

## Table of Contents

<b>LAWS3480 – IP: COPYRIGHT AND DESIGN .....</b>	<b>2</b>
<b>TOPIC 1 – INTRODUCTION TO IP .....</b>	<b>2</b>
<b>TOPIC 2 – INTRODUCTION TO COPYRIGHT: HISTORY AND BASIC PRINCIPLES .....</b>	<b>4</b>
<b>TOPIC 3 – WHEN DOES COPYRIGHT EXIST? .....</b>	<b>6</b>
<b>TOPIC 4 – SUBJECT MATTER .....</b>	<b>14</b>
<b>TOPIC 5 – OWNERSHIP AND EXPLOITATION .....</b>	<b>32</b>
<b>TOPIC 6 – INFRINGEMENT .....</b>	<b>44</b>
<b>TOPIC 7 – ECONOMIC RIGHTS: THE ENUMERATED RIGHTS .....</b>	<b>51</b>
<b>TOPIC 8 – AUTHORISATION OF INFRINGEMENT .....</b>	<b>60</b>
<b>TOPIC 9 – EXEMPTIONS AND LIMITATION ON COPYRIGHT .....</b>	<b>69</b>
<b>TOPIC 10 – OTHER RIGHTS OF CREATORS AND OWNERS .....</b>	<b>80</b>
<b>TOPIC 11 – REMEDIES FOR INFRINGEMENT .....</b>	<b>89</b>
<b>TOPIC 12 – AN INTRODUCTION TO DESIGN LAW .....</b>	<b>97</b>
<b>TOPIC 13 – THE COPYRIGHT-DESIGN OVERLAP .....</b>	<b>105</b>

# SCAFFOLD

## TOPIC 1 – COPYRIGHT SUBSISTENCE

- There are **two kinds of copyright subject matter**:
  - **Part III “works”** (literary, dramatic, musical and artistic works) and
  - **Part IV “other subject matter”** (cinematograph films, sound recordings, broadcasts and published editions).

Part III Works	Part IV Subject Matter
Work is original	(no equivalent)
Author was a qualified person at the work was made/published (s32)	Maker was a qualified person at the time work was made/published (ss89-92) (or broadcaster is one of those identified as right holders under Part IV)
Work is in material form	Requires the making of a record, first copy of a film or broadcast
Copyright rights have no expired due to time since author’s death/publication (ss33-35)	Copyright rights have not expired due to time since publication (ss 93-96)

### 1. Originality – General Requirements

- **\*\*Copyright does not confer a monopoly on facts or information\*\***
- 1. The expression **must originate from the author** and must be a product of it’s author’s skills, labour or expertise; *Sands & McDougall Pty Ltd v Robinson* (1917)
- 2. The work **must not be copied**; *University of London Press*
- 3. Form of expression of the work is a result of **independent intellectual effort**; *IceTV v Nine Network Australia* (2009)
  - **Novelty and invention is not a requirement of originality**; *University of London Press*
    - University written math’s question. Someone collected a bunch of the questions and written answers to them, and published them as a book.
    - Confirmed in *Sands* in Australia: a map was sufficiently original as it was created by drawing on the common stock of information, in circumstances where the map’s author had applied **independent intellectual effort** to create a map with distinct differences from existing maps.

#### a. Originality and Authorship

- Previously, a compilation will be original if the compiler has **exercised labour, skill, judgment or knowledge in selecting the material** for inclusion in the compilation **OR in presenting or arranging the material OR** if they have **undertaken substantial labor or incurred substantial expense** → sweat of the brow/industrious approach; *Desktop Marketing Systems Pty Ltd v Telstra Corp Ltd* (2002)
- **NOW**, *IceTV v Nine Network Australia* (2009)
  - Copyright is aimed at protecting the **particular form of expression (the selection, arrangement)** in which an author conveys ideas or information to the world.
  - **Author and original work are correlative.**
  - Necessary to show that an author had exercised **some control over the resulting work**
  - **Independent intellectual effort** (French et al) **or sufficient effort of a literary nature** (Gummow et al).
    - **Does not require literary merit, novelty or inventiveness**
  - One or more authors must have expended **sufficient effort of a literary nature directed at the form of expression** of the work. The **form of expression** of the work must be the **result of particular mental effort or exertion** by the author and cannot be essentially dictated by the nature of the information.
    - Do not need to show literary or other skill or judgment, but must be more than a copy of other material (*Victoria Park Racing v Taylor*)

### *IceTV v Nine Network Australia* (2009)

**Facts:** 9 sues I because it was showing a program guide in electronic form. 9 programmers prepare the weekly schedules (WS) a few weeks in advance. I did not blatantly copy the program guide in the newspaper – someone sat in front of TV for 3 weeks → created new guide by rolling over, did not copy program description

**Held: No infringement – not substantial part**

- Copyright protects the particular form of expression of the information, and the selection and arrangement of that information → NOT facts
  - Facts = pieces of program time and title information
  - Expression of the facts = arrangement of that information into Nine's Weekly Schedules, in chronological order.
- **CR is about expression in final product** → not skill and labour was used in making programming decisions which is the list of facts → the skill and labour is NOT directed towards the final expression
- **Original?** NOT any substantial originality in the arrangement of the time and title information in chronological order.

- Originality lay in the selection and presentation of the time and title information together with additional program information and synopses as a composite whole.

**Telstra Corporation Ltd v Phone Directories Co Pty Ltd [2010]**

**Facts:** T published telephone directories → claim for copyright in the final product

**Held:**

- The **efforts required by the author must be efforts, which result in the material form of the work.**
  - Although the information in the directories were collected through process which involved human industry, the creation of the material form of the directories were carried out by the database (computer) overseen by persons who had no substantive input into those forms.
  - Directories **first took on material form** when computer file generated containing the full listing for directories in **Extraction Phase**. If **this was done by human, the directories were original works**. However, this was **largely automated** with only minor aspects of checking (but even checking were largely automated).
- **Computers and authors**
  - The humans were not using the software as a novelist using word processor to give form to an idea already conceived.
  - Instead, there were giving instructions at the very highest level about principal parameters of the directories → rules – stop creativity and selection
- **Requirement:** so long as the person **controlling the program can be seen as directing or fashioning the material form of the work** (controlling the nature of the material form produced by it and contribute sufficient independent intellectual effort of a literary nature).

**b. Slavish Copying and Photographs**

- Making performing editions of incomplete, partially destroyed music manuscripts is sufficient intellectual effort to afford originality; *Hyperion Records v Lionel Sawkins [2005]*
- Copying a design (lego blocks) but using different scale and making some small changes to the appearance of the design = sufficient to make the new drawings visually distinctive → original; *Interlego AG v Croner Trading Pty Ltd (1993)*
  - A trader is free to adopt the features of a rival product (in the absence of any infringement of a formal intellectual property right) so long as the trader does not falsely represent that its goods are those of another
- **CR in Photographs; *Antiquesportfolio.com Plc v Rodney Fitxh & Co Ltd [2001]***
  - **Low requirement of originality**, and can be satisfied by little more than opportunistic pointing of the camera and the pressing of the shutter button; *Copinger and Skione James*
    - Demonstrate small degree of time, skill and labour in producing the photograph (demonstrated by the exercise of judgment as to angle, lighting, film speed etc) = original
  - Any photograph may claim originality by virtue of photographer's personal choice of subject matter, angle, lighting and determination of precise time of taking the photo; *Nimmer*
  - **2 exceptional situations (CR DOES NOT exist)**
    - Photographs amount to nothing more than a slavish copying, e.g. photographing a print
    - Photographer in choosing subject matter, angle, lighting etc. copies and attempts to duplicate all of the elements contained in prior photograph
  - Where photograph is of a 2 dimensional object, e.g. photograph/painting = US court concluded that English law applied, held that there would be no copyright in relation to such a photograph (*Bridgeman Art Library Ltd v Correll Corporation*) → however easy to make a case

**2. Qualified Person**

- s84: **qualified person** = an Australian citizen or a person resident in Australia
- **Part III:** Subject matter 'works' – Copyright subsists in Australia in one of 3 scenarios:
  - 1. **If work unpublished** – author must be a qualified person at the time the work was made; s32(1), (4) OR
  - 2. **If work is published**, then the work needs to be first published in Australia or the author must have been a qualified person at the time the work was first published or, if author died before that time, was a qualified person at the time of his or her death; s32(2), (4) OR
  - 3. If the work is a **building or an artistic work** attached to a building, the building must be situated in Australia; s32(3)
- **Part IV:** Subject matter other than works (ss 89 -92, as interpreted in accordance with s 22 and 29)
  - **For sound recordings (s89), and cinematograph films (s90):** either maker/publisher be a qualified person, or the subject matter be made in Australia or first published in Australia
  - **For broadcasts (s91):** those made by qualified broadcasters (public broadcasters and holders of commercial broadcasting licenses) are protected
  - **Published editions (s92):** first publication must take place in Australia or the publisher must be a qualified person

