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**“Assessing the impact and reception of the Court of Justice of the
European Union case law on UK copyright law:**

What does the future hold?”

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INTRODUCTION

Very soon it will be a quarter of a century since the first EU directive in the field of copyright was adopted.¹ The case law of the Court of Justice of the European Union (“the CJEU” or “the Court”) on copyright is now pervasive; there is no aspect of copyright it has not ruled on.² Since its landmark judgment in *Infopaq* in 2009³, many of its decisions in the field of copyright have generated controversy mainly because of the Court’s activism or ‘harmonisation bug’. The Court has often filled gaps in the *acquis communautaire* where the silence of the texts could have meant that the competence still belonged to Member States.

This article examines how the CJEU case law has impacted UK copyright law in two main areas: the concept of work and the originality requirement, which also includes the infringement test as it is at least in part a reflection of the originality requirement (sections 4 and 5). To map the changes, the article first recalls the concepts in UK law pre-*Infopaq*, in the *acquis communautaire* and as interpreted by the CJEU (sections 1, 2 and 3). It also sketches the current and potential impact in other areas of UK copyright law and also notes that the CJEU’s impact is not limited only to the UK; notions of copyright law are being changed in many Member States. The article concludes by trying to determine what the future holds for UK copyright law but also for copyright law more generally (section 6). As the Irish copyright act on the points analysed in this article is almost an exact copy of the British copyright act, much of the analysis below is similarly applicable to Irish law.

1. THE CONCEPTS OF WORK AND OF ORIGINALITY IN UK LAW PRE-*INFOPAQ*

Since its inception, the UK has had a closed list of works. Outside its eight categories – namely literary, dramatic, musical, artistic works, sound recordings, films, broadcasts and typographical arrangements of published editions⁴ – a creation cannot be protected even if it is original (for the first four) or even if it is not a copy (for the last four). This principle lead

* Professor of Intellectual Property Law, University of Nottingham. © Estelle Derclaye 2014. This article is based on a talk given at BLACA, the British branch of the ALAI, on 12 September 2013, the slides of which are available at www.blaca.org/originality-blaca_12_sept_2013_final.pdf. All web sites have been accessed on 27 March 2014. The author would like to thank the editor of RIDA for his patience and Mr Justice Arnold, Sir Robin Jacob and Sam Ricketson for their comments. All potential errors remain the author’s.

¹ Directive 2009/24/EC of the European Parliament and of the Council of 23 April 2009 on the legal protection of computer programs (Codified version), OJ L111 of 5.5.2009, codifying Council Directive 91/250/EEC of 14 May 1991 on the legal protection of computer programs, OJ L 122/42, hereinafter ‘software directive’. Unless otherwise stated, all citations to the literature omit footnotes.

² By aspect, we mean the general aspects namely subject-matter, protection requirements, duration, rights, exceptions and remedies, not every provision of the *acquis*, and obviously only those aspects which have been harmonised (so this excludes for instance moral rights). In the past, the Court ruled on copyright only marginally as there was not yet any secondary law. Therefore, the case law was mainly dealing with freedom of movement goods (exhaustion) and competition issues. For a concise exposition of this case law, see E. Derclaye, “The European Union and Copyright” in P. Geller, ed., *International Copyright Law and Practice*, Lexis Nexis (Matthew Bender), updated every year, last update 2013.

³ Case C-5/08, *Infopaq International A/S v Danske Dagblades Forening* [2009] E.C.R. I-6569. As a reminder this case dealt with news articles, small parts of which were reproduced and sent to subscribers by the media monitoring agency Infopaq. The question was whether there was a reproduction under article 2 of the Directive 2001/29 on the harmonisation of certain aspects of copyright and related rights in the information society [2001] OJ L167 (herein after referred to as ‘infosoc directive’). In determining this, the Court decided to interpret the term ‘work’ and held that the originality requirement was the author’s own intellectual creation for literary works and arguably for all works.

⁴ Sections 3-8 of the Copyright, Designs and Patents Act 1988 as amended (CDPA). The first four categories correspond to the author’s rights in civil law countries while the last four categories correspond to the neighbouring rights in civil law countries (except that the last one does not exist in the vast majority of them).

to the (in)famous *Creation Records*⁵ and *Nova v Mazooma*⁶ decisions, in which a highly original scene and a video game respectively were considered unprotected by copyright. Two additional problems have arisen in relation to work categorisation. First, even if the categories are supposed to be waterproof, because of bad drafting, some are not. Thus a single effort can be at the same time a literary and an artistic work.⁷ Second, judges have also made one category of ‘entrepreneurial works’ (film) overlap with one category of ‘creative works’ (dramatic work).⁸ It may appear pedantic or purely cosmetic to the non-expert but it is not, because in UK law, the category in which a work falls determines its regime, so not only its duration (like in civil law countries) but also the rights and exceptions attached to it.⁹

The traditional UK standard of originality requires checking two things: first, whether the work is not copied¹⁰ and second, whether the author has exerted sufficient skill, judgement or labour (“SSJL”).¹¹ Courts have used a variety of words apart from the traditional ‘triumvirat’ of ‘skill, judgement and labour’ to find a work original, namely work, capital, effort, industry, time, knowledge, taste, ingenuity, experience, expense, investment.¹² The traditional originality requirement thus encompasses equally creative works and works which required mere labour or capital, or even skill which does not necessarily involve creativity, so long as it is more than *de minimis* (hence the term sufficient). However, “[m]uch of the case law seems inconsistent”¹³ and “the dividing line between original ... works and ... unoriginal works, remains an uncertain and shifting one”.¹⁴ For one, courts sometimes use the triumvirat disjunctively (labour, skill *or* judgement), sometimes cumulatively (labour, skill *and* judgement); the latter formula seems to have had the most success in recent years. Second, originality depends on the facts of the case and is a question of degree in each case.¹⁵ Third, both the pre-expressive and expressive stages should be taken into account when determining if a work is original.¹⁶ Fourth, *Interlego* seems to have set other criteria for derivative

⁵ *Creation Records v News Group Newspapers* [1997] E.M.L.R. 444 Ch D (even if there was no copyright in the scene and thus no copyright infringement, there was a breach of confidentiality).

⁶ *Nova Productions v Mazooma Games & Ors* [2006] EWHC 24 (Ch), *aff’d by* [2007] EWCA Civ 219 (however, the Court of Appeal did not reconsider whether the video game was a dramatic work as the appellant dropped that issue on appeal). Arguably, the Berne convention forces the UK to protect videogames because the expression “expressed by a process analogous to cinematography” imposed it from the outset, even if videogames were not known at the time. However, it all depends on how “analogous” and “cinematography” are to be interpreted.

⁷ S. 3(1) states in relevant part “In this Part - “literary work” means any work, other than a dramatic or musical work, which is written, spoken or sung” and thus does not exclude artistic works, and section 4 which deals with artistic works does not exclude literary works. In the so-called electronic diagrams cases, judges were split as to whether a single effort could be classed in two categories (literary and artistic). See *Anacon Corporation v Environmental Research Technology* [1994] FSR 659; *Electronic Techniques (Anglia) v Critchley Components* [1997] FSR 401; *Mackie Designs v Behringer* [1999] RPC 717; *Aubrey Max Sandman v Panasonic U.K. Ltd* [1998] FSR 651.

⁸ *Norowzian v Arks (No.2)* [2000] E.C.D.R. 205 (CA). For a detailed explanation, see Derclaye “Debunking some of UK copyright law’s longstanding myths and misunderstandings” [2013] 1 Intellectual Property Quarterly 1-17 and references therein.

⁹ See ss. 17-21 of the CDPA for the rights and ss. 28-76 for the exceptions.

¹⁰ *University of London Press v University Tutorial Press* [1916] 2 Ch 601.

¹¹ *Ladbroke v. William Hill* [1964] 1 W.L.R. 273, 278, 282.

¹² L. Bently and B. Sherman, *Intellectual Property Law*, 3rd edn, Oxford University Press, 2009, 95.

¹³ *Ibid*, 94.

¹⁴ S. Ricketson, “The concept of originality in Anglo-Australian copyright law” (1991) 9(2) Copyright Reporter 1.

¹⁵ *Macmillan v Cooper* (1923) 93 LJPC 113 (Lord Atkinson), restated in *Ladbroke v William Hill*, above n 11, 278 (HL).

¹⁶ *Ladbroke v William Hill*, above n 11; Bently & Sherman, above n 12, 96.

works.¹⁷ In short, skill and labour in copying does not count and there must be a material change of the right kind. Arguably, these statements are simply an application of the principles as *University of London Press* already stated that there cannot be copyright if there is copying. Material change simply means a new amount of sufficient skill, judgement or labour. One thing *Interlego* added though is that at least in the case of artistic works, the change must have visual significance.

Pre-*Infopaq*, the UK did not have a single requirement of originality as it had to comply with the EU *acquis* which harmonised originality for photographs, computer programs and databases.¹⁸ However, the UK only implemented the requirement of the author's own intellectual creation for databases. And while the literature was in agreement that the new criterion applied to databases, it was not entirely clear if it was a higher requirement than SSJL.¹⁹ In our view, it was clear as the *sui generis* right was adopted to replace sweat of the brow.²⁰ The CJEU confirmed this view in *Football Dataco*.²¹ In relation to computer programs, UK courts carried on applying the traditional SSJL standard even if they should have applied the author's own intellectual creation.²² Since the UK did not change the requirement of originality for photographs when it implemented the term directive, it is unclear whether the requirement for them was SSJL or the author's own intellectual creation as mandated by article 6 of the directive.²³ In conclusion, the legislature and courts generally ignored the new requirement and assumed it meant the same as the old one.

2. THE CONCEPTS OF WORK AND ORIGINALITY IN THE ACQUIS

Even if the term 'work' appears in most directives, the concept of work has only been harmonised in two directives namely the software and database directives. Only the database directive defines its subject-matter (art. 3(1)). The software directive does not define 'computer program'; it only states that preparatory design material is included in the protected subject-matter (art. 1.). Other than software and databases, the concept of work was not something that Member States saw necessary to harmonise.²⁴

¹⁷ *Interlego v Tyco* [1988] RPC 343. For Bently & Sherman, above n 12, 97, n 38, it may well be that there is no single originality criterion in the UK as in *Interlego*, Lord Oliver said that it would be erroneous to apply the test set out in *Labrodke* (which dealt with literary compilations) to artistic works.

