

HEINONLINE

Citation: 15 Intell. Prop. L. Bull. 111 2010-2011



Content downloaded/printed from [HeinOnline](#)

Tue Apr 18 05:53:45 2017

-- Your use of this HeinOnline PDF indicates your acceptance of HeinOnline's Terms and Conditions of the license agreement available at <http://heinonline.org/HOL/License>

-- The search text of this PDF is generated from uncorrected OCR text.

-- To obtain permission to use this article beyond the scope of your HeinOnline license, please use:

[Copyright Information](#)

Discounting the Sweat of the Brow: Converging International Standards for Electronic Database Protection

BRYCE CLAYTON NEWELL*

I. DATABASE PROTECTION GENERALLY

Despite some historically stark differences in database protection standards between jurisdictions that require skill, labor, and investment, and those that require a “higher” threshold of originality¹—such as requiring a work to exhibit creativity or the personality of its author²—recent trends have put international standards of originality for database³ purposes on a convergent course.⁴ Notably, jurisdictions within the European Union provide distinct *sui generis* protection for databases in addition to potential copyright protection,⁵ while other jurisdictions, such as the United States, Canada, and Australia, protect databases only through copyright, subject to national standards of originality.⁶ In recent decades, the required level of originality in these jurisdictions has been in a state of flux. The standards for protection imposed by courts range from requiring a “creative spark” exhibited in the selection and arrangement of database material⁷ to protection based solely on substantial investment made in compiling the database, regardless of creativity.⁸ Indeed, the issue of whether to grant

* Bryce Newell holds a J.D. from the UC Davis School of Law. The author thanks Robert Clark and Coke Newell for suggestions and corrections. Additional thanks to Aprille, Annalisa, Caden, and Aspen for their love and support.

1. Mary S. W. Wong, ‘Transformative’ User-Generated Content in Copyright Law: *Infringing Derivative Works or Fair Use?* 11 VAND. J. ENT. & TECH. L. 1075, 1088–90 (2009); Daniel Gervais, *Feist Goes Global: A Comparative Analysis of the Notion of Originality in Copyright Law* 49 J. COPYRIGHT SOC’Y USA 949, 956 (2002) [hereinafter Gervais, *Feist Goes Global*].

2. See *infra* Part I.B.1.

3. A database, for legal purposes, is generally defined as a collection or compilation of independent works, data, or other materials, arranged in a systematic or methodical way and individually accessible by any (electronic or other) means. Copyright and Related Rights Act 2000, s 2(1) (Ir.); Copyright, Patent and Designs Act 1998, s 3A(1) (UK).

4. Gervais, *Feist Goes Global*, *supra* note 1, at 951.

5. See *infra* Part I.B.2.

6. For a discussion comparing protection in a variety of countries, see Daniel Gervais, *The Protection of Databases* 82 CHI.-KENT L. REV. 1109, 1148–57 (2007) [hereinafter Gervais, *Protection of Databases*].

7. *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991).

8. See *Telstra Corp. Ltd. v. Desktop Mktg. Sys. Pty. Ltd.* (2001) 181 A.L.R. 134 (Austl.), appeal dismissed, *Desktop Mktg. Sys. Pty. Ltd. v. Telstra Corp. Ltd.* (2002) 119 F.C.R. 491,

protection for so called non-original databases—those composed of largely factual information not independently worthy of copyright, such as names, addresses, and phone numbers in telephone directories—rests at the center of this divide and has been hotly contested in international forums.

The major international treaties have not done much to provide general protection for non-original databases.⁹ The Berne Convention, the Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPS”), and the World Intellectual Property Organization (“WIPO”) Copyright Treaty all condition protection for collections or compilations on the requirement that they are independent “intellectual creations,”¹⁰ predicated on the author’s contribution of “non-trivial, non-mechanical choices.”¹¹ Additionally, WIPO’s proposed treaty on the legal protection of databases remains in draft form years after its inception.¹² The European Union took initiative in 1996 by issuing Council Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases (the “Directive”),¹³ thereby requiring member states to implement a system of dual protection.¹⁴ However, after the European Court of Justice reigned in – or clarified – the type of investment required for the *sui generis* right to subsist in a database,¹⁵ it remains unclear whether the resulting Directive will protect non-original databases as fiercely as originally thought. Recent copyright jurisprudence in Europe, North America, and Australia suggests that originality standards for non-original databases are on convergent paths—requiring something more akin to creativity rather than mere investment.

