel Sawkins* [2005] 3 All ER 636, [2005] 1 WLR 3281 (CA), at para. 36 of the judgment.

out of copyright; and (c) Dr Sawkins had no intention of adding any new notes of music of his own.

This reliance on *Walter v. Lane* cannot be accepted, however, without considering the dictum in the *Interlego* case with which it seems at odds. One has, indeed, in the past derived a *de minimis* rule from the words of Lord Oliver in that case—that is, that a copy incorporating some minor alterations of a work that is no longer protected under copyright will not attract copyright. But the question must be asked whether the impact of the following words does not go further:

Take the simplest case of artistic copyright, a painting or photograph. It takes great skill, judgment and labour to produce a good copy by painting or to produce an enlarged photograph from a positive print, but no one would reasonably contend that the copy painting or enlargement was an ‘original’ artistic work in which the copier is entitled to claim copyright. Skill, labour or judgment merely in the process of copying cannot confer originality.<sup>98</sup>

In other words, does this dictum in any way reverse what was said in *Walter v. Lane* in the context of a somewhat differently worded statutory provision?

It is submitted that the two provisions are not incompatible and that the dictum in *Interlego* needs to be interpreted restrictively. The court was, after all, dealing with drawings for plastic toy blocks that had barely been touched and the attempt of the producer of the blocks effectively to prolong the term of their protection was all too obvious. Jacob LJ makes this point very clearly in the second (concurring) judgment in *Hyperion*.<sup>99</sup> Like him, I would like to refer to the authors of the *Modern Law of Copyright*,<sup>100</sup> who interpret the dictum in *Interlego* as follows:

However, whilst the remarks made in *Interlego* may be valid if confined to the subject matter then before the Privy Council, they are stated too widely. The Privy Council was there considering fairly simple technical drawings. This is a rather special subject-matter. While the drawing of such a work is more laborious than it looks, it is a fact that any competent draftsman (perhaps, any conscientious amateur) who sets out to reproduce it exactly will almost certainly succeed in the end, because of the mathematical precision of the lines and measurements. This should be contrasted with, e.g. a painting by Vermeer, where it will be obvious that very few persons, if any, are capable of making an exact replica. Now, assume a number of persons do set out to copy such a painting, each according to his own personal skill. Most will only succeed in making something which all too obviously differs from the original—some of them embarrassingly so. They will get a copyright seeing that in each instance the end result does not differ from the original yet it took a measure of skill and labour to produce. If,

<sup>98</sup> *Interlego AG v. Tyco Industries Inc.* [1989] AC 217, per Lord Oliver at 371.

<sup>99</sup> *Ibid.*, at paras. 79–82 of the judgment.

<sup>100</sup> H. Laddie, P. Prescott, and M. Vitoria (1995) *The Modern Law of Copyright and Designs* 2nd edn, London: Butterworths.

however, one of these renders the original with all the skill and precision of a Salvador Dali, is he to be denied a copyright where a mere dauber is not? The difference between the two cases (technical drawing and old master painting) is that in the latter there is room for individual interpretation even where faithful replication is sought to be attempted while in the former there is not. Further, a photographer who carefully took a photograph of an original painting might get a copyright and, if this is so, it is rather hard to see why a copy of the same degree of fidelity, if rendered by an artist of the calibre aforementioned, would not be copyright. These considerations suggest that the proposition under discussion is suspect. It is therefore submitted that, for example, a picture restorer may get a copyright for the result of his efforts. Be that as it may, it is submitted that the *Interlego* proposition is anyway distinguishable where the replicator succeeds in preserving for posterity an original to which access is difficult.<sup>101</sup>

To quote Jane Ginsburg:<sup>102</sup>

Reproductions requiring great talent and technical skill may qualify as protectable works of authorship, even if they are *copies* of pre-existing works. This would be the case for photographic and other high quality replicas of works of art.

In conclusion, the two dicta are not incompatible: *Walter v. Lane* sets out the rule, but presupposes some creative input; *Interlego* deals with the other end of the spectrum, at which there is only mere copying.

In the words of Jacob LJ:<sup>103</sup>

I think the true position is that one has to consider the extent to which the ‘copyist’ is a mere copyist—merely performing an easy mechanical function. The more that is so the less is his article likely to be taken as ‘original’.

One should not underestimate the importance for English copyright law of the fact that the Court of Appeal has now, in *Hyperion*, clarified the approach that is to be taken to originality by reconfirming the dictum in *Walter v. Lane* and by ruling out any conflict with *Interlego*, which is confined to its particular mere copying scenario.

### ***III.3 Infopaq in the Court of Justice of the European Union***

The Court of Justice dealt with the originality issue in the *Infopaq* case<sup>104</sup> and this is where the autonomous concept of originality emerges. The Court was asked essentially to look at copyright infringement and

<sup>101</sup> *Ibid.*, at para. 4.39.

