

Copyright Law – Protectable Work

“Goldfish-filled Telephone Booth”

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The composition of 50–150 goldfish swimming inside a public telephone booth as if in an aquarium, where the handset of the telephone installed in the booth is fixed off the hook-switch as if floating and is generating air bubbles from the mic of the handset, as is presented in the artwork titled “The Message” can be recognized as creative within the meaning of the Copyright Act. (Sec. 2(1)(i), (xv) Copyright Act – “Goldfish-filled telephone booth”).

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Decision of the Ōsaka High Court; 14 January 2021¹

(First Instance: Nara District Court; 11 July 2019)²

Yamamoto v. Koriyama-Yanagimachi



The plaintiff's The Message



The defendants' The Work³

I. FACTS AND BACKGROUND

The plaintiff-appellant (“plaintiff”), who is a contemporary artist and the creator of an installation work entitled “Message” (“The Message”), brought a suit in the Nara District Court against the defendant-appellees, a cooperative union of merchants, and other entities in the Nara Prefecture (“defendant 1”) and against an individual (“defendant 2”), claiming infringement of copyright and moral rights. Plaintiff alleged that the item of

- 1 Nobuki YAMAMOTO (plaintiff – appellant) v. Koriyama-Yanagimachi Cooperative Union of Merchants & Yutaka KOYAMA (defendants – appellees) – Case No. 2019 ne 1735; https://www.courts.go.jp/app/files/hanrei_jp/019/090019_hanrei.pdf (Japanese only). English translation (in excerpts) by the author.
- 2 Nobuki YAMAMOTO (plaintiff) v. Koriyama-Yanagimachi Cooperative Union of Merchants & Yutaka KOYAMA (defendants) – Case No. 2018 wa 466; https://www.courts.go.jp/app/files/hanrei_jp/837/088837_hanrei.pdf (Japanese only). English translation (in excerpts) by the author.
- 3 Both photos by Naramachi Press: <https://narapress.jp/message/index.html> (Japanese only).

art produced and exhibited by defendants 1 and 2 (“The Work”⁴) was a reproduction of The Message and thus infringed plaintiff’s copyright.

The main issues were the copyrightability of The Message and its scope, and whether The Work is a reproduction of The Message within the meaning of the Copyright Act. At first instance, the Nara District Court (“the District Court”) did not find a copyright infringement. Plaintiff appealed to the Ōsaka High Court (“the High Court”), which subsequently found a copyright violation.

II. FACTS

1. *Plaintiff’s The Message*

Plaintiff created The Message, a public-telephone-booth-like aquarium filled with water and many swimming goldfish, and made it public in 2000 at the latest.

Plaintiff asserted the significance and meaning of this work as follows:

1. The Message is situated in the context of “ready-made” in contemporary art. The functionality and practicality of a “ready-made” product such as a public telephone booth have been lost, and a new meaning and value have been given to them.
2. The Message has as its theme the preservation of the environment and reflects the plaintiff’s message of “Listen to the words of water flowing far in the distance and protect the beautiful water and environment.”
3. The Message aims at making the general public aware of its everyday routine by placing an unusual object into an everyday space.

2. *Defendants’ The Work*

1. The Work was first produced in 2011 by a group of students at the Kyōto University of Arts under the name “Tele-Kin.” In 2013, this student group gave its art piece to a volunteer group represented by defendant 2 in Yamato-Koriyama City, Nara Prefecture, a region known for goldfish farming; the volunteer group renamed the piece “Kingyo Denwa” [literally “goldfish telephone”]. Subsequently, defendant 1 succeeded the volunteer group in ownership of The Work, and on 22 February 2014, defend-

4 Note that the object in question created by the defendants was never actually titled “The Work”; this is simply a catch-all title being used in this paper. When first created, the object in question was titled Tele-Kin. The object was re-titled Kingyo Denwa by its next owners (defendant 2). It is unclear what if any title the object in question carried when it was displayed by its final owner (defendant 1), but at no point was the object titled The Work.

ants 1 and 2 arranged and placed The Work in a shopping street in Yamato-Koriyama City. The current owner of The Work is defendant 1.

