

*Case C-406/10 SAS Institute*

**Speech of the United Kingdom  
For Oral Hearing before the ECJ on 21 September 2011, 0930**

**Introduction**

1. Mr President Members of the Court,
2. The United Kingdom did not file written observations. However having reviewed the observations of the parties, the Member States and, in particular of the Commission, we considered that it was necessary to make submissions on some of the referred questions.
3. I propose to address questions 1, 2, 8 and 9 from the referring Court. While these questions raise a number of complex individual issues, I will focus on a subject which underlies these questions which is this – in order to infringe the copyright in a literary work, whether a computer program or otherwise, does it suffice to reproduce any part, however insubstantial or trivial?
4. I will suggest that the answer to this question is clearly no.
5. Finally, I will also provide the United Kingdom's response to the questions from this Court relating to the relevance of patent law and the judgment of the Court in Case C-393/09 *Bezpečnostní softwarová asociace*.

**"In whole or in part"**

6. Article 2 of Directive 2001/29 on the harmonisation of certain aspects of copyright and related rights in the information society provides the scope of the reproduction right. It states that Member States shall provide the exclusive right to authorise or prohibit direct or indirect,

temporary or permanent reproduction by any means and in any form, in whole or in part."

7. This wording, "in whole or in part" is echoed in Article 4(a) of Directive 2009/24 on the legal protection of computer programs.
8. The wording of "in whole or in part", and the context in which those words appear, indicate that the concept of 'reproduction' should be construed broadly. This also follows from recital 21 in the preamble to Directive 2001/29, which provides that 'a broad definition [of the acts of reproduction] is needed to ensure legal certainty within the internal market'. The broad definition of reproduction is necessary to ensure the high level of protection of copyright which Directive 2001/29 seeks to establish, as is noted in recitals 5 and 9.
9. However, as Advocate-General Trstenjak stated in her Opinion in Case C-5/08 *Infopaq* at paragraph 58, the interpretation of 'reproduction in part' must not be an absurd or excessively technical one according to which any form of reproduction of a work would be included no matter how minimal or insignificant a fragment of the work it is.
10. The words "in whole or in part" can be taken too literally. On their face, they suggest a number of propositions, all of which, upon closer examination can be shown to be either too crude or plainly incorrect.
11. First, they suggest that the approach is quantitative, that it is a matter of assessing infringement by measuring how much material has been taken.
12. Secondly, they might suggest that any part, however small may suffice. There does not seem to be a lower threshold.
13. Thirdly, they might suggest that the amount taken must be a discrete part – a part in itself that has some sort of identity.

14. These interpretations of Article 2 are simplistic because they fail to recognise that the second work must reproduce some of the originality of the first.
15. This was the central tenet of the reasoning of the Court of Justice in Case C-5/08 *Infopaq* at paragraph 48 where the Court concluded that there could be a reproduction of a "part" only where the extract concerned expresses the author's own intellectual creation. The Court added that this was for the national court to make this determination on the facts of the particular case in question.
16. It can be seen therefore that the question is more qualitative than quantitative. One is seeking to assess the nature of what has been taken rather than the amount.
17. Furthermore there is a lower limit. A minimal or trivial amount of reproduction is most unlikely to bear any of the originality of the first work. This can be seen from the Court's analysis of the elements of a work at paragraph 45 of *Infopaq* where it stated that words, in isolation, would not have sufficient originality and that it is only through the choice, sequence and combination of those words that the author could confer originality on them. Therefore sentences or even parts of sentences might attract protection and be capable of infringement or might not.
18. Finally it is clear from the *Infopaq* case that the "part" need not be a discrete part, but may instead be composed of many smaller parts abstracted from the first work. In that case, the defendant's technology worked by triggering a reproduction of an extract of 11 words each time a search word appeared and in fact, users often ran multiple searches with the result that multiple fragments of a work were reproduced. The Court stated at paragraph 50 that the cumulative effect of these fragments might mean that there was reproduction of elements which expressed the intellectual creation of the author.

