ORIGINALITY – PART III 'WORKS'

Literary Works - s. 10(1): 'Literary works include (a) a table or compilation expressed in words, figures or symbols; and (b) a computer program or compilation of computer programs'.

Words, Titles, Headlines and Short Phrases:

Old Law – titles were insufficiently substantial to qualify as literary works, but did not rule out cases where the title was proper subject matter eg. a very long title of important nature (***Francis Day*, 1940**).

Current Law –

Titles: For policy reasons, title and author details tend to be unprotected by copyright; otherwise, every bibliographic reference would infringe copyright. However, cases may arise where a title involves sufficient literary composition, or be of such an important character, that it can justifiably be recognised as a literary work (***Fairfax v Reed, 2010*).**

Headlines: Headlines can be literary works if their creation involves substantial skill and are designed to entice the reader by informing of the article's content (***Meltwater, 2013* – per Proudman J).**

Words/short phrases: Works whose expression is indistinguishable and inseparable from their idea (i.e. do not allow for other conclusions or choices to be reached other than that expressed) are not protected by copyright (***Help Words Case, 2009*)**

Tweets/Emails: For policy reasons, a single sentence cannot be protected by copyright (re protection of freedom of speech). Copyright is unlikely to protect emails and tweets. Short phrases are too easily severable from larger works, and are often recycled in works.

Marketing Slogans: Short phrases by themselves in advertising are usually not protectable. But where a phrase is borrowed or hijacked for blatant commercial use, courts are more likely to find for infringement.

Phrases representing whole work: Where phrases represent the whole work, lack of originality prevents copyright protection over subsequent works: *The smaller the effort, the greater the degree of creativity necessary to attract copyright protection.* However, 'phrases so idiosyncratic that their appearance in another work precludes coincidence' are protected (***Heim v Universal*, Frank J).**

Computer Programs: *TRIPS, Art. 10(1)* – "Computer programs, whether in source code (human-readable) or object code (computer-readable), are protected as literary works under the Berne Convention".

Old Law - Programs in object code are not literary works because they exist in a form invisible, imperceptible or unreadable by human beings. Programs in source code are protectable as they afford readable instruction to human beings (***Computer Edge v Apple, 1986*).**

Current Law – Copyright Act now provides protection to both source code and object code (s. 10(1)). **Computer Programs:** Copyright protects computer programs. A computer program is a program representing a particular selection, ordering, combination ad arrangement of a set of instructions. **Reserved Words:** Each word comprises only a single instruction, not a set of instructions, and therefore not protected by copyright. This would protect ideas rather than expression, forcing all future comers to use less intuitive words, and would discourage creativity and productivity. **Underlying Macros:** Macros allow for performance of a more complex function than reserved words, with underlying source code enabling instruction. They are protected by copyright (***Data Access v Powerflex, 1999*).** Where the source code for a program is generated by a computer system and not by human beings, there is insufficient independent intellectual effort to warrant authorship and copyright protection. However, where human beings create a compilation of source code data, authorship exists and copyright protection is available. The work must be considered as a whole. While the content cannot be ignored, the focus must be on the independent intellectual effort of human beings. (***Acohs v Ucorp, 2010*).**

Dramatic Works s. 10(1): 'Dramatic works include a choreographic or other show, and a scenario or script from a film – *But does not include actual films* (Part IV works).

A minimum requirement for copyright in a dramatic work is **unity intended and capable of performance** i.e. the features of the program need to be related. Where features of a show or performance are unrelated in all aspects except for being accessories in presentation, they will lack unity and copyright will not protect. Standard elements of show, such introduction, credits, introduction of contestants etc are not copyrightable, even in combination; they are no more than general ideas or concepts (***Green v Broadcasting Corp of NZ, 1988*).**

A static scene cannot amount to a dramatic work. A dramatic work requires performance. Films of real life events will not constitute dramatic works as they will not have originated from the author (***Creation Records v News Group Newspapers, 1997*).**

Musical Works

Not defined by Copyright Act, but generally taken to refer to the *non-literary aspects* of musical works.

Effort, skill and time invested into generating musical works are sufficient to accord them originality and copyright protection, even where the works are adaptations. The entirety of a musical work must be assessed to determine copyright subsistence. If the sounds of musical works are affected by the information inserted into the performing editions by the author, which in turn contributes to the overall sound, the works are new musical works and can be deemed original and afforded copyright protection.