- **Publication: s29**
    - Basically if the work has been supplied to the public = published
    - unauthorised publication does not count
    - **NOTE:** performance of work, exhibition of artistic work, construction of building/model of building, supplying photos and engravings of building/model of building/sculpture does not constitute publication
  - **Foreign Works** – Under the principle of ‘national treatment’ in treaties, copyright of foreign nationals is protected in Australia.
- 3. Material Form**
- s10 (1) defines ‘**material form**’: any form of storage, whether visible or not. Includes fixation in computer memory, whether permanent or temporary.
  - Part III: Copyright subsists in a work from the time it is ‘made’ (for unpublished works: s32(1)) or ‘published’ (for published works: s32(2) and 29)
    - A literary, dramatic, musical or artistic work is made when the work was first reduced to writing or to some other material form; s 22(1)
    - A dramatic or musical work that exists in the form of sounds embodied in an article or thing shall be deemed to have been reduced to a material form and to have been so reduced at the time when those sounds were embodied in that article or thing; s22(2)
  - Part IV: Examples – copyright subsists in...
    - Sound recordings that have been made (s 89(1) – (2) and 22(3) – (3C)) or published (s 89 (3) and 29)
    - Cinematograph films that have been made (s 90(1) – (2) and 22(4)) or published (s 90(2) and 29)
    - TV and sound broadcasts made from a place in Australia (s91 and 22(5))
- 4. Duration → See Table**
- Works **made after 1 Jan 2019:** Copyright Amendment (Disability Access and other measures) Act 2017
    - Pt III works: Life + 70 yrs
    - Pt IV subject matter other than broadcasts, published editions: 70 yrs from being made public
    - Broadcasts: 50 yrs from broadcast
    - Published editions: 25 yrs from publication
  - Works (other than artistic works) that have not been made public (by publication, performance, broadcast, recording) and unpublished films and sound recordings remain in copyright indefinitely (s33(3), (5) for works, s93 for sound recordings and s94 for films)

## **TOPIC 2 – SUBJECT MATTER**

### **1. Part III Works**

- s10 (1) of the Copyright Act provides that ‘work’ means a literary, dramatic, musical or artistic work.
  - a. Literary Works**
- s10(1) literary work includes:
  - a table, or **compilation**, expressed in words, figures or symbols; and
  - a **computer program** or compilation of computer programs
- Something that is ‘**expressed in print or writing, irrespective of the question whether the quality or style is high**; *University of London Press Ltd v University Tutorial Press Ltd [1916]*
- ‘Something which was intended to afford either **information and instruction or pleasure** in the form of literary enjoyment’; *Hollinrake v Truswell [1894]*
- **Cases:**
  - **Words** such as ‘Exxon’ is NOT a literary work because it **lacks the necessary coherency even if skill and labour has been expended** on creation; *Exxon Corp v Exxon Insurance Consultants International Ltd [1982]*
  - De minimis principle = **titles** and the like are too insubstantial and too short to qualify for copyright as literary works **i.e. headlines**; *Fairfax Media Publications Pty Ltd v Reed International Books Australia Pty Ltd [2010]*
- **Compilations**
  - Includes electronic databases, catalogues, lists of football fixtures, television broadcasting schedules, safety data sheets, tables of figures, encyclopedias and anthologies of poems
  - **However, there are significant originality/authorship issues**
- **Computer Programs** → included in definition
  - s 10 - set of instructions be used, directly or indirectly to bring about a certain result
  - **No copyright in functionality.** If you reach same function, with different code, no infringement; *Data Access Corporation v Powerflex Services Pty Ltd [1999] HCA*
    - Interface protected? *StatusCard Australia Pty Ltd v Rotondo [2008]* says NO

- Code is different, but interface is identical – was neither a table nor a compilation on the basis that it ‘does not contain intelligible information → no CR
- **Sub part of code = computer programs; *Dais Studio Pty Ltd v Bullet Creative Pty Ltd [2007]***
  - No longer require the code to have a set of instructions to bring about a certain result unaided or by its own doing.
  - As long as **instructions are cooperatively used to bring about a certain result, that should be sufficient**
  - A subpart which is functionally separate could be an independent literary work
    - i.e. Results for the bringing about of which the files were used were recognizable and definable.
  - E.g. in this case - The **files were discrete manageable entities** – could be included or excluded depending on the developer’s requirements

**b. Dramatic Works**

- s10 (1) dramatic work includes: (non exhaustive)
  - (a) a choreographic show or other dumb show; and
  - (b) a scenario or **script for a cinematograph film**
- Generally, includes:
  - Written plays and screen plays (e.g. for films, TV programs, or TV or radio advertisements)
  - Choreograph (provided it had been recorded in some material form)
  - Does not include films (Part IV)
- Minimum requirement of some type of performance. Does not need to be that of human beings, can be cartoons as it calls for performance by characters; *Aristocrat Leisure Industries v Pacific Gaming [2000]*
- A dramatic work must not only be intended to be performed, it must also be able to be performed; *Green v Broadcasting Corporation of New Zealand [1989]*
- **Cases:**
  - Specification for an electronic pokie machine i.e. display, its rules, the symbols NOT dramatic work; *Aristocrat Leisure Industries v Pacific Gaming [2000]*
  - New year fireworks display NOT dramatic work even though there was a script which sequentially detailed the particular fireworks in order and in conjunction with accompanying music; *Nine Network Australia Pty Ltd v Australian Broadcasting Corporation [1999]*
    - **Reduction to material form is not guaranteed:** timing errors or rocket misfiring may prevent the schedule from ever being followed precisely.
- Difficult issues usually arise in relation to **TV formats**

***Green v Broadcasting Corporation of New Zealand [1989] – Precedent case (NZ)***

**Facts:**

- Copyright alleged to subsist in the ‘scripts and dramatic format’ of the show as broadcasted in England.
- There were characteristic features of the show which were repeated in each performance, e.g. the title, the use of various catch phrases, the use of a device called a ‘clapometer’ to monitor audience reaction and the use of sponsors to introduce competitors.

**Held: NO CR**

- There must be certainty in the subject matter of such monopoly in order to avoid injustice to the rest of the world:
  - The subject matter of the copyright claimed for the ‘dramatic format’ of ‘Opportunity Knocks’ is conspicuously lacking in certainty.
- A dramatic work must have sufficient unity to be capable of performance – The features claimed as constituting the ‘format’ of a television show, being unrelated to each other except as accessories to be used in the presentation of some other dramatic or musical performance, lack that essential characteristic.’

***Nine Films & Television Pty Ltd v Ninox Television Ltd [2005]***

**Facts:**

- Ninox claimed that it and TV New Zealand owned the copyright in the Dream Home format and that Nine Films and Nine Network Australia infringed their copyright in producing The Block

**Held:**

**Copyright subsistence and originality:**

- Necessary to consider the whole of the series when deciding whether there is infringement, and not just one episode in isolation
- Generally, there is no copyright in central ideas, themes, or development lines of a program but rather in the combination of situations, events and scenes which reflect the working out or expression of the idea or theme.

**Reproduction of substantial part:**

- Simply by reason that there are large elements of unscripted dialogue and interaction within the overall framework of the programs, there cannot be any substantial reproduction
- The Court compared the key elements (including emotional aspects, key events and the main participants) in the programs and concluded that there was no infringement.

