

THE COMPATIBILITY OF THE SKILL AND LABOUR ORIGINALITY STANDARD WITH THE BERNE
CONVENTION AND THE TRIPS AGREEMENT

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This article argues that the definition of the key notion of originality, as expressed in the famous UK case of *University of London Press v University Tutorial Press, Ltd* of 1916 [1] and based on the skill and labour of the author, is incompatible with the Berne Convention and possibly also with the TRIPs Agreement. [2]

Why It Matters

The debate over compilations of data and particularly collections consisting of the names and numbers of telephone subscribers sheds light over the notion of originality and the exact meaning of the "skill and labour" test which originated in UK copyright law in the early twentieth century, with cases such as *Walter v Lane* [3] and of course the just-mentioned case of *University of London Press*. [4]

The question of the protection of such "collections" has taken new significance since the entry into the sphere of copyright works of an incalculable number of factual (or utilitarian) compilations, whether of key words [5] or other raw data (e.g. names of telephone subscribers [6]). The escalation of the phenomenon, driven by the remarkable growth in electronic databases over the past two decades (particularly those accessible via the internet), has been spectacular. Although protection of anthologies and other "subjective" compilations has rarely caused a problem, [7] the situation is quite different for data compilations.

Part of the problem comes from the hesitancy shown in a number of court decisions to protect factual compilations and directories under copyright law. In the United States, the situation was definitively settled by the Supreme Court in the famous *Feist* case of 1991. [8] Even though *Feist* was decided in part on points of American constitutional law not directly applicable to other countries, the insistence on the need to base copyright on the creativity of the author seems an analysis exportable to other countries. [9] In France and Canada, there have been a number of contradictory decisions on this point. [10] It is notable, nevertheless, that a decision of the Court of Appeal of Paris stated: "Directories that consist of a collection of materials supplied by the public domain are in no way, due to this fact, liable to be exclusive property equivalent to literary property." [11]

From the point of view of an analysis of the policy objectives of copyright law, the protection of factual compilations forces us to answer the following fundamental question: is copyright an instrument for stimulating creativity or a banal Lockean protection against the illicit appropriation of the work done and the investment made?

In common law countries (with the important exception of the United States), the definition of the notion of originality is based on the decision in the *University of London Press* case. [12] It is suggested that this decision should be revisited because it bases protection of copyright on a vague right against misappropriation. [13]

It is easier to understand the University of London Press rationale when the decision is analysed through the lens of equity. It has been argued in that context that the (common law) tort of misappropriation was in its infancy at the beginning of the twentieth century and, consequently, courts were seeking other means to protect the expenditure of "labour", even if this labour was devoid of any creativity. In *University of London Press*, copyright was thus defined as a right to protect investment (in time and money), nothing more. But this may have devalued copyright and its history. Indeed, even without leaving the British Isles, the text of the Statute of Anne clearly shows that the intent in 1710 was not solely utilitarian, but solidly anchored in the author's creativity: "encouragement of learned men to compose and write useful books ... ". [14]

The definition of originality contained in *University of London Press* is questionable for other reasons. The word "original" is interpreted in the sense of "origin": simply put, an author must be the originator of a work. Therefore, Justice Petersen reasoned, this work must not be copied (for in this case its "origin" is not the "author"), and the author who has produced "something" must be able to demonstrate (very logically, of course) that she made an effort. Such an interpretation of the term "original" is far from its common meaning. It is also worth noting that the British Act, as amended in 1911, in fact speaks of "original literary work," the word "original" having been added [15] to the definition of the term "work". This definition also forms part of the Canadian Copyright Act. [16]

Most dictionaries give three definitions for the word "original" [17]: it is used to identify a text that has been translated; to designate something eccentric (generally a person); and, of course, to designate a thing about which one would say that it has been produced by a given author (the Oxford Dictionary gives the example of fashion design). It is this last definition that Justice Petersen used. [18] This is not the meaning that should be applied in copyright. All the discussions and negotiations concerning the Berne Convention (which was ratified by the British Government) clearly show that originality is closely tied to the act of intellectual creation. [19] In French, the term "original" is easier to define. Both the Robert and the Larousse dictionaries, for example, give two definitions (with variants): original in the sense of an archetype that will be copied or translated, and original in the sense of "personal creation," going as far as eccentricity. But the undisputable evidence comes from the international norm enshrined in Berne.

