

**The originality requirement in EU and U.S., different approaches and
implementation in practice**

ABSTRACT

The main subject of this paper is originality as a selection filter qualifying the works to be protected by copyright. Bearing in mind the importance and financial value of creative industries and the tendency of their further growth, the matter of legal protection of intellectual creations plays significant role. The comparative analyses between different approaches in EU and U.S. law shall be conducted, with an idea to define their main features and discuss on their impact on further development of copyright law in international level. Given the role of EU and U.S. markets on international level, we will try to determine if there is the tendency of further differentiation between implementation of originality requirement in the two compared systems, or their unification should be expected in near future.

We shall examine the hypothesis that the originality should be the main and only criteria making the difference between the works to be protected from the ones that should not. Furthermore, it will be analyzed whether the originality requirement should be applied in the same manner for different types of works of authorship.

By researching on relevant legislation and case law, the paper shall hopefully contribute to the discussions on role and limits of copyright protection.

Key words: copyright, originality requirement, intellectual creation, creativity, work of authorship

LIST OF CONTENTS

INTRODUCTION.....	3
SECTION 1: COPYRIGHT LAW – BASICS	5
1. Historical background	5
2. Justification of protection.....	7
3. Subject matter of protection	9
4. Originality requirement	10
SECTION 2: EUROPEAN UNION ORIGINALITY APPROACH.....	12
1. UK copyright regime.....	12
2. French and German copyright regimes	15
3. EU copyright regime	16
a) Information Society Directive	16
b) The history of “author’s own intellectual creation” criterion.....	18
c) Infopaq v. Danske.....	19
d) Painer v. Standard.....	22
e) Flos	24
f) Bezpečnosti softwarova asociace	24
g) Football Dataco v. Yahoo!Uk Ltd.....	26
h) Directives on protection of databases, computer programs and photographs – the same criterion? 26	
i) Conclusion on EU case law	29
SECTION 3: U.S. ORIGINALITY APPROACH.....	30
1. Legislative acts	30
2. Feist	32
3. Original = human origin?	36
a) Naruto.....	36
b) Artificial intelligence.....	37
c) Concluding remarks on originality criteria in U.S. legal practice	41
SECTION 4: COMPARATIVE ANALYSES	43
CONCLUSION	45

INTRODUCTION

Intellectual creations present important asset in today's society. Their value is multilateral – emotional, artificial, financial. The exclusive rights in the products of mind are legal tool for expressing and enforcing the mentioned values. Thus, the question of criteria for copyright protection plays significant role not only for authors, but for users of copyrighted works as well. The holder's control over the dissemination of protected work enables her to acquire the economic benefits being the incentive for further creation of works of authorship. The diversity of creative products contributes to the overall social welfare, at the end. Due to the mentioned, defining the criteria for protection is of major importance for all interested subjects – holders, being interested in as lower standards for protection as possible, and users, being interested in as higher standards as possible, given that the same enable more works to be in public domain. The application of originality requirement is balancing tool functioning as specific selection filter determining the works of authorship to be protected.

Neither EU nor U.S. has defined the originality requirement through their legislative acts, however both systems has developed the standard through case law and relevant decisions of Court of Justice and Supreme Court. In order to establish the similarities and differences in their approaches, the comparative analyses shall be conducted. We shall tend to define the role of originality and examine the implications of its interpretation with respect to different types of works.

In the First part of Paper, the discussion will be focused on historical background, basic institutes and justification for protection. It is important to establish the reasons for

copyright protection, given that the same determine requirements which should specify the intellectual goods to be protected – originality, among others.

In the Second part of Paper the main solutions in EU law will be presented, exploring the differences between regimes of Member States, especially when it comes to defining the subject matter of protection. We will also examine the approach of the current EU legislation with regard to the originality requirement and examine the relevant court decisions of Court of Justice. Special focus will be made on the EU directives specifying the originality requirement, such as those regulating databases, photographs and software. The aim will be to determine if the originality requirement is treated in a consistent manner and also to establish the role it will have in future development of copyright law.

The Third part will be dedicated to the analyses of U.S. law approach. We will take into consideration an important role of relevant case law, apart from legislative acts. We will tend to determine the consequences that inconsistent interpretation of this standard might have as well as to explore the challenges of its implementation in future.

In the Fourth part of Paper the comparative analyses between different approaches in EU and U.S. legal regimes shall be conducted. The idea is to define the main differences and discuss on their impact and importance for further development of copyright law.

PART 1: COPYRIGHT LAW – BASICS

1. Historical background

It is impossible to understand the substance of copyright law without knowing when and how society recognized the necessity for the protection of literary and artistic works. If we see how the need for such a protection had been transformed through time, it may help to better understand its substance and to anticipate its progress in future. The first chapter of this paper shall examine the historic background of copyright protection.

Before fifteenth century, author's rights were not recognized at all – one could say that it is rather surprising that such a complex and developed legal system, such as Roman law, did not regulate the matter of rights on intellectual creations. However, Mr. Gutenberg¹ fired a spark which brought the copyright into the light – it all started with printing revolution and the system of privileges². Once the massive production of written works was enabled, the states recognized the importance of its control bearing in mind the consequences of easy information transmission on the one side, and the support to the local industry, on the other. Thus, the initial interest provoking the regulation of author's rights was not the individual one but the public one. At the beginning, the concept was very different from the current one – the right to print lied with the state authorities, and one could obtain

¹ For more on printing revolution and the history of copyright see: J. C. Ginsburg, "Overview of Copyright Law", Oxford Handbook of Intellectual Property, Rochelle Dreyfuss & Justine Pila, Eds., Columbia Public Law, available at <http://www.thecameraclinks.com/CopyrightLaw.pdf.pdf>.

² On printing privileges, see, eg, Elizabeth Armstrong, "Before Copyright: The French Book-Privilege System 1498–1526" (CUP 1990).

entitlement to do the same only through the grant of a privilege (in France) or through a guild system (in England).³

However, as a consequence of revolution period in XVII and XVIII century, the mentioned systems were swept away and the statutory protection for authors was introduced. While the French Revolution shaped the development of most national laws in Europe, the first Constitution of USA was ratified on the other side of the globe. All national laws recognized copyright as the right which lies with the author – natural person who created the work. However, apart from the mentioned point of overlap, national laws further developed in different directions and consequently the copyright law also followed the different paths of civil and common law systems. We will see if and how this development in U.S. and Europe had any effect to the meaning and the role of originality requirement in those jurisdictions.

Today, we can say that copyright law is somewhat harmonized through many international and bilateral treaties – however the same is very far from unified rules of protection. The fact that U.S., one of the countries with the most powerful economy in the world, became a party to the Bern Convention (being the oldest and probably the most significant international treaty in the field on copyright law⁴) after a century of its existence, resembles how difficult it is to reconcile different approaches to some of the basic copyright issues.

³ See John Feather, "A History of British Publishing" (Routledge 1988) 31–32.

⁴ For more see Ricketson and Ginsburg, "International Copyright and Neighbouring Rights: the Berne Convention and Beyond", Oxford University Press, second edition, 2006.

We can conclude that somewhere between the systems of privileges and today, the copyright law became one of the basic human rights regulated through the supreme national legal acts, where the interests of the author are brought to the light.

2. Justification of protection

It is impossible to understand the substance of copyright law without defining the reasons for its protection. Once it is established why the legal system regulates copyright, its scope and targeted works to be covered will be determined. There are several approaches to the matter of justification the copyright protection today – a distinction shall be made between the economic approach as a dominant one on the one side, and the rest of the theories on the other.

The utilitarian approach is based on the following principles – copyright law provide incentives for production of copyright works and their dissemination, which indirectly enhances the social welfare⁵. Thus, through the monopolistic nature of the right and holder's exclusive entitlements, the author is able to gain economic benefits and thus supported to continue to involve his efforts in the creation of new works of authorship. Notwithstanding the objections that could be raised in respect of the mentioned justification⁶, it is the dominant theory widely accepted.

⁵ Slobodan Marković, *Intellectual property and information society*, University of Belgrade Faculty of Law, 2014.

⁶ Zimmerman, Diane Leenheer, "Copyrights as Incentives: Did We Just Imagine That?" (November 30, 2009). *Theoretical Inquiries in Law*, Available at SSRN: <https://ssrn.com/abstract=1515964>.