### c. Musical Works

- The Copyright Act provides no definition of musical work
- **Sawkins v Hyperion Records Ltd [2005] EWCA Civ 565 [2005]:**
  - Dictionary = essence of music is combining sounds for listening to. **Not same as mere noise. Intended to produce effects of some kind on the listener's emotions and intellect.**
  - The **music score is convenient form of fixation** (conform to material form requirement), but the fixation in the written score **is not in itself the music in which copyright subsists**. A recording of a person's whistling or singing can be 'music'.
- Copyright subsists **in work in its entirety** and not in parts of or extracts from the work; *Coffey v Warner/Chappell Music Ltd [2005]*
  - **Circumstances may exist justifying a constituent part of a larger entity as itself a copyright work**, but **only** when it can fairly be regarded as **so separable from the material** with which it is collocated as itself to constitute a copyright work.
  - E.g. vocal expression, (b) pitch contour and (c) syncopation of or around the words 'does it really matter' **DOES NOT** constitute separate part

### **CBS Records Australia Ltd v Gross (1989)**

- **Real issue is originality.** For copyright to subsist in an arrangement, the differences must be such that a new original work can be identified
  - Originality **depends on work being 'the product of labour, skill and capital of its author' sufficient to impart to the product some quality or character which the raw material did not possess (differentiation).**
  - The **originality lies in a myriad of differences rather than in any specific feature**, and therefore **in the performance as a whole** and not in any special or particular feature thereof.
- Applied to the case, the Trackdown version, considered in its entirety is the product of 'sufficient original skill and creative labour' to sustain copyright
  - Basic melody line is repeated. However, the embellishment which call for higher level of rhythmic subtlety, pitching skill and for wide vocal compass are not emulated in the Trackdown version.
  - Both use the same four by four 16 bar structures and similar melodic compass. However, original contained range of 23 semitones (large tonal range), but Trackdown version have a harmonic range of only 10 semitone. (Note: not creating new work here as this was done because Collette had a limited vocal range)
  - Gross developed the instrumental backing using a synthesizer.

### d. Artistic Works

- s10(1) Artistic Work means
  - (a) a painting, sculpture, drawing, engraving or photograph, whether the work is of artistic quality or not;
  - (b) a building or a model of a building, whether the building or model is of artistic quality or not; or
  - (c) a work of artistic craftsmanship whether or not mentioned in paragraph (a) or (b)
  - But does not include a circuit layout
- This is an exhaustive definition. Must fit into one of these categories.

#### i. Paintings, Drawings and Photographs

- s10(1)
  - **Photograph** is a product of photography or of a process similar to photography, other than an article or thing in which visual images forming part of a cinematograph film have been embodied, and includes a product of xerography.
  - **Drawing** includes a diagram, map, chart or plan
- Paintings: No statutory definition
  - A painting is an object with **paint upon its surface in a permanent arrangement**. Whether something is a painting is a question of fact; *Merchandising Corp of America Inc v Harpbond Ltd*
    - In the case, face paint is not a painting because the human skin is not a surface with a fixed, permanent form
  - Sand sculpture held between two sheets of Perspex is not a painting because it lacks permanency; *Komesaroff v Mickle*:

- **Artistic or literary work?** *Elwood Clothing Pty Ltd v Cotton on Clothing Pty Ltd [2008]*
  - Whether the work can be said to have a **visual** (i.e. to be understood as a design) rather than a **semiotic** function (i.e. to be read as text communicating a message to the reader)
  - Object of T shirt design was to convey a visual look and feel and they were not to be read, did not tell a story or give instructions → chosen to form an aesthetically pleasing visual "look and feel".

### ii. Sculptures and Engravings

- s 10(1) Copyright Act provides following definitions:
  - Engraving includes an etching, lithograph, product of photogravure, woodcut, print or similar work, not being a photograph
  - Sculpture includes a cast or model made for purposes of sculpture
- **Overall:** Object that has been **shaped in some way by human hands** i.e. carved or modelled. Cannot have been the result of a mere industrial process, but must have been modelled by a human with a view of creating a sculpture
- An **industrial model** cannot be considered a sculpture; an industrial mould cannot be considered an engraving; ***Greenfield Products Pty Ltd v Rover Scott Bonnar Ltd (1990)***
  - Key distinguishing factor? Is this just a **utilitarian item or just as an aesthetic item**
  - **Primary Purpose test:** Look at functionality – whether or not it is there to look pretty
- Helmets in Star Wars had utilitarian function of the helmet (i.e. element in the process of production of the film) meant that it was not a sculpture; *Lucasfilm Ltd v Ainsworth [2009]*
  - Multifactorial approach taken – look at the intention of the designer and how the sculpted article was to be used/enjoyed. Helmet was largely functional and hence not sculptures.
    - determined that the helmet was a mixture of costume and prop, with its primary function being utilitarian
- However in AUS – the fact that an item has **some function does not necessarily prevent** it from being a sculpture; *Wildash v Klein [2004]*
  - 3D depictions of animals made out of wire some of which incorporated a candle holder = sculpture because there is a strong visual appeal

### iii. Buildings

- s 10(1) Building includes structure of any kind
- **'Structure'** not defined in statute = something which is of some substance, and is usually erected upon or constructed upon or in ground with an element of permanence, although it need not be a fixture in the property law sense; *Darwin Fibreglass Pty Ltd v Kruhse Enterprises Pty Ltd*
- Structure or building does not have to be occupied by human or living species, and includes bridges and dams; *Darwin Fibreglass Pty Ltd*
- There is **no single test for what is or what is not a 'building'**. **But relevant factors are:** *Darwin Fibreglass*
  - Size
  - Evident proposed use of object to an independent observer
  - Object is fixed to or under the ground or intended to be portable
  - Degree of permanence in location (likely life span of the object)
- Have been held to include
  - A miniature tennis court; *Half Court Tennis Pty Ltd v Seymour* and
    - Whether it is of artistic quality or not does not matter.
  - A fiberglass swimming pool; *Darwin*
    - even though it was manufactured off site and is capable of being removed

### iv. Works of Artistic Craftsmanship

- No definition in Copyright Act. But they are the only form of artistic work where some kind of artistic quality is required.
- Category subset of utilitarian item → exception to the rule in engravings and sculptures → The reason for this is the copyright and design overlap
- The two elements (artistic and craftsmanship) must be united in the same person: *Burke & Margot Burke Ltd v Spicers Dress Designs [1936]*
- The **'artistic' quality** of the craft work is gauged by looking at the **intention of the artisan** and asking whether **the main object of creating the piece, albeit utilitarian**, was that it should have a **'substantial appeal to the taste of those who observe it;** *Cuisenaire v Reed*

#### ***Coogi Australia Pty Ltd v Hysport International Pty Ltd (1998)***

- A work of artistic craftsmanship **may be mass produced** → they **need not be handmade**
- Although the author **must use a highly sophisticated machine** with **creative skill, knowledge,**



**and pride** in workmanship → need not be the product of a single person.

**Facts:**

- In this case, the plaintiff designed and manufactured a distinctive machine-knitted fabric and garments – highly textured surface, complex, abstract, multi-coloured design.

**Principle – Work of artistic craftsmanship entails 2 features:**

- **1. Objective aesthetic quality**
  - Determined objectively → Creator's subjective intention not determinative
  - "The article need not have such a high level of aesthetic quality as to make it a work of fine art."
  - But: "The level of aesthetic appeal required for a work of artistic craftsmanship is higher than **mere visual appeal**"
- **2. Work of craftsmanship**
  - Evidenced by skill, knowledge of materials and pride in workmanship on the part of the creator
  - Craftsmanship can also exist where an **article is made by a skilled person who uses these skills to set up and operate a machine** which produces an article even if creator used highly sophisticated computer-controlled machine to produce it, **if it is a manifestation of creator's skill with machinery, knowledge of materials and pride in workmanship**
  - **Does not have to be hand craft!**
- Coogi fabric is work of artistic craftsmanship
  - Objectively, the output satisfies the aesthetic qualities required for artistry
  - An expert person programmed the machine to produce the output, which is sufficient craftsmanship

**Burge v Swarbrick [2007] HCA 17**

**Issue:** Are design for the plug and the mouldings for yacht were "works of artistic craftsmanship"?

**Held:** Neither the Plug nor moulds were works of artistic copyright at all

- A work could be one of artistic craftsmanship, despite its form being **partially dictated by functional considerations**.
- Need to assess the **extent to which the particular work's artistic expression**, in its form, is **unconstrained by functional considerations**.
- The **greater the requirements** in a design brief to satisfy utilitarian considerations, the **less scope** to encourage substantial **artistic effort**

**Applied: NO**

- In designing the plug for the boat, S's key aim/overriding consideration was creating speed on the water, and, in seeking to achieve it, he was acting in the role of an engineer rather than an artist-craftsman.
- The aesthetic appeal of the look of the resulting sports boat was a secondary concern.
- Evidence of a naval architect indicated that the nature of boat design and promotional material for the yacht emphasized functional considerations over aesthetics.

