

## **COPYRIGHT AND DESIGNS**

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## THE QUALIFICATION REQUIREMENT

Connecting factors:

- Personal criterion: based on nationality or residence of alleged author or maker ('qualified person')
  - Subject matter made anywhere in the world by Australian citizens or residents is protected in Australia by the Copyright Act
    - **Copyright Act s 10(1)**: Australia is defined as including the external territories
    - **Aust Citizenship Act 2007 (Cth) s 4**: Australian citizenship may be acquired by birth, adoption, descent or conferral (naturalisation)
    - **Aust Citizenship Act 2007 (Cth) s 3**: Person resident in Australia will be deemed to be ordinarily resident if the person has his or her home in Australia, or Australia is country of his or her permanent abode notwithstanding the person is temporarily absent from it
    - A person isn't deemed to be resident if he or she resides in Australia for a special or temporary purpose only
    - **Copyright Act s 11**: were a person who is ordinarily resident in a country is temporarily absent from that country, he or she is to be treated as if he or she had been resident there at that time
  - If there is a personal connecting factor, it doesn't matter where the work or subject matter was published or made
- Territorial criterion: based on place of first publication or making of the work or subject matter
  - The essential requirement is that the work or subject matter was first published or made in Australia
  - For subject matter made by citizens or residents of a Berne convention country, or first published there, the Copyright Act applies (by virtue of the Regulations) as if the subject matter were made or first published in Australia
  - The personal status of the performer, maker or author is irrelevant

Works:

- Published works:
  - **Copyright Act ss 32(2)(d),(e)**: personal connecting factor if the author was a qualified person at time the work was first published or, if the author has died before publication, where he or she was a qualified person immediately before his or her death
  - **Copyright Act s 32(2)(c)**: territorial connecting factor if the first publication of the work took place in Australia
- Unpublished works:
  - **Copyright Act 32(1)**: personal connecting factor if the author was a qualified person at time when the work was made or, where the making of the work extended over a period, was a qualified person for substantial part of that period
- A qualified person in the context of works:
  - **Copyright Act 32(4)**: a qualified person is an Australian citizen or a person resident in Australia

Other subject matter

- Sound recordings (unpublished and published):
  - **Copyright Act s 89**: where the maker was a qualified person at the time the sound recording was made, the recording was made in Australia, or the first publication of a published sound recording took place in Australia
- Cinematograph films:
  - **Copyright Act s 90**: where the maker was a qualified person at the time (or substantial part of the period during which) the film was made, the film was made in Australia, or the first publication of a published film took place in Australia
- Broadcasts:
  - **Copyright Act 91**: Copyright subsists in a television broadcast or sound broadcast made from a place in Australia under the authority of a licence or a class licence under the Broadcasting Services Act or by the Australian Broadcasting Corporation or the Special Broadcasting Service Corporation
- Published editions:
  - **Copyright Act s 92**: Copyright subsists in a published edition of a literary, dramatic, musical or artistic work, or of 2 or more literary, dramatic, musical or artistic works, where the first publication of the edition took place in Australia, or the publisher of the edition was a qualified person at the date of the first publication of the edition
- A qualified person in the context of other subject matter:
  - **Copyright Act s 84**: an Australian citizen or a person (other than a body corporate) resident in Australia, or a body corporate incorporated under a law of the Commonwealth or of a State

Special connecting factors

- **Copyright Act s 32(3)**: Buildings situated in Australia and artistic works attached to buildings
- Note there are special connecting factors for works and subject-matter made by, or under the direction and control of, the Crown **Copyright Act ss 176-179**, and certain prescribed international organisations **Copyright Act ss 187-188** (not examinable)
- Special rights for performances **ss 248A(1), 248G(1)** (not examinable)
- Protection is given to performances under Part XIA – isn't a full copyright, but it has a number of features in common with the protection accorded to works and other subject matter, particularly with respect to the connection factors required for protection

