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Critically discuss, in relation to UK copyright law, (i) “the originality criterion as it applies to ‘copies’ of works”, and (ii) “the ownership of employee created works and commissioned works”.

By Krishan Thakker

1. The originality criterion as it applies to ‘copies’ of works

Originality is a concept in Intellectual Property Law which is concerned with the relationship between the author and his/her work, and is one of several requirements that need to be satisfied for work to gain copyright protection in the UK. It is enshrined in the Copyright, Designs and Patents Act 1988, s. 1(1), and it can be said that its essence has derived from more judicial reasoning and logic, as well as now EU legislation, than from its initial UK statutory basis and support. To be fulfilled it requires that the author must have exercised the requisite intellectual qualities. Due to harmonisation of copyright law in the EU, the ‘author’s own intellectual creation’ is used in the UK to determine the originality of databases, computer programs and photographs. For literary, dramatic, musical and artistic (LDMA) works (see Copyright, Designs and Patents Act 1988, s. 1 (1) (a)), the test in the UK is whether there was sufficient labour, skill and effort expended into them. A traditional perspective is that British copyright law treats the separate elements (i.e. artistic, musical, literary and dramatic) in one composite creation as having distinct copyrights, each with their own author and term. Today, a numerous amount of material is being held in digital form, and so ‘originality’ distinctions between the categories are diminishing. The law has shifted to favour and adopt a simpler and cumulative approach/solution in relation to ‘originality’, especially due to the fact that multi-media digital products are on the increase, and therefore, for the purposes of this essay, they shall all be considered together to reflect commercial reality.

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Copyright and Designs Essay 1

Copyright hence focuses on the input of an author's contribution to the resulting work, from which we can derive the fundamental principle that British law is concerned with protecting expressions of ideas rather than ideas themselves. Originality thus sets limits on the duration of protection, as it prevents existing works being the subject of further copyright protection in the absence of additional contribution, which also makes it useful for establishing an infringement of copyright; and it is from such a notion which gives rise to discussion of 'originality' in 'copies' of work, more formally known as 'derivative works' (works which incorporate material copied from another source).

Originality in derivative works can be said to undermine the old principle of originality, namely that in order for a work to be protected, it must 'originate' from the respective author as its source (*University of London Press Ltd v University Tutorial Press (1916)*). Courts in England have however over recent years relaxed such stringency and set the threshold quite low, probably due to changes in society and technological innovation that has ultimately caused an up rise in derivative works. These consist for example of varied works of translations from one language to another, or updated new editions of certain books, and so on. They have been deemed to be protected as a result of a moral obligation more than anything else, which is that authors should be rewarded for building upon pre-existing works. The interesting thing about this is that copyright can subsist in a 'copied' work yet still infringe copyright in an existing work

(i.e. the transposition from 2D to 3D for artistic works), and therefore a derivative work can be both original and infringing.

It must be noted here that mere copying and ‘competent draftmanship’ cannot confer originality, as can be seen in the *Interlego AG v Tyco (1989)* case. Neither will trifling additions and corrections made to an existing work be sufficient to attract copyright protection anew (*Hedderwick v Griffin (1841)*; *Thomas v Turner (1886)*), nor mere reprints of earlier works (*Hogg v Toye & Co. (1935)*). Here, it was submitted that the pre-existing work must be developed or embellished in some way for copyright to subsist in the new work. The mere expenditure of effort or labour has sometimes been said to suffice for conferment of originality, but in practice some minimum element of skill or judgment is usually required, ‘only certain kinds of skill, labour and judgement confer originality’ (Per Lord Oliver, *Interlego* at 263). As Bently and Sherman state, the ‘labour must be of the right kind’. It seems as though in the UK more emphasis is placed on quality rather than quantity. Thus, in *MacMillan v Cooper (1924)* it was held that the labour must portray some sort of ‘individuality’ and ‘independency’. This seems to set an increasingly high standard for the types of labour, skill and judgement, and can be compared with *Walter v Lane (1900)*, another derivative works case, whereby it was held that a newspaper report of an oral speech, transcribed by a reporter, was protected. The House of Lords mentioned that the reduction to writing of the words spoken by someone very quickly is an art requiring training, and is not within the knowledge of an ordinary person (as per Lord Davey and Lord James of Hereford, 551-554). Such a concept has latterly become known as the ‘reporter’s copyright’, a prime example of a protectable derivative work. This leaves open for debate of whether resulting products of

technological advances shall suffice for originality, such as the digitisation of work with no changes. Is this the ‘right kind of labour’ which would render the outcome different and thereby original? Prima facie the answer seems to be in the affirmative, but in light of the decision in *MacMillan* it seems more doubtful.