Originality in copyright is limited to expression, not information or ideas. It does not impose standards of novelty or aesthetic merit. The bar for originality is low – only some kind of independent intellectual effort is required (***Hyperion v Sawkins, 2005*).**

Artistic Works - s. 10(1): 'Artistic works include (a) a *painting, sculpture, drawing, engraving or photograph;* (b) a *building or model of a building*, whether the work/building is of artistic quality or not; or (c) a *work of artistic craftsmanship* – but does not include a circuit layout…

Painting: To attain copyright protection, a painting must be on a surface of some kind and must have a sufficient degree of performance. Make-up on a performer's face, lacking surface and permanence, is not considered a painting for the purposes of the Copyright Act (***Merchandising Corp v Harpbond, 1983*).**

Sculptures and Engravings: s. 10(1): Sculpture – includes a cast or model made for the purposes of sculpture; **s. 10(1): Engraving** – includes an etching, lithograph… wood-cut, print or similar work, not being a photo.

Sculptures: To be protected by copyright, a sculpture must in some way express, in 3D form, an idea of the sculptor. Utilitarian objects made out of plastics (eg. Frisbees) will not be considered sculptures, as they lack any expressive form or idea of the creator. Sculpture objects probably need to be made of sculpting material, such as stone or wood (***Lincoln v Wham-O, 1984*).** The term 'sculpture' is given its ordinary meaning. While some sculptures consist of or include parts of machines, not all machines and parts thereof are sculptures. The same applies to moulds (***Greenfield v Rover-Scott, 1990*).** Manufacturers of moulds are not considered 'artists' (***Metix v Maughan, 1977*).** The essence of sculpture is for it to be enjoyed for its visual appeal alone; it has no use or function. However, having some use will not automatically disqualify an object from being a sculpture; as long as it is not purely functional and has some 3D representation, copyright will still apply in respect of sculpting. A purely functional item, however, will not be treated as a sculpture, even if carved from wood of stone. Rather, it will be considered a work of 'artistic craftsmanship' (***Lucasfilm v Ainsworth, 2009*).**

Engravings: Engraving pertains to cutting upon a surface with a graving instrument. The actual cutting is where the artist's skill and labour is directed, and is the skill protected by copyright. However, an engraving is not intended to be appreciated visually; it must have some artistic quality (***Lincoln v Wham-O, 1984*).** The term 'engraving' does not cover shaping a piece of metal or wood on a lathe. Engraving relates to marking, cutting or working a typically flat surface of an object. Moulds are not engravings (***Greenfield v Rover-Scott, 1990*).**

Drawings: s. 10(1): Drawing – includes a diagram, map, chart or plan. A drawing is a 2D work in which shapes and images are depicted by lines, often without colouring. The essence of a drawing is the representation of some object by a pictorial line, but does not have to represent something which exists or is to exist in real life. Drawings comprised of made up numbers and words which do not have linguistic meaning no signify an institution idea or team are not considered literary works. However, such drawings do have semiotic meaning through visual resemblance and expression of ideas. NOTE: It is possible for a single work to fall under two categories (i.e. literary and artistic), so long as it can be appreciated visually and for its semiotic function (***Elwood Clothing v Cotton On Clothing, 2008*).**

Photographs: s. 10(1): Photograph – means a product of photography or of a similar process to photography, other than an article in which visual images forming part of a film are embodied.

Buildings/Models of Buildings: s. 10(1): Building – includes a structure of any kind. A building is capable of copyright protection even where it is utilitarian in nature and whether it is of artistic quality or not (eg. Tennis court). Skill and labour invested in the design and construction of a building is sufficient for copyright (***Half-Court Tennis v Seymour, 1980*).** 'Structure of any kind' broadens the definition of a building to structures which are not ordinarily buildings. There is no requirement that a building or structure be for human habitation (i.e. bridges and dams are included). However, 'structure' implies the object must of some substance, and erected, constructed or placed in the ground with some permanence. Size, proposed use to an independent observer, fixation to the ground, evident portability and degree of permanence (including lifespan) are all relevant in determining whether a work is a building. A 'model' has 2 meanings: (1) a representation of some structure built or to be built, showing its proportions, shape, design and arrangement of parts; (2) a 3D image which is a copy of an object, or which is coped to make the object itself (***Darwin Fibreglass v Kruhse, 1998*).**

Works of Artistic Craftsmanship: Category is undefined, but significant (s. 77). The ultimate test of whether a work is a work of artistic craftsmanship is whether it is from the hand of an artistic craftsman. Such a work's primary purpose must be visual and aesthetic appeal, not one of its range of considerations or a subordinate aspect. Such a work cannot be substantially directed to utilitarian purposes; it must be unconstrained by functional considerations **(*Burge v Swarbrick, 2007*).**

Derivative and Infringing Works: In determining whether copyright subsists in works containing infringing material, the courts must consider the *whole* of the work – they must not deduct the infringing part first and decide subsistence based on the remainder. Infringement cannot occur when the part taken is not original, for it is not considered taking of a substantial part. Copyright can subsist in works incorporating unoriginal material, so long as it is co-located and supplemented with original material **(*Warwick Films v Eisinger, 2007*).**

