

## Originality in comparative legal studies (Originalité dans le droit compare)

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*Oral presentation given in Campus International d'été: Les dynamiques du droit d'auteur (International Summer Seminar: Copyright in Motion). Paris, July the 10<sup>th</sup>, 9:30, Session B, workshop 3 – "Originalité: concept, nouveauté, créations assistées par l'informatique, créations, fonctionnelles, preuve, fixation, liste fermée d'œuvres"*

1. Mr. Azzaria, Madame Graça, Mr. Feng, Mr. Kenan, dear colleagues, I would like to thank you for the opportunity of this wonderful seminar and its international importance. Especial thanks to the members of the scientific committee, who made possible the realization of this event: Mr. Pierre Sirinelli. Mr. Antoine Latreille, M. Alexandra Bensamoun and M. Sarah Dormont
2. Bien que je parle en anglais, je comprends bien la langue française. Si vous voulez parler français avec moi ou me posé quelques questions, j'y réprondrai avec grand plaisir.
3. I'll be speaking about the concepts of originality in comparative legal studies.
4. To begin with my presentation is necessary to establish feel notions of comparative law schools or methods of comparative analysis. It's an endless debate and a very old one.
5. As you can see only a fraction of this debate is already overwhelming:

BRAND, Oliver. Conceptual comparisons: towards a coherent methodology of comparative legal studies. *Brooklyn Journal of International Law*, 2007, v. 32, n. 2, p. 405-466; LEGRAND, Pierre. Comparative legal studies and commitment to theory. *The Modern Law Review*, 1995, v. 58, p. 262-273; MOROSINI, Fabio. Globalization & law beyond traditional methodology of comparative legal studies and an example from private international law. *Cardozo Journal of International and Comparative Law*, 2005, v. 13, p. 541-561; ZUMBANSEM, Peer. Comparative law's coming of age? Twenty years after Critical Comparisons. *The German Law Journal*, 2005, v. 6, n. 7, p. 1073-1084; MARKESINIS, Basil. Comparative law – a subject in search of an audience. *The Modern Law Review*, London, v. 53, n. 1, January, p. 1-21, 1990; MARKESINIS, Basil. Litigation-mania in England, Germany and the USA: are we so very different? *Cambridge Law Journal*, v. 49(2), July, p. 233-276, 1990; MARKESINIS, Basil. French System Builders and English problem solvers: missed and emerging opportunities for convergence of French and English law. *Texas International Law Journal*, v. 40, p. 663-690, 2005; MARKESINIS, Basil. Understanding American law by looking at it thought foreign eyes: towards a wider

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theory for the study and use of foreign law. *Tulane Law Review*, , v. 81, p. 123-185, 2007. ; RENNEN, van TP. Philosophical underpinnings of modern comparative legal methodology. *Stellenbosch Law Review*, 1996, v. 7, n.1, p. 37-60; PICKER, Colin B. Comparative Law Methodology & American legal culture: obstacles and opportunities. *Roger Williams University Law Review*, 2011, v. 16, p. 86-99; MICHAELS, Ralf. The functional method of comparative law. *Duke Law School Faculty Scholarship Series*, paper 26, 2005, p. 1-47; SACCO, Rodolfo. Legal formats: a dynamic approach to comparative law (Installment I of III). *The American Journal of Comparative Law*, 1991, v. 39, n. 1, 1991, p. 1-34; KÖTZ, M. Hein. Comparative law in Germany today. *Revue Internationale de Droit Comparé*, 1999, v. 51, n. 4, p. 753-758; PLATSAS, Antonios Emmanuel. The functional and the dysfunctional in the comparative method of law: some critical remarks. *Electronic Journal of Comparative Law*, 2008, v. 12.3, p. 1-16;