Furthermore, in *MacMillan*, it was stated that the effort must have provided ‘some quality or character which the raw material did not possess, and which differentiates the product from the raw material’. This consequently establishes that the law ensures that any copyright acquired in the derivative work is distinct from the incorporated original work, and so there is a ‘material change’, as Bently and Sherman put it, in the resulting product (*Byrne v Statist Co. (1914)*; *Cummins v Bond (1927)*). It is all too easy to see that originality, from such a rule, can be conferred upon several things such as compilations, arrangements of music, engravings and translations, to name but a few. However, a difficulty arises in determining what exactly constitutes such a ‘material change’ transformation.

The guiding case on this principle is *Interlego v Tyco*. It was held by the Privy Council here that subsequent drawings were not original artistic work as although the changes were technically significant and the result of considerable labour and expertise, there was no ‘material alteration or embellishment’ present; they were only changes made primarily to the written specifications. It therefore seems that in the case of artistic works the alterations must be both visually and materially significant. However, in *Macmillan* it was held by the High Court that the publication of the respective simplified charts based upon Admiralty charts were ‘original’. Contrasting the amendments made in both cases, it is rather difficult to reconcile the two. It appears that each case is to be decided upon its

own specific facts. A criticism of *Interlego* is that the principle could have severe ramifications for works in other contexts – for instance, types of ‘appropriation art’, where artists focus on meaning rather than just physical visual appearance of the work. The rationale of *Interlego* is further put into doubt when it is the same author who produces a series of drafts/drawings. It was held by Nourse LJ at p.136 in *LA Gear v Hi-Tech Sports (1992)* that in such a scenario it’s unnecessary for the labour to produce materially different work for it to be original.

Finally, to add to the inconsistency of ‘originality’ of derivative works, the law has taken two different approaches to both tables and compilations, namely (i) the quality of labour (appropriate skill, labour and effort) and (ii) the quantity of labour (sufficient amount of routine work), used. Hence both focus on the labour exercises on the work, yet differ on the type of labour needed for work to be classed as original. Tables and compilations are prima facie derivative works in themselves, as for example, a list is made up from pre-existing material, and so all the more reason for the basic notions of ‘originality’ to apply here. Hence, a table/compilation would not be original if merely copied from another work, nor would an automatically selected compilation (*Cramp v Smythson 1944*). The controversial issue arises in determining the quantum of labour used to suffice ‘originality’. Such a rule is based upon the maxim: ‘what is worth copying is prima facie worth protecting’ (*University of London Press v University Tutorial Press*). If a person copies an existing work, s/he has demonstrated that the work incorporated skill/labour; otherwise it would not be worth copying. The problem with this is that if the statement is to be taken at face value, it will prevent defendants from asserting that they are entitled to copy the claimant’s work on the basis that it was not original – a highly absurd

conclusion! It must be stated here that the exercise of non-creative labour has only been used in the UK to confer originality on resulting works in a limited number of situations i.e. largely to tables and compilations of maps, guidebooks, dictionaries and street directories. Additionally, cases which involve this doctrine have focussed on the amount of labour used in the selection of materials to be included, and henceforth the pre-expressive stage.

2. The ownership of employee created works and commissioned works

The basic rule, in regard to ownership, is that the first owner of copyright in a work is the person who created the work i.e. the initial author (Copyrights, Designs and Patents Act 1988, s.11 (1)). The major exception to such rule is found in s .11 (2) of the CDPA 1988, which provides that where a person creates an LDMA (or film) work in the course of employment as an employee, it is prima facie the employer who is the first owner of any copyright in the work (Stephenson Jordan & Harrison v MacDonald (1952); Noah v Shuba (1991)), subject to an agreement to the contrary or any contractual terms in the contract of employment (could be written, oral or implied by conduct). There are also special provisions which apply to the Crown, Parliamentary Copyright and copyright for certain international organisations (CDPA 1988, s. 11(3)).

The rationale of s. 11(2) is that it is employers who provide the facilities and materials that enable the creation of the work, and who provide an important amount of contribution to the production. Further, it can be said that it encourages employers to invest in the infrastructure, for example, that supports creators. Employers are also

deemed to be in better fiscal positions to exploit copyright in works, and that employees are usually rewarded anyway via other means such as wages, continued employment, promotion and even pensions.

In determining an 'employee' for such purposes, the task is relatively simple. Firstly, one needs to look to see if there is a mutuality of obligation. If one is providing work and pay/valuable consideration in return for labour, there is said to be an employment relationship in place. Second, one should look at the degree and capability of exercise of control of one over another. Influential factors can consist of wages, income tax deductions, pension schemes, National Insurance payments, holiday entitlements, and so on. The most controversial factor has to be whether 'the work was made in the course of employment' or not. It is this crucial feature which has caused conflict in the case-law governing this aspect of ownership today. There can be said to be several determining questions which need to be asked here, such as: by whom were the expenses paid? How much of the company's time was taken? Which specific resources were used for the creation of the work? Were other members of staff involved? Was the work created an 'accessory' to the contracted work? Has the employee carried out the task before, and has the employer claimed in the past for such action?