¹⁸ Articles 6 of Directive 2006/116/EC of the European Parliament and of the Council of 12 December 2006 on the term of protection of copyright and certain related rights (codified version), Official Journal L 372/12 (hereinafter term directive), 1(3) of the software directive and 3(1) of the Directive 96/9 on the legal protection of databases [1996] OJ L77/20.

¹⁹ See e.g. Bently & Sherman, above n 12, 108.

²⁰ E. Derclaye, *The Legal Protection of Databases, A Comparative Analysis*, Edward Elgar, Cheltenham, 2008 chapter 3, section 3.1 and chapter 4 and references therein. See also A. Beunen, *Protection for databases: the European Database Directive and its effects in the Netherlands, France and the United Kingdom*, Wolf Legal Publishers, 2007, 76-77.

²¹ Case C-604/10, *Football Dataco v Yahoo UK!* [2012] nyr. All decisions not yet reported are available on www.curia.europa.eu.

²² See e.g. *Ibcos Computers v. Barclays Mercantile Highland Finance* [1994] FSR 275; *Cantor Fitzgerald International v. Traditional* [2000] RPC 95; *Navitaire v Easyjet Airline* [2005] ECDR 17.

²³ Bently & Sherman, above n 12, 109 and 111.

²⁴ See M. van Echoud, 'Along the Road to Uniformity - Diverse Readings of the Court of Justice Judgments on Copyright Work' (2012) 3 JIPITEC 1, 62-63; A. Firth and F. Gotzen, "Towards a single EU concept of originality?", ALAI Congress, Dublin, June 30, 2011.

On the other hand, the concept of originality appears in three directives: the software, term and database directives. According to the *travaux préparatoires*²⁵, originality was clearly only harmonised for the three types of works envisaged in these directives, namely computer programs, photographs and databases.²⁶ The same term appears in all three directives: “the author’s own intellectual creation”. The vast majority of the literature thought that the SSJL’s standard is lower than that of the author’s own intellectual creation.²⁷ On the other hand, some commentators argued that the concept of the author’s own intellectual creation is stricter in the term directive than in software and database directives owing to the use of “personality” in recital 17.²⁸ Neither the *travaux préparatoires* nor the text of the Directive make clear whether the test for photographs is the same as that for software.²⁹ However, it would be strange if the test was different for photographs as it is illogical to choose the same terms to describe a different standard. In conclusion, it was clear that Member States did not intend to harmonise the concepts of work and originality except for three types of work. However, it was unclear what the author’s own intellectual creation actually meant and whether it had a different meaning for photographs as opposed to computer programs and databases.

3. THE COURT OF JUSTICE’S INTERPRETATION OF THE CONCEPTS OF WORK AND ORIGINALITY

²⁵ European Commission, Green Paper on Copyright and Related Rights in the Information Society, COM (95) 382 final, Brussels, 19.07.1995, 27.

²⁶ Van Eechoud, above n 24, 73 referring to the Green Paper on Copyright and Related Rights in the Information Society of 1995. Even if it postdates the three relevant directives, the Commission restated this fact again in 2004. If not the Member States, at least the Commission did not think that the criterion of originality was harmonised beyond photographs, computer programs and databases. See Commission Staff Working Paper on the review of the EC legal framework in the field of copyright and related rights, Brussels 19.07.2004, SEC(2004) 995, available at http://ec.europa.eu/internal_market/copyright/docs/review/sec-2004-995_en.pdf, no. 3.1, 14. See also L. Bently, “Harmonization by Stealth: Copyright and the ECJ”, Presentation at 20th Annual Intellectual Property Law & Policy Conference, Fordham University School of Law, April 2012, available at http://fordhamipconference.com/wp-content/uploads/2010/08/Bently_Harmonization.pdf.

²⁷ J.A.L. Sterling, *World Copyright Law*, Sweet & Maxwell, 3rd edn, 2008, 355-356; A. Strowel, *Droit d’auteur et copyright*, Bruylant, 1993, 469 (also noting that further evidence comes from the semi-conductor topographies directive which has a different criterion from that in the software directive namely the *intellectual effort* of its creator (art 2(2) of the directive)); Bently and Sherman, above n 12, 97; P. Torremans, *Holyoak and Torremans’ Intellectual Property Law*, Oxford University Press, 7th edn, 2013, 200-201; M. van Eechoud, B. Hugenholtz, S. van Gompel, L. Guibault & N. Helberger, *Harmonizing European copyright law: the challenges of better lawmaking*, Kluwer, 2009, 42; E. Rosati, *Originality in EU Copyright, Full Harmonization through Case Law*, Elgar, 2013, 80; I. Alexander, “The concept of reproduction and the ‘temporary and transient’ exception” [2009] 68(3) Cambridge Law Journal 520, 522. Less decisive: W. Cornish & D. Llewelyn, *Intellectual Property: Patents, Copyright, Trademarks and Allied Rights*, 6th edn, Sweet & Maxwell, 2007, 424, (the EU author’s own intellectual creation is not the SSJL); A. Rahmatian, “Originality in UK copyright law: the old “skill and labour” doctrine under pressure” [2013] IIC 4. Synodinou (ed), *Codification of European Copyright Law. Challenges and Perspectives*, Kluwer, 2012 98 notes that some continental authors thought that the author’s own intellectual creation simply meant originating from the author and thus was equivalent to the British standard, citing A. Lucas & H.-J. Lucas, *Traité de la propriété littéraire et artistique*, Litec, 3rd edn, 2006, 85, no 98 and M. Walter & S. von Lewinski, *European Copyright Law, A Commentary*, Oxford University Press, 2010, 93-94.

²⁸ Recital 17 reads in relevant part “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.” M. van Eechoud, B. Hugenholtz et al, above n 27, 41, referring to G. Karnell, “European Originality: A Copyright Chimera”, in J. Kabel & G. Mom (eds), *Intellectual Property and Information Law: Essays in Honour of Herman Cohen Jehoram*, Kluwer, 1998, 201, 203; Rosati, above n 27, 68, 69 and 71.

²⁹ Karnell above n 28; Van Eechoud, above n 24, 62.

3.1. THE CONCEPT OF WORK

The CJEU has now interpreted the notion of work in (at least) three decisions (*Infopaq*, *BSA*³⁰ and *FAPL*³¹). The Court said in the relevant passages of the three cases:

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

BSA: “45. The Court has held that copyright within the meaning of Directive 2001/29 is liable to apply only in relation to a subject-matter which is original in the sense that it is its author’s own intellectual creation (see, to that effect, with regard to Article 2(a) of Directive 2001/29, *Infopaq International*, paragraphs 33 to 37).

46. Consequently, the graphic user interface can, as a work, be protected by copyright if it is its author’s own intellectual creation.”

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

97. To be so classified, the subject-matter concerned would have to be original in the sense that it is its author’s own intellectual creation (see, to this effect, Case C-5/08 *Infopaq International* [2009] ECR I-6569, paragraph 37).

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

Some have argued that already in *Infopaq*, the Court had totally harmonised the notion of work in the sense that the notion of work includes having categories or not as well as the fixation, the idea/expression and the originality requirements, adding that for the Court it meant that there are no categories and a work exists simply if the requirement of originality is fulfilled.³² This interpretation of *Infopaq* may be stretching the words of the Court a little far.³³ However, in *BSA*, the Court went further and seems to imply that a work exists simply if it is its author's own intellectual creation.³⁴ This implication was made clearer in *FAPL* where the Court arguably subsumed the notion of work with that of originality.³⁵ These decisions have lead commentators to argue that the Court has done away with the UK categorisation system³⁶, in other words that the list of works is not exhaustive.³⁷ Some have

³⁰ Case C-393/09, *Bezpečnostní softwarová asociace – Svaz softwarové ochrany v Ministerstvo kultury* [2010] ECR I-13971 (further referred to as *BSA*).

³¹ Joined Cases C-403/08 and C-429/08, *Football Association Premier League v. QC Leisure and Karen Murphy v Media Protection Services* [2012] F.S.R. 1 (further referred to as *FAPL*).

³² C. Handig, “*Infopaq International A/S v Danske Dagblades Forening* (C-5/08): is the term “work” of the CDPA 1988 in line with the European Directives?” [2010] EIPR 53, 54-55.

³³ See also S. Vousden, “*Infopaq* and the Europeanisation of Copyright Law” [2010] WIPO Journal 197, n 12.

³⁴ Para 46.

³⁵ Paras 96-98.

³⁶ Some are more cautious than others: among them L. Bently “The Lionel, the *Bezpečnostní softwarová asociace* and the Wandering Court of Justice”, 11 January 2011, The IP Kat Blog, <http://ipkitten.blogspot.co.uk/2011/01/lionel-bezpecnostni-softwarova-asociace.html> (“Although the language is not as clear as it might be, the CJEU seems to be saying that Directive 2001/29 requires that protection be afforded to any and every “intellectual creation”); J. Davis, *Intellectual Property Law*, Oxford University Press, 2012, 4th edn, p. 25, mentions that *Infopaq* could make a difference in relation to the categories but does not take a position; W. Cornish, D. Llewelyn and T. Aplin, *Intellectual Property: Patents, Copyright, Trademarks and Allied Rights*, 8th edn, Sweet & Maxwell, 2013, no. 11-04 think it is debatable that the categories subsist after *BSA* and *FAPL*; E. Derclaye, “*L’arrêt Softwarová*: une révolution en droit d’auteur ou une « erreur de jugement »?” [2011] 43 *Revue du Droit des Technologies de l’Information* (RDTI) 57, 59-60; J. Griffiths, “*Infopaq*, *BSA* and the ‘Europeanisation’ of United Kingdom Copyright Law” [2011] *Media & Arts Law*

argued further that since seemingly the only requirement for a work to subsist in EU law is that it is original, it would mean that there is no need to check if it is a work (apart from being an intellectual creation)³⁸ nor whether it is recorded in a material form.³⁹ The same argument could be made from the recent *Nintendo* ruling in which the Court holds that ‘videogames [...] constitute complex matter comprising not only a computer program but also graphic and sound elements, which, although encrypted in computer language, have a unique creative value which cannot be reduced to that encryption. *In so far as the parts of a videogame, in this case, the graphic and sound elements, are part of its originality, they are protected, together with the entire work, by copyright in the context of the system established by Directive 2001/29.*’⁴⁰ This seems to suggest that videogames are not only computer programs but also artistic and musical works. It is a pity, and strange, that the Court did not extend its ruling to the game’s audiovisual element as it would have definitely overruled *Nova* if the correct interpretation of its case law is that categories no longer exist.