6. The importance of these methods is to make easier for the researcher to study foreign law by establishing directions and principals.
7. Functionalism is indeed the most traditional method applied to comparative legal studies in several fields of knowledge, sharing space with *Comparative Law and Economics* and *Critical Comparative Law*. My research is based upon the functional method.
8. I personally recommend the reading of one particular article written about the subject: Mr. Michaels, Ralf, "The Functional Method of Comparative Law" (2005). *Duke Law School Faculty Scholarship Series. Paper 26*.
9. In this work, Mr. Michaels will explain the very large and profound notion of functionalism. Also, he will provide the major lines of thought inside functionalism, which are:
  - Neo-aristotelian functionalism
    - Brings Aristotle's Idea of *telos* or *causa finalis*. *Problems are universal, derived upon the 'the nature of things'.* If problems are then universal, they are only formally different in law, but are substantial similar. *Jossef Esser and James Gordly are important authors who defend this line of thought.*
  - Evolutionary functionalism
    - Influenced by the ideas of Darwin, law should be more about the general ideas of the development of civilizations, not about what's written or the *ratione legis of law*. Auguste Comte and Jhering are important authors which suffered some influence from this line of thought.
  - Structural functionalism
    - Its most general ideas may be traced back to Émile Durkheim. Brings the idea of *causa efficiens* as opposed to *causa finalis*. Function would be then a relation

between elements and not a qualification in itself. It tries to deal with objectivity and data analysis.

- Neo-Kantian functionalism

- Brings the idea that the 'nature of things' is not based on the nature itself, but rather on the human construction of the 'nature'. It changes then the *locus* on ontology to the epistemological focus, which means that we can compare stuff without major abstractions or generalizations. Important authors of this line of thought are Gustav Radbruch, Max Salomon e Ernest Cassirer.

10. We also have a new fashionable way of functionalism, which is equivalence functionalism (proposed by Mr. Michaels). I cannot address deeply these matters because of the short presentation time.

11. When we study functionalism, we have seven functions:

- The epistemological function

- What this vision provides is that you don't need to be necessarily an actor inside a given system of law to understand it. You can functionally study it as an 'outsider', because what does matter is a construction vision.

- The comparative function: *function as tertium comparationis*

- Function explanations would better serve us. Thus, we compare empirically, not philosophically; we become pragmatic. It's easier to discuss functions as oppose to values. Legal solutions, although expressed in a fashion different way, may be functionally very similar. The solution, thus, may be functionally equivalent.

- The presumptive function: *presunpcio similitudinis*

- It presupposes that problems are universal and when we focus on the problems we can achieve function solutions. It does not mean that the analysis will always lead to similar solutions, although it is the point of departure of the functionalism study.

12. We also have more four functions, which I cannot address because of the time:

- The formalizing function
- The evaluative function
- The universalizing function
- The critical function

13. The major source of criticism made to functionalism is driven by the *culturalists*, the *Critical Legal Studies* movement and *Critical Comparisons*.

14. The idea is basically that when we study function we hide or ignore the culture ideologies from the foreign law. It basically denies the ontological openness of the subjects of law in formalistic and monolithic schemes. The idea of neutrality of the solutions is also questioned. These formalistic schemes tend to create an *ethnocentricity* or *logocentric position*, which means that the good stuff is only produced in the United States and Europe.
15. Why wouldn't comparative legal studies be only a hermeneutic exercise or a *démarche herméneutique, if we are to protect our own culture?* This is a very valuable question.
16. Although I agree with many of the critics, I personally do not think that this kind of criticism creates an *ethnocentricity vision when we study originality* in the United States, after the decision of the Supreme Court in *Feist Publications*, or the Canadian Supreme Court decision in *CCH Canadian*.
17. The *Feist* decision basically creates a rupture of North-American copyright with the secular *sweat of the brow* doctrine. What this does is that now, in order to receive copyright protection, it's necessary to demonstrate *a quo* intellectual manifestation in the work, even though this demonstration is *de minimis*.
18. Intentionally or not, the decision of the Supreme Court approximated, at least with regard to the originality standard, North-American with Brazilian and European copyright.
19. It is a changing system, a sort of mutation, and makes sense to study this mutation in what can be the closer approximation of *common law* and *civil law* copyright. So, this is not a pseudo-intellectual fashion, but the best viable option to functionalism and the study of originality.
20. Is not only a changing system with regard to originality. If we analyze the *Berne Convention Implementation Act, Visual Artists Rights Act, and the Architectural Works Copyright Protection Act*, in the United States, we can see, even with all the flaws that they are trying to get in a closer international level.
21. In the decisions of the Canadian Supreme Court and Federal Appellate Court we see the conflict between the *sweat of the brow* doctrine and the *creativity doctrine*. Makes logically sense to explore Canadian decisions and doctrine, because after *CCH* case we also see a mutation in the originality standard. The new perspective of the *CCH* case, as point out by a Canadian commentator<sup>2</sup>, is exuberating with freedom, because the Supreme Court rejected *creativity* as well as the *sweat of the brow*, creating a *tertium quid* or a mutation sort of mixture between both doctrines. It means that one who seeks a new framework between functional and creativity should explore post-*CCH* decisions in Canada, even though there are those which think that the *CCH* decision is not different from the *Feist* decision, because it requires a 'sparkly of creativity'. This

