Copyright and Related Rights Law

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WEEK - 05

LECTURE – 22

Threshold of Creativity?

Welcome back to this course on copyright and related rights law. This week we are discussing the concept of originality, and how this concept applies as a requirement for the satisfaction of subsistence of copyright, in relation to subject matters. In the previous discussion, we considered how original and originality can be split into two dimensions. The first dimension is a simple question of whether a given expression has been copied from another expression or not, and if it has not been copied, then it is original. In this session, we are going to discuss a second dimension, which is a question of whether there should be a threshold of creativity. An additional consideration beyond the first dimension of whether there is any copying or not, or in other words, whether there is independence of creation.

Let us start with the University of London Press case once again. In this case, I must stress again for clarity that in the first layer, an objective assessment is conducted, wherein - If an expression fits the requirements of a subject matter, it is categorized, and then a question of whether it is original or not is considered. Original, according to the court is simply independence of creation, that it must not be copied. But the Court also highlighted that the term "original" does not mean original in the sense of inventive thought.

The Court highlighted: Copyright acts are not concerned with the originality of ideas, rather with the expression of thought. In this second dimension, we are looking at how we should consider expressions of thought as copyrightable, as distinguished from inventive thought. In fact, by making such a distinction, the Court seems to be suggesting that there is some level of creativity that is required for inventive thought, and that is not required for copyrightable expression. What is that level? This is what we are looking to focus on in today's session. When we talk about levels, scientific temperament tells us that some kind of objective assessment must also be possible at this point.

That is, if inventive thought is different from originality in terms of copyrightable expression, then it should be possible to objectively identify these levels, because only then can we say that one is copyrightable and one is patentable. But in terms of what the subject matter can include, it is functionality. Therefore, in terms of what this level is looking to highlight, is merely a distinction of creative input and not in terms of the subject matter itself. In which case, isn't this in some way a subjective analysis that should be a case-by-case consideration? Let us consider the requirements of novelty in patent law. In our earlier discussions, we made a distinction between what is copyrightable and what is patentable.

You would recall in Baker v. Seldon, when we discussed how the US Supreme Court made a distinction between idea and expression. An example that the court referred to, was when a doctor wrote about a particular medicinal formulation and its effect on the patient. The medicine itself cannot be prevented from unauthorized use if a book has been written about it. Rather, there must be a patent that is sought and registered for the medicine itself.

The functional consideration is obvious here, but in terms of the level of creative input that is required for a patent to be granted - There is a level of novelty and inventive step which we can clearly see, as well as this idea of an inventive thought. Consider this example. You can see a simple example of a claim. What is a claim? When an inventor files an application for the grant of a patent, he provides certain claims in his patent application. These claims provide a boundary for what he intends to cover as part of the patentable invention.

For example, the claim reads like this. It says - I claim a tool comprising Part A, Part B, and Part C, which connects Part A and Part D. You can see from this claim, that the inventor is claiming a patent on a mechanical device, in which there are specific components that interact with each other in a particular way. Where a new part is added by someone else. Where the claim now reads: I claim a tool comprising part D, part A, part B, and part C, which connects part A and part B.

You can see that from this earlier claim, there is now a new ingredient that has been added. Novelty and novelty analysis must be made by comparing elements in the prior art with those of the invention element by element. It would not be possible for there to be some kind of mosaicing effort to say that this particular claim is not novel. What does that mean? If part D is present in the claim of some other inventor, but not with these specific elements that have been posed here, then a combination of this particular claim and the other claim cannot be used to defeat the novelty of this particular claim. Novelty, therefore, in patent law is a question of whether a new element has been introduced from what exists in the prior art.

This is the prior art. Confused? Let us consider in some detail what prior art is. Prior art includes all information related to the invention that is available on the date of the patent application. We have discussed that an invention is connected to a product or a process, something that serves a specific utility and can be made industrially. We have also discussed that in terms of what is copyrightable prior information, and its connection to the expression which has been made and which is being claimed as copyrightable - can only have a connection, if the prior information has copyright in it.

If it is in the public domain, then the expression can be provided in a different manner through a distinct form of expression. Let us now consider what the inventive step is. The inventive step is interpreted to mean that these provisions are included in this, as well as the provisions I have cited here from the Indian Patent Act. The provision here reads: Inventive step means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art. See from this interpretation of what an inventive step is: this addition of part D in this claim may satisfy the novelty consideration, but when the inventive step consideration is brought in - then we are asking the question of whether the addition of part D to the prior art is an obvious addition to a person skilled in the art.