However, the constant tension between the interest of an author as an individual and the public interest having the economic background was subject of some other theories which explain the copyright protection in a different manner. For example, the theory of human rights – the right to intellectual property of an individual is regulated as one of the basic human rights (as stipulate by Charter of fundamental rights of the European union⁷ and Universal declaration on human rights⁸). However, bearing in mind that copyright protection is not absolute it does not seem that this justification fits in currently existing system of its limitations. The other one follows the logic of typical property right approach – the authors enjoy protection as their works belong to them, the same are the products of their intellectual work and the absolute right should be established for its protection⁹. However, this standing does not explain the limitation of term of copyright protection, nor the whole system of its limitation. There are also theories relying on Loch’s labor theory¹⁰ – people should enjoy legal protection on the works being the products of their work. Furthermore, there are theories having their philosophical foundation in Kant and Hegel with the personality theory¹¹ – the personal connection between the author and his work is what justifies the legal protection, as the work presents embodiment of author’s personality.

⁷ See Article 17 of the Charter of fundamental rights of the European Union, (2000/C 364/01). Full text available at: https://www.europarl.europa.eu/charter/pdf/text_en.pdf.

⁸ See Article 27 of the Universal declaration on human rights, full text available at: <https://www.un.org/en/universal-declaration-human-rights/>.

⁹ Mossoff, Adam, “Is Copyright Property?”, (October 1, 2010). San Diego Law Review, Vol. 42, p. 29, 2005. Available at SSRN: <https://ssrn.com/abstract=491466>

¹⁰ Joseph A. Gerber, “Locking Out Locke: A New Natural Copyright Law”, 27 Fordham Intell. Prop. Media & Ent. L.J. 613 (2017) Available at: <https://ir.lawnet.fordham.edu/iplj/vol27/iss3/4>

¹¹ Yoo, Christopher S., “Copyright and Personhood Revisited” (September 18, 2012). U of Penn Law School, Public Law Research Paper No. 12-39. Available at SSRN: <https://ssrn.com/abstract=2160441>.

As mentioned before, the most popular justification theory is the neoliberal utilitarian economic theory – the one treating the information being the communicated through the work of authorship as a public good, and explaining the reasons for its monopolization through economic consequences on the author, right holders and society. Now, we will put the subject matter of this paper, originality requirement, in the context of presented theory. It seems that the same serves as a tool making a difference between those works (information) which shall be justifiably monopolized, from those which shall, as a rule, remain in public domain. Thus, we may conclude at this point that the originality requirement is what makes copyright protection the exceptional treatment of information's expression, in comparison to the common one where the information and its expression is free and available to everyone.

3. Subject matter of protection

There are two different approaches when regulating the subject matter is concerned. The first one is, for example, adopted in UK law¹², where the law prescribes the exhaustive list of works to be protected¹³. The other one is the *open list* approach, implemented in both EU and U.S. law. For example, the Copyright Law of the United States¹⁴ (hereinafter Copyright Act 1976) stipulates that *copyright protection subsists in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a*

¹² T. Aplin and J. Davis, *Intellectual property law*, Oxford University Press, third edition, 2017, 75.

¹³ Copyright, Designs and Patents Act 1988, 1(1), eight categories are: literary, dramatic, musical, artistic works, films, sound recordings, broadcasts and typographical arrangements of published editions.

¹⁴ Copyright Law of the United States, 1976, 102(a).

machine or device. Furthermore, most of EU member states implement the same approach, prescribing only the basic requirements the work has to meet in order to be protected¹⁵.

The latter system seems to be the one where originality requirement plays more important role, as it is to be applied to very different types of works. Apart from originality, there are also two other criteria commonly being used to determine the works to be protected - the form expression request (so called idea-expression dichotomy¹⁶ - impossibility to protect the ideas, procedure, process, system, method of operation, concept, principle or discovery), as well as the human creation criteria (which shall be challenged in the further chapters of Paper). Among three of those, the originality is the most problematic one as there are no clear rules (or rules at all) on how to examine and estimate the same. Thus, we could conclude that the originality requirement is closely related to the question of subject matter of protection.

4. Originality requirement

Some theorists claim that the principle of originality corresponds in some way to the principle of distinctiveness of the mark in trademark law and inventiveness of invention in patent law¹⁷. It is the characteristic of the work which makes the same suitable for copyright protection. However, there are many types of works that can be subject to legal protection and it is difficult to establish unique standard of originality for all potentially protectable intellectual

¹⁵ For example, French Law on copyright regulates *the rights of authors in all works of the mind, whatever their kind, form of expression, merit or purpose*.

¹⁶ Karim, Md. Rezaul, "The Idea/Expression Dichotomy and Its Impact on the Blurring Copyright-Patent Paradigm" (January 20, 2014). Available at SSRN: <https://ssrn.com/abstract=2498867>.

¹⁷ Slobodan Marković, *Intellectual property and information society*, University of Belgrade Faculty of Law, 2014.

creations. Similarly as distinctiveness¹⁸ in trademark law, originality is to be assessed taking into consideration human intellectual performances and psychological potentials.

It is important to define whether the originality is subjective or objective concept. In other words, whether the same should be examined with respect to the author's characteristics, or with respect to some general, common standard of human creativity or intellectual potential. Thus, it will be examined from which of the following two aspects should originality requirement be considered:

- Objectively – originality with respect to the type of works in question;
- Subjectively – originality with respect to the author's intent;

Furthermore, it could be explored whether it has unique role. Apart from being the selection tool when it comes to eligibility for protections, originality requirement could also be important element in infringement analysis. When the work is partially reproduced, the existence of infringement could depend on the fact whether the original elements were copied. This dual potential of originality requirement shall be in special focus of our research.

¹⁸ The distinctiveness presents capability of a mark to perform the distinguishing function in relation to the specific goods. The lack of mark's distinctiveness presents absolute ground for refusal of protection.

PART 2: EUROPEAN UNION ORIGINALITY APPROACH

Before we conduct the in-depth analyses of originality requirement as regulated on EU level, we shall present the examples of treatment of this matter in other jurisdictions influencing the mentioned legal system – United Kingdom, Germany and France approach.

In order to examine whether the test of originality is equally regulated, we shall take into consideration legislative background and relevant case law.

1. UK copyright regime

UK copyright law is unusual not only as it grants copyright protection for works listed in exhaustive manner, but also as the originality requirement is not equally set; namely, the same is necessary only for literary, music, dramatic and artistic work¹⁹. Furthermore, originality requirement is only specified for databases, where it is prescribed that the original database means that it constitutes *author's own intellectual creation*. Thus, the originality test in UK is not merely “not copied”, as it is the case with films, broadcast, sound recording and typographical arrangement. One of the key decisions that concerned the originality test in UK copyright law was *Walter v Lane* (1900), where Lord Davey²⁰ defined the originality as skill and labor involved in creation of a work. Namely, the advantage of originality test as set in this decision is that the same presents clear criteria that differs the works – skill and labor is something that is measurable and definitely more concrete than the mere abstract term “original”. However, the disadvantage of this approach is that it is still not clear if any skill and labor (and judgment) constitutes the originality, or there is some level of the same to be achieved. Furthermore, it can be examined whether this criteria is applicable to other types of

¹⁹ CDPA 1988, 1(1)(a).

²⁰ *Walter v Lane* (1900) AC 539.

works apart from literary works. At *Ladbroke (Football) Ltd v William Hill (Football) Ltd* (1964)²¹, the main question was whether the originality can be claimed in the betting coupon. The second issue was about the relevance of the effort invested in deciding on bets to include. From this decision arose important rule that “originality of compilation is a matter of degree depending on the amount of skill, judgment or labor that has been involved in making the compilation”. The first conclusion that we make is that compilation of some elements can be considered original, regardless the mere elements and their individual originality. The second is that certain degree of skill, labor or judgment is to be involved in order achieve the originality threshold.

We find this case interesting for another reason too. Namely, the matter of originality was not considered here only in a context of copying the prior existing work, but as a filter that should differ those human creations that deserve protection from those which should not, regardless the fact that they originate from the author (i.e. are not copied from anyone else). We believe that it is important to recognize and emphasize this dual nature and purpose of the originality requirement – to both make a barrier to copying (and thus free riding on other’s work) and to differentiate those human creations that should be protected.

