

LAWS3021: FOUNDATIONS OF IP

Table of Contents

COPYRIGHT	3
1 SUBSISTENCE: DOES COPYRIGHT ARISE IN THIS SITUATION?	3
1.1 Works	3
1.2 Subject Matter Other than Works	7
1.3 Criteria for Copyright Protection	8
1.4 Author's Eligibility to Hold Copyright	10
2 RIGHTS	13
3 INFRINGEMENT: HAS COPYRIGHT IN THE WORK BEEN INFRINGED?	13
3.1 Direct Infringement	13
3.2 Indirect Infringement	17
4 EXCEPTIONS: IS THERE AN EXCEPTION OR DEFENCE TO THIS INFRINGEMENT?	19
4.1 Fair Dealing	19
4.2 Performed Under Licence	21
4.3 Permitted Under the Act	22
4.4 In the Public Interest or Against Public Policy?	22
MORAL RIGHTS	23
1 INTRODUCTION	23
1.1 Origins and Rationale	23
1.2 Definitions	23
1.3 Duration and Exercise	24
2 RIGHT OF ATTRIBUTION	24
2.1 Right of Attribution	24
2.2 Identification of the Author	25
2.3 Infringement	25
3 RIGHT NOT TO BE FALSELY ATTRIBUTED	25
3.1 Right not to be Falsely Attributed	25
3.2 Infringement	26
4 RIGHT OF INTEGRITY	26
4.1 Right of Integrity	27
4.2 Infringement	27
5 DEFENCES	28
5.1 Defence of "Reasonableness"	28
5.2 Consent	28
5.3 Remedies	29
BREACH OF CONFIDENCE	30
1 INTRODUCTION	30
1.1 Breach of Confidence Relationship with IP Rights & Privacy	30
2 ELEMENTS	30
2.1 Information Must Have the Necessary Quality of Confidence	30
2.2 Obligation of Confidence	31
2.3 Authorisation	33
2.4 Damage	33
2.5 Defences	34

S 18 ACL: MISLEADING AND DECEPTIVE CONDUCT	35
1 PROVISIONS.....	35
2 ELEMENTS	35
3 RELATIONSHIP WITH PASSING OFF	36
PASSING OFF.....	37
1 INTRODUCTION: UNREGISTERED TRADEMARKS	37
2 ELEMENTS	37
2.1 <i>Goodwill</i>	38
2.2 <i>Misrepresentation</i>	42
2.3 <i>Damage</i>	44
TRADEMARKS	46
1 REGISTRATION:	46
1.1 <i>Registration Process</i>	47
1.2 <i>Trademark MUST Fall into One of These Categories: s 41</i>	48
1.3 <i>Absolute Grounds for Refusal of Registration (Registration MUST be Refused)</i>	52
1.4 <i>Relative Grounds for Refusal of Registration</i>	54
2 GROUNDS FOR OPPOSITION	56
2.1 <i>Grounds</i>	56
3 GROUNDS FOR REVOCATION.....	57
3.1 <i>Removal for Non-Use</i>	57
4 INFRINGEMENT	57
4.1 <i>Use in Australia</i>	57
4.2 <i>Substantial Identity/Deceptive Similarity</i>	58
4.3 <i>Dilution: s 120(3)</i>	58
5 DEFENCES	58
5.1 <i>Available Defences</i>	58
DESIGNS.....	60
1 REGISTRATION: IS IT A REGISTRABLE DESIGN?	60
1.1 <i>Formalities Check</i>	60
1.2 <i>Examination (if requested):</i>	61
1.3 <i>Ownership of Designs</i>	63
2 INFRINGEMENT: ONLY IF CERTIFIED	63
3 DEFENCES	64
3.1 <i>Licence or Authority</i>	64
3.2 <i>Certain Repairs Do NOT Infringe Registered Design</i>	64
4 COPYRIGHT LAW AND DESIGN PROTECTION.....	64
REMEDIES	66

COPYRIGHT

KEY LEGISLATION: Copyright Act 1968 (Cth)

1 Subsistence: Does Copyright Arise in this Situation?

Basic Presumptions: Copyright Act 1968 s 126

- Copyright is **presumed to subsist** if the respondent does not put the question of subsistence of copyright in issue
- Where **subsistence is established**—the plaintiff shall be **presumed to be the owner** of the copyright if he/she claims to be the owner and the respondent does not put the question of ownership in issue
- **Presumptions are rebuttable** but provide a starting point to copyright litigation