TOPIC 4: RIGHTS AND PRIMARY INFRINGEMENT

Exclusive Rights of Copyright Owners

The exclusive rights for copyright holders of each class of work and subject matter are defined in the *Copyright Act* as follows:

Work/Other Subject Matter	Sections	Rights (to do any or all of the following acts)
Literary, Dramatic and Musical Works	*s. 31(1)(a)*	Reproduce the work in a material form; Publish the work; Perform the work in public; Communicate* the work to the public; Make an adaptation of the work; To do any of the aforementioned acts in relation to an adaptation of the work.
	ss. 31(1)(c)(d)	In the case of a literary, dramatic or musical work (other than a computer program), to enter into a commercial rental agreement in respect of the work reproduced in a sound recording. In the case of a computer program, to enter into a commercial rental agreement in respect of the program.
Artistic Works	*s. 31(1)(b)*	To reproduce the work in a material form; To publish the work;* To communicate* the work to the public. *The right to perform a work in public or make an adaptation of a work does not pertain to artistic works.*
Sound Recordings	*s. 85(1)*	To make a copy; To cause the recording to be heard in public; To communicate** the recording to the public; To enter into a commercial rental.
Cinematograph films	*s. 86*	To make a copy; To cause the film to be seen or heard in public; To communicate* the film to the public.
Broadcasts	*s. 87*	To make a cinematograph film of a television broadcast, or copy of such a film; To make a sound recording of a broadcast, or copy of such a sound recording; To re-broadcast the broadcast or communicate it to the public.
Published editions of works	*s. 88*	To make a facsimile copy of the edition.

NOTE:

***'Communicate' (s. 10):** Means make available online or electronically transmit a work or other subject matter, including a performance or live performance within the meaning of the *Copyright Act*, whether over a path or combination of paths provided by a material substance or otherwise.

***s. 29(3):** Exhibition of artistic work does not constitute publication of the work.

DIRECT INFRINGEMENT – Direct infringement is the *unauthorised exercise of one of the exclusive rights belonging to the copyright owner.*

s. 36(1) – Works; s. 101(1) – Subject Matter: A person who is not the owner of the copyright, nor has the license of the copyright owner, commits copyright infringement when they perform or authorise any act comprised in the copyright (*see left*) and does so in Australia. Relevant direct infringement legislation includes:

WORKS: s. 37 – Infringement by importation for sale or hire; s. 38 – Infringement by sale and other dealings; s. 39 – Infringement by permitting place of public entertainment to be used for performance of work.

SUBJECT MATTER: s. 102 – Infringement by importation for sale or hire; s. 103 – Infringement by sale and other dealings.

NOTE: There can be no infringement unless copyright subsists in the source material.

There are 4 general requirements pertaining to direct infringement –

(1) *The defendant must have exercised one of the rights* ***within the copyright owner's exclusive control.***

(2) *The alleged infringement must have been done to the* ***whole or substantial part of the work*** **(SUBSTANTIALITY).**

(3) *There must be a* ***causal connection*** between the plaintiff's and defendant's work **(CAUSAL CONNECTION)**;

(4) *There must be* ***sufficient objective similarity between the 2 works*** *in their expression, not their underlying ideas* **(OBJECTIVE SIMILARITY)**.

Requirement 1: Substantiality – s. 14(1): The alleged infringement must have been done to the whole or *substantial part* of the work. Substantiality is determined by reference to the work protected (eg. music – determined aurally). Relevant considerations for substantiality include:

(1) **Quality, not quantity, of the part taken;**

(2) **Originality of the part taken;**

(3) **Object or purpose of taking, and use made of the part taken;**

(4) **Whether use of the part taken interferes with the sales of the original i.e. competing with it.**

NOTE: It is legally okay to take 'non-substantial' elements of protected works.

Substantiality – Musical Works: It is possible for a very small part of a much larger work to constitute a substantial part, particularly where the part of the song is extremely recognisable, vital and essential to the overall work ***(Hawkes v Paramount Film, 1934)***. There will be infringement when the original work, though adapted for a different purpose, can still be recognised by ear. Infringement does not depend on whether the actual notes are taken, but whether the *substance* of the original copyright work is taken i.e. the *distinctiveness and importance* of the part taken to the original. An unoriginal part will not ordinarily be a substantial part: *The simpler and less original the original work, the greater the degree of taking necessary to result in infringement*. With respect to musical works, it is not impermissible to treat each individual note as worthy of copyright protection (quality over quantity). The question of 'substantial part' is an objective one, determined according to the test of an 'ordinary experienced listener/reader/viewer'. The objective person is not precluded from focusing on particular parts of the work, from engaging with the work repeatedly or from having regard to expert views. The fact a resemblance goes *subjectively* unnoticed for a number of years is irrelevant ***(EMI Songs v Larrikin Music, 2011)***.