## Publication

- Place of publication is a connecting factor for subsistence of copyright, but is also important in determining duration of protection **Copyright Act s 33** and whether there has been infringement (because the right to publish is one of the exclusive rights in works) **Copyright Act ss 31(1)(a)(ii), (b)(ii)**
- Note FIRST publication only
- **Copyright Act s 29(1)**: What constitutes publication (derived from Art 3(3)-(4) Berne)
  - (1)(a): works and editions of works; per (2), substantial per (s 14) doesn't apply
    - Reproductions of the work have been supplied (whether by sale or otherwise) to the public
  - (1)(b): films (more limited) – a film isn't published where copies of it are sold, let or hired to cinema-owners, even if the films are then exhibited in public (because cinema-owners aren't the public)
  - (1)(c): sound recordings
- **Copyright Act s 29(3)**: For the purposes of the Act, the following don't constitute publication of a work:
  - Performance of a literary, dramatic or musical work
  - Supplying (whether by sale or otherwise) to the public of records (recordings) of a literary, dramatic or musical work
  - Exhibition of an artistic work
  - Construction of a building/model of a building
  - Supplying (whether by sale or otherwise) to the public of photographs or engravings of a building, of a model of a building or of a sculpture
- Unauthorised publication see **Copyright Act s 29(6)**
- First publication see **Copyright Act s 29(5)**
  - Under this provision, a publication in Australia or any other country isn't to be treated as being other than the first publication if an earlier publication elsewhere has taken place within a period of not more than 30 days
  - If the first publication is outside Australia in a country that is not party to a relevant convention, the rights holder can still gain protection if they publish in Australia or another convention country within 30 days
  - This 30 day grace period for first publication derives from Art 3(4) Berne
  - Eg a work published in France on 11/11/11 and then published on 28/11/11 in Australia will be treated as having been first published in Australia

## Supply to the public:

- Defined as exposure for sale even if there is no sale, invitation to the public to acquire copies (whether for money or free), passive availability without active offering
- A gratuitous supply or distribution will be sufficient to constitute a publication of the work or edition
- Even though the public may be very small (ie one or two people) it must not be limited in any way
- The distribution of supply of reproductions and copies etc mustn't be restricted to particular groups of persons – the copyright owner must be prepared to supply to anyone **Bodley Head v Flegon, Oscar Trade Mark**
- **Copyright Act s 29(4)**: A publication that is merely colourable and is not intended to satisfy the reasonable requirements of the public shall be disregarded
- What is colourable will be a question of fact on the circumstances or each case **Francis, Day, Hunter v Feldman**

### **Bodley Head v Flegon**

- Concerned a novel by Solzhenitsyn that was banned in Soviet Russia because it was politically sensitive, smuggled out and first published in France
- Defendant alleged that there was prior publication in Russia by circulation of clandestine (underground) duplicated typescript versions
- The underground (clandestine) circulation didn't amount to publication of the work in Russia, even though it was quite widely disseminated
- It could hardly be regarded as an effort to satisfy the reasonable requirements of the public, particularly where it was unlawful for potential readers to voice their requirements or for the author to satisfy them (ie s 29(4) would probably exclude limited clandestine circulation)

### **Oscar Trade Mark**

- Publication of the plaintiff's work (the Oscar statuette) hadn't taken place
- This was despite the fact approximately 1300 copies of it had been awarded to Oscar winners over the preceding 50 years

### **Francis, Day, Hunter v Feldman**

- Plaintiffs (music publishers) received 12 copies of a song from the NY Broadway Corporation, with instructions to copyright it in the UK on a certain day
- On that day, the plaintiffs sent one copy of the song to the clerk at the Copyright Receipt Office at the British Museum, filed one copy in their office for reference, and exposed 6 copies for sale in an open box marked 'new works issued this day' in the retail department of their London premises
- The next day, they send the remaining 4 copies of the song to an agent for receiving copies for university library
- The song slowly became more successful, and plaintiffs secured the UK copyright and requested 20 more copies from the US
- Then a UK edition of 750 copies of the song was printed and then over 250,000 copies of the song were sold
- Plaintiffs alleged the defendants had infringed their copyright through the printing and publication of a reply song
- Defendants argued the plaintiffs didn't own the copyright in the original song, as it hadn't been first published in the UK (as was