Since the Court held that the term ‘work’ was an autonomous notion of EU law (as ‘work’ does not refer to national laws in any of the directives), it probably has the same meaning in all directives whether the directives define the term or not.⁴¹ Also, if the Court is coherent with itself⁴², it must apply its autonomous and uniform interpretation to all terms which do not refer to Member States laws. Nevertheless, if the amalgam between the notion of work and of originality is confirmed⁴³, it is an error⁴⁴ and thus unfortunate as it is bound to confuse national courts and to lead to wrong decisions (see e.g. below in section 3.2 in relation to ‘rules of the game’). Hopefully, in a future reference, the Court will be able to rectify this. Indeed, if it is consistent, the Court would refer to article 2(1) of the Berne Convention and hold that first, courts must check whether something is a work before verifying whether it displays originality. It would also be consistent with its *SAS* ruling⁴⁵ which confirms that copyright does not protect ideas and thus by implication it does not protect original ideas.

In conclusion, since the term ‘work’ is an autonomous notion of EU law, even if the Court has not had to say it explicitly as it has never been asked the question, it probably means that

Review (“It is, after all, not a necessary step from (i) all ‘works’ must satisfy the ‘author’s own intellectual creation’ standard (*Infopaq*) to (ii) anything satisfying the ‘author’s own intellectual creation’ standard is a ‘work’”); J. Griffiths, “Dematerialization, pragmatism and the European copyright revolution” [2013] 33(4) *Oxford Journal of Legal Studies* 767, 782 and 784; van Eechoud, above n 24, 66; Kevin Garnett, Gillian Davies, Gwilym Harbottle, *Copinger and Skone James on Copyright*, Sweet and Maxwell, 2nd supplement to the 16th edition, 2013, 11 quoting *SAS* [2013] ChD RPC 17, paras 23 and 27 whereas others are more definite: Rosati, above n 27, 133 and 157; I. Silverman, “Copyright and fashion: friends at last?” [2013] *EIPR* 637, 642 (commenting on *BSA*).

³⁷ C. Handig “The “sweat of the brow” is not enough! - more than a blueprint of the European copyright term “work”” [2013] *EIPR* 334, 339.

³⁸ S. Carre, « Le rôle de la Cour de Justice dans la construction du droit d’auteur de l’Union », in C. Geiger (ed.), *La contribution de la jurisprudence à la construction de la propriété intellectuelle en Europe*, Lexis Nexis/Université de Strasbourg/CEIPI, 2013, p. 1, 56; Griffiths 2013, above n 26, 782, 785; van Eechoud, above n 24, 66; Silverman, above n 36, 642 is more definitive.

³⁹ Handig, above n 37, 339 (disputable that the fixation requirement can subsist as this aspect is likely to be covered by harmonisation); Griffiths 2013, above n 36, 782-783, 785.

⁴⁰ Case C-355/12, *Nintendo v PC Box et al* [2014] nyr, para 43 (emphasis added).

⁴¹ C. Handig “The copyright term “work” - European harmonisation at an unknown level” [2009] *IIC* 665, 671, 684; Handig, above n 32, 54-55; Handig, n 37 above, 334-335.

⁴² We shall see in section 6 that it is not always the case.

⁴³ As Bently, above n 26, rightly said this is uncertain. Hence our use of the word ‘if’.

⁴⁴ V.-L. Benabou, ‘L’originalité, Un Janus juridique, Regards sur la naissance d’une notion autonome de droit de l’Union’ in *Mélanges en l’honneur d’André Lucas*, Éditions du Jurisclasseur Lexis Nexis, forthcoming 2014 (One cannot say something is not a work if it is not original. Something can be a work but can be banal).

⁴⁵ Case C-406/10, *SAS Institute v World Programming* [2012] nyr (further referred to as *SAS*).

it will have to choose whether the categories are closed or open and probably would choose an open system as in the Berne convention. The same choice would have to be made in relation to fixation. Falling back on the Berne convention would not help as the convention specifically leaves it to Member States. If the Court, as it seems, keeps relying on its ‘high level of protection mantra’ (recital 9 of the infosoc directive), it is likely it would find that fixation is not required.

3.2. ORIGINALITY

The Court has now construed the requirement of originality in no less than seven decisions. They involved literary works (*Infopaq*) including computer programs (*SAS*), graphical user interfaces (“GUI”)⁴⁶ (*BSA*), photographs (*Painer*⁴⁷), football matches (*FAPL*), databases (*Football Dataco*) and works of applied art (*Flos*⁴⁸). The relevant passages of the Court’s reasoning, in chronological order, are as follows with our emphases:

Infopaq: “45. [...] words [...], considered in isolation, are not as such an intellectual creation of the author who employs them. It is only through the choice, sequence and combination of those words that the author may express his creativity in an original manner and achieve a result which is an intellectual creation.

48. [...] the reproduction of an extract of a protected work which, like those at issue in the main proceedings, comprises 11 consecutive words thereof, is such as to constitute reproduction in part within the meaning of Article 2 of Directive 2001/29, if that extract contains an element of the work which, as such, expresses the author’s own intellectual creation; it is for the national court to make this determination.”

BSA: “48. the national court must take account, inter alia, of the specific arrangement or configuration of all the components which form part of the graphic user interface in order to determine which meet the criterion of originality. In that regard, that criterion cannot be met by components of the graphic user interface which are differentiated only by their technical function”.

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

Painer: “88. [...] an intellectual creation is an author’s own if it reflects the author’s personality.

89. That is the case if the author was able to express his creative abilities in the production of the work by making free and creative choices. ...

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

94. Such photograph is an intellectual creation of the author reflecting his personality and expressing his free and creative choices in the production of that photograph.

97. Moreover, nothing in Directive 2001/29 or in any other directive applicable in this field supports the view that the extent of such protection should depend on possible differences in the degree of creative freedom in the production of various categories of works.

⁴⁶ GUI can include literary, musical, dramatic or artistic works.

⁴⁷ Case C-145/10, *Eva-Maria Painer v. Standard Verlags GmbH* [2011] E.C.D.R. 297 (further referred to as *Painer*).

⁴⁸ Case C-168/09, *Flos SpA v Semeraro Casa e Famiglia SpA* [2011] E.C.D.R. 8 (further referred to as *Flos*).

98. Therefore, as regards a portrait photograph, the protection conferred by Article 2(a) of Directive 2001/29 cannot be inferior to that enjoyed by other works, including other photographic works.”

Football Dataco: “38. that criterion of originality is satisfied when, through the selection or arrangement of the data which it contains, its author expresses his creative ability in an original manner by making free and creative choices and thus stamps his ‘personal touch’ [...]”

39. By contrast, that criterion is not satisfied when the setting up of the database is dictated by technical considerations, rules or constraints which leave no room for creative freedom [...]

42. [...] the fact that the setting up of the database required, irrespective of the creation of the data which it contains, significant labour and skill of its author [...] cannot as such justify the protection of it by copyright [...], if that labour and that skill do not express any originality in the selection or arrangement of that data.”

SAS Institute: “66. [...] the keywords, syntax, commands and combinations of commands, options, defaults and iterations consist of words, figures or mathematical concepts which, considered in isolation, are not, as such, an intellectual creation of the author of the computer program.

67. It is only through the choice, sequence and combination of those words, figures or mathematical concepts that the author may express his creativity in an original manner and achieve a result, namely the user manual for the computer program, which is an intellectual creation”.

Flos: “34. However, it is conceivable that copyright protection for works which may be unregistered designs could arise under other directives concerning copyright, in particular Directive 2001/29, if the conditions for that directive’s application are met, a matter which falls to be determined by the national court”.

What can one conclude from all these formulas? At least three things are clear. First, very short works can be original (*Infopaq*). Second, as it is comprised in the concept of work, the concept of originality is also an autonomous uniform notion of EU law. Third, significant, labour or skill as such is not enough if there is no creativity (*Football Dataco*). As Sterling rightly said, some skills involve creativity, some not.⁴⁹ This means that “sufficient skill” does not per se equate to creativity. Indeed, in our view, only judgement can sometimes equate with creative choices. Choice is not equivalent to creativity⁵⁰ and the Court insists that the choices must be free and creative.

On the other hand, at least two things are unclear. First, the CJEU case law indicates that if there is no room for creative freedom because of function, technical considerations, rules or constraints, originality cannot arise (*BSA* para 48⁵¹, *Football Dataco* para 39). It is therefore possible that a work that has some functionality is also creative. Although it is more ambiguous in *Football Dataco*⁵², both *BSA* and *Football Dataco*’s language allow for this possibility. Indeed, if this interpretation is not adopted, many deserving works would otherwise be left unprotected. As some have noted, constraints (such as themes, economic

⁴⁹ Sterling, above n 27, 354.

⁵⁰ A. Waisman, ‘Revisiting originality’ [2009] EIPR 370, 375 citing A. Strowel, above n 27, 406: “... even if choice is an activity of the spirit through which it is possible to know someone’s personality, choosing is not equivalent to creating”.

⁵¹ ‘that criterion cannot be met by components of the graphic user interface which are differentiated *only* by their technical function.’ (emphasis added). The terms ‘only by’ mean a contrario that if a GUI is not entirely dictated by function it can be protected by copyright. They also remind of the terminology used in article 7(1) of the design directive (Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs OJ L 289/28). It is clear that functional designs can be protected. It is only when the aspect the designer wants protection for is entirely dictated by technical function that protection is denied.