A. THE ORIGINALITY STANDARD IN THE UNITED STATES

The United States protects databases through copyright law and does not provide for a system of *sui generis* protection.¹⁶ The United States Congress has repeatedly considered implementing a distinct

available at http://www.austlii.edu.au/au/cases/cth/federal_ct/2001/612.html; but see *IceTV Pty. Ltd. v Nine Network Australia Pty. Ltd.* (2009) 239 C.L.R. 458. For a discussion of the various levels of protections, see MARK J. DAVISON, *THE LEGAL PROTECTION OF DATABASES* 10–11 (Cambridge University Press, 2003).

9. Gervais, *Protection of Databases*, *supra* note 6, 1118.

10. *Id.* at 1114–18.

11. *Id.* at 1118.

12. *Id.* at 1119.

13. Council Directive 96/9/EC, 1996 O.J. (L 77) 20 (EC) (hereinafter *Database Directive 96/9/EC*).

14. *Id.*

15. See Case C-444/02, *Fixtures Mktg. Ltd. v. Organismos Prognostikon Agonon Podosfairou AE*, 2004 E.C.R. I-10549; Case C-338/02, *Fixtures Mktg. Ltd. v. Svenska Spel AB*, 2004 E.C.R. I-10497; Case C-203/02, *British Horseracing Bd. Ltd. v. William Hill Org. Ltd.*, 2004 E.C.R. I-10415; Case C-46/02, *Fixtures Mktg. Ltd. v. Oy Veikkaus AB*, 2004 E.C.R. I-10365.

16. See Gervais, *Protection of Databases*, *supra* note 6, at 1134.

system of database protection.¹⁷ Indeed, database protection bills were introduced in the 104th, 105th, 106th, 107th, and 108th Congresses, but without much success.¹⁸ As a result, databases are subject to the same standard of originality as other copyrightable works.¹⁹ The mandate that works must exhibit some degree of originality before copyright protection will adhere to them is firmly rooted in the U.S. Constitution.²⁰ The Supreme Court has held that the terms “authors” and “writings” as used in the Constitution “presuppose [this] degree of originality.”²¹ Although the originality requirement for copyright protection is a relatively low bar, copyright does not protect facts or ideas, only expression.²²

Prior to the Supreme Court’s decision in *Feist Publications Co. v. Rural Tel. Serv. Co.*, federal courts applied different standards of originality. The Second, Fifth, Ninth, and Eleventh Circuits adhered to a “creative selection” theory that rewarded creativity,²³ while other circuits granted protection for labor, skill, and investment on “sweat of the brow” principles.²⁴ These two lines of cases arguably represent the two principal justifications for providing copyright protection; to reward effort and investment, or to reward creativity and the enhancement of the public domain.²⁵ The *Feist* decision, however, is said to have “dropped a bomb” on the country’s copyright jurisprudence when it espoused the latter viewpoint,²⁶ despite the fact that the Supreme Court essentially only resolved a circuit split and did not create a new standard.²⁷ The “sweat of the brow” doctrine, or

17. Joseph J. Beard, *Clones, Bones and Twilight Zones: Protecting the Digital Persona of the Quick, the Dead and the Imaginary* (2001) 16 BERKELEY TECH. L.J. 1165, 1169, 1180.

18. Gervais, *Protection of Databases*, *supra* note 6, at 1142. See also Beard, *supra* note 17, at 1180 n.21; *Database and Collections of Information Misappropriation Act: Hearing before the Subcomm. on Courts, the Internet, and Intellectual Property of the Comm. on the Judiciary and the Subcomm. on Commerce, Trade and Consumer Protection of the Comm. on Energy and Commerce*, 108th Cong. (2003) (statement of David O. Carson, General Counsel, U.S. Copyright Office), available at <http://www.copyright.gov/docs/regstat092303.html>; *Database and Collections of Information Misappropriation Act*, 108th Cong. (2003), available at <http://thomas.loc.gov/cgi-bin/query/z?c108:H.R.3261>.

There has also been a debate about the constitutionality of these congressional attempts to provide protection for databases beyond that granted by copyright, based on the premise that such protection would “alter the balance between protection and public access/competition embodied in the Copyright and Patent Clause” of the U.S. Constitution. Gervais, *Protection of Databases*, *supra* note 6, at 1142.

19. See Gervais, *Protection of Databases*, *supra* note 6, at 1134.

20. U.S. CONST. art. I, § 1, cl. 8. See also *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346–347 (1991).

21. *Feist*, 499 U.S. at 346–347.