2. Plaintiff lodged protests with the student group and the volunteer group on each occasion that he found a version of The Work on exhibition (under the earlier respective names of Tele-Kin and Kingyo Denwa), arguing a copyright infringement of The Message. When plaintiff later found The Work on display after it had been passed on by the volunteer group, he complained to defendant 2. Thereafter, negotiations were held between plaintiff and defendants 1 and 2. As a result, in August 2017, defendant 1 posted a description on The Work that made reference to the plaintiff and The Message. Subsequently, negotiations broke down after the plaintiff made additional requests to defendants 1 and 2. Finally, The Work was removed from display in April 2018. In September 2018, plaintiff sued to prevent a recurrence.

III. FINDINGS OF THE DISTRICT COURT

1. *Issue (1): Copyrightability*

The Message was considered a copyrightable work solely as regards the colour and shape of the public telephone booth-like item, and the type, colour, and arrangement of the telephone installed inside.

1. The basic features of The Message:
 - (a) A box shaped like a public telephone booth with a public telephone installed inside. The box is filled with water, and many goldfish swim within the box like in an aquarium.
 - (b) Air bubbles are generated through the handset of the telephone to maintain a sustainable environment for the goldfish.
2. Concerning (a), the extraordinary scene of goldfish swimming inside an ordinary public-telephone-booth-like box can be deemed novel and original. However, it is merely plaintiff's idea and not an expression thereof. Thus, it is not subject to protection under the Copyright Act.
3. Concerning (b), this is to be considered an expression of plaintiff's idea, but it is not creative for the following reasons.

It is clear that injecting air into the water is essential for plaintiff's idea of having many goldfish swim in the box. In trying to generate bubbles from something that is normally placed in a public telephone booth, it is rational and natural to generate them from a handset that already has holes. In this sense, the manner of realizing plaintiff's idea is limited, and creativity can thus not be recognized in this expression.

4. On the other hand, a creative expression can be found in the following aspects: the colour and type of the box formed like a telephone booth and the type, colour, and arrangement of the telephone installed in the box.

2. *Issue (2): Reproduction*

As regards The Message, The Work was not held to be a reproduction thereof and not held to infringe the copyright of The Message.

a) *Comparison*

(a) A box shaped like a telephone booth

Both The Message and The Work are vertically long, rectangular parallelepipeds with four glass sides that imitate the appearance of the public telephone booths commonly found in Japan; they are filled with water in which goldfish are left to swim. However, both works are in part different, e.g. the colour of the roof of the booth or the materials composing the booth. Thus, there is no identical expression in this respect.

(b) The telephone installed in the booth

Both works have two shelves installed in the box and a public telephone placed on the upper shelf. The public telephones are of different colours and models, and both shelves are of different colour and shape. Here, an identicalness is found only in the characteristic that a two-tiered shelf board is installed in the box and the public telephone is placed on the upper shelf (“Id. 1”).

(c) The handset of the public telephone

Both telephone handsets are fixed off the hook-switch and the body as if floating in the water, with air bubbles generated from the mic of the handset. This feature can be considered an identical expression (“Id. 2”).

b) *Analysis*

(a) Plaintiff argued that The Work was a reproduction of The Message because both items have the same features: goldfish swimming in a public-telephone-booth-like box filled with water; both boxes have almost the same shape in appearance; a public telephone is set in the box generating air bubbles from the handset. However, it was held that this argument is unfounded because these features do not constitute an expression and are instead only the plaintiff’s idea.

(b) Among the identical aspects of expression between The Message and The Work, Id. 1 was not found by the District Court to be a creative expression because it is common in Japan to have the public telephone placed on the upper shelf and the telephone directory put on the bottom shelf. Con-

sequently, a composition featuring a two-tiered shelf with a telephone set on the upper tier is inevitable for realizing plaintiff's idea of imitating an ordinary public telephone booth. The District Court found that Id. 2 was the only feature in common between The Message and The Work, with the other aspects being deemed different. Accordingly, it is not possible to directly perceive The Message from The Work, and on the whole, it could not be held that The Work was a reproduction of The Message.

IV. FINDINGS OF THE HIGH COURT

1. Issue (1): Copyrightability

The Message was held to contain a copyrightable expression, namely an aquarium-like public telephone booth in which about 50–150 goldfish are swimming, with the handset of the telephone installed in the box fixed off the hook-switch as if floating in the water, with air bubbles generating from the mic of the handset.

