

**FEIST GOES GLOBAL: A COMPARATIVE ANALYSIS OF THE NOTION OF ORIGINALITY IN COPYRIGHT LAW**

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What is originality? To see something that is yet without a name, that is yet impossible to designate, even though it stares you in the face.

(Friedrich Nietzsche)

INTRODUCTION

The U.S. Supreme Court decision in *Feist Publications v. Rural Telephone Service Company, Inc.*<sup>1</sup> delivered in March 1991 was hailed both as a landmark decision<sup>2</sup> and a legal "bomb."<sup>3</sup> It was said the Court had gone

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<sup>1</sup> 499 U.S. 340 (1991).

<sup>2</sup> See, e.g., Tracy Lea Meade, *Ex-Post Feist: Applications Of A Landmark Copyright Decision*, 2 J. INTELL. PROP. L. 245 (1994).

<sup>3</sup> An expression used by former Register of Copyrights, Ralph Oman, in his testimony before the House of Representatives, quoted in Paul Goldstein, *Copyright*, 38 J. COPYR. SOC'Y 109,188 (1991).

out on a limb.<sup>4</sup> Was Feist so original as to deserve all the attention? After all, it did not establish a new originality paradigm as such but only ended a long division among federal circuits concerning the protection under copyright of factual compilations. A number of circuits had adopted a test similar to the one articulated in Feist (i.e., based on creative selection), while others required only evidence of labor, a test known as "sweat of the brow."<sup>5</sup>

In reality, Feist did much more than resolve a definitional tension: it determined that there was a constitutional requirement of creativity.<sup>6</sup> Not surprisingly, the decision was almost immediately perceived in eschatological terms by the U.S. database industry: the sky had fallen; their business base would soon wither away;<sup>7</sup> piracy would be free to flourish on the high seas of the database industry.<sup>8</sup> In sum, factual compilations would no longer be protected and without adequate protection, investments necessary

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<sup>4</sup> See Marci Hamilton, Justice O'Connor's Opinion in Feist Publications, Inc. v. Rural Telephone Service Co.: An Uncommon Though Characteristic Approach, 38 J. COPYR. SOC'Y 83, 88.

<sup>5</sup> See *id.* at 245-46; Denise R. Polivy, Feist Applied: Imagination Protects, But Perspiration Persists -- The Bases Of Copyright Protection For Factual Compilations, 8 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 773, 780-81 (1998); and Jennifer R. Dowd, A Selective View Of History: Feist Publications, Inc. v. Rural Telephone Service Co., 34 B.C. L. REV. 137, 138-39 (1992).

<sup>6</sup> Feist, 499 U.S. at 347-51. It was said the Court melded the notions of originality and creativity. See Justin Hughes, The Personality Interest Of Artists And Inventors In Intellectual Property, 16 CARDOZO ARTS & ENT. L.J. 81, 99-100 (1998). In other cases, originality was defined as comprising both creativity and the absence of copying. This is not incorrect but does not change our analysis. See, e.g., Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n, 805 F.2d 663, 668 n.6 (7th Cir. 1986).

<sup>7</sup> "[V]ast amounts of information have been ejected into the public domain, with resulting implications to all businesses for which the amassing or distribution of information is essential." S. Leigh Fulwood, Feist v. Rural: Did The Supreme Court Give License To Reap Where One Has Not Sown?, COMM. LAW., Fall 1991, at 15, 19. See also Jessica Litman, After Feist, 17 U. DAYTON L. REV. 607, 608 (1992). Contra, Paul T. Sheils & Robert Panchina, What's All The Fuss About Feist? The Sky Is Not Falling On The Intellectual Property Rights Of Online Database Proprietors, 17 U. DAYTON L. REV. 563 (1992).

<sup>8</sup> See Daniel Davis, Feist Publications, Inc. v. Rural Telephone Service Co.: Opening The Door To Information Pirates?, 36 ST. LOUIS U. L.J. 439, 440 (1992) ("This broad holding [in Feist] affects the economic feasibility of producing any commercially saleable factual compilation, whether as a printed directory or as an automated database service, such as LEXIS, WESTLAW, Prodigy or Compuserve.").

for the creation and maintenance of databases would dry up.<sup>9</sup> It seems that the end of the world has been postponed.<sup>10</sup>

The purpose of this article is not to analyse whether Feist was correctly decided, but rather to show that a Feist-like standard is now applied or may soon emerge in key common law countries. Moreover, in a move that may bridge the gap between the two major systems of copyright,<sup>11</sup> we will demonstrate that civil law systems have also adopted a similar doctrine.

In Part I, after putting Feist in a historical perspective that will show it was not a revolutionary decision (by U.S. copyright law standards), we will analyze Feist's "international progeny" in common law jurisdictions. In Part II, we will compare the Feist standard of originality with the standard now applied in a number of civil law countries, and demonstrate that there is a global emerging standard that narrows the gap between civil and common law-based copyright systems. In Part III, we will look at applicable international treaties, notably the Berne Convention<sup>12</sup> and the TRIPs Agreement,<sup>13</sup> to see whether they contain definitional elements we can use to build an international notion of "originality." Finally, Part IV contains an assessment and synthesis of the previous parts, establishes the central role of originality, and proposes a definition of originality's core that may bridge the gap between the major legal systems and greatly facilitate the application of the Feist notion of originality.

## I. ORIGINALITY IN COMMON LAW SYSTEMS

### A. United States

#### 1. Feist Teachings on the Notion of Originality

Commenting on Feist, Jane Ginsburg opined that U.S. copyright has never excluded author-oriented personality notions of copyright and, in

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<sup>9</sup> See *id.*

<sup>10</sup> One of several recent examples is the announcement by Sybase, Inc., a major provider of database software, of significant revenue growth in spite of a recession that hit technology companies especially hard. See Marie McInerney, *Sybase on Track for 2002 Estimates; Seeking Buys*, NEWS.COM, Feb. 27, 2002, available at <http://news.cnet.com/investor/news/newsitem/0-9900-1028-8932880-0.html>.

<sup>11</sup> See Jane Ginsburg, *A Tale of Two Copyrights: Literary Property in Evolutionary France and America*, 64 TUL. L. REV. 991, 1006-14 (1990).

<sup>12</sup> Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, as last revised at Paris, July 24, 1971, S. TREATY DOC. NO. 99-27 (1986) [hereinafter *Berne Convention*].

<sup>13</sup> Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakech Agreement Establishing the World Trade Organization, Annex 1C, Legal Instruments: Results of the Uruguay Round, v. 31; 33 I.L.M. 1197 (1994) [hereinafter *TRIPs Agreement*].

fact, that when the Supreme Court rendered its decision in this telephone directory controversy, most of U.S. copyright rested on a "subjective" conception of originality, with a special, arguably anomalous, reserve of sweat of the brow copyright for directories and similar fact-intensive, personality-deprived work.<sup>14</sup> It is true that the Second, Fifth, Ninth and Eleventh Circuits had espoused a "creative selection" theory, which required an author to show a small amount of creativity in order to receive copyright protection.<sup>15</sup>

The Feist court found that creative choices in the selection and arrangement of the data were necessary to generate sufficient originality to warrant copyright protection.<sup>16</sup> This reasoning echoes earlier Supreme Court cases dealing with photographs.<sup>17</sup> In *Burrow-Giles*,<sup>18</sup> the Court had

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<sup>14</sup> Jane C. Ginsburg, No "Sweat"? Copyright and Other Protection of Works of Information After *Feist v. Rural Telephone*, 92 COLUM. L. REV. 338, 339 (1992). Contra Marci Hamilton, Copyright At The Supreme Court: A Jurisprudence Of Deference, 47 J. COPYR. SOC'Y 317, 326 (2000).

<sup>15</sup> Meade, supra note 2, at 245.

<sup>16</sup> "Factual compilations, on the other hand, may possess the requisite originality. The compilation author typically chooses which facts to include, in what order to place them, and how to arrange the collected data so that they may be used effectively by readers. These choices as to selection and arrangement, so long as they are made independently by the compiler and entail a minimal degree of creativity, are sufficiently original that Congress may protect such compilations through the copyright laws." *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 348 (1991) (emphasis added). See also Alan Durham, Speaking of the World: Fact, Opinion and the Originality Standard of Copyright, 33 ARIZ. ST. L.J. 791, 794-95 (2001), where an accurate distinction is drawn between such choices and "discovery" choices ("In factual works--works that describe aspects of the world in which we live--'creation' generally includes the author's choice of language, arrangement of materials, and selection of materials to include or exclude. These are choices made at the author's discretion. They are not imposed by an order found in the world, but reflect the author's judgment as to how and what to communicate to his audience. Together, these choices produce the kind of original 'expression' traditionally protected by copyright. 'Discovery' includes any information about the world communicated through the medium of the author's expression. Sometimes that information is 'original' in the sense that it has never been communicated before, but it is not 'original' in the sense that the author made it. If the information is accurate, the author found it. Such information, according to Feist, belongs to the public.").

<sup>17</sup> *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 60 (1884); *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250-51 (1903). Several lower courts adopted a similar approach. See, e.g., *Falk v. Brett Lithographing Co.*, 48 F. 678, 679 (C.C.N.Y. 1891); *Gentieu v. John Muller & Co., Inc.*, 712 F. Supp. 740, 742-44 (W.D. Mo. 1989). See also Patricia L. Baade, Photographer's Rights: Case For Sufficient Originality Test In Copyright Law, 30 J. MARSHALL L. REV. 149, 150-53 (1996).

<sup>18</sup> See previous note.

to decide whether a photograph of Oscar Wilde was original. In concluding in the affirmative, the Court noted the creative choices made by the photographer, including pose, costume, lighting, accessories and the set itself.<sup>19</sup>

The main reason why the circuits were split among between the two main doctrines prior to Feist<sup>20</sup> is that there are two principal justifications -- and, therefore, bases -- for copyright protection: either it is a reward/incentive of the effort or investment made, or a reward/incentive for adding to the pool of creative works available to the "public." In other words, in the United States, copyright is not and was not, contrary to what may have been the case in post-revolutionary France,<sup>21</sup> a natural right of the author which somehow follows from the outpouring of the author's creative soul. Copyright should be viewed as a contract between society and the author consonant with the Constitutional objective of promotion of science and the useful arts.<sup>22</sup> This "contractual" aspect of the social contract between authors and the public is well documented.<sup>23</sup>

The question before the Supreme Court, therefore, was what should be rewarded: mere work (and, perhaps, investment) or creativity. The Court clearly found that creativity was required by the Constitutional

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<sup>19</sup> Id. See also COPYRIGHT AND PHOTOGRAPHS: AN INTERNATIONAL SURVEY 305-06 (Ysolde Gendreau et al. eds., 1999). One could also mention the Trade-Mark Cases, 100 U.S. 82, 94 (1879), in which the Court found that a work of authorship must evidence the "creative powers of the mind."

<sup>20</sup> See supra note 5.

<sup>21</sup> See Cécile Bougeard, Les racines du droit d'auteur, in I., LE DROIT D'AUTEUR AUJOURD'HUI 7 (De Lamberterie ed., 1991); and Jane Ginsburg, Histoire de deux droits d'auteur: la propriété littéraire et artistique dans la France et l'Amérique révolutionnaire, 147 REV. INT'L. DROIT D'AUTEUR 124 (1991).