IceTV v Nine Network (2009): Key High Court Case

- Consider both the **quantity and quality** of the information copied—e.g. time and title information deemed not to be substantial part of the work
- Distinction between the **skill and labour** that went into the creation of the compilation—copyright only protects skill and labour so far as it is **directed towards the expression of the work**
 - Nine's claim was not original enough—has to be more than compiling things → **originality**
- Post IceTV:
 - Greater focus on **identifying the author** and less reliance on presumptions
 - May need to identify all joint authors not just one of them
 - Authors need to be **human** (databases are not protected)

1.1 Works

1. Is it a work?

- Literary**: all works expressed in print or writing including a table, compilation, computer program, preparatory design material for a computer program or database
- Dramatic**: a work of action that is capable of being performed
- Musical**: a work consisting of music excluding words/action intended to be sung, spoken or performed with the music
- Artistic**: graphic work, painting, engraving, photograph, sculpture, collage, irrespective of artistic quality, work of architecture, work of artistic craftsmanship which requires artistic quality

2. Is it recorded in material form?

3. Is it original? (Not a copy and with sufficient skill, labour and judgement used in its creation)

4. Is it substantial enough to merit copyright protection? (Not name or title—de minimus)

1.1.1 Literary

“Literary work” defined in s 10(1) → non-exhaustive definition (a) a table or compilation expressed in words, figures or symbols and (b) a computer program or compilation of computer programs	
General	<ul style="list-style-type: none">• A literary work is one which is intended to afford either information and instruction, or pleasure, in the form of literary enjoyment: <u>Hollinrake v Truswell (1894)</u>• Literary works covers things expressed in print or writing, irrespective of whether the quality or style is high: <u>University of London Press v University Tutorial Press (1916)</u>• Literary merit is not required and exam papers, accounting forms qualify as literary works because they convey meaning (information, instruction or literary enjoyment) or are the result of an exercise of knowledge, judgment, labour or skill: <u>University of London Press v University Tutorial Press (1916)</u>

	<ul style="list-style-type: none"> • <u>Express Newspaper v Liverpool Daily Post (1985)</u> and <u>Ladbroke v William Hill (1964)</u> <ul style="list-style-type: none"> ◦ Referred to as the “Betting Cases” where literary work found as the result of exercise of knowledge, judgment, labour or skill. ◦ IMPORTANCE REDUCED POST ICETV
Literary vs artistic works	<ul style="list-style-type: none"> • Designs that incorporated words and numbers but did not have semiotic meaning (not read as text) were artistic not literary works • Visual look and feel goes to designs: <u>Elwood Clothing v Cotton On (2008)</u>
‘De minimus’ Single words, titles and phrases	<p>Material that is considered too insubstantial to qualify as “literary works” → de minimus</p> <ul style="list-style-type: none"> • “EXXON” is not a literary work—made up work but a single word or title cannot be a literary work because it has no meaning in itself; function of literary work is to afford pleasure, instruction or information in the form of literary enjoyment: <u>Exxon Corp v Exxon Insurance Consultants (1982)</u> <ul style="list-style-type: none"> ◦ To avoid a monopoly over the English language, you can trademark but not copyright single words • Single words, names and titles are not likely to be protected by copyright law: <u>Francis Day & Hunter v Twentieth Century Fox (1940)</u> • <u>State of Victoria v Pacific Technologies (2009)</u>: use of “Help-Help-Driver-in-danger-Call Police-000” <ul style="list-style-type: none"> ◦ Victoria argued that there was no subsistence as it was too trivial, ordinary, insubstantial and commonplace to constitute “written work” ◦ Held: the phrase only stated an idea and was the setting down of simple words as instruction—did no more than state the obvious words for drawing attention to taxi driver; should not be awarded monopoly protection • <u>Fairfax Media v Reed International (‘Headlines Case’) (2010)</u>: Fairfax claimed that headlines of newspaper articles were infringed by Reed providing abstracts to subscribers <ul style="list-style-type: none"> ◦ Held: Fairfax did not own copyright in headlines as they were not sufficiently substantial or original to attract copyright under the de minimus rule
Compilations and tables	<ul style="list-style-type: none"> • <u>Kalamazoo (Australia) v Compact Business Systems (1985)</u>: plaintiff’s accounting forms (not individual forms) were original works and were more than a copy of other material • In the case of a compilation—simple unordered presentation will not be protected unless some greater coherence or order is imposed by the author
Computer programs	<ul style="list-style-type: none"> • Computer program in source code is literary work but the object code (not visible and not intended to convey meaning) was not a literary work: <u>Computer Edge v Apple Computer (1986)</u> • “Computer program” is defined in the Copyright Act 1968 as a set of statements or instructions to be used directly or indirectly in a computer in order to bring about a certain result → TRIPS Art 10(1)—computer programs protected under the <i>Berne Convention</i> • Individual command words are not themselves computer programs because they could not individually be considered to be a set of instructions that would cause the computer to function as intended: <u>Data Access Corporation v Powerflex Services (1999)</u> • AV and caption content of DVD discs are not computer programs: <u>Australian Video Retailers Association v Warner Home Video (2001)</u> • Computer games are literary works: <u>Kabushi Kaisha Sony Computer Entertainment System (2001)</u>