**2. Part IV Works**

**a. Sound Recordings**

- **s 10** Copyright Act provides following definitions:
  - **Sound recording** means the aggregate of the sounds embodied in a record
  - **Record** means a disc, tape, paper or other device in which sounds are embodied
- **s 23**
  - **(1)** ...sounds embodied in a **sound-track** of a **cinematograph film** is NOT a sound recording
  - **(2)** A reference...to a record...shall be read as a reference to a record by means of which the work or other subject matter can be performed (i.e. sound recording must be able to be played)
- **Embodied (s 24)** = a sound recording could be made on a tape, onto a CD, or any other form (tech neutral), provided that the **sounds can be reproduced from the thing or article**
- **s 89** protects the actual sounds in a sound recording, and not the musical works comprising those sounds; *CBS Records v Telmak*

**b. Cinematographic Film**

- **s 10(1)** Copyright Act provides following definitions:
  - **Cinematograph film** means the **aggregate of the visual images embodied in an article** or thing so as to be capable by the use of that article or thing:
    - (a) of being shown as a **moving picture**; OR
    - (b) of being embodied in another article or thing by the use of which it can be so shown and includes the **aggregate of the sounds embodied in a sound track associated with such visual images**

# NOTES

# LAWS3480 – IP: COPYRIGHT AND DESIGN

## TOPIC 1 – INTRODUCTION TO IP

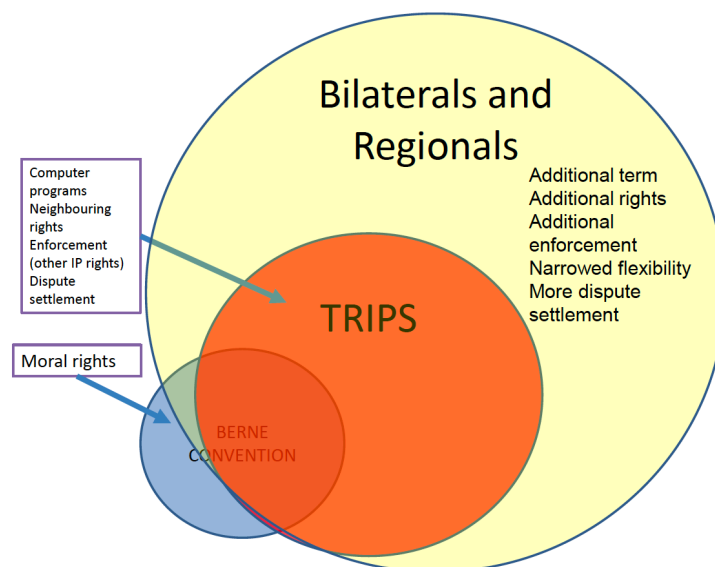
### 1. The Nature of IP

- What is a copyright?
  - A law that grants creators (e.g. authors, producers) exclusive property rights in their creations
  - Property rights in intangibles in order to protect products of human creativity and inventiveness
- Key feature of IP rights:
  - Exclusive use
  - Property right – enforceable against the whole world
  - Transferability – ability to assign right

### 2. The Constitutional Basis for IP Law

- IP is a matter of Federal jurisdiction
- Commonwealth Constitution s 51(xviii): Commonwealth given power with respect to ‘copyrights, patents of inventions, and designs and trademarks’
  - Early authority interpreted this narrowly: *Union Label* case
  - Interpreted broadly in *Grain Pool of WA v Commonwealth* (2000) 202 CLR 479 – can include plant varieties and circuit layouts
- Also: external affairs power s 51(xxix) → treaties

### 3. International Influences



#### a. The Berne Convention 1886

- Seeks to provide an international system of protection for some subject matters recognised in the Australian Copyright Act.
- The logic of the Berne Convention rests on two pillars: **national treatment** and **minimum standards**.
  - National treatment (article 2(1)): Foreign authors get the same treatment as local author. Each member of the Berne Union affords foreign authors the same copyright standards they afford domestic authors.
  - Minimum standards: treaties establish minimum levels of protection
    - E.g. length of copyright at least life of author + 50 years and cannot require registration
- Not allowed to agree to treaties with other countries that have a lower standard than Berne
- Remedy: ICJ only

#### b. Rome Convention 1961

- The Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations 1961 provides an international system of protection for so - called ‘neighbouring rights’ in sound recordings, broadcasts and performances.

#### c. Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS (1994))

- An agreement under the umbrella of the World Trade Organization (WTO) Agreements.
- Every member of the WTO must comply with TRIPS.
- TRIPS incorporates most of the provisions of Berne by reference (art 9), and includes some further obligations, particularly on newer technologies and enforcement → excludes moral rights

- Principle of most favoured nation: If country A agrees with country B to give more rights to country B, then under this principle, all nations (i.e. country C) get the same treatment as country B
- Breaches of TRIPS can be the subject of dispute settlement proceedings in the WTO which may ultimately lead to sanctions.

#### **d. The WIPO Internet Treaties**

- In 1996, two new agreements, the WIPO Copyright Treaty and the WIPO Performances and Phonograms Treaty were concluded.
- The goal of these treaties was to update/supplement copyright law to take account of the rise of digital and network technologies (such as the internet).

#### **e. Bilateral, Regional, and Plurilateral Trade Agreements**

- IP obligations have become commonplace in bilateral, plurilateral and regional trade agreements. Australia's law has, for example, been significantly influenced by the IP chapter in the Australia - US Free Trade Agreement concluded 2004.
- Australia also in 2015 concluded the Trans - Pacific Partnership (TPP), a regional agreement involving 12 countries and including a detailed IP Chapter. The US repudiated the TPP but the remaining TPP members intend to go forward (suspending a few provisions including some copyright provisions).

## **TOPIC 2 – INTRODUCTION TO COPYRIGHT: HISTORY AND BASIC PRINCIPLES**

### **1. History of Copyright Law**

- Statute of Anne
  - 14 years initially – could renew if still alive
  - exclusive right to make copies – not extended to make into play
  - controversial – some individuals believed that they had property in their works forever
- Literary property wars – go to courts, CL also recognises perpetual right to work despite Statue of Anne
- *Millar v Taylor*
  - Court of appeals holds that there is perpetual CL copyright based on Locke-ian type reasoning – statue is just regulation
- *Donaldson v Beckett*
  - HOL says no – there is no CL copyright – if there was, it would have been overruled by the statute
  - Now: s 8 asserts exclusive jurisdiction of the statue with regards to copyright
- In the late 19<sup>th</sup> century from rights in books to series of rights in other creative arts
- Consolidated in early 20<sup>th</sup> century (1923 copyright act)
- Over course of 20<sup>th</sup> century and the act has changed over time to incorporate new tech
- Large change in 1960 – recognised copyright in film and sound recording for first time – the copyright act as we know it now
- The mid-90s Copyright Crisis
  - The riddle is this: if our property can be infinitely reproduced and instantaneously distributed all over the planet without cost, without our knowledge, without its even leaving our possession, how can we protect it? How are we going to get paid for the work we do with our minds?
  - And, if we can't get paid, what will assure the continued creation and distribution of such work?
  - ...The economy of the future will be based on relationship rather than possession. It will be continuous rather than sequential. (John Perry Barlow, Selling Wine without Bottles on the Global Net)
  - The answer to the machine is in the machine
    - Encryption
    - Digital rights management (DRM) (and legal rights to prevent hacking)
    - Building DRM into devices (CSS and DVD players; other proposals like SDMI)
- Continued attempts to strengthen copyright
  - Notice and takedown→notice and stay down?
  - Website blocking
  - Domain name seizures
  - Multinational law enforcement efforts (Kim Dotcom)
  - Follow the money: the credit card providers and the online advertising companies)

### **2. Philosophical Justifications**

#### **a. Incentive-Utilitarian Argument**

- Incentives: the classic economic rationale
  - Investment is necessary to create intangibles (literary/arts or scientific)