The second significant decision which considered the principle set in *Walter v. Lane* was the *Interlego v Tyco* (1989)²². This case is important as it considered whether the originality test “skill, labor and judgment” was applicable to other categories of works such as artistic works. Furthermore, it brought a conclusion that may be considered in direct conflict with the principles established by the previously discussed cases. This decision expresses opinion that the “skill, judgment or labor merely in the process of copying cannot confer originality”.

²¹ *Ladbroke (Football) Ltd v William Hill (Football) Ltd* (1964) 1 WLR 273.

²² *Interlego v Tyco* (1989) AC 217.

Furthermore, it considered the difference between quantitative and qualitative alterations of the earlier work and their contribution to the originality, establishing that qualitative ones are of greater weight when it comes to the contribution to the originality. We may conclude that this decision confirms that the originality test should be “not copied plus skill, labor and judgment”.

The other decision where the originality of artistic works was commented, *Antiquesportfolio.com plc c Rodney Fitch & Co. Ltd*²³, set the rule on originality of photographs of a static three-dimensional object. Namely, the test of originality is the same as there is also some skill and effort contained in the author’s choice of lighting, angling, positioning.

The decision that reconciled the tension between the cited decisions is the one made in *Hyperion Records v. Sawkins (2005)*²⁴, where the judge Jacob LJ stated that the difference should be made between servile copying and the forms of copying which do amount to originality. The judge referred to the authors of *Modern Law of Copyright* who elaborated on the process of making a reproduction of old master painting, claiming that there is significant skill and effort to be involved. Furthermore, this decision confirmed not only that the *Walter v. Lane* is still a good law, but that the same test is applicable to all other types of works subject to the originality requirement. It is also clearly stated that the originality requirement has nothing to do with the issue of quality of the work, but only with the efforts originated from the author, which were involved in the creation of a work.

²³ *Antiquesportfolio.com plc c Rodney Fitch & Co. Ltd* (2001) FSR 23.

²⁴ *Hyperion Records v. Sawkins* 12 (2005), EWCA Civ 565, (2005) RPS 32, (2005) 1 WLR 3281.

Given the aforementioned, it can be concluded that traditional originality test in UK copyright law set by relevant case law is the “skill, labor and judgment” test, supported with the “not slavish copy” requirement.

2. French and German copyright regimes

As far as French and German laws are concerned, we emphasize that the legislative regime has the most important role, as opposed to common law system jurisdictions which are equally based on case law. Namely, French Intellectual Property Code (1992) prescribes that *the author of a work of the mind shall enjoy in that work, by the mere fact of its creation, an exclusive incorporeal property right which shall be enforceable against all persons*²⁵. The term “work of mind” is the one that corresponds to the originality requirement as discussed in this paper. This expression was chosen as pointing out the character of intellectual and personal creation. When interpreting the mentioned term, the courts referred to the “imprint of the personality of the author”, “personal imprint”, “reflection of the personality of the author”, “imprint of creative personal talent” etc²⁶. Furthermore, different approach was expressed in the Pachot²⁷ case, which regarded the originality of computer programs and where the standard of “intellectual contribution” was set.

As far as German copyright law is concerned, the same is currently regulated by the Author’s Right Law (1965)²⁸. Works must be *personal intellectual creations* in order to be entitled for

²⁵ French Intellectual Property Code 1992, Article L111-1.

²⁶ André Lucas and Henri-Jacques Lucas, “Traité de la Propriété Littéraire et Artistique”, 2 ed. (Paris: Édition Litec, 2001).

²⁷ French Supreme Court, 1986, Babolat Maillot Witt v Pachot. The court found that the appealed judgment had correctly assessed originality since the computer programs resulted from ‘a personalized effort that goes beyond the mere application of an automatic and compulsory logic’ and they ‘had an imprint of an intellectual input’ by Mr. Pachot.

²⁸ Copyright Act of 9 September 1965 (Federal Law Gazette I p. 1273).

protection. It is interesting to emphasize that the German courts recognized the importance of differing this criteria when different types of works are concerned. Thus, there used to be a higher level of creativity requested for works of applied arts²⁹. Furthermore, German law developed the concept of “small change” of author’s rights according to which some works such as catalogues will have very low level of creative input but yet be protected, however with rather narrow scope of protection³⁰.

3. EU copyright regime

EU copyright law is regulated through several directives and regulations³¹; however we could not say that the same is highly harmonized, especially when it comes to the originality requirement. As will be discussed later, there is a uniform standard set by the case law; however the level of its implementation in national laws is still questionable. The mentioned discrepancy is caused by very different approaches of member states – while some of them apply open list system where any original work can be subject of protection, the others apply the opposite one. Furthermore, some of them recognize related rights and provide different scope of protection for their subject matters. As shown above, even the member states with identical copyright regime (in terms of mentioned differences) have different definitions of originality requirement.

a) Information Society Directive

²⁹ BGH Seilzirkus, GRUR (2012) 58, BGH Geburtstagszug, GRUG (2014) 175.

³⁰ The so called Small change concept was developed in Germany and it refers to the lowest level at which a work is eligible for protection as personal intellectual creation.

³¹ For more on the sources and the history of its development see E. Rosati, *Originality in EU copyright: Full Harmonisation through Case Law*, Cheltenham by Edward Elgar, 2013.

One of the main directives regulating copyright law is Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonization of certain aspects of copyright and related rights in the information society³² (hereinafter referred to as the Information Society Directive). It concerns the legal protection of copyright and related rights in the framework of the internal market, with particular emphasis on the information society. Some of the specific subject matters are excluded from its scope, given that the same are regulated by separate directives, such as computer programs, databases, rental right, lending right, the term, as well as certain rights related to copyright in the field of intellectual property. The Information Society Directive does not, however, regulate criteria for copyright protection, nor mentions originality requirement in any of its provisions. In its preamble, under the point 9, it explains the purpose of copyright protection as follows: *Any harmonization of copyright and related rights must take as a basis a high level of protection, since such rights are crucial to intellectual creation. Their protection helps to ensure the maintenance and development of creativity in the interests of authors, performers, producers, consumers, culture, industry and the public at large. Intellectual property has therefore been recognized as an integral part of property.* Thus, any conditions filtering the subject matters of protection have to be in line with the mentioned purpose – maintaining and development of creativity. Such aim is not set only in the interest of the authors, but also in the interest of public at large. The courts had developed the criteria of “author’s own intellectual creation”, which should be interpreted in line with cited justification of copyright protection.

³² Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society, Official Journal L 167 , 22/06/2001 P. 0010 – 0019. For more on the Directive and its influence see: Aplin, Tanya F., The Impact of the Information Society Directive on UK Copyright Law (July 1, 2018). Forthcoming, Brigitte Lindner and Ted Shapiro (eds), Copyright in the Information Society: A Guide to National Implementation of the EU Directive 2nd edition (Edward Elgar 2018) ; King’s College London Law School Research Paper No. 2019-16. Available at SSRN: <https://ssrn.com/abstract=3250388> or <http://dx.doi.org/10.2139/ssrn.3250388>.

b) *The history of “author’s own intellectual creation” criterion*

Before the originality regime in EU based on “author’s own intellectual creation” criterion is further analyzed, its history shall be presented. The standard was first introduced in the 1991 Directive as the intention was to overrule the criterion previously introduced by German Supreme Court in 1985. The German court found that the creative elements in a computer program should reflect creativity which surpasses the work of an average professional. In addition, the Court stated: *the minimum requirements of copyrightability are met only at a somewhat higher level. They presuppose a significant amount of creativity with respect to selection, accumulation, arrangement and organization, as compared to the general, average ability.*³³ This very high standard of originality was applied in Germany and was suggested to be applied overboard³⁴, and the “author’s own intellectual creation” was set in order to express refusal of such solution. Bearing in mind the reason of its introduction, some conclusions on the nature of criteria itself could be made. The inherent idea was obviously to underline that originality is subjective category, related to the author only, and that it should not be considered with respect to any other objective criteria, or depend on comparison with other authors creating the identical type of works. This is important as it indicates that any criteria not related to the author and its internal process, such as aesthetic or any other values, should not be taken into consideration. As we will see in the further text, this strictly subjective approach is not unanimously supported.

