

THE BASIS FOR ORIGINALITY IN PHOTOGRAPHS

Although photographs are artistic works, locating originality in this category of works has proved problematic for copyright systems due to the verisimilitude of photographs and the mechanical nature of photography. Divergent approaches have thus been adopted in the US and under UK common law. In 2017, the Ninth Circuit likened photographs to factual compilations, holding that it was the selection and arrangement of the individual elements of a photograph which, if sufficiently original, were protected by copyright. This article examines the different approaches adopted in the UK and US and their respective doctrinal underpinnings, and considers the way ahead for Singapore law.

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I. Introduction

1 Photographs are artistic works which may be protected by copyright. This reflects the legal position in Singapore² and, indeed, most states having a copyright regime, given the inclusion of photographs within the definition of “artistic works” in the Berne Convention for the Protection of Literary and Artistic Works³ (“Berne Convention”). But while their status as subject matter in which copyright may subsist cannot be seriously disputed today, photographs were initially regarded by copyright systems with suspicion,⁴ and the international community was slow to recognise them as artistic works. The 1886 Berne Convention initially went no further than to permit conferring copyright protection upon photographs.⁵ Mandatory protection of photographs only came decades later,⁶ as did recognition of photographs as “literary and

1 The author is grateful to Prof David Tan for his comments on an earlier draft of this article. All errors and omissions remain the author’s own.

2 Copyright Act (Cap 63, 2006 Rev Ed) s 7(1).

3 9 September 1886; revised 24 July 1971; amended 1979, Art 2(1).

4 Justin Hughes, “The Photographer’s Copyright – Photograph as Art, Photograph as Database” (2012) 25 Harv JL & Tech 339 at 341; Burton Ong, “Originality from Copying: Fitting Recreative Works into the Copyright Universe” (2010) 2 IPQ 165 at 166–167.

5 Final Protocol, Berne Convention for the Protection of Literary and Artistic Works (9 September 1886).

6 Berne Convention for the Protection of Literary and Artistic Works (9 September 1886, revised 13 November 1908), Art 7, which provided that “[f]or photographic
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artistic works”⁷. Moreover, even when the Berne Convention finally imposed a minimum term of protection for photographs in 1967, this was considerably shorter than the minimum protection terms applying to other works.⁸ Only with the 1996 World Intellectual Property Organization (“WIPO”) Copyright Treaty⁹ was the protection term for photographs finally aligned with other types of artistic works.¹⁰

2 Even today, however, courts and copyright systems struggle to apply originality principles to photographs. This is chiefly due to the unique features of photographic technology which distinguish photographs from other types of artistic works – namely, the verisimilitude of photographs and the mechanical nature of the technology.¹¹ Because of these features, the quality and degree of a photographer’s involvement in the production of a photograph may vary greatly: photographs range from creatively styled portraits to mechanical reproductions involving little or no choices by the photographer, or even unintentionally captured

works and works obtained by a process analogous to photography ... the term of protection is regulated by the law of the country where protection is claimed ...”. Even then, no minimum term of protection was required. In contrast, “literary and artistic works” (which did not include photographs) had to be protected for at least the “the life of the author and fifty years after his death”.

- 7 Berne Convention for the Protection of Literary and Artistic Works (9 September 1886, revised 26 June 1948) Art 2. Prior to this, photographs were treated distinctly, falling under Art 3 in the 1908 revision which provided that “[t]he present Convention shall apply to photographic works and to works produced by a process analogous to photography. The contracting countries shall be bound to make provision for their protection”.
- 8 Berne Convention for the Protection of Literary and Artistic Works (9 September 1886, revised 14 July 1967) Art 7(4). The minimum term of protection for photographs was only 25 years from the date of making the photograph, as compared to the lifetime-plus-fifty formula in respect of other works provided under Art 7(1).
- 9 S Treaty Doc No 105-17 (20 December 1996; entry into force 6 March 2002).
- 10 World Intellectual Property Organization Copyright Treaty (S Treaty Doc No 105-17) (20 December 1996; entry into force 6 March 2002) Art 9.
- 11 See, eg, Burton Ong, “Originality from Copying: Fitting Recreative Works into the Copyright Universe” (2010) 2 IPQ 165 at 166–167, observing that:

While photographs have now been formally elevated, under most common law based copyright systems at least, to a *bona fide* sub-category of artistic works entitled to the same duration and level of protection as drawings, paintings, sculpture and other works of artistic craftsmanship, residual hang-ups related to the mechanical aspects of the production process have surfaced when courts have applied the originality standard to photographs;

See also *Copinger and Skone James on Copyright* vol 1 (Gillian Davies, Nicholas Caddick & Gwilym Harbottle eds) (Sweet & Maxwell, 17th Ed, 2016) at para 3-235, noting that:

... [p]hotographs, which in one sense will always be a copy of what is before the camera lens, and which may more specifically be a copy of an existing artistic work, create their own problems as regards originality, and the principles discussed above are not easily applied to them.

shots, and a photographer's input in producing each of these accordingly differs. Nevertheless – and despite the wide spectrum – it has been persuasively argued that all photographs, which are inevitably copies of the subject matter before the camera, may from one perspective be viewed as databases.¹² Understanding photographs as fact-based works can provide us with a useful tool to locate photographic originality, and therefore identify when a photograph may receive no protection at all, or, for photographs which are protected, where such originality lies.¹³

3 The applicable principles for determining when (or which elements of) a photograph is protected by copyright law in Singapore remain to be expounded by the local courts. Looking to US and UK common law,¹⁴ divergent approaches have been adopted with regard to locating photographic originality. In the US, the Court of Appeal of the Ninth Circuit in *Jacobus Rentmeester v Nike Inc*¹⁵ (“*Rentmeester*”) accepted academic argument likening photographs to factual compilations, holding that it was not the individual elements of a photograph, but the selection and arrangement of those elements – if sufficiently original – that were protected by copyright. In contrast, although the issue has yet to be fully worked out by the UK courts, traditional UK common law appears to adopt a broader scope of originality. This article attempts to demonstrate that the variance in approaches is attributable mainly to the different underlying justifications of copyright protection in the US and UK. While US courts view copyright as an incentive to add to the pool of creative works available for the benefit of society – manifested in the creativity doctrine of originality¹⁶ – UK courts applying the traditional common law have tended to view copyright as a reward for investment

12 See Justin Hughes, “The Photographer’s Copyright – Photograph as Art, Photograph as Database” (2012) 25 Harv JL & Tech 339, referred to in *Jacobus Rentmeester v Nike Inc* 883 F 3d 1111 (9th Cir, 2018). It is acknowledged that the possibility of digital manipulations of photographs – which are commonplace today – may result in a “photograph” bearing little or even no resemblance to the original scene. The question of whether, or to what extent, such manipulated images remain “photographs” remains, however, outside the scope of this article, which deals with a more conventional understanding of photography. See the *obiter* remarks of Colin Birss J in *Temple Island Collections Ltd v New English Teas Ltd* [2012] EWPC 1 at [28]–[29].

13 The latter is especially significant for providing the basis for determining when copyright in a given photograph can be said to be infringed, although consideration of this important issue remains outside the scope of this work.

14 References in this article to UK common law are, for the avoidance of doubt, references to the traditional position in the UK prior to the influence of European Union directives and the jurisprudence of the Court of Justice of the European Union, which may have altered the test for originality. See para 20 below.

15 883 F 3d 1111 (9th Cir, 2018).

16 *Feist Publications Inc v Rural Telephone Service Co Inc* 499 US 340 at 349–350 (1991).

and protection against unfair competition,¹⁷ pursuant to an originality doctrine which conferred copyright protection even on works produced merely by the sweat of one's brow.¹⁸ Additionally, UK courts have also indicated a willingness to stretch the concept of originality in the context of photographs beyond sweat-based justifications.

4 The different approaches have resulted in correspondingly different scopes of protection. This article explores the legal positions in these two jurisdictions, and attempts to convince the reader that once accepted that photographs are fact-based works, the approach in *Rentmeester* should be followed by local courts. Part II¹⁹ explains that the verisimilitude of photographs and the mechanical nature of photography, which enable divorcing the production of a photograph from the input of the photographer, have resulted in the law struggling to locate photographic originality. Further, it describes the argument, drawing on the acceptance of photographs as evidence due to their verisimilitude, that photographs have a fact-bearing capacity and may – besides constituting art – be understood as databases. Part III²⁰ discusses the general requirement of originality under US and UK common law, explaining the different doctrinal underpinnings of copyright in both jurisdictions. It also touches briefly on the application of originality principles in the context of factual compilations – a category of works relevant to photographs due to their similarities as fact-based works. Part IV²¹ then delves into the jurisprudence in the US and UK on photographic originality and explores how different approaches have been adopted in the two jurisdictions, stemming largely from the divergent justifications for copyright protection. Moreover, given the underdeveloped state of the law on the subject in the UK, this part also engages with some challenging issues posed by the wide scope of photographic originality suggested by UK courts, which tends to stretch the concept of originality. Part V²² then considers the implications of the differing originality doctrines on the protection of a particular category of photographs – photographic replicas of existing works – by looking at

17 See, eg, *Walter v Lane* [1900] AC 539 at 545, per Lord Halsbury, and 552, per Lord Davey; see also *Copinger and Skone James on Copyright* vol 1 (Gillian Davies, Nicholas Caddick & Gwilym Harbottle eds) (Sweet & Maxwell, 17th Ed, 2016) at para 3-204, fn 863, where the authors note that the “sweat of the brow” or “industriousness” standard of originality is “premised on a natural rights or Lockean theory of ‘just deserts’, namely that an author deserves to have his or her efforts in producing a work rewarded”.

18 *Copinger and Skone James on Copyright* vol 1 (Gillian Davies, Nicholas Caddick & Gwilym Harbottle eds) (Sweet & Maxwell, 17th Ed, 2016) at para 3-217.

19 See paras 5–10 below.

20 See paras 11–22 below.

21 See paras 23–48 below.

22 See paras 49–68 below.

the relevant principles concerning originality in derivative works in both jurisdictions. Finally, Part VI²³ turns to the local context and explains that the creativity doctrine espoused in *Rentmeester* should be preferred by the Singapore courts when considering the issue of photographic originality.

II. Peculiarities of photography and tension with originality

A. *Verisimilitude of photographs and mechanical nature of photography*

5 The difficulties associated with locating originality in photographs stem from the unique nature of the technology, which distinguishes photographs from other types of artistic works. Because the photographic process involves the production of an image through the recording of light (or other radiation) on a certain medium,²⁴ photographs are essentially copies of the subject matter before the camera.²⁵ This verisimilitude of photographs was perhaps regarded as its greatest merit during the early days of the technology when, for the first time, it was possible to record objective and accurate portrayals of the world.²⁶ Indeed, as Christine Haight Farley observes, judicial cognisance was quickly taken in the US of the camera's ability to "produce a direct transcription of the scene before it":²⁷

23 See paras 69–84 below.

24 See, eg, *Singsung Pte Ltd v LG 26 Electronics Pte Ltd* [2016] 4 SLR 86 at [106], where the Singapore Court of Appeal described photography as "involv[ing] the capturing or recording of light on a particular medium (namely, film, paper, etc)". The court also referred to the definition of "photograph" in s 4(2) of the UK Copyright, Designs and Patents Act 1988 (c 48), which defines it as "a recording of light or other radiation on any medium on which an image is produced or from which an image may by any means be produced".

25 Kevin Garnett QC, "Copyright in Photographs" (2000) 22(5) EIPR 229 at 229, noting that in relation to UK common law, that "[o]ne question which has remained largely unexplored by case law ... is how the originality requirement of UK copyright law is to be interpreted in the case of photographs, given that every photograph is more or less a copy of something else". See also Burton Ong, "Originality from Copying: Fitting Recreative Works into the Copyright Universe" (2010) 2 IPQ 165 at 166: "Photographs are, in essence, copies of the image of the subject matter that has been captured by the cameraman."

26 See Christine Haight Farley, "The Lingering Effects of Copyright's Response to the Invention of Photography" (2004) 65 U Pitt L Rev 385 at 395–400, where Farley observes that photographs were variously described as "impressed by nature's hand" and "sun pictures". See also Justin Hughes, "The Photographer's Copyright – Photograph as Art, Photograph as Database" (2012) 25 Harv JL & Tech 339 at 345, where Hughes, citing Susan Sontag, describes photographs as "miniatures of reality".

27 Christine Haight Farley, "The Lingering Effects of Copyright's Response to the Invention of Photography" (2004) 65 U Pitt L Rev 385 at 389; see also *Udderzook v The Commonwealth* 76 Pa 340 at 353 (1874):

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The perceived objectivity of the camera made it particularly well-suited for evidence in legal disputes and the first mentions of photography in court opinions are references to pieces of evidence. Even though the evidentiary doctrine eventually stabilised and treated photographs as visual aids of testifying witnesses, initially there was a tendency to allow the photograph to speak for itself, as photographs were seen as inscrutable conveyers of truth.

6 A second characteristic of photographs that distinguished it from other artistic works was the mechanical nature of the technology. There was an initial tendency to stress the objectivity of photography by emphasising the role of the machine and denying the role of the human operator.²⁸ Indeed:²⁹

... the initial, perhaps dominant view was that the photographer was not a creator, but the operator of a machine: it was the machine's interaction with nature that was the source of the final photographic image.

[Photography] has become a customary and a common mode of taking and preserving views as well as the likenesses of persons, and has obtained universal assent to the correctness of its delineations. We know that its principles are derived from science; that the images on the plate, made by the rays of light through the camera, are dependent on the same general laws which produce the images of outward forms upon the retina through the lenses of the eye. The process has become one in general use, so common that we cannot refuse to take judicial cognisance of it as a proper means of producing correct likenesses

...

and Justin Hughes, "The Photographer's Copyright – Photograph as Art, Photograph as Database" (2012) 25 Harv JL & Tech 339 at 345 where Hughes similarly notes that:

As 'miniatures of reality,' photographs were embraced by the law as a revolutionary form of legal evidence. Indeed, judges were struggling with the admissibility of photographs as a form of legal evidence well before judges were sorting out the copyrightability of photographs. Photographs may have come before the Supreme Court as early as 1857 and, in an 1859 case, the Justices said, in effect, that the photographs submitted allowed them to determine the facts as effectively as the trial court judge.

28 See Christine Haight Farley, "The Lingering Effects of Copyright's Response to the Invention of Photography" (2004) 65 U Pitt L Rev 385 at 395–396, observing that when photographs were first invented in the 19th century:

... the photograph was not seen as the product of an author, but rather the product of a machine. The photograph was seen as having the ability to re-present nature; to produce an unmediated copy of the real world. The medium itself was transparent.

And at 399–400:

Whereas artists 'made' art, photographs, to be valuable as a record or evidence, needed to be produced by machine rather than man. The utter denial of the human agency is clear in the language used to describe this phenomenon: photographs were said to be 'impressed by nature's hand,' or they were called 'sun pictures.' Photographs were 'obtained' rather than made and the process was seen as being purely mechanical.

29 Justin Hughes, "The Photographer's Copyright – Photograph as Art, Photograph as Database" (2012) 25 Harv JL & Tech 339 at 343.

As Burton Ong observes, as recently as the late 1970s, “many English copyright lawyers regarded photography as an industrial process rather than an artistic one”.³⁰

7 But although the photographer’s role may no longer be understated today, the verisimilitude and mechanical nature of photography continues to pose difficulties when considering the originality of this category of works.³¹ While the photographic process can be simultaneously mechanical and creative, “the balance between these two elements may vary enormously in any given case, yet the product is in each case a photograph”.³² Consider two broad categories of photographs in which a photographer’s input may vary: In the first category, a photographer may *stage the tableau* (that is, physically arrange the subject matter, such as of a portrait) before taking a photograph. In directing the scene, the photographer exerts his influence on the resulting image, for the scene does not exist independently but is created by the photographer for the purposes of the photograph.³³ In the second category, the photographer sets out to take a photograph depicting an *independent reality* (such as a panoramic vista or street scene). Here, although the photographer does not create or direct the scene, he nevertheless plays an important role in the production of a photograph when he makes choices as to, *inter alia*, the frame of the shot, aperture, shutter speed and other camera-related settings.³⁴ Yet, even *within* these broad categories, the degree of a photographer’s involvement may vary – for example, a technically perfect photographic replica of an existing painting may require no exercise of creativity by the photographer, but only technical skill and labour to produce. A photograph may even be the result of little to no intellectual (or even laborious) input by a photographer, such as in the production of photocopies, straightforward representations of scenes or

30 Burton Ong, “Originality from Copying: Fitting Recreative Works into the Copyright Universe” (2010) 2 IPQ 165 at 166.

31 See Burton Ong, “Originality from Copying: Fitting Recreative Works into the Copyright Universe” (2010) 2 IPQ 165 at 166–167, observing that:

While photographs have now been formally elevated, under most common law based copyright systems at least, to a *bona fide* sub-category of artistic works entitled to the same duration and level of protection as drawings, paintings, sculpture and other works of artistic craftsmanship, residual hang-ups related to the mechanical aspects of the production process have surfaced when courts have applied the originality standard to photographs.

32 *Copinger and Skone James on Copyright* vol 1 (Gillian Davies, Nicholas Caddick & Gwilym Harbottle eds) (Sweet & Maxwell, 17th Ed, 2016) at para 3-259.

33 See Justin Hughes, “The Photographer’s Copyright – Photograph as Art, Photograph as Database” (2012) 25 Harv JL & Tech 339 at 361.

34 See Justin Hughes, “The Photographer’s Copyright – Photograph as Art, Photograph as Database” (2012) 25 Harv JL & Tech 339 at 363. Such choices or actions may also be undertaken by a photographer taking a photograph of a staged tableau.

objects devoid of any meaningful choices, or even accidentally captured photographs.

8 The range of a photographer's involvement in the production of a photograph is thus wide. As Jane C Ginsburg comments, "the greater the machine's role in the work's production, the more the 'author' must show how her role determined the work's form and content".³⁵ Because it is possible to divorce the production of a photograph from any intellectual input or even significant labour of the photographer, photographs have "an inherent 'non-original' potential due to the nature of the photographic process",³⁶ distinguishing them from other types of artistic works, such as paintings.