- Intangibles are readily duplicated once publicly released
- Copyists can undercut original creators because did not make investment in creation (less sunk costs to recover)
- Thus exclusive rights: allows creation of a market for intangibles
- In reality, it is more complex
  - Throsby Study: Australian writers averaged:
    - \$12900 from creative work
    - \$14000 from associated work (editorial; teaching creative writing)
    - \$20000 from non-arts work
  - Authors tend to get an 'advance' and then start receive royalties on future sales only once they 'earn out' their advance
    - The advance can vary, from \$5000 up (e.g. Lena Durham, US \$3.5M) depending on expected sales, fame, track record
  - Economics varies industry to industry, and across media
    - Music – top 1% earns 77% of income from recorded music
    - This is very common in all creative industries
    - There is a generally oversupply of creators – pushes income down and a lot of power in negotiation are in the hands of distributors
- Taking incentives rationale seriously
  - Copyright lasts for the authors life plus 70 years
  - Is the money from royalties an incentive to create works? After 40 years? 60 years?
    - Assuming interest rate of 7%, each dollar of royalties from year 80 has a present value of \$0.0045
    - So no
  - Will a creative work still be earning royalties after 100 years it is published?
    - Average commercial life:
      - Music: 2-5 years
      - Literary works: 1.4-5 years
      - Art: 2 years – distribution is highly skewed
      - Film: 3.3 – 6 years

#### **b. Natural Rights Theories**

- **1. Locke:**
  - 'You should not reap where you have not sown'
  - This position regards copyrightable works to be extensions of the author's personality.
  - The author is given certain powers to control those works on account of his or her connection to them (*droit d'auteur* – authors rights).
- **2. Hegel:**
  - Products of mind of creative is an emanation of the spirit/personality of the creator. There is an indestructible connection between the author and the product.
  - Entitles author to control bits of them that are out there in the world
  - Not severed even by the fact that you have assigned copyright to someone else. Will always be something of yours and therefore you should have limited rights such as the right of refusal

#### **c. Moral Rights Theory**

- French word *droit d'auteur* = author's moral right → rights of creators of copyrighted works.
- Include right of attribution, right to have a work published anonymously or pseudonymously and the right to the integrity of the work/right against derogatory treatment,
- Moral rights are distinct from any economic rights tied to copyrights. Even if an artist has assigned his or her copyright rights to a work to a 3rd party, he or she still maintains the moral rights to the work

#### **d. Others**

- Neil Netanel's democratic theories (allows independence of creators from patrons)
  - Allows critical cultural and informative sector
- IP as a human right: UDHR article 27 (2)
  - Everyone has a right to protection of moral and material interests resulting from any scientific, literary or artistic production of which he or she is author
- Drahos: financiers copyright
  - Investors instead of creators' right
- Gurry: IP has new reasons to exist
  - Mechanism for determining fair competition in relation to the 'resource base of the knowledge economy'

- Mechanism for finding equilibrium among competing interests: including interests of society in access to creations, sharing social benefits of new knowledge
- Financing mechanism for underwriting activities – e.g. sporting events which are funded through sale of broadcasting rights

### 3. **Copyright Principles**

#### a. **The Concept of Public Domain**

- Public domain: Body of creative material that exist that is not protected by copyright
- Is it a bad thing to fall into the public domain?
  - Every creator draws from what has gone before them
  - Can translate into other languages
  - Becomes part of culture, ease of research, feeling that it belongs to everyone
  - Means can reuse stuff for free and artists generally would reference – culture of referencing and would like future artists to reciprocate
  - Copyright covers everything, including letters written by soldiers etc, if there were never ending CR then museums couldn't show them
  - Make valuable works accessible in ways they have never been able before
- Host of reasons why want to go back to public domain materials

#### b. **Copyright as Property**

- s 196 (1) Copyright is personal property and is transmissible by assignment, by will and by devolution by operation of law
- Copyright is a form of property. However, it relates to an abstraction — the work or material in question; and should be distinguished from ownership of the physical medium in which the material is expressed.
- The copyright in each type of work or other subject-matter has independent existence. copyright may subsist independently in a literary work, a film based on the work and a broadcast of the film. Three different copyright owners may own these three different kinds of copyright.
- Property right in copyright is separate from property right in physical medium in which it is embodied (i.e. I can sell you the book, but does not mean you get the copyright of the book)
  - Cite *In re Dickens; Dickens v Hawksley*
    - Dickens died → Transferred personal property to one person (P1) and copyright property to another (P2)
    - Found unpublished manuscript – who has right to publish? P1 or P2
    - The person who has the actual thing? Or the person who has the copyright?
    - Shared 50/50 – person who had property shared with the person who had copyright and they got it published
  - *Pacific Film v Commissioner of Taxation*
    - Prints of photograph – copyright belongs to person who took photographs. But printer owned the prints in tax context.

#### c. **Idea v Expression**

- “Ideas, thoughts and facts merely existing in a man’s brain are not ‘works’ and in that form are **not within the Copyright Act**; but **once reduced to writing or other material form** the result may be a work **susceptible to protection**. Given that there exists a good copyright in a work, **the law does not protect a general idea or concept which underlies the work, nor any one fact or piece of information contained therein**. However, a more detailed collection of ideas, or patterns of incidents or compilation of information may amount to such a substantial part of the work that to take it would be an infringement of the copyright, although expressed in different language or other form, it being a matter of fact and degree whether the dividing line has been impermissibly crossed”
  - Laddie, Prescott and Vittoria, *The Modern Law of Copyright and Designs*, 3rd edition, 2001
- ***Donoghue v. Allied Newspapers Ltd***
  - Jockey paid for a series of interviews published by the interviewing journalist
  - Jockey can’t stop publication of articles based on these interviews
  - *Jockey* provided the ideas – but jockey didn’t create the written form
  - *journalist* wrote the ideas down so journalist is the author and owns the copyright
- E.g. JK Rowling does not get to control the idea of wizards or wizard school, but she has a control of expression of wizards, such as Harry Potter
  - Expression does not refer to literal expression of words.
  - E.g. Cannot recreate Harry Potter by changing a few words.

### **TOPIC 3 – WHEN DOES COPYRIGHT EXIST?**

- There are **two kinds of copyright subject matter**:
  - **Part III “works”** (literary, dramatic, musical and artistic works) and

- **Part IV “other subject matter”** (cinematograph films, sound recordings, broadcasts and published editions).
- The rights granted, the rules relating to initial ownership, and rules relating to infringement are different for Part IV subject matters.
- Key criteria for subsistence in Copyright Act 1968 (Cth)

Part III Works	Part IV Subject Matter
Work is original	(no equivalent)
Author was a qualified person at the work was made/published (s32)	Maker was a qualified person at the time work was made/published (ss89-92) (or broadcaster is one of those identified as right holders under Part IV)
Work is in material form	Requires the making of a record, first copy of a film or broadcast
Copyright rights have no expired due to time since author’s death/publication (ss33-35)	Copyright rights have not expired due to time since publication (ss 93-96)

### 1. Originality

- Originality is critical in copyright. It is:
  - The threshold for subsistence for works (s 32)
  - Relevant to determination of who is an author (which determines ownership)
    - Authors get first rights, i.e. they are the first owner of their work.
  - Relevant to infringement (assessing whether defendant has copied a ‘substantial part’)
- **Meaning of ‘originality’?**
  - 1. The expression **must originate from the author** and must be a product of it’s author’s skills, labour or expertise. (*Sands & McDougall Pty Ltd v Robinson (1917)*)
  - 2. **Novelty and invention is not a requirement of originality** (*University of London Press*)
    - Confirmed in *Sands* in Australia: a map was sufficiently original as it was created by drawing on the common stock of information, in circumstances where the map’s author had applied **independent intellectual effort** to create a map with distinct differences from existing maps.
  - 3. **Does not depend on literary or artistic merit or skill.** Although literary skill or taste may be indicative of originality, it is not required. A work can be completely devoid of artistic merit yet still be original (as long as there is intellectual labour) (*Desktop Marketing case*)

#### **University of London Press Ltd v University Tutorial Press Ltd [1916]**

##### **Facts:**

- University written math’s question. Someone collected a bunch of the questions and written answers to them, and published them as a book.
- Defendant argued that there was nothing creative about the questions as they were just formulae.

##### **Held:** Court rejected the view that there has to be creativity

- Copyright Acts are **not concerned with the originality of ideas (novelty)**, but with the expression of thought, and in this case of literary work with the expression of thought in print or writing.
- The originality which is required relates to the expression of the thought. But the Act **does not require** that the **expression must be in an original or novel form**, but that **the work must not be copied** from another work – that it should originate from the author
- The fact that authors drew on body of knowledge common to mathematicians did no compromise originality. Even though same old mathematics problems every student is familiar with and even though no creative input, the skill, labor and judgment of authors was sufficient to make papers original literary works.