³³ Federal Supreme Court, May 5, 1985, Case No. I Zr 52/83.

³⁴ W. G. Karnell, “European originality: a copyright chimera”, Intellectual property and information law. Essays in Honour of Herman Cohen Jehoram, 1998.

It is interesting to examine what is the actual weight of the term “intellectual”. In other words, does the same excludes incidental works created by humans, which were not result of any intentional human activity but rather made by accident?

c) Infopaq v. Danske

We shall now analyze the most influential case law which introduced the “author’s own intellectual creation” criteria as requirement applicable to all types of works. The case is *Infopaq International A/S v Danske Dagblades Forening*³⁵ (hereinafter referred to as *Infopaq* case) and regards a dispute before Dutch court which addressed two questions to the Court of Justice regarding the scope of reproduction right and exemption of some acts as transient reproduction. The factual background will be briefly presented as follows³⁶: the plaintiff was Danish professional association representing local newspapers in copyright matters while the defendant was *Infopaq*, media monitoring organization which provides summaries of selected content to its subscribers. The summary which was provided included eleven words extracted on the base of one search term instructed by the user, plus five additional words which come after and before the searched word. The plaintiff claimed that the act of summarizing (storing and then printing out on a paper) in the described manner is to be considered the act of reproduction in terms of Information Society Directive. Although it is clear that the Directive establishes author’s exclusive right not only to prohibit the reproduction of its work in total, but also in part, it was unclear what the boundaries to the scope of right on partial reproduction are. When answering the raised questions, Court of Justice referred to the Bern Convention and its general scheme: “It is moreover, apparent from the general scheme of the Berne

³⁵ *Infopaq International A/S v Danske Dagblades Forening*, 2009, Case C-5/08.

³⁶ For more see Griffiths, Jonathan, “*Infopaq*, BSA and the 'Europeanisation' of United Kingdom Copyright Law” (March 4, 2011). *Media & Arts Law Review*, Vol. 16, 2011. Available at SSRN: <https://ssrn.com/abstract=1777027>

Convention, in particular arts 2 (5) and (8), that the protection of certain subject matters as artistic or literary works presupposes that they are intellectual creations³⁷”. Furthermore, it also referred to the three directives regulating the copyright in computer programs, databases and photographs, finding that the same are only protected if being original, i.e. author’s own intellectual creations. With the reference to the preamble of Information Society Directive, the Court concluded that its framework is based on the same principle, and thus ruled that the same criterion is to be applied to all subject matters. Deciding on the question on partial reproduction, the Court stated: “*the various parts of a work thus enjoy protection provided that they contain elements which are the expression of the intellectual creation of the author of the work*”³⁸.

The cited sentence is important as it implies that originality requirement could have two roles – not only being the selection filter determining which works should enjoy protection, but also influential factor when considering the infringement. When the unauthorized use concerns only some elements of the work, and not the work as a whole, it would be considered infringing only if the elements used meet the originality requirement, i.e. present intellectual creation of the author of the work.

Furthermore, the Court elaborated on the sort of author’s contribution which satisfies the set standard. It is pointed out that the form, the manner in which the subject is presented and the linguistic expression indicate the intellectual creation of the author. When it comes to the part of the work used and its eligibility for protection, the Court commented that the words as such do not constitute elements protected. Only their combination through the selection, choice and sequence could present the expression of author’s creativity. The Court avoided to expressly

³⁷ Paragraph 34 of the judgment, Case C-5/08.

³⁸ Paragraph 39 of the judgment, Case C-5/08.

decide on the sufficiency of eleven words in comparison to the whole newspaper article, declaring that it is on national court to make this determination. However, the Court did underline that printing out the extract of eleven words could not be considered a transient in nature, in terms of Information Society Directive.

Even though the discussed case regards the literary works only, it could be concluded that the Court introduced a generalized test of originality applicable (and obligatory) for all types of works. Although the harmonized standard had been set, it still remained open how should it be applied on some specific types of goods, such as musical works and similar. In opinion of the author, the set standard has two important elements determining the nature of the criteria; the first one is term *intellectual creation*, which means that any other creation made by humans and not being the result of intellectual work should be excluded³⁹. Furthermore, this element of the definition also implies that any work created by subject not being capable of having intellectual internal processes should not be protected, regardless any other value such as aesthetic, financial, its purpose and similar. The second element of the standard is the term “own”, underlying the importance of connection between the author and its work. On one side, this element corresponds to the “not copied” requirement as recognized through UK practice. On the other side, it emphasizes the inherent individualism in nature of copyright, negating the relevance on any other criteria such as comparison with the creations or skills of other authors.

³⁹ For example, a high jump could not be considered as resulting from intellectual work, even it can be impressive.

d) *Painer v. Standard*⁴⁰

In 2012 the Court of Justice had an opportunity to decide on applicability of mentioned originality requirement on photographs. As will be elaborated later, the originality of photographs is explicitly regulated by Term Directive, which prescribes that the photographic work shall be considered original if it is author's own intellectual creation reflecting his personality - no other criteria such as merit or purpose being taken into account. The case is *Painer v. Standard Verlags GmbH* and regards the following factual background: Ms. Painer was photographer who had taken a portrait photo of a girl aged ten; the photos had been sold however without any consent with regard to their publishing. After eight years, the girl being the subject of photographing was involved in a dramatic event which attracted the attention of the public. The defendant, being a newspaper publisher, used one of the photos made by Ms. Painer when publishing the story about currently actual drama in girl's life, without photographer's consent. The Austrian court addressed the question on applicability of the Term Directive on portrait photograph, bearing in mind the very narrow scope of creative freedom available in such creation. When answering the raised question, the Court made a reference to the criteria set in *Infopaq* case as well as the mentioned provision from the Term Directive. It consequently concluded: *"That is the case if the author was able to express his creative abilities in the production of the work by making free and creative choices. As regards a portrait photograph, the photographer can make free and creative choices in several ways and at various points in its production"*⁴¹. The Court further stated that the author's freedom lies in the choice of the background, subject's pose and lightening, framing, angle of view and atmosphere created. In addition, it was emphasized that the mentioned

⁴⁰ *Painer v. Standard Verlags GmbH*, 2012, Case C-145/10.

⁴¹ Paragraphs 89 and 90 of the judgment, Case C-145/10.

choices enable the author to stamp his personal touch. Thus, the Court decided in favor of copyright protection of portrait photograph, providing additional inputs on interpretation of set “author’s own intellectual creation” criterion with regard to the works different from literal.

The presented case confirms that the originality test should be applied with respect to the specifics of the work in question – the purpose of the same is not to narrow the scope of protectable works, but to ensure that the same shall subsist only in those works where it is in line with the initial objection of copyright protection, regardless the nature of the work. The Court’s arguments on different available manners of expression of author’s free choices confirm understanding of photography and its rather special character. As opposed to the other artificial works, the purpose of photography is to catch the moment from reality and present it as realistic as possible. Photographers tend to choose the special moment or scene; however they always tend to catch something that already exists. As opposed to the other creative works which are created with an intent to bring something new, photographers tend to present something already existing (either focusing on its most attractive pose/lightening, or randomly selected materials). The same does not mean that there is no space for making contributions to the final product (work) by intellectual choices the author makes. The analogy could be made to the *Walter v. Lane* case in UK and the reporters tending to convey the speech as realistic as possible. Although the case set the “skill and labor” test, the reference is made due to the similar task standing before the authors, as well as similar space of their freedom despite the nature of the task. While photographer can select an angle or lightening, the reporter can choose punctuation, a sentence, or a word to be highlighted. It is concluded that the “author’s own intellectual creation” test can be applied to very different works, although its consideration could be different depending on the nature of the work in question.