22. *Id.* at 350–351.

23. Gervais, *Protection of Databases*, *supra* note 6, at 1133.

24. *Feist*, 499 U.S. at 351–352.

25. Gervais, *Protection of Databases*, *supra* note 6, at 1134.

26. See *id.* at 1133 (citing Ginsburg, *Statement on H.R. 2652: The Collections of Information Antipiracy Act* (Oct. 28, 1997), available at <http://www.hyperlaw.com/topix/database/ginsburg.htm> (attributing the quote to the Register of Copyrights at the time the *Feist* decision was announced)).

27. Gervais, *Feist Goes Global*, *supra* note 1, at 950, 953.

“industrious collection” had been circulating through a number of lower courts for years by the time *Feist* came along.²⁸ The American decisions that adhered to the “sweat of the brow” doctrine were based on a line of authority that led all the way back to the English cases *Kelly v. Morris*²⁹ and *Morris v. Ashby*³⁰ from the 1860s.³¹ A classic example of this doctrine, discussed in the *Feist* decision, stated that:

The right to copyright a book upon which one has expended labor in its preparation does not depend upon whether the materials which he has collected consist or not of matters which are publici juris, or whether such materials show literary skill *or originality*, either in thought or in language, or anything more than industrious collection. The man who goes through the streets of a town and puts down the names of each of the inhabitants, with their occupations and their street number, acquires material of which he is the author.³²

The *Feist* Court overruled the sweat of the brow doctrine, concluding that some threshold amount of material must be “independently created by the author (as opposed to copied from other works)”³³ and that the work must possess “at least some minimal degree of creativity.”³⁴ The Court also held, quite clearly, that creativity is the only valid basis for granting copyright protection.³⁵ The required amount of creativity is decidedly low,³⁶ and the “vast majority of works make the grade quite easily, as they possess some creative spark.”³⁷ In *Feist*, the Court held that copyright would not protect listings in a telephone directory because the information was purely factual and its alphabetical arrangement did

28. *Feist*, 499 U.S. at 352–54.

29. *Kelly v. Morris*, (1866) 1 L.R.Eq. 697 (the plaintiff claimed copyright in a street directory).

30. *Morris v. Ashbee* (1868) 7 L.R.Eq. 34 (The defendant in an earlier case, claimed copyright in his trade directory comprised of an alphabetical list of names and occupations of merchants and traders carrying on business in London. Sir Giffard V.C. said:

The Plaintiff incurred the labour and expense first of getting the necessary information for the arrangement and compilation of the names as they stood in his directory, and then of making the actual compilation and arrangement . . . [I]n a case such as this no one has a right to take the results of the labour and expense incurred by another for the purposes of a rival publication, and thereby save himself the expense and labour of working out and arriving at these results by some independent road. If this was not so, there would be practically no copyright in such a work as a directory.

Morris, (1868) 7 L.R.Eq. 34 at 40–41).

31. See *Telstra Corp. Ltd. v Desktop Mktg. Sys. Pty. Ltd.* (2001) 181 A.L.R. 134 (Austl.), appeal dismissed, *Desktop Mktg. Sys. Pty. Ltd. v Telstra Corp. Ltd.* (2002) 119 F.C.R. 491, available at http://www.austlii.edu.au/au/cases/cth/federal_ct/2001/612.html.

32. *Feist*, 499 U.S. at 352–53 (quoting *Jeweler’s Circular Publ’g Co. v. Keystone Publ’g Co.* 281 F. 83 (2d Cir. 1922)) (emphasis added).

33. *Id.* at 345.

34. *Id.*

35. Gervais, *Protection of Databases*, *supra* note 6, at 1134.

36. *Feist*, 499 U.S. at 345.

