EUROPEAN COMMISSION

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TO THE PRESIDENT AND MEMBERS OF THE COURT OF JUSTICE OF THE EUROPEAN UNION

WRITTEN OBSERVATIONS

submitted pursuant to Article 23 of the Statute of the Court of Justice

by **the European Commission** represented by Thomas VAN RIJN Principal Legal Adviser and Ms Julie SAMNADDA, Member of its Legal Service, acting as Agents with an address for service in Luxembourg at the office of Mr. A. ARESU also a Member of the Commission's Legal Service, Bureau F3/907, Bâtiment BECH, 5 Rue A Weicker, L-2721 Luxembourg

in Case C-604/10

a request for a preliminary ruling by the Court of Appeal of England and Wales pursuant to Article 267 of the TFEU in proceedings between

1) Football Dataco Limited
2) the Football Association Premier League Limited
3) The Football League Limited
4) The Scottish Premier League Limited
5) The Scottish Football League
6) PA Sport UK Limited

and

Yahoo! UK Limited
1) Stan James (Abingdon) Limited
2) Stan James plc
3) Enetpulse Aps

on the interpretation of Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases (OJ L 77 27.03.1996 p 0020-0028).

1. THE FACTS AND THE MAIN PROCEEDINGS

1. This is a request for a preliminary ruling from the Court of Appeal of England and Wales ("the Referring Court") and the questions are set out in the order for reference ("Order for Reference"). It concerns Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases (OJ L 77 27.03.1996 p 0020-0028) ("the Directive").

2. The proceedings before the Referring Court concern an action for copyright infringement. It is an appeal to the Referring Court from a judgment of the lower court (*Football Dataco Ltd and others v Brittens Pools Ltd and others* [2010] EWHC 841(Ch)) ("the High Court judgment).The main facts and the legal arguments relied upon are summarised in the Order for Reference and are also set out in much greater detail in the High Court judgment. This case concerns whether any and, if so which rights, subsist in the annual fixture lists produced and published for the purposes of the English and Scottish football Premier Leagues ("the fixture lists").

3. The claimants in the main proceedings and now the respondents ("the Respondents") before the Referring Court are the following: the Football Association Premier League Ltd, the Football League Ltd, the Scottish Premier League Ltd, the Scottish Football League which organise professional football matches in England and Scotland; and there is also Football Dataco Ltd, and PA Sport UK Ltd which are involved in the exploitation of data and rights in connection with football matches, including the football fixture lists.

4. The defendants in the main proceedings who are now the appellants ("the Appellants") before the Referring Court are: Yahoo! UK Ltd, a media company; Stan James (Abingdon) Ltd and Stan James Plc, two betting companies ("Stan James"); and Enetpulse ApS, a Danish company which supplied data to Stan James.

5. At Annex 1 to the schedule of the Order for Reference, there is an extract from the High Court Judgment which sets out the findings of fact in relation to the process of creating the English football fixture lists. Nothing similar has been provided for the Scottish football fixture lists and there is no further information other than the Scottish fixtures lists "involved more use of a computer and less individual input"

than the English fixture lists. However, at paragraphs 23-40 of the High Court judgment, the judge sets out his findings of fact in relation to the Scottish fixture lists.

6. In addition, according to the Order for Reference, individual authors have been identified for the English fixture lists (a Mr Thompson) (paragraph 3 of the Order for Reference) and for the Scottish fixture lists described as "at all times [having] been the work of Mr Blair, together with a Mr Mailer and a Mr Ogilvie" (paragraph 39 of the High Court judgment).

7. The Appellants contend that there are no rights in the fixture lists and that therefore fixture lists can be used without payment of a licence fee to the Respondents. The Respondents contend to the contrary. It is not disputed that if rights do exist, then in that case the owners would be the Respondents.

8. At first instance, the Respondents claimed that there were three rights at issue:

   - the *sui generis* right pursuant to Article 7 of the Directive;
   - copyright in the database pursuant to Article 3 of the Directive;
   - in the alternative, copyright under English statute law if neither the *sui generis* right nor copyright in the database is found to subsist ("the national right");

9. In the lower court, the judge held that there was copyright in the database pursuant to Article 3 but that there was no *sui generis* right pursuant to Article 7; and that there was no national right.

10. On appeal, the Appellants continue to contest the subsistence of any of the rights.

2. THE LEGISLATION

2.1. International law

11. Articles 9 (1) and 10 (2) of the Agreement on Trade-related Aspects of Intellectual Property Rights[1] ("the TRIPS Agreement") provide as follows:

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[1] The Agreement on Trade-Related Aspects of Intellectual Property Rights ('the TRIPs Agreement'), as set out in Annex 1C to the Marrakesh Agreement establishing the World Trade Organisation, was approved on behalf of the European Community by Council Decision 94/800/EC of 22 December 1994 concerning the conclusion on behalf

"Article 9

Relation to the Berne Convention

1. Members shall comply with Articles 1 through 21 of the Berne Convention (1971) and the Appendix thereto.

Article 10

Compilations of Data

[...]

2. Compilations of data or other material, whether in machine readable or other form, which by reason of the selection or arrangement of their contents constitute intellectual creations shall be protected as such. Such protection, which shall not extend to the data or material itself, shall be without prejudice to any copyright subsisting in the data or material itself."

12. Articles 2 and 5 of the World Intellectual Property Organisation Copyright Treaty[2] ("the WCT") provide as follows:

"Article 2 scope of copyright protection

Copyright protection extends to expressions and not to ideas, procedures, methods of operation or mathematical concepts as such.

Article 5 Compilations of data (databases)

Compilations of data or other material, in any form, which by reason of the selection or arrangement of their contents constitute intellectual creations, are protected as such. This protection does not extend to the data or the material itself and is without prejudice to any copyright subsisting in the data or material contained in the compilation."