B. Photographs as fact-based works

9 Besides enabling them to serve as evidentiary tools, the truthfulness of photographs illuminates our search for the basis of photographic originality. In his insightful article, Justin Hughes points out that "[a]nother way to understand this acceptance of photographs and film as evidence is to understand the photograph or film as a database".³⁷ For photographs depicting independent realities, this fact-capturing nature is not difficult to understand. Crime scene photographs, the works of photojournalists and the remarkable scenes in nature captured by National Geographic photographers may or may not be regarded as art, but each constitutes a documentary record of a scene or place at some point in time. The fact-bearing capacity of photographs may also be observed in their treatment under data protection and privacy laws – as Hughes observes, "privacy disputes involving the publication of photographs ... are built on the express premise that the photograph conveys information".³⁸ Indeed, UK courts have recognised photographs as constituting "information",³⁹ and the Singapore High Court has

35 Jane C Ginsburg, "The Concept of Authorship in Comparative Copyright Law" (2003) 52 DePaul L Rev 1063 at 1074.

36 Christina Michalos, *The Law of Photography and Digital Images* (Sweet & Maxwell, 2004) at paras 2-002-2-006.

37 Justin Hughes, "The Photographer's Copyright – Photograph as Art, Photograph as Database" (2012) 25 Harv JL & Tech 339 at 348.

38 Justin Hughes, "The Photographer's Copyright – Photograph as Art, Photograph as Database" (2012) 25 Harv JL & Tech 339 at 349.

39 *Campbell v Mirror Group Newspapers Ltd* [2004] 2 AC 457 at 477, where Lord Hoffmann observed that "a photograph is in principle information no different from any other information"; *OBG Ltd v Allan* [2008] 1 AC 1 at 93 where the court held that photographic images of a wedding could constitute confidential information. See also *Von Hannover v Germany* no 59320/00 § 59, ECHR 2005 where the European Court of Human Rights observed that photographs could contain "personal or even intimate information about an individual".

similarly accepted photographs as information protected under the law of confidence.⁴⁰ Additionally, the Personal Data Protection Commission in Singapore recognises that photographs may clearly capture personal data, bringing them within the ambit of the Personal Data Protection Act 2012.⁴¹

10 Leaving aside photographs depicting independent realities, however, “even a portrait photograph is a compilation of facts”,⁴² because the image on every photograph derives from the subject matter before the camera lens. Therefore, in order to produce a photograph of a staged tableau, the tableau must at some point in time actually exist, and in capturing a “slice of [that] reality”, the photograph becomes a “direct, mechanical representation of some set of real-world facts”.⁴³ In this manner, one may commonly experience that a photograph portraying a person’s countenance or staged scene is valuable, not merely for its artistic pretensions, but for its verisimilitude to a specific individual or moment in time-past.⁴⁴

III. Subsistence of copyright – Requirement of originality

11 Before engaging with the specific subject matter of photographs, it will be helpful to first examine the general concept of originality under US and UK common law. While it is trite that originality is a prerequisite for any work to acquire copyright protection, UK and US courts have emphasised different underlying justifications for copyright protection, resulting in different thresholds for originality.

40 *Vestwin Trading Pte Ltd v Obegi Melissa* [2006] 3 SLR(R) 573 at [37].

41 Act 26 of 2012. See Personal Data Protection Commission, *Advisory Guidelines on the Personal Data Protection Act for Selected Topics* (24 September 2013; revised 31 August 2018) at paras 4.1–4.2 and 4.4.

42 Justin Hughes, “The Photographer’s Copyright – Photograph as Art, Photograph as Database” (2012) 25 Harv JL & Tech 339 at 348.

43 See Justin Hughes, “The Photographer’s Copyright – Photograph as Art, Photograph as Database” (2012) 25 Harv JL & Tech 339 at 361–362, where Hughes adds that:

... [i]n the old-style portrait session (or the modern fashion shoot) where the photographer creates a new, highly stylised composition of people and props, that composition exists in reality – albeit momentarily. The composition is real, yet at the same time is close to a work of fiction[.]

in contrast to a painter who may “simply imagine [the tableau] and paint the same, the photographer has to place [the tableau] in actual surroundings”.

44 See also Justin Hughes, “The Photographer’s Copyright – Photograph as Art, Photograph as Database” (2012) 25 Harv JL & Tech 339 at 348.

A. Originality – US law

12 The US Supreme Court’s decision in *Feist Publications v Rural Telephone Service Co Inc*⁴⁵ (“*Feist*”), is globally known for definitively resolving the basis for copyright protection of factual compilations under US law. This dispute involved the “interaction of two well-established propositions” – on one hand, that “facts are not copyrightable”, and on the other, that “compilations of facts generally are”.⁴⁶ The court held that copyright protects only “the selection and arrangement” of facts or data, provided that such selection and arrangement was “made independently by the compiler and entail[ed] a minimal degree of creativity”.⁴⁷ On the other hand, facts, or the hard work that went into compiling them, were unprotectable.⁴⁸ But while this landmark decision made global waves concerning copyright protection of factual compilations,⁴⁹ reaching even Singapore’s shores,⁵⁰ its impact within the US itself is significant for all types of copyright works, and not merely compilations.

13 This was because *Feist* was, on a broader level, resolving the doctrinal split between the federal circuits as to the proper justification for copyright protection – between the “sweat of the brow” camp which rewards effort or investment made, and the “creativity” camp which rewards the adding to the pool of creative works available for society’s benefit.⁵¹ The court ruled that creativity was constitutionally required⁵²

45 499 US 340 (1991).

46 *Feist Publications v Rural Telephone Service Co Inc* 499 US 340 (1991) at 344.

47 *Feist Publications v Rural Telephone Service Co Inc* 499 US 340 (1991) at 348.

48 *Feist Publications v Rural Telephone Service Co Inc* 499 US 340 at 354 and 359–360 (1991).

49 See generally Daniel Gervais, “*Feist* Goes Global: A Comparative Analysis of the Notion of Originality in Copyright Law” (2002) 49 J Copyright Soc’y USA 949. Since then, Australia, too, has adopted the *Feist* approach towards factual compilations: see *Telstra Corp Ltd v Phone Directories Co Pty Ltd* (2010) 273 ALR 725.

50 See *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2016] 2 SLR 165; affirmed on appeal in *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2017] 2 SLR 185.

51 See Daniel Gervais, “*Feist* Goes Global: A Comparative Analysis of the Notion of Originality in Copyright Law” (2002) 49 J Copyright Soc’y USA 949 at 953, noting that:

... [t]he main reason why the circuits were split among between the *two* main doctrines prior to *Feist* is that there are two principal justifications – and, therefore, bases – for copyright protection: either it is a reward/incentive of the effort or investment made, or a reward/incentive for adding to the pool of creative works available to the ‘public’. [emphasis added]

52 *Feist Publications v Rural Telephone Service Co Inc* 499 US 340 at 346–347 and 363 (1991); see also Daniel Gervais, “*Feist* Goes Global: A Comparative Analysis of the Notion of Originality in Copyright Law” (2002) 49 J Copyright Soc’y USA 949 at 950: “In reality, *Feist* did much more than resolve a definitional tension: it determined that there was a constitutional requirement of creativity.”

by “defin[ing] originality by reference to creativity”.⁵³ Originality, the court held, was the “*sine qua non* of copyright” and required by the Constitution of the United States (“US Constitution”) and the US Copyright Act of 1976.⁵⁴ Drawing on two of its 19th-century decisions,⁵⁵ it explained that originality presupposed a “minimal degree of creativity”,⁵⁶ and therefore required authors to make creative choices passing a low threshold.⁵⁷ Pertinently, by locating creativity in the US Constitution, the *Feist* requirement for original works to contain a “modicum of creativity” extends to all copyright works and not merely factual compilations.⁵⁸ Factual compilations consisting wholly of facts and no original written expression, however, may be protected as long as the selection and arrangement of facts is original. Copyright in compilations would, however, be inevitably “thin”, limited to those original elements.⁵⁹

14 The Supreme Court jettisoned the “sweat of the brow” doctrine, along with the “underlying notion ... that copyright was a reward for hard work that went into compiling facts”.⁶⁰ It observed that:⁶¹

[i]t may seem unfair that much of the fruit of the compiler’s labor may be used by others without compensation. ... however, this is not ‘some unforeseen by-product of a statutory scheme.’ ... It is, rather, ‘the essence of copyright’ ... and a constitutional requirement. *The primary objective of copyright is not to reward the labor of authors, but ‘to promote the Progress of Science and useful Arts.’ ... To this end, copyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information*

53 Justin Hughes, “The Personality Interest of Artists and Inventors in Intellectual Property” (1998) 16(1) *Cardozo Arts & Ent LJ* 81 at 99.

54 17 USC § 101 *et seq.* *Feist Publications v Rural Telephone Service Co Inc* 499 US 340 at 345–346 and 355–361 (1991). The court held that the Copyright Act of 1909 Pub L 60–349 also embodied this requirement, “but not as clearly as it might have”: see 351.

55 *Ie, The Trade-Mark Cases* 100 US 82 at 94 (1879), where the Supreme Court described originality as being “founded in the creative powers of the mind” and *Burrow-Giles Lithographic Co v Sarony* 111 US 53 at 58 (1884) where it held that copyright was limited to the “original intellectual conceptions of the author”.

56 *Feist Publications v Rural Telephone Service Co Inc* 499 US 340 at 345 (1991).

57 *Feist Publications v Rural Telephone Service Co Inc* 499 US 340 at 348 (1991); see also Daniel Gervais, “*Feist* Goes Global: A Comparative Analysis of the Notion of Originality in Copyright Law” (2002) 49 *J Copyright Soc’y USA* 949 at 952–953.

58 *Feist Publications v Rural Telephone Service Co Inc* 499 US 340 (1991) at 347: “The originality requirement is *constitutionally mandated* for all works” [emphasis in original]; see also Eric J Schwartz & David Nimmer, “United States” in *International Copyright Law and Practice* (Paul Edward Geller & Lionel Bently eds) (LexisNexis, 2015) at § 2[1][b]; Howard B Abrams, “Originality and Creativity in Copyright Law” (1992) 55(2) *Law & Contemp Probs* 3 at 5; Dennis S Karjala, “Copyright and Creativity” (2008) 15(2) *UCLA Ent L Rev* 169 at 170.

59 *Feist Publications v Rural Telephone Service Co Inc* 499 US 340 at 348–349 (1991).

60 *Feist Publications v Rural Telephone Service Co Inc* 499 US 340 at 352 (1991).

61 *Feist Publications v Rural Telephone Service Co Inc* 499 US 340 at 349–350 (1991).

conveyed by a work. ... This principle, known as the idea/expression or fact/expression dichotomy, applies to all works of authorship. As applied to a factual compilation, assuming the absence of original written expression, only the compiler's selection and arrangement may be protected; the raw facts may be copied at will. *This result is neither unfair nor unfortunate. It is the means by which copyright advances the progress of science and art.* [emphasis added]

15 Later it added, citing the leading US treatise, *Nimmer on Copyright*⁶² (“*Nimmer*”):⁶³

Protection for the fruits of such research ... may in certain circumstances be available under a theory of unfair competition. But to accord copyright protection on this basis alone distorts basic copyright principles in that it creates a monopoly in public domain materials without the necessary justification of protecting and encouraging the creation of ‘writings’ by ‘authors’.

16 This conceptual basis for granting copyright protection is, however, not universally held, and – as will be seen – the divergent views manifest most evidently in the scope of protection for fact-based works, which include photographs.

B. Subsistence of copyright in the UK

(1) Originality under traditional UK common law

17 Turning to UK common law, the Copyright, Designs and Patents Act 1988⁶⁴ (“CDPA”) requires a literary, dramatic, musical or artistic work to be “original” to qualify for copyright protection.⁶⁵ The term “original” is undefined in the CDPA save in relation to databases,⁶⁶ and further elaboration as to its requirements have been left to the courts.

18 Emerging from the cases, then, are two main aspects of originality.⁶⁷ First, originality requires that the work should originate from

62 Melville B Nimmer & David Nimmer, *Nimmer on Copyright* (Matthew Bender & Co Inc, 1978).

63 *Feist Publications v Rural Telephone Service Co Inc* 499 US 340 at 354 (1991); see also Daniel Gervais, “*Feist Goes Global: A Comparative Analysis of the Notion of Originality in Copyright Law*” (2002) 49 J Copyright Soc’y USA 949 at 954, stating that:

... [t]he Court ... clarified the delineation between copyright (and its underlying policy objectives, namely a reward for the sake of incentivizing creation) and misappropriation, which tends to protect investment unduly appropriated.

64 c 48 (UK).

65 Copyright, Designs and Patents Act 1988 (c 48) (UK) s 1(1)(a).

66 This is discussed further at paras 21 and 22 below.

67 See *Copinger and Skone James on Copyright* vol 1 (Gillian Davies, Nicholas Caddick & Gwilym Harbottle eds) (Sweet & Maxwell, 17th Ed, 2016) at para 3-208; (cont’d on the next page)

the author's efforts, rather than being a slavish copy of a work produced by the efforts of others.⁶⁸ Secondly, in creating the work, the author must have expended at least a "relatively modest" or "more than negligible" amount of skill, judgment or labour.⁶⁹ It is, however, not possible to define the precise amount of skill, judgment or labour required, which is a matter of degree and dependent on the facts of each case.⁷⁰

19 The UK common law standard of originality therefore presents a relatively low threshold to works acquiring copyright protection,⁷¹ and – unlike the creativity standard – would confer copyright protection on works produced by the exercise of a more-than-trivial amount of "labour", even if no creative choices were involved.⁷² For example, labour expended towards the collection of facts for the preparation of a compilation would be relevant to the originality inquiry.⁷³ Similarly, the exercise of "skill"

J A L Sterling, *Sterling on World Copyright Law* (Trevor Cook gen ed) (Sweet & Maxwell, 5th Ed, 2018) at para 7.85.

- 68 *Hyperion Records Ltd v Sawkins* [2005] EWCA Civ 565; [2005] 1 WLR 3281 at [31], per Mummery LJ; *University of London Press v University Tutorial Press* [1916] 2 Ch 601 at 608–609, per Peterson J; see also *Copinger and Skone James on Copyright* vol 1 (Gillian Davies, Nicholas Caddick & Gwilym Harbottle eds) (Sweet & Maxwell, 17th Ed, 2016) at para 3-208; and Michael Tappin *et al*, *Laddie, Prescott and Vitoria: The Modern Law of Copyright* vol 1 (LexisNexis, 5th Ed, 2018) at para 3.40. It is, however, possible for a derivative work to be original, and the applicable legal principles and their relevance to photographs are discussed at paras 50–68 below.
- 69 *Hyperion Records Ltd v Sawkins* [2005] EWCA Civ 565; [2005] 1 WLR 3281 at [56]; *Ladbroke (Football) v William Hill (Football) Ltd* [1964] 1 WLR 273 at 277, per Lord Reid, 287, per Lord Hodson; see also *Copinger and Skone James on Copyright* vol 1 (Gillian Davies, Nicholas Caddick & Gwilym Harbottle eds) (Sweet & Maxwell, 17th Ed, 2016) at para 3-208; Michael Tappin *et al*, *Laddie, Prescott and Vitoria: The Modern Law of Copyright* vol 1 (LexisNexis, 5th Ed, 2018) at paras 3.40–3.41 and 3.45.
- 70 *Macmillan & Co Ltd v Cooper* (1923) 93 LJPC 113 at 121; *G A Cramp & Sons Ltd v Frank Smythson Ltd* [1944] AC 329 at 335; *Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1 WLR 273 at 279 and 282; *Interlego AG v Tycos Industries Inc* [1989] AC 217 at 261; see also *Copinger and Skone James on Copyright* vol 1 (Gillian Davies, Nicholas Caddick & Gwilym Harbottle eds) (Sweet & Maxwell, 17th Ed, 2016) at para 3-208; Michael Tappin *et al*, *Laddie, Prescott and Vitoria: The Modern Law of Copyright* vol 1 (LexisNexis, 5th Ed, 2018) at para 3.45.
- 71 See, eg, *Copinger and Skone James on Copyright* vol 1 (Gillian Davies, Nicholas Caddick & Gwilym Harbottle eds) (Sweet & Maxwell, 17th Ed, 2016) at paras 3-199 and 3-208.
- 72 See J A L Sterling, *Sterling on World Copyright Law* (Trevor Cook gen ed) (Sweet & Maxwell, 5th Ed, 2018) at para 7.95, commenting on the difference between skill and judgment, on the one hand, and labour, on the other:
Skill and judgment imply the application of personal choice, of some intellectual contribution. Mere labour does not carry this implication. While skill and judgment may involve an intellectual contribution akin to creativity, mere labour does not.
- 73 See *Copinger and Skone James on Copyright* vol 1 (Gillian Davies, Nicholas Caddick & Gwilym Harbottle eds) (Sweet & Maxwell, 17th Ed, 2016), where the
(cont'd on the next page)

which does not involve making creative choices – such as stenography – may be protected.⁷⁴ This basis for copyright protection under traditional UK common law therefore rests on the very justification rejected in *Feist*:⁷⁵

[The] protection of the author's investment in the production of the work against unfair competition, especially against a competitor's free ride and his parasitical undercutting of the author's expenses by unauthorised and cheaper copying.

20 An important caveat to the discussion above is that the current UK position must now be considered in light of the European Union (“EU”) Directives and jurisprudence of the Court of Justice of the European Union, where the test for originality has been restated as asking whether the work is the “author[’s] own intellectual creation.”⁷⁶

authors observe at para 3-217: “[t]he typical case where copyright has been conferred on a work simply as a result of the labour which has gone into it is a case of a table or compilation”, and (at para 3-266) that “the relevant skill and labour may be directed to the compiling of the contents”, and that “[a]s to the gathering of information into a table or compilation, it has never been the position under English law that compilations merely using ‘sweat of the brow’ and not involving skill and judgment in the selection of their constituent parts were not protected as original works”. See also *Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1 WLR 273. Similarly, the Singapore High Court in *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2016] 2 SLR 165 noted at [76] that:

The ... sweat of the brow school ... admits effort taken in the preparatory steps leading up to the reduction of the work to its final or particular form. These preparatory efforts include the labour involved in fact finding, fact creation and fact collection.