The case-law over the years seems to suggest that courts have been quite reluctant to allow copyright to subsist with employers and large firms. Back in 1914 in the case of *Byrne v Statist*, an employee of "The Financial Times", who translated a Portuguese speech into English, was held to have copyright remain with him and not with the paper,

as translation wasn't part of his normal contractual duties and he did the work in his spare time. In *Stevenson Jordan*, it was held that because it was not shown that the accountant could have possibly been ordered to write and deliver the lectures, and as he had not received extra remuneration for lecturing since lectures were not part of his duties as employee, the work in dispute was not created in the course of employment and so copyright belonged to the accountant employee (even though the text had been typed by the claimant's staff). The work was thus 'not an integral part of the business' (at 22). In addition, because the employer had never claimed copyright infringement in the past, through time a term came to be implied by custom into the contract that copyright subsisted in the employee i.e. an agreement to the contrary, as stipulated in s 11(2). The court also mentioned that the lectures represented services supplied from which the company gained publicity. Could this have been the start to the judicial system's anti-capitalist perspective?

In *Noah v Shuba (1991)*, the court held again that the respective 'hygienic skin piercing' guide was not written in the course of Dr Noah's employment, even though he was employed as a consultant epidemiologist, had discussed the work with colleagues, made use of his employer's library and had the requisite manuscript typed up by the secretary. It was held that the guide was done in addition to his contractual work, and the court tended to place more emphasis on the fact that Dr Noah had written the draft at his home in the evenings and at weekends. Here again, the court critically analysed the express and implied terms of the contract.

The distinction between a contract of service and a contract for services is significant for identifying who is an employee. Thus in *Beloff v Pressdram (1973)*, an internal memo made by the claimant for the “Observer” newspaper was owned by the paper, the issue being whether she was employed under a contract of service or a contract for services. Similarly, in the more recent case of *Griggs Group Ltd v Evans (2005)*, it was held that while the commissioned freelancer (who created a logo and paid all of its expenses) was the author and the first initial owner of legal title, there was a prior implied agreement that copyright was to belong to Griggs; it was deemed necessary to give business efficacy to the arrangement. It was clearly contemplated that Griggs would be able to use the logo and prevent others from using it.

Persons commissioned to produce copyright works are not usually regarded as employees and therefore not subject to s. 11(2) (subject to any express/implied agreement, as we saw above in *Griggs Group Ltd*), so the position as to ownership of copyright must thus be made clear via contract. Where an employer surrenders copyright, whether for instance by accident, the agreement does not have to be in any particular form. A court can deduce the situation through general employment law principles and all circumstances surrounding the case. This can also work the other way around. Under such certain limited circumstances courts will infer that an independent contractor (e.g. a trustee/liquidator) is subject to an implied obligation to assign copyright to a commissioner (e.g. a beneficiary). This in turn creates copyright being held on constructive equitable trust (*AG v Guardian Newspapers (1988)* – ex-MI5 officer holding copyright on trust for the Crown, the ‘Spycatcher case’). On the other hand, all formal

grants of copyright by assignments (transfer of legal rights of ownership), or indeed a grant by an exclusive licence, will only take effect if signed in writing by or on behalf of the assignor (s. 91(1), s. 90 (3)).

As a final point, the impact of such decisions as we have seen is to undermine a clear consistent scheme reflected by Parliament in its statutes, which is designed both to achieve certainty in transactions and to protect authors and owners of relevant copyright. Over-riding the statutory requirements is an instance of the readiness of courts to qualify formalities in the interests of justice. However, it is to be argued that such an implication is only made when strictly necessary; for example in relation to the commissioning of work, as and when the commissioner can prove evidentially that s/he needed to exclude the author from using the work. It is apparent though, on the basis of the case-law, that terms can be implied relatively easily merely by taking circumstances into consideration, hence rebutting the 'employer's copyright' presumption in s. 11 (2). For example, if an employed teacher writes a textbook for his subject, he may be entitled to the copyright, not because he is employed to write textbooks, but because he is employed to teach. Yet if the writing of the book is within his/her 'course of employment', s/he may be able to show that his/her employer hasn't claimed copyright from them to date, nor has done so from other teachers who've written similar textbooks. Therefore, an agreement that any copyright is to belong to the teacher may be implied in fact via conduct.