1. Compared to the appearance of a real public telephone booth, The Message has the following characteristics:
 - (a) Most of the booth is filled with water.
 - (b) A real telephone booth has a doorway with a vertical hinge on one of the four sides, whereas all four sides of the booth of The Message are made of acrylic glass.
 - (c) Red goldfish are swimming in the water-filled booth, with the number varying for each exhibition between at least 50 and at most 150.
 - (d) The handset of the telephone installed in the booth is fixed off the hook-switch, with air bubbles generating from the receiver of the handset.
2. Regarding (a), although this can be said to be the novel likening of a telephone booth to an aquarium, there is room for choice of expression only as to how much water is filled inside. In addition, the use of a public telephone booth as an aquarium makes a strong impression on the viewers, but it can be expected that many people would only rarely pay attention to the amount of water in it. Therefore, it is hard to say that there is creativity in the telephone box being “partially” filled with water.
3. Regarding (b), the vertically long hinges on the doorway are not very conspicuous, and even those who use public telephones are hardly aware of the hinges. Therefore, this point would not be an element that attracts the attention of the viewer, and it cannot be said that “the absence of vertically long hinges” demonstrates any creativity on the part of the plaintiff.
4. Item (c) is also the expression of a novel idea and various compositions are possible depending on the number of goldfish and the combination of

various types and colours of goldfish. In fact, Tele-Kin, as created by the art university students, had about 1,000 goldfish swimming inside it and can be considered a work that creates an impression different from that of The Message, a conclusion furthered by the fact that a large amount of air bubbles were generated from the floor of Tele-Kin. However, among such a wide range of composition, plaintiff chose that of about 50 to 150 red goldfish swimming in the box. This number does not seem particularly distinctive relative to the size of the telephone booth, and it is difficult to conclude that plaintiff's originality is exhibited therein.

5. Concerning (d), the handset of the telephone, which is usually set on the hook-switch when not in use, is fixed in the water as if floating, creating a unique visual scene. In addition, it is striking that the mic is generating air bubbles. These features create an impression of someone talking to someone else, and therefore it can be held that this feature makes a strong impression on the viewer. It can be said that the plaintiff's originality is manifest in this feature.

The defendants argue, however, that this feature arises inevitably from the idea of using a telephone booth as an aquarium in which goldfish are swimming. However, a more common method of injecting air into an aquarium is to use a bubble generator, such as an airstone. In addition, considering the fact that both the mic and speaker of a handset are designed for communication between individuals rather than the transmission of air, creating an image akin to communication by generating air bubbles from the mic is not a common expression and constitutes a manner of metaphor.

6. In addition to (a) to (d), plaintiff claims that the yellowish-green colour of the public telephone and the roof of the telephone booth are especially important because The Message is concerned with environmental issues. However, the box of The Message has almost the same appearance as some real public telephone booths, and a yellowish-green colour for a public telephone and its roof are common in Japan such that no creativity can be found therein.
7. Although neither (a) nor (c) alone is creative as such, upon adding (d) thereto, the additional effect of (d), i.e., having the handset of the telephone fixed floating off the hook-switch while generating bubbles, makes The Message recognizable as a creative work.

2. *Issue (2): Reproduction*

The Work was a reproduction of The Message as follows:

*a) Comparison**(a) Similarities*

- (1) A public-telephone-booth-like aquarium filled with water, all four sides of which are made of acrylic glass, and about 50-150 red goldfish are swimming in the water.
- (2) The handset of the telephone installed in the booth is fixed off the hook-switch, generating air bubbles from the mic of the handset.

(b) Differences

- (1) The type of telephone installed inside.
- (2) The color of the telephone in *The Message* is yellowish-green while that in *The Work* is gray.
- (3) The color of the roof in *The Message* is yellowish-green, that in *The Work* is red.
- (4) *The Message* has one square-shaped shelf therein whereas *The Work* has two shelves: the upper is a square-shaped shelf; the lower is hexagonal but almost triangular.
- (5) The water filling the booth of *The Message* leaves some space at the top, while the booth of *The Work* is almost completely filled.
- (6) When *The Work* was first exhibited in February 2014, it had long hinge-like objects on one of the four acrylic glass sides, then the objects were removed.

b) Analysis

Similarities (1) and (2) are creative expressions found in *The Message*.

Differences (1) to (5) are all related to the part of *The Message* that is not part of the creative expression as they can be considered indistinctive or hardly noticed by the viewers. Also, difference (6) has no effect on the similarity between *The Message* and *The Work* because not only telephone users but also viewers will hardly pay attention to the hinge.