<sup>102</sup> J. Ginsburg, ‘The Concept of Authorship in Comparative Copyright Law’ (2003) 52 DePaul L Rev 1063.

<sup>103</sup> *Hyperion Records v. Lionel Sawkins* [2005] 3 All ER 636, [2005] 1 WLR 3281 (CA), at para. 82 of the judgment.

<sup>104</sup> Case C-5/08 *Infopaq International A/S v. Danske Dagblades Forening* ECLI:EU:C:2009:465.

exceptions and limitations, but it accepted that in copyright one needs to know what the work is and whether it attracts copyright before one can deal with infringement and limitations. One cannot infringe what is not protected in the first place and exceptions and limitations necessarily apply to the copyright protection of the work. From that perspective the Information Society Directive<sup>105</sup> dealt necessarily with the concept of (copyright) works when it harmonized limitations and exceptions for all categories of copyright works. The Directive is not limited in scope to certain categories of copyright works. It does not, on the other hand, contain a definition of a work, let alone of originality. Nevertheless, one needs a definition in order to be able to address the questions on infringement and limitations and exceptions before the court. Under EU rules of interpretation these undefined concepts are then given an autonomous interpretation, i.e. one does not refer back to the law of the member states.<sup>106</sup> The court then finds that in EU law reference is made to the Software and Database Directives, as this is also the case in the Information Society Directive, and in those two Directives the only indication that is found is that of the originality as the work being ‘the author’s own intellectual creation’. In the absence of conflicting elements of a common definition the court therefore accepted that across the EU the Directive now imposes that concept of originality for all categories of works.<sup>107</sup> Most recently the CJEU referred in this context to the fact that the author is able to make free and creative choices that are capable of conveying the originality of the subject matter to the reader, even if in that latter bit the concept of a work is not far away. The originality in terms of free and creative choices then arises from the choice, sequence and combination of words (or images, etc.) And from that then flows an original expression of creativity that forms an intellectual creation and hence a work. It demonstrates the Court’s approach to originality, but also the close link with the autonomous concept of a work.<sup>108</sup>

#### ***III.4 The impact of the autonomous concept of originality in UK Copyright law***

One can see this as harmonization via the back door or as the imposition of a higher originality criterion on countries such as the United Kingdom or one can see it as the correct application of the rules of interpretation to the provisions of the Information Society Directive to which all member states agreed. Be that as it may, one needs to ask the question whether this decision changes a lot in UK copyright law. Arguably it does not change a lot in relation to original literary, dramatic, musical, or artistic works. More recent decisions, such as *Hyperion*,<sup>109</sup> had paid lip service to the skill and labour idea, but they had emphasized the point that the author must produce his or her own expression of the idea. In doing so the author surely does not copy, and invests his or her own skill and judgement. The question then arises how one ascertains that the author

<sup>105</sup> Directive 2001/29/EU of the European Parliament and of the Council of 22 May 2001 on the harmonization of certain aspects of copyright and related rights in the information society [2001] OJ L 167/10.

<sup>106</sup> Case C-5/08 *Infopaq International A/S v. Danske Dagblades Forening* ECLI:EU:C:2009:465, at para. 27.

<sup>107</sup> Case C-5/08 *Infopaq International A/S v. Danske Dagblades Forening* ECLI:EU:C:2009:465, at para. 37.

<sup>108</sup> Case C-469/17 *Funke Medien NRW GmbH v Bundesrepublik Deutschland* ECLI:EU:C:2019:623, at para. 23.

<sup>109</sup> *Hyperion Records v. Lionel Sawkins* [2005] 3 All ER 636, [2005] 1 WLR 3281 (CA).



produces his or her own expression of the idea. Where does the originality lie? What is the original article of the author? The cases clearly show that a mere copy is not what one is looking for and that the author's own individual interpretation is needed as a minimum requirement. That is not the same as requiring creativity or artistic value, but it is a particular kind of skill and labour and not mere sweat of the brow. The House of Lords made this specifically clear when it argued that one needs to look at the reason why a work is given copyright protection.<sup>110</sup> For each category of works there is a specific 'original' article that is required. For literary works it is literary originality and for artistic works it is artistic originality and so on. That approach cannot be reconciled with a definition of originality as mere sweat of the brow. A specific kind of skill and labour is required and it is necessarily put in by the author. Without going into the issue of (literary or artistic) merit, that clearly links originality to the input into the expression of the idea by the author. In choosing that expression the author will necessarily use his or her intellect and it therefore becomes 'the author's own intellectual creation'.