Before beginning the analysis of the Berne Convention, one should underscore that in respect of collections the UK Copyright Act has been amended in the process of implementing the EU Database Directive [20] and now protects collections that are the author's "own intellectual creation". [21] The use of those words, in light of the comments above and the analysis below, seems to rule out any further use of the skill and labour originality test in this area. The analysis presented below, which deals mainly with the protection of compilations, is thus of little assistance in interpreting the amended British Act, but it is directly relevant in interpreting the originality standard applicable in all Commonwealth countries where the *University of London Press* test still applies to this category of works.

The Berne Convention

Is the Berne Convention really very poorly written, or did its drafters assume that the (informed) reader would be able to tell the difference between the different meanings of the word "original"? At the outset, in Art.2(3), the Convention provides the following: "Translations, adaptations, arrangements of music and other alterations of a literary or artistic work shall be protected as original works without prejudice to the copyright in the original work." [22]

Then in Art.8, the Convention states that "Authors of literary and artistic works protected by this Convention shall enjoy the exclusive right of making and of authorizing the translation of their works throughout the term of

protection of their rights in the original works". Similar provisions are contained in Arts 11(2), 11ter(2), and 14(2).

And Art. 14bis(1) states:

"Without prejudice to the copyright in any work which may have been adapted or reproduced, a cinematographic work shall be protected as an original work. The owner of copyright in a cinematographic work shall enjoy the same rights as the author of an original work, including the rights referred to in the preceding Article."

Then, in Art. 14ter(1):

"The author, or after his death the persons or institutions authorized by national legislation, shall, with respect to original works of art and original manuscripts of writers and composers, enjoy the inalienable right to an interest in any sale of the work subsequent to the first transfer by the author of the work."

Finally, in Art. IV(3) of the Appendix one can read that "in the case of a translation, the original title of the work shall appear in any case on all the said copies". [23]

Stunningly, therefore, the Convention uses the term "original" in each of the three senses mentioned above: to designate the work that the author has created in Art. 14ter(1); to designate a work that will be reproduced or adapted in Arts 2(3), 8, 11(2), 11ter(2), 14(2), and 16 (in the French version) and Art. IV of the Appendix; and finally, in Art. 14bis(1), to designate the intellectual creation (original) protected by the Convention.

Clearly, Art. 14bis(1) is the one that sheds the most light on the meaning that the term "original" should have for the purpose of determining the ambit of protection. It also gives a sense of the significance of the historical-conceptual approach used in this article. The question arose at the Berlin Revision Conference in 1908 of whether cinematographic productions (a new technology at the time) were works protected by the Convention. It wasn't until the Rome Conference in 1928 that cinematographic works were added to the list of categories in Art. 2. But as a temporary solution, a text that can be considered the predecessor of Art. 14bis was added to the Convention. This Article of the Berlin Act of the Convention read as follows:

"Cinematographic productions shall be protected as literary or artistic works if, by the arrangement of the acting form of the combination of the incidents represented, the author has given the work a personal and original character." [24]

The meaning given to the term "original" in this context is unambiguous. That said, its use combined with the word "personal" can be problematic. This is why, at the Rome Conference 20 years later (1928), Art. 14(2) was rewritten and greatly simplified: "Cinematographic productions shall be protected as literary or artistic works if the author has given the work an original character". [25] As far as the Berne Convention is concerned, originality is thus inextricably linked to creativity.

If the reader has any lingering doubts about the meaning of the term "original" in the context of the Convention, the General Report of the Rome Conference contains the following note:

"A film which reproduces street scenes without any staging does not deserve any protection other than that which is afforded by the law to photographs. The protection enjoyed by other works of art should be reserved for cinematographic works which meet the requirement of originality.... In order to show clearly that the only requirement concerned is that of the originality with which every work of the mind must be endowed, we propose deleting the words 'personal and ...'." [26]

This paragraph was struck at the Brussels Conference of 1948, since, as Rapporteur Marcel Plaisant noted: "The time has come, in view of the progress made by the film industry, to deal with all cinematographic productions ... on an equal footing." [27]

A parallel, but clearly slower, evolution marked the protection of photographic works under the Convention. [28] Nevertheless, the Convention still limits the duration of protection of these "inferior" works to 25 years from their production, [29] a provision that the states that ratified the 1996 WIPO copyright treaties have committed themselves not to use any more. [30]