13. There is also an Agreed Statement to Article 5 of the WCT which states as follows:

"The scope of protection for compilations of data (databases) under Article 5 of this Treaty, read with Article 2, is consistent with Article 2 of the Berne Convention and on a par with the relevant provisions of the TRIPS Agreement."

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of the European Community, as regards matters within its competence, of the agreements reached in the Uruguay Round multilateral negotiations (1986-1994) (OJ 1994 L 336, p. 1).

[2] The World Intellectual Property Organisation (WIPO) adopted in Geneva, on 20 December 1996, the WIPO Performances and Phonograms Treaty and the WIPO Copyright Treaty. Those two treaties were approved on behalf of the Community by Council Decision 2000/278/EC of 16 March 2000 (OJ 2000 L 89, p. 6).

2.2. Union Law

14. The following provisions of the Directive are relevant to this case. Recitals (1)-(5), (13)-(18), (21), (27)-(30), (39)-(40) and (60) of the preamble to the Directive and Articles 1, 3, 5, 7 and 14:

(1) Whereas databases are at present not sufficiently protected in all Member States by existing legislation; whereas such protection, where it exists, has different attributes;

(2) Whereas such differences in the legal protection of databases offered by the legislation of the Member States have direct negative effects on the functioning of the internal market as regards databases and in particular on the freedom of natural and legal persons to provide on-line database goods and services on the basis of harmonized legal arrangements throughout the Community; whereas such differences could well become more pronounced as Member States introduce new legislation in this field, which is now taking on an increasingly international dimension;

(3) Whereas existing differences distorting the functioning of the internal market need to be removed and new ones prevented from arising, while differences not adversely affecting the functioning of the internal market or the development of an information market within the Community need not be removed or prevented from arising;

(4) Whereas copyright protection for databases exists in varying forms in the Member States according to legislation or case-law, and whereas, if differences in legislation in the scope and conditions of protection remain between the Member States, such unharmonised intellectual property rights can have the effect of preventing the free movement of goods or services within the Community;

(5) Whereas copyright remains an appropriate form of exclusive right for authors who have created databases;

[...]

(13) Whereas this Directive protects collections, sometimes called 'compilations', of works, data or other materials which are arranged, stored and accessed by means which include electronic, electromagnetic or electro-optical processes or analogous processes;

(14) Whereas protection under this Directive should be extended to cover non-electronic databases;

(15) Whereas the criteria used to determine whether a database should be protected by copyright should be defined to the fact that the selection or the arrangement of the contents of the database is the author's own intellectual creation; whereas such protection should cover the structure of the database;

(16) Whereas no criterion other than originality in the sense of the author's intellectual creation should be applied to determine the eligibility of the database

for copyright protection, and in particular no aesthetic or qualitative criteria should be applied;

(17) Whereas the term 'database` should be understood to include literary, artistic, musical or other collections of works or collections of other material such as texts, sound, images, numbers, facts, and data; whereas it should cover collections of independent works, data or other materials which are systematically or methodically arranged and can be individually accessed; whereas this means that a recording or an audiovisual, cinematographic, literary or musical work as such does not fall within the scope of this Directive;

(18) Whereas this Directive is without prejudice to the freedom of authors to decide whether, or in what manner, they will allow their works to be included in a database, in particular whether or not the authorization given is exclusive; whereas the protection of databases by the sui generis right is without prejudice to existing rights over their contents, and whereas in particular where an author or the holder of a related right permits some of his works or subject matter to be included in a database pursuant to a non-exclusive agreement, a third party may make use of those works or subject matter subject to the required consent of the author or of the holder of the related right without the sui generis right of the maker of the database being invoked to prevent him doing so, on condition that those works or subject matter are neither extracted from the database nor re-utilized on the basis thereof;

[...]

(21) Whereas the protection provided for in this Directive relates to databases in which works, data or other materials have been arranged systematically or methodically; whereas it is not necessary for those materials to have been physically stored in an organized manner;

[...]

(27) Whereas copyright in such works and related rights in subject matter thus incorporated into a database are in no way affected by the existence of a separate right in the selection or arrangement of these works and subject matter in a database;

(28) Whereas the moral rights of the natural person who created the database belong to the author and should be exercised according to the legislation of the Member States and the provisions of the Berne Convention for the Protection of Literary and Artistic Works; whereas such moral rights remain outside the scope of this Directive;

(29) Whereas the arrangements applicable to databases created by employees are left to the discretion of the Member States; whereas, therefore nothing in this Directive prevents Member States from stipulating in their legislation that where a database is created by an employee in the execution of his duties or following the instructions given by his employer, the employer exclusively shall be entitled to exercise all economic rights in the database so created, unless otherwise provided by contract;

(30) Whereas the author's exclusive rights should include the right to determine the way in which his work is exploited and by whom, and in particular to control the distribution of his work to unauthorized persons;

[...]

(39) Whereas, in addition to aiming to protect the copyright in the original selection or arrangement of the contents of a database, this Directive seeks to safeguard the position of makers of databases against misappropriation of the results of the financial and professional investment made in obtaining and collection the contents by protecting the whole or substantial parts of a database against certain acts by a user or competitor;

(40) Whereas the object of this sui generis right is to ensure protection of any investment in obtaining, verifying or presenting the contents of a database for the limited duration of the right; whereas such investment may consist in the deployment of financial resources and/or the expending of time, effort and energy;

[...]

(60) Whereas some Member States currently protect under copyright arrangements databases which do not meet the criteria for eligibility for copyright protection laid down in this Directive; whereas, even if the databases concerned are eligible for protection under the right laid down in this Directive to prevent unauthorized extraction and/or re-utilization of their contents, the term of protection under that right is considerably shorter than that which they enjoy under the national arrangements currently in force; whereas harmonization of the criteria for determining whether a database is to be protected by copyright may not have the effect of reducing the term of protection currently enjoyed by the rightholders concerned; whereas a derogation should be laid down to that effect; whereas the effects of such derogation must be confined to the territories of the Member States concerned.