Thus, it was held that *The Work* physically reproduces all of the creative expressions found in *The Message* and does not express any original ideas that are different from *The Message*, though there are some differences in the other parts or in specific aspects of expression.

V. COMMENT

1. General Understanding of Copyrightability and Reproduction

Both the District Court and the High Court had the following understanding regarding copyrightability and the reproduction of works, which is a general interpretation of the Copyright Act.

a) Copyrightability

Sec. 2(1)(i) of the Copyright Act defines “work” as “a creatively produced expression of thoughts or sentiments that falls within the literary, academic, artistic, or musical domain.” This means that a work protected by the Act must (1) not be thoughts and sentiments as such (hereinafter referred to as “ideas”), but the expression of those,⁵ and (2) show creativity in that expression. This “creativity” does not mean a high degree of originality. However, where an expression is commonplace, it cannot be a “creative” expression, that is, a certain degree of the creator’s individuality must be shown therein. Also, when the choice of how to express an idea is limited, the expression would be the same or similar no matter who creates it and therefore is not creative.⁶

In recent years, with the emergence of programs and databases that do not necessarily reflect the creator’s originality, some insist on a theory whereby the creativity of a work is judged by the range of choices of expression, i.e., how many options are left for others to create a similar type of expression if copyright protection is granted to the work in question.⁷ If there are many such options left, and the creator has chosen one manner of expression from among the many options, then this is where the creator’s creativity can be found. On the other hand, if there are few choices left or none at all, there is no room for the creator’s creativity to show itself.⁸ More than a few courts seem to understand creativity in this way.⁹ It can be

⁵ This is referred to as “idea-expression dichotomy.” See Art. 9(2) of TRIPs.

⁶ This is referred to as the “doctrine of merger.” See N. NAKAYAMA, *Chosaku-ken-hō* [Copyright Law] (3rd ed., 2020) 79–82.

⁷ This is commonly referred to as the “range of choice theory.” See NAKAYAMA, *supra* note 6, 70–77. See also T. UENO, *Chosaku-butsu-sei (1): sōron* [The Copyrightability (1): General Aspects], *Hōgaku Kyōshitsu* No. 319 (2007) 160, 166–167.

⁸ Professor NAKAYAMA explained that the range of choice theory shifts the focus from author’s rights emphasizing the individuality of the creator to a copyright view that, first, emphasizes the aspect of property rights and, second, is closely related to idea-expression dichotomy in the sense that the scope of protection is appropriately limited for the purpose of enhancing diversity of information and expression. In other words, this is an attempt to take a unified view of copyrightability by means of the concept of range of choice. See NAKAYAMA, *supra* note 6, 76–77, and N. NAKAYAMA, *Sōsaku-sei ni tsuite no kihon-teki kangaekata* [Basic Thoughts on Creativity], *Chosaku-ken Kenkyū* No. 28 (2003) 2.

⁹ Intellectual Property High Court, 6 October 2005, Case No. 2005 ne 10049; 26 December 2006, Case No. 2006 ne 10003, available at the Supreme Court’s webpage (Japanese only): https://www.courts.go.jp/app/hanrei_jp/search1.

inferred from the text of the decision that the High Court in this case adopted such a view.¹⁰

b) Reproduction

A “reproduction”, which amounts to a copyright infringement, refers to (i) a physical replication based on an existing work (ii) which makes it sufficiently possible to recognise its content and form.¹¹ However, if such a physical reproduction is identical to the existing work, there is nevertheless no infringement for those parts that do not relate to the creative expression.¹²

2. Issues in This Case

The District Court and High Court differed in their judgment regarding the copyrightability of *The Message*, and this difference affected whether *The Work* was considered a reproduction of *The Message*. The two judgments agreed on the following points: the main features in *The Message* are (i) goldfish swimming in a public-telephone-booth-like box and (ii) air bubbles being generated from the microphone of the handset placed in the water as if floating; *The Work* was identical to *The Message* in these regards; feature (i) as such is an idea, i.e., not a creative expression subject to protection under the Copyright Act. The judgments were different regarding feature (ii), and, ultimately, an act of creative expression was recognized by the High Court mainly on this point.¹³

The District Court held that feature (ii) constituted an instance of expression but not a creative one because of its narrow choice of expression, and the High Court held that the combination of features (i) and (ii) was a creative expression. As a result, the District Court declined to conclude that *The Work* reproduced the creative expression of *The Message*, whereas the High Court agreed with this contention.