The Court of Justice had an opportunity to further elaborate on the meaning and application of set standard with regard to the other types of work. The following three cases each brought some further guidelines:

e) Flos

In *Flos*⁴², the Court had to decide on a question made by Italian court regarding the protection of industrial designs and the contradiction between the national rules prescribing the conditions for protection and the ones established in previous Court's practice. The Court took into consideration the legal regime prescribed by Design Directive⁴³, whereby it is left to the Member States to determine under what conditions copyright protection would arise in respect of designs protected by design rights. The Court decided that no other requirements could be imposed apart from the one set in *Infopaq*. The consequence of this standing is that, if a design is eligible for protection i.e. presents author's own intellectual creation, Member States can not deny protection, regardless the fact that design may not meet the requirements set by their national law. This conclusion was also confirmed in *Donner*⁴⁴ case.

f) Bezpečnosti softwarova asociace

In the first case addressed to the Court after *Infopaq*, *Bezpečnosti softwarova asociace*⁴⁵, the court elaborated further on applicability of set standard to graphic user interfaces. The Court found that the term *creation* should be understood as imposing the creativity requirement: "*the standard of originality mandates in fact that the author has expressed his creativity in an*

⁴² *Flos SpA v Semeraro Casa e Famiglia SpA*, 2011, C-168/09.

⁴³ Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs, L 289/28.

⁴⁴ *Titus Alexander Jochen Donner*, 2012, C-5/11.

⁴⁵ *Bezpečnostní softwarová asociace - Svaz softwarové ochrany v Ministerstvo kultury*, 2010, C-393/09.

*original manner*⁴⁶. It should be noted that the Court introduced (or affirmed?) the higher level of protection, bearing in mind that the original creation had not have to involve creativity, before the mentioned precision made by the Court. This standing was also confirmed in Football Association Premier League and Others⁴⁷, where it was declared: “*originality as author’s own intellectual creation requires exerting ‘creative freedom’, this being something that football matches – being subject to the rules of the game – do not possess*”⁴⁸. The mentioned reasoning on lack of protection for football matches could be considered disputable. With reference to the previously discussed cases on portrait photography and speech reports, the rules of football game do not mean that its players do not have the freedom to express their individualism and free choices. However, the football game should not be considered as intellectual creation of its players – they do not tend to express any idea or message, neither to communicate something through their work to the public. Players tend to score the goal and win the game and act on the base of their physical abilities, agreed tactic and playing instinct. Such an activity does not present a work, in terms of relevant copyright legislation. The standing that the originality should be the criteria to determine if something is to be considered as a work is hereby contested; the same should be applied only afterwards, once it is established that the subject matter could be copyrightable as such⁴⁹.

⁴⁶ Paragraph 50 of the judgment, Case C-393/09.

⁴⁷ Football Association Premier League Ltd, NetMed Hellas SA, Multichoice Hellas SA v QC Leisure, David Richardson, AV Station plc, Malcolm Chamberlain, Michael Madden, SR Leisure Ltd, Philip George Charles Houghton, Derek Owen (C-403/08), Karen Murphy v Media Protection Services Ltd (C-429/08), 2009.

⁴⁸ Paragraph 98 of the judgment, C-403/08 and C-429/08.

⁴⁹ Eleonora Rosati, Copyright and the Court of Justice of the European Union, Oxford University Press, 2019, pg 91.

g) Football Dataco v. Yahoo!Uk Ltd

Another case where the “author’s own intellectual creation” was further elaborated is *Football Dataco v. Yahoo!Uk Ltd*⁵⁰, which regarded the copyright in football league fixture lists. The two questions addressed to the Court were about the content of set standard for databases with regard to the significant selection of arrangement as well the matter of preclusion for national copyright protection of databases other than that provided by the Database Directive. Answering on the first question raised, the Court found that *it is irrelevant for the purpose of assessing eligibility for the protection whether or not that selection or arrangement includes ‘adding important significance to the data’*. Furthermore, it stated that the only relevant criteria to be applied for database protection is originality, in the sense of making free and creative choices, expressed in the selection of arrangement of the data.

h) Directives on protection of databases, computer programs and photographs – the same criterion?

As mentioned earlier, EU copyright law is commented as harmonized when it comes to the three specific subject matters – software, database and photograph. The originality requirement is defined in the following three directives: Directive 96/9/EC of the European Parliament and of the council on legal protection of databases (hereinafter referred to as Database Directive), Council Directive 91/250/EEC of 14 May 1991 on the legal protection of computer programs (hereinafter referred to as Computer programs Directive), and Council Directive 93/98/EEC of 29 October 1993 harmonizing the term of protection of copyright and certain related rights (Term Directive). All of the cited directives précised the meaning of term originality as follows:

⁵⁰ *Dataco v. Yahoo!Uk Ltd*, 2012, C-604/10.

- *“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”⁵¹;*
- *“A photographic work within the meaning of the Berne Convention is to be considered original if it is the author's own intellectual creation reflecting his personality, no other criteria such as merit or purpose being taken into account”⁵²;*
- *“Whereas no criterion other than originality in the sense of the author's intellectual creation should be applied to determine the eligibility of the database for copyright protection, and in particular no aesthetic or qualitative criteria should be applied”⁵³.*

Although they seem very similar, we shall examine whether the originality requirement is actually regulated in identical manner for these three types of works. There are two common elements contained within all three provisions – the author’s intellectual creation (we emphasize that, even irrelevant from the substantive point of view, there is a lack of term “own” in the provision of Database Directive) as explanation of term originality and negative criteria on what should not be applied. Although the same wording “author’s own intellectual creation” indicates that the originality should be equally interpreted, different negative criteria imply that there could be some dissimilarities. Before each of them is explored, the additional condition on author’s own intellectual creation at photograph works should be also pointed out – there should be a reflection of author’s personality. When photographs are concerned, no other criteria should be applied, especially not merit or purpose. Furthermore, when databases are concerned, no other criteria should be applied, in particular no aesthetic or qualitative

⁵¹ Council Directive 91/250/EEC of 14 May 1991 on the legal protection of computer programs, Article 1(3).

⁵² Council Directive 93/98/EEC of 29 October 1993 harmonizing the term of protection of copyright and certain related rights, Article 6.

⁵³ Directive 96/9/EC of the European Parliament and of the council on legal protection of databases, Article 3 (1).

ones. As far as we consider originality of computer programs, no other criteria shall be applied and especially no tests as to the qualitative or aesthetic merits of the program. Although there are scholars arguing that the cited differences negate the actual harmonization⁵⁴, in our opinion such claim is not grounded. Namely, the additional variations of criteria that should not be applied (together with any other) only reflects the nature of the work in question, they do not put any substantial difference or weight to the originality requirement. Only the additional requirement of “reflection of personality”, mentioned in the Term Directive, puts some qualitative difference to the originality required. At the same time, it is rather difficult to precise which intellectual creation expressed through the photograph reflects the author’s personality, thus it is questionable what the actual reach of this addition is.

Apart from the three mentioned directives, the most recent directive regulating copyright should also be mentioned - Directive (EU) 2019/790 of the European parliament and of the council of 17 April 2019 on copyright and related rights in the Digital Single Market and amending Directives 96/9/EC and 2001/29/EC⁵⁵ (hereinafter referred to as the Digital Single Market Directive). The same also explicitly introduces the “author’s own intellectual creation” definition of originality, with respect to the works of visual arts: *Member States shall provide that, when the term of protection of a work of visual art has expired, any material resulting from an act of reproduction of that work is not subject to copyright or related rights, unless the material resulting from that act of reproduction is original in the sense that it is the author's own intellectual creation*⁵⁶.

⁵⁴ W. G. Karnell, “European originality: a copyright chimera”, Intellectual property and information law. Essays in Honour of Herman Cohen Jehoram, 1998.

⁵⁵ Directive (EU) 2019/790 of the European Parliament and of the Council of 17 April 2019 on copyright and related rights in the Digital Single Market and amending Directives 96/9/EC and 2001/29/EC, PE/51/2019/REV/1.