- 74 *Walter v Lane* [1900] AC 539; see *Copinger and Skone James on Copyright* vol 1 (Gillian Davies, Nicholas Caddick & Gwilym Harbottle eds) (Sweet & Maxwell, 17th Ed, 2016) where the authors state (at para 3-218) that in *Walter v Lane*, “it was held that a reporter was entitled to copyright in his verbatim report of a public speech. It seems that no creative choices were made”. See also J A L Sterling, *Sterling on World Copyright Law* (Trevor Cook gen ed) (Sweet & Maxwell, 5th Ed, 2018) at para 7.96, observing that “it may be that some types of skill may be classed as ‘creative’, whereas others may not”.
- 75 *Feist Publications Inc v Rural Telephone Service Co Inc* 499 US 340 (1991); see para 14 above; see also Daniel Gervais, “*Feist* Goes Global: A Comparative Analysis of the Notion of Originality in Copyright Law” (2002) 49 J Copyright Soc’y USA 949 at 958 where Gervais observes that “[t]his traditional UK test seems very close to the pre-*Feist* ‘sweat of the brow’ doctrine”. See further Andreas Rahmatian, “Originality in UK Copyright Law: The Old ‘Skill and Labour’ Doctrine under Pressure” (2013) 44(4) IIC 4 at 5; see also Jane C Ginsburg, “The Concept of Authorship in Comparative Copyright Law” (2003) 52 DePaul L Rev 1063 at 1080: “[T]he persistence of a sweat standard in these jurisdictions has less to do with originality than it does with the absence of an unfair competition remedy against ‘misappropriation.’ That is, the solicitude for sweat may seem more to protect investment than creativity.”
- 76 See *Infopaq International A/S v Danske Dagblades Forening* C-5/08, EU:C:2009:465; [2009] ECR I-6569; [2009] ECDR 15 holding that Art 2(a) of the Directive (*cont’d on the next page*)

Whether the common law threshold for originality has thus been altered currently remains an open question,⁷⁷ although full treatment of the issue falls outside the scope of this article.

2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society (hereinafter “Information Society Directive”) conferred copyright protection only if the subject-matter was “original in the sense that it is its author’s own intellectual creation” (at paras 33–37); see also Eleonora Rosati, “Originality in a Work, or a Work of Originality: The Effects of the *Infopaq* Decision” (2010) 58 J Copyright Soc’y USA 795. As to the meaning of “intellectual creation”, the Court of Justice of the European Union in *Eva-Maria Painer v Standard Verlags GmbH* C-145/10, EU:C:2011:798; [2012] ECDR 6 at paras 88–89 held that:

... an intellectual creation is an author’s own if it reflects the author’s personality. That is the case if the author was able to express his creative abilities in the production of the work by making free and creative choices ...

- 77 See *Copinger and Skone James on Copyright* vol 1 (Gillian Davies, Nicholas Caddick & Gwilym Harbottle eds) (Sweet & Maxwell, 17th Ed, 2016) at para 3-215. The Court of Justice of the European Union’s rulings have generated uncertainty as to whether the common law sweat-based doctrine remains good law, given that the “intellectual creation” requirement and allusion to works reflecting the “author’s personality” appear to import continental European conceptions of copyright: see *SAS Institute Inc v World Programming Ltd* [2013] EWCA Civ 1482 at [36], citing the Opinion of the Advocate General in *Football Dataco Ltd v Yahoo! UK Ltd* C-604/10, EU:C:2011:848; see generally, Michael Tappin *et al*, *Laddie, Prescott and Vitoria: The Modern Law of Copyright* vol 1 (LexisNexis, 5th Ed, 2018) at paras 3.2 and 3.8; *Copinger and Skone James on Copyright* vol 1 (Gillian Davies, Nicholas Caddick & Gwilym Harbottle eds) (Sweet & Maxwell, 17th Ed, 2016) at para 3-212; and Eleonora Rosati, “Originality in a Work, or a Work of Originality: The Effects of the *Infopaq* Decision” (2010) 58 J Copyright Soc’y USA 795 at 797. The English Court of Appeal has reached different conclusions on the matter: see *Newspaper Licensing Agency Ltd v Meltwater Holding BV* [2011] EWCA Civ 890 at [20], affirming the decision of the English High Court in *Newspaper Licensing Agency Ltd v Meltwater Holding BV* [2010] EWHC 3099 (Ch) where Proudman J observed at [81] that the test “has been re-stated but for present purposes not significantly altered by *Infopaq*”, though admitting that “the full implications of the decision have not yet been worked out; cf *SAS Institute Inc v World Programming Ltd* [2013] EWCA Civ 1482, where a contrary position was reached by the English Court of Appeal, holding (at [31]–[33]) that the phrase “intellectual creation” required an author’s exercise of “expressive and creative choices in producing the work”, and that “[t]he more restricted the choices, the less likely it is that the product will be the intellectual creation (or the expression of the intellectual creation) of the person who produced it”. The court there opined that an expression “dictated by technical function” would not be an intellectual creation. It therefore observed that the intellectual creation test “may not be quite the same as the traditional test in English law” and that *Infopaq International A/S v Danske Dagblades Forening* C-5/08, EU:C:2009:465; [2009] ECR 1-6569; [2009] ECDR 15 and the Information Society Directive may have “raised ... the hurdle to obtaining copyright protection” (at [37]). For one view that European Union law slightly alters the understanding of originality in the UK but not so far as to adopt fully a continental European conception, see Andreas Rahmatian, “Originality in UK Copyright Law: The Old ‘Skill and Labour’ Doctrine under Pressure” (2013) 44(4) IIC 4. The direction UK copyright law will take on this issue post-Brexit also remains to be seen.

(2) *Databases in the UK*

21 Owing to the similarities between factual compilations and photographs as fact-based works, short mention will be made of the originality criteria for databases under UK law. The term “original” is statutorily defined in the CDPA only in relation to databases,⁷⁸ where s 3A(2), introduced in 1998⁷⁹ to implement the EU’s Database Directive,⁸⁰ states that a database is original only “if, by reason of the selection or arrangement of the contents of the database, the database constitutes the author’s own intellectual creation”.⁸¹

22 This was considered to raise the requirement of originality in respect of such works,⁸² for prior to the introduction of this section, the common law protected compilations laboriously prepared but “not involving any skill or judgment in the selection of their constituent parts”.⁸³ Describing the erstwhile state of UK law, the authors of a leading UK treatise *Copinger and Skone James on Copyright* (“*Copinger*”) state that “originality may lie in the humdrum though painstaking accumulation of information”.⁸⁴ The scope of protection of these works therefore differed from that under US law, owing to the different doctrines of originality: The traditional UK position sought to prevent the appropriation by others of the skill and labour invested in the creation of the database⁸⁵ –

78 Copyright, Designs and Patents Act 1988 (c 48) (UK) s 3A(1), where “Database” is defined as:

- ... a collection of independent works, data or other materials which—
 (a) are arranged in a systematic or methodical way, and
 (b) are individually accessible by electronic or other means.

79 Pursuant to the Copyright and Rights in Databases Regulations 1997 (SI 1997 No 3032).

80 Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases (hereinafter “Database Directive”).

81 Notably, this is similar to the position under s 7A of Singapore’s Copyright Act (Cap 63, 2006 Rev Ed).

82 See *Football Dataco Ltd v Brittens Pools Ltd* [2010] EWHC 841 (Ch) at [53]; see also Michael Tappin *et al*, *Laddie, Prescott and Vitoria: The Modern Law of Copyright* vol 1 (LexisNexis, 5th Ed, 2018) at paras 23.4 and 23.27–23.29; *Copinger and Skone James on Copyright* vol 1 (Gillian Davies, Nicholas Caddick & Gwilym Harbottle eds) (Sweet & Maxwell, 17th Ed, 2016) at paras 3-49 and 3-268.

83 *Copinger and Skone James on Copyright* vol 1 (Gillian Davies, Nicholas Caddick & Gwilym Harbottle eds) (Sweet & Maxwell, 17th Ed, 2016) at para 3-266. See also Michael Tappin *et al*, *Laddie, Prescott and Vitoria: The Modern Law of Copyright* vol 1 (LexisNexis, 5th Ed, 2018) at para 23.9.

84 *Copinger and Skone James on Copyright* vol 1 (Gillian Davies, Nicholas Caddick & Gwilym Harbottle eds) (Sweet & Maxwell, 17th Ed, 2016) at para 3-266. See also *Football League Ltd v Littlewoods Pools Ltd* [1959] Ch 637; [1959] 2 All ER 546.

85 Michael Tappin *et al*, *Laddie, Prescott and Vitoria: The Modern Law of Copyright* vol 1 (LexisNexis, 5th Ed, 2018) at paras 3.54 and 23.9.

the same justification categorically rejected by the US Supreme Court in *Feist*.⁸⁶

IV. Originality in photographs

23 Having explored the general originality requirement and underlying justifications in the US and UK, the author will now examine the treatment of photographs as copyright works in both jurisdictions. It will be seen that the differing approaches towards photographic originality may be traced to the aforementioned divergent justifications for copyright protection. Moreover, owing to the verisimilitude of photographs and the mechanical nature of the technology, some courts and commentators have tended towards broad protection, which seemingly stretches the originality doctrine beyond even sweat-based justifications.

A. *Photographs in the US*

24 US courts recognised early on that the verisimilitude and mechanical nature of photography did not preclude the photographer's exercise of creativity. But although the expansion of copyright subject matter to include photographs in 1865⁸⁷ was upheld as constitutional in *Burrow-Giles Lithographic Co v Sarony*⁸⁸ ("*Burrow-Giles*"), the US Supreme Court initially located originality only in the photographer's pre-shutter choices in staging the tableau,⁸⁹ such as in setting the scene for a portrait.

25 In *Burrow-Giles*, the defendant challenged the constitutionality of affording photographs copyright protection, arguing, *inter alia*, that photographers were not "authors" within the US Constitution.⁹⁰ It argued

86 *Feist Publications v Rural Telephone Service Co Inc* 499 US 340 (1991).

87 Copyright Act of 1865 ch 126, 13 Stat 540 § 1, which provided that the provisions of the US copyright legislation then in force ...

... shall extend to and include photographs and the negatives thereof which shall hereafter be made, and shall ensure to the benefit of the authors of the same in the same manner, and to the same extent, and upon the same conditions, as to the authors of prints and engravings.

88 111 US 53 (1884).

89 Justin Hughes, "The Photographer's Copyright – Photograph as Art, Photograph as Database" (2012) 25 Harv JL & Tech 339 at 356; Christine Haight Farley, "The Lingering Effects of Copyright's Response to the Invention of Photography" (2004) 65 U Pitt L Rev 385 at 427.

90 *Burrow-Giles Lithographic Co v Sarony* 111 US 53 at 56 (1884). Art 1, § 8, cl 8 of the US Constitution gave Congress power "[t]o promote the progress of science and useful arts, by securing, for limited times to authors and inventors, the exclusive right to their respective writings and discoveries".

against the existence of creativity in the production of a photograph,⁹¹ contending that as the word “author” “presuppose[s] the idea of originality”,⁹² copyright protected “only such as are original, founded in the creative powers of the mind”.⁹³ A photograph, it alleged, “being a reproduction on paper of the exact features of some natural object or of some person, is not a writing of which the producer is the author”, but a:⁹⁴

... mere mechanical reproduction of the physical features or outlines of some object animate or inanimate, and involves no originality of thought or any novelty in the intellectual operation connected with its visible reproduction in shape of a picture.

26 Interestingly, the Supreme Court did not directly address this argument, but impliedly rejected it as a description of *all* photographs.⁹⁵ Observing that although *Burrow-Giles* may be correct regarding “the ordinary production of a photograph”, this description did not apply to the photograph in question – a portrait of Oscar Wilde taken by acclaimed photographer Napoleon Sarony. This photograph was a:⁹⁶

... useful, new, harmonious, characteristic, and graceful picture, and that plaintiff made the same ... entirely from his own original mental conception, to which he gave visible form by posing the said Oscar Wilde in front of the camera, selecting and arranging the costume, draperies, and other various accessories in said photograph, arranging the subject so as to present graceful outlines, arranging and disposing the light and shade, suggesting and evoking the desired expression, and from such disposition, arrangement, or representation, made entirely by plaintiff, he produced the picture in suit.

27 The court therefore considered that photography *could* be an entirely mechanical process,⁹⁷ though it refused to decide if such

91 *The Burrow-Giles Lithographic Co v Sarony* 111 US 53 (1884) claim was essentially that “there was no creativity or originality involved in a machine recording whatever facts are put in front of it” – an “extremely mechanical” view of photography: see Justin Hughes, “The Photographer’s Copyright – Photograph as Art, Photograph as Database” (2012) 25 Harv JL & Tech 339 at 355–356.

92 See Justin Hughes, “The Photographer’s Copyright – Photograph as Art, Photograph as Database” (2012) 25 Harv JL & Tech 339 at 354, citing “Statement and Brief for Plaintiff in Error” at 9, *Burrow-Giles Lithographic Co v Sarony* 111 US 53 (1884).

93 See Justin Hughes, “The Photographer’s Copyright – Photograph as Art, Photograph as Database” (2012) 25 Harv JL&Tech 339 at 354, citing “Statement and Brief for Plaintiff in Error” at 18; *Burrow-Giles Lithographic Co v Sarony* 111 US 53 (1884).

94 *Burrow-Giles Lithographic Co v Sarony* 111 US 53 at 59 (1884).

95 See Justin Hughes, “The Photographer’s Copyright – Photograph as Art, Photograph as Database” (2012) 25 Harv JL & Tech 339 at 356.

96 *Burrow-Giles Lithographic Co v Sarony* 111 US 53 at 60 (1884).

97 Christine Haight Farley, “The Lingering Effects of Copyright’s Response to the Invention of Photography” (2004) 65 U Pitt L Rev 385 at 409.

“ordinary” photographs were protected.⁹⁸ The nature of the technology did not, however, preclude Sarony’s authorial intervention, whose actions in staging the tableau were deemed creative.⁹⁹

28 Later decisions followed *Burrow-Giles* in locating originality in the pre-shutter decisions of the photographer.¹⁰⁰ The question left unanswered was whether photographs depicting independent realities could be protected, and if so, where did their originality lie?

29 Hughes observes that “[o]ver time, courts ... became comfortable with moving beyond extra-machine composition to increasingly recognise personal expression in the process of using a machine”.¹⁰¹ In *Pagano v Charles Beseler Co*,¹⁰² the photograph in issue involved no staged tableau, being a scene of the streets of New York. The court located originality in the other choices of the photographer, stating that it “requires originality to determine just when to take the photograph, ... with the adjunctive features of light, shade, position, etc”.¹⁰³ Many decisions have since concurred that photographic originality may lie in decisions concerning lighting and shading, angle of shot, selection of camera, film lens and filters, and even camera settings such as shutter speed.¹⁰⁴

98 *Burrow-Giles Lithographic Co v Sarony* 111 US 53 at 59 (1884) : on whether “the ordinary production of a photograph” was eligible for copyright protection, the court “decide[d] nothing”; see also *American Mutoscope & Biograph Co v Edison Manufacturing Co* 137 F 262 at 265 (DNJ, 1905), where the court noted that “[w]hether a photograph of a building or any other object, which is a mere mechanical reproduction of the physical features or outlines of the object, involving no originality or novelty on the part of him who takes it, is the subject of copyright, may well be doubted”.

99 *Burrow-Giles Lithographic Co v Sarony* 111 US 53 at 60 (1884), where the court held that the lower court’s findings “show this photograph to be an original work of art, the product of plaintiff’s intellectual invention, of which plaintiff is the author”.

100 See, eg, *Falk v Gast Lithograph & Engraving Co Ltd* 48 F 262 (CCSDNY, 1891); *Falk v Brett Lithographic Co* 48 F 678 (CCSDNY, 1891); *Falk v Donaldson* 57 F 32 (CCSDNY, 1893); *Gross v Seligman* 212 F 930 (2nd Cir, 1914); *Altman v New Haven Union Co* 254 F 113 (D Conn, 1918). See generally Christine Haight Farley, “The Lingering Effects of Copyright’s Response to the Invention of Photography” (2004) 65 U Pitt L Rev 385 at 439–444 for a discussion of these cases.

101 Justin Hughes, “The Photographer’s Copyright – Photograph as Art, Photograph as Database” (2012) 25 Harv JL & Tech 339 at 363.

102 234 F 963 (SDNY, 1916).

103 *Pagano v Charles Beseler Co* 234 F 963 at 964 (SDNY, 1916).

104 See, eg, *Roger v Koons* 9 60 F 2d 301 at 307 (2nd Cir, 1992) (“Elements of originality in a photograph may include posing the subjects, lighting, angle, selection of film and camera, evoking the desired expression, and almost any other variant involved”); *Gentieu v John Muller & Co Inc* 712 F Supp 740 at 742 (WD Mo, 1989) (“The copyrightable elements, therefore, include the photographer’s selection of background, lights, shading, positioning of subject, and timing”), referred to in *Leigh v Warner Bros* 10 F Supp 2d 1371 at 1376 (SD Ga, 1998); *Latimer v Roaring* (cont’d on the next page)

30 More accurate, however, were decisions which grounded originality in the *effects produced* by such elements, rather than the elements themselves. In *Mannion v Coors Brewing Co*,¹⁰⁵ it was clarified that while courts frequently enumerated “lists of the potential components of photographic originality”, this was “not sufficiently precise”.¹⁰⁶

Decisions about film, camera, and lens, for example, often bear on whether an image is original. But the fact that a photographer made such choices does not alone make the image original. ‘Sweat of the brow’ is not the touchstone of copyright. *Protection derives from the features of the work itself, not the effort that goes into it.* [emphasis added]

31 Referring to *Bridgeman Art Library Ltd v Corel Corp*¹⁰⁷ (“*Bridgeman II*”) the court then noted that a photographer’s decisions going towards the production of “slavish copies” were insufficient to demonstrate originality, even if a “great deal of effort and expertise” went into making them.¹⁰⁸ Similarly, the Ninth Circuit in *Ets-Hokin v Skyy Spirits Inc*¹⁰⁹ observed that it was more precise to refer to “the elements of

Toyz Inc 601 F 3d 1224 at 1230 (11th Cir, 2010), noting that the photographer “made all decisions regarding lighting, appropriate camera equipment and lens, camera settings and use of the white background”; and *SHL Imaging Inc v Artisan House Inc* 117 F Supp 2d 301 at 310 (SDNY, 2000):

The technical aspects of photography imbue the medium with almost limitless creative potential. For instance, the selection of a camera format governs the film size and ultimately the clarity of the negative. Lenses affect the perspective. Film can produce an array of visual effects. Selection of a fast shutter speed freezes motion while a slow speed blurs it. Filters alter color, brightness, focus and reflection. Even the strength of the developing solution can alter the grain of the negative ...