Substantiality – Compilations: *Old law – misappropriation rationale:* The 'substantial part' of compilations lies in the skill and labour expended in compiling the data. If a party simply copies this data, without adding any labour of their own, they will have lifted a substantial part ***(Desktop Marketing v Telstra, 2002)***. *Current law – rejection of misappropriation rationale*: Skill and labour involved in the creation of a work will only be relevant to the extent it is directed to a particular form of expression *(eg. copying time and title into TV guides will not infringe where the primary skill and labour was directed toward programming decisions)*. Expending small amounts of skill and labour in expressing information is not considered infringement of a substantial part (Gummow, Heydon & Hayne JJ). ***Merger Doctrine:*** If a fact or idea mergers with its expression such that the way in which the information can be conveyed is very limited, taking of that expression will not amount to infringement (French CJ). In assessing 'quality' of work taken, **originality of the part copied is a critical consideration.** The fact a reproduced part originates from the author does not make the part copied 'substantial'; expression must be original before it can be considered substantial. Taking unprotected elements will not normally be a substantial part ***(IceTV v Nine Network Australia, 2009)***. Objective similarity in the selection, structure and arrangement between 2 compilations is necessary for a finding of copyright infringement ***(Sports Data v Prozone Sports, 2014)***.

Substantiality – Computer Programs: Whether a substantial part of a computer program has been taken is assessed by reference to the *originality* of the part taken, *not essentiality* of the part; all code is essential. Simply reproducing data or information irrelevant to the program's structure and choice, combination and sequence of commands is unlikely to be a substantial reproduction of the program. If the part taken originates from a human author as a result of independent intellectual effort, this suggests a substantial part was taken. However, more than mere origin is required (*see IceTV*) ***(Data Access v Powerflex, 1999)***.

Substantiality – Photographs: The 'feeling and artistic character' of a photo is its substantial part i.e. its 'essence' (eg. using a photo as inspiration for a painting of a different feel and character is not 'use of a substantial part') ***(Bauman v Fussell, 1978)***. However, a photograph which is derived from (i.e. 'caused by') another photo will have taken a substantial part from the former (eg. use of the same composition, similar angle, light, shade, exposure, filtering, developing techniques etc breaches copyright) ***(Temple Island, 2012)***. But where arrangement is intrinsically ephemeral (i.e. continued existence can only be in the form of a photo), use of the photo will not be infringement of a 'substantial part' ***(Creation Records)***.

Substantiality – Broadcasts: If the part of the broadcast taken amounts to the 'heart of the work' (eg. the best scenes or an important ingredient), it will be considered a substantial part and infringement will have occurred. However, where a visual comparison will not inform a finding, the plaintiff's financial interest and the defendant's purpose will inform the finding. 'Matters of technical significance, such as the technical considerations associated with the infrastructure of production, are not considered interests protected by copyright and therefore not 'substantial parts' (*Finkelstein J*) ***(TCN Channel Nine v Network Ten, 2005)***.

Substantiality in summary:

'Substantial part' differs depending on the nature of the work – what is substantial will be different depending on the kind of work that at issue. For example, a musical copyright protects the sounds, a literary work protects the phrasing, a compilation copyright protects the selection and arrangement etc;

Quality over quantity – an inquiry into substantiality of a part is a question of quality, not quantity. A tiny percentage of the overall work can constitute a 'substantial part' if it is qualitatively important.

Focus on expression, not information - the focus of copyright is protecting the author's expression, not any underlying ideas or information.

TOPIC 7: USER RIGHTS AND DEFENCES

Copyright exceptions are *full exemptions* permitting the copyright material to be used *without authority for compensation*, thus providing a defence to infringement actions. A number of reasons are given for copyright exceptions: (a) they allow uses which cause no material detriment to the copyright owner; (b) they allow uses in circumstances where public interest overrides the copyright owner's right to withhold access; and (c) they allow uses which cannot be detected or enforced (eg. taping of free to air broadcasts).