1.1.2 Dramatic

<p>“Dramatic work” defined in s 10(1) → non-exhaustive definition</p> <p>(a) choreographic show or other dumb show</p> <p>(b) a scenario or script for a cinematographic film (but doesn’t include the film as distinct from the script)</p>	
<ul style="list-style-type: none"> • Nine Network Australia v ABC (1999): not clear whether a planned fireworks display would have a sufficiently strict schedule to constitute a dramatic work • Green v Broadcasting Corporation of NZ (1988): a dramatic work must have sufficient unity to be capable of performance <ul style="list-style-type: none"> ◦ Sufficient unity: is the script tight enough to be performed with specific moves as opposed to e.g. the fireworks case → is there requisite specificity? 	
<p>Summary</p> <ul style="list-style-type: none"> • Intended to be performed and includes choreography or screenplay but excludes the film itself • Look for material form—script, video recording, and is it capable of being performed? • Examples: <ul style="list-style-type: none"> ◦ Diving—are they doing anything original or is it all just building blocks of movement? ◦ Football plays—capable of being performed? 	
<p>Performances</p> <ul style="list-style-type: none"> • Performer’s rights (different from copyright) are also covered by the Copyright Act 1968 <ul style="list-style-type: none"> ◦ Performer’s consent is required for the recording or broadcast of a live performance ◦ Exceptions: fair dealing ◦ Performers get limited civil rights to sue for infringement 	

1.1.3 Musical

<p>“Musical works” are not defined in s 10(1)</p>	
<ul style="list-style-type: none"> • Look at the musical work as a whole → don’t isolate insubstantial features and portraying them out of context: Coffey v Warner/Chappel Music (2005) • Look for material form: <ul style="list-style-type: none"> ◦ Sequence of sounds/noises, music notation, sound recording (tape, digital) • Larrikin Music Publishing v EMI Songs Australia (Kookaburra Case) (2010): <ul style="list-style-type: none"> ◦ Held: “Down Under” song reproduced a substantial part of the “Kookaburra song” consisting of 4 bars → differences in key, harmony and structure but still substantially reproduced ◦ The melody was recognizable and sufficient degree of objective similarity to constitute infringement as the “signature” part of the song was reproduced 	

1.1.4 Artistic

<p>“Artistic work” defined in s 10(1) → exhaustive definition</p> <p>(a) a painting, sculpture, drawing, engraving or photograph whether the work is of artistic quality or not;</p> <p>(b) a building or model of a building, whether it is of artistic quality or not; or</p> <p>(c) a work of artistic craftsmanship whether or not mentioned in paragraphs (a)-(b) but does not include circuit layouts</p>	
Drawing or painting	<p>“Drawing” defined in s 10(1) to include diagram, map, chart or plan whilst “painting” is undefined</p> <ul style="list-style-type: none"> • Face painting didn’t constitute a painting: Merchandising Corporation of America v Harpbond (1983) <ul style="list-style-type: none"> ◦ Question of fact whether what is under discussion is a painting (not defined in the act); face-painting doesn’t have the permanence to be a painting • There can be a drawing in the form of a pattern, using shapes, colours and other elements to give pleasure or simply to attract attention to convey a visual impression—“look and feel”: Elwood Clothing v Cotton On (2008)
Sculpture and engraving	<p>“Sculpture” defined in s 10(1) to include a cast or model made for purposes of sculpture</p> <p>“Engraving” defined in s 10(1) to include an etching, lithograph, product of photogravure, woodcut, print or similar work that is not a photograph</p>