<sup>22</sup> U.S. Const. art. 1, § 8, cl. 8. The theories justifying society's justification vary greatly. A fairly common one in common law jurisdictions is inspired by Lockean, property-based views. A rent-theory version of the Lockean model is also worth mentioning in this context. See R. Anthony Reese, Reflections On The Intellectual Commons: Two Perspectives On Copyright Duration And Reversion, 47 Stan. L. Rev. 707, 708 (1995). A commentator noted that the Supreme Court had mostly deferred to Congress on this point, though it made it clear that copyright was based on positive law, not natural law. See Marci Hamilton, Copyright At The Supreme Court: A Jurisprudence Of Deference, 47 J. Copyr. Soc'y 317, 323-24 (2000).

<sup>23</sup> See Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 348-50 (1991). The contract analogy is helpful but should not be overexploited. In economic terms, while contracts may replace to a certain extent intellectual property rights, those rights are necessary to allow authors and inventors to "fence off" their creations and inventions. See Ejan Mackaay, The Share of Sharing, in THE COMMODIFICATION OF INFORMATION (Neil Netanel et al. eds., 2001).

clause and was the (only) appropriate basis for copyright protection.<sup>24</sup> The Court brought compilations on the same footing as other categories of copyrighted works,<sup>25</sup> and clarified the delineation between copyright (and its underlying policy objectives, namely a reward for the sake of incentivizing creation<sup>26</sup>) and misappropriation, which tends to protect investment unduly appropriated.<sup>27</sup>

## 2. The Impact of Feist on Originality in the U.S.

Is there a Feist ghost in the copyright machine? Feist did not purport to create a new standard of originality; instead, it restated a well-known standard, already described albeit not as "clearly" in *Burrow-Giles Lithographic Co. v. Sarony*<sup>28</sup> and the Trademark Cases.<sup>29</sup> In fact, as we have seen, the creative selection standard was already applied in at least three circuits.<sup>30</sup> The legislative history of the 1976 Copyright Act shows that originality is required and involves something other than ingenious and

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<sup>24</sup> See supra note 6 and accompanying text.

<sup>25</sup> See supra note 14 and accompanying text.

<sup>26</sup> See Jessica Litman, *Revising Copyright Law For The Information Age*, 75 OR. L. REV. 19, 28-29 (1997).

<sup>27</sup> In *International News Service v. Associated Press*, 248 U.S. 215, 243-45 (1918), the Supreme Court affirmed an injunction which prohibited INS from selling, in competition with the Associated Press ("AP"), news which INS had copied from AP. Generally, under the doctrine which emerged from the INS case, a cause of action for misappropriation arises when (1) a plaintiff has invested substantial time and money to develop a "property"; (2) a defendant has appropriated the property at little or no cost; and (3) the plaintiff has been injured by the defendant's conduct. The INS case has been interpreted narrowly, and it is unclear to what extent how misappropriation claims survived copyright preemption (see *National Basketball Ass'n v. Motorola, Inc.*, 105 F.3d 841, 852, 853 (2d Cir. 1997) and *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 151, 156-57 (1989)); *Sheils & Penchina*, supra note 7, at 579). Conceptually, however, the purpose of misappropriation is to "impose liability methods of competition that undermine rather than advance the competitive process," *Restatement (Third) of Unfair Competition* § 38 cmt. A (1995). Protecting investments to allow the market to function would seem to meet the same objective.

<sup>28</sup> 111 U.S. 53 (1884). Copyright was described as applying to "original intellectual conceptions of the author," who was characterized as "he to whom anything owes its origin; originator; maker." *Id.* at 58.

<sup>29</sup> 100 U.S. 82 (1879) ("it is only such as are original, and are founded in the creative powers of the mind. The writings which are to be protected are the fruits of intellectual labor, embodied in the form of books, prints, engravings, and the like.") *Id.* at 94. See also Polivy, supra note 5, at 792-93.

<sup>30</sup> See supra note 15 and accompanying text; and *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 347 (1991) ("The originality requirement articulated in *The Trade-Mark Cases* and *Burrow-Giles* remains the touchstone of copyright protection today."). See also Joseph P. Hart, *From Facts to Form: Extension and Application of the Feist "Practical Inevitability" Test and Creativity Standard*, 22 GOLDEN GATE U. L. REV. 549, 553 (1992).

novel material.<sup>31</sup> Prior to 1976, it was not mentioned in the Act but was nonetheless required for copyright protection.<sup>32</sup>

Many appellate cases since *Feist* have tried to pinpoint the location of the creativity threshold articulated in *Feist*.<sup>33</sup> A good example is afforded by the decision of the Second Circuit in *CCC Information Services, Inc. v. Maclean Hunter Market Reports, Inc.*<sup>34</sup> In dealing with the question whether the *Red Book*<sup>35</sup> was protected by copyright, the court wrote:

The thrust of the Supreme Court's ruling in *Feist* was not to erect a high barrier of originality requirement. It was rather to specify, rejecting the strain of lower court rulings that sought to base protection on the 'sweat of the brow,' that some originality is essential to protection of authorship, and that the protection afforded extends only to those original elements. Because the protection is so limited, there is no reason under the policies of the copyright law to demand a high degree of originality. To the contrary, such a requirement would be counterproductive. The policy embodied into law is to encourage authors to publish innovations for the common good -- not to threaten them with loss of their livelihood if their works of authorship are found insufficiently imaginative.<sup>36</sup>

This seems to accurately reflect the *Feist* doctrine: the requirement of originality is minimal. Some works, such as factual compilations, usually hover around and sometimes inch past the threshold. Clearly, other more "artistic" works will be a mile above the threshold. But there is a single originality threshold, and it is a constitutional requirement to obtain copyright protection.<sup>37</sup>

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<sup>31</sup> H.R. Rep. No. 1476, 94th Cong., at 51, reprinted in 1976 U.S.C.C.A.N. 5659. The Act does not define originality and this omission was apparently deliberate. See William Patry, *Copyright in Collection of Facts: A Reply*, 6 *Comm. & Law* 11, 18 (1984).

<sup>32</sup> See Julia Reytblat, *Is Originality In Copyright Law A "Question Of Law" Or A "Question Of Fact?"*: The Fact Solution 17 *CARDOZO ARTS & ENT. L.J.* 181, 183 (1999).

<sup>33</sup> *Feist*, 499 U.S. at 347-48.

<sup>34</sup> 44 F.3d 61 (2d Cir. 1994), cert. denied, 516 U.S. 817 (1995). See Polivy, *supra* note 5, at 805-06.

<sup>35</sup> Described in the CCC case as "Automobile Red Book Official Used Car Valuations." 44 F.3d at 63.

<sup>36</sup> *Id.* at 66.

<sup>37</sup> See *Feist*, 499 U.S. at 347; and *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1270-71 (11th Cir. 2001). See also *infra* note 200 and accompanying text.

That being said, there remains a doubt whether the CCC court, which accurately described the Feist test, correctly applied the test. The choices necessary to determine car prices were largely dictated by standards and by the function (the need to accurately reflect the market).<sup>38</sup> As a photographer trying to take a technically perfect picture is not making creative choices,<sup>39</sup> one could argue that the authors of the Red Book are not making the kind of choices that give rise to copyright protection.<sup>40</sup>

The fact is, though, that Feist did not destroy copyright protection for compilations: a majority of post-Feist cases dealing with factual compilations found the compilation to be protected.<sup>41</sup> In addition, and more importantly, the fact that some factual compilations are not protected by copyright does not mean that copyright is bad for databases (and thus somehow must be changed); it means that factual databases are bad for copyright.<sup>42</sup> Protection of informational works that do not pass the Feist

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<sup>38</sup> See Durham, *supra* note 16, at 828.

<sup>39</sup> See *Bridgeman Art Library, Ltd. v. Corel Corp.*, 25 F. Supp. 2d 421 (S.D.N.Y. 1998); and 36 F. Supp. 2d 191 (S.D.N.Y. 1999). The case is discussed below. See *infra* note 203 and accompanying text.

<sup>40</sup> The notion of creative choices is discussed in Part III, below.

<sup>41</sup> For appellate cases where a factual compilation was found to be copyrightable, see *Key Publ'ns, Inc. v. Chinatown Publ'g Enters., Inc.*, 945 F.2d 509 (2d Cir. 1991); *Lipton v. Nature Co.*, 71 F.3d 464 (2d Cir. 1995); *Warren Publ'g, Inc. v. Microdos Data Corp.*, 52 F.3d 950 (11th Cir.), vacated, 67 F.3d 276 (11th Cir. 1995) (granting rehearing en banc), remanded, 115 F.3d 1509 (11th Cir. 1997) (en banc), cert. denied, 522 U.S. 963 (1997); *Kregos v. Assoc. Press*, 937 F.2d 700 (2d Cir. 1991); *United States Payphone, Inc. v. Executives Unlimited of Durham, Inc.*, 18 U.S.P.Q. 2d 2049 (4th Cir. 1991); *Nihon Keizai Shimbun, Inc. v. Comline Bus. Data, Inc.*, 166 F.3d 65 (2d Cir. 1999); *TransWestern Publ'g Co., LP v. Multimedia Mktg. Assocs., Inc.*, 133 F.3d 773 (10th Cir. 1999); and *CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports*, 44 F.3d 61 (2d Cir. 1994). In the *United States Payphone* case, however, the basis for protection seems to be still the "sweat of the brow" of the compiler ("the Guide ... was the result of hundreds of hours of reviewing, analyzing and interpreting [the data]," *United States Payphone, Inc. v. Executives Unlimited of Durham, Inc.*, 18 U.S.P.Q. 2d, at 2050). For cases where protection was refused, see *Victor Lalli Enters, Inc. v. Big Red Apple, Inc.*, 936 F.2d 671 (2d Cir. 1991); *BellSouth Adver. & Publ'g Corp. v. Donnelley Info. Publ'g, Inc.*, 999 F.2d 1436 (11th Cir. 1993); *Sem-Torq, Inc. v. K-Mart Corp.*, 936 F.2d 851 (6th Cir. 1991); *Mid-Am. Title Co. v. Kirk*, 867 F. Supp. 673 (N.D. Ill 1994), *aff'd*, 59 F.3d 719 (7th Cir.), cert. denied, 516 U.S. 990 (1995). See also *Sheils & Penchina*, *supra* note 7, at 566-68.

<sup>42</sup> In fact, trying to bring a database under the copyright umbrella might mean making a database less exhaustive due to increased selection or harder to use due to non-standard arrangement of the data. See *Ginsburg*, *supra* note 14, at 347; and *Polivy*, *supra* note 5, at 796-802. See also *Schoolhouse, Inc. v. Anderson*, 275 F.3d 726 (8th Cir. 2002) -- there was an admission by the defendant that a table was copyrightable, but the court noted that the protection was very thin.

"minimal creativity" threshold can be protected in a variety of ways, including contracts and torts, especially misappropriation.<sup>43</sup> Sui generis legislation could also be enacted, as was done in Europe.<sup>44</sup> While copyright protection could not be extended in light of the ruling in *Feist* that minimal creativity is constitutionally mandated,<sup>45</sup> Congress could probably act under the Commerce Clause.<sup>46</sup> But stretching the copyright canvas of protection to cover factual compilations could debase copyright. The *Feist* test puts the creative efforts of authors at the core of copyright and refuses to protect factual compilations simply because the making of the compilation required skill, time or a substantial investment. Copyright is not the proper vehicle to protect these non-creative, non-original compilations.

Putting the author/creator at the center of the copyright picture<sup>47</sup> by requiring evidence of a human (intellectual) creativity does not necessarily stem from an author-friendly perspective or benefit authors. In fact, the reverse may be true.<sup>48</sup> As one commentator put it, "by overturning sweat of the brow, the Supreme Court reemphasized that the primary benefactor of copyright laws is the public, and benefits to the author are secondary."<sup>49</sup>

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<sup>43</sup> See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 354 (1991); and Sheils & Penchina, *supra* note 7, at 572-83.