⁵⁶ *Ibid*, Article 14.

i) Conclusion on EU case law

As shown through the above case law, we could say that the standard of originality is somewhat harmonized in EU – there is a unique criteria to be applied to all types of works. Even though the standard was not defined in relevant legislation, the Court had an opportunity to elaborate on the same through the cases addressed and it could be concluded that it somewhat influenced national laws. For example, German legislation explicitly introduced the originality requirement through the standard of author’s own intellectual creation into its legislation⁵⁷, leaving no room for application of previously highly defined standard. Furthermore, even not at the beginning⁵⁸, in recent years it could be confirmed that the EU standard is accepted in UK court practice as well. For example, in 2017 in *Banner Universal Motion Pictures Ltd v. Endemol Shine Group*⁵⁹, the High Court of England and Wales decided on copyright on television formats defining that the requirement of originality under the CDPA 1988 is “expression of the author’s own intellectual creation”. However, there still remains a doubt on the level of creativity requested – by underlining that creation imposes creativity, the Court indicated that the higher standard is required.

⁵⁷ Act on Copyright and Related Rights, 2012, Article 2(2).

⁵⁸ In 2010 the High Court of England and Wales stated that originality involves the application of skill and labour in the creation of the work. *Newspaper Licensing Agency Ltd and Others v. Meltwater Holding BV and Others*, 2010, EWHC 3099.

⁵⁹ *Banner Universal Motion Pictures Ltd v. Endemol Shine Group Ltd and Another*, 2017, EWHC 2600.

PART 3: U.S. ORIGINALITY APPROACH

1. Legislative acts

A difference between two approaches could be made when it comes to defining the originality in U.S. copyright law before Feist⁶⁰. The first one follows the British approach and traditional “skill and labor” test – it is focused on the investment made in the creation of the work, and could be defined as the objective one. The other is about the creativity invested and could be recognized as subjective approach. U.S. copyright protection is based on the objective set in its Constitution⁶¹ focusing on the promotion of science and the useful arts. There is a difference with what is the case in civil law tradition where the author’s right is considered to be a natural right which follows from the outpouring of the author’s creative soul. In U.S., copyright protection is justified by the objection set in the following provision of its Constitution (Article 1, Section 8 (8)): *The Congress shall have power to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.* Many theorists⁶² rely on the cited provision when justifying copyright protection and its scope in U.S. However, promotion through the incentive for the authors is only one part of the provision, whilst not much attention is given to the word “useful”, defining the art which should be promoted. Nevertheless, U.S: copyright law is currently regulated by The Copyright Act 1976⁶³, defining the subject matter of protection and thus leaving no space for any speculation in mentioned direction.

⁶⁰ Feist Publications, Inc., v. Rural Telephone Service Co., 499 U.S. 340 (1991)

⁶¹ U. S. Const. amend. Section 8 (8).

⁶² Samuelson, Pamela, Justifications for Copyright Limitations & Exceptions (February 10, 2015). Forthcoming chapter in Ruth Okediji (ed.), Copyright Law in an Age of Limitations and Exceptions. Available at SSRN: <https://ssrn.com/abstract=2476669>.

⁶³ Copyright Law of the United States, 1976.

The Copyright Act 1976 is the main piece of legislation regulating copyright law in U.S. although the other acts also regulate some of its specific aspects⁶⁴. The first important feature of its regime is that it prescribes non exhaustive list of categories of works which can be protected. Although there are eight specifically mentioned categories, any other item meeting the requirements could enjoy copyright protection. The mentioned solution contributes to the importance of originality as protection requirement – the same should be applicable to the works of very different nature. As opposed to the UK and its exhaustive list approach, where the originality requirement is to be applied to only certain types of works, the task of setting the guidelines for its examination in U.S. is more difficult, as it should cover unspecified categories. Section 102 (1) stipulates that copyright protection subsists in “*original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced or otherwise communicated, either directly or with the aid of a machine or device*”. However, no further explanation on meaning of the term “original work of authorship” is provided. The same stands for other legislation regulating copyright in U.S. such as Bern Convention. Before the Copyright Act 1976, the Copyright Act of 1909 provided protection for writings; however it did not expressly mentioned originality as a condition for protection. The concept was present and governed by case law, as shall be presented in the upcoming paragraphs. Although the Act of 1976 brought some major changes regarding the conditions of protection, such as leaving the manufacturing clause⁶⁵, extending the term of protection⁶⁶, leaving the registration system⁶⁷, it does not differ from previous regulation when it comes to the originality requirement. Thus, it could be concluded that U.S.

⁶⁴ For example, Bern Convention regulates the treatment of foreign authors.

⁶⁵ The rule which is in contradiction with Bern Convention. It prescribes that the work has to be printed or otherwise produced in U.S. in order to be protected.

⁶⁶ From life plus 50 years to life of the author plus 70 years.

⁶⁷ Although even today registration of a work is a prerequisite for copyright enforcement.

legislation does not provide much guidelines when it comes to interpretation of this requirement – nevertheless it is clear that the same presents important criteria defining the subject of protection, which should be in the service of constitutional objection of copyright protection, i.e. promotion of art. The mentioned justification, being different from the ones which are based on the author’s personality and natural right in its creations, implies that the higher standard should be applied. If promotion of art is the final aim set by constitution, then the criteria for protection could rely on the nature of the work, i.e. it should depend on *what is the result of some creating process*, and not on *what was the incentive for creating process* or *on the process itself*. Thus, if the focus is made only to relevant legislation, U.S. copyright regime applies the objective approach towards originality, not the subjective one. However, in the following paragraphs it shall be analyzed how is the originality criteria applied in practice and what is the standing of U.S. courts.

2. Feist

As already mentioned, the decision in *Feist* could be considered as revolutionary when it comes to the interpretation of originality requirement in U.S. court practice. The case regarded the copyright in telephone directory containing data such as names, addresses and phone numbers. The alleged infringement was reflected in copying of portions of listings from the plaintiff’s directory. There were two important dilemmas in the case. The first one was about the tension between copyright protection over the facts and protection of their compilations. The court clearly stated that copyright does not subsist in the facts as they do not owe their origin to an act of authorship. However, their compilation could present a work being the result of author’s work, and thus could be subject matter of protection. The other dilemma regarded the issue of originality in the compilation of facts. Examining the mentioned

requisite, the Court stated the following: “*Original, as the term used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity...*”. The cited sentence resembles two important aspects of the meaning of originality. The first one is that the Court interpreted the criteria with a close reference to its literal meaning – original means that the work originates from the author, i.e. it is not copied. However, there is also the additional criteria putting more significance to the standard required – the original means that there is some minimal level of creativity. The latter requirement of creativity seems to be the heart of the originality condition, bearing in mind that the *origin aspect* seems to be already covered by the part of definition prescribing that the work has to be the work of authorship. Furthermore, the court underlined that “*originality does not signify novelty*⁶⁸”, “*as long as similarity is fortuitous and not the result of copying, a work may be original*⁶⁹”. This is significant as it implies that creativity is related to the internal, personal processes of the author and should be examined without the reference to the existing works. Moreover, it could be concluded that the author’s intention does play important role when determining the originality of the work which is identical to the one already existing – in case there was no intentional copying, the copyright protection should be granted. This finding is in contradiction with our previous stating about the character of originality requirement resulting from U.S. legislation; however this tension shall be further analyzed in the upcoming text.

The revolutionary nature of the case lies in the fact that the creativity approach (also commented as the subjective approach) prevailed. The court found that *the creative choices in*

⁶⁸ The distinction should be made from the patent law, where novelty presents an requirement for obtaining the protection, apart from other conditions. Thus, it is imaginable that two identical creations which were created independently from each other both enjoy copyright, regardless the difference in time of their production.

⁶⁹ The latter part of the sentence indicates that author’s intention plays role when considering originality – there is no such thing as unintentional copying.

*the selection and arrangement of the data were necessary to generate sufficient originality to warrant copyright protection*⁷⁰.

However, the Feist case was not the first one where the court requested more than “sweat of the brow⁷¹”. The same standard was also applied in *Burrow Giles Lithographic Co. v. Sarony*⁷², where the originality meant *the original intellectual conceptions of the author*, as well as in *The Trademark Cases*⁷³, where originality was interpreted as *creative powers of the mind, and fruits of intellectual labor*. Thus, the Feist did not introduce a new concept to the practice of U.S., but rather restated the already existing standard applied by some circuits.