⁵² The terms ‘which leave no room’ in para 39 can be interpreted both ways i.e. rules, constraints etc never leave room for creative freedom or they sometimes can.

demands, formats imposed by the employer or commissioner etc.) are often necessary to creation.⁵³ On the other hand, by definition, the Court seems to be saying that the rules of a game never leave room for creative freedom (*FAPL*).⁵⁴ Indeed, it is clear from paragraph 98 in *FAPL* that it is not possible at all for football games (and thus any sporting events by analogy) to be protected by copyright but the Court seems to say that it is the case because they are not *works*, not because they are not creative. If the Court had more clearly made the distinction between the concept of work and the concept of originality, the confusion would have been avoided. It is thus ‘more’ because a football game is not a work (‘an intellectual creation’) rather than because it lacks originality that it is not protected by copyright. This is what paragraph 98 suggests but if it had been better drafted, it would have said that it is so simply because sport games are not works, full stop. If the Court had said this, it would have left no confusion and it would be clear that rules, constraints, function and technical considerations are not *per se* a bar to creativity. It is only when the work is *entirely* dictated by these rules etc that the work is not creative. The Court’s ambiguous wording in *FAPL* and *Football Dataco* leaves much to be desired and may lead national courts to the wrong conclusions.⁵⁵ In this respect, the Court of Appeal of England and Wales seems to have clarified the ambiguity as it construed the CJEU case law as meaning that “[t]he more restricted the choices, the less likely it is that the product will be the intellectual creation (or the expression of the intellectual creation) of the person who produced it”.⁵⁶

Second, it is not entirely clear that the criterion of originality (author's own intellectual creation) is the same for all works.⁵⁷ This is because for literary works and GUI (first two cases of the series) and computer programs (last case of the series), the Court does not use the terms ‘personal touch’ which it uses for photographs and databases (both cases were decided between these two aforementioned cases). However, in *Painer*, the Court refers to *Infopaq* and *FAPL* to support its reasoning which probably means that the personal touch was included in the author's own intellectual creation from the start (i.e. in *Infopaq*) even if the Court did not utter it in its previous judgments. And in *Football Dataco*, the Court refers to all its previous rulings i.e. *Infopaq*, *BSA*, *FAPL* and *Painer* where it discusses originality.⁵⁸ Therefore, many commentators, including us, think the requirement is the same for all works.⁵⁹ It would be illogical otherwise, as databases and photographs (especially in the cases referred) are no less functional than computer programs and GUI. It seems also that *Painer* put the nail in the coffin on different standards of originality since the Court states that the scope of copyright is not dependent on the degree of creativity the work displays. Provided it reflects the free and creative choices of the author, a ‘simple’ photograph (read ‘work’) is as protected as an elaborate one.⁶⁰

Thus, a rational construction of the Court’s case law means that not only the standard of originality is the same for all works (except perhaps for registered artistic works because of

⁵³ Benabou, above n 44; Handig, above n 37, 337.

⁵⁴ *Contra*: Benabou, above n 44 who interprets *FAPL* as saying that protection is not granted *when* the rules of the game leave no room to creative freedom.

⁵⁵ Similarly Benabou, above n 44.

⁵⁶ *SAS Institute v World programming* [2013] EWCA civ 1482, para 31.

⁵⁷ Many commentators who wrote after *Infopaq* and *BSA* but before the other decisions thought it did apply to all works in the same way. See e.g. V. Benabou, Note d’observations, C.J.C.E. (4e ch.), 16 juillet 2009 [2009] 39 RDTI, 61 ff.; Handig, above n 41.

⁵⁸ Van Eechoud, above n 24, 67.

⁵⁹ Torremans, above n 27, 206; van Eechoud, above n 24, 67; Benabou, above n 44; Synodinou, above n 27, 104. *Contra*: Rosati, above n 27, 187; Vousden, above n 33, p 202-203, but writing before *BSA* and the other decisions.

⁶⁰ *Painer*, para 98. Synodinou, above n 27, 106.

*Flos*⁶¹) but also the claim that the author's own intellectual creation is stricter for photographs is now out. In conclusion, the criterion of originality for all works is "free and creative choices" - so long as the author can exercise those choices, there will be a personal touch and originality. It is indeed clear that choice, arrangement and creativity are all present from the start and in all judgments. Creativity results from choices or arrangements⁶² and the latter must be free and creative. This also means that the criterion adopted by the Court is subjective and not objective.⁶³ Nevertheless, as the Court's has sometimes zigzagged before coming to a settled position, only time will tell if the requirement of author's own intellectual creation is indeed the same for all works.

4. IMPACT OF THE COURT OF JUSTICE'S CASE LAW ON UK COPYRIGHT LAW

4.1. THE concept OF WORK

If one accepts that the Court amalgamates the notions of work and originality then its rulings changed UK copyright law. The UK cannot rely on its categories any longer. If so, it is for the better, as it gets rid of the anomalies created by the act, as illustrated in *Creation Records* and *Nova v Mazooma*.⁶⁴ There is no reason why static scenes and video games, if they are original, should not be protected by copyright. It also makes sense to have no categorisation system if one has a higher originality threshold as the latter makes it more difficult to obtain protection. In the past, the UK had the reverse system, closed categories but a more generous originality requirement. It would be even worse for authors compared to the prior UK law if a closed system was combined to a higher originality requirement.

The impact of the CJEU case law is far reaching if categories no longer exist. Indeed, the purpose of categories is to differentiate between works as far as their regime is concerned not only in relation to protection requirements or duration such as between so-called 'original works' and 'entrepreneurial works' – as is also the case in civil law countries between author's rights and neighbouring rights - but also between rights and exceptions of 'original works'. For instance, authors of artistic works do not enjoy the same rights as other works (no adaptation or performance right).⁶⁵ Likewise, not all exceptions apply to all works (e.g. fair dealing for reporting current events does not apply to photographs and the exception for reprographic copying by educational establishments of passages from published works does

⁶¹ On this, see below section 4.2.1.

⁶² The words chosen by the Court in its rulings on originality not surprisingly echo those used in the Berne convention in relation to collections of works ("selection or arrangement") when defining originality and stated again in articles 10(2) and 5 of the TRIPs agreement and WIPO Copyright Treaty respectively in relation to compilations of data or works.

⁶³ E. Derclaye, "Wonderful or worrisome? The impact of the ECJ ruling in *Infopaq* on UK copyright law" [2010] EIPR 247; C. Caron, *Comm. Electr.* 2009, comm.. 97; B. Michaux, *Auteurs & Média* 2009/5, 473, 482; P. Sirinelli, *D.* 2011, 2166, all cited in A. Lucas, H.-J. Lucas & A. Lucas-Schloetter, *Traité de la propriété littéraire et artistique*, 4th edn, Litec, para 123, n 407; Benabou, above n 44 (also stating that the formula at para 42 of *Football Dataco* implies a more 'industrial' rather than 'artistic' notion of originality and wondering whether this more industrial notion applies to all works or only databases). *Contra*: A. Lucas, H.-J. Lucas & A. Lucas-Schloetter, *Traité de la propriété littéraire et artistique*, 4th edn, Litec, citing E. Trepoz, *RTDE* 2010, 948 who think that the CJEU has adopted an objective notion of originality.

⁶⁴ See section 1.

⁶⁵ See ss. 19 and 21 CPDA.

not apply to artistic works).⁶⁶ In practical terms, it means that all exceptions will apply to all original works and since whether a work is literary or artistic no longer matters, the conflict between the electronic circuit diagrams case is resolved.⁶⁷ If the CJEU case law abolishes the categories, it is welcome as there is no reason to treat different categories of original work differently. The infosoc directive⁶⁸ does not differentiate between original works in relation to rights or exceptions and exceptions appearing in the CDPA which also appear in the infosoc directive have to comply with the latter. In fact, the UK government is proposing to abolish some of these differences.⁶⁹

4.2. ORIGINALITY AND THE TEST OF INFRINGEMENT

There is at least one aspect that the CJEU case law does not change as the author's own intellectual creation still leaves a room for manoeuvre to national courts in this respect – it is the judge-made law principle that originality depends on the facts of the case and that it is a question of degree in each case.⁷⁰ Even if *Painer* holds that the same protection should be afforded to all works and the degree of freedom should not be taken into account (a work which barely meets the originality requirement must be protected in the same way as a highly original work)⁷¹, a judge still has some room to manoeuvre. This is well illustrated in *Temple Island Collections*, an arguably borderline case which could have been decided differently on the facts. Apart from this maxim, the CJEU case law on originality and the infringement test impacts UK copyright law in two ways: in some cases, it is clear that the rulings change UK law (section 4.2.1.) while in the other cases, it is not clear they do (section 4.2.2.).

4.2.1. ASPECTS OF UK LAW THAT THE CJEU RULINGS CLEARLY CHANGE

The CJEU decisions change UK law on originality in five ways and the test of infringement in one way.

First, a work resulting from pure labour, skill or judgement is not original if this labour, skill or judgement does not result from free and creative choices. Judgement will probably meet that criterion in most cases unless the choices are banal or not free. What is clear though is that neither labour nor skill is required, but only free and creative choices. As we already said in 2010, subcreative works are now excluded.⁷² This may not involve a great number of

⁶⁶ Ss. 30(2) and 36 CDPA.

⁶⁷ On this conflict, see n 7 above.

⁶⁸ Only art. 5(3)(j) and (m) apply to specific works but it is obvious the exceptions can only apply to artistic works so that the proposition that the infosoc directive does not differentiate between works still holds. The relevant exceptions read: “3. Member States may provide for exceptions or limitations to the rights provided for in Articles 2 and 3 in the following cases: [...] (j) use for the purpose of advertising the public exhibition or sale of artistic works, to the extent necessary to promote the event, excluding any other commercial use; [...] (m) use of an artistic work in the form of a building or a drawing or plan of a building for the purposes of reconstructing the building”.

⁶⁹ <http://www.ipso.gov.uk/types/hargreaves.htm> and particularly the The Copyright and Rights in Performances (Research, Education, Libraries and Archives) Regulations 2014, available at <http://www.legislation.gov.uk/ukdsi/2014/978011112755> which are about to be approved by Parliament.

⁷⁰ *Macmillan v Cooper*, above n 15.

⁷¹ *Painer*, paras 97-98.

⁷² E. Derlaye, above n 63, 248-249. UK commentators are generally less certain in relation to the impact of *Infopaq* and its progeny on the notion of originality. See Cornish et al, above n 36, no. 11-04 and 11-09 (although they mention that *Football Dataco* clearly has an impact as football fixtures are not protected ‘despite significant skill and labour in creating data’); Davis, above n 37 p. 30 mentions *Infopaq* but does not take a

works but it is not negligible.⁷³ It is therefore incorrect to say that “[o]riginality means that a sufficient amount of skill, labour and judgement has gone into the work in such a way that through the choices, selection and arrangement in the making of the work the author gives the work a modicum of individuality and so renders it his/her own intellectual creation”.⁷⁴ Skill and labour are not required. In fact, such statement is even contrary to the directives, which clearly state that no other criteria than the author's own intellectual creation may be used to determine originality. It is also incorrect to say that the CJEU case law has not changed the UK originality requirement.⁷⁵

The CJEU requires free and creative choices, not just choices. Indeed, there can be unoriginal choices or choices constrained by rules. It is clear therefore that *Walter v Lane*⁷⁶ cannot withstand the CJEU originality test.⁷⁷ The reporters exercised skill and labour but no judgment. They made no free or creative choices when recording faithfully the Earl of Rosebery's speeches. In contrast, the *Sawkins*⁷⁸ case would not be decided differently nowadays. Even if Dr Sawkins was trying to stick as closely as possible to Lalande's lost or unfinished works, he had choices, exercised them and put his personality in the work.