<sup>44</sup> See *infra* note 66 and accompanying text; and Anant Narayanan, Standards of Protection for Databases in the European Community and the United States: *Feist* and the Myth of Creative Originality, 27 *GEO. WASH. J. INT'L L. & ECON.* 457, 477-80 (1993-1994). Because the impact of a sui generis regime on existing intellectual property rights and the resulting rearrangement of the intellectual property matrix (interfaces among the various rights), there should be ample empirical data showing a market failure is present before such legislation is enacted. A number of bills were introduced in the 106th Congress containing such sui generis rights, including the Collections of Information Antipiracy Act, H.R. 354, 106th Cong. (1999) and the Consumer and Investor Access to Information Act of 1999, H.R. 1858, 106th Cong. (1999).

<sup>45</sup> *Feist*, 499 U.S. at 346.

<sup>46</sup> See Jane Ginsburg, No 'Sweat'? Copyright and Other Protection of Works of Information After *Feist v. Rural Telephone*," *supra* note 14, at 368- 74. But see Robert P. Merges & Glenn H. Reynolds, The Proper Scope of the Copyright and Patent Power, 37 *HARV. J. ON LEGIS.* 45, 63-64 (2000).

<sup>47</sup> For an interesting discussion of the relationship between the author and her work, and how the work is expressed, see Leslie A. Kurtz, Speaking To The Ghost: Idea And Expression In Copyright, 47 *U. MIAMI L. REV.* 1221, 1248- 50 (1993).

<sup>48</sup> See Hamilton, *supra* note 4, at 90 ("While the result is not surprising, much of the rhetoric is, which, unlike the rhetoric in *Harper & Row*, is undeniably on the side of the debate that pushes hard for public access rather than author's rights. The pervasive spirit of the opinion is strongly reminiscent of the spirit of Justice Stevens' approach in his opinion for the Court in *Sony* and his dissent in *Stewart v. Abend*.").

<sup>49</sup> Meade, *supra* note 2, at 268.

It seems that by requiring the mark of creativity, rather than looking at the work, time or money invested in the creation process, the Supreme Court clarified the consideration that society expects from its copyright "contract" with the author, and that copyright is not (only) an investment protection scheme.<sup>50</sup>

## B. United Kingdom

One of the first cases that comes to mind when looking at originality in the United Kingdom is *Walter v. Lane*,<sup>51</sup> decided prior to the 1911 Act, in which the House of Lords granted copyright protection to reporters' notes of a speech by the Earl of Rosebery because the note-taking process had required an "industrious collection" effort. Another such decision was *University of London Press*,<sup>52</sup> where the court found that to generate sufficient originality for copyright protection, "independent creation" (defined as absence of copying) and skill and labor were sufficient.<sup>53</sup> This traditional U.K. test seems very close to the pre-Feist "sweat of the brow" doctrine. It was applied more recently in *Express Newspapers Plc v. News (U.K.) Ltd.*,<sup>54</sup> in which the court decided to follow *Walter v. Lane*. This is significant because between *Walter v. Lane* and *Express Newspapers*, the U.K. statute was amended to add a standard of originality.<sup>55</sup>

At first glance, the picture emerging from the U.K. seems difficult to reconcile with Feist. However, the past few years may point to an evolution of the test, prompted perhaps by the progressive harmonization of British copyright law with the copyright laws of its fellow EU member States.<sup>56</sup> U.K. litigants are also actively trying to change the test. Hence,

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<sup>50</sup> See Feist, 499 U.S. at 358.

<sup>51</sup> [1900] A.C. 539. A similar conclusion was reached in *Morris v. Ashbee*, [1868] 7 Eq. 34, and *Kelly v. Morris*, [1866] 1 Eq. 697.

<sup>52</sup> *Univ. of London Press, Ltd. v. Univ. Tutorial Press, Ltd.*, [1916] 2 Ch. 601.

<sup>53</sup> *Id.* at 608: "The word original does not in this connection mean that the work must be the expression of original or inventive thought. Copyright Acts are not concerned with the originality of ideas, but with the expression of thought ... The Act [requires] that the work not be copied from another work -- that it should originate from the author." The skill and labor element was further developed in *Ladbroke (Football), Ltd. v. William Hill (Football), Ltd.*, [1964] 1 All E.R. 465, 469 (H.L.).

<sup>54</sup> [1990] F.S.R. 359 (Ch. D.).

<sup>55</sup> *Id.* at 365 ("The word original in the statute does not imply inventive originality; it is enough that the work is the production of something in a new form as a result of the skill, labour and judgment of the reporter.").

<sup>56</sup> See Daniel J. Gervais, *Transmissions Of Music On The Internet: An Analysis Of The Copyright Laws Of Canada, France, Germany, Japan, The United Kingdom, And The United States*, 34 *VAND. J. TRANSNAT'L L.* 1363, 1403-07 (2001), and footnotes 64 and 65 *infra*, and accompanying text.

in *Interlego A.G. v. Tyco Industries, Inc.*<sup>57</sup> the defendant tried to convince the Privy Council that, "[t]he word 'original' means the same for literary works as it does for artistic works. What is produced by the author need not be new in the absolute sense. There must be original creative input by the author. If in copying something is added, it is a question of degree whether that makes it an original artistic work or not. The skill and labour in doing the copying is irrelevant."<sup>58</sup> Lord Oliver of Aylmerton, on behalf of the Council, did not accept the defendant's argument but conceded that University of London Press was incomplete.<sup>59</sup> He noted that skill and labor were insufficient to confer originality; the work also had to "originate from the author."<sup>60</sup>

In two recent cases, the House of Lords insisted on the need for original skill and labor and, in one case, original artistic skill and labor.<sup>61</sup> If the House of Lords further elaborates on this test, it may get to a clear creativity-based test, because "original skill and labor" cannot have the same meaning as "skill and labor."<sup>62</sup> We suggest, therefore, that the *Express Newspapers* case<sup>63</sup> might have to be reconsidered. The introduction of originality in the Statute cannot be meaningless. In other words, if "original" means something, which it must, it is more than mere skill and labor, and that additional element is likely the intellectual creativity which seems to be required by EU directives.<sup>64</sup> The expression "author's own intellectual

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<sup>57</sup> [1989] A.C. 217 (P.C.).

<sup>58</sup> *Id.* at 232.

<sup>59</sup> *Id.* at 260.

<sup>60</sup> *Id.* at 263-64.

<sup>61</sup> *Newspaper Licensing Agency, Ltd. v. Marks & Spencer, plc*, [2001] UKHL 38; [2002] R.P.C. 4 at ¶ 19: "copying of certain of the ideas expressed in that [fabric] design which, in their conjoined expression, had involved original artistic skill and labour, constituted the copying of a substantial part of the artistic work. ... The notion of reproduction ... is sufficiently flexible to include the copying of ideas abstracted from a literary, dramatic, musical or artistic work, provided that their expression in the original work has involved sufficient of the relevant original skill and labour to attract copyright protection." (emphasis added). The other case is *Designers Guild, Ltd. v. Russell Williams (Textiles), Ltd.*, [2000] 1 W.L.R. 2416; [2001] 1 All E.R. 700.

<sup>62</sup> To use University of London Press terminology, "original" cannot be read as meaning that the work is the product of skill and labor. Interestingly, the 1988 U.K. Act specifically mentions that works must be original. See *The Copyright, Designs and Patents Act, 1988*, ch. 1, § 1(1) (U.K.). The counter-argument is that the Act simply codified what the courts had previously defined as originality, namely skill and labor and absence of copying.

<sup>63</sup> See *supra* note 54.

<sup>64</sup> Art. 1(3) of the Directive 91/250/EEC of May 14, 1991 on the legal protection of computer programs states that, "A computer program shall be protected if it is original in the sense that it is the author's own intellectual creation. No other criteria shall be applied to determine its eligibility for protection." (OJ L 346, Nov. 27, 1992, p.61, as amended by Directive 93/98/EEC). A similar statement in respect of databases is contained in Article 3(1) of the Directive 96/9/EC of March 11, 1996 on the Legal Protection of Databases (OJ L077, Mar. 27, 1996, p. 0020-0028). In an obiter, a British Court seems to agree that adding an originality requirement to the statute had the effect of overturning *Walter v. Lane*. See *Robertson v. Lewis*, [1976] R.P.C. 169, 174 (Ch. D.).

creation" is now part of the U.K. Act in respect of compilation of data.<sup>65</sup> A hint of such evolution may have been given when the court used the expression "artistic skill and labor."

We also suggest that the University of London Press case could be reopened to reflect the EU's concept of "intellectual creation."<sup>66</sup> Arguably, the case hinges on the wrong notion of originality. Originality is a word with several meanings, including in copyright law. The expression "original work" may be used to describe a creative work, but also a work from which a derivative work is made. It can also refer to a work of which a copy is made.<sup>67</sup>

The Webster's Dictionary actually defines originality in four ways: "the quality of being original"; "ability to think or express oneself in an independent and individual manner"; "creative ability," and "freshness or novelty of an idea."<sup>68</sup> Indeed, the vernacular meaning might be closer to "novel" than creative.<sup>69</sup> Hence the aphorism that originality is trying to

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<sup>65</sup> See Article 3A of the Copyright, Designs and Patents Act, 1988 (Eng.).

<sup>66</sup> See *id.*

<sup>67</sup> Examples in the U.S. Copyright Act include "original work of authorship" in the definition of "compilation" in 17 U.S.C. § 101 and in § 102; in a different sense when referring to commercial advertisements in § 111(c)(3); and in yet another sense when referring to a license up for renewal in § 114(j)(10). Interestingly, § 1301(b) dealing with the protection of designs states that "A design is original if it is the result of the designer's creative endeavor that provides a distinguishable variation over prior work pertaining to similar articles which is more than merely trivial and has not been copied from another source." This definition would seem to contain various elements: creativity; distinguishable and not copied.

<sup>68</sup> WEBSTER'S ENCYCLOPEDIA UNABRIDGED DICTIONARY OF THE ENGLISH LANGUAGE 1366 (1996).

<sup>69</sup> John Stuart Mill wrote several pieces about originality. In them he uses the term original several times to mean "novel" or fresh, for example in his review of Bentham's philosophy. See John Stuart Mill, Bentham, LONDON & WESTMINSTER REV., Aug. 1838, revised in 1859 in DISSERTATIONS AND DISCUSSION, v. 1). In On Liberty, quoting Wilhelm Von Humboldt, he writes: "'the end of man, or that which is prescribed by the eternal or immutable dictates of reason, and not suggested by vague and transient desires, is the highest and most harmonious development of his powers to a complete and consistent whole'; that, therefore, the object 'towards which every human being must ceaselessly direct his efforts, and on which especially those who design to influence their fellow-men must ever keep their eyes, is the individuality of power and development'; that for this there are two requisites, 'freedom, and a variety of situations'; and that from the union of these arise 'individual vigour and manifold diversity,' which combine themselves in 'originality. ...' originality is a valuable element in human affairs. There is always need of persons not only to discover new truths, and point out when what were once truths are true no longer, but also to commence new practices, and set the example of more enlightened conduct, and better taste and sense in human life." JOHN STUART MILL, ON LIBERTY, Ch. III (London: Longman, Roberts & Green, 4th ed. 1869) (emphasis added).

be like everybody else -- and failing.<sup>70</sup> And to say of someone that she is "original" is not necessarily a compliment.

But when referring to the protection of copyright works, it does not appear to be a stretch to equate originality with creativity.<sup>71</sup> When used to mean simply that the work must originate from the author, originality is eviscerated of its core meaning. It becomes a synonym of "originated,"<sup>72</sup> and fails to reflect the ordinary sense of the word.