See also *Kisch v Ammirati & Puris Inc* 657 F Supp 380 at 382 (SDNY, 1987): “The copyrightable elements of a photograph include such features as the photographer’s selection of lighting, shading, positioning and timing.”

105 377 F Supp 2d 444 (SDNY, 2006).

106 *Mannion v Coors Brewing Co* 377 F Supp 2d 444 at 451 (SDNY, 2006). See also Justin Hughes, “The Photographer’s Copyright – Photograph as Art, Photograph as Database” (2012) 25 Harv JL & Tech 339 at 408–409, referring to such descriptions as an “ambiguity-laden shorthand”. Hughes notes that “[t]he problem is that courts tend to use formulae that locate the originality in the work based on the process that produced the work ... it is not the ‘means of filters, developing techniques, etc,’ but rather the actual effects on the visual image – the ‘effects achieved’”; Ysolde Gendreau *et al*, *Copyright and Photographs: An International Survey* (Kluwer Law International, 1999) at p 306:

The rejection of [the sweat of the brow] doctrine by the Supreme Court in the *Feist* decision should mean that the appreciation of the more ritualistic aspects of photography must be made with the intention of discovering whether or not they betray creativity. A mere finding that these activities took place would not suffice.

107 36 F Supp 2d 191 (SDNY, 1999).

108 *Mannion v Coors Brewing Co* 377 F Supp 2d 444 at 451 (SDNY, 2006).

109 225 F 3d 1068 (9th Cir, 2000).

photographs that *result* from [the photographer's] decisions" [emphasis added] as being protected by copyright.¹¹⁰

32 Hughes notes, however, that besides enumerating lists of the sort mentioned above, "[c]ourts rarely press further on the criteria of originality or creativity in photography".¹¹¹ Referring to the fact-capturing capacity of photographs and their judicially-recognised evidentiary power,¹¹² he suggests that just as with databases, for which "the *only* creativity possible is in [the] selection and arrangement [of the pre-existing elements]" [emphasis in original], it is similarly the selection and arrangement of the elements in a photograph which, if sufficiently creative, may be protected by copyright.¹¹³ Such selection and arrangement can be done physically where the subject matter is a staged tableau, but this understanding of the originality criteria also extends to photographs recording an independent reality (involving no staged tableau or direction by the photographer):¹¹⁴

... the position of the camera, and therefore the choice of the image frame, produces selection in the copyright sense. For example, are you including the Chrysler Building in your photo of midtown? Are you framing the photo so that your ugly uncle is missing? Once the frame is chosen, there is another set of choices made by the photographer regarding the position of the subject, angle, and timing. These can be creative choices.

Moreover, besides physically arranging the objects in a tableau:¹¹⁵

... arrangement of the objects in a photo can also happen just *within* the image: the angle chosen for the shot arranges things in the visual image. ... The reality does not change at all, but your selection of the camera angle ... produces the particular arrangement of the objects in the photograph. [emphasis in original]

33 These views were endorsed by the Court of Appeals of the Ninth Circuit in *Rentmeester*. The court observed that although one may point to the various creative choices adopted by a photographer in producing an image, "none of those elements is subject to copyright protection when

110 *Ets-Hokin v Skyry Spirits Inc* 225 F 3d 1068 at 1074–1075 (9th Cir, 2000).

111 Justin Hughes, "The Photographer's Copyright – Photograph as Art, Photograph as Database" (2012) 25 Harv JL & Tech 339 at 366.

112 Justin Hughes, "The Photographer's Copyright – Photograph as Art, Photograph as Database" (2012) 25 Harv JL & Tech 339 at 345–351.

113 Justin Hughes, "The Photographer's Copyright – Photograph as Art, Photograph as Database" (2012) 25 Harv JL & Tech 339 at 367.

114 Justin Hughes, "The Photographer's Copyright – Photograph as Art, Photograph as Database" (2012) 25 Harv JL & Tech 339 at 366.

115 Justin Hughes, "The Photographer's Copyright – Photograph as Art, Photograph as Database" (2012) 25 Harv JL & Tech 339 at 367.

viewed in isolation”.¹¹⁶ Rather, “photographs can be likened to factual compilations” in that:¹¹⁷

... [w]hat is protected by copyright is the photographer’s selection and arrangement of the photo’s otherwise unprotected elements. If sufficiently original, the combination of subject matter, pose, camera angle, etc., receives protection, not any of the individual elements standing alone. ... a photographer’s copyright is limited to ‘the particular selection and arrangement’ of the elements as expressed in the copyrighted image. [emphasis in original]

34 Analogising photographs to factual compilations and locating originality within the selection and arrangement of a photograph’s unprotected elements might initially seem novel. Having examined the aforementioned developments in US jurisprudence, it should, however – at least on hindsight – be less surprising. As observed by several commentators, courts had long recognised the fact-based nature of photography in dealing with their evidentiary usefulness.¹¹⁸ Moreover, previous decisions considering the originality of photographs already intimated that it was the photographer’s *selection* of various elements, which, if original, would confer copyright on the photograph.¹¹⁹ As with unprotectable facts in factual compilations, courts and commentators alike already recognised that photographic copyright extended only to the original elements of the photograph, but not the unoriginal underlying subject matter.¹²⁰ Applying the *Feist* formulation to

116 *Jacobus Rentmeester v Nike Inc* 883 F 3d 1111 at 1119 (9th Cir, 2017).

117 *Jacobus Rentmeester v Nike Inc* 883 F 3d 1111 at 1119–1120 (9th Cir, 2017).

118 See paras 5–8 above.

119 See para 29 above. See also *SHL Imaging Inc v Artisan House Inc* 117 F Supp 2d 301 at 310 (SDNY, 2000) where the court recognised that it was the “elements that combine” which must satisfy the standard of creativity set out in *Feist Publications v Rural Telephone Service Co Inc* 499 US 340 (1991).

120 *Roger v Koons* 960 F 2d 301 at 307 (2nd Cir, 1992) (“that a whole work is copyrighted does not mean that every element of it is copyrighted; copyright protection extends only to those components of the work that are original to the creator.”); *Leigh v Warner Bros* 10 F Supp 2d 1371 at 1376 (SD Ga, 1998) (“In cases involving photographs, a plaintiff cannot copyright the subject matter of the photo.”); *Kisch v Ammirati & Puris Inc* 657 F Supp 380 at 382 (SDNY, 1987), citing *Rochelle Asparagus Co v Princeville Canning Co* 170 F Supp 809 at 812 (SD Ill, 1959) (“It is a general rule that [a] copyright does not give to the owner thereof an exclusive right to use the basic material, but only the exclusive right to reproduce his individual presentation of the material.”); *Caratzas v Time Life Inc* No 92 Civ 6346, 1992 US Dist LEXIS 16285 (SDNY, 1992) at 10 (“actionable copying does not occur where a photographer takes a picture of the subject matter depicted in a copyrighted photograph, so long as the second photographer does not copy original aspects of the copyrighted work, such as lighting or placement of the subject.”); *Bleistein v Donaldson Lithographing Co* 188 US 239 at 249 (1903) (“Others are free to copy the original. They are not free to copy the copy.”); See Christine Haight Farley, “The Lingering Effects of Copyright’s Response to the Invention of Photography” (2004) 65 U Pitt L Rev 385 at 450
(cont’d on the next page)

photographs also ensures that the focal point for assessing originality in photographs remains on the creative choices – as opposed to labour – of the photographer,¹²¹ and directs courts to an examination of the effects of such choices on the final image, rather than the mere fact that choices were made.

B. *Photographs in the UK*

35 There has been generally less judicial discourse on the scope of photographic copyright in the UK,¹²² and the topic has therefore “yet to be worked out comprehensively by the [UK] courts”.¹²³

36 As with US law in *Burrow-Giles*, UK common law recognised early on that a photographer’s act of staging of a tableau was sufficient to confer originality on the resulting photograph. In *Nottage v Jackson*,¹²⁴ the court accepted the photographer’s arranging of cricketers for a portrait shot as sufficient to confer copyright.¹²⁵

37 Beyond staged tableaus, it has been accepted that the threshold of originality for photographs under UK common law is low. Neuberger J had to consider, in *Antiquesportfolio.com v Rodney Fitch & Co Ltd*¹²⁶ (“*Antiquesportfolio*”) “the extent to which a photograph of a single static

(“[T]he scene is a fact that no photographer may appropriate. The only prohibitions on a second comer is that they must not copy the original aspects of the work such as the lighting or placement of the subject”). See also *Jacobus Rentmeester v Nike Inc* 883 F 3d 1111 at 1119 (9th Cir, 2017): “That remains true even if, as here, a photographer creates wholly original subject matter by having someone pose in an unusual or distinctive way.”

121 Daniel Gervais, “*Feist Goes Global: A Comparative Analysis of the Notion of Originality in Copyright Law*” (2002) 49 J Copyright Soc’y USA 949 at 952–953.

122 As mentioned above, this article deals with the position under UK common law, as opposed to that pursuant to the European Union Directives and the *Infopaq International A/S v Danske Dagblades Forening* C-5/08, EU:C:2009:465; [2009] ECR I-6569; [2009] ECDR 15 line of authority.

123 Michael Tappin *et al*, *Laddie, Prescott and Vitoria: The Modern Law of Copyright* vol 1 (LexisNexis, 5th Ed, 2018) at para 4.65. See also Eleonora Rosati, “Originality in US and UK Copyright Experiences as a Springboard for an EU-Wide Reform Debate” 41(5) IIC 524 at 541 (2010), noting that “judicial decisions in this area have given little guidance in determining what originality means in this context”.

124 (1883) 11 QB 627.

125 *Nottage v Jackson* (1883) 11 QBD 627 (“*Nottage*”) at 632. Indeed, *Nottage* was referred to by the US Supreme Court in *Burrow-Giles Lithographic Co v Sarony* 111 US 53 (1884) for the reasoning employed by the UK court on locating authorship in photography. See *Burrow-Giles Lithographic Co v Sarony* 111 US 53 at 60–61 (1884); see also Christine Haight Farley, “The Lingering Effects of Copyright’s Response to the Invention of Photography” (2004) 65 U Pitt L Rev 385 at 409–410.

126 [2000] IP & T 1375.

item, such as a jug or candelabra or sofa, can said to be protected by copyright”.¹²⁷ Noting that the point was “free of direct authority”, the court endorsed the proposition in an older edition of *Copinger* that in relation to copyright in photographs:¹²⁸

... the requirement of originality is low, and may be satisfied by little more than the *opportunistic* pointing of the camera and the pressing of the shutter button
.... Provided that the author can demonstrate that he expended some *small degree of time, skill and labour* in producing the photograph, (which may be demonstrated by the *exercise of judgment as to such matters as the angle from which to take the photograph, the lighting, the correct film speed, what filter to use, etc*) the photograph ought to be entitled to copyright protection, irrespective of its subject matter. [emphasis added]

He also cited, with approval, the following passage from a leading US treatise, *Nimmer*:¹²⁹

any (or as will be indicated below, almost any) photograph may claim the necessary originality to support a copyright merely by virtue of the photographers’ *personal choice of subject matter, angle of photograph, lighting and determination of the precise time when the photograph is to be taken*. [emphasis added]

38 The reference to *Nimmer* and the ostensible similarities between the passage from *Copinger* and US decisions which frequently enumerated lists of actions resulting in photographic originality may initially suggest consistency between UK and US law on the subject.¹³⁰ Closer examination, however, reveals this to be untrue as those passages appear to have been cited merely to state that the bar to photographic originality under UK common law is low. This is because the two treatises actually differ on when originality is *not* found – which difference stems from the divergence in doctrinal underpinnings of copyright in US and the UK. It has been observed that under US law it is the “effects produced” by the choice of various elements, rather than the “fact that a photographer made such choices” which makes a photograph original.¹³¹

127 *Antiquesportfolio.com plc v Rodney Fitch & Co Ltd* [2000] IP & T 1375 at 1380–1381.

128 *Antiquesportfolio.com plc v Rodney Fitch & Co Ltd* [2000] IP & T 1375 at 1381.

129 *Antiquesportfolio.com plc v Rodney Fitch & Co Ltd* [2000] IP & T 1375 at 1381–1382.

130 See, eg, Colin T Cameron, “In Defiance of Bridgeman: Claiming Copyright in Photographic Reproductions of Public Domain Works” (2006) 15 *Tex Intell Prop LJ* 31 at 56 where one author, having considered the above passage from *Copinger* and *Skone James on Copyright* vol 1 (Gillian Davies, Nicholas Caddick & Gwilym Harbottle eds) (Sweet & Maxwell, 17th Ed, 2016) concluded that “the British skill and labour standard and the US originality standard may not be so different” as “[a]lthough the British court couches its analysis in terms of the author’s skill and labour, each court weighs the same factors to discern whether copyright subsists in a work”.

131 See para 30 above.

The *Nimmer* treatise therefore states that no originality is to be found in “photographing a print”, or where the photographer “in choosing subject matter, camera angle, lighting, *etc*, copies and attempts to duplicate all of such elements as contained in a prior photograph”.¹³² In contrast, the passage quoted from *Copinger* focuses on the *exercise* of time, skill and labour which *in itself* suffices to confer copyright, “irrespective of [the photograph’s] subject matter”. Indeed, *Copinger* elaborates:¹³³

There seems no reason of principle why there should be any distinction between the photograph which is the result of such a process and a photograph which is intended to reproduce a work of art, such as a painting or another photograph.

39 The court was not too minded by the differences between the positions, however, since it was only required to decide whether originality subsisted in “photographs of a three-dimensional object”,¹³⁴ the taking of which was in any event found to involve creative choices that would have sufficed to confer copyright under US law.¹³⁵ As for the controversial subject of whether originality inhered in photographic reproductions of existing paintings or photographs which required the use of skill, effort and labour to produce, the court refused comment.¹³⁶

40 Further developments transpired in *Temple Island Collections Ltd v New English Teas Ltd*¹³⁷ (“*Temple Island*”), where Colin Birss J adopted the proposition in *Laddie, Prescott and Vitoria: The Modern Law*

132 See *Antiquesportfolio.com plc v Rodney Fitch & Co Ltd* [2000] IP & T 1375 at 1382, referring to the relevant passage from Melville B Nimmer & David Nimmer, *Nimmer on Copyright* (Matthew Bender & Co Inc, 1978).

133 *Antiquesportfolio.com plc v Rodney Fitch & Co Ltd* [2000] IP & T 1375 at 1381, citing *Copinger and Skone James on Copyright* (Kevin Garnett, Gillian Davies & Gwilym Harbottle eds) (Sweet & Maxwell, 14th Ed, 1998) at para 3-104.

134 *Antiquesportfolio.com plc v Rodney Fitch & Co Ltd* [2000] IP & T 1375 at 1382: the court noted that on the facts of the case, it “need not decide” whether there was originality in a “purely representational photograph of a two-dimensional object such as a photograph or a painting”.

135 *Antiquesportfolio.com plc v Rodney Fitch & Co Ltd* [2000] IP & T 1375 at 1382. The court found that:

... the instant photographs appear to have been taken with a view to exhibiting particular qualities, including the colour (in the case of some items), their features (eg, the glaze in pottery) and, in the case of almost all the items, the details. It may well be that, in those circumstances, some degree of skill was involved in the lighting, angling and judging the positioning.

136 *Antiquesportfolio.com plc v Rodney Fitch & Co Ltd* [2000] IP & T 1375 at 1382. This category of photographs is further discussed at paras 50–68 below.

137 [2012] EWPC 1. Although this was a post-*Infopaq* decision in which the court applied the “intellectual creation” test, the case remains relevant to traditional common law in UK in so far as Colin Birss J did not think that there was a difference between the two tests and used the terms “skill and labour” and “intellectual creation” interchangeably: see [27], [31], [34] and [53].

of Copyright¹³⁸ (“*Laddie*”) that there are three aspects in which there is room for originality in photography, namely: (a) residing in specialities of angle of shot, light and shade, exposure and effects achieved with filters, developing techniques and so on; (b) residing in the creation of the scene to be photographed; and (c) deriving from being in the right place at the right time.¹³⁹ The court also suggested a potential fourth aspect in which a photograph might be original – digital manipulations to the photograph after it was taken.¹⁴⁰

41 The second category relates to staging the tableau, which has already been discussed. In respect of the first category, it has been suggested that unlike the *Copinger* treatise cited in *Antiquesportfolio*, for *Laddie* it is not merely the *exercise* of skill, judgment or labour which makes a photograph original; rather, it is the “effects achieved” on the final image which are significant.¹⁴¹ The full passage in *Laddie* does appear to emphasise the importance of the effect on the visual image: “in such manner does one photograph of Westminster Abbey differ from another”,¹⁴² and such a conclusion would appear to align with the US approach. Yet, the position advocated by *Laddie* may not be as clear as suggested, because elsewhere the authors submit that “a photographer who carefully took a photograph of an original painting might get a copyright”.¹⁴³ Be that as it may, the *Temple Island* court seemed to adopt

138 Michael Tappin *et al*, *Laddie, Prescott and Vitoria: The Modern Law of Copyright* vol 1 (LexisNexis, 5th Ed, 2018).

139 *Temple Island Collections Ltd v New English Teas Ltd* [2012] EWPC 1 at [22].