Second, a consequence of the first point is that no other area of law can protect the subcreative works now left unprotected by copyright as the UK lacks a full-blown unfair competition tort or statute.⁷⁹ Passing off can only help if there is a misrepresentation (in sum some risk of confusion in addition to goodwill and damage).

Third, as *Infopaq* makes clear that short works (e.g. titles, headlines) can be protected, it overrules UK law in this respect.⁸⁰ However, arguably such protection will remain rare as not only will it be hard for short works to be expressions rather than ideas but also hard to be creative.⁸¹

Fourth, the *Football Dataco* decision makes clear that anything done during the pre-expressive stages does not count to determine originality, only the result does.

position on its impact on originality; Torremans, above n 27, 206-208; Griffiths 2013, above n 36, 785 (probably the standard is higher now and this will leave some works unprotected in the UK that were protected before).

⁷³ Derclaye above n 63, 249. *Contra*: Rahmatian, above n 27, thinks that the practical difference of applying the new test in the UK will be probably very small.

⁷⁴ Rahmatian, above n 27, 30. Emphasis added.

⁷⁵ Taking the position that the new requirement is the same as the old UK requirement, Copinger, above n 36, 24, no 3-128 and 26, no. 3-144. For C. Colston and J. Galloway, *Modern Intellectual Property Law*, 3rd edn, Routledge, 2010, p. 368, *Infopaq* is in line with the prior UK case law in relation to infringement. They do not discuss the decision in relation to originality. But since the two are linked, the point they make is still relevant here). H. Laddie, P. Prescott & M. Vitoria, *The Modern Law of Copyright and Designs*, 4th edn, Lexis Nexis, 2011, sometimes confuse the old and new test of originality and infringement.

⁷⁶ *Walter v Lane* [1900] AC 539. This case involved a number of reporters who took down in shorthand verbatim notes of a speaker's speeches.

⁷⁷ For Laddie et al, above n 75, 95 it is not as clear. For them, at best, *Infopaq* introduces uncertainty as to whether *Walter v Lane* is overruled. However, it is possible that the record of a shorthand writer could be protected as a sound recording. On this, see Derclaye above n 8, 7 ff.

⁷⁸ *Hyperion Records v Lionel Sawkins* [2005] 3 All ER 636 (the case dealt with the reconstruction of 17th century music).

⁷⁹ Derclaye, above n 63; Torremans, above n 27, 207; Bently, above n 26.

⁸⁰ Derclaye, above n 63. UK case law held that copyright did not protect short works such as slogans and titles. See *Francis Day & Hunter v Twentieth Century Fox* [1940] AC 112, 123; *Exxon Corp. v Exxon Insurance Consultants International* [1981] 2 All ER 495, *aff'd by* [1981] 3 All ER 241.

⁸¹ Laddie et al, above n 75, 86; Torremans, above n 27, 210.

Fifth, the Court's judgment in *Flos*⁸² confirms that Member States keep their national originality requirements for those designs which are registered, as article 17 of the design directive leaves this to Member States' copyright laws but also implies that unregistered designs (i.e. works of applied art which are not also registered as designs) are now subject to the same originality requirement as all other copyright works i.e. the author's own intellectual creation. This is problematic for the UK, the only Member State which has a national unregistered design right. In the UK, the requirement for works of artistic craftsmanship (the category in which falls the vast majority of works of applied art) is higher than the author's own intellectual creation, namely the work must be artistic, which has been interpreted by UK courts as some level of artistic merit. The result of *Flos* is that works of artistic craftsmanship which are registered have a higher level of originality than those which remain unregistered.⁸³ Thus, this means that two different originality standards can apply for one and the same work of applied art, depending if it is registered or not.⁸⁴ This may discourage design registration in some cases. In addition, *Flos* also implies that the protection of unregistered designs must comply with articles 2 to 4 of the infococ directive and exceptions must fall within the closed list of article 5 of the same directive.⁸⁵

Finally, as is known, the concept of originality finds its way back at the level of infringement. Indeed, the Court in *Infopaq* interpreted the reproduction right exactly this way as the test in the infococ directive is 'reproduction of the work or part of a work'. So long as the claimant's own intellectual creation is found in the defendant's work, infringement follows. Several consequences arise. First, is the UK 'substantial part' test unchanged by the new 'original part' test? The answer is both positive and negative. It is negative in the sense that it is still the quality of the part taken that counts not the quantity taken.⁸⁶ *Infopaq* and its progeny have not changed this. But of course, the quality of the part is different now. It is not the SSJL found in the part but the author's own intellectual creation which is relevant.⁸⁷ Also the other criteria of quality that courts checked in the past, such as whether the part was commercially relevant⁸⁸, can no longer be used.⁸⁹ Quality is now only related to the originality of the part taken. In this sense, the CJEU case law has changed the UK infringement test.⁹⁰ In addition, it seems logical that the test of infringement as interpreted by the CJEU in respect of the right of reproduction applies to all other rights too.⁹¹

4.2.2. ASPECTS OF UK LAW THAT IT IS UNCLEAR THE CJEU RULINGS CHANGE

⁸² Above n 48.

⁸³ Van Echoud, above n 24, 69. Generally on the broader implications of the *Flos* ruling, see L. Bently, 'The return of industrial copyright?' [2012] EIPR 654; T. Cook, "The Cumulative Protection of Designs in the European Union and the Role in such Protection of Copyright" [2013] 18(1) Journal of Intellectual Property Rights, 83-87.

⁸⁴ Van Echoud, above n 24, 69.

⁸⁵ Bently, above n 26.

⁸⁶ Laddie et al, above n 75, 151.

⁸⁷ Derclaye, above n 63, 250.

⁸⁸ *BBC v Time Out* [1984] FSR 64.

⁸⁹ Derclaye, above n 63, 250.

⁹⁰ *Contra*: Copinger, above n 36, 57, 59 and 60.

⁹¹ Griffiths 2013, above n 36, 784.

Three aspects are unclear in relation to the concepts of originality and one aspect is unclear in relation to the infringement test.

The first question is whether *Flos* overrules the case law on artistic works, which clearly requires the artist intending that his or her work has visual appeal i.e. that the work is not purely functional (*Lucasfilm*).⁹² Two questions arise. Is this requirement part of the originality requirement or the definition of subject-matter? It matters if the CJEU has harmonised only the originality requirement and not the work requirement. If the UK ‘purpose or intention requirement’ is part of the definition of the work and the CJEU has not harmonised the notion of work, then the UK can keep this requirement. But if the CJEU has harmonised the notion of work in the sense that it simply needs to be a literary or artistic work or the notion is amalgamated with the originality requirement, then the ‘purpose or intention requirement’ is overruled.⁹³ This is because the software, term and database directives all say that no other criterion can be applied apart from the author's own intellectual creation.⁹⁴ Another consequence is that at least UK unregistered design right (“UKUDR”) may become less interesting and eventually redundant as the protection requirement is lowered for artistic works which remain unregistered. This is because in most cases, it will be harder to prove that the UKUDR protection criterion namely SSJL and non-commonplaceness⁹⁵ is fulfilled than the author's own intellectual creation.⁹⁶

Second, a point of law established in *Interlego* may no longer be good law. In that case, the Privy Council held that since the essence of artistic works is visual significance, in the case of a derivative artistic work, the change must have visual significance for the new work to attract copyright.⁹⁷ The case has led some commentators to generalise this rule to all original works so that “to confer copyright, the skill and labour must produce a change which is relevant to the category of work in question”.⁹⁸ Can one infer this from the CJEU case law too? The CJEU has not yet pronounced itself on derivative works but why would the originality requirement be different? Nothing in the directives indicates it should be and probably it is not because the directives state clearly that no other criteria than the author's own intellectual creation is applicable. All that is required is that the author has made free and creative choices so as to imprint the work with his personal stamp. This formula does not require that the author of an artistic derivative work must add something visually significant. The same would apply for any derivative work, whether artistic, literary, dramatic, audiovisual or musical. However, since the CJEU has not yet had to hear a case about a derivative work, it will be interesting to see what it rules. And this will also impact at the level of infringement.⁹⁹

⁹² *Lucasfilm v Ainsworth* [2008] EWHC 1878 (Ch), *aff'd by* [2009] EWCA Civ 1328 and [2011] UKSC 39 (the issue was whether the helmet and armour of the stormtroopers in Star Wars films were protected by copyright). This requirement applies at least to sculptures and works of artistic craftsmanship. On this question, see Bently, above n 83.

⁹³ Derclaye, above n 63, 250. Similarly, Rosati, above n 27, 207.

⁹⁴ The term directive is the clearest in this regard as its recital 17 states that “no other criteria such as *merit* or *purpose* being taken into account. ». Recital 8 of the software directive states “Whereas, in respect of the criteria to be applied in determining whether or not a computer program is an original work, no tests as to the *qualitative* or *aesthetic merits* of the program should be applied”. Emphases added.

⁹⁵ S. 213(4) CDPA.

⁹⁶ See similarly Cook, above n 83, 86 (stating that it is ironic that the Cinderella of IPR now attracts far more protection via copyright and wondering whether the complex overlapping protections for design should not be repealed, the law only retaining copyright to protect designs).

⁹⁷ *Interlego A.G. v. Tyco Industries Inc. & Ors* [1988] 3 W.L.R. 678, 258, 263, 266.