## C. Canada

### 1. Tele-Direct

The U.K. University of London Press case<sup>73</sup> was followed in several Canadian decisions.<sup>74</sup> In fact, the skill and labor test was viewed by many, even after Feist, as a "fundamental principle of Anglo-Canadian copyright law."<sup>75</sup> Against this backdrop, it is not surprising that a commentator argued that Feist was bad law and should not be "imported" into Canadian law;<sup>76</sup> another author questioned its compatibility with the TRIPs Agreement<sup>77</sup> because it sets too high a standard of originality.<sup>78</sup>

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<sup>70</sup> Raymond Radiguet (1903-1923), French novelist, quoted in JOSEPH BRENNAN, "THOMAS MANN," THREE PHILOSOPHICAL NOVELISTS (1964).

<sup>71</sup> See *supra* note 6 and accompanying text.

<sup>72</sup> See also *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 60 (1884).

<sup>73</sup> See *supra* note 53.

<sup>74</sup> *Viceroy Homes, Ltd. v. Ventury Homes, Inc.*, [1996] 69 C.P.R.3d 459 (Ont. Ct. App.); *Slumber-Magic Adjustable Bed Co. v. Sleep-King Adjustable Bed Co.*, [1984] 3 C.P.R. 81 (B.C. Sup. Ct.); *U&R Tax Servs., Ltd. v. H&R Block Canada, Inc.*, [1995] 62 C.P.R.3d 257 (Fed. Ct. Tr. Div.)

<sup>75</sup> Michael Morgan, *Trash Talking: the Protection of Intellectual Property Rights in Computer Software*, 26 OTTAWA L. REV. 425, 462 (1994).

<sup>76</sup> See Norm Siebrasse, *Copyright in Facts and Information: Feist Publications Is Not, and Should Not Be the Law in Canada*, 11 CAN. INTELL. PROP. REV. 91 (1994).

<sup>77</sup> See *supra* note 13.

<sup>78</sup> See Sunny Handa, *A Review of Canada's International Copyright Obligations*, 42 MCGILL L.J. 961, 978 (1997). The TRIPs Agreement does not define or mandate any specific originality standard, though it incorporates by reference the Berne Convention (TRIPs Article 9(1)) and, as decided by a WTO dispute-settlement panel, this includes the history of the Convention, which, as explained *infra* in Part III, includes some hints as to the meaning of "originality." See United States - Section 110(5) of the U.S. Copyright Act, Report of the Panel, WTO Document WT/DS160/R, June 15, 2000, at ¶¶ 6.43-6.46.

However, in a case also involving copyright in a telephone directory,<sup>79</sup> the Federal Court of Appeal refused to apply the University of London Press test. The peg on which Justice Decary hung the new test is Article 1705 of the North American Free Trade Agreement (NAFTA), which reads in part as follows:

1705: Copyright (1). Each Party shall protect the works covered by Article 2 of the Berne Convention,<sup>80</sup> including any other works that embody original expression within the meaning of that Convention. In particular: (b) compilations of data or other material, whether in machine readable or other form, which by reason of the selection or arrangement of their contents constitute intellectual creations, shall be protected as such.<sup>81</sup>

The Tele-Direct court concluded that, "what the parties to the Agreement wanted to protect were compilations of data that 'embody original expression within the meaning of [the Berne] Convention' and that constitute 'intellectual creations.' The use of these last two words is most revealing: compilations of data are to be measured by standards of intellect and creativity. As these standards were already present in Anglo-Canadian jurisprudence ... I can only assume that the Canadian Government in signing the Agreement and the Canadian Parliament in adopting the 1993 amendments to the Copyright Act expected the Court to follow the 'creativity' school of cases rather than the 'industrious collection' school."<sup>82</sup> The court was thus clearly aware of the two schools of thought; in fact, it specifically referred to and "adopted" the Feist definition of originality.<sup>83</sup>

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<sup>79</sup> *Tele-Direct (Publ'ns), Inc. v. Am. Bus. Info., Inc.*, [1998] 2 F.C. 22 (Fed. Ct. App.), leave to appeal refused, May 21, 1998, [1997] S.C. C.A. No. 660.

<sup>80</sup> See *supra* note 12.

<sup>81</sup> *Id.* at ¶ 14.

<sup>82</sup> *Id.* at 303.

<sup>83</sup> "In *Feist Publications, Inc. v. Rural Telephone Service Co.*, decided prior to the coming into force of NAFTA, the United States Supreme Court has found that names, towns and telephone numbers of subscribers in local white pages telephone directories were uncopyrightable facts and that these bits of information were not selected, coordinated, or arranged in an original way. In the course of her reasons, O'Connor J. stated the following: 'As mentioned, originality is not a stringent standard; it does not require that facts be presented in an innovative or surprising way. It is equally true, however, that the selection and arrangement of facts cannot be so mechanical or routine as to require no creativity whatsoever. The standard of originality is low, but it does exist [at 1296].' These words, in my view, could have been said in a Canadian context." *Id.* at 309.

## 2. Tele-Direct and the Feist Progeny in Canada

The Canadian picture is far from uniform, however. In a pre-Tele-Direct case, *Prism Hospital Software, Inc. v. Hospital Medical Records Institute*,<sup>84</sup> the first Canadian decision to consider Feist, Judge Parrett of the British Columbia Supreme Court quoted Feist with approval,<sup>85</sup> but in *Neudorf v. Nettwerk Productions, Ltd.*<sup>86</sup> another British Columbia trial judge interpreted Tele-Direct as modifying the standard of originality only with respect to compilations. If Neudorf is the correct interpretation, this would mean that there are two different originality standards in Canadian law,<sup>87</sup> which in turn would seem to require a fairly clear indication from Parliament. Yet, nowhere in the statute is this dual nature of copyright articulated. In fact, the reasoning itself is questionable: why would creativity be required for compilations, arguably the type of work in which creativity is the most difficult to express, while only skill and labor would be required for paintings, novels and films? We thus believe this case is also incorrect in the respect just mentioned: there is a single threshold in Canadian law as correctly expressed in Tele-Direct: creative choices. The particular fact pattern of Tele-Direct should not distract us from the fact that it rearticulated the concept of originality in a way that seems fully consonant with the underlying policy objective of copyright, which is not to reward financial investment or time, but rather creative input.<sup>88</sup>

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<sup>84</sup> [1994] C.P.R.3d 129 (B.C. Sup. Ct.). Compare *CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports., Inc.*, 33 F.3d 61 (2d Cir. 1994).

<sup>85</sup> *Id.* at 270 ("Copyright protection is not afforded to collections of facts but rather to the original component contributed by a particular author. This distinction is illustrated in a portion of the reasoning of the Supreme Court of the United States in *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*").

<sup>86</sup> [1999] C.P.R.4th 129 (B.C. Sup. Ct.).

<sup>87</sup> *Id.* at ¶ 19 ("Originality is not defined in the Act. However with the possible exception of a work that deals with a compilation of data (see *Tele-Direct (Publ'ns) Inc. v. Am. Bus. Info., Inc.*, [1998] 2 F.C.R. 22 (Fed. Ct. App.), leave to appeal refused, May 21, 1998, [1998] S.C.C.A. No. 660; *Hager v. ECW Press, Ltd.*, [1998] 85 C.P.R.3d 289 (Fed. Ct. Tr. Div.)) the meaning of the word "original" appears now to be well-settled by the oft-cited statement of law set out in *University of London Press Ltd. v. University Tutorial Press Ltd.*")

<sup>88</sup> At least, this is how the policy was formulated in a 1985 report entitled *A Charter of Rights for Creators* (House of Commons, Standing Committee on Communications and Culture (Ottawa: Minister of Supply & Services, 1985)), which served as a basis for both phases of copyright reform in Canada. Phase I was contained in R.S.C. 1985, c.10 (4th Supp.), and Phase II in S.C. 1997, c. 24. See David Vaver, *Copyright Phase 2: The New Horizon*, 6 *INTELL. PROP. J.* 37 (1990).

The Neudorf case is only an example of decisions that did not accept to follow *Tele-Direct*,<sup>89</sup> however. In *Hager v. ECW Press*, a case dealing with copyright in an interview with Canadian singer Shania Twain, the Trial Division of the Federal Court interpreted *Tele-Direct* very narrowly. First, Judge Reed said the *Tele-Direct* court had not expressly said it was rejecting the previously established "skill and labor" doctrine.<sup>90</sup> Second, it distinguished *Tele-Direct* because the instant case was dealing with a different type of work, namely an interview instead of a compilation.<sup>91</sup>

In another skill and labor decision, *ITAL-Press Ltd. v. Sicoli*,<sup>92</sup> the same court found that a telephone directory of Italian-Canadians was original because of the selection of the data and the skill and labor<sup>93</sup> in selecting and arranging ads in the book.<sup>94</sup>

It seems that both these cases incorrectly interpreted and applied the Feist/*Tele-Direct* test, because the presence of creative choices was simply not proven.<sup>95</sup> In the case of the directory of Italian names, the choices made by the authors depended on a technical function: extracting names

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<sup>89</sup> *CCH Canadian, Ltd. v. Law Soc'y of Upper Canada*, [1999] 179 D.L.R.4th 609 (Fed. Ct. Tr. Div.); and *Ital-Press, Ltd. v. Sicoli*, [1999] 86 C.P.R.3d 129 (Fed. Ct. Tr. Div.). Absent a confirmation by the Supreme Court, there is some resistance vis-à-vis the adoption of the "new" test, as demonstrated in *Hager v. ECW Press, Ltd.*, [1998] 85 C.P.R.3d 289 (Fed. Ct. Tr. Div.), and *B & S Publications, Inc. v. Max-Contacts, Inc.*, [1999] 3 C.P.R.4th 129 (Alta. Q.B.).

<sup>90</sup> *Hager v. ECW Press, Ltd.*, [1998] 85 C.P.R.3d 289, at ¶ 41.

<sup>91</sup> *Id.* at ¶ 43.

<sup>92</sup> [1999] 86 C.P.R.3d 129 (Fed. Ct. Tr. Div.).

<sup>93</sup> *Id.* at ¶ 109-10 ("The chief distinguishing feature of the listings in the *Guidas* is that they are all names of Canadian residents of Italian origin or residents who can reasonably be thought to be of Italian origin. Thus, there was a selection process involving elements of skills and judgment as well as labour.").

<sup>94</sup> *Id.* at ¶ 101 ("The *Guidas* are not 'garden-variety' telephone books, whether those telephone books be white pages books, yellow pages books or books comprised of both white pages and yellow pages components. They are not directed to all telephone users. They are directed to a very well defined segment of that class. Nor are they directed to all yellow pages users. They are directed, once again, to a very selected segment of the market, that segment being shops, stores and services catering particularly to the Italian/Canadian community. In addition to the listings and block advertisements, the range of other components comprised in the *Guidas* is also specifically tailored to the same community.").

<sup>95</sup> Arguably in *Ital-press* the presence of such choices could have been established but no finding was made by the court. Compare *Key Publ'ns, Inc. v. Chinatown Today Publ'g Enters., Inc.*, 945 F.2d 509 (2d Cir. 1991), *supra* note 41.

of Canadians of Italian descent.<sup>96</sup> To use a different example, a selection of the major poems of the twentieth century would be copyrightable, not a list of names of their arrangement in alphabetical order. The same is not true of course of the placement of ads in the directory, which does reflect, to a certain extent at least,<sup>97</sup> the choices made by the author.<sup>98</sup>

In *B & S Publications, Inc. v. Max-Contacts, Inc.*,<sup>99</sup> an Alberta trial court found that an index of oil and gas information was protected by copyright in spite of the fact that the data was "researched, confirmed and arranged in a unique way so as to meet the needs of the personnel in the oil and gas industry who require accurate, up-to-date information concerning companies engaged in the exploration and production of oil and gas."<sup>100</sup> While the choices made seem to be entirely function-based, the facts clearly showed that the authors had a certain margin of choice in selecting and, especially, arranging the data.<sup>101</sup> The case does seem to have been correctly decided in light of Feist.