<ul style="list-style-type: none"> <li>required under the Act at the time)</li> <li>• Whether or not the publication of the song was a genuine publication</li> </ul>
<ul style="list-style-type: none"> <li>• Colourable means a case where there is no intention to satisfy the reasonable requirements of the public</li> <li>• Here is could not be said to be colourable</li> <li>• The demand anticipated was insignificant and the supply secured to satisfy the demand was also insignificant (12 copies were all that were sent at the time of publication)</li> <li>• It wasn't until some time afterwards that further copies were applied for and sent from the US</li> <li>• However the intention from the start was to satisfy the public demand in the UK – that is what the publication in England was for (ie the intention of the NY Broadway Corporation was for it to be published)</li> <li>• Therefore there was good and genuine publication in the UK</li> <li>• If the anticipated public demand is small, it is sufficient to get in a small quantity of stock and still be viewed as satisfying the public demand</li> </ul>

### Works and subject matter of foreign origin

- Most of the works and subject matter that are available in Australia are of foreign origin
- Foreign works gain copyright protection under Australian law as a consequence of Australia's membership to international copyright conventions, primarily Berne (which also provides that other member states must afford Australian works equal copyright protection under their own laws)
- Australia gives effect to its obligations through the Copyright (International Protection) Regulations 1969 (Cth) (as amended)
- Foreign works, subject matter and performances which satisfy the connecting factors stipulated in the Regulations are treated in all respects as Australian works, subject matter and performances
- It isn't reciprocal, although there is a rough approximation in the level of protection granted in each country
- The protection granted is akin to national treatment ie works claiming copyright under Berne are assimilated to, or accorded the same protection as, the works of nationals, plus those rights specifically granted by Berne (art 5(1))
  - Works don't need registration or any formality Art 5(2)) (note registration remains mandatory in the US)
- Remember the legal mechanism for copyright protection is the Copyright Act, as applied by the Copyright (International Protection) Regulations 1969 (Cth)
- The Berne Convention (like other of Australia's international conventions) itself has no force of law in Australia unless or until implemented by Australian legislation

### Legislative provisions

- **Copyright Act s 184:** Application of Act to countries other than Australia
- **Copyright Act s 185:** Denial of copyright to citizens of countries not giving adequate protection to Australian works
- **Copyright (International Protection) Regulations, Reg 4:** Protection – application of the Act (other than Part XIA) to specified foreign countries
  - Extends copyright protection to works and subject matter whose authors or makers are citizens or residents of other Berne countries, or which were first published in other Berne countries, in the same way as the Act would apply to works and subject matter made and first published in Australia by Australian citizens or resident
  - Extends copyright protection not only to Berne countries but to members of other copyright conventions eg members of Rome, Universal Copyright Convention, TRIPS (ie WTO), WIPO Copyright Treaty, WIPO Performances and Phonograms Treaty
- The regulations also extend the protection of the Copyright Act to other subject matter not covered by Berne that emanates from nominated countries (eg sound recordings) which are subject to different international obligations
  - **Copyright (International Protection) Regulations, Reg 5:** Copyright not to subsist in overseas editions in certain cases (published editions)
  - **Copyright (International Protection) Regulations, Reg 6:** Copyright in certain sound recordings may include right to cause the recording to be heard in public
  - **Copyright (International Protection) Regulations, Reg 7:** Copyright in certain sound recordings may include right to broadcast the recording
- Foreign performances also receive protection:
  - **Copyright (International Protection) Regulations, Reg 8:** Protection – application of Part XIA of Act to specified foreign countries