140 *Temple Island Collections Ltd v New English Teas Ltd* [2012] EWPC 1 at [28]–[29]. This was only suggested by way of *obiter dicta* as the court was not required to decide the point, though it qualified that this would only be the case if the work continues to qualify as a photograph within the definition in s 4 of the UK Copyright, Designs and Patents Act 1988 (c 48) (*ie*, a recording of light). The court thought that certain manipulations made to the photograph in that case (*ie*, strengthening the colour of the bus; turning the rest of the photograph monochrome; removing certain persons in the foreground; stretching the photograph to change the perspective) did not prevent the image from being a photograph as it was “still ultimately a recording of light”, though it expressed reservations over the cropping out of the sky and replacing the same with a white background. Nonetheless, nothing turned on this point as it was not extensively argued.

141 Justin Hughes, “The Photographer’s Copyright – Photograph as Art, Photograph as Database” (2012) 25 Harv JL & Tech 339 at 409: “the *Laddie* treatise states the correct test: it is not the ‘means of filters, developing techniques, etc.’, but rather the actual effects on the visual image – the ‘effects achieved.’”

142 Michael Tappin *et al*, *Laddie, Prescott and Vitoria: The Modern Law of Copyright* vol 1 (LexisNexis, 5th Ed, 2018) at para 4.66.

143 Michael Tappin *et al*, *Laddie, Prescott and Vitoria: The Modern Law of Copyright* vol 1 (LexisNexis, 5th Ed, 2018) at para 4.44. This statement is made in apparent disagreement with the opinion of the US court in the decisions in *Bridgeman Art Library Ltd v Corel Corp* 25 F Supp 2d 421 (SDNY, 1998); 36 F Supp 2d 191 (SDNY, 1999), which held that, applying UK law, photographic replicas of pre-existing works
(*cont’d on the next page*)

the former view, referring to this category as being the same as that in an Austrian decision cited to it.¹⁴⁴ That decision held that photographs were original where “the arrangements used cause distinctiveness”,¹⁴⁵ and that this would be so if “another photographer may have arranged the photograph differently”.¹⁴⁶

42 The third limb of *Laddie*'s test, however, presents some challenges and seems to go further than the US decisions.¹⁴⁷ The full text in *Laddie* states, that under this limb:¹⁴⁸

... a person may create a worthwhile photograph by being at the right place at the right time. Here his merit consists of capturing and recording a scene unlikely to recur, eg a battle between an elephant and a tiger, to adopt an illustration of *Romer LJ*, but the capture of a less dramatic subject, such as a street scene, might also be relevant. He may capture a scene worth preserving because he made a special effort to go and find it, such as where a news photographer covers a story, or he may be there and press the trigger at just the right time by sheer good fortune or by selecting just the right moment to do so; but it is submitted that this makes no difference, for the law would be unrealistic if it tried to exclude this element of serendipity.

43 We have already seen that temporal selection is recognised in both US and UK jurisprudence as a factor contributing to photographic originality.¹⁴⁹ This would be especially so for live objects capable of

lacked originality. See paras 50 and 54 below. The authors of *Laddie, Prescott and Vitoria: The Modern Law of Copyright* vol 1 (LexisNexis, 5th Ed, 2018) also argue that the proposition laid down by the Privy Council in *Interlego AG v Tyco Industries Inc* [1989] AC 217 – that only skill and labour which is “visually significant” is relevant for the purposes of assessing the originality of an artistic work – is too wide and should be confined to relatively simple works. See paras 64 and 65 below.

144 *O (Peter) v F KG* [2006] ECDR 9.

145 *Temple Island Collections Ltd v New English Teas Ltd* [2012] EWPC 1 at [19].

146 *Temple Island Collections Ltd v New English Teas Ltd* [2012] EWPC 1 at [19].

147 Despite the three limbs from Michael Tappin *et al*, *Laddie, Prescott and Vitoria: The Modern Law of Copyright* vol 1 (LexisNexis, 5th Ed, 2018) being cited with approval in *Mannion v Coors Brewing Co* 377 F Supp 2d 444 at 451–454 (SDNY, 2006) with the court opining that UK copyright law was “similar to [US copyright law] with respect to the requirement of originality”, it appears that the court there might not have considered the full implications of the third limb, as will be seen at paras 43–48 below. Hughes rightly refers to this limb as posing a “vexing problem”: Justin Hughes, “The Photographer’s Copyright – Photograph as Art, Photograph as Database” (2012) 25 *Harv JL & Tech* 339 at 402.

148 Michael Tappin *et al*, *Laddie, Prescott and Vitoria: The Modern Law of Copyright* vol 1 (LexisNexis, 5th Ed, 2018) at para 4.66.

149 See para 29 above on US law; see also, eg. the US decisions of *Pagano v Charles Beseler Co* 234 F 963 (SDNY, 1916); *Gentieu v John Muller & Co* 712 F Supp 740 (WD Mo, 1989); and *Kisch v Ammirati & Puris Inc* 657 F Supp 380 (SDNY, 1987) which refer to the choice of the “timing” of the shot as one of the elements which may produce an original photograph, and *Mannion v Coors Brewing Co* 377 F Supp (cont'd on the next page)

independent movement – a photograph of a crowd at Shibuya Crossing, for example, requires the photographer to select the precise moment to press the shutter, producing the particular selection and arrangement of the objects within the frame.¹⁵⁰ This would also be true of any visually perceptible difference in the composition of the photograph which is a function of time, such as the angle, brightness or colour of natural lighting.

44 But the phrase “being at the right place at the right time” is capable of a wider construction, because *Laddie* posits that photographs merit originality not by mere temporal selection of the photographer but by their “capturing and recording a scene unlikely to recur”.¹⁵¹ The passage first suggests that originality may reside in photographs captured because the photographer “made a special effort to go and find it”. Take for example, one photographer who spent over 4,200 hours and 720,000 shots before capturing a “perfect shot” of a kingfisher executing a “flawless dive” into the water without the appearance of a ripple.¹⁵² Though such a photograph is likely to be protected under US law, the basis for protection may differ from that suggested by *Laddie*. Following *Rentmeester*, such a photograph would be original by virtue of the selection and arrangement of the elements within the frame – including through temporal selection, as the photographer must capture the precise moment to produce the desired photograph. The expenditure of a significant amount of time and effort enables the photographer to make that particular selection and arrangement, but is not otherwise relevant to its originality.¹⁵³ In this regard, a parallel may be drawn with “preparatory efforts” exerted in the production of a factual compilation, such as the

2d 444 (SDNY, 2006) where the US district court approved of the three limbs in Michael Tappin *et al*, *Laddie, Prescott and Vitoria: The Modern Law of Copyright* vol 1 (LexisNexis, 5th Ed, 2018), holding (at 452–453) that temporal selection may result in a photograph being original. On UK law, see also *Antiquesportfolio.com plc v Rodney Fitch & Co Ltd* [2000] IP & T 1375 at 1381–1382 where the court held that “determination of the precise time when the photograph is to be taken” may result in originality, and *Bauman v Fussell* [1978] RPC 485 at 490 where it was held that copyright subsisted in a photograph taken by a photographer who “waited for the moment to take the photograph when the birds were in the position he wanted them to be, and his photograph produces the position”.

- 150 Justin Hughes, “The Photographer’s Copyright – Photograph as Art, Photograph as Database” (2012) 25 Harv JL & Tech 339 at 404.
- 151 Michael Tappin *et al*, *Laddie, Prescott and Vitoria: The Modern Law of Copyright* vol 1 (LexisNexis, 5th Ed, 2018) at para 4.66.
- 152 Colin McNeill, “Scots Dad Takes 720,000 photos over Six Years to Get Perfect Kingfisher Picture for Late Grandfather” *The Herald* (24 November 2015).
- 153 Thus, when the court in *Mannion v Coors Brewing Co* 377 F Supp 2d 444 at 453 (SDNY, 2006) referred to “Catch of the Day” (a photograph depicting a salmon appearing to leap into the gaping mouth of a brown bear atop a waterfall) as an example of a photograph “strikingly original in timing”, it did not locate originality
(*cont’d on the next page*)

“labour involved in fact finding, fact creation and fact collection”, which are irrelevant to originality under the creativity view.¹⁵⁴ On the other hand, while such temporal selection is also relevant to originality under UK law, the *expenditure* of time and effort to produce the photograph *in itself* contributes to originality.¹⁵⁵

45 Yet, this alone is not what *Laddie* seems to refer to as the justification for conferring originality under this limb, for the quote suggests that even without the photographer consciously making such a selection or arrangement nor expending time or effort in finding the shot, the simple capturing of a scene unlikely to recur may result in originality. Imagine a person who stops along the Great Ocean Road intending to photograph the Twelve Apostles. Years of erosion causes a stack to collapse precisely when he presses the shutter, and he captures it as it crumbles into the ocean. It might seem odd to conclude that originality resides in the arrangement of the rock formation in the photograph owing to the temporal *selection* of the photographer capturing it as it crumbled, for that moment was not *selected* to capture that arrangement.¹⁵⁶ Nor is sweat necessarily involved in the production of the photograph in this illustration. One might therefore query whether this limb is consistent with prevailing notions of originality.¹⁵⁷

46 The flip side of the coin to serendipity is intentionality, and it may perhaps be helpful to view the question in this way. *Laddie*'s third limb may be seen as positing that originality may inhere in the depiction of a scene unlikely to recur, even if that depiction was not intentionally selected by the photographer but resulted from “sheer good fortune”.

in the effort that went into producing the photograph despite acknowledging that many have tried with varying degrees of success to produce a similar photograph.

154 *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2016] 2 SLR 165 at [76], affirmed on appeal: see *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2017] 2 SLR 185 at [23]; see also *Asia Pacific Publishing Pte Ltd v Pioneers & Leaders (Publishers) Pte Ltd* [2011] 4 SLR 381 at [37].

155 It will be recalled that the court in *Antiquesportfolio.com plc v Rodney Fitch & Co Ltd* [2000] IP & T 1375 held that for originality to subsist in a photograph, the photographer need only “demonstrate that he expended some *small degree of time, skill and labour* in producing the photograph”: see para 37 above; see also *Bauman v Fussell* [1978] RPC 485 at 492–493 where Romer LJ (dissenting) was clearly of this view.

156 Indeed, it is acknowledged in Michael Tappin *et al*, *Laddie, Prescott and Vitoria: The Modern Law of Copyright* vol 1 (LexisNexis, 5th Ed, 2018) that in this case the trigger is pressed at the right time “by sheer good fortune” as opposed to the photographer “selecting just the right moment to do so”: see para 42 above.

157 See Justin Hughes, “The Photographer’s Copyright – Photograph as Art, Photograph as Database” (2012) 25 Harv JL & Tech 339 at 411 where Hughes questions: “Are these descriptions of originality or are they descriptions of hard work or good luck that we believe we should reward?”

This sits uncomfortably with the creativity view because there we often refer to originality residing in the *choices* made by the author; and where fact-based works are concerned, in his *selection* and *arrangement* of facts. These phrases presuppose authorial intention – indeed, it might seem a contradiction of terms to speak of an unintentional “choice”, “selection” or “arrangement”.¹⁵⁸ As Christopher Buccafusco explains:¹⁵⁹

Authorship is an act – of expressing, representing, or arranging – and it is the act that is potentially copyrightable. In this sense, the only way that photographs are copyrightable is through what Judge Kaplan called ‘rendition’ – *how* something is depicted, not *what* is depicted. Moreover, this is the only way in which any work is copyrightable.

Accordingly, we need to inquire into the manner in which the uncopyrightable elements of the photograph are composed. We need to understand the relationship that the photographer created between the objects in the image ... and how they were depicted ... This, and no more, is the extent of the photographer’s authorship.

158 See Justin Hughes, “The Personality Interest of Artists and Inventors in Intellectual Property” (1998) 16(1) *Cardozo Arts & Ent LJ* 81 at 162 (“It would be an understatement to say that protection of inadvertent originality is a nettlesome problem for the personal expression paradigm. If the artist did not *intend* to badly distort the woman’s nose, how can such distortion be his *personal expression*?” [emphasis in original; other emphasis added]); *Chamberlin v Uris Sales Corp* 150 F 2d 512 at 513 (2nd Cir, 1945) (“If one made an unintentional error in copying which he perceived to add distinctiveness to the product, he might perhaps obtain a valid copyright on his copy, although the question would then arise whether originality is precluded by lack of intention.”); Daniel Gervais, “*Feist* Goes Global: A Comparative Analysis of the Notion of Originality in Copyright Law” (2002) 49 *J Copyright Soc’y USA* 949 at 976–977 (“a creative choice is one made by the author ... A conscious, human choice must have been made, even though it may be irrational.”); cf *Alfred Bell & Co v Catalda Fine Arts Inc* 191 F 2d 99 at 105 (2nd Cir, 1951) (“*Alfred Bell*”), where it has been held that “[a] copyist’s bad eyesight or defective musculature, or a shock caused by a clap of thunder, may yield sufficiently distinguishable variations. Having hit upon such a variation unintentionally, the ‘author’ may adopt it as his and copyright it”. See also Jane C Ginsburg, “The Concept of Authorship in Comparative Copyright Law” (2003) 52 *DePaul L Rev* 1063 at 1086: “a requirement that the ‘author’ have intended to create the resulting work does not reflect the positive law ... Admittedly, the author accomplishes an act of will when she ‘adopts’ the accidental effect as her own, but I think a creative act occurs at the image’s genesis, not only at its subsequent acceptance.” Although Ginsburg endorses the *Alfred Bell* ruling, her original point relates to the irrelevance of an intention to be creative, rather than the intentionality of the choice, selection or arrangement made by the putative author. The author need not intend to be creative so long as what he did was actually creative – as Ginsburg observes, it is the “intellectual contribution” of the author, as opposed to whether he intended to be creative, which is relevant (at 1085–1086).

159 Christopher Buccafusco, “A Theory of Copyright Authorship” (2016) 102(5) *Va L Rev* 1229 at 1286–1287.

47 Accordingly, if the photographer does not “create” the relationship between the objects in the image, that relationship may not be original to him.¹⁶⁰ Photographs capturing an independent reality, then, may be viewed as generally less original under the creativity view than those involving the staging of the tableau, in so far as in the former category, some relationships between the depicted objects may not be the intentional choices, selections or arrangements of the photographer. In contrast, the photographer who stages the tableau (presumably) has every opportunity to consciously impact all aspects of the resulting photograph. Undoubtedly, it will be a factual determination to be made in each case.¹⁶¹ Returning, for example, to the photograph of a crowd at Shibuya Crossing: the photographer waits for the pedestrian lights to turn green, and when the crowd is in a desirable position, presses the shutter. Does the photographer *intend* the precise position and other details of each of the thousand or so persons in the photograph? That much is unlikely, although the fact that the photographer could and would have anticipated the crowd’s crossing, and therefore waited for a particular moment to press the shutter, would demonstrate some intentional selections and arrangements on a macro level. Or, in photographing the kingfisher, did the photographer, in attempting to capture the precise moment, intend all those other elements such as the relative position of the bird within the frame, the arrangement of the background elements and colour hues? The fact that much effort went into the production of that photograph may by itself contribute to originality under the sweat view, but under the creativity view, it might demonstrate that the captured position of the bird and stillness of the water were *intended*, and therefore formed part of the photographer’s selection and arrangement. Hughes appears to admit this when stating that “when the photographer captures

160 Despite the use of the word “create”, this does not mean that only photographs involving staged tableaus are copyrightable – a photographer who chances upon an image in nature and decides to capture it engages in an authorial, intentional act of selecting and arranging the objects in the photograph: see Michael Tappin *et al*, *Laddie, Prescott and Vitoria: The Modern Law of Copyright* vol 1 (LexisNexis, 5th Ed, 2018) at para 4.17, fn 4: “It is suggested that the process of waiting for the right picture to come up, and then recognising it when it does, is more exacting than it sounds.” This situation is quite unlike one where the photographer who, by pressing the shutter at a certain time, captures an image which is unintended. Indeed, despite requiring photographers to “create” the relationships between the depicted objects before originality may subsist, Christopher Buccafusco does not attempt to deny originality to photographs without staged tableaus – the phrase “rendition” is a reference to the first limb in the test in Michael Tappin *et al*, *Laddie, Prescott and Vitoria: The Modern Law of Copyright* vol 1 (LexisNexis, 5th Ed, 2018), as was described by the court in *Mannion v Coors Brewing Co* 377 F Supp 2d 444 (SDNY, 2006).

161 See, *eg*, *Mannion v Coors Brewing Co* 377 F Supp 2d 444 at 451 (SDNY, 2006), where the court observed that “the nature and extent of a photograph’s protection differs depending on what makes that photograph original”.

a reality that is clearly the expression of another person's judgments or personality, the apparent originality of the photograph is reduced".¹⁶² This might be true, yet it is not so limited. The apparent originality of such photographs is reduced, but this is not simply attributable to an aspect of the captured reality being someone else's expression. Rather, it is because an aspect of that reality is *not the photographer's expression*; this applies to any photograph capturing an independent reality – a reality that, unlike staged tableaux, may not fully (or at all) lie within the photographer's control.¹⁶³

48 *Laddie's* third limb therefore appears to extend copyright protection of photographs beyond the originality doctrines under the sweat or creativity views. Reference has been made to the prevalent view of copyright in the UK as a tool primarily for the protection of reasonable investments. *Laddie's* third limb stretches originality for a different reason – that of “mistak[ing] beauty for originality”.¹⁶⁴ This confusion is attributable to the verisimilitude of photographs, which “can ‘give the impression of artistic creations’ without the photographer making any deliberate effort to be creative”.¹⁶⁵ Given that the issue was not explored in detail in *Temple Island*, it remains to be seen whether the fuller implications of *Laddie's* third limb will be endorsed in the UK.

V. Photographic replicas of existing works

49 The author will now turn to consider a category of photographs for which debate over their originality has generated considerable controversy. Because photographs embody a certain verisimilitude to the subject matter before the camera, photographic technology allows the creation of two-dimensional replicas of existing artistic works (such as paintings or other photographs) with almost perfect fidelity.¹⁶⁶ Such

162 Justin Hughes, “The Photographer’s Copyright – Photograph as Art, Photograph as Database” (2012) 25 Harv JL & Tech 339 at 416.

163 Cf Justin Hughes, who argues that a “discovered” photograph that is part of a photographer’s “intentional program” may qualify as a personal expression of the photographer, so long as there is an initial intent to engage in the activity or program: see Justin Hughes, “The Photographer’s Copyright – Photograph as Art, Photograph as Database” (2012) 25 Harv JL & Tech 339 at 417–419.