Analysis

As a point of departure of our critical analysis, let us examine why there was hesitancy concerning the notion of originality as applied to cinematographic works. This hesitancy is indeed very instructive, and we can draw lessons from it that are applicable to databases and other factual compilations. The debates over adoption of Art.14 at the 1908 Berlin Revision Conference and then over its modification in Rome show clearly that in the writers' minds there were two types of films: those showing evidence of staging (and with a dramatic character, one might add) and those that simply showed what went on in front of the camera without any other staging. [31] The source of originality thus has to do with the choices that give the production an element that goes beyond simply recording reality. We can think here of an open microphone that captures ambient sounds compared to a musical composition: would we say that an individual who knows which filter or film (or other technique) to use to film in shadow is the author of what an immobile camera records? Or that someone who sets out a microphone to capture birdsong or underwater sounds is the author of a musical work? And yet that is exactly what University of London Press teaches: a person simply has to have made an effort without copying. It is this effort, or the money spent that copyright protects.

This is just as difficult to reconcile with the Berne notion of originality as the Australian ruling in the Telstra case, [32] which protected the work necessary to produce a compilation of data concerning telephone subscribers but recognised in the same breath that if someone redid the same work (and if this was exhaustive it would arrive at exactly the same result), there would be copyright infringement. How can it be claimed in this context that original expression is protected? Yet it is precisely to the protection of expressions that the signatory states to the TRIPs Agreement committed themselves: "Copyright protection shall extend to expressions and not to ideas, procedures, methods of operation or mathematical concepts as such." In Telstra, clearly it is not the expression but the "sweat of the brow" that is protected. What if there is no creativity in selecting or arranging factual data? Is there some other basis for holding that the compilation is copyright? In England a series of cases decided before the Copyright Act 1911 held that, to establish originality in a compilation of facts or other existing material, it is not necessary to show any intellectual effort in the creation of the work. It could be enough to establish that there has been sufficient work involved and expense incurred in gathering the facts or other data. According to these cases copyright protection will be given as a reward for the author's investment of time and money, even if there is no creativity in the work.

A ruling from England that is just as difficult to reconcile with Berne is *Blacklock & Co Ltd v C Arthur Pearson Ltd*. [33] To run a contest, a newspaper had reproduced (but adding its own data) some pages from an index of train stations and train schedules known as "The Bradshaw's Guide". There was no competition between the two, but the judge reached the conclusion that there was copyright infringement in the list of stations and departure and arrival schedules, since "without any exertion of their own getting the benefit of the labour and expense expended in compiling the list which formed the index to Bradshaw". [34]

The British courts' notion of originality is thus, from this point of view, essentially a measure designed to make up for the absence of a sufficiently strong law on unfair competition.

If the Court of Chancery that heard *University of London Press* [35] had been able to use the weapon of the tort of misappropriation, as the US Supreme Court did in the (controversial) decision in *International News Service v Associated Press*, [36] it would not have been necessary to use copyright to fill the "gaps in equity". In *International News Service*, the US Supreme Court protected the news of the day beyond copyright by applying the offence of misappropriation to establish three criteria: (1) that the plaintiff had invested time and money to develop a property; (2) that a defendant has appropriated this property (even if intangible) at little or no cost; (3) that the plaintiff had suffered prejudice.

There is therefore at least an indirect link between the state of the law concerning misappropriation (i.e. the relevant aspects of tort law and the corresponding quasi-contract in civil law systems) and the definition of the notion of originality. [37] When courts are seeking a way to protect effort and investment, copyright is the legal vehicle that seems the closest-- copyright as a neighbouring law to misappropriation, so to speak.

This seems a historic error. It would be better to develop the tort of misappropriation than to fiddle with originality. Copyright is and must remain a legal system that encourages and protects the result of intellectual creativity. Conceptually, the protection should be sufficient to attain this objective and to show respect for authors. A balance must be struck between proprietary rights [38] and moral rights: on the one hand, an economic incentive to optimise distribution of the work and, consequently, revenues generated by its exploitation; on the other hand, a mechanism enabling authors to protect their status as authors and the integrity of their work. That is the true foundation of copyright.

In the national legal systems of Commonwealth members, the notion of "skill" could also be reinterpreted as referring to creative skill, as suggested it seems by Prof. Sterling: "The word 'skill' has an extensive import, and covers creative endeavour. So a United Kingdom judgement should have no difficulty applying the test of skill as requiring intellectual creation." [39] This would arguably bring those legal systems in line with the Berne Convention. Is such a change necessary to comply also with TRIPs?