Fortunately, other cases did follow and explain *Tele-Direct*. First, the Federal Court of Appeal recently confirmed its *Tele-Direct* findings in *Édutile inc. v. Ass'n pour la protection des automobilistes*.<sup>102</sup> In determining that a published guide of prices for used cars was protected by copyright, the court found that originality did not stem from the data itself but its arrangement in three columns instead of the two that were standard in similar guides.<sup>103</sup>

In a recent decision that may yet be appealed to the Supreme Court,<sup>104</sup> a different bench of the Federal Court of Appeal questioned whether *Tele-Direct* should be applied to works other than factual compilations and seemed to indicate that the University of London Press standard of skill and labor was still relevant in respect of other works. One can question where in the Copyright Act there is an indication of the presence

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<sup>96</sup> See *id.*

<sup>97</sup> One would assume that there are certain marketing practices that are used to determine optimal placement. However, if the practices are only guidelines, there is still room for creativity.

<sup>98</sup> A simple rule of thumb might be to determine whether two different authors with the same technical knowledge of standard practices would arrive at the same result. But the fact that two persons in a similar situation will arrive at a different result does not automatically mean that the choices are creative. David Nimmer gives as an example the reconstruction of the Dead Sea Scrolls. See David Nimmer & Eaton S. Drone, *Copyright In The Dead Sea Scrolls: Authorship And Originality*, 38 HOUS. L. REV. 1, 96 (2001).

<sup>99</sup> [1999] 3 C.P.R.4th 129 (Alta. Q.B.).

<sup>100</sup> *Id.* at ¶ 19.

<sup>101</sup> See *id.*

<sup>102</sup> [2000] 188 D.L.R.4th 132 (Fed. Ct. App.).

<sup>103</sup> *Id.* at ¶ 15.

<sup>104</sup> *CCH Canadian Ltd. v. Law Society of Upper Canada* [2000] FCA 187.

of several, different originality thresholds.<sup>105</sup> The trial court,<sup>106</sup> had found that Tele-Direct was applicable to works other than compilations and could be viewed as establishing a general standard for originality.<sup>107</sup> Originality in a case summary could exist but only in a "narrow groove."<sup>108</sup> This seems correct: there are very few choices that can be made in this kind of work, although it may be possible to pass the minimal threshold. Case summaries follow certain fairly well-established guidelines.<sup>109</sup>

Support for the Tele-Direct doctrine can also be found in *Delrina Corp. v. Triolet Systems, Inc.*,<sup>110</sup> in which Justice Morden of the Ontario Court of Appeal, discussing the performance of a computerized performance monitoring system, stated:

I accept that the reproduction of a particular arrangement of elements that are not themselves protectable can constitute copyright infringement if that arrangement is original. However, in this case ... the alleged similarities between Sysview and Assess, including similarities in the arrangement of elements, were dictated by functional considerations or otherwise not protectable by copyright.<sup>111</sup>

Finally, in *Robertson v. Thomson Corp.*,<sup>112</sup> an Ontario court also said it was following Tele-Direct, but the decision appears at the same time to be applying the sweat of the brow test.<sup>113</sup>

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<sup>105</sup> See *supra* notes 37 and 87 and accompanying text.

<sup>106</sup> [1999] 179 D.L.R.4th 609 (Fed. Ct. Tr. Div.). The case dealt with copyright (or absence thereof) in reported judicial decisions, headnotes, annotated statutes, case summaries, topical indices, legal textbooks and monographs. The case is now before the Federal Court of Appeal (file nos. A-806-99; A-807-99; A-808-99).

<sup>107</sup> *Id.* at ¶ 131.

<sup>108</sup> *Id.* at ¶ 134.

<sup>109</sup> See *id.* at ¶ 137-39 ("I am satisfied that editorially enhanced judicial decisions should be measured by a standard of intellect and creativity in determining whether they give rise to copyright, in the same way as compilations of data."). Compare *Matthew Bender & Co. v. West Publ'g Co.*, 158 F.3d 693 (2d Cir. 1998); and a pre-Feist case, *West Publ'g Co. v. Mead Data Central, Inc.*, 799 F.2d 1219 (8th Cir. 1986), cert. denied, 479 U.S. 170 (1987).

<sup>110</sup> [2002] O.J. No. 676, Mar.1, 2002.

<sup>111</sup> *Id.* at ¶ 29 (emphasis added). The appeal was dismissed.

<sup>112</sup> [2001] O.J. No. 3868 (Ont. Sup. Ct. of J.). See Deborah Tussey, *The Creative As Enemy of the True: The Meaning of Originality in the Matthew Bender Cases*, 5 RICH. J. L. & TECH. 1030-5 (1999). The fact pattern of the Robertson case (dealing with the electronic use of material produced by freelance authors) is very similar to *New York Times Co. v. Tasini*, 533 U.S. 483 (2001).

<sup>113</sup> See *id.* at ¶ 36.

## D. Australia

Australia produced a very interesting case in 2001, also dealing with telephone directories.<sup>114</sup> Judge Finkelstein of the Federal Court of Appeal provided a thorough analysis of British cases concerning the copyrightability of factual compilations, and then studied *Feist*<sup>115</sup> and *Tele-Direct*.<sup>116</sup> The court found there were cogent policy arguments both for and against following *Feist*<sup>117</sup> but decided against it:

the very nature of copyright requires the work to be the product of creative thought. The first copyright statute was enacted 'for the Encouragement of learned Men to compose and write useful Books.' These books were necessarily the result of the author's intellectual effort. That was also true of other works (engravings, sculptures, dramatic works and the like) that were given copyright protection by the early statutes. But a compilation is of a different character from a work of art or literature. This is especially true of a compilation of facts that are in the public domain .... the creativity is of a different order from that involved in producing a work of art or literature.<sup>118</sup>

We suggest that this reasoning is either incorrect or imprecise. The central assertion is that copyright in compilation is by its very nature different from copyright in other subject matter. There is no statutory basis for such a claim and, as we shall see later, no basis in the history of international copyright law. What the court was perhaps trying to express was that there is a single threshold of originality but that some works merely crawl over it while others are a mile beyond. But the differentiation among various creativity/originality thresholds based on the type of work concerned is unfounded.<sup>119</sup>

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<sup>114</sup> *Telstra Corp., Ltd. v. Desktop Mktg. Sys. Pty, Ltd.*, [2001] F.C.A. 612.

<sup>115</sup> *Id.* at ¶ 69-78.

<sup>116</sup> *Id.* at ¶ 79-82.

<sup>117</sup> "There are those who argue that the abandonment of the 'sweat of the brow' theory has threatened the progress of information. The argument is that the collection of factual material is essential to the economy. Databases provide a wealth of information to business people, professionals, scientists and consumers. If copyright protection is not given, the investment of the time and money that is required to produce these compilations will not be forthcoming. ... Perhaps it was the risk of this occurring that led to the introduction of a bill to repeal the effect of *Feist* in the United States House of Representatives." (referring to the Collections of Information Antipiracy bill introduced in the 105th Congress). *Id.* at 83.

<sup>118</sup> *Id.* at ¶ 84.

<sup>119</sup> See *supra* notes 37 and 87 and accompanying text.

The key to the Telstra decision is probably a fairness issue: the court expressed the need to find a way to protect investments in a compilation.<sup>120</sup> As we have argued above, this is a matter best left to tort law,<sup>121</sup> or perhaps, though with some hesitation, to sui generis legislation as was done in Europe.<sup>122</sup>

Interestingly, in another recent decision involving the same parties,<sup>123</sup> a three-member panel of the Federal Court of Appeal indicated a willingness to consider a departure from the skill and labor standard. However, one judge felt that only the High Court could do so,<sup>124</sup> while another asked Parliament to intervene.<sup>125</sup>

In *Sands McDougall Proprietary, Ltd. v. Robinson*,<sup>126</sup> the High Court fully supported the sweat of the brow test. It thus seems unlikely that Telstra will be overturned by the same Court, absent a clear decision in the U.K. stating that *Walter v. Lane* and especially *University of London Press* are no longer good law. The 2001 decisions by the House of Lords<sup>127</sup> may not be sufficient to convince the court that adoption of a new test is warranted.

## II. ORIGINALITY IN CIVIL LAW SYSTEMS

The traditional originality test in France is that the work must express or reflect the author's personality, a fairly subjective notion to be sure.<sup>128</sup> According to a French commentator, it was normal that such a subjective notion would emerge during the nineteenth century because "the modes of expression then in vogue -- sculpture, painting and writings -- is ... the expression of (inner) turmoil (tourmente) of the author, the emotional, subjective and non-rational aspect of human thought. In a way, what differentiates

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<sup>120</sup> "[T]he investment of the time and money that is required to produce these compilations will not be forthcoming." *Id.* at 83.

<sup>121</sup> See *supra* note 43 and accompanying text.

<sup>122</sup> Article 7(1) of the database directive (see *supra* note 64) provides a new right "for the maker of a database which shows that there has been qualitatively and/or quantitatively a substantial investment in either the obtaining, verification or presentation of the contents to prevent extraction and/or re-utilization of the whole or of a substantial part evaluated qualitatively and/or quantitatively, of the contents of that database."

<sup>123</sup> *Desktop Mktg. Sys. Pty, Ltd. v Telstra Corp., Ltd.*, [2000] FCAFC 112.

<sup>124</sup> *Id.* at paragraph 271.

<sup>125</sup> *Id.* at paragraph 429.

<sup>126</sup> (1917) 23 C.L.R. 49, 53-54.

<sup>127</sup> See *supra* note 61 and accompanying text.

<sup>128</sup> ANDRE LUCAS & H.J. LUCAS, *TRAITE DE LA PROPRIETE LITTERAIRE ET ARTISTIQUE* 77-78 (2d ed. 2001): [author's translation] "The classic thesis is simple: Originality must be understood as the mark of the author's personality."

one work from another is its irrationality, a reflection of the author's own irrational mind." <sup>129</sup>

This approach, while understandable for the types of works mentioned (sculpture, writings and painting), does not mesh well with compilations and databases. Yet, the protection of several types of compilations has been recognized by French courts: statistical studies, <sup>130</sup> comparative tables of television audience ratings <sup>131</sup> or even specialized telephone directories <sup>132</sup> and calendars. <sup>133</sup> The French Supreme Court <sup>134</sup> made it clear that labor itself was insufficient <sup>135</sup> and that one had to look at the choice of the method used by the author of the compilation. <sup>136</sup> In fact, recognizing that the classical test could not be used for newer types of works such as databases (compilations) and computer software, several French courts have tried to develop a new test or, more precisely, to elevate the classical test to a higher level of abstraction, by answering the following question: what is it that an author does to show her personality through a work? The fairly unanimous answer given by French courts is that creative choices make the difference. <sup>137</sup> In a case involving a bilingual dictionary, the Court of Appeal of Paris found that "the choices and intellectual operations required to create the [dictionary] tend to give the resulting work a certain degree of originality, even when dealing with a technical type of work." <sup>138</sup> In this *Harrap's* case, the Court made it clear that the fact of sorting data that was difficult to generate in alphabetical order was not original. Originality can only follow from intellectually creative (as opposed to mechanical or dictated by the function or format) choices. <sup>139</sup> A similar conclusion was reached by the same court a few years later concerning a repertory of Cajun words. <sup>140</sup>

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<sup>129</sup> Jean Martin, *Le droit d'auteur applicable au logiciel*, in *LE DROIT D'AUTEUR AUJOURD'HUI* 111 (Isabelle de Lamberterie ed., 1991) [author's translation].

