
June 2012

EU harmonisation of the copyright originality criterion

As a consequence of a number of copyright rulings from the CJEU, the Swedish threshold of originality requirement is being superseded by an EU originality criterion. In this article, Henrik Bengtsson, IP expert at Delphi in Stockholm, reports on the development and the possible impact on the harmonisation of Swedish copyright law.

Less than two years ago, the Swedish Supreme Court rendered its judgment in the Mini Maglite case (NJA 2009 s 159) and ruled that the Mini Maglite flashlight was copyright protected. The Mini Maglite case concerned the pre-requisites under which a work of applied art meets the threshold of originality.

The Supreme Court's view on the threshold of originality concept vis-à-vis "the author's own intellectual creation"

One of the legal issues in the Mini Maglite case was whether the judgment should be based on a Swedish originality requirement or on the EU originality criterion enshrined in the EU copyright directives. The Supreme Court found that the EU harmonisation of copyright law was limited to computer programs, photography and database directives, and was not applicable to industrial designs;

"Under two EC directives, computer programs and photographs could be covered by copyright protection, inter alia, on the condition that the work is original in the sense that it is the author's own intellectual creation; it is added that no other tests shall be applied as regards the right to protection (Directive 91/250/EEC and Directive 93/98/EEC). A directive regarding legal protection for databases has been drafted in a similar way in this respect (96/9/EC).

The partial harmonisation which follows from the directives is thus restricted to certain specified works and must be deemed as being justified by the special nature of these works. There is no reason, in this case, to discuss what the pre-requisite of originality set forth in the directives entails. However, it can be concluded that there is no support, under applicable law in the area of applied art, to deviate, under the influence of the EU Directive, from the requirements for copyright hitherto applied. [...]" (my underlining).

June 2012**EU harmonisation
of the copyright
originality criterion****CJEU rulings on EU originality criterion**

A few months after the *Mini Maglite* case, the CJEU delivered a preliminary ruling in the *Infopaq* case (case C-5/08), a case which concerned the interpretation of the concepts “reproduction in part” and “transient” in Articles 2 and 5, respectively in the *Infosoc Directive* (2001/29/EC) which harmonises certain aspects of copyright and related rights in the information society. One of the questions which the Danish *Højesterett* posed to the CJEU was whether the concept “reproduction in part” in the *Infosoc Directive* should be interpreted as encompassing storage in data systems and print-out on paper of an extract of eleven words. This meant that the CJEU first had to assess what is deemed a work under the *Infosoc Directive*. The CJEU concluded, based on the originality criterion in the *Copyright Term Directive* and the *Software and Database directives*, respectively, that a work which is original in the sense that it is the author’s own intellectual creation, is protected as work in the meaning of the *Directive* (recital 37). This originality requirement was then applied to article texts in newspapers. The Austrian government claimed that it was incumbent upon the Member States themselves, and not the CJEU, to define the concepts in the *Infosoc Directive*. However, the CJEU was of the opinion, with reference to case C-245/00 *Sena*, that it followed from both the requirement of a uniform application of community law and the principle of equal treatment, that community provisions which do not contain any express reference to the Member States’ legal systems regarding the test of their significance and scope, shall normally be given an independent and uniform interpretation throughout the entire community. The same applies to all expressions where the directives do not expressly refer to national law (cf. *inter alia* C 306/05 *SGAE* concerning the expression communication to the public in Article 3(1) and C-510/10 *TV2 Danmark*, respectively concerning the expression “means of their own facilities” in Article 5(2) (d) of the *Infosoc Directive*). Thus, following *Infopaq*, the issue of whether a work meets the requirements to be protected by copyright is not subject to a national test but an EU concept. Starting with *Infopaq*, the CJEU’s introduction of an EU originality criterion has been criticised by Schulze in *GRUR* 2009, 1019, among others, as being a covert harmonisation measure.

The CJEU has, in later judgments, returned to the EU originality criterion; “author’s own intellectual creation”. In *BSA* (case C-393/09), the Court concluded that a computer program’s user interface can be protected by copyright (however not the program) if it is the author’s own intellectual creation. Whether the originality requirement was fulfilled in the actual case was left to the national court to decide. In *Murphy* (joined cases C-403/08 and C-429/08), the CJEU made a concrete assessment of whether a sporting event can constitute an intellectual creation which qualifies as a work under the *Infosoc Directive*. The Court was of the opinion that sporting events, as such, could not constitute works as they are governed by rules of play leaving no scope for creative freedom as intended under copyright law.