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<sup>2</sup> CRAIG, Carys J. Resisting "sweat" and refusing *Feist*: rethinking originality after *CCH*. *U.B.C Law Review*, v. 40, p. 70-120, 2007.

would be functionally indistinguishable from the North-American *de minimis* standard.<sup>3</sup> I do not think this is so clear or definitive, as we shall see.

22. What is *sweat of the brow* or *creativity*? Two Canadian authors have approached this debate in a very fashionable way, which I also recommend the reading, Mr. Drassinower's<sup>4</sup> and Mr. Graig's<sup>5</sup> works.
23. What is the Canadian *sweat of the brow*? According to this notion, originality, as follows from section 5 of the *Canadian Copyright Act*, does not require the need of creativity. It only prohibits the copy of another work, meaning that hard work, effort, skill, labour, or judgment are enough.
24. Thus, the vast majority of mechanical processes of selection, arrangement and coordination are sufficient to make the threshold. For instance, ordinary white pages of telephone catalogs would be protected, likewise blank account forms, competition rules and betting coupons.
25. Canadian creativity doctrine, on the other hand, requires, besides the absence of copy, a quantum *de minimis* of creativity, even if modicum or minimum. Mere mechanical selections of preexistent materials would not suffice the standard, and thus, would be public domain, as the vast majority of white pages phone books catalogues.
26. What lies behind these doctrines ere ideological conflicts? The *sweat of the brow* is largely based on John Locke's labor theory of property and the idea of misappropriation, that is, a way to guarantee the fruits of the laborer. The creativity doctrine, on the other hand, assumes a public domain protection perspective – the *quid pro quo* bargain – factual compilations which are mechanical in its face cannot be protected.
27. This does not exclude, for instance, the North-American idea of the *created fact and soft fact doctrine* or *the thin protection doctrine*, explain by M. Ginsburg<sup>6</sup>. The created fact and soft fact doctrine postulates that the infusion of a subjective choice in the arrangement, even though, in some manner, can be a victim of 'objectification' criteria, is still protectable by copyright.
28. In *Tele-Direct (Publications) Inc v. American Business Information Inc*<sup>7</sup>, the Canadian Federal Appellate Court judged that compilations of data are to be measured by standards of intellect and creativity, following the "creativity" school of cases rather than the "industrious collection" school.

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<sup>3</sup> GERVAIS, Daniel. Canadian Copyright Law Post-CCH. *Intellectual Property Journal*, v. 18, p. 139, 2004.

<sup>4</sup> DRASSINOWER, Abraham. Sweat of the brow, creativity, and authorship: on originality on Canadian copyright law. *University of Ottawa Law & Technology Journal*, v. 1, p. 107-123, 2004.

<sup>5</sup> GRAIG, Carys J. The evolution of originality in Canadian copyright law: authorship, reward and the public interest, *University of Ottawa Law & Technology Journal*, v. 2, p. 425-445, 2005.

<sup>6</sup> GINSBURG, Jane. Copyright, common law, and sui generis protection of databases in the United States and abroad. *University of Cincinnati Law Review*, v. 66, p. 151-176, 1998.

<sup>7</sup> 1997 CanLII 6378 (FCA); 154 DLR (4th) 328; 37 BLR (2d) 101; 76 CPR (3d) 296; 134 FTR 80.