Article 1

Scope

1. This Directive concerns the legal protection of databases in any form.

2. For the purposes of this Directive, 'database` shall mean a collection of independent works, data or other materials arranged in a systematic or methodical way and individually accessible by electronic or other means.

[...]

CHAPTER II

COPYRIGHT

Article 3

Object of protection

1. In accordance with this Directive, databases which, by reason of the selection or arrangement of their contents, constitute the author's own intellectual creation shall be protected as such by copyright. No other criteria shall be applied to determine their eligibility for that protection.

2. The copyright protection of databases provided for by this Directive shall not extend to their contents and shall be without prejudice to any rights subsisting in those contents themselves.

Article 4

Database authorship

1. The author of a database shall be the natural person or group of natural persons who created the base or, where the legislation of the Member States so permits, the legal person designated as the rightholder by that legislation.

[...]

CHAPTER III

SUI GENERIS RIGHT

Article 7

Object of protection

1. Member States shall provide for a right for the maker of a database which shows that there has been qualitatively and/or quantitatively a substantial investment in either the obtaining, verification or presentation of the contents to prevent extraction and/or re-utilization of the whole or of a substantial part, evaluated qualitatively and/or quantitatively, of the contents of that database.

[...]

Article 14

Application over time

1. Protection pursuant to this Directive as regards copyright shall also be available in respect of databases created prior to the date referred to Article 16 (1) which on that date fulfill the requirements laid down in this Directive as regards copyright protection of databases.

2. Notwithstanding paragraph 1, where a database protected under copyright arrangements in a Member State on the date of publication of this Directive does not fulfill the eligibility criteria for copyright protection laid down in Article 3 (1), this Directive shall not result in any curtailing in that Member State of the remaining term of protection afforded under those arrangements.

2.3. National Law

15. The main instrument in the United Kingdom is the Copyright, Designs and Patents Act 1988 (as amended). The relevant provisions are Section 2, Section 3 and Section 3A:

"Section 2 Rights subsisting in copyright works.

(1)The owner of the copyright in a work of any description has the exclusive right to do the acts specified in Chapter II as the acts restricted by the copyright in a work of that description.

Section 3 Literary, dramatic and musical works.

(1)In this Part—

"literary work" means any work, other than a dramatic or musical work, which is written, spoken or sung, and accordingly includes—

(a) a table or compilation other than a database,

[...] and

(d) a database"

Section 3A Databases

(1)In this Part "database" means 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.

(2) For the purposes of this Part a literary work consisting of a database is original if, and only if, by reason of the selection or arrangement of the contents of the database the database constitutes the author's own intellectual creation."

3. THE QUESTIONS REFERRED

1. In Article 3(1) of Directive 96/9/EC on the legal protection of databases what is meant by "databases which, by reason of the selection or arrangement of their contents, constitute the author's own intellectual creation" and in particular

(a) should the intellectual effort and skill of creating data be excluded?

(b) does "selection or arrangement" include adding important significance to a pre-existing item of data (as in fixing the date of a football match);

(c) does "author's own intellectual creation" require more than significant labour and skill from the author, if so what?

2. Does the Directive preclude national rights in the nature of copyright in databases other than those provided for by the Directive?

4. PRELIMINARY REMARKS

16. In relation to the First Question, this is the first occasion that this Court has been asked to consider the scope and eligibility of copyright protection accorded to a database under Chapter II of the Directive.

17. As far as the *sui generis* right is concerned, this Court has previously considered the scope of the *sui generis* right most notably in the *British Horseracing Board* and the three *Fixtures* cases[3] as it concerns horse racing data and football fixture lists and the use that is made by third parties in the betting industries of the contents of those databases. An open question is whether that jurisprudence which concerns the *sui generis right* in Article 7 should influence this Court's analysis of what is an original database in which copyright subsists for the purposes of Article 3. Put simply, whether the effect of the Court's jurisprudence in the *British Horseracing Board* and *Fixtures* cases is that the object of protection in Article 7 (1) is the same as the object of protection in Article 3.

18. It may be convenient at this stage to remind the Court of what was decided in the *British Horseracing Board* and *Fixtures* cases. Here the Court thought it "appropriate to deliver a general ruling on the scope of [the sui generis right in] Article 7(1)".[4] In particular, the Court ruled on the object of protection in Article 7(1) which requires "a substantial investment in either the obtaining, verification or presentation of the contents" as more fully described below:

> *31 Against that background, the expression 'investment in ... the obtaining ... of the contents' of a database must,[...] be understood to refer to the resources used to seek out existing independent materials and collect them in the database, and not to the resources used for the creation as such of independent materials. The purpose of the protection by the sui generis right provided for by the directive is to promote the establishment of storage and processing systems for existing information and not the creation of materials capable of being collected subsequently in a database.*

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[3] Case C-302/02 *British Horseracing Board v William Hill*; Case C-338/02 *Fixtures Markting Ltd v Sneska psel*; Case C-444/02 *Fixtures Marketing Ltd v Organismos prognostikon agonon podofairou AE*; Case C-46/02 *Fixtures marking Ltd V Oy Veikkaus av.*

[4] See paragraph 31 of the judgment in Case C-46/02 *Fixtures Marketing Ltd v Oy Viekkaus av.*

34 The expression 'investment in ... the ... verification ... of the contents' of a database must be understood to refer to the resources used, with a view to ensuring the reliability of the information contained in that database, to monitor the accuracy of the materials collected when the database was created and during its operation. The resources used for verification during the stage of creation of data or other materials which are subsequently collected in a database, on the other hand, are resources used in creating a database and cannot therefore be taken into account in order to assess whether there was substantial investment in the terms of Article 7(1) of the directive.