<sup>130</sup> TGI Paris, réf. Jan. 18, 1999; *Juris-Data* no. 043760.

<sup>131</sup> CA Paris, 1e ch., May 22, 1990: *Légipresse* 1990, I, at 67.

<sup>132</sup> CA Paris, Dec. 18, 1924: *DH* 1925, at 30.

<sup>133</sup> CA Paris, 4e ch., 4e ch., Apr. 14, 1986: *D.* 1987, somm. P. 152 obs. COLOMBET.

<sup>134</sup> Cour de cassation.

<sup>135</sup> Cass. 1e civ., May 2, 1989: *JCP G* 1990, II, 21392, note A. Lucas; *RIDA* 1/1990, at 309 ("Coprosta" case).

<sup>136</sup> Cass. crim. May 18, 1938: *Gaz. Pal.* 1938, 2, p.311; and Cass. civ., May 27, 1942: *S.*1942, 1, 124.

<sup>137</sup> See DANIEL GERVAIS, *LA NOTION D'OEUVRE DANS LA CONVENTION DE BERNE ET EN DROIT COMPARE* 85-86 (1998).

<sup>138</sup> CA Paris, 4e ch., Mar. 21, 1989: 142 *RIDA* 333, 338-39 ("*Harrap's*" case) [author's translation].

<sup>139</sup> *Id.*

<sup>140</sup> CA Paris, 1e ch., Jan. 14, 1992: 152 *RIDA* 198.

Another interesting case involved a compilation of short stories based on traditional folklore.<sup>141</sup> Because the stories themselves were in the public domain through the expiration of the term of protection, copyright could only subsist in the (original) selection and arrangement of stories. The Court found that "by choosing the stories, by narrating them with his own style and by arranging them according to a sequence chosen by him and which was not necessary,<sup>142</sup> and by giving the book a specific structure, Mr. Guillois created a creative work."<sup>143</sup>

Undoubtedly then, when French courts tried to elevate the level of abstraction, they realized that what distinguishes one work from another are creative choices.<sup>144</sup>

Similar though not as completely developed doctrines have been accepted by courts in Belgium,<sup>145</sup> the Netherlands<sup>146</sup> and Switzerland.<sup>147</sup> In fact, Swiss copyright scholars Bannelet and Egloff assert that what creates originality are choices made by the author that were not dictated by custom or good practice.<sup>148</sup>

### III. ORIGINALITY IN INTERNATIONAL COPYRIGHT TREATIES

There is no definition of the concept of "originality" in international copyright treaties.<sup>149</sup> In fact, the requirement that a work be "original" is

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<sup>141</sup> CA Paris, 4e ch., Sept. 23, 1992: 156 RIDA 224 [hereinafter Fayard case].

<sup>142</sup> In the sense of not having been dictated by the technique used or usual norms concerning this type of compilation.

<sup>143</sup> Fayard case, 156 RIDA at 224-5 [author's translation].

<sup>144</sup> We will refine the concept of "creative choices" below (see *infra*, Part IV.B).

<sup>145</sup> Cass. civ. Apr. 27, 1989: R.W. 1989-90, at 362; Cass. civ. Oct. 25, 1989; R.W. 1989-90, at 1061; see also Alain Strowel, Rapport belge, in *COPYRIGHT AND INDUSTRIAL PROPERTY: CONGRESS OF THE AEGEAN SEA II* 392 (1991); ALAIN STROWEL, *DROIT D'AUTEUR ET COPYRIGHT* 420-31 (1993).

<sup>146</sup> See *Van Dale v. Romme I*, HR Jan. 4, 1991, IER 1991 (8) at 177; and *Van Dale v. Romme II*, HR Apr. 1, 1993, IER 1993 (3) at 82. See also STROWEL, *supra* note 138, at 425-26.

<sup>147</sup> See GERVAIS, *supra* note 131, at 87-88; MAX KUMMER, *DAS URHEBERRECHTLICH SHUTZBARE WERK* 30 (1968); and DENIS BANNELET & WILLI EGLOFF, *LE NOUVEAU DROIT D'AUTEUR: COMMENTAIRE DE LA LOI FEDERALE SUR LE DROIT D'AUTEUR ET LES DROITS VOISINS* 24 (1994).

<sup>148</sup> In French, "règles de l'art." See BANNELET & EGLOFF, *supra* note 141, at 10-24.

<sup>149</sup> Actually, very few national laws contain such a definition. We studied ninety-three national laws and found a specific definition of originality in only three national laws, namely Bulgaria, Burkina Faso and Malaysia. See GERVAIS, *supra* note 131, at 72-76. Indirectly, a definition is contained in the two European Union directives that require that a work be the result of the author's "own intellectual creation." See note 64 *supra*; and *Bridgeman Art Library, Ltd. v. Corel Corp.*, 36 F. Supp. 2d 191, 195 (S.D.N.Y. 1998).

not mentioned either. There are, however, several statements in records of diplomatic conferences and committees of experts meeting under the aegis of the World Intellectual Property Organization that confirm the requirement that originality be present, and that this is the only applicable criteria, to the exclusion of, e.g., artistic merit or purpose.<sup>150</sup>

The expression "work" itself is only "defined" officially by the list of categories of works in Article 2 of the Berne Convention.<sup>151</sup> However, a WIPO<sup>152</sup> Committee of Experts concluded that this expression was synonymous

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<sup>150</sup> One additional criterion would be that the subject matter to be protected fit within one of the categories of works (literary and artistic) as defined in Article 2(1) and (5) of the Berne Convention and in national laws, such as 17 U.S.C. § 101. It is interesting to put this in parallel with the Supreme Court dictum in *Feist* according to which originality was the "key to resolving the tension" among the conflicting approaches to copyright. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991).

The first statement on originality was made during the Revision Conference of the Berne Convention held at Rome from May 7 to June 2, 1928. The Acts of this conference were originally published only in French (*Actes de la Conférence réunie à Rome du 7 mai au 2 juin 1928* (Berne: Bureau de l'Union internationale pour la protection des oeuvres littéraires et artistiques, 1929), but WIPO published an English translation of the records of all Berne revision conferences on the occasion of the centenary of the Berne Convention. See WIPO, 1886-1986: *BERNE CONVENTION CENTENARY* (1986). In the General Report, rapporteur Edoardo Piola Caselli wrote: "The protection enjoyed by other works of art should be reserved for cinematographic productions which meet the requirements of originality laid down in paragraph (2) [of Article 14]. In order to show clearly that the only requirement concerned here is that of the originality with which every work of the mind must be endowed ...." *Id.* at 174.

<sup>151</sup> See *supra* note 12, Article 2(1), which reads as follows:

The expression "literary and artistic works" shall include every production in the literary, scientific and artistic domain, whatever may be the mode or form of its expression, such as books, pamphlets and other writings; lectures, addresses, sermons and other works of the same nature; dramatic or dramatico-musical works; choreographic works and entertainments in dumb show; musical compositions with or without words; cinematographic works to which are assimilated works expressed by a process analogous to cinematography; works of drawing, painting, architecture, sculpture, engraving and lithography; photographic works to which are assimilated works expressed by a process analogous to photography; works of applied art; illustrations, maps, plans, sketches and three-dimensional works relative to geography, topography, architecture or science.

A copy of the 1971 Act (latest) Convention is available at <http://www.wipo.int/treaties/ip/berne/index.html>.

<sup>152</sup> World Intellectual Property Organization. See <http://www.wipo.int>.

with "intellectual creation,"<sup>153</sup> and that such creation should contain "an original structure of ideas or impressions."<sup>154</sup> The same committee also noted that originality "was an integral part of the definition of the concept of 'work.'"<sup>155</sup>

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

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

The records of various diplomatic conferences adopting and revising the Berne Convention reflect that the reason why Article 2(1) of the Convention does not state explicitly that works are intellectual creations is that that element of the notion of works was considered to be evident.<sup>156</sup>

The General Report of the Berne Convention Revision Conference held in Brussels in 1948 specifically states: "You have not considered it necessary to specify that those works constitute intellectual creations because ...

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<sup>153</sup> The concept of intellectual creation has been acknowledged as a synonym of work in several international meetings. See GERVAIS, *supra* note 131, at 45-49.

<sup>154</sup> WIPO Committee of Experts on Model Provisions for Legislation in the Field of Copyright, First Session, document CE/MPC/I/3, of March 3, 1989, at 16. (The Committee Report also states, "Originality [is] part of the definition of 'work' and ... a reference to it should be included in Section 2(1) .... The idea of providing a definition of the concept of 'work' was, however, opposed by a number of participants; it was felt that that question should rather be left to national legislation and/or to the courts.") *Id.*

<sup>155</sup> *Id.* While international meetings of this nature are not normative in nature, their findings are relevant as doctrinal input and in certain cases may reflect an existing international custom (see Article 38(1)(b) of the Statute of the International Court of Justice). The history of the Convention was also used extensively by a WTO dispute-settlement panel to interpret provisions of the Convention that were incorporated by reference into the TRIPs Agreement. See *supra* note 77.

<sup>156</sup> Draft Model provisions for Legislation in the Field of Copyright. Memorandum prepared for the WIPO Committee of Experts on Model Provisions for Legislation in the Field of Copyright, document CE/MPC/I/2-III of Oct. 20, 1988, at 10. Emphasis in original text.

The second element of the definition is that "is determined by the adjectives literary and artistic." *Id.*

if we are speaking of literary and artistic works, we are already using a term which means we are talking about personal creation or about an intellectual creation within the sphere of letters and the arts."<sup>157</sup>

The Convention itself provides two important hints as to what constitutes an original work. Article 2, when discussing the protection of collections, states that "[c]ollections of literary or artistic works such as encyclopedias and anthologies which, by reason of the selection and arrangement of their contents, constitute intellectual creations shall be protected as such, without prejudice to the copyright in each of the works forming part of such collections."<sup>158</sup> Again, as the court found in *Feist*, selection and arrangement are essentially choices that must be creative in order to generate copyright protection; and a creation may be considered "intellectual" if it fits that description.<sup>159</sup>

Finally, the TRIPs Agreement<sup>160</sup> only contains an a contrario definition, as it were. For the first time in an international agreement in this field a list of exclusions was agreed upon.<sup>161</sup>

#### IV. ASSESSMENT AND SYNTHESIS

##### A. The Key Role of Originality

There were two schools of thought in the United States when it came to defining originality in copyright law. The first, which we would call objectivist, defined it as something that resulted from skill and labor. The traditional British test<sup>162</sup> was to that effect; it was applied for several decades in Australia<sup>163</sup> and Canada,<sup>164</sup> and in a number of federal circuits in the United States prior to *Feist*.<sup>165</sup>

Led by France, nineteenth century civil law systems adopted an approach that required searching not for evidence of skill and labor but

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<sup>157</sup> The Acts of the Conference were reproduced in 1886-1986: Berne Convention Centenary (1986) at 179.

<sup>158</sup> Article 2(5). See supra note 145.

<sup>159</sup> See supra note 16 and accompanying text.