- The **necessary quality of confidence** is relative to the situation in which the information exists: Ansell Rubber v Allied Rubber Industries (1967)
- 'Relative secrecy' needs to be maintained: Franchi v Franchi (1967)

2.1.1 Relative Secrecy

- If relative secrecy is maintained—the confidence will be protected
 - If **secrecy is maintained amongst all the people who know about the information**
- Franchi v Franchi (1967): not fatal that other people know the information but a **question of degree in the specific case**.
- Ansell Rubber v Allied Rubber Industries (1967): not fatal to claim that the information is known to others (or even substantial number of others); the information needs to be protected so as to **not enter the public domain through carelessness**
- Factors relevant to determining secrecy in commercial context: Ansell Rubber v Allied Rubber Industries (1967)
 1. Extent to which the information is **known outside of the business**
 2. Extent to which it is **known by employees** and others involved in the business
 3. Extent of **measures taken to guard the secrecy** of the information
 4. **Value of the information** to the business and to competitors
 5. **Amount of effort or money expended** in developing the information
 6. **Ease or difficulty** with which the information could be properly **acquired or duplicated by others**

2.1.2 Springboard Doctrine

- **Recipient of the information cannot misuse it for their own benefit**
- Seager v Copydex (No 1) (1967): recipient of the information must not use it as a “springboard” for other activities which may **give an unfair advantage over or be detrimental to the confider** of the information
- Terrapin v Builders Supply (1967): springboard remains even where all the features have been published or can be ascertained by actual inspection by members of the public. The possessor of such information must be **placed under a special disability in the field of competition** in order to ensure that there is no unfair advantage

2.1.3 Triviality and Precision of Information

- Coco v AN Clark (Engineers) (1969): **protectable information must be more than trivial information**
 - Equity unlikely to intervene unless the circumstances are of sufficient gravity—equity ought not to be invoked merely to **protect trivial information however confidential**
- Seager v Copydex (No 1) (1967): the confidential information must be identified with **sufficient specificity for an order to be fair and practicable**

2.2 Obligation of Confidence

- Any **reasonable man** standing in the shoes of the recipient of the information would have realized that **upon reasonable grounds** the information was being **given to him in confidence**: Coco v AN Clark (Engineers) (1969)
- Consider the circumstances of the communication, particularly in respect to:
 - Information concerning a **personal relationship**: Duchess of Argyll v Duke of Argyll (1965)
 - Information obtained in **the course of an employment relationship**: Ansell Rubber v Allied Rubber Industries (1967)
 - If a 3rd party or stranger is **actively or constructively made aware of its confidential nature**: Schering Chemicals v Falkman (1981)

PASSING OFF

1 Introduction: Unregistered Trademarks

Is this a case where one trader is representing its goods and services as those of another trader?

- **Reddaway v Banham (1896)**: nobody has the right to present his goods as the goods of somebody else. How far the use of particular words, signs, or pictures does or does not come up to the proposition is a **question of evidence**.
 - **Cannot monopolise a descriptive term** such as “camel hair belt” and a **secondary meaning is required**

2 Elements

Lord Diplock's Test in the *Advocaat Case*:

1. A **misrepresentation**
2. By a **trader** in the course of trade
3. To prospective or ultimate **customers**
4. Which is calculated to injure the **business or goodwill of another** and
5. Causes **actual damage** to that other

Restated by Lockhart J in Australia in *ConAgra v McCain*

1. **Goodwill/reputation**
2. **Misrepresentation**
3. **Damage**

IF YES, THEN THERE IS AN ARGUABLE CASE FOR PASSING OFF

Jif Lemons Test (1990) – Reckitt & Coleman v Borden

- An action for passing off requires:
 - **Goodwill/reputation attached to goods and services** supplied in the minds of the purchasing public by association with the identifying get-up under which the plaintiff's particular goods and services are offered to the public (recognized as distinctive and specific to the plaintiff's goods and services)
 - **Misrepresentation by the defendant to the public** (intentional/unintentional) leading or likely to lead the public to believe that the goods and services offered by him are the plaintiff's goods and services
 - **Damage (or likelihood of damage)** by reason of the erroneous belief engendered by the defendant's misrepresentation that its goods and services is the same as the plaintiff's