## “MAKING” AND THE MATERIAL FORM REQUIREMENT

- Strictly only needed for works, not for other subject matter
- Where a claimant is relying upon the personal connecting factors, the possession of ‘qualified person’ status must coincide with the making of the work or subject matter (**Copyright Act ss 32(1), 89(1), 90(1)**)
- Where there is reliance upon the territorial connecting factor of first publication, publication requires the supply of reproductions, copies or records, as this in turn implied that the work or subject matter has been made
- It is clear that works and other subject matter cannot exist simply in the author’s mind if they are to receive protection
- It is the act of reducing the work to material form that constitutes the making of the work and thereby gives rise to a protectable subject matter
- It is the person who carried out this process of reduction who is to be regarded as the author or maker of the work or subject matter (refer to the idea/expression dichotomy, *Donoghue v Allied Newspapers*)
- As copyright only protects expression, a person who supplied only ideas or facts won’t be regarded as the author if they don’t also supply the material form in which those ideas or facts are expressed
- Note an exception may arise where the person who reduced the work to material form does so as the amanuensis of another person

### The making of works

- **Copyright Act s 32:**
  - Personal connecting factor is satisfied if ‘qualified person’ at time when work ‘made’, or if ‘qualified person’ at time work first published
  - Publication under Copyright Act s 29 (supply of reproductions to the public) implies work ‘made’
  - Territorial connecting factor is satisfied if first publication in Australia
- **Copyright Act s 22:** under the Act, the making of a work or subject matter requires reduction into some kind of physical or tangible form
  - **Copyright Act s 22(1):** A reference in this Act to the time when a Part III work was made shall be read as a reference to the time when the work was first reduced to writing or to some other material form
  - **Copyright Act s 22(2):** For sounds embodied re Part III works
  - **Copyright Act s 10(1):** “Writing” means a mode of representing or reproducing words, figures or symbols in a visible form and ‘written’ has a corresponding meaning
    - Requires some kind of visible notation of representation (cf material form)
  - **Copyright Act s 10(1):** “Material form”, in relation to a work or an adaptation of a work, includes any form (whether visible or not) of storage of the work or adaptation, or a substantial part of the work or adaptation, (whether or not the work or adaptation, or a substantial part of the work or adaptation, can be reproduced)
    - This definition intends to cover works stored in a computer (hence that ‘any form (whether visible or not) of storage’)
    - *Roland Corporation v Lorenzo & Sons (1991)*: Certain instruction manuals were made at the time they were recorded on the disk of a word processor
    - Prior to 2004, it was necessary that the work could be reproduced, but this was changed in consequence of the Australia/US Free Trade Agreement amendments (requirement for reproduction was deleted)
    - *Kabushiki Kaisha Sony Computer Entertainment v Stevens (2003)*: Storage in RAM wasn’t in material form because it couldn’t be reproduced from there)
    - Thus an electronic document in “read-only” form would after 2004 be in “material form”
  - **Copyright Act s 10(1):** embodied
- The exclusive reproduction right is confined to the reproducing of a work in a material form **Copyright Act s 31(1)**

### The making of other subject matter (and the de facto material form requirement)

- The meaning of “made” and “published” in the context of films, sound recordings and published editions creates an implied fixation requirement (due to the nature of those formats)
- They need some material form, be it in a record in the case of a sound recording, or any article or thing in which its images or sounds are embodied in the case of a film
- The other way in which your connecting factor can be made out for sound recordings and films is where they have been published
- Unless the copies or records are supplied, publication doesn’t occur, and since copies and records embody the work in material form, this means there is a de facto fixation requirement

### Sound recordings

- **Copyright Act s 22(3):** a sound recording, other than a sound recording of a live performance, shall be deemed to have been made at the time when the first record embodying the recording was produced, and the maker of the sound recording is the person who owned that record at that time
- **Copyright Act s 22(3A):** The makers of a sound recording of a live performance are the person or persons who, at the time of the recording, own the record on which the recording is made, and the performer or performers who performed in the performance
  - **Copyright Act s 10(1):** a record is a disc, tape, paper, electronic file or other device in which sounds are embodied (ie there must be some tangible form)
- **Copyright Act s 22(3B)-(3C):** Sound recordings of live performances under employment
- **Copyright Act s 22(7):** Definition of ‘live performance’ and ‘performer’