37. *Id.*

not “possess more than a de minimis quantum of creativity.”³⁸ The *Feist* definition of creativity precludes some factually based works from obtaining copyright protection, including digital models of real life objects,³⁹ bookkeeping forms,⁴⁰ and systematically arranged telephone directories.⁴¹ However, even after *Feist*, expression can exist in the creative selection and arrangement of otherwise unprotectable material.⁴²

Despite the confusing lack of consistency among the circuit courts prior to 1991, *Feist* has presumably cleared up any confusion these cases might have provided about the vitality of the sweat of the brow doctrine in American copyright law. Post *Feist*, American courts have consistently rejected the sweat of the brow doctrine in the text of their judgments.⁴³ However, because the creativity threshold is quite low, courts have struggled to define its parameters and some courts have arguably rewarded less than creative effort with what has been referred to as “thin copyright protection.”⁴⁴ In *CCC Information Services, Inc. v. Maclean Hunter Market Reports, Inc.*, for example, the U.S. Court of Appeals for the Second Circuit granted copyright protection for a compilation of used car valuations because the process of valuation itself involved some creativity.⁴⁵ Additionally, many post-*Feist* appellate cases involving factual compilations have resulted in decisions finding the requisite creativity.⁴⁶ This is evidence that, in practice, the American standard is still quite low.

B. THE ORIGINALITY STANDARD(S) IN THE EUROPEAN UNION

In 1996, the European Parliament and Council of the European Union issued Directive 96/9/EC on the legal protection of databases.⁴⁷

38. *Feist*, 499 U.S. at 363 (emphasis omitted).

39. See *Meshwerks Inc. v. Toyota Motor Sales U.S.A., Inc.*, 528 F.3d 1258 (10th Cir. 2008).

40. See *Baker v. Selden*, 101 U.S. 99 (1879).

41. In some post-*Feist* cases, however, federal appellate courts have upheld copyrights in factual compilations. See *Assessment Techs. of WI, LLC v. WIREdata, Inc.* 350 F.3d 640 (7th Cir. 2003); *TransWestern Publ'g Co. LP v. Multimedia Mktg. Assocs., Inc.*, 133 F.3d 773 (10th Cir. 1998); *Lipton v. Nature Co.*, 71 F.3d 464 (2d Cir. 1995); *Warren Publ'g, Inc. v. Microdos Data Corp.*, 52 F.3d 950 (11th Cir. 1995); *CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports, Inc.*, 44 F.3d 61 (2d Cir. 1994); *Key Publ'ns, Inc. v. Chinatown Today Publ'g Enters., Inc.*, 945 F.2d 509 (2d Cir. 1991); *Kregos v. Associated Press*, 937 F.2d 700 (2d Cir. 1991); *U.S. Payphone, Inc. v. Execs. Unlimited of Durham, Inc.*, 18 U.S.P.Q.2d (BNA) 2049 (4th Cir. 1991).

42. *Feist*, 499 U.S. at 345 (“The compilation author typically chooses which facts to include, in what order to place them, and how to arrange the collected data so that they may be used effectively by readers. These choices as to selection and arrangement, so long as they are made independently by the compiler and entail a minimal degree of creativity, are sufficiently original that Congress may protect such compilations through the copyright laws.” (citing 1-2 NIMMER ON COPYRIGHT §§ 2.11[D], 3.03)).

43. For a list of cases, see Gervais, *Feist Goes Global*, *supra* note 1, at 956 n.41.

44. *Id.*

45. *CCC Info. Servs., Inc.*, 44 F.3d 61, 64–65 (2d Cir. 1994), *cert. denied*, 516 U.S. 817 (1995). See Gervais, *Feist Goes Global*, *supra* note 1, at 956.

46. Gervais, *Feist Goes Global*, *supra* note 1, at 956 n.41.

47. *Database Directive 96/9/EC*, *supra* note 13.

The Directorate-General introduced the Directive as an antidotal response to *Feist*.⁴⁸ The Directive's intent was to expand protection beyond the limited reach of copyright caused by the originality/creativity requirement,⁴⁹ as well as to harmonize existing laws in respect to database protection.⁵⁰ Under the Directive, injured parties can find relief through copyright or distinct *sui generis* protection. Database owners are protected from the extraction or reutilization of a substantial part of their database, evaluated qualitatively or quantitatively,⁵¹ and from the repeated and systematic extraction or reutilization of insubstantial parts in conflict with the legitimate interests of the database owner.⁵² The two methods of protection under the Directive may overlap, and finding protection under one scheme does not affect potential protection under the other.⁵³ Because of the Directive's dual system of protection, different standards apply for copyright and *sui generis* protection.