35 In that light, the fact that the creation of a database is linked to the exercise of a principal activity in which the person creating the database is also the creator of the materials contained in the database does not, as such, preclude that person from claiming the protection of the sui generis right, provided that he establishes that the obtaining of those materials, their verification or their presentation, in the sense described in paragraphs 31 to 34 of this judgment, required substantial investment in quantitative or qualitative terms, which was independent of the resources used to create those materials.

19. Therefore, the Court concluded for the purposes of the *sui generis* right that in general an "investment" in "obtaining" excludes the resources used in the creation of data itself and refers instead to the "resources used to seek out existing independent materials and use them in the database". The Court did not preclude that the creator of the materials in the database could claim the *sui generis* right but that person is required to establish that there has been a substantial investment in so doing. In the circumstances of the *British Horseracing Board* and *Fixtures* cases, the Court found that such an investment had not been established.

20. At the heart of the Appellants case is that this Court's jurisprudence on the scope of the *sui generis* right should be applied by analogy to the scope of copyright protection and that accordingly copyright cannot subsist in a database in circumstances where the natural persons that are the authors (Messrs Thompson et el) have themselves created the data as well as the structure. In their view "Article 3 is limited to selection or arrangement of "pre-existing data." In other words, if the Appellants' argument is followed, the database in question would not qualify for copyright protection as the authors have themselves created the data and have not made use of independent resources.

21. The Commission submits that the specific subject matter of copyright in a database for the purposes of Article 3 is inherently different from the *sui generis* right in Article 7(1). This is demonstrated by both the intention of the EU legislature and the

wording of the respective provisions of the Directive and related Recitals in particular, Article 3 for the purposes of copyright in a database construed alongside Recitals (15) and (16); and Article 7 for the purposes of the *sui generis* right construed in the light of Recital (39), (40) and (41).

22. The Directive harmonises on the hand, copyright protection of databases which by reason of the *selection or arrangement of their contents* (emphasis added) constitute the author's own intellectual creation; and at the same time, the Directive introduces a new *sui generis* right for makers of databases in which there has been *substantial investment in the contents* (emphasis added) (See to this effect Recitals (39) and (40)).

23. Copyright protection is afforded to the selection or arrangement of the contents and not to any investment in the contents. The *sui generis* right is a right to prevent misappropriation of the contents of a database in which there has been a substantial investment. Accordingly, if the object of protection is intended to be different and this is also demonstrated by the text of the respective provisions, there should be no read across of the analysis undertaken in this Court's previous case law for the purposes of Article 7 to Article 3 even where the facts concern the same type of database.

24. That being said, the Commission is aware that, as the Court of Appeal points out at paragraph 19 of the Order for Reference, there is a risk that a different approach on Article 3 might bypass the Court's jurisprudence on Article 7. However, the Commission considers that this might be an inevitable consequence of the bifurcation of protection in the Directive. It should not be the case that the same effect or result would be arrived at depending on whether copyright or the *sui generis* rights is invoked in relation to a particular database. That would defeat the aim of the harmonisation as set out in Recital (39) and (40). This was expressed to be a different object and level of protection in terms of object, restricted acts, duration and beneficiary.

25. Although this Order for Reference does not call for a comprehensive examination of the differences between both rights, nevertheless, one salient difference stands out which is key to the Order for Reference: the beneficiary of protection under Article 3 is an author. Under Article 4, an author is "the natural person or group of natural

persons who created the base or where the legislation of the Member State so permits, the legal person designated." In the case of the United Kingdom, the legislation so permits the Appellants to be the rightholder, as the owner.

26. In contrast, the *sui generis* right is accorded to a "maker of a database which shows that there has been a substantial investment." In many instances, this person might very well be a different person (whether natural or legal) for the purposes of Article 7 to the author who does the act of creating for the purposes of Article 3 and 4. The maker of the database may be entirely extraneous to the work such as an investor or venture capitalist whereas an author will always have a more intimate connection with the work as its creator. Indeed, Recital (28) recognises that the author might have moral rights under national law.

27. Indeed, what appears to be the concern of the Referring Court is not whether the same result would be arrived at as far as the rights are concerned. Rather, the concern appears to be that a different result might be arrived at for copyright as far as *fixtures lists* are concerned (emphasis added).

28. In this respect, the Commission would like to make two brief remarks.

29. First, as with computer programs for the purposes of Directive 91/250 (now Directive 2009/24) on the legal protection of computer programs, databases are essentially utilitarian works with little or no appeal to the senses. Yet both at international and EU level there has been a deliberate policy choice to accord protection to databases (where they meet the requirements) as copyright works in the sense of the "author's own intellectual creation." Indeed, the natural person or author also has moral rights in the database (See Recital (28) of the Directive). The challenge with such utilitarian or mundane works has always been as how to make an assessment of copyright protection which does not treat such works differently from other "literary works" either because of specificities of the industry in which the database is created or because the database itself might appear to not merit it because of its utilitarian nature.

30. Second, in that context, it seems to the Commission that the issue is not whether fixture lists ***per se*** as a category are eligible for any sort of protection at all. Rather the question is whether these *particular* fixture lists, in the light of the findings of

fact set out in the High Court judgment, meet the eligibility requirements for copyright protection as an original database(s) in the sense of the author's own intellectual arrangement within the meaning of Article 3(1) and read alongside Recitals (15) and (16) of the Directive.