**Arnold J's application of these principles**

19. In the United Kingdom's view, the referring Court correctly interpreted the meaning of "in whole or in part". It did so by expressly considering the Court's judgment in *Infopaq*.

20. This can be seen at paragraph 79 of the Order for Reference in brief form and at paragraphs 242 and 243 of the referring Court's judgment in more detail. In summary the Court considered the well-established UK case law to the effect that the scope of the reproduction right was determined by reference primarily on the quality of the parts that have been reproduced. By "quality" I do not mean – and the judge did not mean – artistic merit or aesthetic quality, merely that the assessment took account of the nature of the extract and in particular its originality. So the assessment is qualitative in the sense that one looks primarily at the nature of what has been taken rather than the extent.

21. The referring Court then went on to consider *Infopaq* and considered, as the United Kingdom does, that the Court of Justice took the same approach in that case because it linked the concept of reproduction to the requirement of originality.

22. The referring Court then applied this to the facts by concluding, at paragraph 85 of the Order for reference, that once functionality was excluded, what was reproduced did not amount to a substantial part because, in essence, the parts did not constitute the author's own intellectual creation. There was some reproduction of names which were descriptive and no evidence of significant skill judgment or labour by SAS Institute in devising these. In addition there was some reproduction of some short and banal pieces of text which did not appear to satisfy the originality standard.

23. These sort of judgments are, of course, quintessentially matters for national Courts.



24. Since the judgment of the referring Court, there has been further UK case law dealing with the point. In *Newspaper Licensing Agency v. Meltwater* [2011] EWCA Civ 890, the issue was whether the reproduction of the headlines of newspaper articles amounted to a reproduction of a part sufficient for the purposes of Article 2. The Court of Appeal considered *Infopaq* in some detail, concluding that the test laid down by the Court of Justice required an assessment of the quality of what was taken and agreeing with the first instance court that there was reproduction of a substantial part because there would inevitably be some reproduction of the originality of the original works.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]



[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

**Broad answer to Q1,2, 8 & 9**



40. Accordingly, to summarise our position, the United Kingdom submits that the broad answer to questions 1 and 2 is that the national court is required to differentiate between reproduced parts that are dictated by function and those that are not in arriving at a conclusion on whether what has been taken amounts to an original part. Recent case law of the Court, in particular the Court's judgment in *Bezpečnostní softwarová asociace*, suggests that if an aspect is functional then it does not count towards the originality quotient. Therefore it is necessary to take account solely of the skill, labour and judgment expended on parts that are not solely functional and which are therefore capable of constituting the author's own intellectual creation.

41. Those parts may be non-literal and non-textual, but they must be substantial in the sense that they involve taking a part that is primarily qualitative in nature and which constitutes the author's intellectual creation. The taking of an insubstantial part – any part assessed quantitatively, for example – would not be sufficient.

42. The United Kingdom respectfully suggests a similar approach to questions 8 and 9 of the referring Court, as, by parity of reasoning, the same principles apply to all other copyright works.

### **The CJEU's questions**

43. I will conclude by making some very brief remarks on the Court's questions.

44. On the first question, the United Kingdom expresses no view on whether the software in question in this case would be patentable, as that is a complex question which requires consideration of the exclusions from patentable subject matter and the application of the principles to the complex facts of this case. In any event, however, the United Kingdom would suggest that whether software is patentable or not in any particular case has no bearing on whether it can be protected under the

law of copyright because Article 9(1) of Directive 2001/29 is expressed to be without prejudice to provisions concerning, in particular, patent rights.

45. The second question I believe we have already addressed in my submissions. The *Bezpečnostní softwarová asociace* case strongly supports an approach that differentiates between functional and non-functional aspects and deems only the latter capable of being original and therefore protectable under copyright law.

46. Mr President, Members of the Court, I am grateful. Those are my submissions.

SIMON MALYNICZ