Exception 1: Fair Dealing

For fair dealing to apply (a) use must fall within one of the categories below, and (b) the use must be objectively 'fair' in accordance with the standards of a fair minded and honest person:

Fair dealing for the purposes of research or study (s. 40/103) –

Works:

s. 40(1): A fair dealing with a work or adaptation for the purposes of research or study does not constitute infringement of the copyright in the work. **S. 40(2):** Factors to be taken into account in determining whether a particular use constitutes fair dealing for the purposes of research or study include: (a) the purpose and character of the dealing, (b) the nature of the work or adaptation, (c) the possibility of obtaining the work or adaptation within a reasonable time at an ordinary commercial price, (d) the amount and substantiality of the part copied in relation to the whole work or adaptation.

s. 40(3): Despite (2), a reproduction of a work contained in an article in a periodical publication for the purposes of research or study is taken to be fair dealing for the purposes of research or study. **s. 40(5):** Despite (2), a reproduction of not more than a *reasonable** portion of a work or adaptation for the purposes of research or study… that is not contained in an article or periodical publication is taken to be fair dealing for the purposes of research or study.

***Reasonable portion:** *Literary, dramatic or musical works* – in a published edition: 10% of pages, or 1 chapter; - in electronic form: 10% of the number of words, or 1 chapter. *This does not apply to artistic works, computer programs or electronic databases and any subsequent reproduction thereof* **(s. 40(7)).**

Subject Matter:

s. 103C: Fair dealing with an audio-visual item (i.e. sound recording, film, sound broadcast or television broadcast **(s. 100A)**) does not constitute an infringement… if it is for the purpose of research or study. Factors to be taken into account in determining whether a particular use constitutes fair dealing for the purposes of research or study include: (a) the purpose and character of the dealing, (b) the nature of the audio-visual item, (c) the possibility of obtaining the work or adaptation within a reasonable time at an ordinary commercial price, (d) the effect of the dealing upon the potential market for or value of the audio-visual item; and (e) the amount and substantiality of the part of audio-visual item copied in relation to the whole item.

NOTE: In the US, 'fair use' is a general defence. The doctrine operates to prevent copyright being used to scupper innovation and competition.

Fair dealing for the purposes of criticism or review (s. 41/103A):

s. 41/103A: Fair dealing with a work or adaptation/audio-visual item does not constitute an infringement… if it is for the purposes of criticism or review, and a sufficient acknowledgement of the work is made. **s. 10(1):** 'Sufficient acknowledgment' means an acknowledgment identifying the work by its title or description and identifying the author, unless the work is anonymous… or the author has agreed or directed that an acknowledgment should not be made.

Clips used to satirise a TV presenter is not criticism or review, as there is no connection with the subject matter broadcast. Clips used to poke fun at ineffective disguises of interviewees are not criticism or review, but mere entertainment (***TCN Nine v Channel 10, 2002***).

Fair dealing for the purposes of parody or satire (s. 41A/103AA):

s. 41A/103AA: A fair dealing with a work or adaptation/audio-visual item does not constitute an infringement… if it is for the purpose of parody or satire.

'Parody' and 'satire' are not defined in the Act, but rather are given their ordinary meaning.

Fair dealing for the purposes of reporting news (s. 42/103B):

s. 42/103B: A fair dealing with a work or adaptation (or audio-visual item) does not constitute an infringement… if (a) it is for the purpose or associated with the reporting of news in a newspaper, magazine or periodical and a sufficient acknowledgment is made, or (b) it is for the purpose or associated with the reporting of news by means of a communication or in a film.

Fair dealing for the purposes of judicial proceedings or professional advice (s. 43/104):

s. 43(1): The copyright in a work is not infringed by anything done for the purposes of a judicial proceeding or report thereof.

s. 43(2): A fair dealing with a work does not constitute an infringement… if it is for the purpose of giving professional advice by a legal practitioner, patent attorney or trademarks attorney.

s. 104: A copyright in subject matter is not infringed by anything done for the purposes of a judicial proceeding or report thereof, or for the purpose of seeking or giving advice from and by a legal practitioner, patent attorney or trademarks attorney.

Common Law: Fair use for the purpose of research does not include mere retrieval of information, especially for commercial purposes. Fair use for the purpose of study does not include merely gathering facts. Fair use for the purpose of criticism or review does not include merely locating information. Fair use for the purpose of reporting news refers to reports of 'any recent event or situation, events published in a newspaper, journal, radio, TV or other medium, information and events considered suitable for reporting, and information not previously known' (***De Garis v Neville Jeffres, 1990***). RE s. 103A: Fair dealing for the purpose of reporting news is ascertained objectively in relation to the relevant purposes, judged according to the standpoint of a fair minded and honest person. The fact news coverage is interesting or entertaining does not negate the fact it could be news. RE s. 103B: Criticism and review are words of wide and indefinite scope which should be interpreted liberally. Criticism and review may be strongly expressed, but must be genuine and not a pretence for some other purpose (***TCN Channel Nine v Network 10, 2002***). The absence of express or implied consent by the author of an unpublished work for the purposes of criticism or review is an important factor in deciding whether there has been fair dealing (s. 41). A purpose of mere revelation in disclosing secret documents or information is not considered fair dealing (***John Fairfax & Sons, 1980***).