31. That assessment of Article 3(1) needs to be made in the light of the Court's case law on the threshold of originality. Since the Court handed down its judgments in the *British Horseracing Board* and *Fixtures* cases, this Court has ruled in *Infopaq,*[5] on the threshold of originality required for copyright protection in EU law in a rather horizontal manner. In formulating that test, the Court used as its point of departure, the various EU directives in the area of copyright. It stated that "under Articles 1(3) of Directive 91/250, 3(1) of Directive 96/9 and 6 of Directive 2006/116, works such as computer programs, databases or photographs are protected by copyright only if they are original in the sense that they are their author's own intellectual creation" (paragraph 35 of *Infopaq*). The Court then went on to formulate that test as follows at paragraph 45:

> *" Regarding the elements of such works covered by the protection, it should be observed that they consist of words which, considered in isolation, are not as such an intellectual creation of the author who employs them. It is only through the choice, sequence and combination of those words that the author may express his creativity in an original manner and achieve a result which is an intellectual creation."*

32. With the present reference, the Referring Court is seeking guidance on the scope of that particular provision, Article 3 which is one of the bases of the Court's test of originality. Although that test was applied in *Infopaq* in relation to newspaper articles under Article 2 of Directive 2001/29, the Commission submits that the same approach can be taken for the purposes of Article 3 of the Directive and that an author may express his creativity through the choice, sequence and combination of data in relation to the structure of a database and achieve a result which is an intellectual creation.

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[5] Case C-5/08 Judgment of 16 July 2009 *Infopaq International A/S v Danske Dagblades Forening*

5. ANALYSIS OF THE QUESTIONS REFERRED FOR A PRELIMINARY RULING

33. The Referring Court considers that the question of whether copyright subsists in the fixture lists is not *acte clair* for the reasons set out at paragraphs 16-21 of the Order for Reference. Apart from enquiring as to what is the correct level of "skill and judgment" required, the Referring Court seeks clarification as to "the meaning and limits" of "author's own intellectual creation." The Appellants' main contention against a finding of copyright under Article 3 is that the Respondents are "creating" data and that in their view following the *British Horseracing Board* and *Fixtures* cases, Article 3 is limited to the "selection or arrangement *of pre-existing* data."

34. The Respondents maintain that the High Court was right when it held that copyright subsisted in the fixtures lists but if the High Court judge was wrong about copyright under Article 3, then in the alternative either the *sui generis* right subsists under Article 7; or failing that the national right should apply.

35. The Referring Court considers the question of whether any national right exists should also be referred, in the event that the fixture lists do not qualify for copyright protection under the Directive. However, the Referring Court doubts that this is the case as in its view it would defeat the aim of harmonisation (paragraphs 13-15 of the Order for Reference).

36. However, the Referring Court considers that the question of whether a *sui generis* right exists in the fixture lists is *acte clair* in the light of this Court's previous jurisprudence. Applying the *British Horseracing Board* and *Fixtures* rulings of this Court, the Referring Court finds that there is no *sui generis* right and has declined to ask this Court to revisit the question (paragraphs 10-12 of the Order for Reference). The Commission submits that the Referring Court is correct on this point.

37. In relation to the Second Question, the Commission considers that the Court should also interpret Article 1(2), and Article 14 as it is for the Court to provide the national court with all the elements of interpretation of EU law which may be of assistance in adjudicating the case before it, whether or not that court specifically refers to them in its questions (Case C-456/20 Trojani [2004] ECR I-0000, paragraph 38).

38. Article 1(2) defines a database and the term is applied to both the *sui generis* right and copyright in databases. Underlying the Second Question is whether full

harmonisation has been achieved in relation to the types of work in question, as far as copyright is concerned. In order to properly answer this question, the term "database" in Article 1(2) will need to be examined both for the purposes of the object of protection under Article 3(1) but also in relation to whether full harmonisation is achieved where a work meets the requirements of the definition but fails to meet the threshold of originality and thereby eligibility for copyright protection.

39. In addition, and also in relation to the Second Question, the Commission submits that Article 14 and the accompanying Recital (60) should also be interpreted as it specifically envisages that under existing copyright arrangements in Member States, there may be databases which no longer meet the eligibility for copyright protection with the introduction of Article 3; and with Article 14, a specific transitional provision was introduced for such databases.

5.1. Legal Analysis

Relevance of the international conventions

40. It is settled case law that EU legislation must, so far as possible, be interpreted in a manner that is consistent with international law.[6] Article 5 of the WCT and Article 10 (2) of TRIPS are stated to be consistent with each other and offer a parity of protection. Indeed, although the Directive was not specifically introduced to implement any existing international convention, it took as its basis for harmonisation, the relevant provisions of the Berne Convention[7].

41. There is also evidence from its legislative history which coincided with the negotiation of the TRIPS Agreement that changes were introduced by the EU legislature to ensure as far as possible that the Directive reflected the TRIPS Agreement and the ongoing discussions that led to the WCT.[8]

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6 Case C-456/06 *Peek & Cloppenburg KG v Cassina SpA* Judgment of the Court of 17 April 2008, paragraph 30 and case law referred to therein.

7 COM (92) 24 Final-SYN 393 Proposal for a Council Directive on the legal protection of databases and draft recital 19 and Article 1.

8 Common Position (EC) No 20/95 adopted by the Council on 10 July 1995 OJ C288 30.10.1995 p.0014.

42. In this respect, unlike the *sui generis* right which is a complete creation of the EU legislature and which has no equivalent in any international intellectual property convention, the relevant international conventions require "compilations of data" to be protected by copyright. Therefore, as far as copyright in a database is concerned, the parameters of that right should be interpreted in the light of the relevant international conventions and not solely by reference to the relevant EU measure. In the Commission's submission, there is no such constraint on the interpretation of the *sui generis* right.