164 Justin Hughes, “The Photographer’s Copyright – Photograph as Art, Photograph as Database” (2012) 25 Harv JL & Tech 339 at 400.

165 See Justin Hughes, “The Photographer’s Copyright – Photograph as Art, Photograph as Database” (2012) 25 Harv JL & Tech 339 at 401 and fn 296 therein.

166 See *Copinger and Skone James on Copyright* vol 1 (Gillian Davies, Nicholas Caddick & Gwilym Harbottle eds) (Sweet & Maxwell, 17th Ed, 2016) at para 3-235: “Photographs, which in one sense will always be a copy of what is before the camera lens, and which may more specifically be a copy of an existing artistic work, create their own problems as regards originality”; see also Kevin Garnett QC, “Copyright
(cont’d on the next page)

photographs – which are derivative works – are commonplace. Museums, for example, commonly commission photographic reproductions of existing paintings for printing on memorabilia, catalogues or other paraphernalia. As will be seen, the different originality doctrines in UK and US have resulted in divergent approaches here as well.

A. *Derivative works under US law*

50 The issue of originality in photographic replicas came before the US courts in the two decisions in *Bridgeman Art Library Ltd v Corel Corp*.¹⁶⁷ Bridgeman maintained a library of high-quality photographic reproductions of paintings which had fallen out of copyright. A considerable amount of technical skill, labour and judgment was employed by the photographers to create precise photographic reproductions of such paintings “without any avoidable addition, alteration or transformation”.¹⁶⁸ It alleged that the defendant infringed its copyright in these reproductions. Interestingly, in the first decision¹⁶⁹ (“*Bridgeman I*”), Kaplan J determined that the issue of copyright subsistence was a matter of UK law,¹⁷⁰ and held that copyright did not subsist in faithful photographic reproductions of existing paintings under UK law because they lacked sufficient originality.¹⁷¹ Kaplan J further noted that he would have arrived at the same conclusion had US law applied.¹⁷²

51 In *Bridgeman II*, Kaplan J ruled that US law applied to the issue of copyright subsistence, but in keeping with his earlier decision, held that copyright did not subsist in Bridgeman’s photographic reproductions. Firstly, he referred to *Burrow-Giles*, which left open the matter of whether the “ordinary production of a photograph” was protected by copyright,¹⁷³ noting that although it was suggested in *Jewelers’ Circular Pub Co v*

in Photographs” (2000) 22(5) EIPR 229 at 229: “The problem [of photographic originality] arises in its most stark form in the case of a photograph whose whole purpose is to reproduce as faithfully as possible another work, such as a painting or even another photograph.”

167 25 F Supp 2d 421 (SDNY, 1998); 36 F Supp 2d 191 (SDNY, 1999).

168 *Bridgeman Art Library Ltd v Corel Corp* 25 F Supp 2d 421 at 426 (SDNY, 1998).

169 *Bridgeman Art Library Ltd v Corel Corp* 25 F Supp 2d 421 (SDNY, 1998).

170 *Bridgeman Art Library Ltd v Corel Corp* 25 F Supp 2d 421 at 425–426 (SDNY, 1998).

171 *Bridgeman Art Library Ltd v Corel Corp* 25 F Supp 2d 421 at 426–427 (SDNY, 1998); though apparently without the adduction of expert evidence as to UK law, and chiefly relying on *Interlego AG v Tyco Industries Inc* [1989] AC 217 without having cited *Walter v Lane* [1900] AC 539. This is discussed further at paras 54–68 below. For an analysis of the decisions as to UK law, see Kevin Garnett QC, “Copyright in Photographs” (2000) 22(5) EIPR 229.

172 *Bridgeman Art Library Ltd v Corel Corp* 25 F Supp 2d 421 at fn 47 (SDNY, 1998).

173 *Bridgeman Art Library Ltd v Corel Corp* 36 F Supp 2d 191 at 195 (SDNY, 1999).

*Keystone Pub Co*¹⁷⁴ that all photographs were protected regardless of originality,¹⁷⁵ that view had since been rejected in *Feist*.¹⁷⁶ Next, the court referred to *Nimmer*, which supports the view that there is no originality “where a photograph of a photograph or other printed matter is made that amounts to nothing more than slavish copying”.¹⁷⁷ Finally, the court considered that under US law, a derivative work is original only if it contains a “distinguishable variation” from the underlying work – requiring “something beyond technical skill” and “not supplied by a change of medium”.¹⁷⁸ It held that:¹⁷⁹

Elements of originality ... may include posing the subjects, lighting, angle, selection of film and camera, evoking the desired expression, and almost any other variant involved. But ‘slavish copying’, although doubtless requiring technical skill and effort, does not qualify. As the Supreme Court indicated in *Feist*, ‘sweat of the brow’ alone is not the ‘creative spark’ which is the *sine qua non* of originality.

As the whole point of *Bridgeman’s* exercise was “to produce the underlying works with absolute fidelity”, the court concluded that copyright did not subsist in *Bridgeman’s* photographic reproductions.¹⁸⁰

52 A similar conclusion was reached in *Simon v Birraporetti’s Restaurants Inc.*¹⁸¹ There, the court cited the earlier referenced passage

174 274 F 932 (SDNY, 1921), affirmed in *Jewelers’ Circular Publishing Co v Keystone Publishing Co* 281 F 83 (2nd Cir, 1992).

175 *Jewelers’ Circular Publishing Co v Keystone Publishing Co* 274 F 932 at 934 (SDNY, 1921).

176 *Feist Publications Inc v Rural Telephone Service Co Inc* 499 US 340 (1991).

177 *Bridgeman Art Library Ltd v Corel Corp* 36 F Supp 2d 191 at 196 (SDNY, 1999).

178 *Bridgeman Art Library Ltd v Corel Corp* 36 F Supp 2d 191 at 196 (SDNY, 1999), referring to *L Batlin & Son Inc v Snyder* 536 F 2d 486 at 491 (2nd Cir, 1976). See also Colin T Cameron, “In Defiance of *Bridgeman*: Claiming Copyright in Photographic Reproductions of Public Domain Works” 15 *Tex Intell Prop LJ* 31 at 36: “Copyright in a derivative work subsists in the original expression added by the derivative work’s author. Should the author simply reproduce the preexisting work without recasting, transforming, or adapting it, then he has not added any expression and does not possess a valid copyright.”

179 *Bridgeman Art Library Ltd v Corel Corp* 36 F Supp 2d 191 at 196–197 (SDNY, 1999).

180 *Bridgeman Art Library Ltd v Corel Corp* 36 F Supp 2d 191 at 197 (SDNY, 1999); See also *Mannion v Coors Brewing Co* 377 F Supp 2d 444 at 452 (SDNY, 2006), agreeing with *Bridgeman Art Library Ltd v Corel Corp* 36 F Supp 2d 191 (SDNY, 1999): “[I]n *Bridgeman Art Library*, the goal was to reproduce exactly other works. The photographs were entirely unoriginal in the rendition ... Unless a photograph replicates another work with total or near-total fidelity, it will be at least somewhat original in the rendition.”

181 720 F Supp 85 (SD Tex, 1989).

from *Nimmer* on the situations in which a photograph will not be original:¹⁸²

There is no originality ‘where a photograph of a photograph or other printed matter is made which amounts to nothing more than a slavish copying.’ ... This rationale applies, for example, to any mechanical photocopying such as ‘photostat, microfilm, thermofax, and Xerox.’ ... ‘No originality can be claimed in making an additional print from a photographic negative,’ and, therefore, when the same effect is achieved by photographing a print rather than reprinting a negative, ‘there should be no finding of greater originality.’

53 These conclusions are consistent with the *Rentmeester* approach towards photographic originality. A photograph of an existing photograph or painting which seeks to faithfully replicate the underlying work involves no creative choices. Indeed, although a photographer may be required to select the appropriate lens, lighting and other camera-related settings to produce such photographs, these do not qualify as original selections, for they are made to enable the faithful replication of the underlying work, and therefore “dictated by convention or subject matter”.¹⁸³ Moreover, because what counts towards originality under the

182 *Simon v Birraporetti’s Restaurants Inc* 720 F Supp 85 at 88 (SD Tex, 1989); see also Eric J Schwartz & David Nimmer, “United States” in *International Copyright Law and Practice* (Paul Edward Geller and Lionel Bently eds) (LexisNexis, 2015) at § 2[2][e][ii] (“Originality is lacking, however, when a photograph exactly reproduces an earlier photograph, as by photocopying or retakes the same shot as does a prior photograph”) and *Alfred Bell & Co v Catalda Fine Arts Inc* 191 F 2d 99 at 104–105 (2nd Cir, 1951), holding that mezzotints of existing paintings were original on the basis that they “were not intended to, and did not, imitate the paintings they reproduced”.

183 See also Daniel Gervais, “*Feist* Goes Global: A Comparative Analysis of the Notion of Originality in Copyright Law” (2002) 49 J Copyright Soc’y USA 949 at 956 (“a photographer trying to take a technically perfect picture is not making creative choices”); Justin Hughes, “The Photographer’s Copyright – Photograph as Art, Photograph as Database” (2012) 25 Harv JL & Tech 339 at 374 (“where the content of the photograph has an independent reality, and the photographer seeks only to achieve and does in fact achieve an accurate representation of that independent reality, there is a good chance that the photograph has no copyright protection at all”); Michael Tappin *et al*, *Laddie, Prescott and Vitoria: The Modern Law of Copyright* vol 1 (LexisNexis, 5th Ed, 2018) at para 3.9:

This exemplifies the convergence around a test that focuses on the extent to which there are options open to an originator as contrasted with ‘mechanical’ or determined decisions. Again, one aspect of copyright protection that this analysis cannot easily grapple with is works (such as accurate transcriptions) whose very value lies not in the choice of selection or organisation of material but in their verisimilitude to and the slavishness of their reproduction.

Although some commentators have taken the contrary view that originality may inhere in faithful photographic reproductions of existing photographs or paintings, it is submitted that these arguments are unpersuasive: see Justin Hughes, “The Photographer’s Copyright – Photograph as Art, Photograph as Database” (2012) 25 Harv JL & Tech 339 at 376, fn 190 and the accompanying text. For example, Kogan suggests that such photographs embody creativity given the possibility
(*cont’d on the next page*)

creativity view are the effects produced – the features of the work – and not the mere fact that decisions were made by the photographer, the court rightly held that technical skill in producing the photograph was irrelevant.¹⁸⁴

B. UK law on photographic replicas and derivative works

54 In contrast, the UK common law position on the originality of photographic replicas is more uncertain, given the absence of authority squarely addressing the issue.¹⁸⁵ *Bridgeman I* is not binding on UK courts, and the correctness of the decision as to UK law has been the subject of debate. Indeed, the authors of *Copinger* – whose views were adopted by the court in *Antiquesportfolio* – suggest that photographic replicas

of “distinguishable variations” between the original work and the photographic reproduction as well as between two “exact” reproductions, and further that new techniques have resulted in the production of improved images: see Terry S Kogan, “Photographic Reproductions, Copyright and the Slavish Copy” (2012) 35 Colum JL & Arts 445 at 483–487. It is, however, submitted that minor variations are insufficient to justify originality in so far as such reproductions are intended to, and do, replicate the underlying work: see, eg, *ATC Distribution Group Inc v Whatever It Takes Transmissions & Parts Inc* 402 F 3d 700 at 712 (6th Cir, 2005), holding that hand-drawn sketches copied from photographs “intended to be as accurate as possible in reproducing the parts shown in the photographs on which they were based” fell “far short of the ‘substantial variation’ required to justify copyright protection”, and were “a form of slavish copying that is the antithesis of originality”. Variations between reproductions attributable to technological improvements are similarly uncreative. Indeed, Kaplan J acknowledged the possibility of such variations but seemingly considered them immaterial – originality was denied on the basis that the photograph reproduced the underlying work “as precisely as technology permits”: *Bridgeman Art Library Ltd v Corel Corp* 36 F Supp 2d 191 at 198 (SDNY, 1999). While Kogan further posits that the choice of photographing the head-on perspective of the existing work is – despite being conventional – a creative choice, since other perspectives could have instead been chosen, this is entirely typical and would fail to meet the minimal degree of creativity required by *Feist Publications Inc v Rural Telephone Service Co Inc* 499 US 340 (1991). Additionally, such a representation would be deemed unoriginal under the merger doctrine: see *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2016] 2 SLR 165 at [187].

184 *Bridgeman Art Library Ltd v Corel Corp* 36 F Supp 2d 191 at 196–197 (SDNY, 1999).

185 Kevin Garnett QC, “Copyright in Photographs” (2000) 22(5) EIPR 229 at 229:

One question which has remained largely unexplored by case law, however, is how the originality requirement of UK copyright law is to be interpreted in the case of photographs, given that every photograph is more or less a copy of something else. The problem arises in its most stark form in the case of a photograph whose whole purpose is to reproduce as faithfully as possible another work, such as a painting or even another photograph.

See also R Deazley, “Photographing Paintings in the Public Domain: A Response to Garnett” (2001) 23(4) EIPR 179.

of existing works are original under UK common law,¹⁸⁶ and it has also been argued that such photographs qualify as original, given that their production involves elements falling within the first limb of *Laddie's* test cited in *Temple Island*.¹⁸⁷ Surveying the relevant decisions as well as those concerning derivative works, it is posited that UK courts demonstrate a continued reliance on “sweat of the brow” justifications to determine originality, and other policy justifications extrinsic to both creativity and sweat may also be relevant to the inquiry.

55 The 1869 decision of *Graves' Case*¹⁸⁸ (“*Graves*”) held that a photograph taken of an engraving of a picture could be original. While it was argued that a photograph of a picture could not constitute an “original photograph”, the court rejected this argument on the basis that “[a]ll photographs are copies of some object”.¹⁸⁹ It added that “although it is unlawful to copy a photograph or the negative, it is permitted to copy the subject matter of the photograph by taking another photograph”.¹⁹⁰ In contrast, the court in *The Reject Shop plc v Robert Manners*¹⁹¹ (“*Reject Shop*”) held that an enlarged image produced by photocopying a drawing was unoriginal. It has been suggested that the key to reconciling these cases lies in the state of technology of photography in *Graves'*. While the judgment offers little elaboration, Kevin Garnett posits that *Graves'*:¹⁹²

186 See para 38 above. Although in that case Neuberger J expressly refused to comment on the issue nor on the correctness of *Bridgeman Art Library Ltd v Corel Corp* 25 F Supp 2d 421 (SDNY, 1998) as to UK law, it being unnecessary to decide the point. Indeed, one of the former editors of *Copinger and Skone James on Copyright* vol 1 (Gillian Davies, Nicholas Caddick & Gwilym Harbottle eds) (Sweet & Maxwell, 17th Ed, 2016) argues that Kaplan J was wrong as to UK law: see Kevin Garnett QC, “Copyright in Photographs” (2000) 22(5) EIPR 229.

187 Kevin Garnett QC, “Copyright in Photographs” (2000) 22(5) EIPR 229 at 235:
... the first passage cited from *Laddie* arguably supports *Bridgeman's* position, for its photographs will all have been ones whose ‘originality [did] not depend on creation of the scene or object to be photographed or anything remarkable about its capture, and which resides in such specialities as ... light and shade, exposure, effects achieved by means of filters, developing techniques *etc* ...’

188 (1869) LP 4 QB 715.

189 *Graves' Case* (1869) LP 4 QB 715 at 723.

190 *Graves' Case* (1869) LP 4 QB 715 at 723.

191 [1995] FSR 870.

192 Kevin Garnett QC, “Copyright in Photographs” (2000) 22(5) EIPR 229 at 231. See also *Copinger and Skone James on Copyright* vol 1 (Gillian Davies, Nicholas Caddick & Gwilym Harbottle eds) (Sweet & Maxwell, 17th Ed, 2016) at para 3-261:

The test of originality may be satisfied by little more than the opportunistic pointing of the camera and the pressing of the shutter button and there seems no reason of principle why there should be any distinction between the photograph which is the result of such a process and a photograph which is intended to reproduce a work of art, such as a painting or another photograph.

... can be regarded as authority for the proposition, not that all photographs must be 'original', but that photographs which do require skill and labour in their taking, even if only technical skill applied to achieve a quality reproduction, do satisfy the originality test.

Likewise, *Laddie* suggests that “presumably some level of skill was required to take a photograph of that kind in those days. A mere Xerox copy would not qualify as an original work”.¹⁹³ Conversely, in *Reject Shop*, the process by which the photocopy was produced was “wholly mechanical”, involving no “relevant skill and labour”.¹⁹⁴

56 In arriving at its decision, the court in *Reject Shop* relied on the Privy Council’s decision in *Interlego AG v Tyco Industries Inc*¹⁹⁵ (“*Interlego*”), which concerned derivative works. There has, however, been significant judicial disagreement under UK common law on the *type* of skill, labour or judgment which is relevant to originality in derivative works.

57 The famous decision of the House of Lords in *Walter v Lane*¹⁹⁶ over a century ago exemplifies the “sweat of the brow” approach and continues to generate debate today, remaining the starting point for copyright in derivative works under UK law. There, skilled shorthand writers employed by *The Times* took down verbatim the speeches of Lord Rosebery, which reports were copied by the defendants. The question of copyright subsistence in the reports turned on whether the reporters could be considered the “authors” of their reports (pertinently, Lord Rosebery did not claim copyright in the speeches). The reporters demonstrated considerable skill in their ability to follow and record the live speeches accurately – described by the court as an “art requiring considerable training, and [which] does not come within the knowledge of ordinary persons”.¹⁹⁷ Notably, however, such skill did not allow for the exercise of creative choices – the aim (and result) of the reporters’ efforts was to produce accurate reports.

58 Despite recognising the skill and labour involved in accurate stenography, the Court of Appeal held that “an accurate report is not an original composition, nor the reporter of a speech the author of what

193 Michael Tappin *et al*, *Laddie, Prescott and Vitoria: The Modern Law of Copyright* vol 1 (LexisNexis, 5th Ed, 2018) at 4.42; see also para 4.66, fn 3: “[T]here may have been special skill or labour in setting up the equipment to get a good photograph, especially with the rather primitive materials available in those days.”