In what follows, I will first take a closer look at the judgments concerning features (i) and (ii) before then reviewing the circumstances that were taken into consideration by the High Court in finding the existence of a reproduction.

¹⁰ It is not clear whether the District Court took the same view.

¹¹ Sec. 2(1)(xv) Copyright Act. *See* Supreme Court, 7 September 1978, Case No. 1975 o 324, Minshū 32-6, 1145.

¹² Supreme Court, 28 June 2001, Case No. 1999 ju 922, Minshū 55-4, 837.

¹³ The two courts also came to a different conclusion regarding the fact that the roof of the telephone booth and the telephone in *The Message* were yellowish-green. The District Court ruled that this was a creative expression while the High Court held that it was not creative. As this issue does not affect the conclusion, I will not discuss the issue in further detail.

3. *Analysis of Feature (i)*

1. It should be first noted how both the District Court and the High Court viewed ideas and expression within the meaning of the Act. They examined the plaintiff's idea recognizable from the external visible appearance of The Message and the range of choices of expression based on it (i.e., creativity) for each of its components¹⁴ (hereinafter “outer approach”). They did not adopt the approach of viewing an embodiment of a more abstract idea, such as the basic concept or message underlying it as being an expression of ideas within the meaning of the Act¹⁵ (hereinafter “inner approach”). Although it is not clear from the reading of the judgments, this seems to be so for two reasons. First, according to the inner approach, even a seemingly common and simple modeling, such as a single-flower vase, can be considered copyrightable because of the originality of the underlying basic concept. Also, through the outer approach it is possible to establish predictability regarding copyrightability for others who would create a similar expression.¹⁶

There are some authors who disagree with the two judgments of the District Court and High Court.¹⁷ Among them, Professor MOTOYAMA ar-

14 The High Court evaluated the range of expression, i.e., the creativity in each part of The Message, from the perspective of the viewers, based on how The Message attracts or impresses them. However, whether an expression is creative or not is essentially a judgment as to whether or not the creator's originality can be found therein. The range of choice theory also determines the creativity of a work based on how much room is left for other creators. In any case, it has nothing to do with how the viewers feel. See M. MOTOYAMA, *Kingyo denwa bokkusu no zōkei to chosaku-ken shingai no seihi* [Form of the Goldfish Telephone Box and the Decision About a Copyright Infringement], Shin Hanrei Kaisetsu Watch, October 2021, 285, 288.

15 From the judgments of the District Court and the High Court, it seems that the plaintiff argued for the copyrightability of The Message in this way.

16 See MOTOYAMA, *supra* note 14, 287–288.

17 See T. UENO/T. MAEDA, *Keesu kenkyū chosakubutsu no ruiji-sei handan bijuaru āto hen* [Case Study on the Decision of Similarity of Works], Keisō Shobō 2021, 157; T. INABA, *Kinji no saibanrei ni miru gendai-teki na funsō ni tsuite* [On Contemporary Disputes in View of Recent Court Decisions], Jiyū To Seigi 73-2 (2022) 22; M. MURAI, *Gendai bijutsu no chosakubutsu-sei* [Copyrightability of Contemporary Art], Hōgaku Seminā No. 798 (2021) 131; M. ŌTSUKA, *Gendai bijutsu sakuhin no chosakubutsu-sei* [Copyrightability of Pieces of Contemporary Art], Memoirs of Osaka Institute of Technology 64-2 (2019) 1; Y. TSUJIMOTO, *Chosakubutsu gainen ni okeru “sōsaku-teki ni hyōgen” no imi to hogo han'i* [The Meaning and Scope of Protection of “Creative Expression” within the Meaning of the Term Work], Chizai Prizumu 20-231 (2021) 1; O. SUWANO, *Kingyo bokkusu jiken* [The Goldfish Box

gues that even with the outer approach, the courts could find a creative expression because the idea of The Message was recognizable as “making an aquarium out of something that is not an aquarium”. The Message as an embodiment of that idea was therefore novel, as both courts held.¹⁸

This view shows one of the key perspectives in evaluating the significance or meaning of contemporary art. On the other hand, the viewpoint of leaving room for others to create, which relates directly to the aim of the Copyright Act, should also be taken into account when considering the scope of copyright protection. If the copyright protection level of abstraction in the expression is set at “goldfish swimming in a telephone-booth-like object,” there remains enough room for further choice of expression, including the shape of the public telephone booth or telephone, the type and number of goldfish, the selection and arrangement of creatures and plants other than goldfish, and, as mentioned below, the arrangement of the handset. If such aspects of expression were granted copyright protection, protection would seemingly be too broad and leave no room for creativity of others. In this sense, it would accordingly be difficult to grant copyright protection to creative expression of this nature.