If it is not an obvious addition, then it would be considered an inventive step. Try to answer this question. How could an improvement on something known before satisfy the inventive step? I'm sure you are now able to answer that if the improvement is not obvious to a person skilled in the art, then it will be considered an inventive step. In order to explain what inventive thought is, I have sought to provide a very simplistic understanding of the very important ingredients in patent law: novelty and inventive step. I must say that this explanation has only been provided for the purpose of making a comparison between originality and novelty.

But these concepts of novelty and inventive steps are very detailed in themselves and need their own separate consideration. But no doubt, for our purposes, now that we look at this particular explanation: what we are able to understand is that if a person expresses an idea in a particular way, then the idea itself need not be new. And second, the expression need not be in a particular manner that is not obvious to anybody else. And therefore, we can say that determining what is an inventive thought capable of patent protection is a high threshold that needs to be satisfied. In fact, regarding this threshold, it was clearly explained by the Indian Supreme Court in the very important case of Bishwanath Prasad Radhey Shyam versus Hindustan Metal Industries, that not just any workshop improvement could satisfy the inventive step.

But isn't it possible for improvements to be made to an existing expression in such a way that the addition made is somehow transforming the nature of that expression? In terms of

what you see in this image, a person is wearing an ordinary boot. You can see in this image a boot, that is specifically designed for better traction to play football on a field. What you can see this has done is the addition of an inventive thought. It has been able to solve the problem. In effect, it is also functional.

But in this particular image, you can see a person who is playing football. He is playing with a particular shoe that has spikes on its soles. This particular image can be expressed in many different ways by various authors. And that is the distinction between what is patentable and what is copyrightable. Copyrights can be based on the same idea, and the expression can vary.

This variation of expression is what we are interested in. Is this variance original simply because it is not copied from one another? One thing seems to be clear: be it a subject matter under patent or a subject matter under copyright, these are both results of creative thought. What is also clear is that the satisfaction of patentability for an invention is a high-threshold satisfaction. Whereas the threshold for originality in comparison seems like a low threshold of satisfaction. Again, what does the threshold mean here? The ordinary meaning of threshold is a level, rate, or amount at which something comes into effect.

Think for a moment. The expression of a commonplace idea: should it be copyrighted? You would recall that in our discussion, we discussed the doctrine of merger. Where we had stated that if an idea is expressed in such a way that the idea cannot be expressed in any other way, then the expression is nothing but the idea itself and, therefore, not something copyright can protect. But an image such as this can be a common source of a variety of different expressions. An image such as this can be the source of a variety of different expressions. Should it be possible for expressions to be considered copyrightable if they simply express something that is very generic? In other words, there is seemingly no effort, seemingly no skill, and seemingly no application of mind.

And if all that was needed was no copying, then many expressions of the same idea that help with similarities would be copyrightable. Meaning what? Copyright protection would essentially act as a stumbling block - where creators themselves would not be clear on whether they are eligible for copyright protection or not, then many expressions of the same idea albeit with similarities would be copyrightable. Let us consider whether effort can be a possible threshold. How much effort would a photographer have to put into taking this photograph? Sure, he would have to set the scene. He would have to ask the subjects to pose in a certain way.

Is that enough effort? What about skills? Is there any skill? If there are, then many expressions of the same idea with similarities would be copyrightable. Let us consider the question of whether effort can be a possible threshold marker. What are we looking to

find? Has there been enough expenditure of labor and time in creating a creative expression? Is this a threshold marker? You would see that this is inherently problematic because effort is tied to skills. For a skilled professional, it might be easier to produce a creative expression with little effort compared to a person who is less skilled. Thus, should we be considering skill as a possible threshold? What about judgment or the application of the mind? Should this be considered a threshold? You can see that, be it effort, skill, judgment, or application of mind, all of these can be used in subjective considerations on a case-by-case basis.

For a painting by a given person, we might have to use this particular combination in a specific way. For a book written by a particular author, we might have to use it in some other ways. Consider the case of telephone directories, something that we touched upon in a previous session. How much effort does it take to collect information for the purpose of creating a telephone directory? Is the effort itself sufficient to grant this person copyright protection? Is there any skill that is needed to collect this information? What about the manner of its arrangement? Should there be any application of the mind? Therefore, we see that these considerations are very subjective. In fact, only if we see this on a case-by-case basis will we be able to answer what could be a possible threshold.

Such is the scenario that an attempt to make some kind of objective distinction between creative expressions and what kind of creative expression, and at what level it will be considered copyrightable, is very problematic. What we'll be looking at in the next session is whether originality has any role to play in the determination of the existence of works in terms of the subsistence of copyright. From then on, we will take a look at how different courts have addressed the seemingly difficult question of how originality must be considered and applied. Thank you for joining me.

See you all in the next session. Thank you.