The House of Lords may have come to this position from a (specific) skill and labour angle, but the outcome differs little from the outcome reached by the French Supreme Court that started from an expression of the author's personality angle. The French Supreme Court<sup>111</sup> recently held that the inscription of the word 'Paradis'<sup>112</sup> in gilded letters with a special effect and graphic form on an old door with a lock in the shape of a cross, embedded in a dilapidated wall with peeling paint, is a combination that involves aesthetic choices that reflect the author's personality. That led the court to the conclusion that the artist's conceptual approach, which consists of placing a word in a specific place and changing its usual meaning, constitutes an original material creation that enjoys copyright protection. One sees an emphasis on concepts of personality and creativity that one would not find in a House of Lords or Supreme Court judgment, but that use of wording cannot hide that one can also decide the case by using the UK wording that the artist invested his specific skill, labour, and judgement and applied it to the work to come to a copyright work as the expression of the author's own intellectual creation. The actual difference may therefore be very small or non-existent, without even taking into account the *Infopaq* harmonization. *Infopaq* may therefore be a mere confirmation of a somewhat higher level of originality being required. This does, of course, mean that certain works will no longer attract copyright protection in the UK and that copyright can no longer be used as a stop-gap solution to protect these works in the absence of a tort of unfair competition.

What may surprise in the French judgment, as well as in the *Infopaq* decision is that small amounts of words, i.e. one and eleven respectively, are seen as potentially constituting a copyright work. *Infopaq* confirms

<sup>110</sup> *Newspaper Licensing Agency Ltd v. Marks & Spencer plc* [2001] 3 WLR 290 at para. 19 (HL).

<sup>111</sup> *Bettina Rheims v. M. Jakob Gautel and ors*, decision of the 1st Civil Division of the French Cour de Cassation (Supreme Court) of 13 November 2008, 40 (2009) 4 IIC 485.

<sup>112</sup> Meaning 'paradise'.

specifically that the originality test applies to parts of the work as well as to the whole work.<sup>113</sup> The question whether a part of a work attracts copyright protection is therefore dependent on whether the part is original and involves therefore an element of the author's own intellectual creation (and this is not necessarily a low hurdle that can be passed easily). That excludes non-original and copied parts, but it also means that parts of the work can attract protection and that using or copying them can amount to an infringement. It is arguable that the old UK system offered less protection in this area and that *Infopaq* therefore broadens the scope of copyright. That conflicts with the idea that UK copyright traditionally combines this weaker form of protection with a restrictive approach to limitations and permitted exceptions. Our limitations and exceptions may now become too narrow and copyright owners may get an unduly broad protection (to the detriment of the user) if protection is also available to parts of the work. What is clear though is that the English courts are now adopting the approach set out in *Infopaq*<sup>114</sup> and there is a clear trend towards the use of the concept of the author's own intellectual creation as the standard for originality.<sup>115</sup> The *Infopaq* standard was used to decide that certain newspaper headlines could attract copyright protection in the *Meltwater* case<sup>116</sup> and that decision was confirmed on appeal.<sup>117</sup> The case is also a good example of how small parts of a work can attract their own copyright by meeting the *Infopaq* standard.

#### **IV. Conclusion**

There seems to be a rather important difference between on the one hand the concepts of works and originality and the closed list of works in UK copyright law and the autonomous concepts of a work and originality set out in the case law of the Court of Justice of the European Union. One could even ask the question whether the UK approach complies with the requirements of EU law as set out by the Court. However, appearances can be deceptive. The recent case law of the UK courts shows a remarkable degree of flexibility on these points and, in reality, the approach that emerges is rather close indeed to the approach set out by the Court of Justice of the European Union.

That leaves open the question whether the UK courts introduced this degree of flexibility to anticipate the changes at EU level or to take them on board without spelling that out in detail, or whether these changes are homegrown and would have taken place anyway. The answer to that question is not clear and may not even be very relevant. All parties seem at present rather happy with the outcome. That outcome suits the various

<sup>113</sup> Case C-5/08 *Infopaq International A/S v. Danske Dagblades Forening* ECLI:EU:C:2009:465, at para. 39.

<sup>114</sup> See also *Temple Island Collections Ltd v. New English Teas Ltd and Nicholas John Houghton* [2012] EWPC 1.

<sup>115</sup> See e.g. *SAS Institute Inc v. World Programming Ltd* [2013] EWCA Civ 1482.

<sup>116</sup> *Newspaper Licensing Agency Ltd v. Meltwater Holding BV* [2010] EWHC 3099 (Ch), [2011] RPC 7.

<sup>117</sup> [2011] EWCA Civ 890, [2012] RPC 1.

parties in the copyright world and it is therefore likely to survive the current changes, be they new copyright legislation at EU level or Brexit at UK level.

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