2. With the outer approach, it is difficult under the Copyright Act to grant protection to contemporary art that puts importance on highly abstract ideas or on the context of the work and the novelty of basic concepts and intent, aspects which are difficult to objectively identify in artistic works. Though the value of contemporary art is not called into question by an acknowledgement of this difficulty,¹⁹ the question nevertheless arises as to whether such a lack of protection is acceptable.

Some insist that the copyrightability of contemporary art should be judged in the same way as some court decisions have done,²⁰ namely taking into account the idea and feeling underlying the expression in determining the copyrightability of work. Professor KOJIMA, using Marcel DUCHAMP’S “Fountain” as an example, points out that in determining the copyrightability of contemporary art, the chronological factors in the

Case], Hatsumeï 2020, No. 4, 42; K. MUROTANI, *Kingyo denwa box jiken* [The Goldfish Telephone Box Case], *Chizai Purizumu* 19-225 (2021) 26, 36–37.

18 See MOTOYAMA, *supra* note 14, 287–288.

19 Virginia RUTLEDGE points out: “Art and copyright are different games. A thin copyright isn’t worth much, but some highly original art has been made out of very minimal gestures. The value of Duchamp’s Fountain has nothing to do with its copyright.” C. DANZIGER/T. DANZIGER, *The Shape of Things*, *Art+Auction Magazin*, December 2008, 1, 3.

20 For example, Ōsaka District Court, 6 September 2013, Case No. 2013 yo 20003, *Hanrei Jihō* No. 2222, 93.

creative process or the context of the work must be seriously discussed.²¹ KIMURA, an art law lawyer, argues as follows:²² Among “ready-made” works, those which are composed of multiple materials creating a certain form, such as Subodh GUPTA’s “Very Hungry God,” are considered to be copyrightable in the same way as traditional sculptures. On the other hand, a work that consists of multiple materials in which more emphasis is placed on the choice of materials than on the shape, such as “Pharmacy” by Damien HIRST and “Bicycle Wheel” by Marcel DUCHAMP, would have considerably narrower copyright protection, whereas creative expression can be found in terms of composition, combination, arrangement, colour, etc., taking into consideration thoughts that formed the basis of the expression and the meaning or concept that creators put into their work. Similarly, it is not impossible to recognize as copyrightable even a work that consists of only one material, such as Marcel DUCHAMP’s “Fountain” or “In advance of the broken arm”, by taking into consideration the basic concept and the meaning of the title, though the scope of protection will be extremely narrow.

In recent years, among court decisions and academic theories, the prevailing view is that creativity should be widely recognized and copyright infringement should be judged strictly except in cases where it is objectively obvious that there is no creativity.²³ The extent of the restriction on the expression of others can be taken into account in the judgment of similarity between the works, i.e. in the determination of infringement.²⁴ While this appears a possible solution, careful consideration is required from the viewpoint of idea-expression dichotomy.²⁵

In the present case, the basic concept of The Message is to create an awareness of the plaintiff’s message of environmental conservation through use of an object which incorporates a “ready-made” factor to show extraordinary scenery in an everyday space. On the other hand, The Message is a combination of a telephone booth, a telephone, water, and

21 See R. KOJIMA, *Gendai āto to hō: chitekizaisan-hō oyobi bunka seisaku no kanten kara* [Contemporary Art and the Law: From the Perspective of Intellectual Property Law and Cultural Policy], *Chiteki Zaisan-hō Seisakugaku Kenkyū* 36 (2011) 1.

22 See K. KIMURA, *Gendai bijutsu no orijinariti to wa nani ka* [What is Originality in Contemporary Art?], *Chosaku-ken-hō kara mita “redi meido”* [“Ready-made” from the Viewpoint of Copyright Law] (1) and (2), available at <https://bijutsutecho.com/magazine/series/s22/20046>, <https://bijutsutecho.com/magazine/series/s22/20291> (last visited May 2022).