1. The Copyright Originality Standard

Under the Directive, member states are required to protect databases through copyright when the selection and arrangement of the database constitutes "the author's own intellectual creation."⁵⁴ As a result of the Directive, the originality standards for copyright in the common law jurisdictions of the Republic of Ireland and United Kingdom have been raised with respect to databases.⁵⁵ Prior to the Directive, these jurisdictions held that copyright could protect compilations lacking any literary merit solely because of labor extended in their creation,⁵⁶ similar to some U.S. jurisprudence prior to *Feist*.⁵⁷ In both the United Kingdom and Ireland, legislation implementing the Directive now predicates protection on works that are the author's "own intellectual creation"—as is required by the Directive.⁵⁸ These changes have resulted in standards of originality closer, though not necessarily identical, to *Feist*'s heightened creativity standard.⁵⁹ In addition, many civil law jurisdictions in

48. Gervais, *Protection of Databases*, *supra* note 6, at 1119–1120.

49. *Id.*

50. *Database Directive 96/9/EC*, *supra* note 13, at Preamble, paras. 2, 4.

51. *Id.* at art. 7(1).

52. *Id.* at art. 7(5).

53. Gervais, *Protection of Databases*, *supra* note 6, at 1178–79.

54. *Database Directive 96/9/EC*, *supra* note 13, at art. 3(1).

55. Robert Clark, "Sui Generis Database Protection: A New Start for the UK and Ireland?" 2 J. INTELL. PROP. L. & PRACTICE 97, 98 (2007).

56. *JC Gleeson v HR Denne Ltd* [1975] RPC 471, 483 (Whitford J).

57. For one example, compare *JC Gleeson v HR Denne Ltd* [1975] RPC 471 with *Jeweler's Circular Publ'g Co. v. Keystone Publ'g Co.*, 281 F. 83 (2d Cir. 1922), *cert. denied*, 259 U.S. 581 (1922).

58. Copyright and Related Rights Act 2000 §§ 2(1), 18(1); Copyright, Designs and Patents Act 1988 § 3A(2).

59. Cristin Fenzel, Note, *Still Life with "Spark" And "Sweat": the Copyrightability of Contemporary Art in the United States and the United Kingdom*, 24 ARIZ. J. INT'L & COMP. LAW

Europe have interpreted the Directive's "intellectual creation" requirement to coincide with their previously held requirement that works exhibit the personality of their author before they can obtain copyright protection,⁶⁰ a historically higher standard than industrious collection.

2. *Sui Generis* Protection: The Requirement of Substantial Investment

The Directive also provides *sui generis* protection for databases that have been created by "the investment of considerable human, technical and financial resources."⁶¹ For *sui generis* protection to adhere, the maker of the database must have made a qualitatively or quantitatively substantial investment in obtaining, verifying, or presenting the data.⁶² However, in a quartet of cases in 2004, the European Court of Justice (ECJ) limited the scope of the Directive's protection when it clarified the type of investment required to obtain protection under the *sui generis* right.⁶³ The ECJ held that substantial investment in *obtaining, presenting, or verifying* pre-existing data would enable the creator to benefit from protection, while investment in *creating* the data would not.⁶⁴ The ECJ decision effectively denied database protection to football fixtures and horseracing schedules⁶⁵ because drawing up these lists involved only the *creation* of data. Determining that the Directive should not protect the football fixture data at issue in the *Fixtures Marketing* cases, the ECJ held that:

Finding and collecting the data which make up a football fixture list do not require any particular effort on the part of the professional leagues. *Those activities are indivisibly linked to the creation of those data*, in which the leagues participate directly as those responsible for the organization of football league fixtures. Obtaining the contents of a football fixture list thus does not require any investment independent of that required for the creation of the data contained in that list.⁶⁶

Similarly in *British Horseracing Board v William Hill*, perhaps the most significant of the 2004 decisions, the ECJ stated that the

541, 570 (2007).

60. See Clark, *supra* note 55, at 101; Gervais, *Protection of Databases*, *supra* note 6, at 1152.

61. *Database Directive 96/9/EC*, *supra* note 13, at Preamble, para. 7. See Beard, *supra* note 17, at 1178–1179.

62. *Database Directive 96/9/EC*, *supra* note 13, at art. 7(1); See Beard, *supra* note 17, at 1179.

63. Case C-444/02, *Fixtures Mktg. Ltd. v. Organismos Prognostikon Agonon Podosfairou AE*, 2004 E.C.R. I-10549; Case C-338/02, *Fixtures Mktg. Ltd. v. Svenska Spel AB*, 2004 E.C.R. I-10497; Case C-203/02, *British Horseracing Bd. Ltd. v. William Hill Org. Ltd.*, 2004 E.C.R. I-10415; Case C-46/02, *Fixtures Mktg. Ltd. v. Oy Veikkaus AB*, 2004 E.C.R. I-10365. See also Gervais, *Protection of Databases*, *supra* note 6, at 1126.