#### **a. Edge Problem: Collection of Facts?**

- Fringe problem – whole universe comprehensive collection of fact where extensive effort but minimal creativity, judgement or selection is involved
- UK stance: *Kelly v Morris*
  - Majority of English case law accepts that there can be copyright in a factual compilation because of the ‘sweat of the brow’ doctrine, noting that where significant labour has been expended in compiling a street directory for example, it will be entitled to receive copyright protection from misappropriation by others
- Before Ice TV case in Australia, the leading case was: *Desktop Marketing Systems*

#### **Desktop Marketing Systems Pty Ltd v Telstra Corp Ltd (2002)**

##### **Facts:**

- DMS produce searchable marketing and residential directories on CD-ROM using data and categories from Telstra’s White and Yellow pages’ telephone directories.

##### **Issue:** Is ‘industrious collection’ sufficient to establish originality?

**Court:** Based on previous authorities:

- A **compilation will ordinarily be an original literary work for copyright purposes** if the compiler has **exercised labour, skill, judgment or knowledge in selecting the material** for inclusion in the compilation (e.g. collection of commentaries) **or in presenting or arranging the material** (births and deaths column in newspaper)
- In addition, a **compilation of factual information** will ordinarily be an **original literary work** if the compiler has **undertaken substantial labor or incurred substantial expense in collecting the information** recorded in the compilation
- Copyright in a factual compilation **will be infringed only** where the alleged infringer **takes a substantial part of the copyright work**.

**Significance:**

- **Affirmed sweat of the brow/industrious collection standard – no judgment/skill/creativity required** for copyright protection
  - i.e. sufficient work and investment in a thing will entitle you to copyright. Do not need to show judgment or skill
  - No skill/judgment needed to arrange the phone number, no skill in selecting what you are going to put in the phonebook. Does not sound original, but the investment in putting together information was enough in this case.
- Left a query about human authorship (see first instance Finkelstein Judgment)
- Also clear that **preparatory work not directed to actual final form was sufficient to make work original** – whatever the simplicity/inevitability of the final output
  - *Olympic Amusements v Milwell* – A table that reflected underlying complicated mathematics and algorithms to do the minimum payouts in pokey machines. The outcome of the calculation was a simple table, that was copied. All of the skill was what made it entitled to copyright. If table is copied, there is infringement.
- Problem of this case creating tension:
  - Copyright usually do not protect facts (e.g. history book). Phonebook is a copy of facts.
  - Grants monopoly to Telstra.
- **Cf with US case in *Feist***: modicum of creativity is required.
  - Some selectivity and creativity and judgement not just effort
  - Trying to reconcile two propositions
    - 1. Compilations have historically been protected by CR
    - 2. But there is no CR in facts
  - CR will not protect pure collections of facts – will protect where someone has exercised some judgement
    - i.e. if select 100 poems by dead author – copyright, but if compilation of all poems by dead author, then no

- Subsequently, **Ice TV case changed the position**. Although subsistence of copyright was conceded, it was necessary to consider the originality of parts copied from the TV program guide in question, in determining whether they constituted a substantial part and hence a copyright infringement.

***IceTV v Nine Network Australia (2009)***

**Facts:**

- 9 Network sued because Ice TV was showing a program guide in electronic form.
  - Programmers at Channel Nine prepare the weekly schedules (WS) a few weeks in advance.
  - Sent information to aggregators who put it with information from other TV channels to make up TV guides.
  - Nine alleged IceTV indirectly gathered information for its programming guide from the Aggregated Guide.
  - The Weekly Schedule was alleged by Nine to be an “original” literary work under the *Copyright Act 1968* (Cth). Nine asserted that any reproduction of material that IceTV took from the Weekly Schedule or Aggregated Guide would be an infringement of the copyright Nine held as literary work
- Ice TV did not blatantly copy the program guide in the newspaper. Someone watched the TV for 3 weeks and recorded the timing of the TV programs.
- The person created the table (i.e. recording of past facts). In order to create the new guide, they rolled it over to predict the future days and checked it against 9 Network’s program guide.
- They copied the time/day and name of program of the bits that were changed. They did not copy the description of the program and actually wrote their own.

**Issue:** Note that this is an infringement case as Ice TV conceded that copyright subsisted in the Weekly Schedules (since they wanted their own guides protected). It simply argued that it had not copied a substantial



part of the Weekly Schedule. → Question is whether copying the differences in schedules = substantial part  
**Held: Not substantial part → no infringement**

- “Copyright does not protect facts or information. **Copyright protects the particular form of expression of the information**, namely the words, figures and symbols in which the pieces of information are expressed, and **the selection and arrangement of that information** ... Copyright ... does not confer a monopoly on facts or information because to do so would impede the reading public’s access to and use of facts and information.
  - In this case the “facts” were the pieces of program time and title information obtained by IceTV from the published television guides.
  - The “expression” of those facts was the arrangement of that information into Nine’s Weekly Schedules, in chronological order.
- Channel Nine established that skill and labour was used in making programming decisions, such as what program was to be broadcast in a particular time slot. However, this skill and labour was not directed to the particular form of the time and title information that IceTV reproduced.
  - What Channel Nine had produced were a list of facts → it is the expression of this list of facts in the final format this is copyrightable – how it looks in the final table
  - **CR is about expression in final product** – words on the page, table on the page, notes of the music, the brushstroke – not about the underlying programming decision
- French CJ, Crennan and Kiefel JJ focused on the **ideas/ expression dichotomy**, finding that there was **insufficient originality in the arrangement of the time and title information** for that to amount to a substantial part.
  - This was because their Honours **did not consider that there was any substantial originality in the arrangement of the time and title information in chronological order.**
  - To the extent that any skill and labour had been invested by Nine’s employees in arranging the time and title information in the Weekly Schedules, that skill and labour was considered to be minimal in relation to expressing that information.
- Similarly, Gummow, Hayne and Heydon JJ found that **the originality of the Weekly Schedules lay in the selection and presentation of the time and title information together with additional program information and synopses as a composite whole**, not in the expression of the time and title information itself.
- The preparatory work involved in producing the time and title information was not relevant to substantiality and there was left only “the extremely modest skill and labour” in setting down the programs already selected.
- They also cautioned against reliance on the *Desktop Marketing* emphasis on appropriation of skill and labour, suggesting that the reasoning in *Desktop Marketing* may have been “out of line with the understanding of copyright law over many years”.

**High Court on ‘originality’:** Both judgments emphasize (French and Gummow)

- **The importance of originality of expression.** Copyright focuses on skill **directed to particular form of expression** protected by copyright, i.e. the literary work.
  - French judgment: **Copyright is aimed at protecting the particular form of expression** in which an **author conveys ideas or information to the world**. Copyright is not given to reward work distinct from the production of a particular form of expression.
  - **Skill in selecting show not relevant.** The **arrangement in creating the TV guide is relevant**, but **no skill required as arrangement is merely by time.**
  - **Copyright subsisted in the TV guide**, but the **arrangement of the schedule is not original to the Excel Weekly Schedule**. Not a substantial part and hence not infringement because what was copied was not original in its expression.
  - **Intellectual effort in determining what time to show particular programs was not relevant: this skill/judgment was not directed to the particular form of expression**
- **The importance in the Act of human authorship**
  - Authorship and original work are correlatives, i.e. originality requires that the work should have originated with the author and it was not merely copied from another work. **Necessary to show that an author had exercised some control over the resulting work**
  - **Language on authorship: independent intellectual effort** (French et al) **or sufficient effort of a literary nature** (Gummow et al).
    - **Does not require literary merit, novelty or inventiveness**
  - Not clear what is sufficient to constitute the above terms. Varies between other countries too.
  - Here, as the **time and title information were limited forms of expression which could only be expressed in a small number of ways, they lacked the requisite originality for it to constitute a substantial part of the Weekly Schedule**. The authors of the WS **had little if any choice in the particular form adopted**, as the expression as essentially dictated by the nature of the information (i.e. lacks requisite originality)
  - Comparatives:

- US Supreme Court in *Feist*: need some modicum of creativity or minimal creative spark
- European court in *Infopaq*: standard of 'author's own intellectual creation'
- Gummow judgment: focuses more on subsistence
  - Explicitly throws doubt over *Desktop Marketing*
  - Examines process of creating the database in detail
  - Notes absence of evidence of role of human authors in determining form of expression of database and notes that if arrangement of database is automatic, supposed author may not in fact be an author

#### b. Slavish Copying and Photographs

- Originality does not arise where work has been 'slavishly copied' from another even if significant skill and effort has been expended in producing the copy
- Small changes during the copying will however often be sufficient to confer a fresh copyright

#### ***Hyperion Records v Lionel Sawkins [2005] → UK Case***

##### **Facts:**

- Dr Sawkin ('S') had researched the works of the late Lalande, the principal composer at the courts of Louis XIV and Louis XV, and had created new performing editions of four of his works.
  - Existing manuscripts are incomplete because they are destroyed, and also lacking in symbols that were yet to be created at that time
- Hyperion Records (H) produced a CD featuring performances of the four performing editions.
- H disputed that S was entitled to copyright in these editions, on the basis that an editor should not obtain copyright in non-copyright works.