23 R. SHIMANAMI / T. UENO / H. YOKOYAMA, *Chosaku-ken-hō nyūmon* [Introduction to Copyright Law] (2nd ed., 2018) 30–31.

24 See ŌTSUKA, *supra* note 17, 6.

25 See MURAI, *supra* note 17.

aquatic organisms. If the artist sought to express an everyday space, he would have chosen a telephone booth and telephone commonly seen in Japan; and for organisms that swim in the telephone booth, he would have chosen goldfish, which are commonly kept in aquariums in Japan. In this sense, the choice of materials and the combination of materials is quite limited. As such, even if considering the concept, we would still not have any choice but to find an expression of the plaintiff's originality only in the arrangement of the handset and the generation of air bubbles emanating therefrom.²⁶

4. *Analysis of feature (ii)*

For feature (ii), the District Court declined to find creativity on the basis of the doctrine of merger, taking into account only the depiction of air bubbles coming out of the microphone and finding that it was a reasonable and natural solution to realize the function of an aquarium holding swimming goldfish. On the other hand, the High Court found creativity by taking into account not only this element but also the handset being fixed in the water as if floating.

First, it seems problematic that the District Court did not consider the second element. This is because, in addition to the configurative expression used in *The Message*, another expression capable of giving a different impression is also possible: the handset could be put on the hook-switch or hang down from the body of the telephone.²⁷ Additionally, in terms of the first element, there was, as the High Court pointed out, no need to generate bubbles from the handset for *The Message* to work: an air stone would, for example, have been a possible option. In fact, the predecessor version of *The Work*, *Tele-Kin*, produced a large number of air bubbles from the floor. Thus, there can be a range of choices of expression in feature (ii).

In addition, the combination of the two elements can conjure an image of communicating with a distant caller, as the High Court held. This view is in

²⁶ See ŌTSUKA, *supra* note 17, 6. According to this view, it may be inferred that *The Work* was exhibited for the purpose of underscoring that Yamato Koriyama City, which is one of the major goldfish production areas in Japan, is a “goldfish town” by displaying *The Work* in the street. Therefore, even if *The Work* is similar in expression to *The Message*, it may well be found to not be a reproduction or derivative of *The Message* because *The Work* is based on a different idea than *The Message*, with the latter calling attention to environmental conservation. See MUROTANI *supra* note 17, 37 note 8.

²⁷ See ŌTSUKA, *supra* note 17, 4, MUROTANI, *supra* note 17, 34–35.

line with the basic concept of The Message and may be understood as an evaluation based on the inner approach.²⁸

Thus, one could say that the view of the High Court is preferable because it evaluated The Message more appropriately. However, one could also say that feature (ii) has not been considered creative since the range of expression in terms of the two discussed elements is not especially large. In fact, multiple commentators take the latter view.²⁹

5. Analysis of infringement

Considering the above, in deciding about contemporary art it is difficult to draw a line between idea and expression, and between creative and non-creative expressions. So what was the decisive factor that led the High Court to find that The Message manifested a certain level of creative expression and that The Work was an illegal reproduction of The Message?

The High Court concluded that The Work is based on The Message by means of a finding closely related to the circumstances of the case, including earlier versions of the work, Tele-Kin and Kingyo Denwa, which were also created on the basis of The Message, and that plaintiff had previously asked the creators of these earlier versions to stop displaying them in order to avoid copyright infringement; finding also that defendant 2 was aware of plaintiff's request. Noting this, KIMURA infers that the High Court interpreted the scope of similarity more broadly than usual, taking into account the defendants' bad faith in light of how The Work was created, an issue that also played a role in past court decisions.³⁰ Also MUROTANI, a lawyer,

²⁸ See MOTOYAMA, *supra* note 14, 287.

²⁹ See UENO / MAEDA, *supra* note 17, 156–157, MUROTANI, *supra* note 17, 36–37, K. KIMURA, “*Aidea*” to “*hyōgen*” no hasama o tayutau kingyo ka na. Kingyo denwa bokkusu jiken Ōsaka Kōsai hanketsu no shikō o ou [Goldfish Oscillating the Thin Line Between “*idea*” and “*Expression*”? Pursuing the Concept of the Ōsaka Appeal Court in the Goldfish Telephone Box Case], available at <https://bijutsutecho.com/magazine/insight/23433> (last visited May 2022), K. OKAMOTO, *Gendai āto no mikata, torakata: “aidea” to “hyōgen” no kyōkaisen* [Viewing and Understanding Contemporary Art: the Borderline Between “*Idea*” and “*Expression*”], available at <https://www.kottolaw.com/column/210227.html> (last visited May 2022).