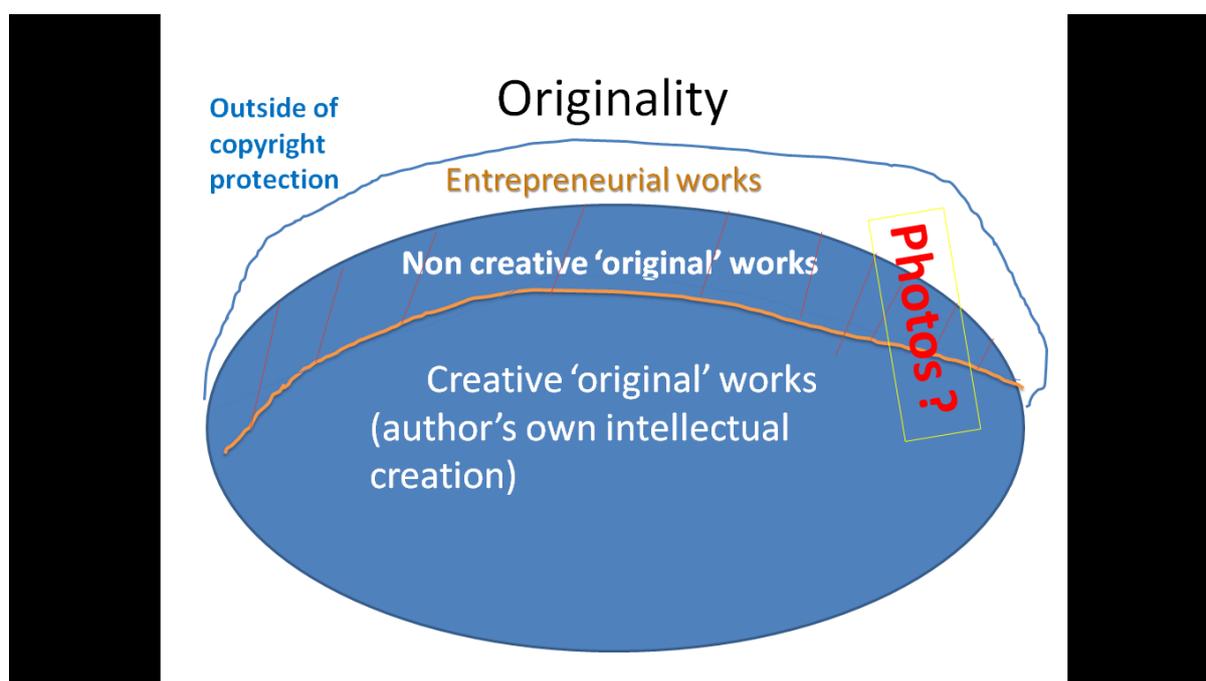
⁹⁸ Bently & Sherman, above n 12, 99.

⁹⁹ Griffiths 2013, above n 36, 788-789 hinting at this possibility in relation to infringement.

Third, if one accepts that the CJEU rulings have not abolished the categories, the CJEU case law poses a problem for non-original photographs in the UK. Indeed, there is only one category for photographs, and they must be original. What happens of the subcreative photographs? They cannot fall in any other category and therefore, must remain unprotected. This is so despite the possibility left in the term directive for Member States to protect them in some other way. On the other hand, if the CJEU case law has indeed abolished the categories, it still poses a problem for UK copyright law as it is not clear that Parliament had intended to protect unoriginal photos e.g. as entrepreneurial works.¹⁰⁰ So, for the sake of clarity and legal certainty, the UK legislature should change the act to make clear that either non-original photographs can be protected as entrepreneurial works, as Mr Justice Arnold suggested¹⁰¹, or can benefit from a type of protection other than copyright or remain unprotected altogether.

Finally, in relation to the test of infringement, the question is whether the judge-made rule that courts cannot dissect the work is still applicable.¹⁰² It may still be the case for altered copying rather than literal (exact) copying because in those cases the originality subsists in the way the entire work is arranged or created not in parts of it and we will need to wait for a CJEU case law that confirms this. But in case of literal copying, it seems that *Infopaq* allows dissection.

Figure 1: Originality before and after the CJEU case law



¹⁰⁰ The authors of Copinger, above n 36, 26, no. 3-144 do not think courts will protect uncreative photographs post-*Painer*. See also Rosati, above n 27, 198-199.

¹⁰¹ R. Arnold, "Copyright in Photographs: A Case for Reform" [2005] EIPR 303 and *ibid*, "Content copyrights and signal copyrights: the case for a rational scheme of protection" (2011) 1(3) Queen Mary Journal of Intellectual Property 272, 277.

¹⁰² *Ladbroke*, above n 11, 277; *Designers Guild v Russell Williams (Textiles)* [2001] FSR 11, paras 6, 19, 31 and 43; *Baigent v Random House Group* [2007] EWCA Civ 247, 131-132.

Caption: prior to *Infopaq* and its progeny, non creative ‘original’ works were protected via SSJL, now they are no longer protected. There are therefore fewer works protected now (as the orange line inside demarcates). The situation regarding entrepreneurial works has not changed. It was unclear how photographs were protected as a result of the non-implementation of the author's own intellectual creation in the act and the situation is still unclear after *Infopaq* although probably subcreative photographs now remain unprotected by copyright law altogether.

5. HOW THE BRITISH JUDGES APPLY THE COURT OF JUSTICE’S CASE LAW ON THE CONCEPTS OF WORK, ORIGINALITY AND THE TEST OF INFRINGEMENT

5.1. THE concept OF WORK

So far the UK courts have not done away with the categories.¹⁰³ In fact, while one judge simply mentioned the possibility that the CJEU case law implies a uniform open notion of work, another seems to have rejected the idea. In the *SAS* case on remand, Arnold J acknowledged the possibility that in the light of the CJEU case law, a work could be protected even if it does not fall within the categories set out at section 1(1) of the CDPA.¹⁰⁴ While recognising this possibility, he holds that it is clear that “the putative copyright work must be a literary or artistic work within the meaning of Article 2(1) of the Berne Convention” as per *Infopaq*.¹⁰⁵ He carries on and holds that while the list in article 2(1) of the convention is not exhaustive, it still has limits, for instance “it is conventionally understood not to include sound recordings or broadcasts”.¹⁰⁶ Finally, he disagrees that “because something is original (because it is an intellectual creation), it must consequently be a work”.¹⁰⁷ In so holding, Arnold J expresses no view as to whether the CJEU has done away with the UK categorisation system. He only expresses the view that not everything and anything can be a work and seems to reject the view that the CJEU has amalgamated the notion of originality with the notion of work. In *Moon*, in a shorter passage, Birss J seems to reject the proposition that the categories are abolished.¹⁰⁸

In our view, the judges are right to doubt that the CJEU’s intention was to abolish the categories as the decisions are not entirely clear on this issue and the Court has never been asked this precise question.

¹⁰³ See e.g. *Mitchell v BBC* [2011] EWPC 42, para 22; *Temple Island Collections v New English Teas* [2011] EWPC 21 (where the judge classifies the work as a photograph or alternatively as a collage); *Wilkinson v London Strategic Health Authority* [2012] EWPC 48 (referring to s. 1(1) and 3(1) of the act - original literary work); *Taylor v Maguire* [2013] EWHC 3804.

¹⁰⁴ *SAS Institute v World Programming* [2013] EWHC 69, para 27.

¹⁰⁵ *Ibid*, paras 32-37.

¹⁰⁶ *Ibid*. He already had expressed this view in *Dramatico* [2012] EWHC 268, para 62.

¹⁰⁷ Above n 104, para 34: “Counsel for SAS Institute argued that the SAS Language was an intellectual creation, and therefore it was a work. In my view that is a *non sequitur*. As counsel for WPL pointed out, there are many intellectual creations which are not works, such as scientific theories: see Ricketson and Ginsburg at pp. 406-407. An article or book describing a scientific theory is a literary work, but for the reasons explained above that is beside the point when it comes to the question of whether the scientific theory *per se* is a work. I would add that treating the scientific theory as a distinct work protectable by copyright would undermine the exclusion of the theory from protection by the copyright in the article or book mandated by Article 9(2) of TRIPS and Article 2 of the WIPO Copyright Treaty (...).”

¹⁰⁸ *Abraham Moon & Sons v Thornber et al* [2012] EWPC 37, paras 98-99. Birss J rejects the claimant’s argument based on *Infopaq* and *Painer* that there are no distinctions at infringement level between literary and artistic works.

5.2. ORIGINALITY

Since the CJEU decision in *Infopaq*, originality and infringement have been discussed in no less than 15 decisions in the High Court and Court of Appeal (“CA”). We list them in chronological order and with the name of the judge delivering the judgment:

2010: *Allen v Bloomsbury Publishing Plc and JK Rowling* (Kitchin J)¹⁰⁹; *Football Dataco v Britten Pools* (Floyd J)¹¹⁰; *SAS Institute v World Programming* (Arnold J)¹¹¹; *NLA v Meltwater* (Proudman J)¹¹²; *Football Dataco v Yahoo! UK* (CA per Jacob)¹¹³;
2011: *Future Publishing v Edge Interactive Media* (Proudman J)¹¹⁴; *NLA v Meltwater* (CA per The Chancellor of The High Court)¹¹⁵; *Forensic Telecommunications Services v The Chief Constable of West Yorkshire Police* (Arnold J)¹¹⁶; *Temple Island Collections v New English Teas* (Birss J)¹¹⁷; *Hodgson v Isaac* (Birss J)¹¹⁸;
2012: *Abraham Moon v Thornber* (Birss J)¹¹⁹;
2013: *SAS Institute v World Programming* on remand (Arnold J)¹²⁰; *Allen v Redshaw* (Recorder Michaels)¹²¹; *SAS Institute v World Programming* (CA per Lewison J)¹²² and *Suzu Taylor v Alison Maguire* (District Judge Clarke).¹²³

This case law is very unsettled. In short, judges are either unaware of the CJEU case law’s effect, confused or inconsistent. Indeed, some judges are simply unaware of the change that *Infopaq* and the later CJEU decisions have had on the concept of originality and infringement. This is the case of Michaels¹²⁴, Kitchin and Clarke JJ¹²⁵. On the other hand, Floyd J added his own twist to the author’s own intellectual creation criterion. For him, following *Infopaq*, the new originality criterion is “judgment, taste or discretion”.¹²⁶ The judge found the list of fixtures (a database) protected by copyright as it was not the result of mere labour but involved a lot of skill.¹²⁷ Granted, Floyd J did not have the insights from the

¹⁰⁹ *Paul Gregory Allen v Bloomsbury Publishing Plc and Joanne Kathleen Murray (professionally known as JK Rowling)* [2010] EWHC 2560 (whether Harry Potter books infringed the copyright in the book Willy the Wizard).

¹¹⁰ [2010] EWHC 841 (football fixtures).

¹¹¹ [2010] EWHC 1829 (computer program and manuals).

¹¹² *Newspaper Licensing Agency v Meltwater Holding* [2010] EWHC 3099 (Ch) (newspaper headlines).

¹¹³ [2010] EWCA Civ 1380.

¹¹⁴ [2011] EWHC 1489 (logo using a certain font to write the word EDGE for a computer gaming magazine called ‘Edge’. The logo can be seen at <http://www.edge-online.com/>).

¹¹⁵ [2011] EWCA Civ 890.

¹¹⁶ [2011] EWHC 2892 (list of numerical data).

¹¹⁷ Above n. 103 (black and white photograph of a London bus (coloured red) crossing Westminster bridge with the Houses of Parliament in the background).

¹¹⁸ [2010] EWPC 037 (Hodgson’s autobiography adapted by Isaac into a script for a film).

¹¹⁹ Above n 108. Artistic copyright in a woollen plaid upholstery fabric.

¹²⁰ Above n 104.