##### **Held:**

- Additions that he made was sufficient. Not a high bar to pass.
- The effort, skill and time that S spent in making the performing editions was sufficient to make them "original", even though they were based on the scores of musical works composed by Lalande.

#### ***Interlego AG v Croner Trading Pty Ltd (1993)***

##### **Facts:**

- In producing the drawings of Lego and Duplo toy bricks as a representative example, a Lego employee had sat down with an earlier drawing of a Lego brick and copied it, using a different scale and making some small changes to the appearance of the bricks in the drawings.

**On appeal:** Originality exists. Gummow J noted that 'great skill' was involved, and the change were sufficient to make the new drawings visually distinctive.

- A trader is free to adopt the features of a rival product (in the absence of any infringement of a formal intellectual property right) so long as the trader does not falsely represent that its goods are those of another

#### ***Antiquesportfolio.com Plc v Rodney Fitxh & Co Ltd [2001] → UK Case***

**Issue:** Photograph of a single static item, e.g. jug or sofa – can it be protected by copyright?

##### **Discussion of commentaries:**

- Laddie, Prescott and Vitoria on the Modern Law of Copyrights and Design – **Originality in photograph can exist under 3 circumstances:**
  - 1. Specialties of angles of shot, light and shade, exposure, effects achieved by means of filters, developing techniques
  - 2. Creation of the scene or subject to be photographed
  - 3. Taking a photo because he was at the right place at the right time (a scene unlikely to recur)
- **Copinger and Skione James on Copyright**
  - Low requirement of originality, and can be satisfied by little more than opportunistic pointing of the camera and the pressing of the shutter button
  - Demonstrate small degree of time, skill and labour in producing the photograph (demonstrated by the exercise of judgment as to angle, lighting, film speed, filter, etc.) = original
  - However, what extent of protection to be afforded is a different matter
- **Nimmer on Copyright (US)**
  - Any photograph may claim originality by virtue of photographer's personal choice of subject matter, angle, lighting and determination of precise time of taking the photo
- **Two latter discussion** represent the law in England
- **2 exceptional situations (CR DOES NOT exist)**
  - Photographs amount to nothing more than a slavish copying, e.g. photographing a print
  - Photographer in choosing subject matter, angle, lighting etc. copies and attempts to duplicate all of the elements contained in prior photograph
- Where photograph is of a 2 dimensional object, e.g. photograph/painting = US court concluded that English law applied, held that there would be no copyright in relation to such a photograph (*Bridgeman*)

*Art Library Ltd v Correll Corporation*)

- However, as suggested in Nimmer, it may well be that if the photograph in such a case could show that he in fact used some degree of skill and care in taking the photo, he could claim originality in such photograph
- BUT in this case, 3 dimensional object, there is copyright because
  - Photos appear to have been taking to exhibit particular qualities, including the colour, their features and details.
  - Some degree of skill was involved in the lighting, angling and judging the position.
  - Author chose particular item in order to find a typical example of a certain type of artefact

**c. Human Authorship**

**Cummins v Bond [1927]**

**Facts:**

- Miss Geraldine Cummins was a medium who sold her services professionally. She used a pen to write down a message by a 1900-year-old spirit, Cleophas, which was addressed to an architect, Mr. Bligh Bond, who was present in the session.
- After she wrote it, Bond typed the message himself. Mr. Bond claimed copyright on the resulting text because it was addressed to him and typed by him.

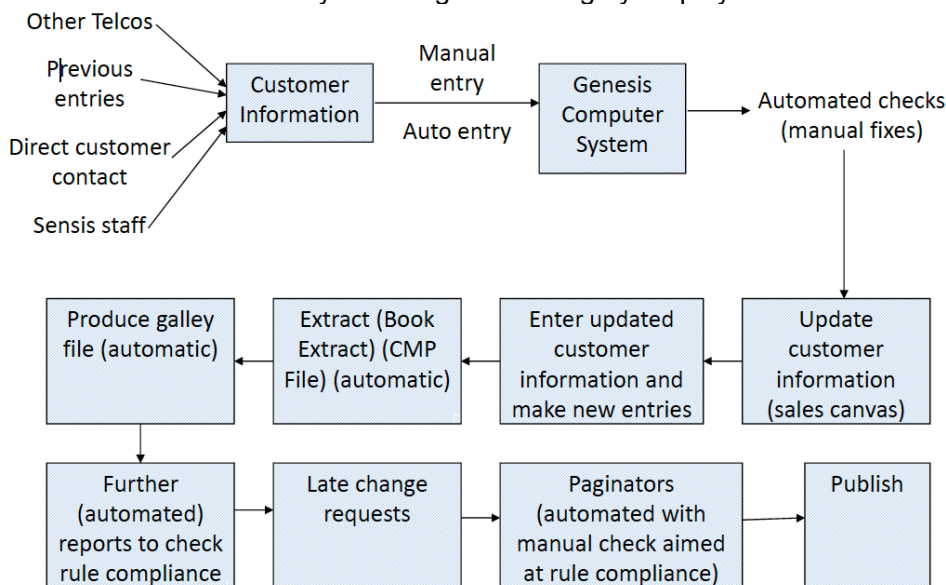
**Held:**

- Court decided it had no jurisdiction over the afterlife and therefore the copyright holder and sole author is Cummins.
- Authorship must be attributed to Cummins whose ability to write quickly and to translate into archaic English matter communicated to her in some unknown tongue resulted in the production of the writing

**Telstra Corporation Ltd v Phone Directories Co Pty Ltd [2010] – Overruled Desktop Marketing – Are White Pages covered by CR in light of IceTV?**

**Facts:**

- Telstra published 2 kinds of telephone directory listing names, addresses, telephone numbers of residential or business customers for a particular geographic area.
- Numerous individuals contributed to each phone directory which was managed by a database (Genesis Computer System).
- 3 production process for directories
  - Collection phase: maintenance, updating and editing of a database containing customer details done by employees
  - Book Extract phase: extraction from database containing customer details
  - Book production phase: typesetting of that form and physical production of the directories followed by checking and editing by employees



**Issue:** Claim was not to copyright in database but the final published directories.

**Held:**

- Although the **information in the directories were collected** through process which involved human industry, the **creation of the material form of the directories were carried out by the database (computer) overseen by persons who had no substantive input into those forms.**
  - The **efforts required by the author must be efforts which result in the material form of the work.**

- The Court emphasised that it was the **extraction phase work that constituted the relevant effort for the purposes of originality.**
- The important creative preparatory step of fashioning the ideas on which a literary work's ultimate form rests are not actions which counts as authorial because copyright protects the form of a work and not ideas which prefigure it
- Hence, here, the **collection phase not relevant to assessment.**
- **Computers and authors?**
  - Act states that compilations are literary works, hence those **who reduce a compilation to material form are likely to be its authors** provided there is **sufficient intellectual or literary effort involved in the process of reduction.**
  - Directories **first took on material form** when computer file generated containing the full listing for directories in **Extraction Phase**. If **this was done by human, the directories were original works**. However, this was **largely automated** with only minor aspects of checking (but even checking were largely automated).
  - The **humans were not using the software as a novelist using work processor to give form to an idea already conceived**. Instead, there were **giving instructions at the very highest level** about **principal parameters of the directories**, i.e. year and location to which each related. **They did not conceive the material form of the directories**. In fact, it did not need to as the Book Extract routine was designed to relive humans of that task.
    - None of the individuals who contributed to production of the directories had any conception of the actual form in which they were finally expressed.
    - The fact that there are rules – stop creativity and selection
    - When computer is telling you what you need to do there is very little human intellectual effort
    - The expression is completely governed by rules of computer system and not determined by any of the people who contributed labour
  - **Although intellectual effort went into the operation of the software, the effort was not directed to the incarnation of the material form of the directories.**
    - The software itself however is protect under CR
- **Requirement:** so long as the person **controlling the program can be seen as directing or fashioning the material form of the work** (controlling the nature of the material form produced by it and contribute sufficient independent intellectual effort of a literary nature).
  - Here, they did not guide the creation of the material form of the directories. Hence, no author and copyright cannot subsist.