June 2012
**EU harmonisation
of the copyright
originality criterion**

In Painer (case C-145/10), the CJEU tried whether a portrait photograph constitutes a work in the sense of, inter alia, the Copyright Term Directive (98/93/EEC). In Painer, the CJEU provided (sections 88-93) the harmonized originality criterion with more precise content and stated that (i) an intellectual creation is deemed to be the author's own if it reflects his or her personality (ii) the creation is the author's own when the author in conjunction with the creation of his/her work has been able to express his/her creative ability by making free and creative choices. In this respect, the CJEU referred to an e contrario interpretation of the reasoning in the Murphy case, in which the CJEU concluded that a football game, as such, could not acquire copyright protection. Regarding portrait photographs per se, the CJEU was of the opinion that the author in many ways and in various instances can make free and creative choices in conjunction with the creation. The author (the photographer) may in conjunction with his/her preparation, choose the setting, pose of the person being photographed and the lighting. When the photograph is taken, he/she can choose focus, angle and the atmosphere created, and in developing the film, he/she can choose between different techniques or use a computer program. In this way, the author can stamp his/her personal touch on the work created (section 91).

A few months ago, the CJEU rendered its ruling in Dataco (case C-604/10) concerning the issue of what is meant, under the Database Directive, by a database which, due to the content selection or compilation, constitutes an intellectual work. The CJEU concluded in section 38, with reference to Infopaq, BSA and Painer, that the originality criterion was satisfied when, through the selection or arrangement of the data which it contains, the author expresses his/her creative ability in an original manner by making free and creative choices and thus stamps his 'personal touch' on the work.

However, according to the CJEU, the criterion is not satisfied when construction of the database is dictated by technical considerations, rules or constraints which leave no room for creative freedom. The CJEU also made it clear that, in assessing originality, the Anglo-Saxon "sweat of the brow" criterion, i.e. that the intellectual effort and skill required to create data, must not be given any relevance in the test of whether a database acquires copyright protection, if the work and skill do not express any originality in the selection or arrangement of that data. Finally, the CJEU concluded that the Database Directive constitutes an impediment for national provisions which, under Article 1(2) of the Directive, provide copyright protection on terms other than the ones set out in Article 3(1).

It is now clear that the CJEU is of the opinion that a harmonised EU originality criterion applies to categories of work other than those comprised by the field of application of the computer program, database and term directives. (cf. Axhamn; EU-domstolen tolkar originalitetskriteriet och inskränkningen till förmån för vissa tillfälliga former av mångfaldigande, NIR 2011, s 339ff and Wedel; Die Infopaq-Entscheidung des EuGH: schleichende Harmonisierung der Schutzvoraussetzung des Urheberrechts, s 32f). Under

June 2012**EU harmonisation
of the copyright
originality criterion**

the EU originality criterion, thus far, a creation qualifies as a work if:

1. the creation is the author's own original creation;
2. the creation reflects his or her personality;
3. the author, in conjunction with the creation of his/her work, has been able to express his/her creative ability by making free and creative choices and thus stamping his/her personal touch on the work.

One question which arises, is whether the new EU originality criterion applies to all types of work. It is evident from the Directive on the Legal Protection of Designs (Article 17) and the Regulation on Community Designs (Article 96) that each individual Member State shall decide to what extent, and on what terms, copyright protection is to be given to objects which also enjoy protection of their design, and what originality is required for this protection. The national competence is restricted to work which may enjoy design protection, which means that the copyright test of originality for industrial designs may be more complicated. As the Directive and the Regulation are worded, a work which cannot acquire design protection falls outside the national competence, whilst work which does, would fall under the national competence, which may have the effect that different originality criteria, the Swedish threshold concept or the EU originality criterion, are to be applied. The question is further complicated by the fact that the CJEU, in case C-168/09 Flos, has stated that it cannot be ruled out that other directives in the area of copyright, among them Directive 2001/29, may give copyright to works, which may constitute non-registered designs.