194 *The Reject Shop plc v Robert Manners* [1995] FSR 870 at 876.

195 [1989] AC 217.

196 [1900] AC 539.

197 *Walter v Lane* [1900] AC 539 at 554.

he reports”.¹⁹⁸ In contrast, if the reporter “gives the substance of [the speech] in his own language” and the “expression of them is his own”, the Court of Appeal would have held that the report was original and deserving of copyright.¹⁹⁹ On appeal, the House of Lords reversed the decision and held that copyright subsisted in the reports. It decided that while Lord Rosebery was the author of the speech, the reporters were the authors of their reports, owing to the skill and effort expended by them.²⁰⁰ Such skill and effort, the court held, though not involving the production of any original matter, was “more than mere transcribing or writing from dictation”,²⁰¹ which conferred no copyright.²⁰² The principle emerging from *Walter v Lane*, therefore, is that some types of skill and labour – such as that of the shorthand writer’s – are sufficient to confer originality²⁰³ even if no creative choices are made.²⁰⁴

59 Lord Halsbury made clear the policy consideration which motivated the decision – that one should not “appropriate to himself what has been produced by the skill, labour and capital of others”.²⁰⁵ For Lord Davey, this appears to be the very basis of his decision:²⁰⁶

[I]t is a sound principle that a man shall not avail himself of another’s skill, labour, and expense by copying the written product thereof. To quote the language of North J in another case: ‘For the purposes of their own profit they desire to reap where they have not sown, and to take advantage of the *labour and expenditure* of the plaintiffs in procuring news for the purpose of saving labour and expense to themselves.’ [emphasis added]

60 The UK Copyright Act 1842²⁰⁷ then in force did not require works to be “original”, a point stressed by the House of Lords²⁰⁸ when

198 *Walter v Lane* [1899] 2 Ch 749 at 772.

199 *Walter v Lane* [1899] 2 Ch 749 at 772.

200 *Walter v Lane* [1900] AC 539 at 551, *per* Lord Davey, and 557 and 559, *per* Lord Brampton.

201 *Walter v Lane* [1900] AC 539 at 554, *per* Lord James, and 556, *per* Lord Brampton.

202 *Walter v Lane* [1900] AC 539 at 554, *per* Lord James (“A mere copyist of written matter is not an ‘author’ within the Act”), and 558, *per* Lord Brampton: “A person who merely writes an article from the dictation and as the servant of another can claim no property in what he so writes”.

203 Michael Tappin *et al*, *Laddie, Prescott and Vitoria: The Modern Law of Copyright* vol 1 (LexisNexis, 5th Ed, 2018) at para 3.58.

204 See Michael Tappin *et al*, *Laddie, Prescott and Vitoria: The Modern Law of Copyright* vol 1 (LexisNexis, 5th Ed, 2018) at para 3.55: “[T]here may be an element [of] ‘intellectual creation’ in creating perfect accuracy in verisimilitude as much as in creating something wholly new”. Further discussion as to the types of skill and labour relevant to originality under UK common law is discussed at para 67 below.

205 *Walter v Lane* [1900] AC 539 at 545.

206 *Walter v Lane* [1900] AC 539 at 552.

207 c 45.

208 *Walter v Lane* [1900] AC 539 at 546–548.

it concluded in *Walter v Lane* that there may therefore be copyright “without the production of original matter”.²⁰⁹ But although the 1911 Copyright Act introduced the word “original” to the statute, it has been said that *Walter v Lane* remains good law.²¹⁰ Particularly, the decision was affirmed in *Express Newspapers plc v News (UK) plc*²¹¹ where the court held that skill, labour and judgment employed by a reporter in conducting an interview lasting over eight-and-a-half hours was sufficient to confer copyright in verbatim quotations recorded during the interview.²¹²

61 The correctness of *Walter v Lane* appeared to be challenged in *Interlego*. When considering the issue of copyright subsistence in derivative works, the Privy Council held, citing its earlier decision in *Macmillan & Co Ltd v Cooper*,²¹³ that:²¹⁴

... it is the product of the labour, skill, and capital of one man which must not be appropriated by another, not the elements, the raw material, if one may use the expression, upon which the labour and skill and capital of the first have been expended. To secure copyright for this product it is necessary that labour, skill and capital should be expended sufficiently to impart to the product some quality or character which the raw material did not possess, and which differentiates the product from the raw material.

209 *Walter v Lane* [1900] AC 539 at 554, *per* Lord James. To this end, the court thought that copyright could subsist “in the information given by a street directory”: at 552, *per* Lord Davey; see also 546, *per* Lord Halsbury. This should now be considered in light of s 3A(2) of the UK Copyright, Designs and Patents Act 1988 (c 48) which implements the Database Directive and provides that databases are original only if by reason of the selection or arrangement of its contents the database constitutes the author’s own intellectual creation.

210 At least under the traditional common law approach in UK, for it is now an open question as to whether European Union law has modified the test for originality, and if so, whether *Walter v Lane* [1900] AC 539 remains compatible with the prevailing test: *Copinger and Skone James on Copyright* vol 1 (Gillian Davies, Nicholas Caddick & Gwilym Harbottle eds) (Sweet & Maxwell, 17th Ed, 2016) at para 3-218; Michael Tappin *et al*, *Laddie, Prescott and Vitoria: The Modern Law of Copyright* vol 1 (LexisNexis, 5th Ed, 2018) at para 3.58.

211 [1990] 1 WLR 1320; [1990] 3 All ER 376.

212 *Express Newspapers plc v News (UK) plc* [1990] 1 WLR 1320 at 1325–1326; [1990] 3 All ER 376 at 380–381. Lord Browne-Wilkinson favoured the view taken by the High Court of Australia in *Sands & McDougall Pty Ltd v Robinson* (1917) 23 CLR 49 that *Walter v Lane* [1900] AC 539 remained good law despite the introduction of the word “original” to the statute. The court rejected the *dicta* of Cross J in *Lady Helen Robertson v Harry Lewis* [1976] RPC 169 at 174–175 that in view of the amendment to the statute, *Walter v Lane* may no longer be good law.

213 (1924) 40 TLR 186; (1923) 93 LJPC 113.

214 *Interlego AG v Tyco Industries Inc* [1989] AC 217 at 260.

Therefore, “[s]kill, labour or judgment merely in the process of copying cannot confer originality”.²¹⁵ Lord Oliver stated:²¹⁶

Take the simplest case of artistic copyright, a painting or a photograph. It takes great skill, judgment and labour to produce a good copy by painting or to produce an enlarged photograph from a positive print, but no one would reasonably contend that the copy painting or enlargement was an ‘original’ artistic work in which the copier is entitled to claim copyright.

62 Instead, for copyright to subsist in a derivative work, the court held that “[t]here must in addition be some element of *material alteration or embellishment* which suffices to make the totality of the work an original work” [emphasis added].²¹⁷

63 *Interlego* concerned the originality of technical drawings of interlocking plastic toy bricks. The drawings in question were essentially copies of earlier drawings, involving merely minute differences significant only from a technical perspective but not otherwise visually significant. Thus, despite an estimated half a day of skill, judgment or labour expended to produce the drawings, the court, noting that there was “no substantial alteration to the drawing as such”, held them unoriginal.²¹⁸

64 The authority of *Walter v Lane* was ostensibly restored when the English Court of Appeal in *Hyperion Records Ltd v Sawkins*²¹⁹ (“*Hyperion*”) attempted to qualify the *Interlego* decision. In this case involving musical works, the court had to decide whether a plaintiff who created performing editions of Lalande’s compositions (in which copyright had expired) was entitled to copyright in the performing editions, which the defendant copied. The defendant’s litigation strategy in *Hyperion* appeared to centre around the *Interlego* proposition – viz that the plaintiff did not use the “right kind of skill and labour” and created no new music – no copyright should therefore subsist in the performing editions.²²⁰ However, and despite the plaintiff’s own admission that he was trying to “produce more faithful and better copies of Lalande’s original music and to make it playable, rather than to create new music of his own”,²²¹ the court, examining what the plaintiff *actually* did, found that much of his work in creating the performing editions comprised “his own interventions ...

215 *Interlego AG v Tyco Industries Inc* [1989] AC 217 at 262–263.

216 *Interlego AG v Tyco Industries Inc* [1989] AC 217 at 262.

217 *Interlego AG v Tyco Industries Inc* [1989] AC 217 at 263.

218 *Interlego AG v Tyco Industries Inc* [1989] AC 217 at 258.

219 [2005] EWCA Civ 565; [2005] 1 WLR 3281; [2005] 3 All ER 636.

220 *Hyperion Records Ltd v Sawkins* [2005] EWCA Civ 565; [2005] 1 WLR 3281 at [24] and [38].

221 *Hyperion Records Ltd v Sawkins* [2005] EWCA Civ 565; [2005] 1 WLR 3281 at [41].

not derived from other source materials”.²²² In certain instances, he recreated or recomposed certain parts, and in supplying “corrections” to the music, he used his personal evaluation as to what was intended by the composer.²²³ Interestingly, although the court could have simply held that the performing editions were original because the plaintiff had exercised creative choices,²²⁴ it went further, attempting to restrict *Interlego*. While appearing to agree with the decision in *Interlego* on the facts, Jacob LJ cited academic opinion stating that *Interlego* was, as a general proposition, too widely stated. He thought that the degree of skill or difficulty involved in the copying process was important:²²⁵

The true position is that one has to consider the extent to which the ‘copyist’ is a mere copyist – merely performing an easy mechanical function. The more that is so the less is his contribution likely to be taken as original.

65 While *Interlego* concerned “fairly simple technical drawings”, which perhaps any person would “almost certainly succeed” in reproducing an exact copy, the court thought that this should be distinguished from “eg a painting by Vermeer”, where “very few persons, if any, are capable of making an exact replica”. The court agreed with the suggestion that in the latter case, it would be absurd for the law to afford copyright protection to an amateur who creates a poor copy (therefore distinguishable from the original), while denying copyright to the skilled artist who succeeds in creating a precise replica.²²⁶ In sum:²²⁷

... reproductions requiring great talent and technical skill may qualify as protectable works of authorship, even if they are *copies* of pre-existing works. This would be the case for photographic and other high quality replicas of works of art. [emphasis in original]

This resonates with the reasoning in *Walter v Lane* where the House of Lords attempted to distinguish protectable works produced by

222 *Hyperion Records Ltd v Sawkins* [2005] EWCA Civ 565; [2005] 1 WLR 3281 at [26], per Mummery LJ; see also [86], per Jacob LJ: “His re-creative work was such as to create something really new using his own original (not merely copied) work.” See also Jane C Ginsburg, “The Concept of Authorship in Comparative Copyright Law” (2003) 52 DePaul L Rev 1063 at 1085–1086, referred to at n 157 above.

223 *Hyperion Records Ltd v Sawkins* [2005] EWCA Civ 565; [2005] 1 WLR 3281 at [26], per Mummery LJ; [86], per Jacob LJ.

224 See *Hyperion Records Ltd v Sawkins* [2005] EWCA Civ 565; [2005] 1 WLR 3281 at [86] where Jacob LJ observed that Sawkins “re-created Lalande’s work using a considerable amount of personal judgment”.

225 *Hyperion Records Ltd v Sawkins* [2005] EWCA Civ 565; [2005] 1 WLR 3281 at [83].

226 *Hyperion Records Ltd v Sawkins* [2005] EWCA Civ 565; [2005] 1 WLR 3281 at [81].

227 *Hyperion Records Ltd v Sawkins* [2005] EWCA Civ 565; [2005] 1 WLR 3281 at [83], citing Jane C Ginsburg, “The Concept of Authorship in Comparative Copyright Law” (2003) 52 DePaul L Rev 1063 at 1082.

a stenographer's skill and unprotectable works produced by a mere scribe engaging in "mechanical copying".²²⁸

66 A few observations may therefore be made of the UK common law position on originality in derivative works. Firstly, that *Walter v Lane* remains good law demonstrates the continued reliance on sweat-based justifications for protection, and that creative choices are not always necessary.²²⁹ As Jacob LJ pointed out in *Hyperion*:²³⁰

... [i]n the end the question is one of degree – how much skill, labour and judgment in the making of the copy is that of the creator of that copy? Both individual creative input and sweat of brow may be involved and will be factors in the overall evaluation.

67 Second, not all sweat is equal, and UK copyright law confers protection only on "higher" forms of skill or labour – mechanical copying, even if laborious, is insufficient. This, of course, begs the question: above mechanical copying, what types of skill and labour will, while devoid of creative choices, merit copyright protection? To this, the authors of *Laddie* suggest that in the context of *Walter v Lane*:²³¹

... [t]he answer ought to depend on whether the original manuscript was readily accessible. The courts have recognised that accessibility of the original material is a relevant factor. To reproduce, by shorthand skill, an accessible text where none existed before is to originate something; else the reporter is a mere transcriber. (The real reason that copyright has been given to the work of reporters is that, in the general case, their skills and efforts are of value to the community. They preserve that which would be in danger of being lost. This pragmatic approach is the real explanation of *Walter v Lane*, the result of which would probably have been different had Lord Rosebery published his speech.)

68 This leads to the third observation, being that under UK common law, whether a work is original may, at least at the fringes, resolve into an

228 *Walter v Lane* [1900] AC 539 at 554, *per* Lord James; see also 556, *per* Lord Brampton.

229 See Jane C Ginsburg, "The Concept of Authorship in Comparative Copyright Law" (2003) 52 DePaul L Rev 1063 at 1082: "the author need not be creative, so long as she perspires"; see also Andreas Rahmatian, "The Concepts of 'Musical Work' and 'Originality' in UK Copyright Law – *Sawkins v Hyperion* as a Test Case" (2009) 40(5) IIC 560 at 591. However, this is only representative of UK copyright law in so far as it existed before the influence of European Union ("EU") law. Presently, it is unclear whether EU directives and the requirement for works to constitute the "author's own intellectual creation" as interpreted in *Infopaq International A/S v Danske Dagblades Forening* C-5/08, EU:C:2009:465; [2009] ECR I-6569; [2009] ECDR 15, and successive cases of the Court of Justice of the European Union is compatible with the approach in *Walter v Lane*. See n 209 above.

230 *Hyperion Records Ltd v Sawkins* [2005] EWCA Civ 565; [2005] 1 WLR 3281 at [83].

231 Michael Tappin *et al*, *Laddie, Prescott and Vitoria: The Modern Law of Copyright* vol 1 (LexisNexis, 5th Ed, 2018) at para 3.58.

issue of public policy. The above passage represents a candid observation that the adjudication of whether a work merits copyright protection in UK may be affected by factors extrinsic to creativity or even the type of skill or labour expended in its production. This policy consideration was indeed relevant in *Hyperion*, when Jacob LJ endorsed the view that “the *Interlego* proposition is anyway distinguishable where the replicator succeeds in preserving for posterity an original to which access is difficult”.²³² Just as with *Laddie*’s third limb on photographic originality, one continues to observe that copyright protection under UK common law may be heavily influenced by the social utility in preserving that which would otherwise be lost.²³³

VI. Originality principles under copyright law in Singapore

69 The differences between the originality doctrines applied by the UK and US courts have resulted in different approaches in assessing the originality of photographs, and a correspondingly different scope of copyright protection for such works. Although copyright law in Singapore has largely followed the course of UK common law, there have been few decisions in Singapore dealing with the applicable principles relating to photographic originality, and the direction in which Singapore law should develop therefore remains an open question. It is submitted, however, that the US position should be followed, for it presents a more principled and coherent approach towards photographic originality and is consistent with the nature of photographs as fact-based works. Moreover, the foundation for the adoption of such an approach has already been laid by the Singapore courts’ approach towards originality in factual compilations.

232 *Hyperion Records Ltd v Sawkins* [2005] EWCA Civ 565; [2005] 1 WLR 3281 at [81], citing Sir Hugh Laddie *et al*, *The Modern Law of Copyright* (Butterworths, 3rd Ed, 2000) at para 4.39. In contrast, the Privy Council in *Interlego AG v Tyco Industries Inc* [1989] AC 217 was perhaps influenced by a different policy consideration, *viz* preventing “the undesirable practice of seeking to expand the boundaries of intellectual property rights beyond the purpose for which they were created in order to obtain an unintended and undeserving monopoly”. The plaintiffs had attempted to obtain a perpetual monopoly through “attributing new periods of copyright protection to every minor alteration” (at 255–256).

233 See, *eg*, Burton Ong, “Originality from Copying: Fitting Recreative Works into the Copyright Universe” (2010) 2 IPQ 165 at 189, where one commentator notes that “[t]he preservation for posterity of works to which access is difficult or very limited might also operate as a valid policy goal for copyright law to pursue by recognising such recreative works as ‘original’ and hence copyrightable”; see also Michael Tappin *et al*, *Laddie, Prescott and Vitoria: The Modern Law of Copyright* vol 1 (LexisNexis, 5th Ed, 2018) at para 4.44: “The law of copyright recognises that difficulty of access to the original is a relevant element.”

B. Originality – Singapore

70 As with the CDPA in the UK, s 27 of Singapore’s Copyright Act²³⁴ (“the Act”) requires works to be original to merit copyright protection. The term “original” is similarly left undefined in the Act, and Singapore courts have generally echoed the traditional UK common law “sweat of the brow” approach.²³⁵

71 A point of departure from UK common law originality principles is that which relates to factual compilations, where it is the creativity approach espoused in *Feist* which applies.²³⁶ This was the pronouncement of the Court of Appeal in *Global Yellow Pages Ltd v Promedia Directories Pte Ltd*²³⁷ (“*Global Yellow Pages*”), affirming the judgment of George Wei J in the High Court. Wei J undertook a “comprehensive exegesis of the US, Australian, Canadian, English and Singapore case law”²³⁸ before coming to the conclusion that “not only is the creativity standard required by the Copyright Act and the authorities, it also rests on firm policy justifications”.²³⁹

72 Examining the Act, Wei J observed that ss 4 and 27(2) of the Act “[make] clear that the existence of an original work presupposes an author”,²⁴⁰ and authorship is, in turn, correlated with originality.²⁴¹

234 Cap 63, 2006 Rev Ed.

235 *Auvi Pte Ltd v Seah Siew Tee* [1991] 2 SLR(R) 786 (“*Auvi*”) at [32]: “All that needs to be shown is that the author created it and has not copied it from another, and that he has expended towards its creation a substantial amount of skill or labour.” See also *Golden Season Pte Ltd v Kairos Singapore Holdings Pte Ltd* [2015] 2 SLR 751 at [178]; *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2014] SGIPOS 10 at [237]; and *Fox Street Wear Pte Ltd v Fox Racing Inc* [2014] SGIPOS 13 at [112]; see further Susanna H S Leong, *Intellectual Property Law of Singapore* (Singapore: Academy Publishing, 2013) at paras 03.034–03.039. While the court in *Auvi* referred to the need for a “substantial” amount of skill and labour, it has been said that the court could not have intended to set a high threshold, since had made it clear that originality did not mean novelty, uniqueness or inventiveness: see Ng-Loy Wee Loon, *Law of Intellectual Property of Singapore* (Singapore: Sweet & Maxwell, 2nd Ed, 2014) at para 6.3.28 and the accompanying footnote.