First Question

43. The question is framed only in the context of Article 3(1) which sets out the object of protection and establishes the threshold of protection. However, the object of protection in Article 3(1) of the Directive cannot be ascertained using a literal interpretation of that provision to the exclusion of any other. According to settled case-law, in interpreting a provision of EU law it is necessary to consider not only its wording, but also the context in which it occurs and the objectives pursued by the rules of which it is part.[9]

44. The Commission submits that both Article 3(1) and Article 3(2) should be interpreted.

45. Therefore, before turning to the individual limbs of the First Question which focus on Article 3(1), the Commission will deal more generally with Article 3 as set out in the introduction to the First Question

"In Article 3(1) of Directive 96/9 on the legal protection of databases what is meant "databases which by reason of the selection or arrangement of their contents, constitute the author's own intellectual creation"

46. According to Art 3 (1) of the Directive "databases which, by reason of the selection or arrangement of their contents, constitute the author's own intellectual creation shall be protected as such by copyright. No other criteria shall be applied to determine their eligibility for protection."

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[9] See, in particular, Case C-156/98 *Germany* v *Commission* [2000] ECR I-6857, paragraph 50, and Case C-53/05 *Commission* v *Portugal* [2006] ECR I-0000, paragraph 20).

47. Moreover, this provision should be read alongside Recital (16) which states that "no criterion other than originality... should be applied to determine the eligibility for copyright protection, and in particular no aesthetic or qualitative criteria should be applied"

48. This is consistent with Art 5 of the WCT and Art 10 (2) of the TRIPS Agreement.

49. In *Infopaq* the Court stated that "databases ... are protected by copyright only if they are original in the sense that they are their author's own intellectual creation" (paragraph 35).

50. Furthermore, as previously stated above at paragraph 31, in formulating its test in *Infopaq* the Court stated that in order to "achieve a result which is an intellectual creation", the author has to "express his creativity in an original manner" (paragraph 45 of *Infopaq*).

51. The concept of "the author's own intellectual creation" appears in a provision of the Directive which does not contain any reference to national law and must therefore be regarded as an autonomous concept of European Union law. As already indicated by the Court in *Infopaq*, the standard of originality set by the expression "the author's own intellectual creation" should be regarded as a general common benchmark in the copyright acquis. In the Commission's submission, this though should take account of the specificities of each type of protected work whilst nevertheless seeking to ensure that works such as databases are not treated differently simply because they are utilitarian.

52. The less freedom an author has to express his personality and individual creativity, that is the more his activity is governed by rules and specifications, the less likely it is that the arrangement of the database will be considered as original in the sense of the author's own intellectual creation. It is ultimately for the national judge to decide whether the rules according to which the fixtures lists were established, left its creator a margin to express his originality.

53. It is also up to the national court to assess whether the creation of the structure of the fixture lists reflects the author's individual creativity.

54. Turning now to the individual limbs of the First Question:

(a) should the intellectual effort and skill of creating data be excluded

55. This limb of the Referring Court's question is partly framed in the light of the old English law test of "skill, labour and judgment" which is the common law test applied to assess whether a work qualifies for copyright protection as an original work. Although the Referring Court omits the term "labour", the reference to "effort" and "skill" could still be interpreted as referring to that test. This test should no longer apply in English law following the entry into force of the Directive. This is acknowledged in paragraph 53 of the High Court judgment.

56. In this regard, the Commission submits that this test of eligibility for copyright protection in English law of "skill labour and judgment" (which admittedly is of very long standing)[10] and derived from the case law is not compatible with this Court's judgment in *Infopaq*. The reply to the First Question should be framed in the light of the Court's own test in *Infopaq* which sets out the test for originality for a literary work or part thereof which should apply to databases as with any other literary work. Accordingly, only originality in the sense that it is the author's own intellectual output may be taken into account when assessing whether a database constitutes the author's own intellectual creation.

57. However, not everything that originates with the author qualifies for copyright protection.

58. The object of protection under Art 3(1) of the Directive is the structure of the database, resulting from an original "arrangement or selection" and that originality is expended in creating the *structure* i.e. the specific arrangement or selection of data. In the present case, the person or persons creating the data namely the data entries for each match which make up the contents of the database (and to which protection does not extend in the case of copyright) is also the person or persons creating the structure of the database. Where the author's intellectual creation is needed to create data *(contents)*, this should not be taken into account as a relevant factor when assessing whether a database qualifies for copyright protection under Article 3 (1) of

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[10] See in this respect, The Newspaper Licensing Agency Ltd and others v Melwater Holding BV and other [2010 EWHC 3099 9 Ch] at paragraph 75.

the Directive as the object of protection is not the contents. Nor should it disqualify the structure from protection by copyright.

59. Moreover, Article 3(1) has to be read alongside Article 3(2) which states that copyright protection does not extend to the contents of the database and is without "prejudice to any rights subsisting in those contents themselves".

60. A similar provision to Article 3 (2) is found in the second sentence of Article 10 (2) of TRIPS and Article 5 of the WCT. In this context, at last one academic commentator considers that:

> *"Article 10 (2) states the usual rule in this connection (also found in article 14 of the Berne Convention) that copyright in pre-existing material is not affected by inclusion in the database. In other words, where such material is reproduced in the database, authorisation of the rightholder will be required...*[11]*"*

61. There are two aspects to Article 3(2). First, unlike the *sui generis* right, it places it beyond doubt that no protection is accorded to the contents. Second, this provision should also be read alongside Recital (18) of the Directive which states that "this Directive is without prejudice to the freedom of authors to decide whether, or in what manner, they will allow their works to be included in a database." There is nothing to suggest any intention that such freedom should be restricted or curtailed in the case of the author who creates the data and the database himself and irrespective of whether those data fall to considered as "works" or not.

62. Of course, that leaves open the issue of whether there is a line to be drawn between the creation of a database structure and the creation of the data itself. In the present case, the Commission considers that the act of matching clubs to play matches against each other and fixing a date for these matches is still part of the process of creating data, not linked to the creation of the structure of database. In the case at hand, the Appellants claim that creativity might have been employed in the creation of the datasets, but none has been employed in arranging or selecting this data in a database namely the fixtures list. It seems that what the Appellants are trying to state with this argument is that deprived of the data, the structure is merely an "empty shell" but that in itself does not mean that it is not protected.