ConAgra v McCain (1992) – Australia

- Passing off protects a **proprietary right in the goodwill or reputation** of his business likely to be **injured by the defendant's conduct**
- Basis of the cause of action lies in **misrepresentation** where the underlying rationale is to prevent commercial dishonesty
- Passing off protects the plaintiff's assets, goodwill and reputation and stops persons from gaining a commercial advantage through wrongfully taking the attributes of another's business if it causes/likely to cause damage

2.1 Goodwill

Is there goodwill? (The 'attractive form that brings in custom')

1. A **trader**
2. Has **reputation**
3. **Indicia of reputation** include:
 - a. Get-up or shape
 - b. Colour
 - c. Names (made-up, generic or personal)
 - d. Advertising imagery or themes
 - e. Trade dress or styles
4. In the **minds of relevant customers**
5. Somewhere in the **jurisdiction** (not necessarily the whole jurisdiction)

2.1.1 What is Goodwill?

- Goodwill is comprised of **reputation as a trader that draws customers to purchase**
- Goodwill is the **benefit and advantage of the good name, reputation and connections of a business** and is the attractive force that brings in custom: IRC v Muller (1901)
- **Reputation without goodwill will not support an action** for passing off: Anheuser Busch Inc v Budkejevicky Budvar (1994); "Budweiser Beer" case
- Must be shown that the **public is prompted to purchase** due to the source of goodwill: Hodgkinson Corby v Wards Mobility Services (1995)
- Plaintiff must prove that goodwill/reputation attaches to the goods and services it supplies by **association with identifying name or get-up**: Harrods Ltd v Harrodian School (1996)
- If the public was **misled in a relevant way as to a feature or quality of the goods sold**, that was sufficient to found a cause of passing off brought by those with whom the public associated that feature or quality: Mirage Studios v Counter Feat Clothing (1991)
- Goodwill is the **right of property in a business likely to be injured by misrepresentation**: Spalding & Bros v A W Gamage (1915) (this proprietary right in goodwill of business gives trader standing to bring action in passing off)

Reputation as a Trader

- Day v Brownrigg (1878): there might have been harm but there is **no property right in a mere name**—you **need to be a trader** (Ashford lodge case—neighbour named their house the same)
- **Charities can be considered traders**—Church's reputation was essentially indistinguishable from commercial goodwill: A-G v Holy Apostolic Catholic Assyrian Church New Parish Association (1989)

2.1.2 Indicia of Reputation

- **Any marks, names or devices (logos)** of any kind that are used as **ciphers** to teach the public how to get the trader's goods amounts to indicia of goodwill: Powell v Birmingham Vinegar (1897)
- Wide enough to encompass **other descriptive material including slogans or visual images** which can lead market to associate with plaintiff's product. The test is whether the product has derived from the advertising a **distinctive character** which the market recognizes: Cadbury Schweppes v Pub Squash (1980)
- It is the indicia by which an **activity is known rather than the activity itself** that gives rise to goodwill: BBC v Talksport (2001)

TRADEMARKS

KEY LEGISLATION: *Trade Marks Act 1995 (Cth)*

1 Registration:

- **Registered v unregistered marks**
 - **Trademarks may be registered** with “IP Australia” → then you can use the ® sign (criminal offence to use the ® unless you have a registered TM)
 - **Unregistered “marks”** are protected using common law **passing off**
 - **Retrospective protection**—only used once an alleged infringement has occurred

Registration Options

Australian registration	<ul style="list-style-type: none"> • TM registered in Australia with IP Australia—they apply to the whole of Australia (e.g. passing off may protect marks only in a limited geographical area)
Overseas registration	<ul style="list-style-type: none"> • Overseas marks that are well-known in Australia: TRIPS Art16 → TM registered overseas may be protected in Australia as “well-known” marks: s 120(3) • Australian traders can directly apply for registration overseas
Madrid System (International Registration)	<ul style="list-style-type: none"> • TMs can be registered using the “Madrid System” → Australia is a member of the Madrid Protocol (not Agreement) • Madrid System provides benefits including: <ul style="list-style-type: none"> ◦ Extension of protection in designated countries provides the same rights as national registered TM owners ◦ Possibility of adding other countries after international registration gained ◦ Single request for amendments/renewal