29. *Tele-Direct* claimed copyright in the organization of the subscriber information and in respect of the collection of additional data, such as facsimile numbers, trademarks and number of years in operation.
30. Considerable labor, but no degree of skill and judgment would not be sufficient in most situations to make a compilation of data original. The Court found that according to the Bern Convention, the term author means ingenuity, and, thus, a intellectual creation. Tele-Direct arrangements were to be considered commonplace and not protected by the creativity threshold.
31. In *CCH Canadian Ltd.*<sup>8</sup>, the same Federal Appellate Court reduced the originality concept to a notion of ‘not copying’, in another words, a kind of ‘*sweat of the brow*’, that could protect almost anything, a tournabout ruling, in less than five years. The interpretation to the new ‘creativity’ standard given by the same court was that the work must not be a copy of another work and independently produced – as we can see, the main tonic of *sweat of the brow*.
32. The Supreme Court, on the other hand, reject the Appellate court decision, as well as the *creativity de minimis* standard formulated in the *Feist* case. Rather, according to the Canadian Supreme Court, originality stands between the two extremes and requires exercise of skill and judgment.
33. Mr. Versteeg, a North-American academic, in his valuable article<sup>9</sup>, has formulated the *concrete/abstract non trivial test*. I believe that this test con conjure a bridge between the ‘gap’ of north-American *Feist* jurisprudence and Canadian *CCH* jurisprudence. The idea of this new test is that, although we can’t protect simple effort, we can protect ability, when this ability is capable of indicating a more *then trivial variation*. This would be broader then the *de minimis* standard, possible what the Canadian Supreme Court had in mind when it thought to combine both doctrines. This may be only a semantically difference concept, though, if one is to define a ‘sparkly of creativity’ in broader functional terms.
34. Finally, I would like to approach the Post-*Fiest de minimis* creativity standard in three cases, which involved 1) a simple combination of geometric forms belonging to the public domain; 2) a simple combinations of numbers and words belonging to the public domain; 3) a simple alteration of word’s shapes and source.
35. What the Supreme Court created in *Feist* is the *practical inevitability test*. This basically means that only when there is no alternative form to the arrangement, when form follows function, no copyright protection can exist. Everyone who would make it would have to arrive to the same result.

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<sup>8</sup> *CCH Canadian Ltd. v. Law Society of Upper Canada*, [2004] 1 S.C.R. 339, 2004 SCC 13.

<sup>9</sup> VERSTEEG, Russ. Rethinking originality. *Willian and Mary Law Review*, v. 34, p. 801-883, 1993.

36. Is fundamental to read Katherine's and Juo's article<sup>10</sup>. They explore the Atari, *Willard*, and *Ajit* cases decisions. Giving the very low standard established by the Supreme Court, most works satisfy the requisite, even those which are poor, modest or obvious.
37. The *Atari case*<sup>11</sup>, although judged before *Feist*, perfectly illustrates the reasoning of the Supreme Court. A simple combination of rectangular forms, even if arranged in a modest or obvious way, was held protected expression by the court, as opposed to the Copyright Office refusal to registry the game *Breakout*. The Court stressed that while individual graphical elements of each of *Breakout's* screens are not copyrightable, the images, when taken together as a whole, constitute a copyrightable work of art.
38. In the *Willard case*<sup>12</sup> the combination of public domain Arabic numbers with a "Caneel" petroglyph as the middle two zeros in the calendar year 2000, was held also protected expression. Although all the elements were public domain, the combination, again, was considered to be original and to satisfy the modicum of creativity.
39. In the *Ajit case*<sup>13</sup>, the minimum alteration of the shape of the Indian word *Ajit*, which means unconquerable, was considered protected expression, demonstrating really how minimal is the standard.
40. I would like to end my presentation pointing out today's importance of studying originality in common law. Civil law countries would beneficiate a lot from this experience. I've researched extensively also originality in France, Italy, Germany and Brazil. Maybe we can also talk about these concepts after my presentation.

.... Thank very much you, merci beaucoup!

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<sup>10</sup> KATHERINE, L. Macdaniel; JUO, James. A *quantum* of originality in copyright. *Chicago-Kent Journal of Intellectual Property*, v.8, p. 169-188, 2009.

<sup>11</sup> *Atari Games Corp. v. Oman*, 888 F.2d 878 (D.C. Cir. 1989).

<sup>12</sup> *Willard v. Estern* 206 F.Supp.2d 723 (2002).

<sup>13</sup> *Sadhu Singh Hamdard Trust v. Ajit Newspaper Advertising, Marketing and Communications, Inc.* No. 09-4965-cv.