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[11] The TRIPS AGREEMENT Drafting History and analysis Second Edition Daniel Gervais Sweet & Maxwell 2003

63. In any event, the Commission considers that that is a matter for the national court to assess considering the structure as a whole, with or without the data. As stated above, the object of protection of the right pursuant to Art 3(1) of the Directive is the arrangement or selection of contents, not the contents themselves. Therefore, the originality expended in creating items of data (e.g. establishing the date and time of a football match) is not relevant. Only originality of creation expended in a specific arrangement or selection of (pre-existing and/or created) data may be included in the assessment whether a database is the author's own intellectual creation, i.e. the assessment whether it reflects the personality and the individual creativity of its author.

64. It is also up to the national court to assess whether the creation of the structure of the fixture lists reflects the author's individual creativity.

(b) does "selection or arrangement" include adding important significance to a pre-existing item of data (as in fixing the date of a football match)

65. The arrangement of data is already part of the definition of a database pursuant to Art (1) 2 of the Directive. The definition of a database already pre-supposes an element of arrangement. However, given that the definition of database covers both rights, the Commission submits that something more is required in order to comply with Article 3(1) and the reference to "selection or arrangement" in that Article in order to qualify for copyright protection. Protection arises out of the fact that data has been selected or arranged in a particular manner.

66. Indeed, if the test of originality is that of demonstrating the creativity of the author as set out in this Court's judgment in paragraph 45 of *Infopaq,* so that in order to "achieve a result which is an intellectual creation", the author has to "express his creativity in an original manner" (paragraph 45 of *Infopaq*), then the author should have a certain freedom to create that structure as he chooses even where he is acting under instructions. His protection is not dependent on establishing an investment in the "obtaining" of the contents (unlike the *sui generis* right).

67. Turning now to whether it makes a difference to his selection or arrangement decisions that the author is confronted with pre-existing data, the Commission submits that this should not be taken into account.

68. The Appellants argue that the distinction between pre-existing and newly created data, as established by the Court's jurisprudence, equally applies to the interpretation of Article 3(1) of the Directive. The distinction made by the Court between pre-existing and newly created items of data concerned the assessment of the "substantial investment" needed to qualify for protection under Article 7(1) of the Directive which relied upon an investment, inter alia in "obtaining". This requirement in Article 7(1) of having to demonstrate a financial and professional investment in "obtaining" the contents is key to the Court's analysis.

69. The Commission refers to paragraph 81 of the High Court judgment where the judge states that "the process of selection and arrangement of the contents of the database can and often will commence before all the data is finally created ... to cut from consideration these selection decisions, merely because they occur whilst the database is being created, seems ... arbitrary, and conceptually fraught with difficulty." In the view of the Commission, the question of which comes first, the data or the structure is immaterial for the purposes of the copyright in the database.

70. This implies that "selection [or arrangement] decisions" as it is termed by the High Court judge would need to be made by the author in relation to the contents.

71. In this respect, the reasoning of the *British Horseracing Board* and *Fixtures* cases on Article 7 is not applicable to Article 3.

72. In the *British Horseracing Board* and *Fixtures* cases, the Court ruled that there is no *sui generis* right pursuant to Art 7 of the Directive in fixtures lists. In order to arrive at this conclusion, the Court distinguished between "the establishment of storage and processing systems for existing information" and "the creation of materials capable of being collected subsequently in a database[12]." The Court clarified that the *sui generis* right under Article 7 (1) of the Directive only protects investment that is directed towards the production of the database itself and not that of its contents.

"Resources deployed for the purpose of determining, in the course of arranging the football league fixtures, the dates and times of and home and away teams playing in the various matches represent ... an investment in the creation of the fixture list.

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[12] Case C-444/02 *Fixtures Marketing Ltd v Organismos prognostikon agonon podofairou AE*; paragraph 40.

Such an investment ... is linked to the creation of the data contained in the database ... It cannot, therefore, be taken into account under Article 7(1) of the directive.[13]"

73. The Court arguably made this distinction to ensure that Article 7(1) of the Directive would only be used to protect the substantial investment made in the contents of a database (Recital (39)). However, it is important to bear in mind that the Court, in any event, did not preclude that the *sui generis* right could nevertheless apply where the data had been devised by the maker of the database itself. On the facts of those cases, it had not been demonstrated that there had been an investment in doing so.

(c) does "author's own intellectual creation" require more than significant labour and skill from the author, if so what?

74. As is the case with limb (a), this limb of the First Question is framed in the context of the old English law test of originality in its reference to "significant labour and skill". As previously set out above in relation to limb (a), the originality requirement in Art 3(1) of the Directive is different from the "sweat of the brow" doctrine, according to which considerable skill, labour or judgment in arranging or selecting the contents sufficed in order to qualify for database protection. In order to qualify for protection under Art 3(1) of the Directive, it is therefore not sufficient that the preparation of a database involves considerable "significant labour and skill" of its creator. The Commission submits that no separate response is required for this limb of the First Question. If the Court wishes to respond to this limb, the Court should address its own test in *Infopaq*.

Second Question

Does the Directive preclude national rights in the nature of copyright in databases other than those provided for by the Directive?

Article 1 (2) of the Directive

75. In order to properly answer this question, the Commission considers that the scope of the definition of database should be considered and the level of harmonisation achieved with the Directive.

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[13] Case C-444/02 *Fixtures Marketing Ltd v Organismos prognostikon agonon podofairou AE*, paragraph 47.