Types of Trademarks

Standard	<ul style="list-style-type: none"> • A trademark is a word, phrase, letter, number, sound, smell, shape, logo, picture, aspect of packaging or a combination of these that is used to distinguish the goods and services of one trader from those of another • Goods and services with respect to which trademarks can be registered are classified into “classes” according to the Nice Convention
Collective	<ul style="list-style-type: none"> • Collective marks may be used by members of the association that has registered them to indicate goods and services of the members (and distinguish from other traders) • Examples: industry super fund
Certification	<ul style="list-style-type: none"> • Certification marks distinguish goods and services in respect of quality, accuracy or another characteristic (origin, material or mode of manufacture) • Examples: CPA, Woolmark
Defensive	<ul style="list-style-type: none"> • Registration of trademarks that have acquired a distinctive reputation that could lead to confusion among consumers if they were to be registered by other traders with respect to different classes of goods and services: s 185 • Defensive marks are not vulnerable to removal on the ground of non-use: s 186 • Examples: Coca-Cola, Holden, Bonds, Shell

1.1 Registration Process

- a. Is it a **sign**? **ss 6, 17**
- b. Is it in the **approved form**? **Reg 4.1-4.2**
- c. **Ownership**: **s 27(1)(a)**
- d. Is there use or an **intent to use/assign** the mark? **s 27(1)(b)**
- e. Is there an **adequate graphical representation** of the sign? **s 27(3)(a), s 40**
- f. Are there goods/services **nominated in classes**? **s 27(3)(b), Reg 4.4**

1.1.1 What is a Trademark?

1. Is it a sign?
 - a. **“Trademark”**: a trademark is a **sign used or intended to be used to distinguish goods** and services dealt with or provided in the course of trade by a person **from goods and services dealt with or provided by any other person**: **s 17**
 - b. **“Sign”**: letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, sound or scent
 - c. ***Koninklijke Phillips Electronics v Remington Products (2000)***: the mark should **not be the product itself**
2. **Used or intended to be used?**
 - a. ***Imperial Group v Phillip Morris (1982)***: a mark that is **not going to be used** as a trademark does not fulfil this requirement
3. **Distinguish** goods and services
4. Dealt with or provided in the **course of trade**

1.1.2 Authorship and Ownership of Trademarks

- Application must be made by the **owner of the trademark only**: **s 27**
- In cases concerning prior use **where the owner of the mark is in dispute**
 - Courts have accepted that **prior use is established** by the foreign proprietor who has engaged in a **very small amount of use of the foreign mark** in Australia: ***Aston v Harlee (1960)***
 - **The use should be trading use**: ***Moorgate Tobacco v Phillip Morris (1984)***
 - ***Seven UP v OT (1947)***: use in **journals** held to be **insufficient**

1.1.3 Registration Process

Application s 27	<ul style="list-style-type: none"> • Must be in approved form and must include <ul style="list-style-type: none"> ○ Graphical representation of the TM ○ Nomination of relevant classes ○ Description of the goods and services to which the mark will apply ○ Translation of any part of the mark in a foreign language (GM trying to market the “Nova Car” in Latin America where it means “it doesn’t go”)
Examination s 31	<ul style="list-style-type: none"> • Application examined to ensure there are no grounds for rejecting it <ul style="list-style-type: none"> ○ Application examined in order of filing and includes a substantive examination to ensure they meet the requirements of the Act • Applications are either accepted or rejected after examination: s 33 • Grounds of examination → grounds of rejecting an application <ul style="list-style-type: none"> ○ Absolute grounds: based on characteristics of the proposed mark itself ○ Relative grounds: based on comparison of the proposed mark with existing marks
Acceptance or opposition s 52	<ul style="list-style-type: none"> • Notice of acceptance given to applicant and advertised in the Official Journal • Another person may oppose registration of the TM—accepted applications are vulnerable to opposition for 3 months after the advertisement date