#### Cinematograph films

- **Copyright Act s 22(4)**: a reference to the making of a cinematograph film shall be read as a reference to the doing of the things necessary for the production of the first copy of the film, and the maker of the cinematograph film is the person by whom the arrangements necessary for the making of the film were undertaken
  - **Copyright Act s 10(1)**: a copy, in relation to a film, means any article or thing in which the visual images or sounds comprising the film are embodied (ie there must be some tangible form)

#### Published editions

- A connecting factor will be satisfied upon publication, and **Copyright Act s 29(1)** tells us that publication occurs where reproductions of the edition have been supplied to the public
- If the published edition has no material form, there's nothing to be supplied, therefore there can be no copyright without fixation
- **Copyright Act s 92**: Published editions of works in which copyright subsists

#### Broadcasts

- There is no requirement that broadcasts be fixed in material form
- **Copyright Act s 91**: Television broadcasts and sound broadcasts in which copyright subsists
- **Copyright Act s 22(5)-(6A)**: Broadcasts and other communications

## TOPIC THREE: DURATION OF COPYRIGHT

### Part III works: (see publication p 38)

- Prior to 2005, copyright generally lasted the life of the author plus 50 years (of some defined event eg publication for other subject matter)
  - This was the basic term of protection under Australia's international obligations (Berne Art 7)
- In 2004, these periods were extended to a general term of life plus 70 years, or 70 years, as a result of the AUSFTA amendments
  - Any copyright that had expired at that date has not revived
  - Brings our law into alignment with the US and EU
- Prior to 2019, the Act provided that for works that were unpublished at the time of the authors death (other than computer programs and artistic works except for engravings), the term of copyright continued for 70 years from the date of first publication
- Amendments commencing from 1 January 19 have aligned all copyright in works with known authors to be the life of the author plus 70 years
- The term applies from the year after calendar year in which the work was first made public or author died
- Unknown author: the identity of the author is not generally known at any time before the end of 70 years after the calendar year in which the work was made
- **Copyright Act s 80:** For works of joint authorship, where term depends on life of author, it is the author who died last
- **Copyright Act s 180:** Different copyright terms apply to government copyright material – term of year made plus 50 years (for both Part III and Part IV)

Type of material	When made public	First made public pre 1/1/19 <b>Copyright Act s 33(2)</b>	First made public post 1/1/19, or never made public <b>Copyright Act s 33(3)</b>
Literary works (other than computer programs), dramatic works, musical works, engravings (known author)	Before death of author	Life of author + 70 years	Life of author + 70 years
	After author's death	Year work made public + 70 years	
	Never	Life of author + 70 years	
Computer programs, artistic works (other than engravings) (known author)		Life of author + 70 years	
Part III work with unknown author	Made public within 50 years of being made	Year first made public + 70 years	Year first made public + 70 years
	Not made public within 50 years of being made		Year work made + 70 years

### Part IV works

Type of material	When made public	First made public pre 1/1/19	First made public post 1/1/19
Sound recording and cinematograph film	At any time	Year first made public + 70 years <b>Copyright Act s 93(2)</b>	
	Never	Indefinite	
	Not made public within 50 years of being made, or never made public		Year material made + 70 years <b>Copyright Act s 93(3)</b>
	Made public within 50 years of being made		Year first made public + 70 years <b>Copyright Act s 93(3)</b>
Television and sound broadcasts	At any time	Year broadcast made + 50 years <b>Copyright Act s 95(1)</b>	
Television and sound broadcasts that are repetitions of previous television and sound broadcasts	Made within 50 years of previous broadcast being made	Year previous broadcast made + 50 years <b>Copyright Act s 95(2)(a)</b>	
	Not made within 50 years of previous broadcast being made	No copyright <b>Copyright Act s 95(2)(b)</b>	
Published editions	At any time	Year edition first published + 25 years <b>Copyright Act s 96</b>	

### Productivity Commission Report (September 2016)

- Current copyright duration is excessive – commercial life of most copyright material is 5 years
- Around 25 years should be enough to provide incentive for cultural production without imposing onerous costs on consumers
- Commented on orphaned works, which the government has taken some steps to address