#### Principle:

- To be original, a work must:
  - 1. Not be copied;
  - 2. Originate from a human author; and
    - It is not necessary to identify by name each and every author of a work. Rather, it must be demonstrated that the work originated from a *human* author or authors.
  - 3. Be the result of independent intellectual effort.
    - Importantly, the author's independent intellectual effort must be directed to reducing the work to its ultimate or 'material form'.

## 2. The Requirement of Material Form

- Not a demanding requirement
- Part III: Copyright subsists in a work from the time it is 'made' (for unpublished works: s32(1)) or 'published' (for published works: s32(2) and 29)
  - A literary, dramatic, musical or artistic work is made when the work was first reduced to writing or to some other material form; s 22(1)
  - A dramatic or musical work that exists in the form of sounds embodied in an article or thing shall be deemed to have been reduced to a material form and to have been so reduced at the time when those sounds were embodied in that article or thing; s22(2)
  - Historically: has been said that reduction to material form need not be done by the author
- s10 (1) defines 'material form': any form of storage, whether visible or not. Includes fixation in computer memory, whether permanent or temporary.
- Subsequent destruction is irrelevant: copyright can subsist in a sand sculpture or ice sculpture
- Part IV: Examples – copyright subsists in...
  - Sound recordings that have been made (s 89(1) – (2) and 22(3) – (3C)) or published (s 89 (3) and 29)
  - Cinematograph films that have been made (s 90(1) – (2) and 22(4)) or published (s 90(2) and 29)
  - TV and sound broadcasts made from a place in Australia (s91 and 22(5))

### 3. Territorial Connection Factors/Qualification

#### a. Australian Subject Matter

- **Part III:** Subject matter 'works' – Copyright subsists in Australia in one of 3 scenarios:
  - 1. **If work unpublished** – author must be a qualified person at the time the work was made; s32(1), (4) OR
  - 2. **If work is published**, then the work needs to be first published in Australia or the author must have been a qualified person at the time the work was first published or, if author died before that time, was a qualified person at the time of his or her death; s32(2), (4) OR
  - 3. If the work is a **building or an artistic work** attached to a building, the building must be situated in Australia; s32(3)
- **Part IV:** Subject matter other than works (ss 89 -92, as interpreted in accordance with s 22 and 29)
  - **For sound recordings (s89), and cinematograph films (s90):** either maker/publisher be a qualified person, or the subject matter be made in Australia or first published in Australia
  - **For broadcasts (s91):** those made by qualified broadcasters (public broadcasters and holders of commercial broadcasting licenses) are protected
  - **Published editions (s92):** first publication must take place in Australia or the publisher must be a qualified person
- s84: **qualified person** = an Australian citizen or a person resident in Australia
- **Publication: s29**
  - (1)(a) a work, or an edition of such a work, if reproductions of the work or edition have been supplied (whether by sale or otherwise) to the public;
    - **"work"** means a literary work, a dramatic work, a musical work, an artistic work or a cinematograph film; s189
  - (1)(b) **film** – if copies of the film have been sold, let on hire, or offered or exposed for sale or hire, to the public;
  - (1)(c) sound recording – if records embodying the recording have been supplied (whether by sale or otherwise) to the public.
  - (3) performance of work, exhibition of artistic work, construction of building/model of building, supplying photos and engravings of building/model of building/sculpture does not constitute publication
  - (6) unauthorised publication does not count

#### b. Foreign Subject Matter

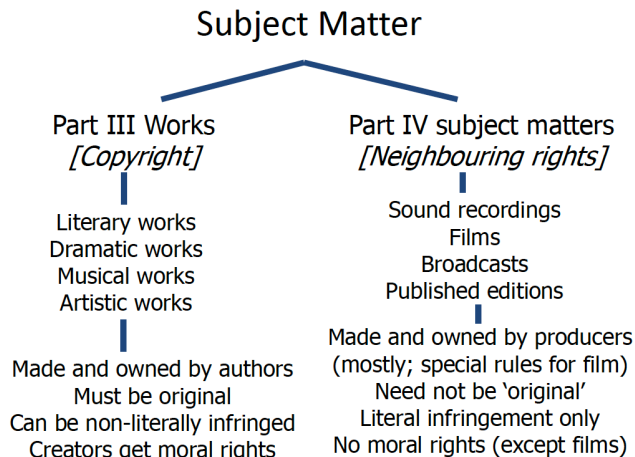
- Under the principle of 'national treatment' in treaties, copyright of foreign nationals is protected in Australia.
- Copyright (International Protection) Regulations 1969 (Cth), Reg 4: extends protection for a Berne Convention country, a Universal Copyright Convention country, a Rome Convention country, a WCT country, a WPPT country, or a WTO country, to:
  - works or other subject-matter made or first published in such a country;
  - an artistic work that is a building, or is attached to or forms part of building, situated in such a country;
  - a person who is a citizen, national or resident of such a country;
  - a body corporate incorporated under the law of such a country;
  - a sound or television broadcast made from a place in a Rome Convention country after 1 January 1992
  - by a "relevant broadcaster"
  - a live performance incorporated in a sound recording and having a connection with a WPPT country;
  - an Australian retransmission of US television broadcasts; and
  - encoded broadcasts made from the USA.

### 4. Duration

- Works (other than artistic works) that have not been made public (by publication, performance, broadcast, recording) and unpublished films and sound recordings remain in copyright indefinitely (s33(3), (5) for works, s93 for sound recordings and s94 for films)
- **See Table**
- Works **made after 1 Jan 2019:** Copyright Amendment (Disability Access and other measures) Act 2017
  - Pt III works: Life + 70 yrs
  - Pt IV subject matter other than broadcasts, published editions: 70 yrs from being made public
  - Broadcasts: 50 yrs from broadcast
  - Published editions: 25 yrs from publication
- **Note: transitional provisions:**

- General rule is that term extensions are granted to works still in copyright when the extension is granted.
- Thus, works in copyright on 1 Jan 2005 got an extra 20 yrs
- In case of reduction in term under 2017 Act, owners of copyright get until 1 Jan 2019 to take advantage of old terms
  - Works of dead authors, presently unpublished, get:
    - 70 yrs post publication if published before 1 Jan 2019
    - 70 yrs post mortem if published thereafter.

## TOPIC 4 – SUBJECT MATTER



### 1. Part III Works

- s10 (1) of the Copyright Act provides that 'work' means a literary, dramatic, musical or artistic work.
  - a. **Literary Works**
- **s10(1) literary work includes:**
  - a table, or compilation, expressed in words, figures or symbols; and
  - a computer program or compilation of computer programs
- **Literary works include:**
  - Novels, essays and works of non-fiction
  - Low standard of originality, hence – instructional manuals, short emails, advertising copy, university examination papers and technical documentation
- **Court definition:** something that is '**expressed in print or writing, irrespective of the question whether the quality or style is high** (*University of London Press Ltd v University Tutorial Press Ltd [1916]*) or '**something which was intended to afford either information and instruction or pleasure in the form of literary enjoyment**' (*Hollinrake v Truswell [1894]*)
- Copyright does not normally subsist in titles and names.
- Generally, titles and single words are better protected through trade mark law and passing off than copyright.

### ***Exxon Corp v Exxon Insurance Consultants International Ltd [1982] – Precedent case***

#### **Facts:**

- The plaintiffs claimed copyright in an invented word 'Exxon' as an original literary work entitled to copyright protection. The word was invented after research and testing to find a suitable word over a period of more than one year

**Issue:** Can the invented word Exxon amount to an original literary work under the Copyright Act 1956 (UK)?

**Held:** No copyright subsists

- The word Exxon is **original because it is the product of labour, skill and expertise**. It is a literary subject matter, being comprised of writing in letters of the alphabet.
- However, it is **not an original literary work, because it lacks the necessary coherency of a work**. It does not have meaning besides its use as a TM
- 'Work' imports **some requirement of coherency** that is not satisfied by a single word
  - The word work means a composition, which entails some coherency in the work considered as a whole
  - **An original literary work must afford:**
    - (i) information;
    - (ii) instruction; OR
    - (iii) pleasure in the form of literary enjoyment
- The word Exxon fails to provide information, or instruction, or literary enjoyment. Hence, it is not a work