236 Although as previously noted, the traditional common law position has since been modified by the introduction of s 3A(2) of the UK Copyright, Designs and Patents Act 1988 (c 48), pursuant to the Database Directive. See paras 21 and 22 above.

237 [2016] 2 SLR 165 (HC); [2017] 2 SLR 185 (CA).

238 David Tan & Stanley Lai Tze Chang SC, “Intellectual Property Law” (2016) 17 SAL Ann Rev 504 at 504–505, para 19.2.

239 *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2016] 2 SLR 165 at [189].

240 *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2016] 2 SLR 165 at [190].

241 See *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2016] 2 SLR 165 at [190] and [192]; see also Jane C Ginsburg, “The Concept of Authorship in Comparative Copyright Law” (2003) 52 DePaul L Rev 1063 at 1078, where Ginsburg notes that “originality is synonymous with authorship”.

Section 7A of the Act provides that copyright protection for compilations – which are literary works – is “limited to the selection or arrangement of its contents which constitutes an intellectual creation”, and “is in addition to, and independent of”, any copyright or performance right subsisting in the relevant material or data contained in the compilation. The statute therefore clearly required that “copyright protection be confined to the elements of original expression arising from the author’s *selection and arrangement* of the individual components of the compilation” [emphasis in original],²⁴² as only such selection and arrangement – and not the components themselves – originate from the author. This conclusion was reinforced by the statutory requirement that the compilation must constitute an “intellectual creation” to acquire copyright protection.²⁴³

73 This interpretation was fortified by consideration of the legislative history of s 7A, as well as the background of the international treaties connected with its enactment. In short, s 7A was “consistent with the scope of copyright protection conferred on compilations by *Feist*”, and the creativity approach was “entirely consistent with the Berne Convention, TRIPS and the language of s 7A”.²⁴⁴ There was therefore a “clear legislative intent to adopt the creativity view at least where compilations were concerned”.²⁴⁵ The creativity approach also found support in the Court of Appeal’s prior decision in *Asia Pacific Publishing Pte Ltd v Pioneers v Leaders (Publishers) Pte Ltd*,²⁴⁶ where V K Rajah JA expressed a “clear preference for the creativity approach”²⁴⁷ and observed that “it is not the preparatory efforts or process of gathering facts that is protected. Rather it is the thought effort involved in creating the particular form of expression that is embraced by copyright”.²⁴⁸

242 *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2016] 2 SLR 165 at [192].

243 *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2016] 2 SLR 165 at [192].

244 *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2016] 2 SLR 165 at [193]–[198]. The High Court noted that the introduction of s 7A of the Copyright Act (Cap 63, 2006 Rev Ed) came on the back of the adoption of the World Intellectual Property Organization Copyright Treaty (20 December 1996; entry into force 6 March 2002) (“WCT”), and bore an unmistakable resemblance to Art 5 of the WCT and Art 10(2) of the Agreement on Trade-Related Aspects of Intellectual Property Rights, Marrakesh Agreement Establishing the World Trade Organization (1869 UNTS 299, 33 ILM 1197) (15 April 1994) Annex 1C (“TRIPS”). Article 10(2) of TRIPS appeared to emulate the holding in *Feist Publications v Rural Telephone Service Co Inc* 499 US 340 (1991), and is similar to Art 2(5) of the Berne Convention for the Protection of Literary and Artistic Works (9 September 1886, revised 24 July 1971; amended 1979).

245 *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2016] 2 SLR 165 at [206].

246 [2011] 4 SLR 381.

247 *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2016] 2 SLR 165 at [200].

248 *Asia Pacific Publishing Pte Ltd v Pioneers & Leaders (Publishers) Pte Ltd* [2011] 4 SLR 381 at [37].

74 Wei J was astutely aware of the competing underlying justifications motivating the sweat of the brow and creativity schools, acknowledging that the sweat-based doctrine sought to protect against persons reaping where they have not sown, while the creativity doctrine “encourages knowledge to be built upon knowledge”.²⁴⁹ Ultimately, both the High Court and Court of Appeal favoured the creativity doctrine in the context of factual compilations.²⁵⁰

75 Finally, both courts rejected the plaintiff’s argument to “augment the statutory requirement of originality to make up for the absence of a *sui generis* database right in Singapore”.²⁵¹ It was not for the courts to supplant or “judicially overrule the clear legislative intent” to adopt the creativity view.²⁵² Moreover, extending copyright protection to an entire class of subject matter on the basis of substantial investment in the obtaining of information or data would, on the creativity view, be “fundamentally at odds with the essence of copyright protection”.²⁵³

C. *Case for creativity doctrine for photographs under Singapore copyright law*

76 Photographs fall within the definition of artistic works under the Act.²⁵⁴ Local decisions considering the applicable principles regarding the originality of photographs are, however, sparse, although it has at least been recognised that the exercise of skill and judgment in matters such as the choice of lighting or angle of shot may result in an original photograph.²⁵⁵ UK common law authorities are therefore likely to be persuasive – indeed, a leading academic text presumes that the approach under UK common law applies in Singapore.²⁵⁶ Nevertheless, it is posited that the Singapore courts should follow the US approach towards photographic copyright for four main reasons.

249 *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2016] 2 SLR 165 at [77].

250 *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2016] 2 SLR 165 at [189]; *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2017] 2 SLR 185 at [24].

251 *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2016] 2 SLR 165 at [206].

252 *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2016] 2 SLR 165 at [206]; *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2017] 2 SLR 185 at [35].

253 *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2017] 2 SLR 185 at [206].

254 Copyright Act (Cap 63, 2006 Rev Ed) s 7(1). The section defines “photograph” as “a product of photography or of a process similar to photography, other than an article or thing in which visual images forming part of a cinematograph film have been embodied, and includes a product of xerography ...”. Notably, this is similar to the corresponding definition under the UK Copyright, Designs and Patents Act 1988 (c 48): see *Singsung Pte Ltd v LG 26 Electronics Pte Ltd* [2016] 4 SLR 86 at [106].

255 *PropertyGuru Pte Ltd v 99 Pte Ltd* [2018] SGHC 52 at [97].

256 Susanna H S Leong, *Intellectual Property Law of Singapore* (Singapore: Academy Publishing, 2013) at paras 04.117–04.118.

77 Firstly, given the nature of photographs as fact-based works, much of the reasoning in the *Global Yellow Pages* decisions lends support to adoption of the creativity approach concerning photographic originality. Wei J held that the creativity doctrine rested on “firm policy justifications”²⁵⁷ and a passage cited from a decision of the High Court of Australia is, in this regard, instructive in suggesting that the balance between competing policy considerations was appropriately struck under the creativity view:²⁵⁸

Copyright does not protect facts or information. Copyright protects the particular form of expression of the information, namely the words, figures and symbols in which the pieces of information are expressed, and the selection and arrangement of that information. *That facts are not protected is a crucial part of the balancing of competing policy considerations in copyright legislation. The information/expression dichotomy in copyright law is rooted in considerations of social utility. Copyright, being an exception to the law’s general abhorrence of monopolies does not confer a monopoly on facts or information because to do so would impede the reading public’s access to and use of facts and information. Copyright is not given to reward work distinct from the production of a particular form of expression.* [emphasis added by the Singapore High Court]

78 Although the *ratio* of the *Global Yellow Pages* decisions concerns factual compilations, there should be no principled basis for distinguishing between factual compilations and other fact-based works such as photographs. Indeed, the Court of Appeal opined that while “the appropriation of *data* or *facts* that represents the fruit of an investment” [emphasis in original] might be frowned upon as commercially immoral, this was “not within the purview of copyright law”²⁵⁹ – a principle that would apply universally to all copyright works, not merely factual compilations. Courts should therefore similarly deny awarding copyright to photographs solely by virtue of significant investment or labour involved in their production.²⁶⁰

79 Second, the language employed by the courts may be suggestive of a shift away from sweat of the brow towards the creativity doctrine concerning *all* copyright works. In *Global Yellow Pages*, the apex court thought that it was the creativity doctrine which represented the correct underlying justification for copyright, observing that while copyright law in the UK “had at times been stretched to protect the labour and expense invested in the creation of databases, this tension was eased

257 *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2016] 2 SLR 165 at [189].

258 *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2016] 2 SLR 165 at [120], citing *IceTV Pty Ltd v Nine Network Australia Pty Ltd* [2009] 239 CLR 458 at [28].

259 *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2017] 2 SLR 185 at [34].

260 See n 154 above; see also Justin Hughes, “The Photographer’s Copyright – Photograph as Art, Photograph as Database” (2012) 25Harv JL & Tech 339 at 414.

after the introduction of a *sui generis* database right”, which “allowed copyright law in UK to perform the function for which it was originally designated”.²⁶¹ This is further supported by the High Court’s observations on the function of copyright law:²⁶²

[C]opyright is not just about protecting the commercial interests of the author or copyright owner. It is not even a law of unfair competition. ... Copyright is not an end in itself. It is a means to an end: benefit to the society as a whole.

Thus, the sweat of the brow doctrine – premised on rewarding authors for their labour and on protection against “free riding” unfair competition – was ultimately rejected by the courts.²⁶³

80 Perhaps the most unequivocal indication of the Court of Appeal’s preference for the creativity view as underpinning copyright law as a whole is found in its response to the plaintiff’s argument to lower the bar of originality for factual compilations to make up for the lack of a *sui generis* database right in Singapore. It held that it was not for the courts to “[adopt] a lower standard of creativity in the case of factual compilations *in comparison to other authors’ works* in order to provide the sort of protection that Parliament considered but then declined to provide” [emphasis added].²⁶⁴ The court was clearly of the view that the creativity doctrine applied to *all authors’ works* and not merely factual compilations.

81 Third, the creativity doctrine is consistent with the law on derivative works in Singapore. The line of UK cases on derivative works and the issues concerning sweat-based protection have been referred to. Yet, neither *Walter v Lane* nor *Hyperion* – both of which apply the sweat-based standard for originality in derivative works – has been affirmed by the Singapore courts.²⁶⁵ Instead, judicial decisions have repeatedly referred to the proposition in *Interlego* that a “material alteration or embellishment which suffices to make the totality of the work an original work” is required for derivative works to qualify for copyright protection,²⁶⁶ and that “copying *per se*, regardless of how much skill

261 *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2017] 2 SLR 185 at [26].

262 *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2016] 2 SLR 165 at [182].

263 *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2016] 2 SLR 165 (HC) at [189]; [2017] 2 SLR 185 (CA) at [34].

264 *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2017] 2 SLR 185 at [35].

265 See Susanna H S Leong, *Intellectual Property Law of Singapore* (Singapore: Academy Publishing, 2013) at para 03.064 noting that whether *Walter v Lane* [1900] AC 539 is good law in Singapore “has not been conclusively dealt with by our courts and remains undecided”.

266 *Virtual Map (Singapore) Pte Ltd v Suncool International Pte Ltd* [2005] 2 SLR(R) 157 at [13]; *Real Electronics Industries Singapore Pte Ltd v Nimrod Engineering Pte Ltd* (cont’d on the next page)

and labour was devoted to the process, does not result in an original work”.²⁶⁷ Importantly, however, the adoption of *Interlego* in Singapore remains unconstrained by the qualification expressed by the English Court of Appeal in *Hyperion*, which stated that the *Interlego* proposition applied only to works produced by “mere copyist[s] ... performing an easy mechanical function”, but not to “photographic and other high quality replicas of works of art”.²⁶⁸ If – as recognised by Jacob LJ – the *Interlego* proposition is as a generality inconsistent with *Walter v Lane*,²⁶⁹ then Singapore courts have adopted the creativity approach regarding originality in derivative works. Indeed, one commentator’s criticism of the *Bridgeman* decisions as being incorrect on the issue of subsistence of copyright under UK law relies heavily on the authority of *Walter v Lane* (which was not considered in the *Bridgeman* decisions)²⁷⁰ and the court’s “uncritical adoption of the broad statement in *Interlego*”.²⁷¹ The fact that *Interlego*, but not *Walter v Lane*, has been repeatedly cited and followed in Singapore tends toward the conclusion that the creativity doctrine holds, and that Singapore courts would agree with the result in *Bridgeman*.

82 Lastly, as with factual compilations, if it is desired that the substantial skill, labour or expense involved in the production of uncreative photographs should be protected, it is open to Parliament to legislate for a two-tier system of protection to avoid distorting copyright principles. The Court of Appeal noted in *Global Yellow Pages* that copyright law in UK “had at times been stretched to protect the labour and expense invested in the creation of databases”, though “this tension was eased after the introduction of a *sui generis* database right” pursuant to EU law.²⁷² It considered the competing policy considerations between the sweat and creative doctrines, and rejected the argument to dilute the creativity standard in relation to factual compilations in order to make up for the lack of a *sui generis* database right so as to reward authors of such works for their labour and investment.²⁷³

[1995] 3 SLR(R) 909 at [37]; *PropertyGuru Pte Ltd v 99 Pte Ltd* [2018] SGHC 52 at [99] and [101].

267 *PropertyGuru Pte Ltd v 99 Pte Ltd* [2018] SGHC 52 at [99], citing *Interlego AG v Tyco Industries Inc* [1989] AC 217 at 263.

268 *Hyperion Records Ltd v Sawkins* [2005] EWCA Civ 565; [2005] 1 WLR 3281 at [83].

269 *Hyperion Records Ltd v Sawkins* [2005] EWCA Civ 565; [2005] 1 WLR 3281 at [83].

270 Kevin Garnett QC, “Copyright in Photographs” (2000) 22(5) EIPR 229 at 236:

The originality requirement must, it is suggested, be approached bearing in mind that the peculiar skill of a photographer is often to reproduce faithfully what appears in front of the camera lens. In many ways, such skill is analogous to the skill of a reporter who faithfully reproduces the spoken word of a speaker, and whose work was protected in *Walter v Lane*.

271 Kevin Garnett QC, “Copyright in Photographs” (2000) 22(5) EIPR 229 at 231.

272 *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2017] 2 SLR 185 at [26].

273 *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2017] 2 SLR 185 at [35].

83 Courts have long struggled with the fact-based nature of photographs and recognised that not every photograph may merit copyright. Although the US Supreme Court in *Burrow-Giles* held that Sarony's photograph was original, it accepted that there may be no copyright in the "ordinary production of a photograph",²⁷⁴ a tacit admission that certain photographs may "merely [transcribe] the actual scene before the camera" without the involvement of any authorial intervention.²⁷⁵ In more recent times, the Term Directive²⁷⁶ permits EU member states to provide for the protection of "other photographs" which are unoriginal.²⁷⁷ This has provided the basis for the enactment of legislation protecting unoriginal photographs akin to the *sui generis* database right under the Database Directive, creating a two-tier system of protection.²⁷⁸ As has been observed, a two-tier system "recognizes that we sometimes want to reward non-original expressions".²⁷⁹ Moreover, it "help[s] keep lawyers and policymakers from distorting the originality standard. Without this system, courts may continue to stretch originality to include in the realm of copyright many arguably uncreative photographs and videos".²⁸⁰

84 Ultimately, however, the appropriate forum to consider whether such photographs should be protected – and if so, the appropriate term of protection – is the Legislature, not the courts.

274 *Burrow-Giles Lithographic Co v Sarony* 111 US 53 at 59 (1884).

275 Christine Haight Farley, "The Lingering Effects of Copyright's Response to the Invention of Photography" (2004) 65 U Pitt L Rev 385 at 409.

276 Directive 2006/116/EC of the European Parliament and of the Council of 12 December 2006 on the term of protection of copyright and certain related rights (hereinafter "Term Directive").

277 Term Directive, Art 6.

278 See also Justine Pila & Paul L C Torremans, *European Intellectual Property Law* (UK: Oxford University Press, 2nd Ed, 2019) at para 11.3.3.4:

Implicit is a two-tier scheme for the protection of films and photographs that mirror the scheme for databases ... namely, copyright for films and photographs as authorial works, and related rights for first fixations of films and non-authorial photographs.

Also see Justin Hughes, "The Photographer's Copyright – Photograph as Art, Photograph as Database" (2012) 25 Harv JL & Tech 339 at 399: "It is no coincidence that the two-tier system for protection of photographs in German law has some similarity to the two-tier system of protection for databases in the European Union."

279 Justin Hughes, "The Photographer's Copyright – Photograph as Art, Photograph as Database" (2012) 25 Harv JL & Tech 339 at 398.

280 Justin Hughes, "The Photographer's Copyright – Photograph as Art, Photograph as Database" (2012) 25 Harv JL & Tech 339 at 398.

VII. Conclusion

85 Copyright law has struggled to locate originality in photographs. Looking to the fact-based nature of photographs and observing their parallels with factual compilations has, however, provided US courts with a tool to separate the wheat from the chaff – protected expression from unprotected facts – and ensures that only the photographer’s creative choices are relevant to the originality inquiry. In contrast, the threshold for copyright protection of photographs under UK common law appears to be lower, underpinned by traditional sweat-based justifications and seemingly influenced by extrinsic considerations, which stretch the doctrine of originality. It has been argued that Singapore courts should depart from the UK approach – a move that would be consistent with the sound legal principles enunciated in recent decisions concerning originality in factual compilations, as well as with prevailing judicial notions on the function of copyright law.