Exception 2: Private Copying - Time/Format Shifting

Time Shifting:

s. 111(1)(2): A person does not infringe copyright if they make a film or sound recording of a broadcast *for watching or listening at a more convenient time where watching or listening will occur solely in a private or domestic setting* (includes lending to family to watch in a domestic setting).

(3): This does not apply if the article recorded is sold, let for hire, distributed by way of trade, caused to be seen or heard in public or used for broadcasting the film ore recording.

Common Law: Use of third party services enabling recording of copyright work for later viewing with only second's delay is considered copyright infringement (***NRL v Optus, 2012***).

Format Shifting:

Books, Newspapers & Periodicals (s. 43C):

The above works can be converted to other forms, subject to a number of rules: (1) the main copy must be made by the owner of the original article; (2) the main copy must be made for private and domestic use only; (c) the main copy must be in different form to the original (eg. scanned into digital form); (d) the main copy cannot be made from an infringing copy; (e) a second reproduction cannot be made from the main copy; (f) commercial dealing renders the main copy an infringement, but not if it is loaned to family members for private or domestic use; (g) if the owner disposes of the work, the main copy must be destroyed.

Sound recordings (s. 109A): Sound recordings can be converted into other forms, but podcasts and similar programs are excluded. However, the earlier copy cannot have been made by downloading from the internet. The recording infringes copyright if it is later sold, let for hire, distributed by way of trade or caused to be heard in public or used for broadcasting. However, this does not apply in respect of lending to family members for domestic use.

Films (s. 110AA): Films can be converted into video tape or electronic format. However, at the time the copy is made, it cannot be in an electronic form substantially identical to the electronic form in which the film is embodied in the main copy. Dealing with the copy is an infringement, but not if it is lent to family for domestic use. If the original is disposed of, the main copy must be destroyed.

Photographs (s. 47J): Photograph can be reproduced in a different form for private use. However, the original photo could not have been an infringing copy or a published work. Dealing with the main copy may make it an infringing copy, but this does not apply where the photo is lent to a member of the lender's family for domestic use. If the original photo is disposed of, the main copy must be destroyed.

Other Exceptions

Certain Purposes: Use for certain purposes is not considered infringement if they comply with the TRIPS, Art 13 test: (1) they must be one of the 'special cases'; (2) they must not conflict with normal exploitation; (3) they must not unreasonably prejudice the legitimate interests of the copyright owner. Use must also not be made for the purpose of obtaining commercial advantages. This applies in respect of maintaining and operating a library, giving educational instruction and assisting another person with a disability.

Other fair use exceptions:

ss. 43A; 111A: Temporary reproductions in the course of communication;
ss. 28, 44, 135ZG, 200: Educational expenses;
ss. 47AA; 110C: Reproduction for 'simulcasting';
ss. 47AB-H: Computer programs;
ss. 48A – 54: Copying by libraries and archives;
ss. 65-73: Exceptions re artistic works;
ss. 103A-112A: Exceptions re other subject matter.

CONTRAST:

US – 17 USC 107: Fair use is not an infringement of copyright, subject to (a) the purpose and character of use, including commercial or non-profit; (b) the nature of the work; the substantiality of the portion used in relation to the whole; the effect of use on the potential market for the work. The fact a work is unpublished is not a bar to fair use if the finding is made on the above factors.

Canada – dealing with publisher's works through photocopy is fair use (***CCH, 2004***). Creating previews of songs for customers to listen to prior to purchasing fair dealing for research purposes (***Bell Canada, 2012***).

TOPIC 10: DESIGNS LAW

The Meaning of Design (*all sections Designs Act 2003, unless otherwise stated*):

s. 5: A 'design' refers to the overall appearance of a *product*, resulting from one or more *visual features* of the product; **s. 6:** A 'product' is a hand-made or manufactured thing, but can also include part of a complex product; **s. 7:** 'Visual features' include the shape, configuration, pattern or ornamentation of a product. A visual feature may serve a functional purpose, but does not need to. However, the following are *not* visual features: (a) the feel of a product; (b) the materials used in the product; (c) the dimensions or pattern repetitions in a product; **s. 7(2): Functionality** – A visual feature may, but need not, serve a functional purpose (meaning that a visual feature is not disqualified merely because it serves a function. Functionality is not a bar to registration, but registration will not grant a monopoly over functionality).

COMMON LAW: Method/Principle of Construction – designs law will not protect products of general description with general characteristics. If a product can be made with a number of different specifics and appearances, each of which are variations on a product's general appearance (eg. a wheel), designs law will not allow for registration; to do so would grant the applicant a monopoly over the product (***Pugh, 1912***).