<sup>160</sup> See supra note 13. During the negotiation of the Agreement, the Swiss delegation had proposed a definition of "work" which would have included any literary or artistic creation of the mind, which has an original character, independent of its literary or artistic merit or commercial value. See GATT document MTN.GNG/NG11/W/73 of May 14, 1990.

<sup>161</sup> Article 9(2) of TRIPs states, "Copyright protection shall extend to expressions and not to ideas, procedures, methods of operation or mathematical concepts as such." This Article mirrors § 102(b) of the U.S. Copyright Act.

<sup>162</sup> See supra Part I.B.

<sup>163</sup> See supra Part I.D.

<sup>164</sup> See supra Part I.C.1.

<sup>165</sup> The Seventh, Eighth, and Tenth Circuits. See Meade, supra note 2, at 245.

rather for the mark of the author's personality in the work.<sup>166</sup> We would call this approach subjectivist.

Feist established, arguably for the first time with this level of clarity, that creative choices were what gives a work its originality.<sup>167</sup> A similar approach was followed in Canada in the *Tele-Direct* case.<sup>168</sup> In Britain and Australia, while the traditional skill and labor<sup>169</sup> approach is still applied by the courts, there is some evidence of a potential shift in two decisions of the U.K. House of Lords, towards something more than skill and labor. It seems logical to conclude that "original skill and labor" must mean something more than just skill and labor.<sup>170</sup>

In parallel, civil law systems adapted themselves to new technologies not by abandoning their traditional model based on the search for the mark of the author's personality, but rather by increasing the level of abstraction of the traditional concept, which led them to a doctrine of creative choices strikingly similar to the test articulated in *Feist* and *Tele-Direct*. This does not mean that the traditional approach is dead: clearly certain works of highly creative nature might contain so many creative choices that they in fact do "reflect the author's personality."<sup>171</sup> But other works, especially more technical creations, do not. Yet, they may still be protected by copyright.

This test based on creative choices is a more modern approach, which not only relieved a tension amongst U.S. federal circuits<sup>172</sup> but has the potential to bridge the conceptual gap between common law and civil law countries with respect to the core notion of originality. A copyright syzygy, as it were. *Feist* is not just a part of this new worldview of originality, it may have been the impetus for an international trend.<sup>173</sup>

The "new" test also provides a way to measure creativity by measuring the quality and quantity of creative choices.<sup>174</sup> Copyright statutes recognize a single originality standard, and this creativity standard clearly is not restricted to compilations. It has in fact been applied to several other types of works.<sup>175</sup> From a copyright standpoint, therefore, either a creation

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<sup>166</sup> See *supra* Part II.

<sup>167</sup> See *supra* note 16 and accompanying text.

<sup>168</sup> See *supra* note 79 and accompanying text.

<sup>169</sup> Referred to as "industrious collection" with respect to compilations.

<sup>170</sup> See *supra* note 63 and accompanying text.

<sup>171</sup> See *LUCAS & LUCAS*, *supra* note 122, at 77.

<sup>172</sup> See *supra* notes 5 and 15.

<sup>173</sup> See *SUNNY HANDA*, *COPYRIGHT LAW IN CANADA* 232-33 (2002).

<sup>174</sup> It may also be useful in applying the idea/expression dichotomic test. See *infra* note 184.

<sup>175</sup> *Atari Games Corp. v. Oman*, 979 F.2d 242 (D.C. Cir. 1992) (audiovisual works); *Ets-Hokin v. Sky Spirits, Inc.*, 225 F.3d 1068 (9th Cir. 2000) (photographs); *CMM Cable Rep, Inc. v. Ocean Coast Props., Inc.*, 97 F.3d 1504 (1st Cir. 1996) (promotional materials); *Boisson v. Am. County Quilts & Linens, Inc.*, 273 F.3d 262 (2d Cir. 2001) (letter patterns on quilts); *County of Suffolk, N.Y. v. First Am. Real Estate Solutions*, 261 F.3d 179 (2d Cir. 2001) (maps); *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101 (2d Cir. 2001) (jewellery designs); *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co., Inc.*, 74 F.3d 488 (4th Cir. 1996) (animal mannequins (sculptures)).

is original or it is not. If it is, then it is protected.<sup>176</sup> If a work contains just a sufficient number of creative choices,<sup>177</sup> then its creativity level (from a copyright perspective) is minimal. Then as the number increases, originality increases proportionally, which in turn may lead to a broader scope of protection.<sup>178</sup>

If the two major copyright systems appear to have almost melded one of the most fundamental notions, namely originality,<sup>179</sup> a key question remains: what exactly are "creative choices"?

## B. Creative Choices

The notion of creativity seems to be inexorably linked to the human mind.<sup>180</sup> But what is creativity? The exercise of choice? Computers can and do "choose" based on preprogrammed instructions; that does not make them authors.<sup>181</sup>

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<sup>176</sup> The U.S. statute is clear: "Copyright protection subsists, in accordance with this title, in original works of authorship." This does not mean that the scope of protection might not vary based on the degree of "extra" originality, i.e., originality that surpasses the threshold. See Michael J. Meurer, *Copyright Law And Price Discrimination*, 23 *CARDOZO L. REV.* 55, 108 (2001); and *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349- 51 (1991).

<sup>177</sup> See *Key Publ'ns, Inc. v. Chinatown Today Publ'g Enters., Inc.*, 945 F.2d 509, 513 (2d Cir., 1991) ("Selection implies the exercise of judgment in choosing which facts from a given body of data to include in a compilation"). As we shall see in the next section, certain creative choices might be qualitatively more important for purposes of copyright protection, and fewer of those would thus be required.

<sup>178</sup> See *supra* note 170.

<sup>179</sup> To quote the High Court of Australia, "that in copyright law the two expressions 'author' and 'original work' have always been correlative; the one connotes the other." *Sands & McDougall Pty., Ltd. v. Robinson*, (1917) 23 *C.L.R.* 49, 56.

<sup>180</sup> The Federal Court of Appeal got to the same conclusion but from the reverse perspective in *Tele-Direct* (see *supra* note 78 at ¶ 3): "The word 'author' conveys a sense of creativity and ingenuity."

<sup>181</sup> See *Matthew Bender & Co. v. West Publ'g Co.*, 158 F.3d 693, (2d Cir. 1998) ("West concedes that the pagination of its volumes -- i.e., the insertion of page breaks and the assignment of page numbers--is determined by an automatic computer program, and West does not seriously claim that there is anything original or creative in that process."). See also Evan H. Farr, *Copyrightability Of Computer-Created Works*, 15 *RUTGERS COMPUTER & TECH. L.J.* 63, 65 (1989) ("In order to qualify as a 'work of authorship,' a work must evidence some intellectual creativity. To be an 'original' work of authorship, as required by the statute, the work must be original to the author, i.e., the work must owe its origin to the author and the author must not have copied it from another work. A human author easily can meet these requirements of originality and intellectual creativity. For a computer, the legal task of creating an 'original work of authorship' might be somewhat more difficult."). In its Final Report, the National Commission on New Technological Uses of Copyrighted Works (CONTU) found there was "no reasonable basis for considering that a computer in any way contributes authorship to a work produced through its use." *NATIONAL COMMISSION ON NEW TECHNOLOGICAL USES OF COPYRIGHTED WORKS FINAL REPORT* 44 (1978). See also Arthur R. Miller, *Copyright Protection for Computer Programs, Databases, and Computer-Generated Works: Is Anything New Since CONTU?*, 106 *HARV. L. REV.* 977 (1993); and Daniel Gervais, *The Protection Under International Copyright Law of Works Created With or By Computers*, 5 *Int'l Rev. of Indus. Prop. & Copyr. L.* 629 (1991). One could add that the question arises not only whether computers can be authors, but also non-worldly entities, as in *Urantia Found. v. Maaherra*, 114 F.3d 955, 958 (9th Cir. 1997) ("it is not creations of divine beings that the copyright laws were intended to protect, and that in this case some element of human creativity must have occurred.").

We suggest that a definition of the notion of "creative choice" that would meet the requirements of international treaties, and mesh with Feist, Tele-Direct and civil law system definitions is as follows: a creative choice<sup>182</sup> is one made by the author<sup>183</sup> that is not dictated<sup>184</sup> by the function of the work,<sup>185</sup> the method<sup>186</sup> or technique used, or by applicable

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<sup>182</sup> "Choice" is used here in the traditional sense of an act or instance of choosing (among a number of possibilities).

<sup>183</sup> This expands on the notion that the choice must be made "independently" by the author. See Feist, 499 U.S. at 346 and *CMM Cable Rep, Inc. v. Ocean Coast Props., Inc.* 97 F.3d 1504, 1516 (1st Cir. 1996). See *Urantia Found. v. Maaherra*, 114 F.3d 955 (9th Cir. 1997).

<sup>184</sup> This terminology was used in *CDN, Inc. v. Kapes*, 197 F.3d 1256, 1259 (9th Cir. 1999), a case that interpreted Feist rather narrowly. It was also in the famous *Computer Associates v. Altai* decision, 982 F.2d 693 (2d Cir. 1992), in a different context, namely the idea/expression dichotomy. ("Professor Nimmer suggests, and we endorse, a 'successive filtering method' for separating protectable expression from non-protectable material. ... This process entails examining the structural components at each level of abstraction to determine whether their particular inclusion at that level was 'idea' or was dictated by considerations of efficiency, so as to be necessarily incidental to that idea; required by factors external to the program itself; or taken from the public domain and hence is non-protectable expression.") *Id.* at 707.

<sup>185</sup> As the numbering system to serve as a shorthand description of the relevant characteristics of each fastener described in *Southco, Inc. v. Kanebridge Corp.*, 258 F.3d 148, 152 (3d Cir. 2001) ("*Southco* uses product numbers that convey specific properties of the products manufactured. The numbers are not assigned at random or in sequence; they are assigned based on the properties of the parts. The Numbering System is a complex code expressing numerous detailed features of *Southco* hardware products; each part number tells the story of a part's size, finish, and utility").

Under this system, each fastener was assigned a unique nine-digit number, with each digit describing a specific physical parameter of the fastener. The "market" may by extension be considered as a "functional requirement" if what is required is so clear as not to leave room for creativity. See, e.g., *Warren Publ'g, Inc. v. Microdos Data Corp.*, 52 F.3d 950, 1520 (11th Cir. 1995) ("The mere discovery of an organizing principle which is dictated by the market is not sufficient to establish creativity."); but see *CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports, Inc.*, 44 F.3d 61 (2d Cir. 1994) ("The fact that an arrangement of data responds logically to the needs of the market for which the compilation was prepared does not negate originality. To the contrary, the use of logic to solve the problems of how best to present the information being compiled is independent creation.").

<sup>186</sup> In the sense of the creation method. The creation of a method (e.g., to present facts) would be copyrightable. See, e.g., *Eng'g Dynamics, Inc. v. Structural Software, Inc.*, 26 F.3d 1335, 1346 (5th Cir. 1994), supplemented by 46 F.3d 408 (5th Cir. 1995).

standards<sup>187</sup> or relevant "good practice."<sup>188</sup> Conversely, purely arbitrary or insignificant<sup>189</sup> selection is insufficient.<sup>190</sup> A conscious, human choice must have been made, even though it may be irrational.