¹²¹ [2013] EWPC B1 (puppet show “Mr Spoon on Button Moon”).

¹²² Above n 56.

¹²³ Above n 103 (whether papercuts (graphic works) were original and infringed by the defendant).

¹²⁴ In *Allen v Redshaw*, the judge simply says that the requirement of originality for all artistic works is low. This is wrong both pre- and post-*Infopaq*.

¹²⁵ Clarke J not only breaches *Infopaq* but also *Painer* when he utters at para 8: “For an artistic work to be original it must have been produced as the result of independent skill and labour by the artist. The greater the level of originality in the work the higher the effective level of protection is, because it is the originality which is the subject of copyright protection.” Nowhere in the judgement does he rely on any of the CJEU judgments.

¹²⁶ Paras 86-87, 91.

¹²⁷ Para 41, 43.

following CJEU decisions (free and creative choices, personal touch) to rely on and was navigating rather in the dark. Mrs Justice Proudman has been inconsistent in the two cases she has had to decide namely *Meltwater* and *Edge*. First, in *Meltwater*, she held that *Infopaq* had changed the case law and she applied the new requirement of the author's own intellectual creation¹²⁸ but then she did not even cite the case when deciding *Edge*; on the contrary, she relied only on *Ladbroke* to hold that the work was original.¹²⁹ As to the Chancellor of the High Court, who delivered the judgment in the appeal of *Meltwater*, he confidently and clearly equates the two requirements. For him, *Infopaq* does not change the previous case law.¹³⁰ In the appeal in *Football Dataco*, Jacob J was more prudent. For him, it was not clear that the two requirements are equivalent and he preferred to ask questions to the CJEU. The following is known; in the *Football Dataco* case, the CJEU confirmed that the two requirements are different. It is therefore strange that Lewison J does not acknowledge this in the *SAS* case on remand. He held that “This test *may not* be quite the same as the traditional test in English law” and “[i]f the Information Society Directive has changed the traditional domestic test, it seems to me that it has raised rather than lowered the hurdle to obtaining copyright protection.”¹³¹ (emphases added). Nevertheless, he acknowledges that if this is the case, the author's own intellectual creation is a higher threshold than the SSJL.¹³²

To make matters worse, over the years, both Arnold and Birss JJ have quoted the two requirements together in their judgments without stating their relationship, probably assimilating one with the other.¹³³ Arguably, sometimes applying one or the other would have made no difference as the works were clearly creative (e.g. *SAS*, *Moon*). However, in his latest decision on the issue¹³⁴, Arnold J does not use the SSJL test any longer but only the author's own intellectual creation, perhaps showing an acceptance that the SSJL is now clearly dead.¹³⁵ It is a pity though that the latest case of the Court of Appeal (*SAS*) does not make entirely clear that SSJL and author's own intellectual creation are clearly different tests as is clear from the CJEU decision in *Football Dataco*. A shadow of doubt thus still lingers in the Court of Appeal which does not fare well for the future UK case law on originality, in view of the confusion in the lower courts.

Courts have not applied the new originality requirement to works of artistic craftsmanship. In the last case to date, in appeal, Lucasfilm abandoned its alternative contention that the Starwars stormtrooper helmet qualified as a work of artistic craftsmanship in addition to a

¹²⁸ Paras 71, 78.

¹²⁹ Para 10: “Dr Langdell submitted that the claimant can have no copyright in its EDGE logo because it is not original over the Franklin Gothic typeface. I do not accept this submission. The stretching of the font was combined with the distinctive slash and projection on the middle bar of the “E”. What is required for artistic originality is the expenditure of more than negligible or trivial effort or relevant skill in the creation of the work; see Copinger and Skone James on Copyright, 16th edn, at 3-130 and *Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1 W.L.R. 273 at 287. The claimant’s logo is original within this test”.

¹³⁰ Para 20: “I do not understand the decision of the European Court of Justice in *Infopaq* to have qualified the long standing test established by the authorities referred to in paragraph 19 above.” In para 19, he refers to *University of London Press*, above n 10 and *Ladbroke*, above n 11.

¹³¹ *SAS*, above n 56, paras 36-37.

¹³² See also *ibid*, para 65.

¹³³ See e.g. *Forensic Telecom*, paras 84 and 91; *SAS*, above n 111, paras 57, 64, 129, 207, 233, 249, 255, 258-261, 263, 322; *Temple Island Collections*, paras 27, 51 and 53 (the equivalence between the two requirements is also noted by Synodinou, above n 27, 102-103 and Rosati, above n 27, 195); then at para 68 he only uses the old test; *Moon*, para 56. However in *Hogdson*, at para 80, Birss J uses the term intellectual effort for the originality test, although he uses author's own intellectual creation for the test of infringement.

¹³⁴ *SAS*, above n 120.

¹³⁵ E. Derclaye, “Football Dataco: Skill and labour is dead!”, 2012, <http://kluwercopyrightblog.com/2012/03/01/football-dataco-skill-and-labour-is-dead>

sculpture.¹³⁶ There have been no new cases dealing with works of artistic craftsmanship since. Therefore, we do not yet know if the courts will apply the author's own intellectual creation to works of artistic craftsmanship which are not also registered as designs.

5.3. THE TEST OF INFRINGEMENT

The confusion is slightly less pronounced at the level of the infringement test. Taking the cases more or less chronologically again, in *Allen v Bloomsbury Publishing Plc and JK Rowling*, Kitchin J does not even mention *Infopaq*; he thinks it is only necessary to apply *Baigent* to decide infringement.¹³⁷ Since only ideas were taken¹³⁸, applying the *Infopaq* test would not have made a difference in that particular case. On the other hand, Arnold J in his first *SAS* decision clearly states that the test of substantial part is now dictated by *Infopaq* and UK courts have to examine whether the part taken incorporates the author's own intellectual creation.¹³⁹ However, despite this clear statement, he then mixes the SSJL with the author's own intellectual creation when he decides infringement.¹⁴⁰ This is unfortunate as it is unclear whether he thinks that the two are equivalent. In *Forensic Telecom* however, Arnold J does not use SSJL when he discusses infringement and clearly expresses that taking a substantial part means taking the author's own intellectual creation.¹⁴¹ He does the same in *SAS* on remand.¹⁴² Mrs Justice Proudman was also clear in *NLA v Meltwater*. She acknowledges that the test is the author's own intellectual creation and applies it, also noting that it would not in the case before her make a difference if one had applied the old substantial part/SSJL test.¹⁴³ However, the Court of Appeal in the same case does not apply the *Infopaq* test at the level of infringement but simply refers to the substantial part test.¹⁴⁴ In *Temple Island Collections*, Birss J dealt with an artistic work (photograph) and relied not only on *Infopaq* but also *Interlego*.¹⁴⁵ "In order to decide if a substantial part of an artistic work has been reproduced", the court must look at the "elements of the work which have visual significance".¹⁴⁶ All he seems to be saying is that pre-expressive stages do not count, what counts is the result you see. If the implication of the application of *Interlego* is just that then it is in line with *Football Dataco* (which admittedly was decided after *Temple Island Collections*) and does not add to the CJEU case law. However, as we mentioned in section 4.2.2, applying *Interlego*'s visual significance test further could be contrary to the author's own intellectual creation test. In *Hodgson*, Birss J, like Arnold J, clearly states that "[a] substantial part must be one in which the elements thus reproduced are the expression of the intellectual creation of their author

¹³⁶ *Lucasfilm*, above n 92.

¹³⁷ Para 80.

¹³⁸ *Ibid*, para 86.

¹³⁹ *SAS*, above n 111, para 243.

¹⁴⁰ *Ibid*, para 260. See also paras 319 and 322.

¹⁴¹ Para 107.

¹⁴² Para 46.

¹⁴³ Paras 69 and 85.

¹⁴⁴ Para 28.

¹⁴⁵ *Temple Island Collections*, paras 33-34.

¹⁴⁶ *Ibid*, paras 34-35 ("Visual significance must also be relevant to infringement and to the question of whether a substantial part of an artistic work has been taken. What falls to be considered, in order to decide if a substantial part of an artistic work has been reproduced, are elements of the work which have visual significance. What is visually significant in an artistic work is not the skill and labour (or intellectual creative effort) which led up to the work, it is the product of that activity. The fact that the artist may have used commonplace techniques to produce his work is not the issue. What is important is that he or she has used them under the guidance of their own aesthetic sense to create the visual effect in question. Just because the Act provides for copyright in these original artistic works irrespective of their artistic quality (s4(1)(a)), does not mean that one ignores what they look like and focuses only on the work which went into creating them").

(*Infopaq*).”¹⁴⁷ While in the most recent decision of the Court of Appeal, Lewison J clearly affirms, like Birss and Arnold JJ, that the infringement test is now whether the defendant took a part which reflects the author's own intellectual creation¹⁴⁸, the most recent case from the High Court does not even mention any CJEU case law and simply applies the old law.¹⁴⁹ Omitting the CJEU case law lead the High Court to imply that the degree of originality of a work could have an impact on the scope of protection, something *Painer* has now ruled out.¹⁵⁰

Some judges also tend to think that the test of infringement has remained a qualitative test after *Infopaq*. This is correct if by that one means that the part taken is the one which is original i.e. reflecting the author's own intellectual creation. This also seems to be what the judges mean.¹⁵¹

To wrap up on the infringement test, notwithstanding the hick-up in the *Taylor* case, the UK case law post-*Infopaq* is getting gradually more settled, with the Court of Appeal decision in *SAS* seemingly overturning its previous unclear decision in *Meltwater* on this point.¹⁵²

5.4. CONCLUSION

In conclusion, as we already had predicted¹⁵³, the new criterion of author's own intellectual creation made a difference in many cases concerning borderline works namely *Football Dataco*¹⁵⁴, *Forensic Telecom*¹⁵⁵, *Meltwater*¹⁵⁶, *SAS*¹⁵⁷ or could have made a difference if it has been applied in *Edge*. So it is important to apply the correct test and not mix the old and the new tests, whether at the level of originality or infringement. It is dangerous that British courts use old requirements and equate them simply to the new ones. Sometimes it will not matter as the work is clearly creative but sometimes it will; so it is best to drop the old test altogether and only use the new one to avoid confusion and incorrect decisions.

¹⁴⁷ *Hodgson*, para. 74.

¹⁴⁸ *SAS*, above n 120, paras 38-39.

¹⁴⁹ *Taylor v Maguire*, above n 103, para 10.

¹⁵⁰ *Ibid*, para 8: “The greater the level of originality in the work the higher the effective level of protection is, because it is the originality which is the subject of copyright protection.”