The latest ruling which concerns copyright protection issues is the CJEU's ruling in case C 406/10 SAS Institute which was delivered on 2 May 2012. In this case, the CJEU assessed whether a computer program's function or program language and file format, which were used in a program to utilize some of its functions, constitutes a form of expression for computer programs. The CJEU concluded that a computer program's function cannot be covered by copyright protection since that would make it possible to monopolize on ideas. Neither could language and file formats constitute forms of expression for a computer program. On the other hand, the CJEU left it open whether program languages and file formats can be copyrighted in their capacity as works under the Infosoc Directive.

The impact of a harmonised originality criterion on European case law

In German courts, harmonisation of the originality criterion through the Directive on the legal protection of computer programs has had a clear impact on German case law in that the requirement for protection has been lowered. In earlier German case law, protection of a computer program required that the creative effort be markedly higher than the efforts that the average programmer would have made (see Bundesgerichtshof ZR 52/83 [debt collection program]) whilst in later case law, only merely routine programming has been excluded from copyright protection as a result of the new originality requirement.

June 2012
**EU harmonisation
of the copyright
originality criterion**

(Bundesgerichtshof ZR 111/02 [Fash 2000]). In Austrian courts, the originality criterion has been lowered for photographs as a consequence of the harmonized originality criterion in the Directive harmonizing the term of protection of copyright. In older case law, only photographs which substantially differed from older photographs were protected (Oberste Gerichtshof Ob 121/93) whilst in more recent case law (Oberste Gerichtshof Ob 221/03h) protection is afforded photographs which differ from existing photographs in that the creator has exercised his/her creative freedom.

The Belgian Supreme Court (case C.11.0108.N) has applied the EU originality criterion following the CJEU rulings in Infopaq, BSA and Murphy but before the Painer and Dataco rulings. The Belgian Supreme Court held that a work should enjoy copyright protection if it is the own intellectual creation of the author and there was no requirement that the author had stamped his/her personal touch on the work.

How will the harmonised originality criterion impact Swedish copyright law?

Because the CJEU leaves national courts to determine whether a creation is the “own intellectual creation of the author”, it is debatable whether the new harmonized originality criterion will make any difference, in practice, to the Swedish legal position. The Supreme Court presupposes in later copyright cases (see inter alia NJA 1995 s 256 and NJA 1998 s 563 [Tomukuhus]) that if a work is original and independent it reaches the threshold of originality. In order to determine whether or not a work meets these criteria, the dual-creator criterion is used as an aid but not as a way of determining the threshold of originality (cf NJA 2004 s 149). One difference between the EU test of originality and the Swedish copyright threshold of originality may, however, be the scope for taking into consideration additional circumstances when assessing the originality. The Svea Court of Appeal in two cases concerning applied art (case T 5541-01 [car heaters] and case T 728-08 [vacuum cleaner nozzles, confirming district court ruling]) considered the purpose of the creation and concluded that when the purpose is substantially governed by functional and production issues, an object will not enjoy copyright protection. The test of originality under EU law may not take into consideration the purpose of the creation, which is why any artistic purpose is irrelevant. If the creator, artistic or otherwise, has stamped his/her personal touch on the creation, it will be seen as a work. With regard to industrial design, there may be scope – as mentioned above – for applying a national test of the threshold of originality.

Swedish rulings on copyright protection which, whilst being decided after Infopaq (Court of Appeal for Southern Norrland, case B 1309-10 concerning the copyright protection of broadcasts of ice hockey matches, Svea Court of Appeal case T 728-08 on copyright protection of vacuum cleaner nozzles, Svea Court of Appeal case T 106-10 on copyright protection of a leather jacket and the Court of Appeal for West Sweden, case B 4278-10 on copyright protection of circus acts) have not made reference at all to the EU

June 2012
**EU harmonisation
of the copyright
originality criterion**

originality criterion but have, instead, applied the national requirement as to threshold of originality.

There are few examples in later Swedish cases in which works have not been deemed to be copyright protected. The Supreme Court in NJA 2004 s 149 held that a trivial drawing of a floorboard was not protected under copyright but formulated no requirement for material difference vis-à-vis existing work in the ruling. It may be presumed that trivial works such as the Pergo drawing are excluded from copyright protection even with a new originality requirement in place, as there is no expression of the creator's personal touch. From a Swedish perspective, it is unlikely that case law from the CJEU concerning the originality criterion entails a revolutionary change. As Karnell reasons in his paper, *Europeisk originalitet – en upphovsrättslig chimär* (NIR 1998 s. 157 – 167), it is possible that the EU originality criterion will merely cause national courts to use the same criteria for determining copyright protection as before whilst formulating themselves in a harmonised language. Nonetheless, it is probable that the concept of "threshold of originality" has run its course and it should be replaced – as a token of harmonisation – by an "originality criterion".