The important question imposed regards the creativity threshold articulated – in other words, how much is minimal? Some courts⁷⁴ commented that it would be counterproductive to insist on high degree of originality, bearing in mind that the policy incorporates the idea of encouragement of the authors, and not threatening the same with the judgment of their imagination. Many courts after Feist found that there is originality in compilations⁷⁵. It is also important to emphasize that the protection of the works having the lower degree of originality could still be granted through the grounds other than copyright, such as misappropriation or torts. Although there were different attempts to define creativity, the following one attracted our attention: *a creative choice is one made by the author that is not dictated by the functions*

⁷⁰ See Alan Durham, “Speaking of the World:Fact, Opinion and the Originality Standard of Copyright”, 2009, in Brauneis, F. Robert (ed), "Intellectual Property Protection of Fact-based Works" (Edward Elgar Publishing, 2009)

⁷¹ See Saksena, Hailshree, “Doctrine of Sweat of the Brow” (May 3, 2009). Available at SSRN: <https://ssrn.com/abstract=1398303> or <http://dx.doi.org/10.2139/ssrn.1398303>

⁷²*Burrow Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884).

⁷³*The Trademark Cases*, 100 U.S. 82 (1879).

⁷⁴*Ccc Information Services Inc v. Maclean Hunter Market Reports Inc*, 44 F. 3d 61, (1994).

⁷⁵ For example, see *Key Publ’ns, Inc v. Chinatown Publ’g Enters Inc.*, or *Lipton v. Nature Co.* 945 F.2d 509 (2d Cir. 1991).

*of the work, the method or technique used, or by applicable standards or relevant good practice*⁷⁶. Conversely, mere arbitrary or insignificant selection is not sufficient.

The cited definition presents synthesis of several elements which eliminate the objective contributors to the final work, such as function, technique and the others. However, the definition should not be interpreted as meaning that the functional works should not enjoy protection, but rather that the same shall be protected in those elements which are not dictated by its function, which are the result of author's free choice. The low degree of creativity requested was also reconfirmed through other decisions: *A work is creative if it embodies some modest amount of intellectual labor*⁷⁷.

It is clear that the identical standard of originality should be applied regardless the different nature of subject matter, however it is interested to reconsider whether the same stands for first and second generation works⁷⁸. There are some cases⁷⁹ implying that the different, higher standard should be applied to derivative works. For example, in *Gracen v. Bradford Exchange*, a case which regarded the painting depicting the famous character from the movie and its copy, established a new standard for derivative works: a derivative work must be substantially different from the underling work to be copyrightable⁸⁰. The principle was further elaborated by Judge Sykes, who underlined that the crucial question is whether there is sufficient expressive variation making the derivative work different from the underling one.

⁷⁶ D. Gervais, "Feist Goes Global: A Comparative Analysis of the Notion of Originality in Copyright Law", *Journal of the Copyright Society of the U.S.A.*, Vol. 49, p. 949, Summer 2002.

⁷⁷ See *Durham Indus v. Tomy Corp.* 630 F.2d 905, 911 (2nd Cir. 1980).

⁷⁸ The first generations works are underlying works while the second generation ones are the derivative works.

⁷⁹ See *Barlin & Son Inc v. Snyder*, 536 F.2d 486 (2d Cir. 1976).

⁸⁰ See *Gracen v. Bradford Exchange* 698 F.2d 300 (7th Cir. 1983).

Putting the Supreme Court's reasoning into the context of constitutional objective justifying copyright protection, it could be summarized that the Court actually reemphasized that the primary benefactor of copyright law is the public, and the author is the secondary one⁸¹. In other words, copyright should not encourage any investment, but only the one that leads to the common benefit.

3. Original = human origin?

The focus shall now be made to the first part of the referenced finding cited above, namely the literal meaning of the term original and the consequences of this interpretation. As mentioned before, apart from minimal threshold of creativity, original also means that works originate from the author. We shall analyze the consequences of this conclusion with the reference to two significant cases which put its importance into the light.

a) Naruto

The first is the famous “monkey selfie”⁸² case, which indicated that the copyright protection subsists only in works created by humans, i.e. originality requirement necessarily narrows the scope of works potentially copyrightable on the basis of their origin. As presented by many scholars in detail⁸³, the case regarded the incidental selfie made by a monkey using the camera previously set by Mr. Slater, professional photographer who had the task to take photos of different animals in the place. Using the moment of his inattention, the monkey touched the button and initiated one of the most debated cases in recent copyright history. The case before

⁸¹ D. Gervais, “Feist Goes Global: A Comparative Analysis of the Notion of Originality in Copyright Law”, *Journal of the Copyright Society of the U.S.A.*, Vol. 49, p. 949, Summer 2002.

⁸² *Naruto v. Slater*, 888 F.3d 418 (9th Cir. 2018).

⁸³ For example see A. Guadamuz, “The monkey selfie: copyright lessons for originality in photographs and internet jurisdiction”, 2016, University of Sussex.

the court in U.S. was initiated by PETA⁸⁴ who acted on behalf of Naruto the monkey, against Mr. Slater. Although there are some scholars pointing out that the public disregarded the important jurisdiction issue (as the case had elements indicating that other courts could be in charge, bearing in mind that the defendant was from UK and that the photograph was made in Indonesia)⁸⁵, which could lead to different outcome, the U.S. court applied the cited norm of Copyright Act 1976 and dismissed the case based on the fact that the monkey can not be an author for the purposes of the law. Even though the judge found that the monkey had taken the picture by “independent and autonomous action”, the copyright could not subsist in its photo bearing in mind that the same does not originate from the author. One could question if the issue at hand regarded the originality requirement or the “work of authorship” condition. Even though it seems that the latter is directly related to the Naruto’s case, it could be also argued that the originality criterion is determined by the human origin of the work. The analyzed issue has important implications on future of copyright practice, bearing in mind that it is reasonable to expect the increase of works not created by human.

b) Artificial intelligence

The other issue regards the “Next Rembrandt” – the project that digitizes the method of famous painter with the aim to create the computer-generated artwork. The central dilemma regards the question of copyright on works which are products of artificial intelligence⁸⁶ – bearing in mind the current technology development and tendencies in its future grow, it is reasonable that this question will become more and more significant. Two main questions

⁸⁴ The abbreviation stands for People for the ethical treatment of the animals, see: <https://www.peta.org>.

⁸⁵ The Monkey selfie: copyright lessons for originality in photographs and internet jurisdiction, Andreas Guadamuz, 2016.

⁸⁶ See more at S. Yanisky Ravid and L. Antonio Velez Hernandez, “Copyrightability of Artworks Produced by Creative Robots, Driven by Artificial Intelligence Systems and the Concept of Originality: The Formality - Objective Model”, 2018, Minnesota Journal of Law, Science & Technology.

could be emphasized – the first one regards the matter of subsistence of copyright in such works. Following the *Naruto* case and the Court’s finding that non human authors are not recognized through the Copyright Act 1976, it seems that computer generated works should not enjoy protection. However, following the arguments in favor of copyright protection for the same, there is the other important question about who is the holder of the right. There are two main solutions: holder could be the software creator, holder could be the person providing necessary inputs to the computer.

Before we analyze these questions through the U.S. originality approach (as standardized in *Feist*), the term of artificial intelligence shall be defined more precisely. These systems are independent, autonomous, goal oriented, capable of processing free choices, unpredictable, evolving⁸⁷ - all the mentioned characteristics make them inherently intelligent. Furthermore, the works they create would be, without any doubt, protectable if created by humans. The concern with their protection and ownership seems rational bearing in mind their importance in today’s world and the industry forecast to become a \$70 billion industry by 2020⁸⁸. Now, getting back to the *Feist* and originality approach thereby set, the Next Rembrandt project and its creations shall be put under the examination. Similarly as with *Naruto*, the criterion of creativity is obviously fulfilled, however there is no direct origin from the human. In this case, the relation between humans and work in question is somewhat stronger than in *Naruto* case, bearing in mind that the program itself was created by human for the purpose of creation of such works. This seems to be significant difference with Mr. Slater’s position, where the use of his camera was incidental. Thus, it is reasonable to set theses where computer generated works could be considered as derivative works. In accordance with the U.S. legislation on the

⁸⁷ *Ibidem*, pg 8.