64. Case C-46/02, *Fixtures Mktg. Ltd. v. Oy Veikkaus AB*, 2004 E.C.R. I-10365. See also Gervais, *Protection of Databases*, *supra* note 6, at 1126–7.

65. Mark J. Davison & P. Bernt Hugenholtz, "Football Fixtures, Horseraces and Spin-offs: The ECJ Domesticates the Database Right" 27 *EUR. INTELL. PROP. REV.* 113, 113 (2005).

66. Case C-46/02, *Fixtures Mktg. Ltd. v. Oy Veikkaus AB*, 2004 E.C.R. I-10365 at ¶ 44 (emphasis added).

effort and investment in organizing horse races and collecting and verifying the large amounts of data at issue constituted investment only in creating the data – not in its collection, presentation, or verification.⁶⁷ Following these decisions by the ECJ, a Dutch court, in *Zoekallehuizen.nl v. NVM*,⁶⁸ distinguished between these different types of investment. The Dutch court held that creating property descriptions, taking photographs, and writing up the results of agent inspections of properties to be posted on a real estate website, and the subsequent entry of this data into an electronic database did not qualify as substantial investment, despite the fact that such investment required the expenditure of both time and resources.⁶⁹

Evidenced by these recent decisions and by the volume of additional case law spawned by the Directive, both national courts and the European Court of Justice have turned to “a pronounced hostility to affording either copyright protection or *sui generis* protection to ‘factual’ databases” because they lack originality or substantial investment.⁷⁰ This hostility appears to be in opposition to the intent of the Directive’s drafters,⁷¹ because it draws European database law closer, rather than away from, the result in *Feist*.⁷² Indeed, at least one commentator has said that these cases in Europe have shown that the Directive provides even less protection for fact-based compilations than U.S. copyright law after *Feist*.⁷³

C. THE ORIGINALITY STANDARD IN CANADA

Canada’s originality jurisprudence involving factual compilations found itself at a crossroads after the *Feist* decision.⁷⁴ On one hand, the skill and labor standard, originally established in the English case *Univ. of London Press, Ltd. v. Univ. Tutorial Press, Ltd.*,⁷⁵ has been

67. Case C-203/02, *British Horseracing Board Ltd v William Hill Organization Ltd* (“BHB”) [2005] 1 CMLR 319 at ¶¶ 80, 39–42.

68. District Court (Arrondissementsrechtbank) Arnhem, March 16, 2006, available at http://zoeken.rechtspraak.nl/resultpage.aspx?snelzoeken=true&searchtype=ljn&ljn=AV5236&u_ljn=AV5236.

69. *Id.* See also Clark, *supra* note 55, at 99.

70. Clark, *supra* note 55, at 97.

71. *Id.*

72. EU Database Directive 96/9/EC defines a database as “a collection of independent works, data or other materials arranged in a systematic or methodical way and individually accessible by electronic or other means” and requires European Union member countries to provide harmonious laws regarding copyright protection for databases. Database Directive 96/9/EC, *supra* note 13, art. 1.2.

73. Clark, *supra* note 55, at 98.

74. See Gervais, *Protection of Databases*, *supra* note 6, at 1149–50; Gervais, *Feist Goes Global*, *supra* note 1, at 961–66.

75. [1916] 2 Ch. 601, 608 (“The word original does not in this connection mean that the work must be the expression of original or inventive thought. Copyright Acts are not concerned with the originality of ideas, but with the expression of thought The Act [requires] that the work not be copied from another work—that it should originate from the author”). The skill and labor element was further developed in *Ladbroke (Football), Ltd. v. William Hill (Football), Ltd.* [1964] 1 All E.R. 465, 469 (H.L.).

called, by one commentator, a “fundamental principle of Anglo-Canadian copyright law.”⁷⁶ On the other hand, provisions from the Berne Convention—included in the North American Free Trade Agreement (“NAFTA”)—specified that compilations were to be protected when they constituted “intellectual creations.”⁷⁷ In *Tele-Direct*,⁷⁸ another telephone directory case, the Canadian Federal Court of Appeal explicitly concluded that the *Feist* creativity standard was the more appropriate of the two options and denied copyright in the directory at issue.⁷⁹ In reaching its conclusion, the *Tele-Direct* court found that by signing NAFTA and amending its copyright act accordingly, the Canadian Government and Parliament intended the courts to look for some evidence of creativity as opposed to merely industrious collection.⁸⁰