The TRIPs Agreement

The question of compatibility with the WTO TRIPs Agreement [40] is crucial, inter alia, because a violation of TRIPs may lead to a request for consultations and the establishment of a dispute-settlement panel, whose decision is binding and may be enforced by the application of tariff-based or other trade sanctions. [41]

Against this backdrop, it is necessary therefore to ask whether the skill and labour test of originality, which seems to be incompatible with the Berne Convention, is compatible with TRIPs. The substantive norms of the Convention were incorporated by reference into TRIPs, by its Art.9.1, which obligates WTO member countries to "comply with Articles 1 through 21 of the Berne Convention (1971) and the Appendix thereto". Does this involve the history and agreed interpretation of the Convention?

One might argue that the history of the Berne Convention is interesting but not very relevant for two reasons: first, it does not have international force of law, and secondly, the truly enforceable international standard today is the TRIPs Agreement. This is incorrect, however. First, Art.32 of the Vienna Convention on the Law of Treaties allows preparatory work of an international instrument to be considered. This is relevant in the context of the TRIPs Agreement because the dispute-settlement body ruled twice that Arts 31 and 32 of the Agreement apply to conventions concluded under the aegis of the WTO. [42] At first glance, this seems to involve the travaux préparatoires for the TRIPs Agreement [43] and not of the Berne Convention. Put differently, can one use the preparatory work for revisions to the Berne Convention to interpret the norms from the Convention that have been incorporated into the TRIPs Agreement? [44] The answer is unequivocally yes.

In the case concerning Art.110(5) of the US Copyright Act, [45] the WTO panel declared:

"There is no indication in the wording of the TRIPs Agreement that Articles 11 and 11bis have been incorporated into the TRIPs Agreement by its Article 9.1 without bringing with them the possibility of providing minor exceptions to the respective exclusive rights. If that incorporation should have covered only the text of Articles 1-21 of the Berne Convention (1971), but not the entire Berne acquis relating to these articles, Article 9.1 of the TRIPs Agreement would have explicitly so provided."

Thus we can conclude that, in the absence of any express exclusion in Art.9.1 of the TRIPs Agreement, the

incorporation of Arts 11 and 11bis of the Berne Convention (1971) into the Agreement includes the entire acquis of these provisions, including the possibility of providing minor exceptions to the respective exclusive rights. [46]

The panel also declared that a statement contained in the General Report could constitute an "agreement" as defined in Art.31(2)(a) of the Vienna Convention. [47]

One can thus refer to the Berne travaux préparatoires to interpret the meaning of the word "original" in the Berne Convention as incorporated into TRIPs. This analysis leads of necessity to the conclusion that "originality", as the term is used in the Convention, and which applies not only to the states that are signatories to the Convention but also to the members of the WTO, is closely linked to the author's creativity.

But when considering whether adopting a skill and labour test to determine the presence of originality is a violation of TRIPs, the analysis is more complex. There are three basic avenues to explore. One could argue, first, that originality is at the very core of copyright law and that there is only one proper notion of originality in the Berne Convention, which now forms parts of TRIPs through the incorporation of the entire normative content of the Convention, including its drafting history. One would thus have to "comply" with such convention under Art.9(1). Thus adopting a different standard would violate both the Convention and the Agreement.

A second train of thought is to view the skill and labour test as a lower or different threshold to benefit from copyright protection, the application of which results in the entry into the field of copyright protection of a vast number of utilitarian productions including in particular factual compilations. It could thus be argued in that context that adopting the skill and labour test is a higher (or different) level of protection than that required by TRIPs and thus authorised under Art. 1.1, which specifically states that WTO Members "may, but shall not be obliged to, implement in their law more extensive protection than is required by this Agreement".

Alternatively, a Member could argue that it has chosen to protect under copyright productions and compilations which are not "works" under the Berne Convention. A sui generis right inside copyright, as it were. A WTO panel might be tempted to adopt this approach.

There is a third option to consider, however, especially from a policy standpoint.