76. The term database as defined in Article 1 (2) is an autonomous concept of EU law. The definition of database applies to both databases protected by copyright under Chapter II and under the *sui generis* right under Chapter III.

77. The relevant international conventions (Article 10(2) of TRIPS and Article 5 of the WCT) use the term "compilations of data". The use of the term "database" in the Directive stems from the fact that as originally proposed, the Directive was intended to cover electronic databases only.[14] It is arguable that the term "compilation" is broader in scope than the definition in Article 1(2) of the Directive which would appear to narrow the scope of what is a protected database to those databases where the items are arranged in a systematic or methodical way and are individually accessible.

78. In Case C-444/02 *Fixtures Marketing Ltd v Organismos prognostikon agonon podofairou AE*, the Court stated that "the compilation of dates, times and names of teams relating to the various fixtures in a football league is ... a collection of independent materials. The arrangement, in the form of a fixture list, of the dates, times and names of teams in those various football matches meets the conditions as to systematic or methodical arrangement and individual accessibility of the constituent materials of that collection." For the purposes of the present case, this point is not in contention and it is therefore accepted that the fixture lists are databases within the meaning of Article 1(2).

Level of harmonisation

79. Pursuant to Recital (2) of the Directive "differences in the legal protection of databases offered by the legislation of the Member States have direct negative effects on the functioning of the internal market as regards databases". Recital (3) clarifies that "existing differences distorting the functioning of the internal market need to be removed and new ones prevented from arising". Recital (4) stresses that "unharmonized intellectual property rights can have the effect of preventing the free movement of goods or services within the Community".

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[14] COM (92) 24 Final-SYN 393 Proposal for a Council Directive on the legal protection of databases and draft recital 19 and Article 1.

80. It follows from these Recitals that the harmonisation of the substantive law of copyright in databases was one of the key objectives of the Directive. Harmonisation is not compatible with the existence of additional copyright for databases as defined under Article 1 (2) under national law.

81. The Appellants argue that the Directive only created two *additional* rights (the Article 3 copyright and the Article 7 *sui generis* right), leaving national rules that provide for additional copyright protection of databases intact. They rely particularly on Recitals (18), (26) and (27) of the Directive. The Commission submits that this is a misreading of those Recitals and the scope of harmonisation undertaken.

82. The above mentioned Recitals do not support the view that the Directive only created additional rights. As laid out correctly by the Referring Court, these Recitals only clarify that any copyright in works included within a database are not affected by the fact that they are included in a database. Accordingly, Article 3 (2) states that "the copyright protection of databases provided for by this Directive shall not extend to their contents and shall be without prejudice to any rights subsisting in those contents themselves".

83. It should also be noted that, if the Directive was not intended to be exhaustive in respect of the databases that merit copyright protection, the difficult bifurcation between original databases protected by copyright and *sui generis* databases would hardly have been necessary. The introduction of the *sui generis* right and the full harmonisation of copyright for databases, as defined, indicate, that the drafters of the Directive wanted to resolve the matter of which databases were to be protected at EU level in a definitive manner. This is also borne out by Recital (16) which confirms that no other standard than that of originality should apply to determine whether a database qualifies for copyright protection.

Transitional arrangements

84. In addition, Article 14 of the Directive was introduced to ensure that where databases, as defined under Article 1(2) could not meet the test for copyright protection under Article 3 (1) but had benefited previously from national copyright protection under another test, those databases would continue to enjoy protection for the duration of the term of protection. The effect of this provision is threefold.

85. First, it is clear from that provision that as from the date of implementation of the Directive, newly created databases as defined within the meaning of Article 1(2), would only qualify for copyright protection under the terms of Article 3(1).

86. Second, Article 14 (1) expressly addresses existing databases, which as of the relevant date set out in Article 16(1) (1st January 1998) may, nevertheless, still qualify for copyright protection under Article 3 (1) if such databases meet the requirements.

87. Third, in recognition of the fact that there may be an impact on existing property rights, Article 14 (2) introduces a saving provision. Pursuant to this provision, there would be no "curtailing" of protection for existing databases which do not meet the threshold of originality under Article 3(1) for the duration of their term. In order to benefit from this saving provision, that database needs to have been protected under the national law "on the date of publication of this Directive." The date of publication of the Directive in the Official Journal is 27th March 1996.

88. In the event that following a ruling of this Court on the scope of protection, if the national court then considers that the fixture lists do not qualify for copyright protection under Article 3(1), it is for the national court to determine first as a question of fact whether those databases were in existence at the relevant date in Article 14(2) and whether they would have been protected at that date under the previous common law approach of assessing originality on the basis of "labour, skill and judgment." In which case, the fixture lists may still benefit from national copyright treatment under Article 14 (2).

89. In conclusion, insofar as these fixture lists are databases within the meaning of Article 1(2), then for the purposes of copyright, either the databases meet the requirements of Article 3 or they fall to be considered under Article 14 (2). The Appellants' case is misguided insofar as they are seeking to rely on any other form of protection for databases in national law. There should be no other form of protection for databases following the entry into force of the Directive.

6. CONCLUSION

90. The Commission, therefore, proposes the following responses to the questions of the Referring Court:

First Question

"Article 3 (1) of Directive 96/9 on the legal protection of databases has to be interpreted in the sense that the expression 'Databases which, by reason of the selection or arrangement of their contents, constitute the author's own intellectual creation' means databases which reflect the creativity of expression of its author in the selection or arrangement of the contents of the database(s).

In assessing whether a database reflects the creativity of expression of its author,

(a) no account should be taken of the creation of the contents;
(b) it is irrelevant whether those data are pre-existing or not;
(c) no reply is necessary to this limb of the First Question.

Second Question

Except where Article 14(2) applies, the Directive precludes national rights in the nature of copyright in respect of databases as defined in Article 1(2) of the Directive."

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Agents of the Commission