Products: The design is not the product, and the product is not the design. Rather, the design is *embodied in but separate from the product*. The design gives the product it overall visual appearance only (***Wolanski's, 1953***). Not every shape is a design. For there to be a design, there must be *sufficient individuality of visual appearance to distinguish from the fundamental form of the article*. Individuality of appearance is determined by the eye, not by measuring dimensions. Dimensions are unnecessary: if the designs visual appearance is substantially the same (different) as the registered design, there (not) be infringement, (bar fraudulent imitation) (***Malleys, 1961***). The visual appearance is the mental conception of the shape, configuration, pattern or ornament of the product in which the design has been applied. The relevant 'eye' is the eye of the judge, although the Court may call upon expert evidence in cases of highly complex designs (***Dart v Decor***).

The Design Registration Requirement – 'Novel and Distinctive': Functionality will not be relevant in determining whether there is a design. However, it will be relevant in determining whether the design is *novel and distinctive* – **s. 15:** A design is a registrable design if it is ***new and distinctive*** compared with the ***prior art base*** as it existed before the date of the design; **S. 15(2):** The prior art base (PAB) consists of (a) designs publicly used in Australia; (b) designs published in a document in or outside Australia; (c) designs disclosed in a design application where the design has an earlier ***priority date*** than the aforementioned design; **s. 27:** The priority date that meets the filing requirements is (a) the filing date of the design application; (b) before the application was filed, an application for protection in respect of the design in a Convention country; (c) the date prescribed by regulations, if the regulations provide for a different date to the priority date;

s. 16(1): A design is ***new*** unless it is identical to a design that forms part of the PAB; **(2):** A design is ***distinctive*** unless it is *substantially similar in overall impression* to a design forming part of the PAB; **(3):** The 'newness' or 'distinctiveness' of a design is not affected by the mere publication or public use of the design in Australia on or after the priority date, or by registration of another design with the same or later priority date;

s. 19: Factors to be considered in assessing substantial similarity in overall impression – (1): More weight needs to be placed on the similarities between the designs than the differences; (2): Regard must be had to (a) the state of the development of the PAB for the design, (b) the new and distinctive features if the design application... included a statement identifying particular visual features, (c) if the new and distinctive features relate to only part of a design, (d) if only part of the design is substantially similar, regard must be had to the amount, quality and importance of that part in the context of the whole design, (e) the freedom of the creator to *design and innovate**. (4) The standard of an *informed user*** must be applied (i.e. a person familiar with the product to which the design relates, or similar products;

s. 17: Certain things to be disregarded in deciding whether a design is new and distinctive – (a) any publication or use of the design with the owner's consent in circumstances prescribed by regulations; (b) any publication or use of the design without the owner's consent by a person who derived or obtained the design from the owner; (c) any information given by or with the consent of the registered owner to the Commonwealth, a State or a Territory, or a person authorised by one of these bodies to investigate the design (thus, this provision excludes publication of a design at an exhibition or use of the design without the owner's consent).

COMMON LAW: If an informed user would not consider the design to be substantially similar in overall impression to a design forming part of the PAB, infringement is unlikely to be made out. Where novelty or distinctiveness comes from a slight variation, a very close resemblance is required for infringement to succeed. Infringement is unlikely to succeed when there are only small differences between the registered design and PAB. The greater the advance in the registered design over the PAB, the more likely the common features between design and copy support a finding of infringement (***Keller v LED, 2010***). A design published in a document outside Australia before the priority date is considered part of the PAB. If a second design is un-identical to the older design, the later will be considered new. Protection for designs published without the consent of the registered owner (s. 17) is designed to protect persons who *will become* the registered owner of the design in the future. Its intent is to prevent competing publications being made without consent from defeating the owner's registration. Once disclosure of a design is made, communication to a very limited audience is sufficient to amount to 'public use', unless there is a limitation of confidentiality or secrecy (***WoT v Tempo,* 2007**). WoT shows how easy it is for a design to become unregisterable due to prior publication. However, an exception is made for artistic works made available and subsequently applied to products - **s. 18: Certain designs to always be treated as new and distinctive** – if copyright subsists in an artistic work and an application is made by or with the consent of the copyright owner for registration of a *corresponding design*, such design will always be treated as new and distinctive unless the (a) the previous use consisted of sale, letting for hire etc and applied industrially* (b) with the consent of the copyright owner of the artistic work.