It is perhaps too simplistic to see skill and labour as a higher level of protection. Copyright policy is like a hydraulic system. [48] Protecting factual compilations under copyright means that users of protected material may legitimately fear that access to factual information and reuse of those facts may be "locked up". Logically, this may prompt demands for new or broader exceptions from protection or other ways to restore the "balance" in respect of compilations but also other categories of works. [49] Similar arguments have been made, for example, about term extension or the protection of technological protection measures and digital rights management systems in the United States. [50] In the same vein, problems associated by certain WTO members to intellectual protection considered as excessive in the pharmaceutical and biotechnological patent areas are now on the agenda of the Doha Round. [51]

From both the Berne Convention and proper copyright policy, the proper originality standard must be based on the author's creativity, that is, the making by the author of creative choices not dictated by the function of the work, the tools used, applicable standards or similar external constraints. A discrepancy between the Convention and the TRIPs Agreement is undesirable, though not necessarily in contravention of TRIPs.

Conclusion

This article has shown, first, that the traditional test to determine the originality of a copyright work in British

copyright jurisprudence based on the skill and labour of the author may be the result of the unavailability of a remedy in tort for misappropriation of another's efforts. It has then shown that the text and drafting history of the Berne Convention unequivocally demonstrate that the proper test of originality is that the work must embody an author's creative input. A work, says the Convention, is only a work if it is an intellectual creation. In this light, the skill and labour test seems incompatible with the Convention.

The article then analysed whether this means that the skill and labour test is also incompatible with the TRIPs Agreement, which incorporated most of the norms contained in the Berne Convention. There, three possibilities emerged. One could legitimately consider that originality is a core copyright norm and as such forms part of TRIPs and that, because the proper norm is based on the author's creativity, using any other standard is a violation of TRIPs obligation to "comply" with Berne. One could also consider that applying a lower or different threshold of originality is a higher level of protection and thus authorised under Art. 1.1 of TRIPs. While this is the route a WTO panel would likely follow, there are valid policy arguments to doubt the validity of the simplistic reasoning that underpins this second option. If a definition of originality based on creativity is indeed an embedded TRIPs obligation, then the "higher" or different level of protection under copyright might in fact contravene TRIPs. On a policy level, it is not clear that a lower originality threshold is indeed a higher level of protection because protecting factual and other utilitarian compilations may lead to demands for broader exemptions and exceptions with respect to other categories of works.

The impact of the finding of incompatibility has little impact in the United Kingdom because its most prominent application is in the area of compilations and databases, where the United Kingdom apparently modified its traditional test and adopted a creativity standard. [52] But in other Commonwealth countries, where the traditional UK test is still applied, [53] it may be time to rethink the extant standard.

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1. *Univ of London Press Ltd v Univ Tutorial Press, Ltd* [1916] 2 Ch. 601. This is not a decision of the House of Lords, but in *Ladbroke v William Hill*, 291- 292, that venerable body did not do much better: "The courts have looked to see whether the compilation of the unoriginal material called for work or skill or expense. If it did, it is entitled to be considered original and to be protected against those who wish to steal the fruits of the work or skill or expense by copying it without taking the trouble to compile it themselves.... " (emphasis added). It is also the first decision on this point to follow the entry into force of the 1911 Copyright Act in the United Kingdom.

2. Agreement on Trade-related Aspects of Intellectual Property Rights, April 15, 1994, Marrakesh Agreement Establishing the World Trade Organization ("WTO Agreement"), Annex 1C, Legal Instruments--Results of the Uruguay Round vol. 31 (1994) 33 I.L.M. 81 ("TRIPs Agreement"), available at www.wto.org/english/docs_e/legal_e/final_e.htm.

3. [1900] A.C. 539. See also the earlier cases of *Morris v Ashbee* [1868] 7 Eq. 34, and *Kelly v Morris* [1866] 1 Eq. 697.

4. *Univ of London Press Ltd v Univ Tutorial Press, Ltd*, n.1 above.

5. The author is thinking of course, of *Law Society of Upper Canada v CCH Canadian Ltd* [2002] 4 F.C. 213 (CA), permission to appeal granted [2002] C.S.C.R. No. 317.

6. *Télé-Direct (Publications) Inc. v American Business Information, Inc.* (1997) 154 D.L.R. (4th) 328; permission to appeal denied [1997] C.S.C.R. No. 660. See also *Édufile Inc v Automobile Protection Association* [2000] 4 F.C. 195 (CA); leave to appeal denied [2000] SCCA No. 302.

7. See A. Lucas and H.-J. Lucas, *Traité de la propriété littéraire et artistique* (2nd ed., 2001), p.110.

8. *Feist Publications v Rural Telephone Service Company, Inc* 499 U.S. 340 (1991).