¹⁵¹ See *NLA v Meltwater*, above n 112, para 81; *Hodgson* (Birss J), para 74 “In the end the test for substantiality is a matter of quality and not quantity. A substantial part must be one in which the elements thus reproduced are the expression of the intellectual creation of their author (*Infopaq*)” and para 78 “The issue in *Infopaq* terms is whether the elements taken from Flipper’s Side are the expression of the intellectual creation of their author? This must be a qualitative test under the *Infopaq* approach just as it was before *Infopaq*”. *Contra*: Griffiths 2013 above n 36, 787 (the infringement tests in the UK and *Infopaq* are different in the sense that “Under the terms of the CDPA 1988, an infringement is committed whenever a defendant commits an act restricted by copyright in relation to the work as a whole or in relation to any ‘substantial part’ of that work. No liability arises in relation to the reproduction of an ‘insubstantial’ part of a work (*even where that part embodies elements of the labour and skill or originality of the work*)”). Emphasis added.

¹⁵² Strangely though, the Court of Appeal cites *Meltwater* with approval (para 38).

¹⁵³ Derclaye, above n 63, 249.

¹⁵⁴ The CJEU reversed the finding of the High Court that the football fixture was protected by copyright.

¹⁵⁵ In this case, Arnold J rejects copyright for a database because it is not its author's own intellectual creation (para 90).

¹⁵⁶ Many headlines would not have passed the *de minimis* test for literary works. See above discussion and the rulings in *Francis Day* and *Exxon*, section 4.2.1.

¹⁵⁷ The High Court and Court of Appeal may well have found (parts of) *SAS*'s software protected under the SSJL.

What else should British, and for that matter Irish, judges do? As per the analysis in this section, they should think carefully which UK precedents are still valid and not assume that they are. In relation to the categorisation system, no one can reasonably claim now that it is clear that an original work not falling in a category is per se unprotectable. If a work does not fall in the categories, British and Irish judges should stay proceedings and ask a question to the CJEU to clarify the matter. Even if the Court's answer may annihilate the categories, it is for the sake of legal certainty of both authors and users. Also if we retain the categories, we give our works less protection than our continental counterparts give theirs. British judges have not been shy in referring matters to the CJEU.¹⁵⁸ It is thus likely that they will carry on doing so to push the Court to clarify its case law. However, national courts must be careful what they wish for because of the CJEU's harmonisation bias.¹⁵⁹

6. Conclusion - WHAT DOES THE FUTURE HOLD?

What one can conclude from the above analysis with certainty is that the Court's decisions have had a rather drastic impact on the UK concepts of work, originality and the test of infringement. Whereas it is now clear that the author's own intellectual creation is higher than the SSJL¹⁶⁰, the current state of the law is uncertain in relation to the categorisation system, the fixation requirement and to a lesser extent in relation to the infringement test. The same goes for other notions not examined in this article for reasons of space such as the adoption of the merger doctrine in *BSA*¹⁶¹ (a concept previously rejected in the UK¹⁶²), the possible absorption of the right adaptation into the right of reproduction¹⁶³ and the now possibly outdated liberal approach to the exceptions that the UK courts used to take.¹⁶⁴ So while it is not clear yet that the CJEU has simplified UK copyright law as elegantly proposed by Christie over a decade ago¹⁶⁵, leaving aside the questionable methods the Court uses to reach its rulings, undeniably "a European consensus on the concept of work and originality is [...] both inevitable and desirable".¹⁶⁶

It is also worth noting that commentators in the UK have sometimes tended to think that the CJEU used the civil law notions of authors' rights laws to interpret the provisions of

¹⁵⁸ UK courts asked the preliminary questions in three out of seven cases in the areas of copyright law reviewed in this article, more than any other Member State: Kitchin J in *FAPL*, Jacob J in *Football Dataco* and Arnold J in *SAS*.

¹⁵⁹ More on this in section 6.

¹⁶⁰ Whether the author's own intellectual creation is the 'continental test' (if such a thing exists) or not is not important as far as the UK is concerned (Rosati, above n 27, 156 notes that the personal touch in the *Painer* judgment "confirms how deeply bound the recent CJEU jurisprudence is to continental (in particular, French and German) copyright traditions."), what matters is that it is higher than SSJL.

¹⁶¹ *BSA*, para 48. Derclaye, above n 36, 60; Synodinou, above n 27, 101.

¹⁶² *Ibcos Computers v. Barclays Mercantile Highland Finance* [1994] FSR 275, 292, 301.

¹⁶³ A. Ohly, "Economic Rights" in Estelle Derclaye (ed.), *Research Handbook on the Future of EU Copyright*, Elgar, 2009, 212, 218; Bently, above n 83, 668; J. Griffiths, "The Role of the Court of Justice in the Development of European Union Copyright Law", in I. Stamatoudi & P. Torremans, *EU Copyright Law, A Commentary*, Elgar, 2014, no 20.16, citing *SAS*, above n 45, paras 63-70.

¹⁶⁴ See e.g. the broad interpretation of the terms 'criticism' in *Pro Sieben Media AG v Carlton UK TV* [1999] FSR 610, 620 and *Fraser-Woodward Ltd v BBC* [2005] EWHC 472, 'current' in *Hyde Park Residence v Yelland* [2000] 3 WLR 215, and 'event' in *Pro Sieben*, *ibid*, 625.

¹⁶⁵ A. Christie, "A Proposal for Simplifying United Kingdom Copyright Law" [2011] *Intellectual Property Quarterly* 26, 40 who proposes a consolidation of the categories and a corresponding harmonisation of exclusive rights.

¹⁶⁶ Bently, n 36 above.

directives.¹⁶⁷ This may lead to believe that the case law has no impact in those countries. However, a quick look at the literature reviewing the impact of the CJEU case law in some of these Member States shows that the CJEU decisions also impact civil law countries, even in Member States the least impacted so far such as France, and sometimes in rather drastic ways too. There is no space in this article to discuss some examples, but the reader can be referred to the literature.¹⁶⁸ This analysis shows that the CJEU case law is affecting both civil law and common law systems and developing a truly ‘*communautaire* copyright’, in other words, new notions based neither on civil law nor on common law concepts.

As will be explained in detail in a forthcoming article¹⁶⁹, while consensus on many copyright notions is desirable not the least for legal certainty, its date of birth is not very predictable. This is because the Court has used a high number of interpretation methods rather inconsistently. This makes it hard to speculate on the future direction of its case law. In view of the inevitably piecemeal harmonisation work the Court can achieve and of its often unclear case law, it is evident that more legislative harmonisation is needed¹⁷⁰, or even simply legislative intervention (i.e. clearly stating no harmonisation is required in some areas). Indeed, if anything, this state of affairs should incentivise the Commission to take the initiative to harmonise more or the EU institutions to clearly state in legislation that some areas are not harmonised to avoid the Court’s application of the principle of autonomous and uniform notion of EU law. Judicial harmonisation is inevitable but reversible. In the meantime, the dialogue between the national courts and the CJEU can carry on.¹⁷¹ And it is not and does not have to be just one way. As the decision in *SAS* on remand has shown, the national court can give hints to the CJEU about its concern over certain unclear aspects of its rulings.¹⁷² The dialogue can also occur between academics and the Court, and not just via conferences and writings¹⁷³ but face-to-face meetings.¹⁷⁴ How the CJEU case law in the field of copyright will develop can also be studied more effectively by political scientists, who in

¹⁶⁷ E.g. Rosati, above n 27, 156.

¹⁶⁸ See e.g. Van Eechoud, above n 24, 69; H. Bengtsson, “EU harmonisation of the copyright originality criterion”, Delphi, 2012, available at <http://www.worldservicesgroup.com/publications.asp?action=article&artid=4597>; V.-L. Benabou, « Retour sur dix ans de jurisprudence de la Cour de Justice de l’Union Européenne en matière de propriété littéraire et artistique : les méthodes » [2012] 43 *Propriétés Intellectuelles*, 140, 148; Benabou, above n 44 and references cited in all these articles.

¹⁶⁹ E. Derclaye, “The Court of Justice Copyright Case Law: Quo Vadis?” [2014] *EIPR* 716-723.

¹⁷⁰ A. Lucas, ‘La longue route vers l’harmonisation du droit d’auteur. Analyse critique’, in M.-C. Janssens & G. Van Overwalle (eds), *Harmonisation of European intellectual property law: From European rules to Belgian law and practice, Contributions in Honour of Frank Gotzen*, Bruylant/Larcier, 2012, p. 19, 28.

¹⁷¹ Bently, above n 83, n 173 quoting Mummery LJ in *Laboratoires Goemar SA v La Mer Technologies* [2005] EWCA Civ 978, para 17: “[the Court of Justice’s] judgments are part of a continuing conversation between the Court of Justice and national courts. The legal learning generated by this process flows, after the fashion of a roman fleuve, from the Court of Justice into the national courts of Member States.”

¹⁷² Above n 104, paras 27 and 34.

¹⁷³ See for instance the questions that van Eechoud, above n 24, 77 has suggested that intellectual property scholars could answer. See also G. Beck, *The Legal Reasoning of the Court of Justice of the EU*, Hart Publishing, 2012.

¹⁷⁴ The aim of the project of P. Torremans, M. Kretschmer and M. Favale “Is there an EU copyright jurisprudence? An empirical analysis of the copyright case law”, is to help predict the direction of the CJEU case law in the field of copyright. The authors are examining, among others, how the background of the advocates general and judges (mainly EU and international lawyers) influence the CJEU copyright case law. The authors also project a conference with academics and the Court’s staff.

fact have already started analysing the Court's behaviour for several years now¹⁷⁵ or even interdisciplinarily.

That said the CJEU's harmonising judgments do not always achieve their aim. It has been slow in the UK but finally, five years on, the UK courts seem to have integrated the new notion of originality. But it is not always the case. In Sweden, in cases arising post-*Infopaq*, many courts have carried on applying the Swedish originality requirement with no reference to the CJEU decisions.¹⁷⁶ It would be interesting to discover what the situation is in other Member States. No doubt such research, and further dialogue between all interested parties, will eventually lead to that Graal of legal certainty copyright academics and practitioners are aspiring for and even to European consensus on such important notions of copyright law.

¹⁷⁵ E.g. K. Alter, "Who Are the Masters of the Treaty?" [1998] 52(1) *International Organization*, p. 121-147 and *ibid*, "The European Union's Legal System and Domestic Policy: Spillover or Backlash?" [2000] 54 *Int Org* 489.

¹⁷⁶ Bengtsson, above n 168, and cases cited therein.