***Industrial use:** More than 50 articles are made, or one or more articles are manufactured in lengths or pieces **(Reg. 17, CA).**

Design Ownership: s. 13(1): the people entitled to be entered on the Register as owners of a design include (a) the person who created the design, (b) a person who created a design under contract or employment, (c) a person who derived title from the designer or by devolution by will or operation of law, (d) the person who would be entitled to the exclusive rights in the design, (e) legal representatives of a deceased in (a-d); **s. 13(2):** A person is not entitled to be entered on the Register as owner of an unregistered design if the person has assigned all of their rights to another person, or the person's rights have devolved to another by operation of law; **s. 14:** The owner of a design is the person who owns the design at the time it is entered on the Register. If there are 2 or more owners, each of them is entitled to an equal undivided share in the exclusive rights in the design and to exercise those rights without accounting to others. However, they cannot grant a license to exercise those rights without the consent of the other(s).

Design Rights: s. 10 – The owner of a design has the exclusive right to (a) make a product embodying the design; (b) import such a product into Australia for sale or trading purposes; (c) sell, hire or dispose of the product; (d) use such a product for trade or business; (e) keep a product for any of the above purposes; (f) authorise another person to do (a-e); **s. 11** – the registered owner may assign their interest in writing, signed by themselves and the assignee...

Design Infringement: s. 71(1) – a person infringes if, during the term of registration and without license, they (a) make or offer a product that is identical or substantially similar to the registered design, or do any of the acts in s. 10(1)(b-d); **(2):** A person does not infringe if they import a product identical or substantially similar to the registered design with the license or authority of the owner; **(3)** 'Substantial similarity' is determined in accordance with s.19; **(4):** Infringement proceedings must commence within 6 years from the date of infringement.

COMMON LAW: Use ***Keller (2010)*** principles for infringement of works 'substantially similar in overall impression'. The most significant matter in determining infringement of 'substantially similar in overall impression' is the similarity with features in the prior art base (***LED v Roadvision, 2012***). The Act does not apply to functional innovations of a general product (***Firmagroup, 1989***).

Design Remedies: The usual remedies apply if a defendant is successful: **injunction, damages, account of profits & additional damages for flagrant infringement.**

Design Process & Revocation: *see ss. 20-61.*

Duration (s. 46): 5 years from filing +5 years if renewed.

Copyright v Designs

	Copyright	Designs Law
Protects	Original expression of works and other subject matter.	Visual appearance of manufactured products.
Registration required?	Does not require registration.	Requires registration.
Duration	Much longer duration.	Maximum of 10 years.
Formalities	No formalities; does not require novelty.	Requires 'novelty', akin to patent law.
Effect	Protection against derivation.	Creates a monopoly.
Does not protect	Neither protects function, nor assures financial gain.	

The Copyright/Designs Overlap:

s. 74: Corresponding design – in relation to an artistic work means visual features of shape or configuration which, when embodied in another product, result in a reproduction of that work. 'Embodied' includes woven into, impressed on or worked into the product; **s. 75:** Where copyright subsists in an artistic work and a corresponding design has been registered, it is not an infringement of copyright to reproduce the work embodying the corresponding design (however, there may still be infringement of the registered design); **s. 77: Unregistered corresponding designs applied industrially** – it is not an infringement of the copyright in an artistic work (*other than a building, model of a building or work of artistic craftsmanship*) to **industrially** reproduce a work embodying a corresponding design on or after the day on which the corresponding design products were first sold. This section does not apply if at the products embodying the corresponding design were excluded from registration by regulations at the time they were let for hire. A design is presumed to be excluded if an application for registration has been refused before proceedings commenced, the reason for refusal was that the design was excluded and no appeal against the refusal is made when proceedings commence. **NOTE:** A building does not include a portable building (eg. a shed, pre-constructed swimming pool etc – **s. 77(5), CA); s. 77A – DEFENCES: Certain reproductions do not infringe copyright** (*SEE SECTION*).

COMMON LAW: s. 77 copyright protection for buildings, models of buildings and works of artistic craftsmanship lapses if they are registered as designs (***Swarbrick, 2007***). Dual (copyright + design) protection is **not available for 3D designs, but only 2D renditions.** Copyright in 2D artistic works is infringed by a 2D copy being made in the course of **industrial application.** 3D buildings, models of buildings and works of artistic craftsmanship may receive dual protection. However, dual protection lapses if such 3D works are not registered as designs or if their corresponding design is commercially produced. Commercial exploited 2D artistic works, however, continue to receive copyright protection. Visual features 'embodied' in a corresponding design include elements woven into, impressed or worked into the product, thus including tapestries, knitted items and carpets (***Polo/Lauren v Ziliani, 2008***).

****Informed User & *Freedom to Innovate:** The 'informed user' is the judge, not the experts or general body of consumers. The standard of the informed user is someone who is familiar with the products, having the awareness and appreciation for the visual features which serve its functionality and aesthetic purposes. In determining 'substantial similarity', the court has regard to the designer's freedom to innovate. This freedom pertains to designs exclusively, not design features or concepts (***Multisteps, 2013***).