New view on scope of copyright protection?

In *Painer* (sections 96-98) the CJEU made an interesting statement concerning the scope of protection afforded a work which enjoys copyright. The court stated that the protection that follows from Article 2 (a) of the Infosoc Directive is to be given a great deal of scope and furthermore that there is nothing in the Infosoc Directive or any other directive applicable in this area, to indicate that the scope of such protection would be contingent upon possible differences in the scope for artistic creativity in conjunction with the creation of different categories of work. In this light, the court concluded that the protection afforded by Article 2 (a) of the Infosoc Directive is therefore no weaker than the protection given other works including photographic works.

The Swedish differentiated test of the scope of protection, which is dependent upon the originality of the work must possibly be seen in a new light as a consequence of the *Painer* ruling. In *Mini Maglite* the Supreme Court made the following statement of principle in the matter of the scope of protection afforded.

"The requirement on the threshold of originality should furthermore be seen in conjunction with the scope of protection afforded by copyright. The scope is determined using, for example, the originality of the work as guidance. It ought to be possible to balance a relatively low requirement on the originality of the work and thereby on its threshold of originality with a correspondingly limited scope of protection (cf Levin, a.a. s. 77, 81 and 91 and Lindberg in NIR 2003 s. 443)."

June 2012
**EU harmonisation
of the copyright
originality criterion**

"When a product meets the requirements for copyright protection but nonetheless does not express any greater degree of originality, the scope of protection is limited, which in principle extends further, however, than a mere protection against reproduction."

It is difficult to reconcile these statements with the statement of the CJEU in Painer that the scope of protection is to be substantial regardless of the opportunities for variation the author enjoyed and irrespective of the opportunities the author had to express his/her creativity. It is thus probable that less original works may now be afforded the same scope of protection as an original work. The question is, however, whether the CJEU's statement in Painer is to be seen as related merely to the actual case as regards copyright protection for photographs or whether the court is establishing a general copyright principle.

En route to a harmonized copyright?

Swedish copyright law has long acquired its substance from the hundreds of CJEU rulings in the areas concerned by the Trademark Directive and Regulations. Through later CJEU rulings, inter alia, on the Infosoc Directive (see inter alia cases C-306/05, C-136/09, C-403 and C-429/08, C-283/10, C-162-20 and C-135/10 concerning the terms communication to the public and reproduction respectively) some parts of copyright law are beginning to acquire a harmonised EU content. A large number of rulings are expected in the coming years and copyright harmonisation is not limited to the area of application of the individual directive but comprises copyright in general. The activist CJEU's position to the copyright law area underlines the CJEU's role as a driver of integration. The court's stance is particularly interesting when one notes the Commission's incipient ideas for a European "Copyright Code" in the Reflection Document: Creative Content in a European Digital Single Market: Challenges for the Future and in the communiqué A single market for intellectual property rights boosting creativity and innovation to provide economic growth, high quality jobs and first class products and services in Europe (COM(2011) 287 final) and the Wittem project's newly published proposal for a harmonized "European Copyright Code" (see www.copyrightcode.eu).

It is apparent that the Supreme Court view that the European originality criterion is restricted to the area of application of the Directive was incorrect shortly after their ruling (their view may still be correct as regards industrial design but in this case due to special regulation of industrial design in the Directive on the legal protection of designs and the Regulation on Community designs). The CJEU rulings concerning the Copyright Directive demonstrate the importance of Swedish courts keeping themselves abreast of EU legal developments also in the area of copyright and striving to interpret cases in line with the Infosoc Directive. It will be interesting to see whether the Supreme Court

June 2012
**EU harmonisation
of the copyright
originality criterion**

in a streaming case (case B 3510-11, leave to appeal granted 28 March 2012) which concerns, inter alia, the matter of whether a sport commentator's commentary and the cameraman's and producer's recordings respectively are protected by copyright follow the CJEU's latest rulings and apply the EU originality criterion, "the own intellectual creation of the author" rather than the traditional Swedish concept of threshold of originality.



Henrik Bengtsson, Partner / Advokat