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<sup>187</sup> Or "garden-variety" variations on a theme. See *Feist*, 499 U.S. at 362. See also *Perma Greetings, Inc. v. Russ Berrie & Co.*, 598 F. Supp. 445, 448 (D.C. Mo. 1981) ("Cliched language, phrases and expressions conveying an idea that is typically expressed in a limited number of stereotypic fashions, [sic] are not subject to copyright protection"); and *CMM Cable Rep, Inc. v. Ocean Coast Props., Inc.*, 97 F.3d 1504, 1520 (1st Cir. 1996). This concept is similar to the notion of "non-obvious" described in *Matthew Bender & Co. v. West Publishing Co.*, 158 F.3d 674, 682-83 (2d Cir. 1998); or of "mechanical or routine" in *Feist*, 499 U.S. at 362; *Mid-America Title Co. v. Kirk*, supra, note 41, at 680; and *BellSouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc.*, 999 F.2d 1436, 1443 (11th Cir. 1993), cert. denied, 510 U.S. 1101 (1994).

<sup>188</sup> See *Victor Lalli Enters., Inc. v. Big Red Apple, Inc.*, 936 F.2d 671, 673 (2d Cir. 1991) ("In Lalli's charts, as Judge Glasser correctly found, he arranges factual data according to 'purely functional grids that offer no opportunity for variation.' The format of the charts is a convention: Lalli exercises neither selectivity in what he reports nor creativity in how he reports it.").

<sup>189</sup> See *Donald v. Zack Meyer's T. V. Sales & Serv.*, 426 F.2d 1027, 1030 (5th Cir. 1970), cert. denied, 400 U.S. 992 (1971). This case was blended in with *Feist* by the Fifth Circuit in *Engineering Dynamics, Inc. v. Structural Software, Inc.*, 26 F.3d 1335 (5th Cir. 1994), reh'g denied, 46 F.3d 408 (5th Cir. 1995) ("the input/output formats fail to satisfy the *Feist-Zack Meyer's* originality test. In *Feist*, the Supreme Court held that an alphabetically arranged phone book lacks the creativity and originality necessary to sustain a copyright. In ... the *Zack Meyer's* case, this circuit held that boilerplate contractual language printed on a blank form was insufficiently original."). Id. at 1345.

<sup>190</sup> See, e.g., *Mitel, Inc. v. Iqtel, Inc.*, 124 F.3d 1366, 1373-74 (10th Cir. 1997).

One element of this definition that might seem controversial is the exclusion of choices dictated by the function of the work. This in fact is very close to the test of "practical inevitability" in *Feist*: if function dictates the course to be followed, there is no room for creativity. From a copyright standpoint, therefore, the result is indeed "inevitable."<sup>191</sup> Function is meant here in a technical sense; it is also linked to the interface between copyright and industrial designs. An example would be a chair or table: if a leg were added at a specific location to make sure the chair would support the weight of a person, then that choice would be functional. To benefit from copyright protection, an author would have to show that other choices were made, such as when deciding the aesthetic shape of the leg, etc.<sup>192</sup> An application of this element of the suggested definition is illustrated in *Allen-Myland v. IBM*.<sup>193</sup> *Allen-Myland* argued that portions of computer code that were added to an existing IBM program lacked originality because programming choices were dictated by earlier programming choices.<sup>194</sup> The court found that there were creative choices because IBM's programmers had to pick from several possibilities for both the structure and the data.<sup>195</sup>

A similar decision was reached by the Second Circuit in a case involving a symmetrical placement of roses in a textile pattern which, the defendant argued, was dictated by a desire to lower manufacturing costs.<sup>196</sup> The court's decision hinged on whether within that desire to reduce costs there was still room for an "artistic" (non-dictated) decision.<sup>197</sup>

Following applicable standards means that there is no room for creative choices.<sup>198</sup> The same conclusion would be reached if choices were dictated by the mere application of relevant principles.<sup>199</sup>

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<sup>191</sup> *Feist*, 499 U.S. at 363.

<sup>192</sup> This distinction between utilitarian and aesthetic is fairly common. See, e.g., *Wal-Mart Stores v. Samara Bros., Inc.*, 529 U.S. 205, 214 (2000). The definition does not take account of the option under Article 2(7) of the Berne Convention for countries not to protect works of applied art under copyright if "special protection" is granted.

<sup>193</sup> 770 F. Supp. 1004 (E.D. Pa. 1991).

<sup>194</sup> *Id.* at 1011.

<sup>195</sup> *Id.* at 1012.

<sup>196</sup> *Folio Impressions v. Byer California*, 937 F.2d 759, 763-64 (2d Cir. 1991).

<sup>197</sup> *Id.* at 764-65.

<sup>198</sup> See *Mid-Am. Title Co. v. Kirk.*, 59 F.3d 719, 722 (7th Cir.), cert. denied, 516 U.S. 990 (1995).

<sup>199</sup> As the criteria used for selecting data in the *BellSouth* case (see *supra* note 41). As the court noted, a technique I always used to gather data, but that does not mean that copyright protection applies ("To be sure, [BellSouth] employed a set of strategies or techniques for discovering this data. Any useful collection of facts, however, will be structured by a number of decisions regarding the optimal manner in which to collect the pertinent data in the most efficient and accurate manner. If this were sufficient, then the protection of copyright would extend to census data ..."). *Id.* at 1441. See also *Reytblat*, *supra* note 32, at 200-02.

This also means that "true" artistic works<sup>200</sup> (arguably with purer aesthetic considerations) are protected: the vast majority of the choices made by an author of a novel or painting clearly are not dictated (or "inevitable") by function, technique or standards.<sup>201</sup>

Perhaps the best way to illustrate the application of the proposed definition is to look at the art of photography. Photographs involve several technical choices made by the photographer (use of a filter, aperture, etc.). These choices are usually dictated by good photographic practices. It is not those choices that may give rise to copyright protection but rather non-dictated choices such as pose, angle, décor, lighting arrangements, etc.<sup>202</sup> This notion brings us to *Bridgeman Art Library, Ltd. v. Corel Corp.*<sup>203</sup> The court had to decide whether "technically perfect" photographs of public domain paintings were copyrightable.<sup>204</sup> Because no copyright subsisted in the works of art per se, the only possible copyright was in the photographs themselves. Undoubtedly, making perfect photographic reproductions of works of art requires a high degree of skill and technique, in other words, considerable skill and labor.

Because the photographs were made by a British photographer, Judge Kaplan decided to analyze their copyright status from both a British law and American law perspective: "[b]ut one need not deny the creativity inherent in the art of photography to recognize that a photograph which is no more than a copy of the work of another as exact as science and technology permit lacks originality. That is not to say such a feat is trivial, simply not original."<sup>205</sup> Quoting in part from *Durham Industries, Inc. v.*

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<sup>200</sup> Terminology in this area is problematic. A distinction is sometimes made between "low authorship" and "high authorship" works. See Jane Ginsburg, No "Sweat"? Copyright and Other Protection of Works of Information after *Feist v. Rural Telephone*, supra note 14, at 340-41. We find that these terms can be misleading. Originality should be seen as a continuum. Above a minimum threshold, protection under copyright arises. This is, in fact, the central message in *Feist*. Above that threshold, originality increases gradually. An essay or how-to book, for example, could be viewed as a "medium authorship" situation. An interesting example is the case of *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257 (11th Cir. 2001), in which the court found that *Gone With the Wind* was "undoubtedly entitled to the greatest degree of protection as an original work of fiction." *Id.* at 1271.

<sup>201</sup> The determination of whether choices were dictated or not would seem to be a question of fact more than law. See *Reytblat*, supra note 199, at 207-12.

<sup>202</sup> See supra note 19 and accompanying text.

<sup>203</sup> See supra note 39.

<sup>204</sup> *Bridgeman Art Library, Ltd. v. Corel Corp.*, 25 F. Supp. 2d 421, 427-28 (S.D.N.Y. 1998).

<sup>205</sup> *Id.*

Tomy Corp.,<sup>206</sup> he adds, "[t]here has been 'no independent creation, no distinguishable variation from preexisting works, nothing recognizably the author's own contribution' that sets Bridgeman's reproductions apart from the images of the famous works it copied."<sup>207</sup> The Court found that the same result would be reached under U.K. law, because the photograph was simply copied from another work.<sup>208</sup>

Contrast this *Corel* case with *United States v. Hamilton*,<sup>209</sup> in which the Ninth Circuit found that photographs of a vodka bottle used to create promotional material were original because "creative decisions involved in producing a photograph may render it sufficiently original to be copyrightable and [courts] 'have carefully delineated selection of subject, posture, background, lighting, and perhaps even perspective alone as protectable elements of a photographer's work.'"<sup>210</sup> In other words, non-dictated choices had been made.

In the case of compilations, it is even easier to apply the test. Taking a Feist-type compilation (telephone directory), one can see that the efforts needed to amass the data are not "creative." Similarly, sorting the data according to a standard of "good practice" filter (such as alphabetical order) is uncopyrightable. Our proposed definition would lead one to the conclusion that a database in which all available data on a topic is entered is not protected under copyright.<sup>211</sup> The creative choices that render a compilation protected can be made through a selection or arrangement<sup>212</sup> that is not "dictated."<sup>213</sup> For example, the selection of poems for an anthology requires an intellectual effort that is not entirely dictated by standards and technique. Otherwise all anthologies would be almost identical.<sup>214</sup>

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<sup>206</sup> 630 F.2d 905, 910 (2d Cir. 1980).

<sup>207</sup> *Bridgeman*, 25 F. Supp. 2d at 427.

<sup>208</sup> *Id.* at 426.

<sup>209</sup> 583 F.2d 448, 452 (9th Cir. 1978). This quote was mentioned with approval post-Feist in *Los Angeles News Serv. v. Tullio*, 973 F.2d 791, 794 (9th Cir. 1992); and *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068, 1077 (9th Cir. 2000).

<sup>210</sup> *Id.*

<sup>211</sup> Other forms of protection are available. See *supra* note 43 and accompanying text.

<sup>212</sup> The presentation of a compilation (book cover, etc.) is also copyrightable of course, but its protection is independent from the protection of the compilation as such.

<sup>213</sup> See *supra* note 184 and accompanying text.

<sup>214</sup> See *Eckes v. Card Prices Update*, 736 F.2d 859, 862-63 (2d Cir. 1984) (choice of best baseball cards).

Compilations that hover just beyond the threshold will only have thin copyright protection.<sup>215</sup> But the key point is to determine whether they display creative choices, even when other copyrighted works may well exceed by far that minimum line.<sup>216</sup>

## CONCLUSION

We began this article by recalling that in *Feist v. Rural Telephone*, the Supreme Court not only relieved a tension among federal circuits concerning the definition of the notion of originality but in fact established a constitutionally-based standard to determine the copyrightability of all categories of copyrighted works. This test was applied and explained in several decisions since 1991.

In examining the notion of originality of other common law countries, we showed that Canada seems to be in the process of adopting *Feist*, while Australia recently refused to do so and, for the time being at least, retains an equivalent of the "sweat of the brow" test. In the United Kingdom, perhaps in response to the progressive harmonization of copyright within the European Union, there is some movement towards a redefinition of the notion.

In civil law systems, while the traditional test to determine whether a work was original was the search for a mark of the author's personality in the work, modern forms of creation such as computer programs and databases have made this test difficult to use. In response, courts have elevated the level of abstraction of the test and as a result are applying a test based on creative choices very similar to the one articulated in *Feist*. This modern test is also fully compatible and in keeping with the history and wording of the Berne Convention.

There thus seems to be emerging an international consensus that originality is not only copyright's single "sieve," but also, and more importantly, that the presence of creative choices in the making of the work is the only adequate test to determine whether the work is worthy of copyright protection.

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<sup>215</sup> See *TransWestern Publ'g. Co., LP v. Multimedia Mktg. Assocs., Inc.*, 133 F.3d 773, 776-77 (10th Cir. 1998); and 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03[A], at 13-28 (1997).

<sup>216</sup> See *supra* note 37 and accompanying text.