Canadian courts did not all follow *Tele-Direct*’s reasoning with enthusiasm, however, and in 2004 the Supreme Court of Canada opted for what it called a middle-ground approach in *CCH Canadian Ltd. v. Law Society of Upper Canada*.⁸¹ The Court disclaimed any Canadian espousal of *Feist* and laid out a new test for determining originality that requires that the work: (1) originate with the author; and (2) that the skill and judgment required to produce the work not be “so trivial that it could be characterized as a purely mechanical exercise.”⁸² According to the decision, this necessarily implicated an exercise of skill and judgment that involved “intellectual effort.”⁸³ Despite the Court’s suggestion of taking a middle path, this standard has been said to mirror the results of *Feist* because a modicum of creativity is exactly what lifts the effort above the trivial or mechanical.⁸⁴ Indeed, in *CCH*, the Court said that its middle-ground approach avoided the requirement that a work be “creative,” however the Court merely defined creativity as “being novel or unique.”⁸⁵ In *Feist*, Justice O’Connor reiterated that “[o]riginality does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous,

76. Morgan, *Trash Talking: the Protection of Intellectual Property Rights in Computer Software* 26 OTTAWA L. REV. 425, 462 (1994).

77. Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, last revised July 24, 1971, S. TREATY DOC. NO. 99–27.

78. *Tele-Direct (Publications) Inc. v. American Business Information, Inc.* [1998] 2 F.C. 22 (Can).

79. *Id.* at 309.

80. *Id.* at 303 n.81.

81. [2004] 1 S.C.R. 339 (Can.).

82. *CCH Canadian Ltd. v. Law Society of Upper Canada*, [2004] 1 S.C.R. 339, para. 25 (Can.); Gervais, *Protection of Databases*, *supra* note 6, at 1150. The first part of the Canadian test is similar to the “skill and labour” test from *Univ. of London Press*, [1916] 2 Ch. 601.

83. *CCH Canadian*, [2004] 1 S.C.R. at para. 16.

84. Gervais, *Protection of Databases*, *supra* note 6, at 1150.

85. *CCH Canadian*, [2004] 1 S.C.R. at para. 16.

not the result of copying.”⁸⁶ Coupled with the fact that recent U.S. case law supports a very low threshold of “creativity” after *Feist*, *CCH*’s requirement of “intellectual effort” that cannot be “characterized as a purely a mechanical exercise”⁸⁷ would seem to require very similar results in application.

D. THE ORIGINALITY STANDARD IN AUSTRALIA

Australia’s database originality jurisprudence provides a perfect example of the volatile nature of defining these standards in recent practice. Australian courts, like those in Ireland and the UK, have historically granted copyright protection to works based on industrious collection and “sweat of the brow” principles.⁸⁸ In a recent Australian case, *Telstra Corp. Ltd., v. Desktop Marketing Systems Pty. Ltd.*,⁸⁹ the Australian Federal Court, exercising its appellate jurisdiction, was confronted with facts similar to those in *Feist*. In *Telstra*, the plaintiff had created a number of white and yellow page telephone directories⁹⁰ and claimed the defendants infringed its copyrights.⁹¹ The court examined British and American case law,⁹² including the *Feist* decision, and held that the plaintiff’s directories were copyrightable as a whole,⁹³ explicitly rejecting the *Feist* rationale requiring a “spark of creativity.”⁹⁴ Upholding this decision on appeal, the Federal Court of Australia held that the telephone directories were original, and therefore copyrightable, because “Telstra had undertaken substantial labour and incurred substantial expense” in compiling and presenting the information in its directory.⁹⁵

However, in the 2009 case of *IceTV v Nine Network Australia*,⁹⁶ the High Court of Australia disapproved of the *Telstra* court’s reasoning⁹⁷ in two separate judgments and finally reversed the prior judgment of the Full Court of the Federal Court of Australia. In that case, Nine Network Australia (“Nine”) distributed weekly television programming schedules for its television networks to third party aggregators.⁹⁸ The information in these weekly schedules was pulled

86. *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991).

87. *CCH Canadian*, [2004] 1 S.C.R. at para. 16.

88. Wong, *supra* note 1, at 1089–90.

89. *Telstra Corp. Ltd. v Desktop Mktg. Sys. Pty. Ltd.* (2001) 181 A.L.R. 134 (Austl.), appeal dismissed, *Desktop Mktg. Sys. Pty. Ltd., v Telstra Corp. Ltd.* (2002) 119 F.C.R. 491.