³⁰ Tōkyō District Court, 15 December 1999, Case No. 1998 wa 11012 & No. 1999 wa 4128, Hanrei Jihō No. 1699, 145; Tōkyō High Court, 21 June 2000, Case No. 2000 ne 750, Hanrei Jihō No. 1765, 96 (appeal of the first instance decision). See KIMURA, *supra* note 29. He also suggests the similarity between this and the “inverse ratio rule” in the U.S. However, caution should be exercised in that the U.S. Court of Appeals for the Ninth Circuit recently found that the inverse ratio rule “is not part of the copyright statute, defies logic, and creates uncertainty for the courts and the parties”, *Skidmore v. Led Zeppelin* – 952 F.3d 1051 (9th Cir. 2020).

suggests that the background of the case may in no small measure have affected the decision of the High Court, pointing to (1) the form of the installation becoming closer to that of *The Message* as it progressed from the predecessor versions to its final configuration;³¹ (2) the attitude and sincerity demonstrated in the negotiations between plaintiff and defendants; (3) the media coverage given to *The Work* as it increasingly became famous, thereby attracting public attention.³²

It is not clear from the text of the judgment whether the High Court took such factors into account, but it may to some extent be acceptable to consider circumstances other than an analysis of the plaintiff's work itself and a comparison with the allegedly infringing work, in order to reach a reasonable result for works of contemporary art where a wide scope of copyright protection cannot be expected. In fact, it has long been pointed out that "similarity" and "infringement" are matters subject to comprehensive judgment given the purpose of the Copyright Act.³³

6. Conclusion

As described above, in the case of contemporary art which emphasizes the creativity of the underlying ideas, related to aspects such as the concept and context, it is difficult to distinguish between an idea and expression and to evaluate creativity under the general understanding of the Copyright Act. Therefore, a wide scope of protection cannot be expected.

Through the analysis of this case, however, it may be said that a possible solution has been found that gives a certain degree of copyright protection to contemporary art considering the balance between the need to protect such an item of contemporary art and the purpose of the idea-expression dichotomy: when judging whether creative expression exists in the plaintiff's work, courts to a certain extent may take account of the concept and the context of the work; when judging similarity to and infringement of the plaintiff's work, a court may to some extent take into consideration the totality of the circumstances.

In any event, whether such an approach is a valid one needs to be examined further in future cases.

31 KIMURA, *supra* note 29, see the uploaded photo on his website.

32 See MUROTANI, *supra* note 17, 37.

33 See NAKAYAMA, *supra* note 6, 722. See also Tōkyō District Court, 29 March 1999, Case No. 1995 wa 24693 & 1995 wa 25924, Hanrei Jihō No. 1689, 138; Tōkyō High Court, 19 September 2000, Case No. 1999 ne 2937 1999 ne 4828, Hanrei Jihō No. 1745, 128 (appeal of the first instance decision).

SUMMARY

In the case of an item of contemporary art, a wide scope of protection cannot be expected under the prevailing understanding of the Copyright Act.

However, through the analysis of the present case, it may be possible to give a certain degree of copyright protection to it by taking into account to a certain extent the following aspects: the idea underlying it when determining the copyrightability of it; the totality of the circumstances when judging similarity and infringement.

ZUSAMMENFASSUNG

Im Falle eines Gegenstandes zeitgenössischer Kunst ist nach dem gegenwärtigen vorherrschenden Verständnis des Urheberrechtsgesetzes kein besonders weiter Schutzzumfang zu erwarten.

Bei Analyse des vorliegenden Falls ist es aber möglich, einen gewissen Grad an Urheberrechtsschutz unter Berücksichtigung der nachfolgenden Aspekte zu gewähren: die zugrundeliegende Idee des Kunstobjekts bei der Entscheidung über die Urheberrechtsfähigkeit; die Gesamtheit der Umstände bei der Beurteilung von Ähnlichkeit und Verletzung.