9. See Daniel Gervais, "Feist Goes Global: A Comparative Analysis of the Notion of Originality in Copyright Law" (2002) *J. of the Copyright Soc'y of the USA* 949.

10. For Canada, see nn.5 and 6 above. For France, 12 favourable decisions are cited in Lucas and Lucas, n.7 above, but so are 13 unfavourable decisions.

11. April 2, 1986: *Ann. Propr. Ind.* 1989, p.62 (author's translation).

12. n.1 above.

13. For proof, in H. Laddie, P. Prescott, M. Vitoria, A. Speck, and L. Lane, *The Modern Law of Copyright and Designs* (2000), at paras 3.88, 3.90, we find, "Consequently the copyright in such a work may be infringed by appropriating an undue amount of the material" (emphasis added).

14. The preamble of the Statute of Anne (8 Anne c.19 (1710) UK) says: "Whereas printers, booksellers, and other persons have of late frequently taken the liberty of printing, reprinting, and publishing, or causing to be printed, reprinted, and published, books and other writings, without the consent of the authors or proprietors of such books and writings, to their very great detriment, and too often to the ruin of them and their families: for preventing therefore such practices for the future, and for the encouragement of learned men to compose and write useful books." The objective of education is found in the very title of this law: "An Act for the Encouragement of Learning....".

15. As Justice Petersen emphasises elsewhere, this is what enabled him to single out *Walter v Lane*, decided under the old law (n.3 above, at 606). The term was deleted from the Act in 1956, Copyright Act (UK) 1956 (c.74), arts 7- 9.). In an obiter, a British court seems to agree that adding an originality requirement to the statute had the effect of overturning *Walter v Lane*. See *Robertson v Lewis* [1976] R.P.C. 169 at 174, Ch D.

16. Copyright Act, RSC 1985, c.C-42, ss.2 and 5(1).

17. These definitions are based on the Oxford Dictionary (2nd ed., 1989).

18. One simply has to reread the passage most often quoted to see the weakness of the underlying logic: "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, and, in the case of 'literary work,' with the expression of thought in print or writing. The originality which is required relates to the expression of the thought. But the Act does not require that the expression must be in an original or novel form, but that the work must not be copied from another work--that it should originate from the author" (n.1 above, at 608-609).

19. For a historical demonstration with supporting documentation, see Daniel Gervais, *La notion d'oeuvre dans la Convention de Berne et en droit comparé* (1998), pp.45-49 and 55-65, and the next subsection.

20. Directive 96/9 of March 11, 1996 on the Legal Protection of Databases [1996] O.J. L77/20-28.

21. Copyright, Designs And Patents Act 1988, s.3A, as amended by the Copyright (Databases), Regulations, 18/12/1997, s.6. S.3A(2) reads as follows: "For the purposes of this Part a literary work consisting of a database is original if, and only if, by reason of the selection or arrangement of the contents of the database the database constitutes the author's own intellectual creation" (emphasis added).

22. Emphasis added here and in quotations from the Berne Convention in this section.

23. One should also mention Art.16, which states that "Infringing copies of a work shall be liable to seizure in any country of the Union where the work enjoys legal protection". In the French version of the text, which has priority (under Art.37(2)(c)), which, interestingly, is not incorporated by reference into the TRIPs Agreement), the second time the term "work" is used it is preceded by "original".

24. Text taken from 1886-1986, *Berne Convention Centenary* (1986), p.229.

25. *ibid.* at p.270.

26. *ibid.* at p.175.

27. *ibid.* at p.182.

28. See Y. Gendreau, A. Nordemann, and R. Oesch, *Copyright and Photographs* (1999).

29. Art.7(4). The fact that the Convention does not use the word "creation" here may be testimony to the same

prejudice.

30. Art.9.

31. And we must not forget the facts of *Canadian Admiral Corporation v Rediffusion Inc* [1954] Ex.C.R. 382 concerning the broadcasting of football games. This decision no longer seems to apply with regard to the definition of "public" (see *Canadian Cable Television Association v Canada (Copyright Board)* [1993] 2 F.C. 138 at 153), but the definition of the notion of originality still holds (see *Chancellor Management Inc v Oasis Homes Ltd* (2002) 19 C.P.R. (4th) 480 (C.B.R. Alta) and *IBM Corporation v Ordinateurs Spirales Inc* (1984), 80 C.P.R. (2d) 187.