⁸⁸ *Ibidem*, pg 6.

works of second generation⁸⁹, the holder of copyright would hold the copyright for the output too. The applicability of this rule was considered in case initiated by Reardenn LLC and Rearden Mova LLC against Walt Disney Company⁹⁰, regarding the use of MOVA technology for creating animal-like characters. The U.S. Supreme Court supported the theses and concluded that where a computer requires significant amount of input from a human user in order to generate artistic work, the author rights ought to the user. This opinion is also reflected in the National Commission on New Technological Uses of Copyrighted Works⁹¹.

The focus shall be now made to the criteria for protection of derivative works – as stipulated in Copyright Act 1976, *derivative is a work consisting of editorial revisions, annotations, elaborations, or other modifications, which, as a whole, represent an original work of authorship*⁹². In order to be protected, derivative works have to meet the originality requirement, and as discussed before, there is no explicit rule that the same should be considered differently from the originality in first generation works. Thus, putting the Feist doctrine into the context of authorship on computer generated artificial works being considered as derivative works, we could conclude that the “origin from the author” includes not only direct relation with the human standing behind the creation, but also the indirect one.

The second opened question is which human should be considered as the author, i.e. who provided the crucial input to the computer – is it the person who created the program, or the person who set the criteria for final product. For example, there is a software capable of

⁸⁹ Copyright Act of 1976, Article 103 (b): The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.

⁹⁰ Reardenn LLC and Rearden Mova LLC against Walt Disney Company, 293 F. Supp. 3d 963 (N.D. Cal. 2018).

⁹¹ Its final report available here: <http://digital-law-online.info/CONTU/>.

⁹² Copyright Act of 1976, Definitions.

creating a new photo with one's face amended in the way the user ordered – on the base of already existing photo, it is possible to generate the new one resembling the same person with changed color of hair or eyes, changed emotion expression, changed age and similar. The new photo being the creation made through the program could be considered original in the terms of necessary creativity. However, there are two potential authors who both provided some input for the final work – the first one is the software creator who made the program capable of making free choices among different variations available, and the other one is the user who provided instructions on concrete parameters to be applied. In our opinion, this dilemma should not be considered differently from regular works being created through the programs which are copyrighted themselves. For example, a novel could be written in Word⁹³, computer program designed for writing texts, however there is no doubt that the copyright in the novel shall be hold by writer only, and not by the holder of copyright over the program itself. Thus, it is important to make a difference between derivative works (focusing on their legislative treatment and provisions defining its meaning), and works which were created by a tool which could present the work of authorship itself. Another example is a painting created by specially designed, carved painting brush. It is clear that the copyrights on those two works are separate, and that their holders have no related entitlements.

However, there are scholars⁹⁴ trying to introduce a new, objective approach when it comes to consideration of originality of works created by artificial intelligence. They argue that the difference should be made between the subjective approach including consideration of author's intent to create an original work, and the objective one, focusing on audience's

⁹³ Microsoft Word is a word processor developed by Microsoft.

⁹⁴ S. Yanisky Ravid and L. Antonio Velez Hernandez, "Copyrightability of Artworks Produced by Creative Robots, Driven by Artificial Intelligence Systems and the Concept of Originality: The Formality - Objective Model", 2018, Minnesota Journal of Law, Science & Technology.

perception of the work. The concept of subjective analyses of third person's internal creative process was already criticized by Judge Leval when considering application of fair use⁹⁵ rule. In terms of mentioned objective approach, the audience criteria imply introduction of an average consumer institute, average consumer being a person who makes a reasonable comparison of the work in question to the already existed works. An argument in favor of mentioned objective approach is an example of works created without the intent to create original work of authorship. However, regardless the internal processes of the authors, many works were protected as the works of authorship⁹⁶.

c) Concluding remarks on originality criteria in U.S. legal practice

The originality requirement, although applied by the courts, was not explicitly mentioned in the regulating acts until the Act from 1976. However, the same did not precise the meaning of the term nor provided any guidance on how the same is to be interpreted, although it was given an important role for selecting the goods to be protected. All until the 1991 the courts struggled with its implementation and had two very different approaches – one focused only on the work and effort invested, and the other one based on the minimum level of creativity expressed. However after the Feist case, Supreme Court ended the discussion in favor of the latter one. The next challenge was defining the sufficient level of creativity required, which is especially important for artistic works, where the aesthetic analyses should not interfere with the concept of originality being the legal concept⁹⁷.

⁹⁵ See Pierre N. Leval, "Toward a Fair Use standard", 1990, Harvard Law Review.

⁹⁶ For example, see the article on specific restoration work on: <http://world.time.com/2012/09/06/the-ecce-homo-dilemma-spain-puzzles-over-an-art-disaster-gone-viral/>.

⁹⁷ See Lavik, Erlend and Gompel, Stef van, On the Prospects of Raising the Originality Requirement in Copyright Law: Perspectives from the Humanities (October 30, 2013). Journal of the Copyright Society of the USA, vol. 60, no.

Although the U.S. judges apply subjective approach and take into consideration the author's internal processes while examining the originality of the work and creativity invested, there are arguments in favor of applying the different, objective approach especially when it comes to the works made by artificial intelligence. It seems that copyright protection could, under U.S. legislation, subsist in computer generated works although being produced by computers. However, focusing on crucial input provided by the user it could be argued that the work originate from the author, although the relation is not as direct as it is at the traditional works of authorship. In our opinion, current U.S. copyright regime is sufficiently elastic to be applied to the works of very different nature.

PART 4: COMPARATIVE ANALYSES

As shown through this Paper, standards of originality in U.S. and EU are both set by relevant court practice, due to the lack of specific rules stipulated by relevant legislation. Both systems recognize originality as filtering standard selecting the words to be protected, which is of particular importance in the open list subject matter systems. While EU copyright is regulated by several directives, only some of them expressly define meaning of the term originality. Where they do, the originality is defined as “author’s own intellectual creation”. This standard was further developed by Court of Justice which declared that the intellectual creation means making free and creative choices; in essence, it imposes both the author’s independence from any external influences as well as some level of creativity expressed. The diverse practice of the Court confirmed that the standard is applicable to very different types of works, even those where the author’s freedom is, in first view, limited. However, it remains opened whether the creativity involved should be considered as a subjective parameter or as the objective one, depending on the final product of author’s intellectual work.

Comparing the EU and U.S. standard of originality, we could conclude that both impose some level of creativity expressed – whilst the U.S. Supreme Court précised that the level required is not high, namely there should be minimum level of creativity expressed, the Court of Justice did not elaborate on the level of creativity required. However, both standards imply that it is not any effort of the author which establishes work’s eligibility for protection, but only the effort in expressing some creativity through intellectual work. The Paper did not reveal sufficient grounds for deciding in favor of any of two compared systems when it comes to the level of the standard required – although in U.S. practice it is defined that minimum level of creativity suffice, in EU it is not précised that any higher level is required. Furthermore, in

preamble of relevant legislative acts, both jurisdictions follows the identical justification for copyright protection – promotion and incentives for authors to invest in creation and dissemination of their works not only in their own interest but in the interest of public at large. Thus, neither of two systems recognizes author’s works as being worth of protection per se – only when the same are original, i.e. of importance for whole society.

CONCLUSION

Conducted research revealed that the originality requirement indeed has two applicable and useful purposes in both EU and US – the first one is the purpose of determining the eligibility for protection and the second one is the purpose of determining the scope of protection, i.e. which portions of the work enjoy protection. With the latter role, an analogy could be made with the principles of distinctiveness and similarity assessment in trademark law, an author's work shall enjoy protection only in those elements which made it suitable for copyright protection.

The analyses also confirmed that the legal meaning of term originality imposes some creativity involved, in both systems. The relevant case law showed that the requirement is sufficiently flexible to be applied to very different types of works, although the assessment has to include specifics of the work examined. The treatment of derivative works should not be any different, as the focus has to be made on the additional original elements differing from underlying work.

It should be kept in mind that the originality is only one of the protection conditions. The importance of other requirements, such as existence of the form and the work being the work of authorship, should not be ignored. It will be challenging to develop the application of originality requirement with respect to the new generation works such as creations made by artificial intelligence. Although some scholars put the focus on originality requirement, in our opinion this task will lead to further development of “work of authorship” requirement. If the protection is to be given to the works produced by non human subjects, current standards of originality would have to shift in favor of more objective approaches.