90. *Id.* at para. 1.

91. *Id.* at para. 7.

92. *Id.* at paras. 50–85.

93. *Id.* at para. 90.

94. *See id.* at para 85.

95. *Desktop Mktg. Sys Pty. Ltd. V Telstra Corp. Ltd.* (2002) 119 F.C.R. 491, 599 (Austl.) (Sackville, J., concurring).

96. *IceTV Pty. Ltd. v Nine Network Australia Pty. Ltd.* (2009) 239 C.L.R. 458.

97. *Id.* at paras. 52, 134, 187–188.

98. *Id.* at para. 92.

from a database on Nine’s computer network.⁹⁹ IceTV, on the other hand, provided its subscribers with an internet-based electronic television program guide, which included stations on Nine’s network.¹⁰⁰ IceTV used a number of sources, including Nine’s aggregated weekly schedules, to create its own television listings.¹⁰¹ The *IceTV* court was focused primarily on the substantiality of the defendant’s taking and not on the issue of originality—indeed, both parties accepted that the Nine database was an original literary work.¹⁰² However, dicta in the judgments strongly suggest that the proper originality touchstone is the skill and effort directed at a particular form of expression rather than just a broad inquiry into expense and labor extended.¹⁰³ In fact, the Australian Digital Alliance, as amicus curiae, explicitly asked the *IceTV* court to overrule the *Desktop Marketing* decision and hold that some “creative spark” or exercise of “skill and judgment” was required for copyright subsistence—the American and Canadian standards.¹⁰⁴ The court declined to rule directly on the issue, but declared that:

It is by no means apparent that the law even before the 1911 Act was to any different effect to that for which the Digital Alliance contends. It may be that the reasoning in *Desktop Marketing* with respect to compilations is out of line with the understanding of copyright law over many years. These reasons explain the need to treat with some caution the emphasis in *Desktop Marketing* upon “labour and expense” per se and upon misappropriation.¹⁰⁵

This language provides strong ground for the assertion that the Australian originality standard is much closer to that in *Feist* or *CCH* than previously thought. Hopefully, this language will produce decisions in the not to distant future that explore this redirected standard of originality in greater detail.

II. CONCLUSION

In summary, the recent trend to back away from database originality standards based purely on industrious collection or other forms of sweat of the brow principles has necessarily resulted in rising originality thresholds. Additionally, the ECJ’s rulings in respect to the EU’s *sui generis* right have narrowed the scope of acceptable investment under that system. In regard to copyright, the jurisdictions

99. *Id.* at para. 113.

100. *Id.* at para. 4.

101. *Id.* at para. 5.

102. *Id.* at paras. 6–7.

103. See *id.* at para. 52–54 (“[A] critical question is the degree of originality of the particular form of expression of the part. Consideration of the skill and labour expended by the author of a work may assist in addressing that question: that the creation of a work required skill and labour may indicate that the particular form of expression adopted was highly original.”).

104. *IceTV Pty. Ltd.* (2009) 239 C.L.R. 458, at para. 187.

105. *Id.* at para. 188.

discussed above all now appear to require an element in addition to requiring that a work originate with its author. In America, this second element has been characterized as a “minimal degree of creativity”¹⁰⁶; in Canada “intellectual effort” that cannot be “characterized as a purely a mechanical exercise”¹⁰⁷; in Europe, the work must constitute “the author’s own intellectual creation”¹⁰⁸; and in Australia, the High Court has suggested that the test is whether the skill and effort is directed at a particular form of expression rather than just a broad inquiry into expense and labor extended,¹⁰⁹ and that this conception is not necessarily out of line with the standards announced in the U.S. and Canada.¹¹⁰ Regardless of potential differences in practical effect, these standards represent a drastic shift from the long-held industrious collection ideals that have permeated copyright jurisprudence in the common law for well over a hundred years, and present a clear picture of standards on convergent paths.

106. Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 348 (1991).

107. CCH Canadian Ltd. v. Law Society of Upper Canada, [2004] 1 S.C.R. 339, para. 16 (Can.).

108. *Database Directive 96/9/E*, *supra* note 13, at art. 3(1).

109. See *IceTV Pty. Ltd.*, (2009) 239 C.L.R. 458, at para. 52.

110. *Id.* at para. 188.