32. *Desktop Marketing Systems Pty Ltd v Telstra Corporation Ltd* [2001] F.C.A. 612; conf. by [2002] F.C.A.F.C. 112 (Aust.). The High Court declined an application to hear the case on June 20, 2003, judging that there was "insufficient prospects of success to warrant a grant of special leave". Case M85/2002.

33. [1915] 2 Ch. 376.

34. *ibid.* at 383.

35. See n.1 above.

36. 248 U.S. 215 (1918). For a discussion, see Gervais, n.9 above, at p.954.

37. In the United Kingdom, see e.g., *Ex parte Island Records Ltd* [1978] Ch. 122, CA: "Accordingly I am satisfied that in equity there is jurisdiction for a court to grant an injunction to a person who claims that he suffered special damage to a property interest of his by a crime and that in the circumstances of this case both the record company and the performer would be entitled to such injunction." Interestingly, the case dealt with a performer's neighbouring rights.

38. In *Théberge v Galeries d'Art du Petit Champlain Inc* [2002] 2 S.C.R. 336, the Supreme Court uses, rather, the expression "economic rights".

39. J.A.L. Sterling, "Creators' Rights and the Bridge Between Authors' Rights and Copyright", in Intergu (ed.), *Schutz von Kultur und geistigen Eigentum in der Informationsgesellschaft*, Nomos Verlag, 1998, at 79.

40. n.2 above.

41. TRIPs Agreement, Art.64. See Daniel Gervais, *The TRIPs Agreement: Drafting History and Analysis* (2nd ed., 2003), pp.334-337.

42. See India--Patent Protection for Pharmaceutical and Agricultural Chemical Products, WTO doc. WT/DS50/AB/R, para.46; and United States--Standards for Reformulated and Conventional Gasoline, WTO doc. WT/DS2/AB/R.
43. See Gervais, *The TRIPS Agreement*, n.40 above.
44. Art.9.1: "Members shall comply with Articles 1 through 21 of the Berne Convention (1971) and the Appendix thereto."
45. WTO document WT/DS160/R of June 15, 2000.
46. *ibid.* at paras 6.62-6.63.
47. *ibid.* at para.6.53.
48. The author believes that this expression was coined by Michigan State University law professor Peter Yu.
49. In that respect, one may think of the decision by the Supreme Court of Canada in *Théberge v Galeries d'Art du Petit Champlain Inc*, n.38 above, in which Mr Justice Binnie, speaking on behalf of the majority, wrote: "The proper balance among these and other public policy objectives lies not only in recognizing the creator's rights but in giving due weight to their limited nature. In crassly economic terms it would be as inefficient to overcompensate artists and authors for the right of reproduction as it would be self-defeating to undercompensate them."
50. On term extension, see, e.g., Caren L. Stanley, "A Dangerous Step Toward the Over Protection of Intellectual Property: Rethinking *Eldred v. Ashcroft*" (2003) 26 *Hamline L. Rev.* 679; Lawrence Lessig, "Copyright's First Amendment" (2001) 48 *UCLA L. Rev.* 1057; and from the same author, "The Law of the Horse: What Cyberlaw Might Teach" (2001) 113 *Harv. L. Rev.* 501; and, contra, Paul M. Schwartz William Michael Treanor "Eldred and *Lochner*: Copyright Term Extension and Intellectual Property as Constitutional Property" (2003) 112 *Yale L.J.* 2331. On DRMs and TPMs, see, e.g., Dan L. Burk and Julie E. Cohen, "Fair Use Infrastructure for Rights Management Systems" (2001) 15 *Harv. J.L. & Tech.* 41.
51. This includes compulsory licensing of patents protecting pharmaceutical products used in the fight against HIV-AIDS. In their Decision of 30 August 2003 on the Implementation of paragraph 6 of the Doha Declaration on the TRIPS Agreement and public health, WTO Document WT/L/540, ministers waived the obligations of an exporting member under Art.31(f) of TRIPs with respect to the grant by it of a compulsory licence to the extent necessary for the purposes of production and export of certain pharmaceutical products to eligible importing members.

52. That is, at least, a fair reading of the "author's own intellectual creation" standard. One could argue of course that an intellectual creation does not need to be creative.

53. See Gervais, "Feist Goes Global", n.9 above, at pp.949-981.

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